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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID TZE-SI WU, STEVEN McCANNE,
MICHAEL J. DEMMER, and NITIN GUPTA

Appeal 2016-008319
Application 12/730,185
Technology Center 2100

Before ERIC S. FRAHM, TERRENCE W. McMILLIN, and
JOYCE CRAIG, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 10, 11, and 17–21. Claims 3–9, 12–16, and 22–28 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Accordingly to Appellants, Riverbed Technology, Inc. is the real party in interest. App. Br. 1.

Exemplary Claim on Appeal

Independent claim 1 is exemplary, and reads as follows (with the disputed portion of the claim emphasized and bracketed lettering added):

1. A method of optimizing a block storage protocol read access to a block storage device via a wide area network, the method comprising:

selecting a first file system entity from a set of file system entities, wherein the first file system entity is associated with a first storage block that was previously requested, and wherein the first file system entity is a file, a directory, or a file system node;

[A] *analyzing the first file system entity to identify a file, a directory, or a file system node that is referenced in the first file system entity and that is likely to be associated with at least one future request*;

identifying at least a second storage block corresponding to the identified file, directory, or file system node;

retrieving the second storage block from a data storage connected with the wide area network at a first network location;

communicating via the wide area network the second storage block from the data storage to a storage block cache at a second network location; and

storing the second storage block in the storage block cache.

Examiner's Rejections

(1) The Examiner rejected claims 1, 2, 10, 11, and 17–21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention, namely the clause “that is likely to be associated with at least one future request” recited in each of independent claims 1, 10, and 17. Final Act. 2–3. This rejection has been withdrawn by the Examiner (Ans. 2), and is therefore not before us on appeal.

Accordingly, we do not address Appellants' arguments (App. Br. 12–13) in this regard herein.

(2) The Examiner rejected claims 1, 2, 10, 11, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Enko (US 2005/0102290 A1; May 12, 2005) and Idei (US 2004/0117398 A1; published Jun. 17, 2004).² Final Act. 3–14; Ans. 3–5.

(2) The Examiner rejected claims 19–21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Enko, Idei, and Vermeulen (US 2008/0313318 A1; published Dec. 18, 2008). Final Act. 14–16.

² Separate patentability is not argued for claims 1, 2, 10, 11, 17, and 18, and Appellants rely upon the arguments presented as to the “independent claims” (*see* App. Br. 18, 19), i.e. claims 1, 10, and 17, for the patentability of (i) claims 2, 11, and 18 rejected as being obvious over Enko and Idei (*see* App. Br. 13–19); and (ii) claims 19–21 as being obvious over Enko, Idei, and Vermeulen (*see* App. Br. 15–18). Independent claims 1, 10, and 17 each recited “analyzing [an] . . . entity to identify” a file, directory, or file system (claim 1), database table or database system node (claim 10), or a file, directory, file system node, database table, or database system node (claim 17) “that is referenced in the . . . entity and *that is likely to be associated with at least one future request*” (claims 1, 10, 17 (emphasis added)). We select claim 1 as representative of claims 1, 2, 10, 11, 17, and 18. Because Appellants rely on similar arguments as presented for the independent claims for the patentability of dependent claims 19–21, we decide the appeal of claims 19–21 on the same basis as we decide the appeal of claim 17 from which claims 19–21 each depend.

Appellants' Contentions

Appellants primarily contend (App. Br. 15) that the Examiner erred in rejecting the independent claims under 35 U.S.C. § 103(a) because the base combination of Enko and Idei, and specifically Enko's Figure 2 and/or paragraphs 46 through 48, "do[es] not disclose the 'analyzing...' feature in the independent claims" (i.e., limitation [A] recited in representative claim 1).³

Issue on Appeal

Based on Appellants' arguments in the Briefs (App. Br. 13–20; Reply Br. 4–9), the following principal issue is presented on appeal:

Did the Examiner err in rejecting claims 1, 2, 10, 11, and 17–21 as being obvious because Enko, and thus the combination of Enko and Idei, fails to teach or suggest limitation [A] recited in representative claim 1?

ANALYSIS

We have reviewed the Examiner's rejections (Final Rej. 3–16) in light of Appellants' arguments (App. Br. 13–19; Reply Br. 4–9) that the Examiner has erred.

³ Notably, Appellants' arguments in the briefs are focused on the language of independent claim 1 (which recites operating on "a first file system entity"), are not commensurate in scope with the language of independent claims 10 and 17 (which recite operating on "a first database entity" (claim 10) and operating on "a first high level data structure entity" (claim 17)). In addition, "the first file system entity" recited in claim 10 lacks antecedent basis and also fails to further limit the "first database entity" (claim 10). For these additional reasons, we select claim 1 as the representative claim.

Although Appellants' Specification describes prefetching (as recited in claim 1) as including at least two specific types of prefetching (Spec. ¶ 40, describing "reactive prefetching" and "policy-based prefetching"), claim 1's recitation of identifying information "that is likely to be associated with at least one future request" encompasses Enko's rule based prefetching technique shown in Figures 1, 2, and 4 and described in paragraphs 45–48, 53–56, and 69. We agree with the Examiner (Final Act. 4–7; Ans. 3–5) that Enko's disclosure of a prefetching process using prefetch rule table 112 shown in Figure 4, under the broadest reasonable interpretation of Appellants' claim 1 in light of the Specification, meets analyzing limitation (limitation [A]) recited in claim 1 on appeal.

Our review of Appellants' disclosed invention reveals that Appellants disclose and claim *prefetching* generally (*see* Fig. 2A, step 230; Fig. 2B, step 265; ¶¶ 48, 52, 53, 60, 61, 63; *see also* App. Br. 6, 7, 9 citing Figure 2B and ¶¶ 61–64 as supporting the subject matter recited in limitation [A] of claim 1). Appellants' Specification describes (i) Figures 2A and 2B as generally showing *prefetching* methods (Spec. ¶ 43); (ii) Figure 2A as showing a method 200 of performing *reactive* prefetching (Spec. ¶ 43); and (iii) Figure 2B as showing a method 255 of performing *policy-based* prefetching (Spec. ¶ 60). Appellants' claim 1 does not limit the analyzing and identifying a file system entity "that is likely to be associated with at least one future request" (claim 1, i.e., prefetching) to *reactive* prefetching and/or *policy-based* prefetching. Instead, Appellants' process "employ[s] a number of different techniques to predict which additional storage blocks are likely to be requested" (Spec. ¶ 40). And, claim 1 does not even recite "prefetching."

Appellants' arguments (App. Br. 15–18) that Enko's prefetching using prefetch rule table 112 (*see* Enko, Fig. 4) does not “predict” that another file is likely to be requested in the future are not persuasive, inasmuch as claim 1 merely recites identifying “*that is likely to be associated with at least one future request*” (claim 1 (emphasis added)). *See In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“[The] proffered facts ... are not commensurate with the claim scope and are therefore unpersuasive.”). While the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005). In the instant case on appeal, while Appellants' Specification may limit claim 1 to *prefetching* to identify files likely to be associated with a future request (*see* Figs. 2A, step 230, Fig. 2B, step 265; ¶¶ 43, 48, 52, 53 and 43, 60, 61, 63), the method steps of analyzing and identifying a file system entity “that is likely to be associated with at least one future request” (claim 1, i.e., prefetching) are not limited to *reactive* prefetching and/or *policy-based* prefetching as described in Appellants' Specification (Spec. ¶ 40). Appellants' disclosed reactive prefetching and policy-based prefetching, and Enko's disclosed rule based prefetching, are all types of prefetching (analyzing and identifying a file system entity likely to be associated with a future request as recited in claim 1), any of which are encompassed by the process broadly set forth in claim 1 (which does not even use the term “prefetching”).

Any new arguments in the Reply Brief not presented in the Appeal Brief will not be considered absent a showing of good why the arguments could not have been presented in the Appeal Brief. *See Ex parte Borden*, 93

USPQ2d 1473, 1477 (BPAI 2010) (informative); *see, e.g., Advanced Magnetic Closures, Inc. v. Rome Fastener Corp.*, 607 F.3d 817, 833 (Fed. Cir. 2010)) (stating that arguments made for the first time in a reply brief are waived); *see also Optivus Tech., Inc. v. Ion Beam Appl'ns. S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (“[A]n issue not raised by an appellant in its opening brief . . . is waived.”) (citation omitted). For the first time in the Reply Brief, Appellants argue (Reply Br. 5–6) that Enko’s meta-data is a block, and not a file system entity (e.g., a file, directory, or file system node) as claimed (*see e.g.*, claim 1), thus searching a block is based on a file name as taught by Enko is not the same as identifying a file in a file system entity “that is likely to be associated with at least one future request” as claimed. We consider such arguments to be untimely and not necessitated by any new findings or determinations in the Answer.

In view of all of the foregoing, Appellants have not sufficiently shown the Examiner erred in rejecting claim 1 for obviousness, and Appellants’ contentions that Enko fails to disclose, teach, or suggest limitation [A] are not persuasive. Accordingly, we sustain the Examiner’s obviousness rejection of representative claim 1, and claims 2, 10, 11, 17, and 18 grouped therewith. For similar reasons, we also sustain the Examiner’s obviousness rejection of claims 19–21 which are based on the same underlying combination of Enko and Idei.

CONCLUSION

Appellants have not shown that the Examiner erred in rejecting representative claim 1 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Enko and Idei.

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Application 12/730,185

DECISION

The Examiner's rejections of claims 1, 2, 10, 11, and 17–21 are 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)(iv).

AFFIRMED