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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAN FASHCHIK and EYAL GORDON

Appeal 2014-004143¹
Application 12/164,446²
Technology Center 3600

Before MURRIEL E. CRAWFORD, NINA L. MEDLOCK, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–25. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed November 15, 2013) and Reply Brief (“Reply Br.,” filed February 10, 2014), and the Examiner’s Answer (“Ans.,” mailed December 10, 2013), and Final Office Action (“Final Act.,” mailed June 18, 2013).

² Appellants identify international Business Machines Corporation as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates to methods, systems and computer program products for performing data protection operations, and more particularly, to a system and method for performing a data protection operation" (Spec. ¶ 1).

Claims 1 and 21, reproduced below, are illustrative of the subject matter on appeal:

1. A method for performing a data protection operation, the method comprising:

receiving at a controller a write instruction that is associated with a writable entity; wherein the write instruction comprises:

a writable entity identifier; and
data protection metadata indicative of a relevancy of at least one data protection operation to be applied in relation to the write instruction; and
participating in an execution of a relevant data protection operation, if such a relevant data protection operation exists.

21. A storage system comprising:

a memory unit that is adapted to store a write instruction that is associated with a writable entity; wherein the write instruction comprises:

a writable entity identifier; and
data protection metadata indicative of a relevancy of at least one data protection operation to be applied in relation to the write instruction; and
a controller, coupled to the memory unit, and adapted to participate in an execution of a relevant data protection operation, if such a relevant data protection operation exists.

REJECTIONS

Claims 1–10 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–25 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

Claims 1–25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ninose (US 2007/0073986 A1, pub. Mar. 29, 2007) and Boaz (US 2006/0288183 A1, pub. Dec. 21, 2006).

Claim 21 is rejected, alternatively, under 35 U.S.C. § 102(b) as anticipated by Ron White, HOW COMPUTERS WORK, Que Corporation (1999) (hereinafter “HCW”).

ANALYSIS

Non-Statutory Subject Matter

The Examiner maintains that claims 1–10 are properly rejected under 35 U.S.C. § 101 because the claims fail the machine-or-transformation test, i.e., the claims are neither tied to a particular machine nor transform the underlying subject matter to a different state or thing (Final Act. 2–3).

Before the mailing date of the Examiner’s Answer, the Supreme Court held in *Bilski v. Kappos*, 561 U.S. 593 (2010) that a patent claim’s failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. *Id.* at 604. Because the Examiner relies only on the machine-or-transformation test, the Examiner has failed to establish a prima facie case of patent-ineligibility. Therefore, we do not sustain the Examiner’s rejection of claims 1–10 under 35 U.S.C. § 101.

Indefiniteness

We agree with Appellants that the Examiner erred in rejecting claims 1–25 under 35 U.S.C. § 112, second paragraph (App. Br. 62–66).

The Examiner takes the position that the phrase “participating in an execution of a relevant data protection operation,” as recited in independent claim 1, and similarly recited in independent claims 11 and 21, is vague and indefinite because it is unclear whether the limitation refers “to the ‘controller participating’ or to the ‘write instruction participating’” (Final Act. 4). The Examiner also maintains that it is unclear whether the controller or another entity, e.g., the writable entity, is performing the receiving and determining steps recited in dependent claim 3 (*id.*).

As an initial matter, there is no requirement that an applicant explicitly recite “who or what” performs each step of a method claim. And the lack of such a recitation does not render a claim indefinite.

We also cannot agree with the Examiner that the phrase “first write instruction,” as recited in claim 3, is vague and indefinite because it is unclear whether the limitation refers to “the write instruction of claim 1, or to a newly introduced write instruction” (*id.*). Instead, we agree with Appellants that a person of ordinary skill in the art would understand from the claim language that the “first write instruction” recited in claim 3 is distinct from the write instruction recited in claim 1 (App. Br. 65–66).

In view of the foregoing, we do not sustain the Examiner’s rejection of claims 1–25 under 35 U.S.C. § 112, second paragraph.

Obviousness

In rejecting independent claims 1, 11, and 21 under 35 U.S.C. § 103(a), the Examiner cites Ninose as disclosing “a write instruction . . . compris[ing] a writable entity identifier,” as recited in claim 1, and similarly recited in claims 11 and 21 (Final Act. 5). More particularly, the Examiner cites paragraph 56 of Ninose as disclosing a write request (i.e., the claimed “write instruction”) comprising a write section number (i.e., the claimed “writable entity identifier”) (*id.*).

Appellants argue that the Examiner’s rejection cannot be sustained, *inter alia*, because Ninose’s write section number, which the Examiner equates to the claimed “writable entity identifier,” is a part of Ninose’s count information, copy information, or bitmap (“BM”) marker, not Ninose’s write requests, which the Examiner equates to the claimed “write instruction” (App. Br. 7–9 (citing Ninose ¶ 55 (“The count information 220 includes count values for the write number and the write section number, as shown in FIG. 6”), 68 (“As shown in FIG. 11, the copy information 20 . . . includes the . . . write section number”), 76 (“As shown in FIG. 12, the BM marker 30 . . . includes . . . write section number”))).

Appellants note that Ninose discloses that, in appropriate circumstances, i.e., where the write request is to be subject to remote copying, the controller may generate copy information or a BM marker that includes a write section number (*id.* at 9). But Appellants maintain that “these elements are never a part of write request 10, but rather generated only after receiving and processing the write request” (*id.*).

The Examiner offers no substantive response to Appellants’ argument in the Examiner’s Answer. Instead, the Examiner simply asserts “Examiner

disagrees. Ninose discloses receiving a write instruction (request) that comprises an identifier (write section number)” (Ans. 2).

Appellants, in our view, have raised a substantial and legitimate question regarding the Ninose disclosure, which ostensibly has gone ignored, or at least unanswered by the Examiner. In failing to address in any way the distinction that Appellants have drawn between Ninose and the subject matter recited in independent claims 1, 11, and 21, the Examiner has failed to establish a prima facie case of obviousness.

Therefore, we do not sustain the Examiner’s rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 2–10, 12–20, and 22–25, which depend from claims 1, 11, and 21, respectively.

Anticipation

In rejecting claim 21 under 35 U.S.C. § 102(b), the Examiner finds that HCW discloses, *inter alia*:

- b. a memory unit (RAM, p 9, 112, 117) that is adapted to store a write instruction that is associated with a writable entity (data contained in documents, spreadsheets, graphics, databases, or any type of file must also be stored in RAM, p 117); wherein the write instruction (program, p 44–63) comprises:
 - c. a writable entity identifier; and
 - d. data protection metadata indicative of a relevancy of at least one data protection operation to be applied in relation to the write instruction.

(Final Act. 10).

Appellants assert that the Examiner’s position, as set forth in the Final Office Action, lacks any citation to HCW with respect to the write instruction comprising a writable entity identifier and data protection

metadata (App. Br. 58). And Appellants argue that, to the extent that the Examiner intends to rely on pages 44–63 as disclosing the claim limitation, “the cited portions of HCW merely provide a high-level overview of late twentieth century software for the uninitiated, briefly introducing the historical impact of software on the emergence of personal computing, *id.* at 44–58, and some basic concepts such as operating systems. *Id.* at 59–63” (*id.* at 59–60).

The Examiner offers no substantive response to Appellants’ argument in the Examiner’s Answer. In fact, the Examiner does not identify the § 102(b) rejection of claim 21 among the grounds of rejection (Ans. 2), although there is no indication in the record that this rejection has been withdrawn.

It is unclear from the Final Action Office to what extent, if any, the Examiner relies on pages 44–63 of HCW as disclosing a write instruction comprising a writable entity identifier and data protection metadata, as recited in claim 21. And, to the extent the Examiner relies on this portion of HCW, the Examiner does not identify any specific disclosure of HCW, or explain in what way, HCW discloses “a write instruction . . . compris[ing] a writable entity identifier and data protection metadata,” as recited in claim 21.

The rejection does not comply with the minimal notice requirements of 35 U.S.C. § 132. *See Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (35 U.S.C. § 132 is violated “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection”). Therefore, we do not sustain the Examiner’s rejection of independent claim 21 under 35 U.S.C. § 102(b).

DECISION

The Examiner's rejection of claims 1–10 under 35 U.S.C. § 101 is reversed.

The Examiner's rejection of claims 1–25 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's rejection of claims 1–25 under 35 U.S.C. § 103(a) is reversed.

The Examiner's rejection of claim 21 under 35 U.S.C. § 102(b) is reversed.

REVERSED