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YOON, ERIC	

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MINKYONG KIM, JAMES R. KOZLOSKI, CLIFFORD A. PICKOVER and MAJA VUKOVIC

Appeal 2018-008127
Application 14/697,810
Technology Center 2100

Before ALLEN MacDONALD, MICHAEL ENGLE, and IFTIKHAR AHMED, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

[1] Appellant identifies the real party in interest as International Business Machines Corporation. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claims 1, 4, 5, and 9 are illustrative of the claimed subject matter (emphasis, formatting, and bracketed material added):

1. A method of controlling icon movement behavior on a graphical user interface, the method comprising:

    [A.] displaying, on a graphical user interface (GUI), a file hosting icon, wherein the file hosting icon represents a file hosting service;

    [B.] displaying, on the GUI, a data file icon, wherein the data file icon represents data, and wherein the data file icon is capable of movement towards the file hosting icon on the GUI to initiate storage of the data by the file hosting service; and

    [C.] adjusting, by one or more processors, a behavior of the movement of the data file icon according to a position of the data file icon relative to a position of the file hosting icon on the GUI and according to predefined features of the data relative to predefined features of the file hosting service.

4. The method of claim 1, wherein said adjusting the behavior of the movement of the data file icon on the GUI results in ***a change in viscosity of an emulated medium*** through which the data file icon travels on the GUI.

5. The method of claim 4, further comprising:

    adjusting, by one or more processors, the viscosity of the emulated medium based on ***a level of sensitivity of the data***.

9. The method of claim 4, further comprising:

    adjusting, by one or more processors, the viscosity of the emulated medium based on ***a history of security incidents*** involving the file hosting service.

REFERENCES[2]

The prior art relied upon by the Examiner is:

Name	Reference	Date
Becker	US 6,392,675 B1	May 21, 2002
Kinawi	US 6,545,669 B1	Apr. 8, 2003
LaBine	US 2009/0292999 A1	Nov. 26, 2009
Ledet	US 2012/0084689 Al	Apr. 5, 2012
Icho	US 2013/0097542 A1	Apr. 18, 2013
Ording	US 2013/0145325 A1	June 6, 2013
Guthrie	US 2013/0212432 A1	Aug. 15, 2013
Sharma	US 2013/0297662 A1	Nov. 7, 2013

REJECTIONS[3]

A.

The Examiner rejects claims 1–9, 13, 14, and 18–20 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie and Becker. Final Act. 3–10.

Appellant separately argues claims 1, 3, 5, 7–9, and 13. App. Br. 16–25, 27–29. Appellant does not present separate arguments for claims 2, 4, 6, 14, and 18–20. Thus, the rejections of these claims turn on our decisions as to claim 1 (with which claims 2, 4, 6, 14, and 18–20 are grouped). Except for our ultimate decision, we do not discuss the § 103 rejection of claims 2, 4, 6, 14, and 18–20 further herein.

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[2] All citations herein to these references are by reference to the first named inventor only.

[3] The Examiner has withdrawn (Ans. 19) the rejection of claims 1–20 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more (Final Act. 2–3).

B.

The Examiner rejects claim 10 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and Ledet. Final Act. 11–12.

C.

The Examiner rejects claim 11 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and Ording. Final Act. 12–13.

D.

The Examiner rejects claim 15 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and Sharma. Final Act. 14–16.

E.

The Examiner rejects claim 17 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and LaBine. Final Act. 18–19.

F.

The Examiner rejects claim 12 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and Kinawi. Final Act. 13–14.

Appellant does not present arguments for claim 12. Thus, the rejections of this claim turn on our decision as to claim 1. Except for our ultimate decision, we do not discuss the § 103 rejection of claim 12 further herein.

G.

The Examiner rejects claim 16 under 35 U.S.C. § 103 as being unpatentable over the combination of Guthrie, Becker, and Icho. Final Act. 16–18.

Appellant does not present arguments for claim 16. Thus, the rejections of this claim turn on our decision as to claim 1. Except for our ultimate decision, we do not discuss the § 103 rejection of claim 16 further herein.

OPINION

We have reviewed the Examiner's rejections in light of Appellant's Appeal Brief arguments that the Examiner has erred.

A.1.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103.

> [T]he final Office Action ***takes the position*** that since *Guthrie* teaches that a data file can be moved to a remote storage location by dragging the data icon to the remote storage location icon (see FIG. 5 and paragraph [0053] of *Guthrie*), and since *Becker* teaches that an icon can be slowed down when it reaches a certain area on a GUI, ***then this is the same as*** slowing down the movement of a first icon towards a second icon.
>
> First, the movement of the data file icon in the present invention depends upon its movement relative to a file hosting icon, not just some predefined area on a GUI (as in *Becker*).
>
> Second, the movement of the data file icon in the present invention depends upon the ***predefined features of the data relative to the predefined features of the file hosting service***. The modification to the movement of the icon (slowing it down)

> in *Becker* depends on whether or not 1) the icon is in the right place on the GUI, and 2) there is no other icon in that spot.

Appeal Br. 19 (emphasis added).

We are unpersuaded by Appellant's argument. First, we disagree with Appellant's assertion that the Office Action takes a "this is the same as" position. Rather, the Office Action takes a position that "[i]t would have been obvious to . . . have incorporated adjusting . . . a behavior of the movement of the . . . icon according to the position of the . . . icon relative to the position of [another] icon . . . as suggested in Becker into Guthrie." Final Act. 5.

Second, Appellant overlooks key words when presenting the assertion that "the movement of the data file icon in the present invention depends upon its movement relative to a file hosting icon, not just some predefined area on a GUI (as in *Becker*)." Appeal Br. 19. In particular, the claim recites "according to a position of the data file icon relative to a position of the file hosting icon." Our review of the record determines that the present invention depends upon the ***position of*** the data file icon relative to a ***position of*** file hosting icon (Spec. ¶ 3), and Becker depends upon the ***location of*** the cursor being within (i.e., at ***a location*** relative to) a predefined area on a GUI (Becker, col. 6, lines 14–18). Contrary to Appellant's assertion, we determine that there is no meaningful difference between these.

Third, the Examiner does not cite Becker alone for the argued "predefined features of the data relative to the predefined features of the file hosting service" limitation. Rather, the Examiner cites Guthrie (¶ 81) and Becker (col. 6, lines 25–52). Final Act. 4–5. Appellant does not address the

full reasoning of the Examiner's rejection. Instead, Appellant attacks the Becker reference singly for lacking a teaching that the Examiner relied on a combination of references to show. It is well-established that one cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). References must be read, not in isolation, but for what they fairly teach in combination with the prior art as a whole. *Merck*, 800 F.2d at 1097.

A.2.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103.

> With regard to dependent **Claim 3**, a combination of the cited prior art does not teach or suggest "wherein said adjusting the behavior of the movement of the data file icon on the GUI results in an emulation on the GUI of a repulsive force between the data file icon and the file hosting icon", as supported by paragraph [0045] of the present specification as originally filed. The final Office Action cites col. 4, lines 39-54 and col. 6, lines 20-53 of *Becker* as teaching this feature. However, col. 4, lines 39-54 of *Becker*, like previously discussed col. 6, lines 20-53 of *Becker*, teach slowing down the rate of movement of a cursor. ***There is never any teaching/suggestion*** of emulating "***a repulsive force*** between the data file icon and the file hosting icon", as claimed in dependent **Claim 3**.

Appeal Br. 20 (emphasis added).

> [I]n *Becker* the cursor slows down when it is where it should be, and ***in the present invention the cursor slows down when it is where it should not be*** (and thus there is a "repulsive force between the data file icon and the file hosting icon").

Appeal Br. 21 (emphasis added).

We are unpersuaded by Appellant's argument. First, Appellant asserts "in the present invention the cursor slows down ***when it is where it should not be.***" Appeal Br. 21 (emphasis added). However, this argument is not commensurate with the scope of the claim language. The structure of claim 3 is not explicitly so limited to "where it should not be," nor does Appellant explain how claim 3 would be inherently so limited, nor do we find alternative language that would similarly mandate the argued limitation. Second, Appellant describes that as the emulated repulsion field gets stronger, movement is made more difficult (i.e., slower). Spec. ¶ 45.

Therefore, based on Appellant's description, we agree with the Examiner that Becker's teaching of slower cursor movement equates to the claimed repulsive force.

A.3.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103.

> First, paragraph [0043] of the present specification is clear with regard to what is meant by "sensitive" when referring to data. Thus, using a definition from a dictionary is contrary to Section 2111.01 (III) of the MPEP.
>
> Second, Claim 5 is not directed to the "sensitivity" of the <u>icon</u> (as suggested by the final Office Action), but rather the "sensitivity" of the <u>data</u> ("based on a level of sensitivity of the <u>data</u>").

Appeal Br. 22 (emphasis added).

We agree with Appellant's first point (that the Specification provides the meaning of "sensitive"). However, we are unpersuaded by Appellant's overall argument that the cited art does not teach or suggest the sensitivity limitation. Appeal Br. 22. Appellant points to paragraph 43 of the

Specification which states: "[f]ile sensitivity may be estimated based on various factors including any of: a topic analysis of text in a document . . .; a file name . . .; a ***file type*** . . .; file metadata . . .; etc." Spec. ¶ 43 (emphasis added). As the Examiner stated, "[Guthrie] [0081] indicates that the system determines the file type and may ascertain that particular ***file types*** are not allowed." Final Act. 4 (emphasis added).

Therefore, based on Appellant's description, we determine that Guthrie's behavior based on file type equates to the claimed sensitivity.

A.4.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103.

> Paragraph [0082] of *Guthrie* teaches that only authorized users may upload a file.
>
> Col. 6, lines 25-53 of *Becker* teaches that a cursor/icon will "slow down" when it gets to its final drop-off area on the GUI.
>
> First, neither *Guthrie* nor *Becker* mention the presently claimed concept of "viscosity of the emulated medium".
>
> Second, there is no motivation to make a user's profile determine the movement of an icon ("adjusting ... the viscosity of the emulated medium"). That is, *Becker* (which modifies how icons move) only teaches that the movement of the icon is based on when the icon is located on the GUI. There is no motivation to make this movement based on the profile of the user of the GUI.

Appeal Br. 23.

We are unpersuaded by Appellant's argument. First, like Appellant's "repulsive force," Appellant describes that for "viscosity of the emulated medium," movement is made more difficult "(e.g. slow[ed] down as if dragging through a viscous fluid)." Spec. ¶ 37. Therefore, based on

Appellant's description, we agree with the Examiner that Becker's teaching of slower cursor movement equates to the claimed viscosity.

Second, Appellant is essentially asserting that it is unobvious "to make a user's profile determine the movement of an icon." We disagree. We agree with the Examiner that "Becker col. 6, lines 25-53 indicates that it may adjust the speed of the cursor/dragged icon depending on whether a target area is valid or invalid." Final Act. 8. Further, we agree with the Examiner that it would be obvious to have a validity/invalidity determination in Becker be based on a user profile (i.e., is the user valid) because "Guthrie [0082] indicates that a user may be allowed to upload only if he/she has proper authority to transfer data using the object area i.e., based on a user profile." *Id*.

A.5.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 8 under 35 U.S.C. § 103.

> With regard to **Claim 8**, a combination of the cited prior art does not teach or suggest the feature supported by paragraph [0062] of the present specification of "adjusting . . . the viscosity of the emulated medium based on a predefined level of trustworthiness of the file hosting service".
>
> First, trustworthiness of a file hosting service is never mentioned by *Guthrie* or *Becker*. Rather, the movement of data to a remote location in *Guthrie* is only dependent upon whether that remote location ***is dedicated to storing that type of data***, not whether the remote location is trustworthy or not. (See paragraph [0081] and [0094] of *Guthrie*.)
>
> Second, the "validity" of a target area in *Becker* has nothing to do with the features of the file hosting service. Rather, the "validity" of the target area in Becker is simply based on its position on the GUI.

Appeal Br. 24 (emphasis added).

We are unpersuaded by Appellant's argument. Appellant points to paragraph 62 of the Specification which states: "a predefined level of ***trustworthiness*** of the file hosting service (i.e., if the file hosting service is not protected by proper password protection, firewalls, ***etc.***, then the emulated viscosity is high, giving the user feedback indicating that it is inadvisable to drop sensitive data into such an unprotected environment)." Spec. ¶ 62 (emphasis added). As Appellant uses "etc." to describe "trustworthiness," we determine that Guthrie/Becker's validity of the file type is sufficient. Further, even if we were to adopt a more limited definition of trustworthiness, Guthrie at paragraph 82 shows that such is a known concern in the art ("a user may be allowed to upload only if he has the appropriate authority").

Therefore, based on Appellant's description, we determine that validity of the file type equates to the claimed sensitivity.

A.6.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 9 under 35 U.S.C. § 103.

> First, a "history of security incidents involving the file hosting service" is never mentioned by *Guthrie* or *Becker*. Rather, the movement of data to a remote location in *Guthrie* is only dependent upon whether that remote location is dedicated to storing that type of data, not whether the remote location is trustworthy or not. (See paragraph [0081] and [0094] of *Guthrie*.)
>
> Second, cited paragraph [0084] of *Guthrie* teaches that only an authorized user can upload data to a remote location. This has nothing to do with security incidents involving the file hosting service.

Appeal Br. 25.

We agree with Appellant's argument. We are persuaded there is insufficient articulated reasoning to support the Examiner's determination that Guthrie and Becker render obvious "adjusting . . . medium based on a ***history of security incidents*** involving the file hosting service" (emphasis added) as required by claim 9. The Examiner determines that "the claimed 'history of security incidents involving the file hosting service' can include one or more past grants of authorization/security status provided to the user." Final Act. 9. However, the Examiner does not indicate how such "history" (or "past grants") is taught, suggested, or otherwise rendered obvious by Guthrie and Becker.

Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 9 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

A.7.

Appellant acknowledges that Guthrie states:

> [A] user may be prompted and/or required to submit certain types of information about a file, such as author's name, company name, sender's name, filename, destination folder or path (e.g., in a file management system), category, creation date, tags, location, GPS, camera type, photography settings, creating application, password protection status, etc. Metadata information may be used, for example, for organizing information in a file management system and/or for facilitating searches of a file management system based on the metadata. In some embodiments, as described in this disclosure, metadata

> information may be received from a user via a user interface (e.g., a metadata entry screen).

Appeal Br. 28 (quoting Guthrie ¶ 46).

Appellant then raises the following argument in contending that the Examiner erred in rejecting claim 13 under 35 U.S.C. § 103.

> [P]aragraph [0046] of *Guthrie* teaches that metadata that is appended to a file may describe a password protection status of the file. However, ***merely password protecting a file does not indicate that the file is confidential***. More specifically, this passage does not teach or suggest "a description of a predefined confidentiality level of the data represented by the data file icon".

Appeal Br. 29 (emphasis added).

We are unpersuaded by Appellant's argument. We disagree with Appellant's assertion that "password protecting a file does not indicate that the file is confidential." *Id*. We conclude that password protection restricts access to the file, and that restricting access indicates the file is confidential.

B.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 10 under 35 U.S.C. § 103.

> Paragraph [0006] of *Ledet* teaches that an item representation can change its appearance when it moves over a drop zone. Paragraph [0082] of *Ledet* teaches that a folder icon can change its appearance when an icon slows down over the folder icon. However, none of these appearance changes are "based on the predefined features of the data being represented by the data file icon".

Appeal Br. 26.

We agree with Appellant's argument. We are persuaded there is insufficient articulated reasoning to support the Examiner's finding that "Ledet teaches adjusting, by one or more processors, a color of the data file

icon as the data file icon is moving relative to the file hosting icon, wherein the color of the data file icon is adjusted based on the predefined features of the data being represented by the data file icon." Final Act. 11. Therefore, we further conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 10 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

C.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 11 under 35 U.S.C. § 103.

> On page 31, the Examiner's Answer states that changing an icon from a trash can icon to a file ejection icon (*Ording*) is equivalent to changing a color of a file hosting icon as the data file icon approaches it (present **Claim 11**). Appellant disagrees. More specifically, the only shading/color changes to icons in cited FIGs. 3A-3C and 6A-6C of *Ording* occurs when a user clicks on the icon. This is unrelated to changing a color of an icon as it approaches another icon.

Reply Br. 6.

We agree with Appellant's argument. We are persuaded there is insufficient articulated reasoning to support the Examiner's finding that "Ording teaches adjusting, by one or more processors, a color of the file hosting icon as the data file icon is moving relative to the file hosting icon, wherein the color of the file hosting icon is adjusted based on the predefined features of the file hosting service represented by the file hosting icon." Final Act. 12. Therefore, we further conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 11 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

D.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 15 under 35 U.S.C. § 103.

> Thus, paragraph [0127] of *Sharma* teaches that even though a document is downloaded and cached on user's device, user can not access [it] outside the office locations. That is, paragraph [0127] of *Sharma* is directed to which files a user can open/display/access in a particular location, even if the files are already on his/her computer. This is unrelated to adjusting the behavior of the movement of the data file icon ("further adjusting . . . the behavior of the movement of the data file icon according to the real-time location of the electronic device").

Appeal Br. 30–31.

We are unpersuaded by Appellant's argument. The Examiner does not cite Sharma for the argued "adjusting the behavior of the movement of the data file icon" limitation. Rather, the Examiner cites Guthrie and Becker. Final Act. 15.

Thus, Appellant does not address the actual reasoning of the Examiner's rejection. Instead, Appellant attacks the Sharma reference singly for lacking a teaching that the Examiner relied on a combination of references to show. Again, it is well-established that one cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references. *See In re Keller*, 642 F.2d at 425; *In re Merck*, 800 F.2d at 1097.

E.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103.

> The final Office Action also cites paragraphs [0002] - [0004] of *LaBine* against **Claim 17**. However, these passages merely describe the ability of networked computers to display shared displayed information. There is no teaching/suggestion in any combination of the cited prior art that such sharing of displayed information will affect "the behavior of the movement of the data file icon on the GUI on the first computer", particularly "***according to the profile*** for the user of the second computer".

Appeal Br. 32 (emphasis added).

We agree with Appellant's argument. We are persuaded there is insufficient articulated reasoning to support the Examiner's determination that Guthrie, Becker, and LaBine render obvious "adjusting . . . the first computer ***according to the profile*** for the user of the second computer" (emphasis added) as required by claim 17. Therefore, we further conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 17 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

CONCLUSION

The Examiner has not erred in rejecting claims 1–8, 12–16, and 18–20 as being unpatentable under 35 U.S.C. § 103.

Appellant has established that the Examiner erred in rejecting claims 9–11 and 17 as being unpatentable under 35 U.S.C. § 103.

The Examiner's rejections of claims 1–8, 12–16, and 18–20 and as being unpatentable under 35 U.S.C. § 103 are **affirmed**.

The Examiner's rejections of claims 9–11 and 17 as being unpatentable under 35 U.S.C. § 103 are **reversed**.

DECISION SUMMARY

In summary:

Claims Rejected	**35 U.S.C. §**	**References/Basis**	**Affirmed**	**Reversed**
1–9, 13, 14, 18–20	103	Guthrie, Becker	1–8, 13, 14, 18–20	9
10	103	Guthrie, Becker, Ledet		10
11	103	Guthrie, Becker, Ording		11
12	103	Guthrie, Becker, Kinawi	12	
15	103	Guthrie, Becker, Sharma	15	
16	103	Guthrie, Becker, Icho	16	
17	103	Guthrie, Becker, LaBine		17
Overall Outcome			**1–8, 12–16, 18–20**	**9–11, 17**

TIME PERIOD FOR RESPONSE

No time 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