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THAI, TUAN V

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DECLAN PATRICK KELLY, WILHELMUS FRANCISCUS JOHANNES FONTIJN, and WILHELMUS JACOBUS VAN GESTEL

Appeal 2010-005501
Application 10/545,183
Technology Center 2100

Before JOSEPH F. RUGGIERO, DENISE M. POTHIER, and STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.[1]

Claims 1 and 3-11 stand rejected under 35 U.S.C. § 103(a) as obvious over Suzuki (US 6,601,139 B1; July 29, 2003) in view of Ashcraft (US 5,247,660; Sept. 21, 1993).

Claim 2 stands rejected under 35 U.S.C. § 103(a) as obvious over Suzuki in view of Ashcraft and further in view of Official Notice.

STATEMENT OF THE CASE

Appellants' invention reserves an area on a disc to store file system data and application start-up data. Spec. 5:14-15.

Independent claim 1 is illustrative with key disputed limitations emphasized and a footnote added:

> 1. A storage medium storing data organized in files complying with a file system usable under an operating system, [said data consisting of file system data and application data,][2] said application data being intended to be used by an application, part of

[1] Throughout this opinion, we refer to (1) the Appeal Brief filed July 17, 2009, and corrected September 24, 2009; (2) the Examiner's Answer mailed November 19, 2009; and (3) the Reply Brief filed January 19, 2010.

[2] Although the Answer states that the Claims Appendix recites the claims correctly, claims 1 and 7-10 in the Claims Appendix show limitations that were contained in a proposed Amendment filed with Appellants' April 17, 2009 Response to Final Office Action. *See, e.g.*, the limitation we have bracketed in the text. Because the May 5, 2009 Advisory Action did not enter the proposed Amendment, the correct version of the claims is contained in the Amendment filed November 26, 2008.

> said application data being needed for starting said application, said storage medium having *a reserved area being located in a single area of the storage medium* for storing data to be read and cached when the storage medium is declared to said operating system, said reserved area *consisting of* file system data descriptive of the file structure of the disc and part of said application data being needed for starting the application.

THE 35 U.S.C. § 112, FIRST PARAGRAPH, REJECTION

During prosecution, Appellants amended claim 1 to substitute the phrase "said reserved area consisting of" file system data for "said reserved area including at least said" file system data. *See* June 13, 2008 Amendment. The Examiner concludes that the phrase "consisting of" is new matter because the reserved area is flexible, storing the application startup data is optional, and there is no language in the Specification that defines the reserved area as having file system data and part of application data to the exclusion of all other data. Ans. 4.

Appellants contend that starting with the title of their application (storage medium with reserved area for file system data and application start-up data), their Specification "clearly states that file system and part of application data (if possible) is stored in the reserved area" and "does not make a single explicit reference or suggestion of storing 'other types of data' in the reserved area." App. Br. 13 (emphases omitted). Therefore, they contend, the Specification "provides the reader with a clear indication of what type of data is and is not intended to be stored in the reserved area." App. Br. 14:7-8.

We assume, without deciding, that the Specification may be construed broadly enough to include storage of data in the reserved area other than file

system data and part of application data. Nevertheless, we are not persuaded by the Examiner's reasoning that the "consisting of" language constituted new matter merely because it excludes parts of an apparatus disclosed in the Specification. Generally, an applicant may narrow the claims and not run afoul of the description requirement of Section 112 by omitting from the claim every feature of a disclosed apparatus. The Examiner has not developed an adequate rationale showing that Appellants were not in possession of what they now claim.

Accordingly, we conclude that the Examiner erred in rejecting claims 1-7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

THE OBVIOUSNESS REJECTIONS

We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claims 1 and 3-11

We concur with the conclusions reached by the Examiner. Ans. 4-8, 10-11. That is, we agree with the Examiner's findings with respect to the individual references, and with the Examiner's determination that it would have been obvious to combine the references based on the rationale set forth by the Examiner. Ans. 7, 11.

Appellants argue that when Suzuki's computer is started, the complete application program needs to be read from the disc in order to perform a useful task and thus most of the data on the disc is read to start the

application. App. Br. 17:17-19. The Examiner responds that Suzuki only loads parts of the application needed to run the program without loading the entire application. Ans. 10:14-16.

Appellants argue that Suzuki does not teach or suggest a reserved area consisting of file system data descriptive of the file structure of the disc and part of the application data being needed for starting the application. App. Br. 17-18. The Examiner responds that Suzuki manages ROM by using directories and other parameters which are written to the Volume Management Area. Ans. 11:5-7.

Appellants' Reply Brief does not persuasively dispute the Examiner's findings regarding Appellants' above two contentions. Instead, Appellants renew the arguments and positions in their Appeal Brief. Reply Br. 6-7. We agree with the Examiner's findings and conclusions and adopt them as our own.

Appellants also argue that it would not have been obvious to apply the teachings of Ashcraft to Suzuki because Suzuki's reserved sectors, file system data, and application startup data cannot be combined into one section and there is no suggestion in either reference of reading all of the data in both the RAM and ROM portions at start-up. App. Br. 18-19. The Examiner responds that in Suzuki all programs may be stored in ROM and the disc need not be divided between RAM and ROM in order for the invention to work. Ans. 11:12-14.

Again, Appellants' Reply Brief does not persuasively dispute the Examiner's findings. We agree with the Examiner's findings and conclusions and adopt them as our own.

We further find that the Examiner has articulated how the claimed features are met by the references' teachings with a rational underpinning to combine Suzuki and Ashcraft.

We are therefore not persuaded that the Examiner erred in rejecting (1) representative claim 1; (2) claims 7-10 for similar reasons; and (3) claims 3-6 and 11 not separately argued with particularity.

Accordingly, we will sustain the Examiner's rejection of claims 1 and 3-11.

Claim 2

Appellants present no arguments pertaining to the Examiner's obviousness rejection of claim 2. Ans. 8-9. Accordingly, we summarily sustain this rejection. *See* MPEP § 1205.02 (8th ed., Rev. 9, August 2012) ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

CONCLUSION

Under § 112, first paragraph, the Examiner erred in rejecting claims 1-7. Under § 103, the Examiner did not err in rejecting claims 1-11. Even though we have found the Examiner erred in rejecting claims 1-7 under 35 U.S.C. § 112, first paragraph, we have also found that the Examiner did not err in rejecting those same claims under 35 U.S.C. § 103. Accordingly, we have affirmed the rejections of all pending claims.

DECISION

The Examiner's decision rejecting claims 1-11 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

babc