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CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

MENEFEE, JAMES A

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

12/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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DLA Piper US LLP
2000 University Avenue
E. Palo Alto, CA 94303

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DEC 19 2008

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,373.

PATENT NUMBER 7313720.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**OFFICE ACTION IN INTER PARTES
REEXAMINATION**

Control No.	Patent Under Reexamination	
95/000,373	7313720	
Examiner	Art Unit	
James Menefee	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on _____

Third Party(ies) on _____

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Response:

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

For Third Party Requester's Comments on the Patent Owner Response:

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-20 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims _____ are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-20 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 been received. not been received. been filed in Application/Control No 95000373.
10. Other _____

INTER PARTES REEXAMINATION OFFICE ACTION

This is an *inter partes* reexamination of United States Patent No. 7,313,720 (“the ‘720 patent”). All claims 1-20 are subject to reexamination.

References

- Ylonen et al., Concurrent Shadow Paging: Snapshots, Read-Only Transactions, and On-The-Fly Multi-Level Incremental Dumping, TKO-B104, Laboratory of Information Processing Science Helsinki Univ. of Tech., 1993¹ (“Ylonen”).
- Gait, The Optical File Cabinet: A Random-Access File System for Write-Once Optical Disks, IEEE Comput., June 1988 (“Gait”).
- Bach, The Design of the UNIX Operating System, Prentice Hall, 1986 (“Bach”).
- Quinlan, A Cached WORM File System, Software – Practice and Experience, Vol. 21(12), pp. 1289-1299, Dec. 1991 (“Quinlan”).
- McKusick, Running “Fsch” in the Background, Proc. of the BSDCon 2002 Conference, Feb. 11-14, 2002 (“McKusick”).
- The FreeBSD File System Documentation, Jan. 2003 (“FFS”).
- U.S. Patent No. 5,819,292 to Hitz et al. (“Hitz”).

¹ The examiner agrees with the Request that, while Ylonen is undated, the other reference to Ylonen (provided in the Request, not cited herein) provides evidence of the date of publication of Ylonen.

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b)(3).

Notification of Other Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the ‘720 patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04. At present the only proceeding the examiner is aware of involving the ‘720 patent is the court case noted by the Requester on p. 2 item 16 of the Request for Reexamination form PTO/SB/58.

Proposed Rejections/SNQs

The Request indicates that the cited references raise substantial new questions of patentability (SNQs) as follows. See Request pp. 2-3 listing the SNQs. Claim charts are also provided pointing out how the references allegedly meet the claims, and are cited below. In the Order Granting the Reexamination Request all proposals were found by the examiner to raise a SNQ.

1. Ylonen raises a SNQ as to claims 1-20. Request pp. 6-17.
2. Gait raises a SNQ as to claims 1-2, 7-9, 11-14, and 18-19. Request pp. 17-26.
3. Hitz and Bach raise a SNQ as to claims 1-2, 7-9, 11-14, and 18-19. Request pp. 26-35.
4. Quinlan raises a SNQ as to claims 1-2, 7-9, 11-14, and 18-19. Request pp. 36-40.
5. McKusick (having the inherent characteristics of FFS) raises a SNQ as to claims 1-2, 7-9, 11-14, and 18-19. Request pp. 40-50.
6. FFS raises a SNQ as to claims 1-2, 7-9, 11-14, and 18-19. Request pp. 50-57.

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Basis for Rejections - 35 USC §§ 102 & 103

The rejections presented herein are based on the following:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Discussion of Rejections Proposed in the Request

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ylonen. This rejection was proposed by the Requester and is adopted as proposed. See Request pp. 6-17, which are hereby incorporated by reference.

It is noted the claims require "active file systems," see, e.g., claim 1; Ylonen does not explicitly use this term, referring instead to databases, but Ylonen does teach active file systems in the same sense as described in the '720 patent. Both the base database and snapshot database of Ylonen are sets of data that can be accessed and modified, thus responding to read and write I/O operations. See, e.g., section 3.4 (noting snapshot is modifiable). These databases can therefore be deemed active file systems consistent with the specification of the '720 patent. While the '720 patent often refers to a file system as the write-anywhere file system, see e.g. col. 3 line 5, this is only done in an exemplary manner. Claims are not to be limited to a preferred embodiment when the claim language is broader than the embodiment. See MPEP 2111.01 II. The '720 patent goes further and describes active file systems in a broader sense: "An "active file system" is a file system to which data can be both written and read or, more generally, an active store that responds to both read and write I/O operations." Col. 3 lines 21-24 (emphasis added). By including such a statement, the patent owner has shown that the term should be considered in a broad sense. The databases of Ylonen fall under the latter broader description of an active file system, therefore the databases are deemed an active file system consistent with the way the term is described in the specification of the '720 patent.

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Claims 1-2, 7-9, 11-14, and 18-19 are not rejected under 35 U.S.C. 102(b) as being anticipated by Gait. This rejection was proposed by the Requester and is not adopted.

The claims require a volinfo block comprising a plurality of pointers configured to reference the active file system fsinfo block and the PCPI fsinfo blocks. The pointers are explicitly claims in independent claims 1, 18, and 19, while independent claim 11 requires the volinfo block "references" the fsinfo blocks. Gait, however, does not teach this feature and cannot anticipate the claims.

The Request appears to indicate that Gait teaches the claimed volinfo block in the disclosure of the timestamp list. See Request p. 19 ("[T]he timestamp list is a linked list of pointers configured to reference the root nodes for the active file system and for each of the snapshots."). As shown in Fig. 4 and its caption, the timestamp list points to a continuation list forming the snapshots, where each block in the continuation list forms a snapshot and the last block in the continuation list represents the current active file system. See also p. 14, describing that the timestamp blocks define a snapshot and are recorded in a continuation list, with the last checkpoint defining the current logical disk. The problem, however, is that there is no single block that corresponds to the claimed volinfo block, i.e. that points to fsinfo blocks.

The Request alleges at p. 19 that Gait Fig. 5 shows the fsinfo blocks as the root nodes of the figure. The top root node is a PCPI fsinfo block (as it is associated with a snapshot) and the bottom root node is the main fsinfo block (as it is associated with the last snapshot, which is the current active file system). However, there is no single block that points to or references both of these fsinfo blocks as required of the volinfo block in the claims. In Fig. 5, block i points to the PCPI fsinfo block (upper root node), while block i+1 points to the fsinfo block (bottom root

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node). Blocks i and $i+1$ are clearly different blocks as they are part of a continuation list, described in the text at p. 14 as a “sequence of blocks.” Thus neither of these blocks can be considered the volinfo block that must itself point to/reference both the PCPI and main fsinfo blocks.

Even if the timestamp list were argued as being the volinfo block, this still would not meet the requirements of the claims. The timestamp list, as shown in Fig. 4, appears to only reference the head timestamp; additional timestamps are referenced by the earlier timestamps via the continuation list structure. As stated in the text, the active file system, i.e. the last in the timestamp list, is found when the file system “traces through the timestamp pointer chain to the last timestamp.” Gait p. 14. The timestamp list thus does not itself reference several PCPI fsinfo blocks; at best it may reference one, the one at the head.

As there is no apparent element in Gait that corresponds to the claimed volinfo block, the examiner declines to make the proposed anticipation rejection.

Claims 1-2, 7-9, 11-14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitz in view of Bach. This rejection was proposed by the Requester and is adopted as proposed. See Request pp. 26-35, which are hereby incorporated by reference.

Claims 1-2, 7-9, 11-14, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Quinlan. This rejection was proposed by the Requester and is adopted as proposed. See Request pp. 36-40, which are hereby incorporated by reference.

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Claims 1-2, 7-9, 11-14, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by McKusick with inherent features of FFS. This rejection was proposed by the Requester and is adopted as proposed. See Request pp. 40-50, which are hereby incorporated by reference. Note the examiner agrees that, since McKusick discusses the use of the FFS, that the features of FFS as described in that reference are inherent in McKusick.

Claims 1-2, 7-9, 11-14, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by FFS. This rejection was proposed by the Requester and is adopted as proposed. See Request pp. 50-57, which are hereby incorporated by reference.

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Conclusion

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced. Patent owner is reminded that any proposed amendments must comply with 37 CFR 1.530(d)-(k). If new claims are presented excess claim fees will be required. 37 CFR 1.20(c).

37 CFR 1.943(b) requires that “[r]esponses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.” This page limit will be strictly enforced.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By U.S. Postal Service Mail to:

Mail Stop *Inter Partes* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

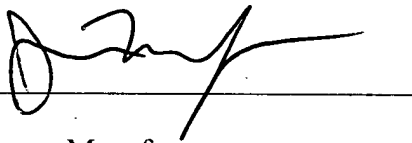
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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:



James Menefee
Primary Examiner
Central Reexamination Unit 3992
(571) 272-1944

December 17, 2008

Conferees:

