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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANAND LAKSHMINATH, BENNY SOUDER, JAMES W.
STAMOS, LIK WONG, and HUNG TRAN

Appeal 2014-008566
Application 11/099,203¹
Technology Center 2100

Before ELENI MANTIS MERCADER, JOHN P. PINKERTON, and
SCOTT E. BAIN, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–3, 5–14, 16, 17, 35, 41–56, and 59–62, which constitute all claims pending in the application. Claims 4, 15, 18–34, 57, and 58 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify Oracle International Corporation as the real party in interest. App. Br. 1.

STATEMENT OF THE CASE

The claimed invention relates to the field of data storage, and specifically a “versioned tablespace repository.” Abstract. In accordance with the claimed invention, electronic items are managed and mapped through the use of metadata identifying various file groups, file group versions, and items that belong to file group versions. *Id.*; Spec. ¶ 19. Claims 1 and 41 are independent. Claim 1 is illustrative of the invention and the subject matter of the appeal, and reads as follows:

1. A machine-implemented method for managing electronic items, the method comprising:

storing, within a repository, metadata that identifies

(a) a plurality of file groups that includes a particular file group;

(b) for each file group of the plurality of file groups, a set of one or more file group versions for said each file group; and

(c) for each file group version of each file group of the plurality of file groups, a set of one or more items that belong to said each file group version, wherein each item in the set of one or more items is identified by a corresponding item identifier;

storing, within the repository, a first mapping that maps the particular file group to a plurality of file group versions;

wherein the plurality of file group versions is the set of one or more file group versions that is identified by the metadata for the particular file group;

wherein the plurality of file group versions includes a first file group version;

storing, within the repository, a second mapping that maps the first file group version to a first set of items that belong to the first file group version, and that maps a second file group version to a second set of items that belong to the second file group version,

wherein the second file group version was created after the first file group version, and

wherein the second set of items includes at least one item that is different from each item in the first set of items;

wherein the second mapping maps the first file group version to a particular item that is identified, within the metadata, by a particular item identifier;

wherein the second mapping maps the second file group version to the particular item that is identified, within the metadata, by the particular item identifier;

after the storing of the metadata and the first and second mappings, receiving a request that requires identification of all items that belong to the first file group version;

in response to the request, determining all items that belong to the first file group version based on the second mapping that is stored within the repository;

wherein the method is performed by one or more computing devices.

App. Br. 26–27 (Claims App’x) (emphasis added).

REFERENCES

The Examiner relies upon the following prior art:

Bridge, Jr. et al.	US 5,890,167	Mar. 30, 1999
Vos et al.	US 2002/0087587 A1	July 4, 2002
Scott et al.	US 2003/0115223 A1	June 19, 2003
Farrell	US 2005/0192955 A1	Sept. 1, 2005

THE REJECTIONS ON APPEAL

Claims 1–3, 5–14, 16, 17, 35, 41–56, and 59–62 stand rejected under pre-AIA 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Final Act. 8–12.

Claims 1–3, 5–14, 16, 17, 35, 41–56, and 59–62 stand rejected under pre-AIA 35 U.S.C. § 112, second paragraph as being indefinite for failing to

Appeal 2014-008566
Application 11/099,203

particularly point out and distinctly claim the subject matter which the applicant regards as the invention. *Id.* at 12–16.

Claims 1–3, 10, 35, 37, 41–43, 49, 56, 57, and 59–62 stand rejected under pre-AIA 35 U.S.C. § 102(b) as anticipated by Scott et al. (“Scott”). *Id.* at 16–31.

Claims 5–9, 14, 44–48, and 53 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Scott and Bridge et al. (“Bridge”). *Id.* at 31–35.

Claims 11–13 and 49–51 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Scott and Farrell. *Id.* at 35–38.

Claims 16–17 and 54–55 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Scott and Vos et al. (“Vos”). *Id.* at 39–41.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments presented in this appeal. Arguments which Appellants could have made but did not make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). On the record before us, we are not persuaded the Examiner erred. We adopt as our own the findings and reasons set forth in the rejections from which the appeal is taken and in the Examiner’s Answer, and provide the following for highlighting and emphasis.

Appellants’ Proposed Claim Amendments

Appellants ask us to “reverse” the Examiner’s refusal to enter Appellants’ proposed claim amendments, which Appellants “submitted in

Appeal 2014-008566
Application 11/099,203

the Response to the Final Action.” App. Br. 6–7; Reply Br. 3–4; Response to Final Action (Oct. 24, 2013). Appellants argue the Examiner invited the amendments in an interview conducted after the Final Action, and that the amendments are “clarifying” and would have “no effect on the patentability or scope of the claims.” *Id.*

An Examiner’s refusal to enter amendments, however, is reviewable only by petition to the Director, not appeal to the Board. *See* 37 C.F.R. §§ 1.113, 1.181; *Ex parte Searles, Jr.*, 422 F.2d 431, 435 (CCPA 1970) (“an examiner’s refusal to allow entry of an amendment to the claims . . . is reviewable only by petition”). Accordingly, the proposed amendments are not before us, and we do not address them. Appellants’ remaining arguments relate to the existing claims, not the amendments, and we address those arguments in turn, below.

35 U.S.C. § 112, Second Paragraph Rejection

Appellants argue the Examiner erred in finding independent claims 1 and 41 (as well as the claims depending therefrom) indefinite. App. Br. 19–22. For the following reasons, we are not persuaded.

As the Examiner finds, the terms “file group,” “particular file group,” and “file group versions,” appear repeatedly throughout independent claims 1 and 41. Ans. 23–24; App. Br. 26–27, 31–32. The Examiner finds, and we agree, it is unclear whether the various recitations of “file group versions” refer to the previously-recited “file groups” or the previously-recited “*particular* file groups” (or neither). Ans. 23–24 (emphasis added). Moreover, the Examiner finds, and we agree, “a ‘file group’ may or may not

be related to the ‘*particular*’ file group. . . . [I]t [could] cover both scenarios.”
Ans. 23 (emphasis added).

Where, as here, a claim is “amenable to two or more plausible claim constructions, the [Examiner] is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211–12 (BPAI 2008) (precedential); *see also In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (it “is the [A]pplicants’ burden to precisely define the invention, not the PTO’s”). Accordingly, we sustain the Examiner’s rejection of independent claims 1 and 41 under pre-AIA 35 U.S.C. § 112, second paragraph as indefinite. We also sustain the same rejection of dependent claims 2, 3, 5–14, 16, 17, 35, 42–56, and 59–62, which include the limitations of their independent claims 1 or 41.

35 U.S.C. § 112, First Paragraph Rejection

Appellants argue the Examiner erred in finding the Specification does not adequately describe multiple elements appearing in independent claims 1 and 41.² App. Br. 7–19. For the following reasons, we are not persuaded.

The Examiner finds the claim 1 limitation

storing, within the repository, a second mapping that maps the first file group version to a first set of items that belong to the first file group version, and that maps a second file group version to a second set of items that belong to the second file group version

² Some of the elements found to be lacking support in the Specification also were found to be indefinite. Thus, there is some overlap in the analyses of the written description and indefiniteness rejections.

lacks support in the Specification. Ans. 7–9. Appellants contend this limitation is supported by paragraph 22 of the Specification. App. Br. 11. As the Examiner finds, however, paragraph 22 describes a relationship in which each “mapping” matches a file group to item identifiers. Ans. 8–9. For example, a mapping maps file group version 214 to item identifier 232. *Id.* (citing Spec. ¶ 22, Fig. 2). Another mapping maps file group version 216 to item identifiers 232 and 234. *Id.* There is no (single) second mapping that maps multiple file group versions to sets of items, as Appellant argues. *Id.* Accordingly, we discern no error in the Examiner’s finding.

The Examiner further finds the claim 1 limitation “in response to the request, determining all items that belong to the first file group version based on the second mapping that is stored within the repository” lacks support in the Specification. Ans. 9. Appellants argue this limitation is supported by paragraphs 17, 44, and 45 of the Specification. App. Br. 13. Specifically, Appellants argue, paragraph 44 refers to “query contents of any given tablespace version” and paragraph 45 states “[o]nce the appropriate metadata has been created within file group repository 100, the versioned tablespace repository is able to query the file group repository 100 to determine which files belong to a particular version of a particular tablespace.” *Id.* (emphasis omitted). Appellants further assert paragraph 17 states “[t]he file-group-version-to-item mapping 110 maps each file group version to the items that belong to the file group version.” App. Br. 13–14. Appellants contend the sum of the foregoing disclosures supports the disputed limitation. We disagree.

As the Examiner finds, Appellants' argument relies on disparate parts of the disclosure that do not coherently fit together. Ans. 11. It is not enough that claim language appears in the Specification. *See Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002). Rather, the “test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed.” *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004). Although paragraph 17 mentions “mapping,” neither that paragraph nor paragraphs 44 and 45 connect such mapping to the claimed “request” and particular “file group version” recited in the claim. Ans. 11.

For the foregoing reasons, we sustain the Examiner's rejection of claims 1 and 41 under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement. We also sustain the same rejection of dependent claims 2, 3, 5–14, 16, 17, 35, 42–56, and 59–62, which include the limitations of independent claims 1 or 41.

Prior Art Rejections

Appellants argue the Examiner erred in finding Scott anticipates independent claims 1 and 41 because, Appellants contend, Scott “fails to disclose mapping the same ‘particular item’ from different branches.” App. Br. 23.³ As the Examiner observes, Ans. 25, Appellants' argument does not cite the particular claim limitation at issue; however, we understand Appellants as referring to the limitation “wherein the second mapping maps the first file group version to a particular item . . . [and] maps the second file

³ Appellants group the independent claims together for purposes of the argument, and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(4).

group version to the particular item that is identified.” App. Br. 27 (Claims Appd’x).⁴ We are not persuaded by Appellants’ argument.

The Examiner finds the disputed limitation disclosed in Figures 3 and 4 of Scott, and the accompanying description thereof. Final Act. 18–19; Ans. 26–27. Figure 3 is reproduced below.

Fig.3.

	201	202	203	204	205	206
	Branch	Object Identity	Version Sequence	Object Data	Predecessor	...
210	X	A	5	ΔXA1 ΔXA2 ΔXA3 ΔXA4 XA5
211	X
212	Y	A	3	ΔYA1 ΔYA2 YA3	XA2	...
213	Y	B	1	YB1
214	Y	C	4	ΔYC1 ΔYC2 ΔYC3 YC4
215	Y
216	Z	A	3	ΔZA1 ΔZA2 ZA3	XA3	...
217	Z

Figure 3 depicts an object branches table 200 arranged as columns and rows. The object branches table 200 includes branch column 201, object identity column 202, version sequence column 203, object data column 204, and predecessor column 205. Scott ¶ 49.

Scott Figure 4 is reproduced below.

⁴ To the extent Appellants intended to argue a different claim limitation, we note that it is Appellants’ obligation to explain the limitations at issue and the bases for their argument, and failure to do so results in waiver of the argument(s). See 37 C.F.R. § 41.37(c)(4); see also *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”).

Fig. 4.

	301	302	303	304	305
	Branch	Object Identity	Version	Working	...
310	X	A	1		...
311	X	A	2		...
312	X	A	3		...
313	X	A	4		...
314	X	A	5		...
315	X
316	Y	A	1		...
317	Y	A	2		...
318	Y	A	3		...
319	Y	B	1		...
320	Y	C	1		...
321	Y	C	2		...
322	Y	C	3		...
323	Y	C	4		...
324	Y
325	Z	A	1		...
326	Z	A	2		...
327	Z	A	3		...
328	Z

Figure 4 depicts object versions table 300 (corresponding to object branches table 200 depicted in Figure 3), and includes branch column 301, object identity column 302, version column 303, and working column 304. Scott ¶¶ 71-73. The foregoing branch, object identity, and version columns of Figure 4 correspond to the object data column 204 of Figure 3. *Id.* at ¶ 74. So, for example, row 210 in the object branches table 200 (of Figure 3) is represented by five corresponding rows in the object versions table 300 (of Figure 4), namely, rows 310 to 314. *Id.* at ¶ 75.

Appellants argue the figures in Scott do not disclose the disputed limitation because, in Figure 4, “no two records in object versions table 300 will ever point to the same object from different branches.” App. Br. 23. As

the Examiner finds, however, Figure 4 contradicts Appellants' assertion. Ans. 25–26. Figure 4 illustrates branch X pointing to object identity A (in row 310, for example), and branch Y also pointing to object identity A (in row 316, for example). *Id.* (citing Scott ¶¶ 71–73). Moreover, as the Examiner further finds, Figure 3 illustrates branch X pointing to object data corresponding to object identity A (row 210) and branch Y also pointing to object data corresponding to object identity A (row 212). Ans. 26. The Examiner further finds, and we agree, Scott paragraphs 82 to 84 disclose “copying objects from the *same or other branch groups.*” *Id.* (emphasis added). Thus, we discern no error in the Examiner's findings.

Appellants also argue dependent claims 61 and 62 separately from their independent claims (1 and 41, respectively). App. Br. 23–24. Claims 61 and 62 recite “each file group version of each file group of the plurality of file groups corresponds to a *snapshot* of the *tablespace* associated with said each file group.” *Id.* at 23 (emphasis added). Appellants assert Scott “fails to [disclose] that the file groups correspond to tablespaces, and that the file group versions correspond to snapshots.” *Id.* at 24.

As the Examiner finds, however, Scott's discussion of versioning discloses the recited “snapshot” of the claims. Ans. 28 (citing Scott ¶¶ 4, 41). Scott discloses “[v]ersioning produces a new copy of an object each time it is modified and saved.” *Id.* (citing Scott ¶ 4). Such copies correspond to the “tablespace” illustrated in Figures 3 and 4. Ans. 27 (citing Scott ¶¶ 49, 71–74). Accordingly, we are not persuaded of error.

For the foregoing reasons, we sustain the rejection of claims 1–3, 10, 35, 37, 41–43, 49, 56, 57, and 59–62 under 35 U.S.C. § 102(b). Appellants argue the obviousness rejections should be reversed for the same reasons as

Appeal 2014-008566
Application 11/099,203

the anticipation rejection. App. Br. 24–25. Accordingly, for the foregoing reasons, we also sustain the obviousness rejections.

DECISION

We AFFIRM the Examiner’s rejections of claims 1–3, 5–14, 16, 17, 35, 41–56, and 59–62.

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. § 41.50(f).

AFFIRMED