

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATOSHI ITAMI, KAZUO NAKASHIMA, and KENICHI UTSUMI

Appeal No. 1998-2658
Application No. 08/507,981

Heard: January 23, 2001

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

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 5-10, and 12, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a software processing apparatus. Specifically, an apparatus is provided for writing software to a medium, or reading software from a medium, only if identification information in the software corresponds to identification information stored in a user

inaccessible area of the medium. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. a software processing apparatus comprising:

first information reading means for reading a first identification information stored in an area to which a user is inhibited from accessing on a medium;

second information reading means for reading a second identification information contained in software;

comparing means for comparing the first identification information read by said first information reading means with the second identification information read by said second information reading means; and

software writing means for writing the software to the medium only if said comparing means recognizes that the first identification information corresponds to the second identification information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tamada et al. (Tamada)	4,879,645	Nov. 7, 1989
Orbach	4,949,257	Aug. 14, 1990
Itami et al. (Itami)	5,418,852	May 23, 1995

Iebcopy, IBM pp. 1-6, (1993).

Claims 1-3, 5-7, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Orbach in view of IBM and Itami.

Claims 8-10 stand rejected under Orbach in view of IBM and Itami, and further in view of Tamada.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed July 31, 1998) and the supplemental examiner's answer (Paper No. 19, mailed October 28, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed May 14, 1998), reply brief (Paper No. 17, filed September 29, 1998), and supplemental reply brief (Paper No. 20, filed December 27, 1999) for the appellants' arguments thereagainst.

The appellants state (brief, page 6) that each of the claims are considered to be separately patentable. From our review of the briefs, we find that the appellants have only presented arguments as to claims 1, 7, 9, and 10. Accordingly, the remaining claims on appeal will stand or fall with the claims from which they depend.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-3, 5-10, and 12. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations 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 led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re

Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider first the rejection of claims 1-3, 5-7, and 12 based on the teachings of Orbach in view of IBM and Itami. We begin with claim 1.

The appellants assert (brief, pages 10 and 11) that

More specifically, claims 1, 7 and 9 recite first information reading means for reading a first identification information stored in an area to which a user is inhibited from accessing on a medium, second information reading means for reading a second identification information contained in software, comparing means for comparing the first and second identification information, and software writing (or reading) means for writing (or reading) the software to (or from) the medium when the comparing means recognizes that the first identification information corresponds to the second identification means.

According to the appellants (brief, page 14) the references "do not teach or suggest the claimed combinations including information stored in an area on a medium that is inaccessible to a user and which requires comparison of first and second information before . . . writing to the medium." The appellants acknowledge (brief, page 13) that "[t]he combination, then, of the disclosures of Orbach, IEBCOPY, and

Itami et al. is a merchandising system for computer software which tracks the customer's ID, which verifies the volume/serial/label number on a medium before unloading data to it, and which verifies the storage capacity of the medium."

However, the appellants maintain (brief, pages 13 and 14) that

Orbach, all purchased information is accessible to the user/customer. In Itami et al., there is a user accessible area and a user inaccessible area on optical disk. There is not, however, any teaching of placing the data in the user accessible area into the inaccessible area on the optical disk.

The examiner asserts (answer, page 4), inter alia, that Orbach teaches,

first information reading means for reading a first identification information (col. 3 lines 50-54, reading name or title of customer's program selection);

second information reading means for reading a second identification information contained in software (col. 4 lines 39-44, reading name of selected software or selected program on disk after customer selected the program);

The examiner acknowledges (answer, page 5) that "Orbach does not explicitly teach reading the first identification information stored in an area to which a user is inhibited from accessing on a medium." To overcome the deficiencies of Orbach, the examiner turns to IBM and Itami. According to the

examiner (answer, page 6), it would have been obvious "to combine the teachings of Orbach, IBM, and Itami to store the first identification information in a user inaccessible area of a recording medium as taught by Itami, and use the utility program's IEBCOPY to verify the identification information stored on the medium before copying the selected program to the recording medium because it would provide data security and prevent software from being unlawfully copied."

We find that in Orbach (col. 3, lines 32-63), after displaying available programs (software) to the user (functions 3 and 4) and allowing for program evaluation by the user on computer 14 (function 5), the customer choice of the program (software) to be purchased is accepted (function 6). The customer may then be asked to choose a format for the carrier (disk), (function 7). After this selection is completed, a batch file is created (col. 4, lines 39-42), which includes the name of the selected software package and echoes the customer's I.D. The purchased program is then written to the carrier (function 8). The customer I.D., program identification, etc., are incorporated on the program and a sales report is printed out (function 9).

From the above teachings of Orbach, we find that in Orbach, the program identification information is incorporated onto the purchased program, which has already been copied onto the disk. Because the program identification information is copied onto the program, which is available to the user, we are in agreement with the appellants (brief, page 13) that in Orbach, the purchased information is accessible to the user.

The examiner relies upon Itami (answer, page 6) for a teaching of storing the first identification information in a user inaccessible area of a recording medium. We find that in contrast to Orbach, where a vendor is writing purchased software onto a disk and providing the disk to a customer, Itami is directed to (col. 1, lines 9-15) preventing unauthorized use of a disk. In Itami, (col. 6, lines 32-36) data indicating the storage capacity $L(=V2)$ of ram area 16 on disk 1 is recorded on DMA area B, which is not accessible to the user. Storage unit 22 of host computer 100, stores the storage capacity $L(=V1)$ (col. 6, lines 39-41). Itami further discloses (col. 6, lines 41-55) that read unit 20 reads storage capacity $L(=V2)$ from the inaccessible area of the disk. Comparator 24 compares the reading of $L(=V2)$ from read

unit 20, and L(=V1) from store unit 22. If V1 does not equal V2, a determination is made that the disk has been unlawfully produced.

From these teachings of Itami, we find that in Itami, identification information is written in ROM area B, which is inaccessible to the user for comparison with the identification information stored in host computer 100, in order to prevent an unlawfully copied disk from being used. In Orbach, the program identification information is already incorporated onto the program by the vendor before the disk is given to the purchaser.

From our reading of Orbach, it is clear that Orbach is not concerned with preventing unauthorized writing of a program onto the disk, as Orbach's merchandising system writes the program to the disk, after the program has been purchased. The examiner relies upon Orbach's (col. 3, lines 50-54) reading of the name or title of the customer's program selection, for a teaching of a first identification reading means for reading a first identification information. We see no reason or suggestion in the prior art as to why one of ordinary skill would have been led to have written this

program identification information in Orbach's ordering system onto the medium as a first identification information. The examiner (answer, page 4) further relies upon the name of the software on the disk as the second identification means. We find that Orbach teaches writing the name of the software (program identification) onto the program on the disk (col. 3, lines 57-59). However, as the second information means is already written on the disk by Orbach, we see no reason or suggestion as to why one of ordinary skill in the art would have modified Orbach to have added the same identification information to a nonaccessible area of the disk, as a first identification means (answer, page 6), and then compare the two identification means before writing the software to the disk.

The examiner's reasoning for the modification (answer, page 6) is to provide data security and prevent software from being unlawfully copied. We agree with the examiner that Orbach suggests adding anti copying protection onto the written program (function 10) (col. 4, lines 1 and 2). In addition, the prior art to Itami, IBM and Orbach as a whole suggest comparing information prior to copying, to ensure that

the correct program is copied to the disk before giving the disk to the user. However, even if anti copying protection were written on the program of Orbach as taught by Itami, and even if Itami's identification information were provided in an area inaccessible to the user, the limitations of claim 1 would still not be met. Claim 1 recites "software writing means for writing the software to the medium only if said comparing means recognizes that the first identification information corresponds to the second identification information." Thus, claim 1 requires correspondence of the first and second identification information prior to writing the software to the medium. The identification information provided in a user inaccessible area as taught by Itami would only be useable to prevent copying of the software from the disk. This is not the same as preventing writing to the disk.

With regard to the IBM reference, both the examiner (supp. answer, page 2) and the appellants (reply brief, pages 1-3 and supp. reply brief, pages 2 and 3) dispute whether a comparing function inherently occurs when utilizing IBM's copy utility. We need not decide this point for two reasons.

Firstly, the appellants acknowledge (brief, page 13) that "[t]he combination, then, of the disclosures of Orbach and IEBCOPY is a merchandising system for computer software which tracks the customer's ID and which verifies the volume/serial/label number on a medium before unloading data to it" (emphasis added). Secondly, even if IBM inherently teaches comparison of first and second file identification information before copying a file, the resultant teachings of the prior art as a whole would only suggest that Orbach's system verifies the name of the program before copying the program onto the disk. The combined teachings of Orbach, IBM and Itami would still not suggest "the claimed combinations including information stored in an area in a medium that is inaccessible to a user and which requires comparison of first and second information before . . . writing to the medium" as asserted by the appellants (brief, page 14).

Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of claim 1. The rejection of claim 1 under 35 U.S.C. § 103, is therefore reversed. As claims 2, 3, 5, 6, and 12 depend from claim 1,

the rejection of claims 2, 3, 5, 6, and 12 under 35 U.S.C. § 103 is reversed.

Turning next to independent claim 7, we note that claim 7 does not recite writing the software to the medium. The claim instead recites reading the software from the medium. Claim 7 additionally recites "second identification reading means for reading a second identification from the medium if¹ software and the second identification information are written to the medium." The appellants present the same arguments regarding claim 7 and they do for claim 1, with the exception that "writing to" has been replaced with "reading from." We find that claim 7 is not met by the combined teachings of Orbach, Itami, and IBM because the prior art does not suggest having both the first and second identification information in the

¹ We note that claim 7 utilizes the conditional term "if." We have construed the claim to require the clause "software . . . medium" to occur, as the claimed comparing means could not compare the first identification information with the second identification information, if no reading of the second identification information occurs. Additionally, nor could the software be read from the medium if the second identification information was not read. As the metes and bounds of claim 7 can only be ascertained when the conditional term "if" is construed as occurring, we find that this is the only possible interpretation of the claim that is clear and definite within the meaning of 35 U.S.C. § 112, second paragraph. As the examiner has not raised the issue of 35 U.S.C. § 112, second paragraph, with regard to claim 7, we decline to do so in view of our stated interpretation of the claim language.

medium. The anti copying protection of Itami would prevent illegal software from being read from the medium. However, in Itami, the second identification information is in the host computer, stored in capacity storage unit 22. We find no suggestion in the applied prior art for locating both the first and second identification information on the medium, except from the appellants' disclosure. Accordingly, we conclude that the examiner has failed to establish a prima facie case of obviousness of claim 7. The rejection of claim 7 under 35 U.S.C. § 103 is therefore reversed.

Turning next to claims 8-10, as Tamada does not overcome the deficiencies of Orbach in view of IBM and Itami, and independent claim 9² contains similar language as claim 1, the rejection of claims 8-10 under 35 U.S.C. § 103 is reversed.

² In claim 9, line 5, it would appear that the "second reading means" should read as "second information reading means" to be consistent with lines 9 and 10 of claim 9. We consider this a formal matter which the examiner can address subsequent to this appeal.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3, 5-10 and 12 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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KENNETH W. HAIRSTON
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge
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SSL:pgg
STAAS & HALSEY
SUITE 500
700 11TH STREET NW
WASHINGTON , DC 20001