



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
14/173,934 02/06/2014 Robin Smith 008916.00028 7773

155218 7590 01/31/2019
BANNER & WITCOFF, LTD.
Applications for Client 008916
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

Table with 1 column: EXAMINER

SPRATT, BEAU D

Table with 2 columns: ART UNIT, PAPER NUMBER

2143

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

01/31/2019

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-155218@bannerwitcoff.com
guy.pamela@outlook.com
guy.pamela@outlook.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* ROBIN SMITH, SUNIL ANANT GUPTA,  
MICHAEL STAPLETON, BENJAMIN JAMES DAVIS,  
AMY ANNETTE HAHN, JORDAN HANEIL SHATSOFF,  
JOSHUA BENJAMIN WAKEFIELD, BIYING HUANG,  
SHADRACK CGAR FRAZIER SR.,  
BRANDON WILLIAM ARTHUR GRAHAM,  
BEAU GUY TREMBLAY,  
SONAL SHASHIKANT KULKARNI, DANIEL OBERLIN,  
and JULIE E. NELSON

---

Appeal 2018-005861  
Application 14/173,934  
Technology Center 2100

---

Before JOHNNY A. KUMAR, LINZY T. McCARTNEY, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–21, 23, 24, and 26. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

## BACKGROUND

The present patent application concerns “allow[ing] a user to share data, such as one or more files from within an application with one or more other (not necessarily co-located) computing devices using a gesture-based sharing function.” Specification 1:21–23, filed February 6, 2014 (“Spec.”).

Claims 1, 21, 24, and 26 are independent. Claim 1 illustrates the claimed invention:

1. A method of sharing files via a network-based sharing service, the method comprising:

receiving, via a user interface, selection of at least one file for sharing with a separate computing device;

identifying, by a processor of a computing device, one or more members for sharing, wherein:

each of the one or more members for sharing is associated with a member identifier, and

the member identifier is associated with an account in a member device database of the network-based sharing service and a respective member computing device executing a data share application in communication with the network-based sharing service;

for each member of at least a portion of the identified one or more members for sharing:

receiving, via the network-based share service, a list of eligible file types associated with one or more applications installed on the respective member computing device; and

determining, by the processor, one or more file types for sharing associated with the member, based at least in part on the list of eligible file types;

causing, by the processor, presentation of one or more graphical identifiers within a display area of the computing device, wherein each graphical identifier of the one or more graphical identifiers is representative of a respective member of

the one or more members, wherein the one or more graphical identifiers represent at least a portion of the one or more members;

identifying, by the processor, a user input gesture indicative of moving the at least one file towards at least a first graphical identifier of the one or more graphical identifiers;

causing, by the processor, conversion of the at least one file from a first file type to a second file type, wherein the second file type is selected from the one or more file types for sharing associated with the member represented by the first graphical identifier;

responsive to identifying the user input gesture,

causing, by the processor, presentation of a graphical representation of the at least one file moving towards the at least the first graphical identifier, and

issuing, by the processor, via a network, a request for data sharing, wherein

the request for data sharing comprises a member identifier associated with the first graphical identifier,

the request for data sharing comprises information associated with the at least one file, and

the request for data sharing is directed to the network-based sharing service; and

receiving, via the network-based sharing service, responsive to the request for data sharing, an acknowledgment of data sharing, wherein the acknowledgment comprises the member identifier.

### REJECTIONS

Claims	Basis	References
1, 3–5, 7–17, and 24	§ 103	Forutanpour, <sup>1</sup> Helmig, <sup>2</sup> and Maharajh <sup>3</sup>
2	§ 103	Forutanpour, Helmig, Maharajh, and Sip <sup>4</sup>
6	§ 103	Forutanpour, Helmig, Maharajh, and Wang <sup>5</sup>
18 and 19	§ 103	Forutanpour, Helmig, Maharajh, and Shappell <sup>6</sup>
20	§ 103	Forutanpour, Helmig, Maharajh, Shappell, and Pattan <sup>7</sup>
21, 23, and 26	§ 103	Forutanpour and Maharajh

### DISCUSSION

We have reviewed the Examiner’s rejections in light of Appellants’ arguments, and except for the rejection of claims 21, 23, and 26, we disagree with Appellants that the Examiner erred. As consistent with the analysis below, we adopt the Examiner’s findings, conclusions, and reasoning in the

---

<sup>1</sup> Forutanpour et al. (US 2011/0083111 A1; Apr. 7, 2011).

<sup>2</sup> Johannes Helmig, *ADSL*, WindowsNetworking.com (August 18, 2001), <http://www.windowsnetworking.com/articles-tutorials/netgeneral/adslinfo.html>.

<sup>3</sup> Maharajh et al. (US 2008/0195664 A1; Aug. 14, 2008).

<sup>4</sup> Sip (US 2012/0216153 A1; Aug. 23, 2012).

<sup>5</sup> Wang et al. (US 2014/0181219 A1; June 26, 2014).

<sup>6</sup> Shappell et al. (US 2005/0091289 A1; Apr. 28, 2005).

<sup>7</sup> Pattan (US 2014/0324960 A1; Oct. 30, 2014).

Final Office Action mailed September 7, 2017 (“Final Act.”) and Answer mailed March 20, 2018 (“Ans.”). We address Appellants’ arguments in turn.

### Claim 1

#### *“Receiving . . . an Acknowledgment of Data Sharing”*

Claim 1 recites “receiving, via the network-based sharing service, responsive to the request for data sharing, an acknowledgment of data sharing.” App. Br. 44. Appellants argue the written description limits “an acknowledgment of data sharing” to an acknowledgment that data has been shared. *See* Reply Brief 2–3, filed May 21, 2018 (quoting Spec. 18:18–25, 30:20–28) (“Reply Br.”); *see also* App. Br. 20–22 (quoting Spec. 18:18–20; citing Spec. Fig. 2).<sup>8</sup> Appellants contend that Forutanpour does not teach or suggest “an acknowledgment of data sharing” because Forutanpour teaches acknowledging that data *can be shared*, not acknowledging that data *has been shared*. App. Br. 20–22; Reply Br. 2–3.

We disagree. On its face, claim 1 does not limit “an acknowledgment of data sharing” to an acknowledgment that data has been shared, and Appellants have not pointed to anything in the claim that suggests such a limitation. For its part, the written description suggests that the broadest reasonable interpretation of “an acknowledgment of data sharing” includes an acknowledgment that data can be shared. The written description explains that, in some implementations, after receiving an acknowledgment of data sharing, the disclosed method presents a status notification “(e.g., *acceptance or rejection of the offer to share*, success or failure in file

---

<sup>8</sup> The Examiner (and on occasion, Appellants) cites the published version of the application. *See, e.g.*, Final Act. 33; Reply Br. 2–3. Throughout this decision, we have changed these citations to the corresponding pages and line numbers in the original application.

transfer, etc.).” Spec. 30:25–26 (emphasis added). Because the notification is responsive to “an acknowledgment of data sharing,” the notification indicates that “an acknowledgment of data sharing” includes an acknowledgment of an acceptance or rejection of an offer to share, that is, an acknowledgment that data can be shared.

Although the parts of the written description cited by Appellants suggest that “an acknowledgment of data sharing” also encompasses acknowledgments that data has been shared, the cited parts of the written description do not limit the term to these acknowledgments. The cited parts of the written description simply provide examples of an acknowledgment of data sharing. *See* Spec. 18:19–20 (“*[I]n some implementations, the share service 204 acknowledges, to the first computing device 202, the data has been shared . . .*” (emphasis added)), 30:22–24 (“*In some implementations, the method 600 includes, responsive to receiving the acknowledgment, causing presentation, within the display area, of a notification indicative of success of sharing (626).*” (emphasis added)). Although we must interpret claims in light of the specification, we generally do not limit claims to embodiments disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) (“We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.”). Appellants have not presented any persuasive reason that we should limit “an acknowledgment of data sharing” to the acknowledgments described in these examples.

Given these disclosures, we conclude the broadest reasonable interpretation of “an acknowledgment of data sharing” includes an

acknowledgment that data can be shared. Under this interpretation, we agree with the Examiner that Forutanpour teaches “an acknowledgment of data sharing.” The Examiner found—and Appellants do not dispute—that Forutanpour teaches sending an authorization message in response to receiving a request for permission to transmit a file. *See* Final Act. 5 (citing Forutanpour ¶¶110, 144); *see also* Forutanpour Fig. 43 (showing a method for obtaining user authorization to receive file transmissions). Forutanpour’s authorization message is at the very least an acknowledgment that data can be shared.

*“Causing . . . Conversion of the at Least One File”*

Claim 1 recites “causing, by the processor, conversion of the at least one file from a first file type to a second file type.” App. Br. 44. Appellants suggest that the recited “conversion,” considered in light of the written description, means changing a file to “a completely different *type of data*.” App. Br. 23 (citing Spec. 1:15–18, 9:7–10, 11:1–10, 25:14–23). Appellants contend Maharajh does not teach or suggest such a “conversion” because Maharajh discloses encoding or transcoding data. App. Br. 23–24.

We disagree. Neither claim 1 nor the written description restricts the recited “conversion” in the way argued by Appellants. Claim 1 does not recite converting data to “a completely different type of data”; the limitation simply recites “conversion of the at least one file from a first file type to a second file type.” Although the parts of the written description cited by Appellants may indicate that “conversion” includes changing CDXML or MOL files into image files, the written description does not limit “conversion” to this type of change. At best, the cited parts of the written description describe examples of a “conversion.” *See, e.g.*, Spec. 11:1–10

(disclosing that “in some implementations” selecting a different file type causes conversion into a different file type before sharing), 25:14–23 (same). As explained above, we generally do not limit claims to examples in the specification. *See Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1369. Based on the plain language of the claim, the recited “conversion” encompasses a change from “a first file type to a second file type,” regardless of whether the conversion results in the second file type consisting of “a completely different type of data” than the first file type.

As found by the Examiner, Maharajh suggests such a conversion. The Examiner found Maharajh teaches transcoding a file (for example, a WAV file) into another kind of file (for example, a MP3 file). *See* Final Act. 7 (citing Maharajh ¶ 102); Ans. 36–37 (citing Maharajh ¶¶ 111, 131, 133–134); *see also* App. Br. 23–24 (acknowledging that “according to the approach described in Maharajh, an audio file format (e.g., WAV format) may be encoded to another audio file format (e.g., AMR, MP2, MP3, AAC, AIFF, or OG format)”). We agree with the Examiner that the broadest reasonable construction of “conversion of the at least one file from a first file type to a second file type” includes changing an MP3 file into a WAV file. Maharajh indicates that MP3 and WAV files are different types of files that have different characteristics. *See, e.g.*, Maharajh ¶ 102 (disclosing a list of “standard file types” including WAV and MP3 files and explaining the files have different file extensions), 153 (disclosing that WAV is an uncompressed audio file format and MP3 is a compressed audio file format).

#### *Motivation to Combine*

Appellants argue that “Maharajh does not suggest any benefit or motivation for modifying the approaches [of] Forutanpour and Helmig,

alone or in combination” to include the recited “conversion” limitation. App. Br. 25. In Appellants’ view, “Maharajh is silent with respect to any benefits that may be obtained by” applying its method to achieve the “quick and visually intuitive option for sharing a file with other user(s)” offered by the claimed invention. App. Br. 25.

We disagree. The Examiner found it would have been obvious to combine the teachings of Maharajh, Forutanpour, and Helmig to arrive at the disputed “conversion” limitation because doing so “would provide more personalized, user centric, engaging community experiences with further compelling interaction with all types of media content.” Final Act. 18 (citing Maharajh ¶ 5). Although this motivation may differ from Appellants’ motivation, one of ordinary skill in the art can be motivated to combine references for different reasons than an inventor. “As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992).

#### *Analogous Art*

Appellants contend Maharajh is non-analogous art because it is not “reasonably pertinent” to the problem faced by the inventors. *See* App. Br. 25–29. This is so, according to Appellants, because Maharajh “is not directed to a gesture-based approach” and “does not address a need for the collaborative file sharing tools sought in the Appellant’s approach but is instead directed to the delivery of content.” App. Br. 26–27 (emphases omitted). Appellants assert Maharajh “is largely directed to one-way content

delivery,” not a “back-and forth” collaborative sharing process. App. Br. 27–28.

We disagree. For an obviousness determination under § 103, a reference qualifies as prior art only if the reference is analogous to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Generally, a reference is analogous to the claimed invention when the reference is from the same field of endeavor as the claimed invention or is reasonably pertinent to the problem faced by the inventor. *Bigio*, 381 F.3d at 1325.

For the “same field of endeavor” test, the Examiner found Maharajh concerns the field of mobile file sharing. Ans. 37–38 (finding that Maharajh “address[es] an arising problem in the field of mobile file sharing”); *see also* Final Act. 8 (finding that Maharajh “address[es] the same field of sharing files”). The written description shows the claimed invention is also in the field of mobile file sharing. The written description discloses that the “present invention pertains to . . . gesture-based sharing of data between separate computing devices” and that “separate computing devices” can include “a tablet computer (e.g., an Apple® iPad® . . .),” “computerized eye glasses, or a mobile phone device.” Spec. 9:6–10. Although other parts of the written description may suggest a narrower field of endeavor, “[t]he field of endeavor of a patent is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.” *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016).

As for the “reasonably pertinent” test, “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the

inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). The written description indicates that the problem faced by the inventors was the "need for a file sharing and collaboration tool that is not application-dependent (e.g., does not require all member computing devices to view/modify/share the file(s) using the same software application) and not location-dependent (e.g., computing devices are not necessarily co-located during file sharing and collaboration)." Spec. 1:15–18. With this problem in mind, Maharajh logically would have commended itself to an inventor's attention because, as found by the Examiner, Maharajh discloses a method of sharing files with a mobile device, the method changing file types that are not supported by the device into file types that are. *See* Final Act. 7 (citing Maharajh ¶ 102), 36 (citing Maharajh ¶¶ 6, 11); Ans. 36–37 (citing Maharajh ¶¶ 111, 131, 133–134). The ability to convert unsupported file types into supported file types would have been relevant to the "application-dependent" aspect of the inventor's problem, and the ability to share content with a mobile device would have been relevant to the "not location-dependent" aspect.

#### *Other Arguments*

Appellants assert that the "result of combining [the cited] references would *not* have been predictable to one of ordinary skill in the art." App. Br. 30 (emphasis modified). Appellants contend it would not have been "clear to one of ordinary skill in the art how to modify the location-based sharing of Forutanpour with the content tagging and delivery described in Maharajh" because their approaches would have been incompatible. App. Br. 30.

Appellants thus believe the Examiner's combination "would render Forutanpour and Helmig unsatisfactory for their intended purpose" and make one of Forutanpour's principles of operation "nonfunctional." App. Br. 30. For these reasons, Appellants also contend the Examiner's rejection rests on "improper hindsight." App. Br. 30.

Appellants have not explained why these assertions are true or provided evidence to support them. *See* App. Br. 30. Because Appellants have provided no support for these assertions, we find them unpersuasive. *Cf. In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984) (explaining in the context of unexpected results that "[m]ere argument . . . does not suffice."); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding "that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art").

Appellants also argue that "claim 1 yields synergistic benefits beyond what could be achieved through any combination" of the cited art. App. Br. 31. Appellants contend these benefits flow from a combination of certain limitations recited in claim 1 and assert "[t]he cited art is silent regarding the combination of these, or similar, elements and/or their respective benefits." App. Br. 32.

Appellants fail to provide persuasive evidence or reasoning to support these assertions. Appellants simply assert, without explanation, that the cited art does not teach certain limitations. *See* App. Br. 31–32. This type of conclusory assertion is not enough to show the Examiner erred. *See* 37 C.F.R. § 41.37(c)(1)(iv); *Lovin*, 652 F.3d at 1357. Appellants' assertion that the claimed invention yields "unique benefits" that are "beyond what could

be achieved through any combination” of the cited art also lacks adequate support and is thus unpersuasive. *See* App. Br. 31–32.

*Conclusion*

For the above reasons, we find Appellants’ arguments for claim 1 unpersuasive. We thus sustain the Examiner’s rejection of claim 1. Because Appellants do not present separate persuasive arguments for the rejections of claims 2–20 and 24, we also sustain the Examiner’s rejections of these claims.

Claims 21, 23, and 26

Claim 21 recites “providing, via the network, to the first data share application, the list of eligible file types.” App. Br. 49. Claim 23 depends from claim 21, and claim 26 recites a similar limitation. App. Br. 50, 53–54. Appellants contend the cited portions of Maharajh are silent about claim 21’s “providing” limitation. App. Br. 37; Reply Br. 3–4.

We agree with Appellants. The Examiner relied on paragraphs 77–84, 102, and 131 of Maharajh for the disputed “providing” limitation. *See* Final Act. 27 (citing Maharajh ¶ 78), 36 (citing Maharajh ¶¶ 77–79, 102); Ans. 38–39 (citing Maharajh ¶¶ 80–84, 102, 131). The Examiner has not adequately explained why these paragraphs teach or suggest this limitation. Thus, on this record, we do not sustain the Examiner’s rejections of claims 21, 23, and 26.

DECISION

<b>Claims Rejected</b>	<b>Basis</b>	<b>Reference(s)</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–5, 7–17, and 24	§ 103	Forutanpour, Helmig, and Maharajh	1, 3–5, 7–17, and 24	
2	§ 103	Forutanpour, Helmig, Maharajh, and Sip	2	
6	§ 103	Forutanpour, Helmig, Maharajh, and Wang	6	
18 and 19	§ 103	Forutanpour, Helmig, Maharajh, and Shappell	18 and 19	
20	§ 103	Forutanpour, Helmig, Maharajh, Shappell, and Pattan	20	
21, 23, and 26	§ 103	Forutanpour and Maharajh		21, 23, and 26
<b>Summary</b>			1–20 and 24	21, 23, and 26

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

AFFIRMED-IN-PART