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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL KAPPES, JIAN LIN, IGOR LIOKUMOVICH, HEMANT NANIVADEKAR, and MANDAR GOKHALE

Appeal 2018-002241
Application 14/804,419
Technology Center 2400

Before BRADLEY W. BAUMEISTER, JOSEPH P. LENTIVECH, and SHARON FENICK, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants[1] appeal from the Examiner's decision to reject claims 1–20, the only claims pending in the application on appeal. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

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[1] According to Appellants, the real party in interest is Microsoft Technology Licensing, LLC. App. Br. 1.

STATEMENT OF THE CASE

Appellants' Invention

Appellants' invention generally relates to "a cloud-based storage service that hosts content that may be shared within a peer-to-peer network." Spec. ¶ 17. The Specification provides:

> The content that is shared within a peer-to-peer network may be accessed from a cloud-based storage service. The cloud-based storage service provides a peer-to-peer network with the additional capability of sharing content from a web-based storage facility. A version of the content is stored in the cloud-based storage service as a set of hashes, referred to as content information. The content information is a compacted version of the content that may be downloaded from the cloud-based storage service faster than downloading the original content.

Id. Claim 1, which is illustrative, reads as follows:

> 1. A system, comprising:
>
> at least one processor and a memory;
>
> the at least one processor configured to:
>
> obtain content information associated with a content file, the content file including a plurality of portions of content, the content information comprising one or more hash values that represent a compacted form of one or more portions of the plurality of portions of content;
>
> search for the content information in a peer-to-peer network;
>
> obtain one or more portions of the plurality of portions of the content that match the content information from the peer-to-peer network;
>
> obtain at least one remaining portion of the one or more portions of the plurality of portions of the content from a first remote storage device; and

> merge the one or more portions of the plurality of portions of the content obtained from the content information found in the peer-to-peer network with the at least one remaining portion to construct a merged content file.

Rejections

Claims 1–20 stand rejected on the grounds of non-statutory obviousness-based double patenting based on claims 1–20 of Kappes et al. (US 9,143,568 B2; issued Sept. 22, 2015) ("Kappes"). Final Act. 4–5.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Schlacht et al. (US 2008/0256615 A1; published Oct. 16, 2008) ("Schlacht") and Kallstrom et al. (US 2014/0156866 A1; published June 5, 2014) ("Kallstrom"). Final Act. 5–7.

DOUBLE PATENTING REJECTION

Appellants do not present any arguments regarding the Examiner's rejection of claims 1–20 on the grounds of non-statutory obviousness-based double patenting based on claims 1–20 of Kappes. Accordingly, we summarily affirm this rejection.

REJECTION UNDER 35 U.S.C. § 103(a)

Examiner's Findings and Appellants' Contentions

Appellants contend the combination of Schlacht and Kallstrom is improper. App. Br. 8–10; Reply Br. 6.

In finding claim 1 obvious in view of the teachings of Schlacht and Kallstrom, the Examiner reasons:

> It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate the "content searching with hash" feature of Kallstrom into Schlacht because Schlacht disclose[s] a system to obtain portions of files at a computer network system and Kallstrom provide[s] a way [to] search for the portions of file by using hash.
>
> A person of ordinary skill in the art would have been motivated to make the modification to Schlacht to provide an efficient way to locate content on the network.

Final Act. 6–7; *see also* Ans. 8.

Appellants contend the combination of Schlacht and Kallstrom is improper because "[t]here is no motivation to combine the references in the manner suggested by the Examiner." App. Br. 8 (emphasis omitted). Appellants argue instead of increasing efficiency in locating content, the proposed combination would result in "an increase in the processing needed to retrieve the content" by "requir[ing] the additional processing of distributing the hash values in addition to the non-crucial portions [of the content]." App. Br. 9. Appellants further argue the Examiner "fails to provide a satisfactory explanation for the motivation finding that includes an express and rational connection with the evidence presented" and "[s]uch a conclusory statement with no explanation is inadequate to support a finding of a motivation to combine the references." Reply Br. 6.

Analysis

Appellants' arguments are persuasive. Schlacht teaches that the non-crucial portions of content are distributed by peer-to-peer distribution. Schlacht ¶ 116. The Examiner fails to explain how modifying Schlacht's peer-to-peer distribution method to include Kallstrom's method of using hash values to identify stored content (Kallstrom ¶ 22) provides an efficient way to locate content within Schlacht's peer-to-peer network. The

Examiner, therefore, fails to provide the required articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). As such, we are constrained by the record to not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of claim 1 and claims 2–20.

Because we find this issue to be dispositive as to the rejection under 35 U.S.C. § 103(a) of all the pending claims, we do not reach Appellants' additional contentions of error.

DECISION

We affirm the Examiner's rejection of claims 1–20 on the grounds of non-statutory obviousness-based double patenting based on claims 1–20 of Kappes.

We reverse the Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a).

Since at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED