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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YI ZHOU, LIANG CHEN, ROD D. WALTERMANN, and JOHN C. MESE[1]

Appeal 2014-005847
Application 12/750,361
Technology Center 2100

Before JOHN P. PINKERTON, JEFFREY A. STEPHENS, and JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm-in-part.

[1] Appellants identify Lenovo Singapore PTE LTD. as the real party in interest. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellants' invention is directed to "migrating an existing user operating system to a remote storage device" wherein inconsistent partition interdependencies resulting from the migration process are detected and fixed. Abstract.

Claim 1 is exemplary of the subject matter on appeal and is reproduced below with the disputed limitations emphasized in *italics*:

> 1. An apparatus comprising:
>
> one or more processors;
>
> a network interface configured to access over a network a remote storage device; and
>
> a hard disk having a multi-partition operating system therein;
>
> wherein, responsive to execution of computer readable program code accessible to the one or more processors, the one or more processors are configured to:
>
> access the multi-partition operating system stored on the hard disk;
>
> *copy the multi-partition operating system to the remote storage device;*
>
> *run one or more checks to ensure that multi-partition interdependencies of the multi-partition operating system are correctly updated subsequent to copying to the remote storage device*; and
>
> responsive to detection of a multi-partition interdependency error, update one or more of the multi-partition interdependencies of the copied multi-partition operating system.

The Examiner's Rejections

1. Claims 19 and 20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2.

2. Claims 1–6, 10–15, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchhorn (US 7,721,142 B2; May 18, 2010) and Stakutis et al. (US 2005/0278492 A1; Dec. 15, 2005) ("Stakutis"). Final Act. 3–6.

3. Claims 7–9 and 16–18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchhorn, Stakutis, and Springfield et al. (US 2008/0244096 A1; Oct. 2, 2008) ("Springfield"). Final Act. 6–7.

Issues on Appeal

1. Did the Examiner err in finding claims 19 and 20 are directed to non-statutory subject matter?

2. Did the Examiner err in finding the combination of Buchhorn and Stakutis teaches or suggests copying a multi-partition operating system to a remote storage device and running one or more checks "to ensure that multi-partition interdependencies of the multi-partition operating system are correctly updated subsequent to copying to the remote storage device," as recited in claim 1?

ANALYSIS[2]

Rejection under 35 U.S.C. § 101

Appellants contend the Examiner erred in rejecting claims 19 and 20 as being directed to non-statutory subject matter because Appellants have attempted to distinguish the claimed storage medium from a signal medium. App. Br. 9–10. Appellants assert they "are not attempting to claim a data signal or form of energy by use of the words 'storage medium.'" App. Br. 10. Additionally, Appellants assert the Board previously has interpreted a "storage medium" to be directed to statutory subject matter. App. Br. 9–10 (citing *Ex parte Hu*, No. 2010-000151 (BPAI Feb. 9, 2012) (non-precedential and nonbinding)).

The Examiner finds, as do we, Appellants provide separate examples for a "computer readable storage medium" and a "computer readable signal medium" in paragraphs 80 and 81 of the Specification, respectively. Ans. 2. However, the Specification merely describes a "computer readable storage medium may be, for example, *but not limited to*," certain media, and "specific examples (*a non-exhaustive list*) of the computer readable storage medium would include" certain other media. (Spec. ¶ 80) (emphases added). Additionally, the Specification mentions program code "may also be stored in a computer readable medium," but contrary to Appellants' assertions, does not limit the claimed computer readable storage medium to a non-transitory embodiment of a "computer readable medium." *See* Spec. ¶ 85.

[2] Throughout this Decision, we have considered the Appeal Brief filed November 18, 2013 ("App. Br."); the Reply Brief filed April 14, 2014 ("Reply Br."); the Examiner's Answer mailed on February 14, 2014 ("Ans."); and the Final Office Action ("Final Act.") mailed on June 17, 2013, from which this Appeal is taken.

Accordingly, Appellants' Specification does not limit the claimed "computer readable storage medium" to a non-transitory embodiment. Similarly, the Board in *Mewherter* did "not find any limitation on the form of the 'machine-readable storage medium' in Appellants' Specification." *Ex parte Mewherter*, 107 USPQ2d 1857, 1859 (PTAB 2013) (precedential). Absent such express limitation on the claimed "computer readable storage medium," the relevant body of extrinsic evidence compels a finding that "the ordinary and customary meaning of 'computer readable storage medium' to a person of ordinary skill in the art [is] broad enough to encompass both non-transitory and transitory media." *Id.* at 1860.

For the reasons discussed *supra*, we are not persuaded the Examiner erred in rejecting claims 19 and 20 as non-statutory.[3]

[3] We note, as the Board did in *Mewherter*, 107 USPQ2d at 1862, that Appellants may overcome this rejection by amending the claims in view of the guidance provided in U.S. Patent & Trademark Office, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) ("A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation 'non-transitory' to the claim."). *See also U.S. Patent & Trademark Office, Evaluating Subject Matter Eligibility Under 35 U.S.C. §101: August 2012 Update*, *pp.* 11–14, *available at http://www.uspto.gov/sites/default/files/patents/law/exam/101_training_aug2012.pdf* (noting that although the recitation "non-transitory" is a viable option for overcoming the presumption that those media encompass signals or carrier waves, merely indicating that such media are "physical" or tangible" will not overcome such presumption).

Rejections under 35 U.S.C. § 103

Appellants contend the Examiner erred in finding Buchhorn teaches or suggests copying a multi-partition operating system to a remote storage device and subsequently checking to ensure that multi-partition interdependencies of the multi-partition operating system are correctly updated. App. Br. 13–15. In particular, Appellants assert the cited portions of Buchhorn are directed to "a data verification process to be employed when copying data generally." App. Br. 13. Although Appellants concede Buchhorn discloses that an operating system may be included among the data copied, Appellants argue there is no teaching or suggestion that the operating system is a multi-partition operating system and that Buchhorn fails to teach partition interdependency checks on the copied data. App. Br. 13–14.

The Examiner finds Buchhorn teaches a verification process for copied data and determines, because Buchhorn cycles through files, directories, and partitions as part of this process, "the copied operating system is a multi-partition operating system." Ans. 3 (citing Buchhorn, col. 14, ll. 5–40). Additionally, the Examiner finds Figure 7 of Buchhorn (which depicts a flowchart of the verification process) teaches the detection of multi-partition interdependency errors as represented in the "Faults found?" decision block. Ans. 4.

We find Appellants' arguments persuasive of Examiner error. The Examiner has not persuasively explained or identified adequate teachings within the identified prior art to support, by a preponderance of evidence, the findings that Buchhorn teaches or suggests a multi-partition operating system, or that multi-partition interdependencies are checked and verified

for a multi-partition operating system. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (Examiner's burden of proving non-patentability is by a preponderance of the evidence); *see also In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (the Patent Office may not "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis" in making a rejection under 35 U.S.C. § 103).

For the reasons discussed *supra*, and on the record before us, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claim 1 and, for similar reasons, independent claims 10 and 19, which recite similar limitations. Additionally, we do not sustain the Examiner's rejections under 35 U.S.C. § 103(a) of dependent claims 2–9, 11–18, and 20.

DECISION

We affirm the Examiner's decision to reject claims 19 and 20 under 35 U.S.C. § 101.

We reverse the Examiner's decision to reject claims 1–20 under 35 U.S.C. § 103(a).

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. § 41.50(f).

AFFIRMED-IN-PART