

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY B. RHOADS

Appeal No. 2002-0012
Application 09/545,174

ON BRIEF

Before THOMAS, HAIRSTON, and LEVY, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a paper bearing a Certificate of Mailing of September 30, 2003, appellant requests that we rehear our decision mailed on July 31, 2003, in which we affirmed the examiner's rejection of claims 1-16 under 35 U.S.C. § 103. Inasmuch as we agree with some of the positions set forth by appellant in the Request for Rehearing, our original decision to affirm the examiner's rejection of the claims under 35 U.S.C. § 103 is hereby changed, such that now we reverse that rejection.

Appeal No. 2002-0012
Application 09/545,174

The substance of each independent claim 1, 2, 3 and 16 on appeal requires in part that a first computer or subsystem store data representing "a plurality of creator identifiers and creator contact data corresponding to each of the creator identifiers" as set forth in claim 1. The end of each claim requires that a network communicate an otherwise recited revealed creator identifier from a second computer or subsystem "to said first computer to obtain the creator contact data corresponding to the one of the plurality of creator identifiers from said first memory" as set forth in claim 1. It is the interaction of these features recited in some manner in each of the independent claims on appeal that leads us to presently conclude that the examiner's original rejection within 35 U.S.C. § 103 must be reversed.

A review of pages 6-9 of our original opinion leads us to conclude that we initially set forth an incomplete consideration of all the features of the independent claims on appeal and of the resulting combination of the teachings and suggestions of Shear in view of Powell. Although we remain of the view that the two references are properly combinable within 35 U.S.C. § 103, it is our present view now that the claimed invention would not have resulted.

By the use of the index information, which may be encrypted or un-encrypted, the data stored on the storage medium 100 in Figures 1 and 2 of Shear is read by the host computer 200 in its encrypted form. Then it is sent to the decoder/biller 300 from which it is decoded and sent back to the host computer 200. This is shown generally in Figures 1-4 and discussed at column 4, line 66 through column 5, line 17; column 11, lines 24-38; column 14, lines 3-11; column 14, line 40 through column 15, line 2; column 16, lines 14-68; and column 20, lines 8-10. The discussion of the alternate embodiment in Figure 5 begins at column 20, line 33.

We are therefore persuaded by appellant's reasoning set forth at pages 3-6 of the Request for Rehearing. Although we remain of the view that the decrypted data sent from the decoder/biller 300 back to the host computer 200 would implicitly include creator contact data, the requirements of the independent claims on appeal require more. The claimed first memory recites a correspondence between the creator identifiers and creator contact data. The examiner's correlation of the storage medium 100 as containing the creator identifier data that must be decrypted by the second computer 300 in the manner generally set forth by the claims on appeal in the form of reading a watermark

Appeal No. 2002-0012
Application 09/545,174

in the data is an incomplete view of the claimed requirements. The information sent back to the host computer 200 from the decoder/biller 300 does not access again the storage medium 100 in Figures 1 and 2 to derive any corresponding creator contact data therefrom in the manner required by the claims on appeal. In fact, the storage medium 100 is not again accessed by the host computer 200 once it has received the decrypted information from the decoder/biller 300.

Again, it is emphasized that the independent claims on appeal require that the creator contact data corresponding to one of a plurality of creator identifiers must be obtained from the first memory. The resulting combination of Shear in view of Powell does not teach this feature. As noted earlier, we thus conclude that the subject matter of the independent claims on appeal would not have resulted from the combination of teachings and suggestions of Shear in view of Powell.

In view of the foregoing, since we are persuaded by at least some of the arguments presented by appellant in the Request for Rehearing, our decision originally set forth in our prior opinion

Appeal No. 2002-0012
Application 09/545,174

affirming the rejection of all claims on appeal under 35 U.S.C.
§ 103 is hereby changed, such that we now reverse that rejection.
As such, appellant's Request for Rehearing is Granted.

GRANTED

James D. Thomas)	
Administrative Patent Judge)	
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Kenneth W. Hairston)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 2002-0012
Application 09/545,174

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