

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CESAR MEDINA, QING GONG, and KENNETH LOUIS MILSTED

Appeal No. 2004-1316
Application No. 09/241,276

ON BRIEF

Before THOMAS, BARRY, and LEVY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 45, 47-63, 65-75, and 77-94. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal concerns electronic distribution of digital "content" such as music, film, computer programs, pictures, and games. (Spec. at 2.) Because of the difficulty in preparing such content for electronic distribution, assert the appellants, owners and publishers have been slow to embrace the use of the Internet

for electronic distribution. Many providers of content have tens of thousands of titles in their portfolio. Having a single master sound recording available on several different formats simultaneously (e.g., CD, tape, and "MiniDisc") is also common. In addition, a single format can have a master sound recording re-mastered or re-mixed for different distribution channels. (*Id.* at 5-6.)

According to the appellants, providers often need to use old recording formats to select the correct master sound recordings and have these sound recordings reprocessed and encoded for release. Manually searching databases of titles, artists, and sound recordings is laborious and subject to human error. (*Id.* at 6.) Manually setting encoding parameters such as equalization levels and dynamic ranges also can be burdensome. (*Id.* at 7.)

Accordingly, the appellants' invention automatically retrieves from a database "metadata" associated with digital content. Such automated retrieval, assert the appellants, "decreases the time and cost that are necessary to prepare the digital content for distribution." (Appeal Br. at 2-3.) The invention further includes a "watermarker," an encoder, or an "encrypter" for processing the digital content. (*Id.* at 3.)

A further understanding of the invention can be achieved by reading the following claim.

92. A method for acquiring metadata and content usage conditions during preparation of digital content, the metadata being associated with the digital content but not including the digital content itself, said method comprising the steps of:

automatically filling in at least some data fields of a metadata template by using a mapping table to retrieve the metadata for the data fields from a preexisting database, the mapping table mapping at least a portion of the data fields of the metadata template to locations within the database where the corresponding metadata can be found; and

automatically acquiring at least a portion of the content usage conditions.

Claims 45, 47-50, 52-63, 65-67, 69-75, 77-79, and 81-94 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,982,891 ("Ginter"); U.S. Patent No. 5,983,267 ("Shklar") and U.S. Patent No. 5,845,281 ("Benson"). Claims 51, 68, and 80 stand rejected under § 103(a) as obvious over Ginter; Shklar; Benson; and U.S. Patent No. 5,812,790 ("Randall").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the main point of contention therebetween. The examiner admits that "Ginter fails to disclose . . . an automatic metadata acquisition tool for automatically filling in at

least some data fields of a metadata template by using a mapping table to retrieve the metadata for the data fields from a preexisting database, the mapping table mapping at least a portion of the data fields of the metadata template to locations within the database where the corresponding metadata can be found." (Examiner's Answer at 9.) Finding that "[w]hen information is requested, the system [of Shklar] refers to the metadata-based index which maps to the location of the requested information in a database, retrieves the information and provides it in a certain format for the user (Figures 8 & 13, Col. 2, lines 23-29; Col. 3, lines 38-45; Col. 5, lines 61-67 and Col. 6, lines 46-55)," (*id.* at 17-18), he asserts, "it would have been obvious . . . to include this capability in the system of Ginter for enabling the automatic retrieval of metadata related to content in view of the teachings of Shklar, enabling the automatic retrieval of information without the need for an operator to manually acquire the information." (*Id.*) The appellants argue, "[t]he Sklar [sic] teaching for the use of metadata is limited to using that metadata to access the data to which it pertains. There is no mention in Sklar [sic] of storing or otherwise relocating retrieved metadata from a preexisting database." (Appeal Br. at 8.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1021, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 92 recites in pertinent part the following limitations: "automatically filling in at least some data fields of a metadata template by using a mapping table to retrieve the metadata for the data fields from a preexisting database, the mapping table mapping at least a portion of the data fields of the metadata template to locations within the database where the corresponding metadata can be found. . . ." Claims 45, 54, 63, 71, 75, and 91 include similar limitations. Considering these limitations, claims 45, 54, 63, 71, 75, 91, and 92 require storing metadata in a database, referencing a table that

maps (at least some of) the data fields of a metadata template to locations in the database where the corresponding metadata can be found, automatically retrieving metadata from the database, and using the retrieved metadata to fill-in automatically (at least some of) the data fields of the metadata template.

2. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Ginter discloses "provides a . . . 'virtual distribution environment' (called 'VDE' in this document) that secures, administers, and audits electronic information

use." Col. 2, ll. 22-25. "Employing VDE creation software . . . and VDE templates, users may create VDE objects 300 by, for example, partitioning the objects, placing 'meta data' (e.g., author's name, creation date, etc.) into them, and assigning rights associated with them and/or object content to, for example, a publisher and/or content creator." Col. 257, ll. 23-29. "When an object creator runs through this process, she [sic] normally will go through a content specification procedure which will request required data. The content specification process, when satisfied, may proceed by, for example, inserting data into a template and encapsulating the content." *Id.* at ll. 29-34.

The examiner does not allege, let alone show, that the reference stores metadata in a database for subsequent retrieval and insertion into a metadata template. To the contrary, he explains that in "Ginter . . . an operator is the entity that manually acquires the information that is inserted into the template." (Examiner's Answer at 17.) Lacking a database for storing metadata, the reference does not include any table for mapping data fields of its VDE template to locations in such as database as admitted by the examiner. (*Id.* at 9.)

For its part, Shklar teaches "a system for accessing and presenting data by creating an object oriented organization of the data that can be used to customize the format for displaying the information in real time." Col. 1, ll. 10-13. "Requests for data are sent by [a] user from the terminal 110 through any network 120, such as the global Internet, and received via the network's routing scheme at a system server 130. Located on the system server 130 are . . . metadata which relates to stored data on remote servers, such as remote server 140." Col. 3, ll. 27-33. "[D]iscrete news items," col. 3, l. 54, are examples of the data stored on the remote servers.

"In use, the user accesses a browser . . . and enters an HTTP request for data, which is routed to the main server," col. 5, ll. 62-63, i.e., the system server 130. "The server [130] retrieves the metadata for the request which tells the server the location of the remote files [i.e., the remote server 140] and the location within the files of the requested data." *Id.* at ll. 64-67. "The encapsulated stored data is retrieved [from the remote server 140] and processed into HTML format, according to the metadata (which was generated according to the structure specification), and the presentation specification and returned to the user's browser for display." Col. 5, l. 67 - col. 6, l. 4.

Although Shklar includes a database, viz., the remote server 140, and an "index . . . used to retrieve information," (Examiner's Answer at 18), therefrom, the reference

does not store metadata in the remote server and does not use the index to map data fields of a metadata template to locations in the remote server. To the contrary, Shklar stores data such as news items in its remote server and uses metadata to index locations therein where data are stored.

The examiner does not allege, let alone show, that the addition of Benson cures the aforementioned deficiency of Ginter and Shklar. Because neither Ginter nor Shklar store metadata in a database for subsequent retrieval and insertion into a metadata template, and neither reference includes a table or index for mapping data fields of a metadata template to locations in a metadata database, we are unpersuaded that teachings from the references would appear to have suggested storing metadata in a database, referencing a table that maps (at least some of) the data fields of a metadata template to locations in the database where the corresponding metadata can be found, automatically retrieving metadata from the database, or using the retrieved metadata to fill-in automatically (at least some of) the data fields of the metadata template.

Therefore, we reverse the obviousness rejection of claim 45 and claims 47-50, 52, 53, 58-61, 87, and 93, which depend from claim 45; of claim 54 and claims 55-57 and 88, which depend from claim 54; of claim 63 and claims 65-67, 69, 70, 73, 74, 89, and 94, which depend from claim 63; of claim 71 and 72, which depends from claim 71; of claim

75 and claims 77-79, 81-86, 90, which depend from claim 75; of claim 91; and of claim 92.

The examiner does not allege, let alone show, that the addition of Randall cures the aforementioned deficiency of Ginter, Shklar, and Benson. Therefore, we reverse the obviousness rejection of claims 51, 68, and 80.

CONCLUSION

In summary, the rejections of claims 45, 47-63, 65-75, and 77-94 under § 103(a) are reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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