UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN O. RYAN

Appeal 2009-007071
Application 10/703,681[1]
Technology Center 2400

Decided: March 16, 2010

Before THU A. DANG, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed November 7, 2003. The real party in interest is Macrovision Corporation.

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-51, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

Appellant invented a method to prevent the circumvention of watermarking copy protection by image scaling. (Spec. ¶[0002].)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-51. Claims 1, 13, 24, 35, 47, and 51 are independent claims. Claim 51 is illustrative:

> 51. A method of embedding a plurality of watermarks in video comprising:
>
> a) embedding a watermark having a first scale selected from a range of scales in the video information for a first time period;
>
> b) during or at the end of the first time period, embedding a watermark having another scale selected from the range of scales in the content of the video information for a second time period; and
>
> c) repeating step (b) using a different scale until N number of scales is reached.

C. REFERENCE

The sole reference relied upon by the Examiner as evidence in rejecting the claims on appeal is as follows:

Collier	US 6,360,000 B1	Mar. 19, 2002

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Collier.

II. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Collier

1. In Collier, "the present invention is effective in detecting watermarks in a video stream scaled by any scaling factor in the horizontal and/or vertical dimensions." (Col. 5, ll. 42-44.)

2. Collier discloses that "a watermark or a portion thereof may be embedded in one or more blocks . . ." (Col. 1, ll. 58-59.)

III. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

IV. ANALYSIS

Common Feature In All Claims

Our representative claim, claim 51, recites, *inter alia, "a) embedding a watermark having a first scale . . . in the video information for a first time period; b) during or at the end of the first time period, embedding a watermark having another scale . . . for a second time period; and c) repeating step b) using a different scale until N number of scales is reached."* Independent claims 1, 13, 24, 35, and 47 recite similar limitations. Thus, the scope of each of the independent claims includes embedding watermarks having different scales at various time periods.

The Anticipation Rejection

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 102(e) as being anticipated by Collier.

Appellant contends that in the present invention "the modifications are made in the original (legitimate) DVDs in terms of their video stream having embedded therein at various times during the video stream multiple watermarks of different scales (sizes)." (App. Br. 9.) Appellant further contends that "Collier is detecting a watermark at the recorder by rescaling it at the recorder. He is not doing any 'embedding' of watermarks." (App. Br. 10.)

The Examiner found "Collier discloses how to detect the watermarks within the video st[r]eam by inserting watermarks within the original embedded video watermark, wherein each watermark is divided into equal sizes from a range of scales within a time period." (Ans. 7.)

Issue: Has Appellant shown that the Examiner erred in finding that Collier discloses embedding a watermark as claimed?

Collier discloses a method for detecting watermarks in video streams which have been scaled by any factor (FF 1). Collier further discloses that it is known to embed video information with watermarks (FF 2). However, the Examiner has not established that Collier discloses embedding watermarks in the manner claimed.

For example, in Appellant's invention the video information is embedded, at various time periods, with watermarks of different scales (sizes) (*see* Claim 51). In contrast, Collier starts with embedded

watermarked video information and seeks to *detect* a watermark that has been scaled by an unknown scale (Collier, Abstract). Thus, the Examiner has not shown and we do not readily find where Collier *embeds* watermarks of different scales at various time periods, as claimed. Instead, Collier is primarily concerned with detecting such watermarks and we are left to speculate on how such watermarks were embedded in the first place.

The difficulty that we have with the anticipation rejection before us is that there is no certainty from the Collier reference itself as to what specific embedding procedure is being used to carry out the aforementioned method. Collier merely discloses that several methods have been proposed to embed a watermark in a data stream. (Collier, Col. 1, ll. 45-46.) While it seems logical that one such method would include embedding different size watermarks at various time periods, it is impermissible to make guesses in an anticipation rejection. The Examiner has left it up to us to speculate.

Therefore, we find that the Examiner has *not* set forth a sufficient initial showing of anticipation, and we find that Appellant has shown error in the Examiner's rejection of representative claim 51. Therefore, we reverse the rejection of claim 51 and of claims 1-50, which stand therewith.

Since we agree with at least one of the arguments advanced by Appellant, we need not reach the merits of Appellant's other arguments. It follows that Appellant has shown that the Examiner erred in finding that Collier renders claims 1-51 anticipated.

V. CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-51.

VI. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-51.

REVERSED

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MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO CA 94304-1018