

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BEN GARCIA

Appeal No. 2000-0753
Application 08/909,545¹

ON BRIEF

Before BARRETT, FLEMING, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-17.

We reverse.

¹ Application for patent filed August 12, 1997, entitled "Method for Making Copy Protected Optical Discs."

BACKGROUND

The invention relates to a method for protecting against unauthorized copying of information on an optical medium which stores information in a spiral track. A "mark" is placed in a predetermining location within the spiral track by a special process. The mark cannot be reproduced except by a LBR (laser beam recorder) used in mass CD-ROM manufacturing. Verification of the mark is checked by executable code on the disk.

Claim 1 is reproduced below.

1. A method for protecting against unauthorized copying of information on an optical medium comprising the steps of:

a) placing at least one mark at each of at least one corresponding predetermined location on an optical medium, which at least one location is within a continuous spiral track of said optical medium, which mark is incapable of being reproduced except by a mass reproduction recorder, and which mark, when read by a device adapted to read data contained in said continuous spiral track is incapable of being read, and, thereby prevents writing a copy of said mark on an optically recordable medium;

b) adding an executable code module to said optical medium, said executable code module adapted to verify said at least one mark, and allow access to data and programs on said optical medium after said verification of said at least one mark.

The examiner relies on the following references:

Oshima et al. (Oshima '301)	5,761,301	June 2, 1998 (filed November 17, 1995)
Oshima et al. (Oshima '551)	5,805,551	September 8, 1998 (filed April 25, 1997)

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Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oshima '301 and/or Oshima '551.

We refer to the final rejection (Paper No. 4) (pages referred to as "FR__") and the examiner's answer (Paper No. 11) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 9) (pages referred to as "Br__") and reply brief (Paper No. 12) for a statement of appellant's arguments thereagainst.

OPINION

It is the examiner's duty to establish a prima facie case of obviousness. The way to do this is to point out, with specificity, where each of the claim limitations are taught or suggested in the references. Oshima '301 has 43 sheets of drawings and 42 columns of text and Oshima '551 has 133 sheets of drawings and 66 columns of text. We do not find the examiner's general description of the Oshima patents and references to a couple of figures in each to be of much help in addressing the particular claim limitations. Nevertheless, we try our best to read the claims on the references. We start with Oshima '301.

Oshima '301 discloses a copy protection technique. With reference to the secondary recording process 817 in figure 1, an anti-piracy copy protection mark is formed in the radial direction in random locations on completed disks (step 819a); accurate position information about the mark is read by a

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measuring means (step 819b); this physical feature information is encrypted (step 819c); and is recorded as a barcode signal on the disk by a laser (step 819d).

Claim 1 recites "placing at least one mark at each of at least one corresponding predetermined location on an optical medium" (emphasis added). The limitation does not define the nature of the mark, i.e., it does not describe that the mark is an area where the format is incorrect (e.g., not an eight-to-fourteen modulation (EFM) as required industry standard), so the nonreflective portions of Oshima '301 can be considered a mark (at least as far as this first limitation goes). Oshima '301 discloses (col. 13, lines 28-31): "Laser markings are formed at random in the anti-piracy mark formation process at the factory. No laser markings formed in this manner can be identical in physical feature." (Emphasis added.) Clearly, a random location is not a "predetermined location" as claimed. The examiner does not address this limitation and, thus, the rejection must fail based on the first phrase of the claim. Nevertheless, we address all of the claim limitations.

Claim 1 continues, "which at least one location is within a continuous spiral track of said optical medium." Oshima '301 discloses that the marks are formed by removing the reflective coating to form a nonreflective portion in a radial direction, cutting the spiral track at several places (figures 2A-2C;

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figure 13A-13B; figure 41, marking 9103). Each cut through a track broadly represents a location within a continuous spiral track as shown in figures 2C and 2D.

The examiner interpreted "within a continuous spiral track" as "any location on the disk having a spiral track" (FR2). We agree with appellant's argument (Br7) that this is an erroneous interpretation. However, it has not been shown that the mark in Oshima '301 which cuts across the spiral track several times (figure 2C) does not have a mark within the spiral track.

The examiner states (EA4; see also EA6):

[A]lthough the references do not disclose the use of placing at least one mark on at least one location within spiral data track on the disk, such limitation is merely an alternative equivalent to placing at least one mark on at least one location on a concentric track within the disk data area. Furthermore such limitation is suggested in the references as illustrated in Oshima et al (301) in figures 2D and fig 3 showing a marking within a data track and figs 13A, 13B and 19 showing spiral data tracks on the disk

By stating that placing a mark on a spiral data track is an alternative to placing a mark on a concentric track, it appears that the examiner finds that Oshima '301 does not disclose a spiral data track, which finding is clearly erroneous. This erroneous "difference" appears to be the reason for the obviousness rejection since no other "differences" are addressed. As we have found, the mark in Oshima '301 has several locations which are within the continuous spiral track. The examiner's finding of a difference which does not exist is harmless error.

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Appellant argues that Oshima '301 teaches the use of a physical mark at a physical film level, in a secondary recording process, rather than the master disk level physical mark (Br7). The examiner responds that the claims do not require the mark to be created by the mastering machine and do not recite the process of how the marks are recorded on the disk (EA6).

The examiner is correct. We find no language in the limitation at issue, or in claim 1 as a whole, that distinguishes over placing the mark by a secondary recording process or that requires the creating the mark at the master disk level. Appellant has not pointed to any specific limitations in the claims to support his argument.

Claim 1 continues, "which mark is incapable of being reproduced except by a mass reproduction recorder." The examiner finds that "the mark is reproduced by a mass reproduction recorder (optical head)" (FR2). Appellant argues that the examiner errs in construing the mass reproduction recorder as an optical head because a mass reproduction recorder is defined in the specification at page 5, lines 21-33, as a particular piece of equipment which is much narrower than an "optical head" (Br7-8). The examiner responds that "[t]he claims do not exclude the use of a magnetic head, bar code optical probe..etc. the claim merely recite[s] the use of a mass reproduction recorder and not an optical mass reproduction recorder" (EA6-7).

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As previously observed, the nature of the mark is not claimed. However, the limitation does require that the mark, whatever it is, is capable of being reproduced by a mass reproduction recorder. The examiner has not shown that there is a device in existence which can reproduce the mark in Oshima '301 and, so, has not shown that this limitation is met. We also agree with appellant that a mass reproduction recorder has been described in the specification and that the laser beam recorder (LBR) structure involves more than simply an optical head as stated by the examiner. The important thing is that the mark can be reproduced only by a mass reproduction recorder.

Claim 1 further states "and which mark, when read by a device adapted to read data contained in said continuous spiral track is incapable of being read, and, thereby prevents writing a copy of said mark on an optically recordable medium." The examiner does address this limitation and has not shown that a conventional optical reading device cannot read the mark.

Claim 1 recites "adding an executable code module to said optical medium, said executable code module adapted to verify said at least one mark, and allow access to data and programs on said optical medium after said verification of said at least one mark." The examiner finds that "when the mark is read by a device (optical head) it prompts the device to stop recording and reproducing operation, a software within the disk area prompts

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the user to enter a password, code, ID ..etc in order to verify whether that entered code" (FR2). Appellant argues that the present invention does not include a prompt or user entered password or the like as asserted by the examiner (Br8). It is argued that the present invention includes an executable code module which itself verifies the mark located in a spiral track or data following the track (Br8). The examiner responds that "Oshima et al (301) column 12 line 60 to column 13 line 14 discloses the use of reading position information using encryption data to identify the marking position on the disk meeting appellant's claimed invention" (EA7).

The term "executable code" requires instructions that are executed, not a mere recorded barcode of marking position information that is compared by an external program or hardware as shown in Oshima '301, figure 41. The information recorded in the barcode in Oshima '301 does not verify the mark or allow access to data and programs on the optical medium, as claimed. The examiner's rejection does not address the terminology of "executable code" or the fact that the executable code on the optical medium is adapted to perform verification and access functions.

For the reasons stated above, the examiner has failed to establish a prima facie case of obviousness. The rejection of claim 1, and its dependent claims 2-14, is reversed. Claim 15 is

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similar to claim 1 except that claim 15 recites that the executable code is "adapted to verify correctness of data following said mark contained on said optical medium." This limitation is not taught or suggested in Oshima '301, nor has the examiner sought to address this limitation. For this reason and for the reasons stated in the analysis of claim 1, the rejection of claim 15 and its dependent claims 16 and 17, is reversed.

The examiner's final rejection contains no details of how Oshima '551 is applied to claim 1. The examiner's answer only refers to figures 41a and 46 of Oshima '551. Figure 41 is similar to figure 2 of Oshima '301. Since Oshima '551 is a long and complicated patent, having some fourteen embodiments, we will not hunt through it looking for something that might support the examiner's rejection. It appears that the copy protection of Oshima '551 (the second embodiment, cols. 22-30) is a variation of Oshima '301, which uses the location of physical marks on the disks, and has the same deficiencies as Oshima '301. The examiner has failed to set forth a prima facie case of obviousness. Accordingly, the rejection of claims 1-17 over Oshima '551 is reversed.

We note that the examiner never addressed the patentability of the dependent claims during prosecution. In response to appellant's argument in the brief that the examiner had failed to set forth separate grounds for rejection of these claims with

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specific reference to the prior art (Br10), the examiner briefly treats the dependent claims in the examiner's answer (EA7-8). This constitutes a new ground of rejection and appellant could have petitioned to have the rejection so labeled and prosecution reopened. Since we reverse the rejection of the independent claims, it is not necessary to address the dependent claims.

CONCLUSION

The rejections of claims 1-17 are reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
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