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Barnes & Thornburg LLP (IN) 11 S. Meridian Street Indianapolis, IN 46204			BARTELS, CHRISTOPHER A.	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MAREK PIEKARSKI

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Appeal 2015-004466  
Application 12/328,381  
Technology Center 2100

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Before LARRY J. HUME, NATHAN A. ENGELS, and JOYCE CRAIG,  
*Administrative Patent Judges.*

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 3–29, and 31–56. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

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<sup>1</sup> According to Appellant, the real party in interest is Micron Technology, Inc. App. Br. 2.

## INVENTION

Appellant's disclosed and claimed inventions relate to a method and apparatus for providing data access. Abstract. Claims 1 and 26 are illustrative and read as follows:

1. A method of providing direct access to first data stored at a first device to a second device, the first device storing the first data in a memory of the first device directly accessible to said second device, the method comprising:

at a control element external to each of said first and second devices, modifying the stored first data in said memory directly accessible to said second device; and

by said second device and without the control element, directly accessing the modified stored first data in said memory directly accessible to said second device.

26. An apparatus for providing access to first data stored at a first device to a second device, the first device storing the first data in a memory of the first device directly accessible to said second device, the apparatus comprising a control element external to each of said first and second devices, the control element further comprising:

means for accessing the stored first data in said memory directly accessible to said second device before said first data is directly accessed by said second device, wherein said second device directly accesses said first data without the control element.

## REJECTION

Claims 1, 3–29, and 31–56 stand rejected under 35 U.S.C. § 102(a) as anticipated by Thompson (US 7403542 B1; issued July 22, 2008).

## ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments that the Examiner has erred. Regarding the rejection of claims 1, 3–25, 27–29, and 31–56 under 35 U.S.C. § 102(a), we are persuaded by Appellant’s contentions that the Examiner erred. With respect to the rejection of claim 26 under 35 U.S.C. § 102(a), however, we reach the opposite result.

### *Claims 1, 3–25, 27–29, and 31–54*

We agree with Appellant that the Examiner erred in finding Thompson anticipates claim 1. As Appellant points out, the Examiner’s rejection fails sufficiently to identify elements of Thompson that correspond to each and every element as set forth in the claims. App. Br. 4. We note that the Examiner’s rejection omits explicit analysis of the limitation “modifying the stored first data in said memory directly accessible to said second device,” recited in claim 1. *See* Final Act 2–4; Ans. 3–5. The Examiner, however, identified Thompson’s IP Verifier 302A and OUTBOUND IP/MAC Processor 308, collectively, as the “control element” recited in claim 1. Ans. 4 (citing Thompson col. 12:59–67). The Examiner also found that a “modification performed by ‘OIP 308’ . . . satisfies the claim language because the control element ‘IPV 302A’ does not modify said data.” Ans. 4–5 (citing Thompson col. 11:48–51). The Examiner further explained that Thompson “shows modification by the first device” because “the IOCB entry is returned to host 104 to be reused, even though the requested operation may not be completed.” Final Act. 17; Ans. 18 (citing Thompson cols. 11:25–29, 17:50–55).

We agree with Appellant that the Examiner has not provided sufficient explanation or reasoning why the cited portions of Thompson in columns 11 and 17 disclose “at a control element external to each of said first and second devices, modifying the stored first data in said memory directly accessible to said second device,” as claim 1 requires. *See* Ans. 18. The Examiner has not explained with sufficient clarity how the cited portions of Thompson relate to each other or to the recited claim terms. *See* Ans. 3–5, 18. Nor has the Examiner sufficiently explained how returning an IOCB entry to host 104 to be reused, even though the requested operation may not be completed, would be considered by one of ordinary skill in the art as disclosing the disputed limitation in light of the Examiner’s other findings. *See id.* at 3–5, 18.

Independent claim 29 recites in relevant part:

at a control element external to each of said first and second devices:

modifying said data in said memory directly accessible to said second device before said data is processed by said first device, wherein said first device processes said data without the control element.

App. Br. 13. For the same reasons discussed above for claim 1, we agree with Appellant that the Examiner erred in finding Thompson discloses the disputed “modifying” step of claim 29. Moreover, the Examiner rejected claim 29 “under the same reasoning set forth in the rejection of claims 1,” but clarified that “the first device is now mapped to ‘disk 103’ (See Fig. 2) and the second device is now mapped to ‘host memory 104.’” Ans. 13–14. In the rejection of claim 1, the Examiner points to Thompson’s host memory 104 as the recited “first device” and Thompson’s SERDES as the recited “second device.” The Examiner has not explained with sufficient clarity

how the portions of Thompson the Examiner cited in rejecting claim 29 relate to each other or to the recited claim terms. See Ans. 3–5, 14.

Accordingly, on the record before us, we do not sustain the 35 U.S.C. § 102(a) rejection of independent claims 1 and 29, or of claims 3–11, 13–25, 27,<sup>2</sup> 28, and 31–54, dependent thereon. As our findings herein are dispositive, we do not reach other arguments that Appellant makes in support of the patentability of claims 1 and 29.

*Claims 55 and 56*

Independent claims 55 and 56 recite in relevant part:

at a virtualization proxy controller external to each of said first and second devices:

modifying the stored first data in said memory directly accessible to said second device before said first data is directly accessed in said memory directly accessible to said second device by said second device, wherein said second device directly accesses said first data without the virtualization proxy controller.

App. Br. 17. In rejecting claim 55, the Examiner found Thompson discloses the recited “virtualization proxy controller,” and that the cited virtualization proxy controller in Thompson “inserts source MAC address in transmitted frame 303B.” Ans. 16–17 (citing Thompson cols. 12:13–25, 13:26–30).

The Examiner also relied, without further explanation, on the analysis set forth for claim 1. Final Act. 15–16; Ans. 16. The Examiner’s findings are insufficient to demonstrate that Thompson discloses each and every element

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<sup>2</sup> We leave it to the Examiner to determine whether hybrid “computer program” claim 27, which depends from method claim 1, is invalid under 35 U.S.C. § 112, paragraph 4, because it fails to specify a further limitation of the subject matter of claim 1. See *Pfizer, Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284, 1292 (Fed. Cir. 2006).

of claim 55 because the Examiner has not explained with sufficient clarity how the cited portions of Thompson relate to each other or to the recited claim terms. *See* Ans. 3–5, 16–17.

In rejecting claim 56, the Examiner refers to Thompson’s disk 103 as the recited “second device,” but also rejects claim 56 “under the same reasoning set forth in the rejection of claims 1 recited above.” Ans. 17. In the reasoning for claim 1, however, the Examiner relied on SERDES, not disk 103, as the second device. Ans. 3–4. The Examiner’s findings are insufficient to demonstrate that Thompson discloses each and every element of claim 56 because the Examiner has not explained with sufficient clarity how the portions of Thompson the Examiner cited in rejecting claim 56 relate to each other or to the recited claim terms. *See* Ans. 3–5, 17.

Accordingly, we do not sustain the 35 U.S.C. § 102(a) rejection of claims 55 and 56.

*Claim 26*

Unlike claims 1, 29, 55, and 56, claim 26 does not require the modification of data or access to modified data. App. Br. 12. The Examiner rejected claim 26 under the same reasoning set forth in the rejection of claim 1, for which the Examiner provided new mappings to Thompson in the Answer. Ans. 3–5, 14; *see also* Reply Br. 2–6. In the Reply Brief, Appellant rebuts the Examiner’s new findings with regard to the “modifying” limitation recited in claim 1, but presents no persuasive arguments particular to the limitations recited in claim 26. *See* Reply Br. 2–6.

Accordingly, we sustain the 35 U.S.C. § 102(a) rejection of claim 26.<sup>3</sup>

#### DECISION

We reverse the decision of the Examiner rejecting claims 1, 3–25, 27–29, and 31–56.

We affirm the decision of the Examiner rejecting claim 26.

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)(iv).

#### AFFIRMED-IN-PART

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<sup>3</sup> In the event of further prosecution, including any review for allowance, we leave it to the Examiner to determine whether claim 26, a single means claim, is invalid for undue breadth under 35 U.S.C. § 112, first paragraph. *See In re Hyatt*, 708 F.2d 712, 714–715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor).