

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FAR STONE TECH., INC.,
Patent Owner.

Case IPR2015-00599
Patent 7,120,835 B2

Before HOWARD B. BLANKENSHIP, MICHAEL R. ZECHER, and
BETH Z. SHAW, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Petitioner Apple Inc. filed a request for an *inter partes* review of claims 1–7 and 9–13 of U.S. Patent No. 7,120,835 B2 (Ex. 1001, “the ’835 patent”) under 35 U.S.C. §§ 311–319. Paper 2 (“Petition” or “Pet.”). Patent Owner, Far Stone Tech. Inc. filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). The Board instituted this *inter partes* review of claims 1–7 and 9–13 on an asserted ground of unpatentability for obviousness. Paper 8 (“Dec. on Inst.”).

Subsequent to institution, Patent Owner filed a patent owner response. Paper 14 (“PO Resp.”). Petitioner filed a reply. Paper 16 (“Pet. Reply”).

An oral hearing concerning this case was held on April 18, 2016. The record contains a transcript of the hearing (Paper 27, “Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–7 and 9–13 of the ’835 patent are unpatentable.

A. Related Proceedings

According to the parties, the ’835 patent is involved in the lawsuit *Farstone Tech., Inc. v. Apple Inc.*, No. 8:13-cv-01537-SVW-JEM (C.D. Cal.). Pet. 3; Paper 5, 3.

B. The '835 Patent

The '835 patent relates to a backup/recovery module that establishes at least one recovery unit to hold backup data. Ex. 1001, Abstract.

Figure 1 of the '835 patent is reproduced below.

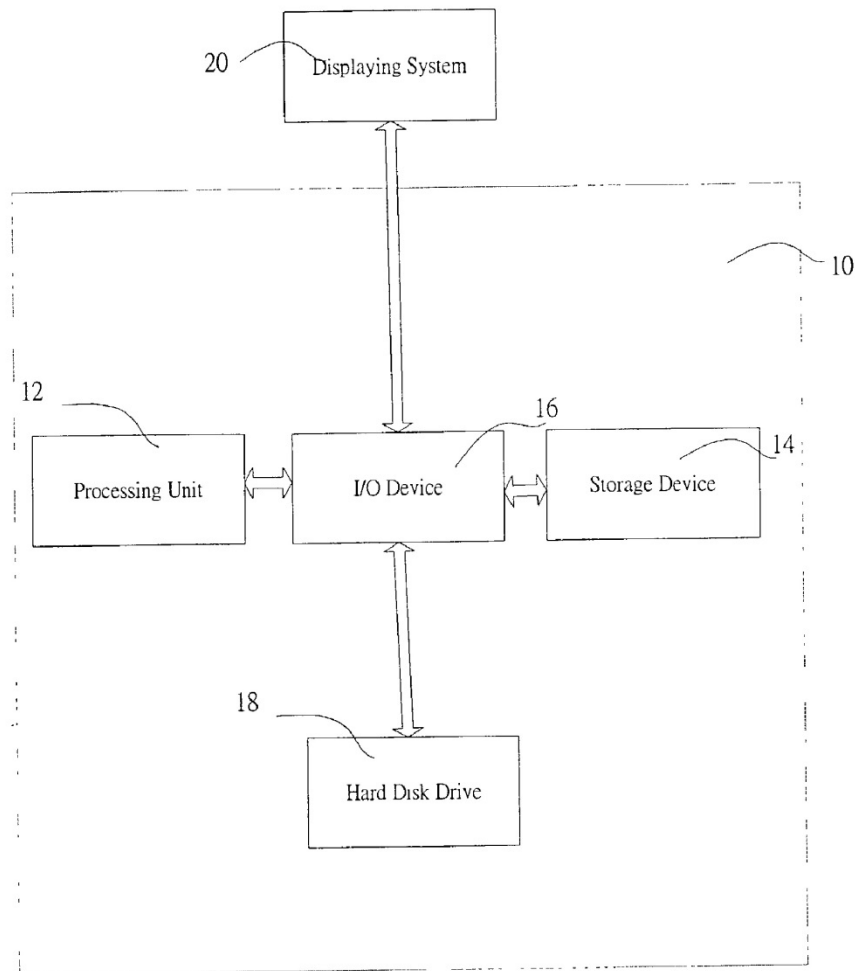


Figure 1 is a schematic block diagram of computer equipment according to a preferred embodiment of the invention. Ex. 1001, col. 3, ll. 55–57. The equipment includes processing system 10 and displaying system 20. Processing system 10 includes processing unit 12, storage device 14, input/output device 16, and a hardware resource such as hard disk 18. *Id.* at col. 4, l. 59 – col. 5, l. 3. Processing system 10 has a

backup/recovery module that can create at least one recovery point to hold backup data. *Id.* at col. 5, ll. 11–16.

C. Illustrative Claim

Of the challenged claims, claims 1 and 9 are independent. Claim 1, reproduced below, is illustrative.

1. A computer equipment having a prompt access function, said computer equipment comprising:
 - a processing system having at least one hardware resource with a backup/recovery module, said backup/recovery module creating at least one recovery unit to hold backup data; and
 - a displaying system for displaying backed up data of said processing system, said backed up data of said processing system corresponding to each of said at least one recovery unit, said displaying system having a selecting means, said selecting means selecting a status corresponding to said processing system at the time of creation of each of said at least one recovery unit, said displaying system displaying said selected status;
- wherein said at least one recovery unit respectively reflects a corresponding status of said at least one hardware resource at the time of creation of each of said at least one recovery unit, said at least one hardware resource can be restored to status at the time of creation of each of said at least one recovery unit.

D. Asserted Prior Art

Gold et al. (“Gold”) US 6,785,786 B1 Aug. 31, 2004¹
(Ex. 1009)

¹ Petitioner has provided a copy of the Patent Cooperation Treaty parent application (published March 11, 1999) as Exhibit 1012.

E. Instituted Grounds of Unpatentability

We instituted *inter partes* review on the following ground of unpatentability under 35 U.S.C. § 103(a) (Dec. on Inst. 15):

Reference	Claims
Gold	1–7 and 9–13

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, the Board construes claim terms in an unexpired patent using their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). The claim language should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citing *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002)). There is a presumption that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). The “ordinary and customary meaning” is that which the term would have to a person of ordinary skill in the art in question. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

When the word “means” appears in a claim element in combination with a function, there is a presumption that it is a means-plus-function

element to which § 112, sixth paragraph, applies.² *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999).

1. “*Selecting Means*” (*Claim 1*)

Claim 1 of the ’835 patent as reproduced above, recites “selecting means, said selecting means selecting a status corresponding to said processing system at the time of creation of each of said at least one recovery unit.” Petitioner contends that the “selecting means” is a means-plus-function limitation that is to be interpreted in accordance with 35 U.S.C. § 112, sixth paragraph. Petitioner submits, however, that there is no corresponding structure in the patent relating to the “selecting means,” rendering the claim indefinite. Pet. 8–13. For purposes of the Petition, Petitioner applies the prior art with the assumption that the “selecting means” is a user interface and input devices. *Id.* at 14.

Subsequent to filing of the instant Petition, the United States District Court for the Central District of California (“District Court”) entered a claim construction order that Patent Owner has filed as Exhibit 2001. Based, in part, on declaration evidence that is not of record here, the District Court determined that “selecting” is a common computer function and requires no additional structure to be disclosed. Ex. 2001, 15. Following the guidance of *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1316 (Fed. Cir. 2011), the District Court held that the function of simply

² Section 4(c) of the Leahy-Smith America Invents Act (“AIA”) re-designated 35 U.S.C. § 112, paragraph six, as 35 U.S.C. § 112(f). Pub. L. No. 112-29, 125 Stat. 284, 296 (2011). Because the ’835 patent has a filing date before September 16, 2012 (effective date of § 4(c)), we will refer to the pre-AIA version of § 112.

selecting or choosing a recovery unit on a displaying system does not need to be implemented by a special purpose computer, such that disclosure of an algorithm is unnecessary. Ex. 2001, 14–15. “Therefore, ‘selecting means’ is not indefinite for lack of corresponding structure.” *Id.* at 15.

For purposes of Institution, we adopted the District Court’s construction of “selecting means” as referring to an operation that does not require description of corresponding structure (such as an algorithm) in the Specification beyond a general purpose computer. Dec. on Inst. 7. Patent Owner acknowledges and does not dispute this construction. PO Resp. 16. We see no need to depart from this construction for purposes of this Final Written Decision.

2. “Status”

Consistent with the position taken by Patent Owner in the related District Court lawsuit, we interpret the term “status” as referring to a “state or condition.” See Ex. 2001, 17 (“Furthermore, the Court does not object to Farstone’s use of ‘state or condition’ as a substitute for ‘status’ in its proposed constructions.”). Patent Owner acknowledges and does not dispute this construction. PO Resp. 16. We see no need to depart from this construction for purposes of this Final Written Decision.

3. “Backup/Recovery Module” (Claim 1) and “Processing System” (Claim 9)

Subsequent to our Decision on Institution, the District Court reconsidered the instant claims in view of the United States Court of Appeals for the Federal Circuit’s recent decision in *Williamson v. Citrix*

Online, LLC, 792 F.3d 1339 (Fed. Cir. 2015) (en banc). Ex. 2006, 1. In a Supplemental Claim Construction Order, the District Court determined that the “backup/recovery module” in claim 1 and the “processing system” in claim 9 are limitations that must be construed in accordance with 35 U.S.C. § 112, sixth paragraph, but found no disclosed structure corresponding to the claimed functions. *Id.* at 5–10. The District Court held, accordingly, that claims 1–14 are invalid for indefiniteness under 35 U.S.C. § 112, second paragraph. *Id.* at 11. According to Patent Owner, Patent Owner’s appeal of the District Court’s judgment of invalidity is pending at the Federal Circuit. Tr. 3:15–22.

An *inter partes* review is limited in scope to consideration of unpatentability under 35 U.S.C. §§ 102 or 103 over prior art patents or printed publications. 35 U.S.C. § 311(b). The meanings of “backup/recovery module” and “processing system” as used in the claims are not in controversy in this proceeding. Only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Accordingly, in this proceeding we do not construe these terms because, regardless of the construction, there is no controversy between the parties as to whether Petitioner has presented sufficient evidence to support a finding that Gold properly accounts for each term.

4. “Displaying Backed Up Data” (Claims 1 and 9)

According to Patent Owner, in view of the Specification of the ’835 Patent, one of ordinary skill in the art would have understood displaying of “backed up data” to include displaying the contents of backed up file data

prior to performing a recovery operation. PO Resp. 26 (citing Ex. 2004 (Declaration of Dr. Matthew D. Green) ¶¶ 19, 35–37). “In contrast, Gold only describes the limited ability to view directory trees of files.” *Id.* at 27 (citing Ex. 2004 ¶¶ 24, 38).

The claims, however, do not recite that the *contents* of backup files are displayed. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claims cannot be relied upon for patentability). Patent Owner, relying on its expert (Dr. Green), refers to text in the Specification as purportedly limiting the scope of the claims.

According to the expert:

The specification describes an embodiment of this display operation explicitly, noting that: “[t]he users can conveniently extract directory or files inside the recovery points. The users can rename or remove any of them, *view contents thereof*, or perform recovery operation, simultaneously and immediately.” (*Id.* at [5:55–59]) (emphasis added).

Ex. 2004 ¶ 35 (quoting Ex. 1001, col. 5, ll. 55–59).

The capability of access to the contents of a recovery point, however, does not require that the contents of backed up files are displayed without further action of a user. Additionally, Patent Owner fails to address text in the Specification that indicates a broader scope. The Specification states that the “*files contained in the recovery points can be easily opened, viewed, copied, or the like.*” Ex. 1001, col. 4, ll. 26–28 (emphasis added). In particular:

Each recovery point is *demonstrated in a form of file folder to the users* to facilitate operations for the users. The users can conveniently extract directory or files inside the recovery points. *The users can rename or remove any of them,*

view contents thereof, or perform recovery operation,
simultaneously and immediately.

Id. at col. 5, ll. 54–59 (emphases added). Patent Owner’s expert Declaration (Ex. 2004 ¶ 35) does not address the sentence immediately preceding the description of what the user might do *after* a recovery point is demonstrated in a form of file folder.

Patent Owner’s expert also opines that “allowing the ‘files contained in the recovery points’ to ‘be easily opened, viewed, copied or the like’ . . . overcomes a limitation in the prior art noted by the inventors.” Ex. 2004 ¶ 36 (quoting Ex. 1001, col. 4, ll. 27–30). However, that is but one purported advantage of the invention. The ’835 patent discloses that a principal advantage of the invention is that not all recovery points have to be loaded into memory and mounted as logical drives before accessing a recovery point. Ex. 1001, col. 1, ll. 8–12, 25–53. Our reviewing court informs us that “[t]he fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (en banc) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 908 (Fed. Cir. 2004)). In *Phillips*, the Court found that “[a]lthough deflecting projectiles is one of the advantages of the baffles of the [patent], the patent does not require that the inward extending structures always be capable of performing that function.” *Id.*

We, therefore, are persuaded that the claimed “displaying backed up data” does not require that the contents of backed up files are displayed. We

construe the phrase “only to the extent necessary to resolve the controversy.”
Vivid Techs., 200 F.3d at 803.

B. Instituted Ground of Unpatentability

1. Gold

Gold describes a computer backup and recovery apparatus. Ex. 1009, Abstract.

Figure 3 of Gold is reproduced below.

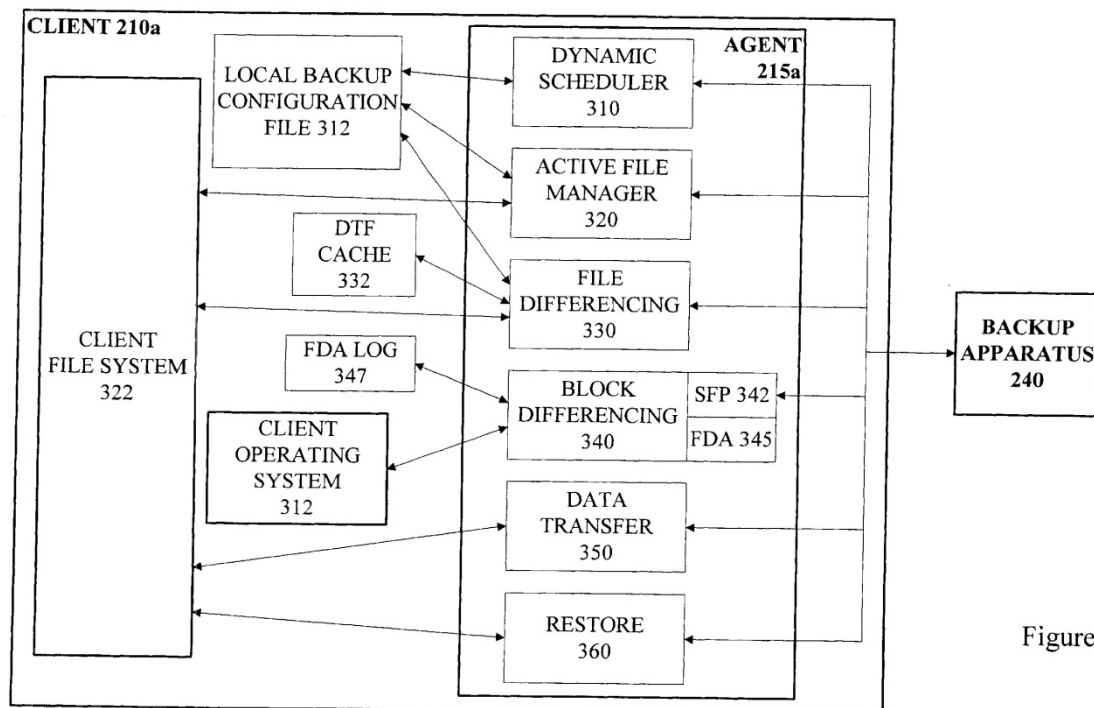


Figure 3

Figure 3 illustrates the main functional modules of the backup agent. Ex. 1009, col. 4, ll. 32–35. Dynamic scheduler 310 dynamically initiates a backup cycle from client 210a. *Id.* at col. 4, ll. 51–54. Active file manager module 320 monitors which files are to be opened for backing up. *Id.* at col. 5, ll. 27–29. File differencing module (FDM) 330 selects the files to be backed up by determining which files have been changed or added since the

last backup. FDM 330 reads the current directory tree of client file system 322 and checks each file's modified time/date against the entries in Directory Tree File (DTF) 332 generated from the last backup. *Id.* at col. 6, ll. 15–22. FDM 330 sends the list of selected new files to backup apparatus 240 to check for redundant copies already held on the backup server. *Id.* at col. 6, ll. 33–57.

Block-differencing module (BDM) 340 determines which blocks in each file have changed since the last backup. *Id.* at col. 6, ll. 65–66. Data transfer module (DTM) 350 performs the actual transfer of the backup data to backup apparatus 240. *Id.* at col. 7, l. 66 – col. 8, l. 1. All the differences in all the changed files since the last backup are stored in backup directory files (BDFs). All backup data is indexed such that it can be reconstructed from the various BDFs on backup apparatus 240. *Id.* at col. 8, ll. 17–21. Every time a backup is performed, a new DTF is generated and sent to backup apparatus 240. *Id.* at col. 8, ll. 36–38.

Restore module 360 performs restore operations using the DTFs to generate a directory tree of all files that can be restored. *Id.* at col. 8, ll. 43–45. A directory tree of all files that can be restored is generated and viewed in a graphical user interface. When a user selects a specific file from a specific backup, the DTFs are used to identify which portions of which BDF contain the file data. This data is then copied from backup apparatus 240 and written to the specified location in client storage. *Id.* at col. 8, ll. 59–66.

2. Section 103(a) — Gold

Petitioner applies the teachings of Gold to the requirements of claims 1–7 and 9–13, relying on the Declaration of Andrew Hospodor, Ph.D.

(Ex. 1002). Pet. 15–26. Upon consideration of Petitioner’s explanations and supporting evidence, we are persuaded by Petitioner’s contentions. We adopt Petitioner’s contentions as our own. Patent Owner argues in its Patent Owner Response that Gold fails to teach certain claim limitations, which we address in turn.

3. Patent Owner’s Arguments

(a) Displaying Backed Up Data (Claims 1 and 9)

Patent Owner argues that Gold does not teach “displaying backed up data,” as recited in claims 1 and 9. PO Resp. 25–29. Patent Owner’s arguments are based on the premise, however, that “displaying backed up data” requires that the *content* of files be displayed. We disagree that the claim phrase requires that contents of files be displayed. *See* § II.A.4, *supra*.

We, therefore, agree with Petitioner that the claimed “displaying backed up data” does not distinguish over Gold’s description of a directory tree of all files that can be restored. Pet. 20 (citing Ex. 1009, col. 8, l. 65 – col. 9, l. 3).

(b) Providing a User with an Outcome of Recovery Operation Beforehand (Claim 9)

Independent claim 9 includes within its preamble the recitation of a recovery method for “providing a user with an outcome of recovery operation beforehand.” Ex. 1001, col. 9, ll. 40–41. Petitioner submits that Gold does that by “allowing the user to view the files that will be restored.” Pet. 23.

Patent Owner responds that the claim 9 language requires more than display of files that will be restored, although the Response is not entirely clear in specifying what more claim 9 requires. *See* PO Resp. 29–32. At the oral hearing, however, Patent Owner’s counsel clarified Patent Owner’s position that the disputed language requires, as argued by Patent Owner with respect to displaying “backed up data,” displaying the data contained in files. Tr. 23:9–24:19.

JUDGE BLANKENSHIP: So you argue this requires that the data within the files be displayed?

MS. SAYOUR: It provides context for that, that is a separate element, but yes.

Id. at 24:16–19.

We have considered the testimony of Dr. Green in support of Patent Owner’s arguments (e.g., Ex. 2004 ¶¶ 41–45), but we are persuaded that “providing a user with an outcome of recovery operation beforehand” requires no more than allowing the user to view the files that will be restored, as taught by Gold. Pet. 23 (referring to elements 1[d] and 1[e] in the claim chart, which, in turn, cite Ex. 1002, 8:65–9:3, 14:6–1, Figs. 2–4)).

(c) Wherein Said Data Contained in Said Processing System Corresponding to Said At Least One Recovery Unit Includes Configuration Corresponding to Said At Least One Hardware Resource (Dependent Claims 3 and 11)

Patent Owner argues that Gold fails to teach “wherein said data contained in said processing system corresponding to said at least one recovery unit includes configuration corresponding to said at least one

hardware resource,” as recited in dependent claims 3 and 11. Patent Owner acknowledges that Petitioner relies, in part, on text in column 6 of Gold for the teaching of the argued limitations of claims 3 and 11. PO Resp. 23. In particular, Gold discloses:

As well as files, the FDM 330 *identifies any modifications to the system information used to rebuild the system* in disaster recovery. *This covers areas such as* NetWare NDS partitions, *disk partition information*, file system types and details (e.g. compressed), bootstrap partitions (e.g. MBR, NetWare DOS partition).

Ex. 1009, col. 6, ll. 58– 63 (emphases added). Patent Owner does not argue that system information such as disk partition information is not “hardware configuration information,” but contends Gold does not teach or suggest backing up such information. PO Resp. 23.

According to Patent Owner, Gold’s DTFs and BDFs do not back up and store “non-file” hardware configuration information. PO Resp. 22 (referring to Ex. 2004 ¶¶ 24, 29). Patent Owner does not explain what it means by “non-file” information. Patent Owner’s expert testifies that “a skilled artisan would recognize that [the DTF and BDF] store only file information, and therefore would not store non-file information such as hardware configuration.” Ex. 2004 ¶ 29. Patent Owner’s expert acknowledges that Gold describes that the FDM identifies modifications to the “system information used to rebuild the system in disaster recovery.” *Id.* ¶ 30 (quoting Ex. 1009, col. 6, ll. 58–63). According to Patent Owner’s expert, however, “[s]uch information might be printed out, or recorded in a separate location so that the user might, at a later point, manually reconfigure the system prior to initiating recovery.” *Id.*

We disagree with Patent Owner’s reading of Gold, as well as the supporting testimony of its expert. It is the FDM — the *file* differencing module — that identifies any modifications to the system information used to rebuild the system in disaster recovery. Ex. 1009, col. 6, ll. 58–63. The system information is not needed for restoration of selected files as described in column 8, lines 59 through 66 of Gold. But the system information *is* needed for the disaster recovery mode, in which backup apparatus 240 can be used to restore a complete data environment in the event of complete failure of the client system. Ex. 1009, col. 13, l. 59 – col. 14, l. 5. The “complete data environment” is more than the operating system. We, therefore, are not persuaded (*see* Ex. 2004 ¶ 32) that Gold’s teaching of having an appropriate operating system installed prior to full system recovery means that the user must manually install and configure all “system information” for the operating system on the recovery machine prior to disaster recovery.

Patent Owner’s expert concludes that Gold does not teach using hardware configuration in the recovery process. PO Resp. 20 (citing Ex. 2004 ¶¶ 24, 29–30). The conclusion is based on the lack of express text in Gold. *See* Ex. 2004 ¶¶ 24, 29–30. But Patent Owner’s expert Declaration does not address, let alone show error in, our preliminary findings in the Decision on Institution as to why one of ordinary skill in the art would appreciate that Gold teaches backing up data that “includes configuration corresponding to said at least one hardware resource” as claimed. Dec. on Inst. 13–14.

According to Gold, “[t]he DTFs on the backup apparatus 240 are used to determine the state of the system to be recovered.” Ex. 1009, col. 14,

ll. 6–7. The restored state, to be operational, necessarily includes restoration of the hardware configuration information. *See* Prelim. Resp. Patent Owner explains that:

One of the objects of the claimed invention is to enable a user to return the hardware resources in a processing system *to a state that is operational, including restoring the hardware configuration information that makes that so*, and in addition includes backup file data of interest to the user.

Prelim. Resp. 4 (emphasis added).

We, therefore, are persuaded that one skilled in the art would understand that Gold teaches backing up data that “includes configuration corresponding to said at least one hardware resource” within the meaning of claims 3 and 11.

III. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–7 and 9–13 of the ’835 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Gold.

IV. ORDER

In consideration of the foregoing, it is
ORDERED that claims 1–7 and 9–13 of the ’835 patent are held unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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