

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYA MIYAZAKI, HARUMITSU NAKAJIMA and TETSUO NAKAKAWAJI

Appeal No. 2003-1329
Application No. 09/131,386¹

HEARD: JANUARY 6, 2004

Before BARRETT, BARRY and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 11-30, which are all of the claims pending in this application. Claims 1-10 have been cancelled.

We reverse.

BACKGROUND

Appellants' invention relates generally to digital contents distribution systems and more specifically, to a digital contents

¹ Application for patent filed August 7, 1998, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of the Japanese Application No. 9-246752, filed September 11, 1997.

distribution system that can implement copyright management and charge management of the vended digital contents. According to Appellants, the conventional digital contents distribution systems are unable to flexibly designate the contents and generate a trial-use version of them since not only the expiration date, but also a range of available functions and data that can be referred to, are restricted (specification, page 2). As depicted in Figures 1-3, the first execution verify logic 7, which is initially linked with the digital contents 8 to generate the encapsulated contents 8, is replaced afterward with the second execution verify logic. (specification, page 13). Thus, the encapsulated contents 6 including the first execution verify logic 7 is distributed as a trial-use digital contents with restricted operation, whereas the execution verify logic conversion software is distributed to replace the first execution verify logic 7 with the second execution verify logic which has a looser restriction (id.).

Representative independent claim 11 is reproduced below:

11. A digital contents distribution system comprising:
an author terminal for transmitting digital contents;
a copyright manager for carrying out copyright management of said transmitted digital contents;

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a distribution center for distributing said digital contents and receiving requests for a different degree of access to said digital contents;

at least one user terminal that receives said digital contents; and

an information transmission medium that interconnects said author terminal, said copyright manager, said distribution center and said user terminal,

wherein said author terminal comprises link means for generating a first logic scheme for verification and execution control of said digital contents, said link means linking said first logic scheme with said digital contents,

wherein said copyright manager comprises a logic conversion software generator generating logic conversion software including a second logic scheme in accordance with specifications of said second logic scheme transmitted from said distribution center for replacing said first logic scheme with said second logic scheme upon execution by said user terminal, the second logic scheme providing the user terminal with a different degree of access to the digital contents than the first logic scheme, thereby precluding said distribution center from changing the degree of access to the digital contents granted to the user terminal without first receiving said logic conversion software from said copyright manager, and

wherein said distribution center comprises generating means for generating said specifications of said second logic scheme when said distribution center receives a request for a different degree of access to said digital contents, and an evaluator for comparing said second logic scheme, included in said conversion software transmitted from said copyright manager, with said specifications of said second logic scheme, generated in said distribution center, to verify said second logic scheme, and wherein said distribution center provides said user terminal with at least part of said conversion software and said digital contents linked with said first logic scheme and said conversion software, via said information transmission medium.

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The Examiner relies on the following references in rejecting the claims:

Rosen	5,557,518	Sep. 17, 1996
Stefik et al (Stefik)	5,629,980	May 13, 1997
Ginter et al. (Ginter)	5,892,900	Apr. 6, 1999

(filed Aug. 30, 1996)

Claims 11-13 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik.

Claims 14-19, 21 and 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik, Ginter and Rosen.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik and Ginter.

We make reference to the answer (Paper No. 22, mailed November 15, 2002) for the Examiner's reasoning, and to the appeal brief (Paper No. 21, filed September 5, 2002) and the reply brief (Paper No. 25, filed March 14, 2003) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claims 11-13, 20, 22-25 and 30, Appellants point out that Stefik teaches that digital works are stored in repositories and may be transported between repositories in compliance with usage rights that are permanently attached to the digital works (brief, page 10; reply brief,

page 3). Appellants further point to Column 11, lines 32-44 of Stefik and assert that the usage rights for a digital work may require that a repository be prohibited from further loaning out the work, although the permanently attached usage rights may permit the repository to grant access request upon certain conditions and/or restrictions (brief, page 11; reply brief, page 3). Appellants further point out that upon distribution of the digital work repositories, the permanently attached usage rights define a "next set of rights" that is at least more restrictive than the previous set of rights (brief, page 11; reply brief, page 4). Additionally, Appellants argue that the sections of Stefik which are relied upon by the Examiner as the suggestion for modifying the reference, merely refer to "unauthorized attempts to use the licensed product" and fail to teach or suggest the claimed generating logic conversion software (reply brief, page 5).

In response to Appellants' arguments, the Examiner merely equates the way the "usage rights language" and "software" may be used to invoke a license check in Stefik with the claimed logic conversion software generator (answer, page 34). The Examiner further relies on the license control system of Stefik denying usage in the event a request goes unanswered which indicates

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"unauthorized attempt to use the licensed product" (col. 2, lines 15-20) as the reason for modifying the reference (answer, pages 34 & 35).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been

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led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

After reviewing Stefik, we agree with Appellants' assertion that the claimed logic conversion software generator that generates a second logic scheme to replace the first logic scheme, is absent in the reference. Stefik relates to a system for controlling usage and distribution of digital works wherein the owner of a digital work can attach usage rights to the work which may be stored in a secure repository (col. 3, lines 51-60). The usage rights are permanently attached to the digital work which still remain attached when copies of the work are made (col. 6, lines 51-56). Stefik further discloses that the usage rights are treated as a part of the digital work such that when a copy is loaned out from the repository, further rights to loan out the copy is prohibited such that the users cannot grant more rights than they have (col. 11, lines 33-44). Therefore, the usage rights are transferred with the digital work and are always

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a part of the entire work or the sections the rights correspond to (col. 11, lines 45-53) and are not replaced by a second set.

We further find Appellants' arguments differentiating the claimed invention and the teachings of Stefik based on the lack of suggestion for a specific modification of the reference, to be persuasive. As discussed above, what the Examiner characterizes in Stefik as the suggestion for including a logic conversion software generator (answer, page 8), is actually a general suggestion for implementing a usage rights scheme for preventing unauthorized attempts to use licensed products. In fact, the desire for preventing piracy does not suggest any specific modification to Stefik that would have made one of ordinary skill in the art to modify the disclosed usage rights scheme to encompass the claimed logic conversion software generator that includes a second logic scheme. In that regard, Stefik merely attaches usage rights to the digital work which are permanent and cannot be replaced by a second logic scheme. Thus, Stefik does not disclose or suggest the recited features of claim 11, nor the other independent claim 22 which recites the steps of generating and transmitting logic conversion software and converting the first logic scheme into the second logic scheme.

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Accordingly, the 35 U.S.C. § 103 rejection of claims 11-13, 20, 22-25 and 30 over Stefik cannot be sustained.

Turning to the 35 U.S.C. § 103 rejection of claims 14-19, 21 and 26-29, we note that the Examiner, in relying on Ginter for disclosing digital watermark means and on Rosen for teaching the calculation of a hash value, has not provided additional evidence to overcome the deficiencies of Stefik as discussed above with respect to the rejection of claims 11-13, 20, 22-25 and 30, and therefore, has failed to establish a prima facie case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 14-19, 21 and 26-28 over Stefik, Ginter and Rosen nor of claim 29 over Stefik and Ginter.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 11-30 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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LANCE LEONARD BARRY)	APPEALS
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