

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NEIL D. SATER and MARY BETH SATER

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Appeal 2007-0993  
Application 10/376,198  
Technology Center 2800

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Decided: June 25, 2007

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Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and ST. JOHN  
COURTENAY III, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Neil and Mary Beth Sater (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 3 and 5 through 25, which are all of the claims pending in this application.

Appellants' invention relates to a system and method for customizing media, such as songs, stories, and poems. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A system that facilitates customizing media, comprising the following computer executable components:

a component that provides for a user to search for and select media to be customized;

a customization component that receives data relating to modifying the selected media and generates a customized version of the media incorporating the received modification data, the customization component receives the modification data via populated data fields embedded in the selected media; and

a distribution component that delivers the customized media to the user.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Catona                                      US 6,288,319 B1                      Sep. 11, 2001

Claims 1 through 3 and 5 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Catona.

We refer to the Examiner's Answer (mailed July 27, 2006) and to Appellants' Brief (filed February 21, 2006) and Reply Brief (filed September 27, 2006) for the respective arguments.

#### SUMMARY OF DECISION

As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 3 and 5 through 25.

## OPINION

Independent claim 1 recites, in pertinent part, that the customization component "receives the modification data via populated data fields embedded in the selected media." Independent claim 18 recites a step of "receiving respective modification data . . . , the modification data populated with selectable embedded data fields." Similarly, independent claim 21 recites the means for "receiving data relating to modifying the selected media, the data includ[ing] one or more selectable data fields embedded in the selected media." Thus, each of the independent claims requires data fields embedded in the selected media.

The Examiner asserts (Answer 4) that Catona discloses in column 3, lines 7-20, that "the customization component receives the modification data via populated data fields embedded in the selected media." Appellants contend (Br. 4) that Catona fails to disclose the above-noted limitation. Specifically, Appellants contend (Br. 5) that Catona's karaoke-style mixing system merges and/or superimposes a pre-recorded song track with a user's vocal track. Thus, Catona does not teach or suggest modifying a song by populating embedded data fields in the passage cited by the Examiner or elsewhere. The Examiner responds (Answer 6-7) that Catona discloses the media, the user's vocal track, and the song modified by the user's vocal track being digitally recorded, that digital songs are formed of "populated data fields embedded with information for producing or reproducing the stored data," and that "[t]his means the media is stored as data fields embedded with information related to the customized media to be produced when

retrieved." The issue, therefore, is whether Catona teaches or suggests data fields embedded in the selected media.

Catona discloses (col. 2, ll. 52-67) that a user selects a pre-recorded song from a database. The song is played on an audio player while the user sings the vocal track into a microphone, and a mixer combines the pre-recorded song and the user's vocal track to form a new mixed track. We find no disclosure or suggestion of discrete or selectable data fields embedded in the original song nor of populated discrete data fields in the resulting mixed track. Thus, we cannot sustain the obviousness rejection of claims 1 through 3 and 5 through 25 under 35 U.S.C. § 103.

#### ORDER

The decision of the Examiner rejecting claims 1 through 3 and 5 through 25 under 35 U.S.C. § 103 is reversed.

Appeal 2007-0993  
Application 10/376,198

REVERSED

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