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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XIN WANG

Appeal 2011-006559
Application 10/424,785
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
PHILIP J. HOFFMANN *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-26, 30-49, and 112-113. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE DECISION

We REVERSE.¹

BACKGROUND

Appellant's invention relates to a system and method for specifying and processing legality expressions, such as contracts, within a Digital Rights and Contracts Management system (Spec., para. [0002]).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method for specifying a legality expression for use in a system for processing said legality expression, said method comprising:
 - selecting at least one digital data element from a legality expression language, including at least one of, a duty element specifying an obligation that a principal must perform an act, a ban element specifying a prohibition that a principal must not perform an act, and a claim element specifying an assertion that a principal does perform an act;
 - determining at least one attribute value for the at least one data element;
 - a computer device transforming the at least one digital data element and the at least one attribute to create a legality expression; and
 - recording the legality expression in a form that can be interpreted by the system for processing legality expressions to thereby permit the system to enforce the legality expression.

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed November 1, 2010) and Reply Brief ("Reply Br.," filed February 24, 2011) and the Examiner's Answer ("Ans.," mailed December 27, 2010).

THE REJECTION

The following rejection is before us for review:

Claims 1-26, 30-49, and 112-113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ganesan (US 2002/0019814 A1, pub. Feb. 14, 2002) in view of Wyman (US 5,204,897, iss. Apr. 20, 1993).²

ANALYSIS

Independent claims 1 and 30

We are persuaded of error on the part of the Examiner by Appellant's argument that neither Ganesan nor Wyman discloses or suggests the required "selecting at least one digital data element . . . including at least one of, a duty element specifying an obligation that a principal must perform an act, a ban element specifying a prohibition that a principal must not perform an act, and a claim element specifying an assertion that a principal does perform an act," as recited in claim 1. The Examiner maintains that the rejection of claim 1 is proper and that Ganesan discloses "selecting at least one digital data element from a legality expression language (programs, see P0001), including at least one of, a duty element (render command, see P0105-0109) specifying an obligation that a principal must perform an act" (Ans. 18). *See also* Ans. 4. The Examiner also maintains (in response to Appellant's arguments in the Appeal Brief) that Ganesan discloses "at least one condition precedent (i.e. duty element) to allowing an event to proceed (see abstract, P0033, 0232-0234, 0249). These condition precedents are duties that must be fulfilled before rendering the content" (Ans. 18). And

² The rejection of claims 1-26, 30-49, and 112-113 under 35 U.S.C. § 112, first paragraph, has been withdrawn (Ans. 17).

the Examiner further maintains that “Ganesan discloses preventing the license from allowing particular types of rendering-action events (i.e. ban element) to proceed (see Ganesan claim 18)” and also discloses “that the user’s computing device must provide a trusted component (i.e. claim element) to satisfy the content owner (see P0098)” (Ans. 18). We cannot agree.

Ganesan discloses an enforcement architecture that allows an owner of digital content to specify license rules that govern a user’s right to render the digital content on the user’s computing device (Ganesan, para. [0036]). Ganesan describes in paragraphs [0105] through [0109], on which the Examiner relies, that a user will attempt to render, e.g., open, run, execute, play, and/or the like, the digital content by executing some variation of a render command. Each type of rendering is performed only if the user has the right to do so. Ganesan thus describes in paragraphs [0107] through [0109] that when a user requests, for example, to play particular digital content, the rendering application determines whether the digital content is encrypted in a rights-protected form and instructs the DRM (digital rights management) system to decrypt the content only if the user has a valid license for the digital content and the right, under the terms of the license, to play the digital content.

We agree with Appellant that a “render command,” as thus described by Ganesan, does not specify “an obligation that a principal must perform an act,” and, therefore, is not a “duty element,” as recited in claim 1 (Br. 11-13). Instead, a “render command” is a request, that the user may choose to make but has no obligation to make, which is executed to render digital

content only if the user has a valid license and also has the right under the license to perform the requested rendering.

We also agree with Appellant that there is no teaching or suggestion of a “at least one of, a duty element . . . , a ban element . . . , and a claim element” in any of other cited portions of Ganesan on which the Examiner relies, i.e., the Abstract, paragraphs [0033], [0098], [0232] – [0234], and [0249], and claim 18 (Reply Br. 1-6).

Ganesan describes in the Abstract and paragraphs [0033], [0232] – [0234], and [0249] that a license may specify certain conditions precedent and/or actions to be taken in connection with certain types of events, e.g., storage of the license, selection of the license, deletion of the license, a request for an action with respect to the license (such as play, print, copy, etc.), and a clock rollback, before the event is allowed to proceed. However, we do not agree that the conditions precedent thus described by Ganesan are a “duty element” that specifies “an obligation that a principal must perform an act” at least because there is nothing in any of the cited portions of Ganesan that requires that any particular event be performed. Because there is no requirement, i.e., obligation, to perform a particular event, it necessarily follows that there also is no obligation that the user satisfy a condition precedent and/or take certain action in connection with that event. A user clearly may choose to do so, i.e., if he/she wants to effectuate the event, but there is no “obligation that [the user] must perform” those acts.

Regarding the claimed “ban element,” claim 18 of Ganesan recites that “failure to include a particular type of rendering-action event in the license prevents the license from allowing the particular type of rendering-action event to proceed.” But specifying that failure to include a certain

rendering-action in the license prevents that rendering-action event from proceeding is not the same as including a “ban element” in the license that specifies that the principal is prohibited from performing a certain act. Instead, as Appellant observes, claim 18 merely reinforces what is well-known in the art, i.e., if an act is not licensed, that act is not authorized to occur (Reply Br. 5).

Finally, with respect to the “claim element,” Ganesan discloses in paragraph [0098] that the user’s computing device must provide a trusted component or mechanism that can satisfy the content owner that the computing device will not render the digital content except in accordance with the terms of the user’s license. However, there is nothing in that paragraph that discloses or suggests a “claim element,” as recited in claim 1, i.e., a “digital data element from a legality expression language” that specifies “an assertion that a principal does perform an act.”

The Examiner takes the position that the trusted component described in paragraph [0098] is the claimed “claim element” (Ans. 18). However, the trusted component described by Ganesan is not a “digital data element specifying an assertion that a principal does perform an act” that may be transformed to create a “legality expression;” instead, it is a mechanism that ensures compliance with the applicable license terms, e.g., a digital rights management system “that determines whether the user has a license 16 to render the digital content 12 in the manner sought, that effectuates obtaining such a license 16 if necessary, that determines whether the user has the right to play the digital content 12 according to the license 16, and that decrypts the digital content 12 for rendering purposes if in fact the user has such right according to such license 16” (Ganesan, para. [0099]).

In view of the foregoing, we will not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). Claim 30 includes language substantially similar to claim 1. Therefore, we also will not sustain the Examiner's rejection of claim 30 for the same reasons as set forth above with respect to claim 1.

Dependent claims 2-26, 31-49, and 112-113

Each of claims 2-26, 31-49, and 112-113 ultimately depends from one of independent claims 1 and 30. We will not sustain the Examiner's rejection of these claims for the same reasons as set forth above with respect to the independent claims. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).

DECISION

The Examiner's rejection of claims 1-26, 30-49, and 112-113 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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