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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/282,595	10/27/2011	Jonathan Bailor	333502.01	4557
69316	7590	01/24/2020	EXAMINER	
MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052			MUELLER, KURT A	
			ART UNIT	PAPER NUMBER
			2157	
			NOTIFICATION DATE	DELIVERY MODE
			01/24/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JONATHAN BAILOR

Appeal 2019-000562
Application 13/282,595
Technology Center 2100

Before ROBERT E. NAPPI, CARL L. SILVERMAN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. Appeal Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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

CLAIMED SUBJECT MATTER

The claimed invention generally relates to techniques of sharing media files using an iterative file share approach. Spec. ¶ 18. Under this approach, different methods of file sharing may be applied in turn until a workable approach is found. *Id.* For example, where a media file may be shared by a defined set of users, a system may first attempt to generate a valid link to the network storage location for the media file. *Id.* ¶¶ 32, 33, 35. If the generated link is invalid, the system may attempt to generate a different type of link. *Id.* ¶ 39. If link generation fails to result in a valid link, the system may next attempt to modify permissions for the network storage location containing the media file. *Id.* As a last resort, after all other file share techniques have been tested and failed, the system will copy the media file to a new storage location. *Id.*

Independent claims 1 and 8 are illustrative:

1. An apparatus, comprising:

a processor; and

a memory communicatively coupled to the processor, the memory to store an application having a media share component operative to share a media file among a defined set of users, the media share component comprising a file manager module operative to determine a network storage location for the media file, and a file reference module operative to determine whether a current link permits access to the network storage location for the media file by the defined set of users, and if not, copy the media file from the network storage location to a different network storage location that permits access to the media file by the defined set of users, and generate a valid link to the different network storage location for the copied media file.

Appeal Br. 31 (Claims App).

8. A computer-implement [sic] method, comprising:
receiving a request to associate a media file with a document;
retrieving links to a network storage location for the media file;
testing the links to determine that each link is an invalid link
that does not permit access to the network storage location by a
document recipient;
generating a second link as a valid link that permits access to
the network storage location by the document recipient; and
associating the second link with the document.

Id. at 32.

Independent claim 15 recites a storage hardware medium having
limitations commensurate in scope with claim 1. *Id.* at 32–33. Dependent
claims 2–7, 9–14, and 16–20 each incorporate the limitations of their
respective independent claims. *Id.* at 31–35.

REFERENCES

Name	Reference	Date
Liebman	US 2006/0184673 A1	Aug. 17, 2006
Soelberg et al. (Soelberg)	US 2006/0259601 A1	Nov. 16, 2006
O’Neill et al. (O’Neill)	US 2008/0262920 A1	Oct. 23, 2008

REJECTIONS

Claims 1–3, 5–17, and 20 are rejected under pre-AIA 35 U.S.C.
§ 103(a) as being obvious over Soelberg in view of Liebman.

Claims 4, 18, and 19 are rejected under pre-AIA 35 U.S.C. § 103(a) as
being obvious over Soelberg, Liebman, and O’Neill.

OPINION

A. *Claims 1–3, 5–17, and 20*

1. *Claim 1*

With respect to claim 1, Appellant contends that the combination of Liebman and Soelberg does not teach or suggest the recited “determining a situation where the link prohibits access by the full list of authorized persons.” Appeal Br. 20. Appellant characterizes Liebman as creating links for users that always permit access to the network storage location for the media file. *Id.* at 21. Appellant further characterizes Liebman as protecting media files in a separate directory that cannot be directly accessed by any unpermitted user. *Id.* Appellant argues that Liebman, which the Examiner relies upon for teaching or suggesting the disputed limitation, does not teach a situation in which a link would prohibit access to the network storage location, and thus Liebman does not contemplate a step of determining that such a situation exists. *Id.* at 20–21.

The Examiner finds Liebman to teach determining a situation where the link prohibits access by the full list of authorized persons. Final Act. 6 (citing Liebman ¶ 27). The Examiner characterizes Liebman as creating a Shared Directory, moving media files from a User Directory to the Shared Directory, and creating a link in the User Directory to the file in the Shared Directory. Ans. 4. The Examiner further characterizes Liebman as “moving [the] files to a usable location and updating the link structure so that the user upon accessing the modified link accesses the now usable file.” *Id.* at 6. The Examiner further finds that prior to copying the file, direct access is not permitted. *Id.*

We are persuaded by Appellant's argument. The portions of Liebman cited by the Examiner describe a technique for virtualizing all shareable media files, moving the files to a Shared Directory, and replacing the original files with links that are indistinguishable from the original files. Liebman ¶ 27. The Examiner does not point to any teaching in Liebman of determining whether the links to the media files permit access. At best, the Examiner finds that prior to the replacement of files on the User Directory (corresponding to each independent user) with links, direct access to the media files on the Shared Directory would not be permitted. Ans. 6; Liebman ¶ 30. Even assuming the veracity of this finding, Liebman has not been shown to perform a determination of whether the link permits access to the network storage location for the media file. Rather, Liebman describes performing actions on all media files; i.e., moving all files and creating new links to all of the files. The Examiner's reasoning is that there is no access to files on the Shared Directory before those files have been created, because no links to files on the Shared Directory exist prior to creation of files on the Shared Directory. However, that does not show any teaching or suggestion that one should perform a determination of whether any particular link permits access to a particular file.

Accordingly, on the record before us, we are persuaded by Appellant's argument that the Examiner has not shown claim 1 to be obvious over the combination of Liebman and Soelberg. The same limitations appear in dependent claims 2, 3, and 5–7, and commensurate limitations appear in independent claim 15 and its dependent claims 16, 17, and 20. Appeal Br. 31, 33–35 (Claims App.). Consequently, we are persuaded that the Examiner has not shown claims 2, 3, 5–7, 15–17, and 20

to be obvious over the combination of Liebman and Soelberg. Accordingly, we reverse the rejection of claims 1–3, 5–7, 15–17, and 20.

2. *Claim 8*

With respect to claim 8, Appellant contends that the combination of Soelberg and Liebman do not teach the recited “testing the links to determine that each link is an invalid link that does not permit access to the network storage location by a document recipient.” Appeal Br. 23. Specifically, Appellant disagrees with the Examiner’s finding that Soelberg’s determination of whether a user is authenticated is “testing the links” as recited. *Id.* at 23–24.

The Examiner finds Soelberg to teach the disputed limitation, in that the user attempts to access the media content via a link, and if the user is not authenticated, the user is not provided the media content, but instead is provided a notification of steps to resolve the issue. Final Act. 7 (citing Soelberg ¶ 27). The Examiner states, “[c]hecking for authentication is a form of checking for validity — if the user is not authorized, the link is not valid for that user, and the user is not permitted access.” Ans. 7. Once the user is prompted, and updates their authorization, the user is permitted access. *Id.* The Examiner characterizes this action thusly: “[t]he link did not work, now it works; that is a modification in the broadest reasonable sense.” *Id.*

In determining whether the claim term “invalid link” may be a link that does not work due to a determination that the user is not authorized to access the file, we turn to the Specification. During prosecution, claim scope is determined “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am Acad. Sci. Tech. Ctr.*, 367 F.3d

1359, 1364 (Fed. Cir. 2004); *see also In re Translogic Tech., Inc.*, 504 F.3d 1249 (Fed. Cir. 2007). The Specification states, “[a]n invalid link does not allow a user to access a media file.” Spec. ¶ 38. As an example, the storage location of the media file may have “a set of permissions that prevent[s] some users from gaining access to the media file.” *Id.* Thus, the Specification describes an invalid link as including a link that does not work due to a failed user authorization. Consequently, we determine that the Examiner did not err in finding that Soelberg’s testing for a user’s authorization, when determining whether to provide a media file requested by a certain link, meets the claimed “testing the links to determine that each link is an invalid link that does not permit access to the network storage location by a document recipient.”

Appellant further argues that neither Soelberg nor Liebman teaches the use of a second link where it is determined that the links are invalid. *Id.* at 24. Appellant argues that once Soelberg determines that a user is authenticated, the original link can be used to access the media file. *Id.* Appellant further contends that although Liebman creates links, Liebman does not create a second link after determining that the first link does not permit access to the network storage location. *Id.*

The Examiner finds Liebman to generate a second link (to access the media files that are moved to the Shared Directory) that associates the link with the media file and permits access to the media file by the users. Ans. 7. The Examiner states that Liebman teaches that the second link is created where the original link prohibits access by the full list of authorized persons. *Id.* As discussed for claim 1, we do not agree with the Examiner that

Liebman, by itself, teaches or suggests creating a link based upon a determination that the original link does not permit access. *Supra* at 5.

To the extent that the rejection relies upon the combination of references to teach both testing the links (Soelberg) and generation of a second link (Liebman), Appellant's argument presumes that the claimed steps of testing links and of creating links are required to be performed in the order that they appear in the claim. However, our reviewing court has held that it is improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims does not impose a specific order on the performance of the method steps, and the specification does not directly or implicitly require a particular order. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371 (Fed. Cir. 2003). In claim 8, the step of "generating a second link" is not expressly limited, as a matter of grammar, to links that have been tested and found invalid. As a question of logic, the claim could reasonably be read as generating second links prior to the testing, because the term "second link" has antecedent basis in the "retrieving links" step, and does not require the "testing the links" step as a logical precursor. Such an interpretation would be consistent with the Specification, because the Specification sets forth generating a "valid" second link, which is then determined to not permit access to the file such that a further step (of modifying user permissions) is then undertaken. Spec. ¶¶ 41–43. Consequently, we are not persuaded that the claim requires the "testing" step to be performed prior to the "generating" step, and therefore we are not persuaded by Appellant's argument based upon that ordering.

Appellant next argues that the Examiner has not provided sufficient rationale for combining Soelberg and Liebman. Appeal Br. 25–29.

Appellant argues, “it is not sufficient to show that the references are like separate pieces of a simple jigsaw puzzle; an explicit reason or motivation must be established for those of ordinary skill in the art at the time of the invention to place these pieces together.” *Id.* at 29.

Under the principles set forth in 35 U.S.C. 103, as interpreted in *KSR Int’l Co. v. Teleflex Co.*, the obviousness analysis is a flexible approach. *KSR Int’l Co. v. Teleflex Co.*, 550 U.S. 398, 415 (2007). Indeed, in some instances, such as in recognition that familiar items may have obvious uses beyond their primary purpose, “a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420. Because the reason for combining references forms a critical part of the obviousness analysis, the reasoning for combining references should be made explicit in the rejection. *InTouch Techs., Inc. v. VGO Commun’s, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (citing *KSR*, 550 U.S. at 418).

Here, we understand the Examiner’s rationale to be based upon a suggestion or motivation to combine the references. Specifically, the Examiner’s rationale for combining Soelberg and Liebman is “for a predictable result of enhancing the sharing mechanism [of Soelberg] by addressing potential failure points and providing additional means to resolve them.” Final Act. 5. Providing such a suggestion or motivation to combine the teachings of the prior art is a guard against hindsight analysis. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). The reason for combining the teachings must rely on knowledge within the level of ordinary skill in the art at the time the claimed invention was made, and not include knowledge gleaned only from applicant’s disclosure. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Based on the record before us, the Examiner has not shown a reason to combine the references beyond that provided by Appellant's Specification. The Specification provides an "iterative file share approach to coalesce multiple different types of media sharing techniques in an innovative manner." Spec. ¶ 3. Appellant's iterative approach addresses a failure to provide a working link, and tries different solutions in turn to provide a working link. *See, e.g.*, Spec. ¶¶ 41–44. Appellant's described innovation is nearly identical to the Examiner's rationale; i.e., "addressing potential failure points and providing additional means to resolve them." Final Act. 7. The Examiner has not explained the source of the rationale, or provided any additional discussion on this point beyond the statement of the rationale itself. *See* Final Act. 7; Ans. 7–8. Further, the Examiner has not provided an independent source for the rationale such that we can determine that the rationale has not been gleaned solely from Applicant's disclosure. Nor does either Soelberg (directed to authentication) or Liebman (directed to providing a new, protected Shared Directory) independently discuss providing additional means to address potential failure points.

Consequently, we are persuaded that the Examiner has not provided a reason for combining the references beyond that gleaned from Appellant's disclosure. Accordingly, we reverse the Examiner's obviousness rejection of claim 8. Since dependent claims 9–14 contain the same limitation, and because the Examiner has not provided any further explanation of why the references would be combined to meet the claim limitations beyond that gleaned solely from the Specification, we are persuaded that the Examiner has not shown claims 9–14 to be obvious over the combination of Liebman and Soelberg. Accordingly, we reverse the rejection of claims 8–14.

B. Claims 4, 18, and 19

Appellant further argues that the rejections of claims 4, 18, and 19 are erroneous for the same reasons as argued against the rejection of claim 1, Appeal Br. 29. For the same reasons as discussed with respect to claim 1, we are persuaded of error in the obviousness rejection of claims 4, 18, and 19. Accordingly, we reverse the rejection of claims 4, 18, and 19.

CONCLUSION

For the above-described reasons, we reverse the Examiner's rejection of claims 1–20 as being obvious under 35 U.S.C. § 103(a).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
1–3, 5–17, 20	103(a)	Soelberg, Liebman		1–3, 5–17, 20
4, 18, 19	103(a)	Soelberg, Liebman, O'Neill		4, 18, 19
Overall Outcome				1–20

REVERSED