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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEVEN FOOTE, PRAYRIT JAIN,  
JIMMY HONLAM CHAN, and SCOTT BLACKBURN

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Appeal 2019-000320  
Application 14/292,627  
Technology Center 2100

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Before ERIC S. FRAHM, KRISTEN L. DROESCH, and  
MICHAEL T. CYGAN, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Microsoft Technology Licensing LLC. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

The claims are directed to interleaving web-based primary and private conversations. *See* Spec. ¶ 1; Abstract. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A processor-implemented method, the processor a component of a server, comprising:
  - establishing, with the processor, a primary conversation among a primary group of users;
  - receiving, with the processor, a command from at least one of the primary group of users to establish a private group including some but not all users of the primary group of users;
  - establishing, with the processor, the private conversation among the private group; and
  - causing, with the processor, a user interface to display the private conversation only to the private group, the private conversation being interleaved on the user interface with the primary conversation.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
McCann et al.	US 2009/0327972 A1	Dec. 31, 2009
Patil et al.	US 2013/0246525 A1	Sept. 19, 2013
Alam	US 2014/0122626 A1	May 1, 2014

### REJECTIONS

Claims 1–6, 8–16, 18–26, and 28–30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patil et al. (“Patil”) and Alam. Non-Final Act. 5–9.

Claims 7, 17, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patil, Alam, and McCann et al. (“McCann”). Non-Final Act. 9.

OPINION

Rejections of Claims 1, 2, 4, 5, 7, 9–12, 14, 15, 17, 19–22,  
24, 25, 27, 29, and 30

Appellant disputes the Examiner’s findings that the combination of Patil and Alam teach or suggest “causing . . . a user interface to display the private conversation only to the private group, the private conversation being interleaved on the user interface with the primary conversation,” as recited in claim 1. Appeal Br. 16; *see id.* at 12–16; Reply Br. 3. Appellant argues independent claims 1, 11, and 21 together as a group. *See* Appeal Br. 16. Consequently, we choose claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(iv) (2017).

The Examiner finds that Patil teaches establishing a primary conversation among a primary group of users and receiving a command from at least one of the primary group of users to establish a private group including some but not all users of the primary group, as required by claim 1, based on Patil’s disclosure that a public conversation can be converted to a private conversation with some or all of the existing participants through the use of “instant groups” where the list of participants in the public conversation is identified for creating the group of participants to be invited to the private conversation. *See* Non-Final Act. 5 (quoting Patil ¶ 11). The Examiner also finds that Patil teaches establishing the private conversation among the private group and causing a user interface to display the private conversation only to the private group, as required by claim 1, based on Patil’s disclosure that “instant groups” on a social network can be utilized to quickly and easily transition from a public conversation to a private conversation. *See id.* at 5–6 (quoting Patil ¶ 12).

The Examiner acknowledges that Patil does not explicitly teach that the private conversation is interleaved on the user interface with the primary conversation, as required by claim 1. *See* Non-Final Act. 6. To address this limitation, the Examiner directs attention to Alam’s teachings that messages from multiple messaging services (e.g., Social Networking Services (SNS) Facebook, Gtalk, WhatsApp) are displayed in a single thread to aid the user in searching and understanding the conversation with the other party. *See id.* (citing Alam ¶ 115, Figs. 8A–B); *see also* Alam ¶¶ 102–103; Figs. 6A, 7B (disclosing a screen with a normal view showing message exchanges between the same party and first, second, and third users pushed from Facebook, Gtalk, and WhatsApp services, where the messages include displays of the corresponding icons for Facebook, Gtalk, and WhatsApp services). The Examiner concludes that it would have been obvious to one with ordinary skill in the art at the time of the invention to incorporate Alam’s feature of displaying messages from multiple messaging services in a single thread with Patil’s teachings of a public conversation and a private conversation, to enhance Patil’s function of displaying messages from different providers (e.g., non-private communication application, private communication application). *See* Non-Final Act. 6.

Appellant argues that the Patil discloses moving a public conversation in a non-private communication application to a private communication tool with some or all of the original participants, but does not teach “that separate public and private conversations exist concurrently, to say nothing of existing concurrently on the same platform.” Appeal Br. 14 (citing Patil Fig. 3); *see id.* at 16 (same argument). Appellant further contends that Patil does not disclose that communications over the non-private application

would advantageously be displayed within the same application as the private collaborative communication tool. *See id.* at 14.

Appellant also argues that “Alam does not show, disclose, or suggest interleaving messages from different conversations, each conversation having a different group of users[,] as required by claim 1.” Appeal Br. 15. Appellant further asserts that “Alam allows *a user* (through a drag and drop mechanism) to move messages received from a particular individual in one message system (say Facebook) to a thread in a different messaging system (say Gtalk) with the same individual, so that all messages from multiple messaging systems *with the same individual* are displayed in a single thread.” *Id.* at 14 (citing Alam ¶¶ 83, 112–115, Figs. 8A–B). Appellant contends that, in Alam, “the users involved in the various messages are the same, under the definition of ‘conversation’ established by claim 1.” *Id.* at 15. Appellant asserts that “Alam at most discloses the consolidation on a single platform of messages related to the *same* ‘conversation.’” *Id.*, *see id.* at 16 (same argument).

Appellant’s arguments are not persuasive of Examiner error because they address the teachings of Patil alone and Alam alone, instead of addressing the teachings of Patil and Alam as combined by the Examiner. One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Contrary to Appellant’s arguments (*see* Appeal Br. 15–16), the Examiner does not rely on Alam to teach or suggest interleaving messages from different conversations having different groups of users, or interleaving a public thread and a private thread. *See* Non-Final Act. 6. The Examiner relies on Patil for teaching public conversations and private

conversations using non-private and private applications, as modified by Alam’s teachings of displaying messages from multiple messaging services in a single thread. *See id.* at 5–6. In other words, as combined by the Examiner, the messages of the public conversation/non-private application and the messages of the private conversation/private application of Patil are modified, in view of Alam’s teachings, to be displayed (i.e., interleaved) in a single thread.

Moreover, Appellant’s following arguments are not commensurate in scope with the limitations of claim 1: (1) Patil does not teach separate public and private conversations exist concurrently, nor exist concurrently on the same platform; and (2) Patil does not recognize that communications over the non-private application would advantageously be displayed within the same application as the private collaborative communication tool. *See* Appeal Br. 14. Claim 1 does not recite or require: (1) concurrent private and public conversations, and on the same platform; and (2) display of public and private conversations within the same application.

For the foregoing reasons, we are not persuaded the Examiner erred in rejecting independent claims 1, 11, and 21. Appellant does not separately and substantive address the limitations of dependent claims 2, 4, 5, 7, 9, 10, 12, 14, 15, 17, 19, 20, 22, 24, 25, 27, 29, and 30. *See* Appeal Br. 19–20. Accordingly, for the same reasons as independent claims 1, 11, and 21, we are not persuaded the Examiner erred in rejecting dependent claims 2, 4, 5, 7, 9, 10, 12, 14, 15, 17, 19, 20, 22, 24, 25, 27, 29, and 30.

*Rejection of Claims 3, 13, and 23*

Claim 3 depends from claim 1 and further recites, “the primary conversation is not viewable by the at least one user of the private group

who is not a user of the primary group of users.” Appellant argues dependent claims 3, 13, and 23 together as a group. *See* Appeal Br. 16–17. As a result, we choose claim 3 as representative of the group. 37 C.F.R. § 41.37(c)(1)(iv) (2017).

The Examiner finds that Patil teaches or suggests the limitations of claim 3 based on Patil’s disclosure of instant groups of users, where the participants of the public conversation are identified for creating the group or members to be invited to the private conversation. *See* Non-Final Act. 6–7 (citing Patil ¶ 11). Appellant contends the Examiner misapprehends the meaning of claim 3 because the cited passage and the remaining disclosures of Patil do not show, disclose, or suggest that a member of the private conversation also is not a member of the public conversation. *See* Appeal Br. 17.

We are not persuaded that the combination of Patil and Alam do not teach or suggest the limitations of claim 3. In addition to disclosing the creation of the group or members to be invited to the private conversation (*see* Patil ¶ 11), Patil also discloses the initial list of potential participants for the private conversation can be modified by adding new users, thereby extending the private discussion to someone who did not participate in the public conversation thread (*see* Patil ¶¶ 43, 45, Fig. 4: 418, Fig. 5).

For these reasons we affirm the Examiner’s rejection of claims 3, 13, and 23. To the extent that we rely on new findings not relied on by the Examiner for teaching or suggesting the limitations of claim 3, we designate our affirmance of the rejection of claims 3, 13, and 23 as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Rejection of Claims 6, 16, and 26

Claim 6 depends from claim 1 and further recites, “a parent message of the primary conversation includes at least one child message from at least one of the primary conversation and the private conversation, the child message being positioned with respect to the parent message.” Appellant argues dependent claims 6, 16, and 26 together as a group. *See* Appeal Br. 17–18. Consequently, we choose claim 6 as representative of the group. 37 C.F.R. § 41.37(c)(1)(iv) (2017).

The Examiner finds that Alam teaches or suggests the limitations of claim 6 based on Figures 8A–B and paragraph 115 disclosing that messages from multiple messaging services are displayed in the single thread to aid the user in searching and understanding the conversation with the other party. *See* Non-Final Act. 8; *see also* Alam ¶¶ 102–103; Figs. 6A, 7B (disclosing a screen with a normal view showing message exchanges between the same party and first, second, and third users pushed from Facebook, Gtalk, and WhatsApp services, where the messages include displays of the corresponding icons for Facebook, Gtalk, and WhatsApp services). Appellant contends the broadest reasonable interpretation of a child message, based on Appellant’s Specification, “is created, e.g., by replying to the parent message.” *See* Appeal Br. 18 (citing Spec. ¶ 27). Appellant asserts Alam merely combines messages from different platforms, and these message are not child messages of one another even if they are between the same users. *See id.* (citing Alam ¶ 102).

We are not persuaded by Appellant’s arguments because Alam discloses in Figures 8A–8B messages that include child reply messages to a parent message, for example, the parent message “Hi Bob?” and the child reply message “Hi Churk,” depicted in Figure 8B. Furthermore, we note

that Patil also discloses the limitations of claim 6, based on Patil's disclosure of the public primary conversation message "Has everyone seen the latest report?" and at least the following child message from the primary conversation: "I have, and the report is confusing. Can you explain page 5 to me?," as depicted in Figure 3.

Therefore, we are not persuaded the Examiner erred in rejecting dependent claims 6, 16, and 26.

*Rejection of Claims 8, 18, and 28*

Claim 8 depends from claim 1 and further recites, "each of the primary and the private conversations include a plurality of messages, wherein the messages of the private conversation include an indicia of being part of the private conversation." Appellant argues dependent claims 8, 18, and 28 together as a group. *See* Appeal Br. 18–19. As a result, we choose claim 8 as representative of the group. 37 C.F.R. § 41.37(c)(1)(iv) (2017).

The Examiner finds that Alam teaches or suggests the limitations of claim 8 based on Figures 8A–B depicting messages of different providers with different indicia. *See* Non-Final Act. 8; *see also* Alam ¶¶ 102–103; Figs. 6A, 7B (disclosing a screen with a normal view showing message exchanges between the same party and first, second, and third users pushed from Facebook, Gtalk, and WhatsApp services, where the messages include displays of the corresponding icons for Facebook, Gtalk, and WhatsApp services). Appellant contends that different providers are not indications of whether or not a message is primary or private. *See* Appeal Br. 19. Appellant further asserts that "the icon corresponding to the different providers only describes the provider, not who the users of a corresponding group are." *Id.*

Appellant's arguments do not persuade us that the Examiner erred. As explained above addressing claim 1, as combined by the Examiner, the messages of the public conversation/non-private application and the messages of the private conversation/private application of Patil are modified, in view of Alam's teachings, to be displayed (i.e., interleaved) in a single thread. In view of Alam's additional teachings of including icons for Facebook, Gtalk, and Whatsapp to indicate different service providers of each of the messages in the single thread (*see* Alam ¶¶ 102–103, Figs. 6A, 7B), the combination of Patil with Alam further teaches or suggests providing different indicia for the messages of the private conversation/private application and for the messages of the primary conversation/non-private application in the single thread.

For these reasons, we are not persuaded the Examiner erred in rejecting dependent claims 8, 18, and 28.

### CONCLUSION

We affirm the Examiner's rejections of claims 1–30 under 35 U.S.C. § 103(a), and to the extent that we have relied on facts or reasoning not relied on by the Examiner, we designate our affirmance of the rejection of claims 3, 13, and 23 as a new ground of rejection pursuant to 37 C.F.R § 41.50(b).

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1–6, 8–16, 18–26, 28–30	103(a)	Patil, Alam	1–6, 8–16, 18–26, and 28–30		
7, 17, 27	103(a)	Patil, Alam, McCann	7, 17, and 27		

3, 13, 23		Patil, Alam			3, 13, 23
<b>Overall Outcome</b>			1-30		3, 13, 23

#### TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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; 37 C.F.R. § 41.50(b)