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Paper 10
Entered: August 21, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP, INC. AND HEWLETT PACKARD ENTERPRISE CO.,
Petitioner,

v.

KOM SOFTWARE, INC.,
Patent Owner.

Case IPR2019-00597
Patent 6,654,864 B2

Before DANIEL N. FISHMAN, KIMBERLY McGRAW, and BRENT M. DOUGAL, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314
37 C.F.R. § 42.108

I. INTRODUCTION

NetApp, Inc. and Hewlett Packard Enterprise Co. (collectively "Petitioner") filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1–3, 5, 6, and 9 of U.S. Patent No. 6,654,864 B2 (Ex. 1001, "the '864 patent"). *See* 35 U.S.C. § 311. KOM Software, Inc. ("Patent Owner") filed a Preliminary Response. (Paper 9, "Prelim. Resp.").

Applying the standard set forth in 35 U.S.C. § 314(a), which authorizes institution of an *inter partes* review when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition," we do not institute *inter partes* review of any claims of the '864 patent.

A. Related Proceedings

Petitioner identifies the following three litigations as involving the '864 patent: (1) *KOM Software Inc. v. Hitachi Vantara Corp.*, Case No. 1:18-cv-00158 (D. Del.); (2) *KOM Software Inc. v. Hewlett Packard Enterprise Co.*, Case No. 1:18-cv-00159 (D. Del.); and (3) *KOM Software Inc. v. NetApp, Inc.*, Case No. 1:18-cv-00160 (D. Del.). Pet. 16.

Petitioner has also filed eight other petitions for *inter partes* review of the ’864 patent and related patents:

IPR2019-00594	U.S. Patent No. 6,654,864 B2
IPR2019-00598, IPR2019-00600	U.S. Patent No. 7,076,624 B2
IPR2019-00604, IPR2019-00605	U.S. Patent No. 7,536,524 B2
IPR2019-00606	U.S. Patent No. 8,234,477 B2
IPR2019-00607, IPR2019-00608	U.S. Patent No. 9,361,243 B2

See Pet. 16.

B. The ’864 Patent (Ex. 1001)

The ’864 patent, titled “Method and System for Providing Restricted Access to a Storage Medium,” is generally directed to methods of restricting access by a computer to storage media. *See* Ex. 1001, [54], [57], 10:22–12:8. A method of restricting file access is disclosed wherein a set of file write access commands are determined from data stored within a storage medium. *Id.* at [57]. The set of file access commands are for the entire storage medium. *Id.* Any matching file write access command provided to the file system for that storage medium results in an error message. *Id.* Other file write access commands are, however, passed onto a device driver for the storage medium and are implemented. *Id.* In this way, commands such as file delete and file overwrite can be disabled for an entire storage medium. *Id.*

Figure 3 of the ’864 patent, reproduced below, depicts a block diagram of an operating system according to the invention. *Id.* at 4:7–8.

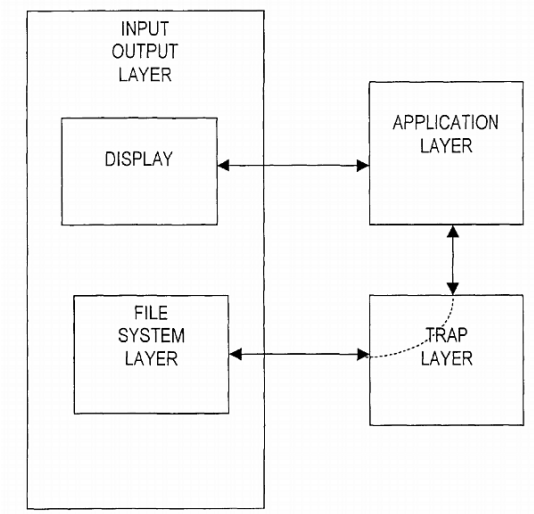

FIG. 3

The simplified view of operating system functionality shown in Figure 3, above, depicts an application layer that communicates with an input/output layer of the computer. *Id.* at 7:30–32. The input/output layer includes a display and a file system layer. *Id.* at 7:32–33. The application layer communicates with the file system layer for performing read operations and write operations with storage media. *Id.* at 7:33–35. Disposed between the application layer and the file system layer is a trap layer, also referred to as a filter layer. *Id.* at 7:35–37. "Each file system access request that is transmitted from the application layer to the file system layer is intercepted by the trap layer." *Id.* at 7:37–39. Restrictions relating to access privileges are implemented in the trap layer. *Id.* at 7:39–40. For example, some requests are blocked and error messages are returned to the application layer. Other requests are modified and the modified request passed onto the file system. *Id.* at 7:41–44. "When a data store is read only, a request to open a file for read write access is modified to an open file for read-only access; a

request to delete a file is blocked and an error message is returned." *Id.* at 7:44–47.

C. Claims

Petitioner challenges claims 1–3, 5, 6, and 9 of the '864 patent. Claims 1, 5, and 9 are independent. Claim 1 is representative and is reproduced below.

> 1. A method of restricting access by a computer to a logical storage medium other than a write once medium in communication with the computer, the method comprising the steps of:
>
> providing an indication of a data write access privilege for the entire logical storage medium, the data write access privilege indicative of a restriction to alteration of a same portion of each file stored on the logical storage medium; and
>
> restricting file access to the logical storage medium in accordance with the indication while allowing access to free space portions of the same logical storage medium.

D. Asserted Ground of Unpatentability

Petitioner argues the challenged claims are unpatentable based upon the following ground:

Reference	Basis	Challenged Claims
Canadian Application 2270651 A1[1]	§ 102(b)[2]	1–3, 5, 6, and 9

[1] Canadian Application 2270651 A1, published Jan. 31, 2000 (Ex. 1003, "CA '651").

[2] The Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011)("AIA"), amended 35 U.S.C. § 102. Because the '864 patent has an effective filing date before September 16, 2012, the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of § 102.

II. DISCUSSION

A. Asserted Anticipation of Claims 1–3, 5, 6, and 9 by CA '651

Petitioner contends claims 1–3, 5, 6, and 9 are unpatentable under pre-AIA § 102(b) as anticipated by Canadian Application 2,270,651 ("CA '651"). *See* Pet. 11; Ex. 1003, [11], [43]. Petitioner asserts that due to a break in the chain of priority, CA '651 qualifies as prior art to the '864 patent. *See* Pet. 1, 3.

For the reasons discussed below, we disagree with Petitioner and determine, on the present record, the information presented does not show a reasonable likelihood Petitioner would prevail in establishing that at least one claim of the '864 patent is unpatentable as anticipated by CA '651. As such, we do not institute an *inter partes* review of the '864 patent.

1. Overview of CA '651

CA '651 is entitled "Method and System for Providing Write Access to a Storage Medium." Ex. 1005, [54]. Claims 27–29, 31, 32, and 35 of CA '651 are identical to claims 1–3, 5, 6, and 9 of the '864 patent, respectively.

2. Status of CA '651 as Prior Art

A threshold issue is whether CA '651, which was published on January 31, 2000, qualifies as prior art against the '864 patent under § 102(b). The '864 patent issued from U.S. Application No. 10/032,467, which was filed on January 2, 2002, and claims priority to U.S. Application No. 09/267,787 ("the parent '787 application"), which was filed on March 15, 1999, and issued as U.S. Patent No. 6,336,175 on January 1,

2002.[3] *See* Ex. 1001, [30], [62]. Thus, if the '864 patent is entitled to claim priority to the March 15, 1999, filing date of its parent '787 application, CA '651 does not qualify as prior art under § 102(b).

Petitioner asserts that because the continuing application giving rise to the '864 patent was filed the day *after* the parent '787 application issued as a patent, the continuing application was not timely filed *before the patenting* of the parent '787 application, as required by 35 U.S.C § 120, and is, therefore, not entitled to claim the benefit of a filing date any earlier than its own January 2, 2002, filing date. *See* Pet. 3–8. Petitioner recognizes that 35 U.S.C. § 21(b)—referred to by the parties as the "holiday exception" or the "holiday rule"—"provides that when the last day 'for taking any action or paying any fee in the [USPTO]' falls on a holiday, the action be taken on the next secular or business day." *Id.* at 6 (quoting 35 U.S.C. § 21(b)). Petitioner, however, contends that the holiday exception of § 21(b) cannot apply to 35 U.S.C. § 120 because § 120 requires the continuing application be filed *before* the application to which it claims priority issues as a patent. *Id.* at 5–8. Petitioner also argues the filing of a continuing application after issuance of the parent violates 37 C.F.R. § 1.78(d) for the same reasons it failed to meet the requirements of 35 U.S.C. § 120. *See id.* at 8–10.

Patent Owner responds that the '864 patent properly claims priority to its parent '787 application because 35 U.S.C. § 21(b) expressly provides that when the last day for taking any action or paying any fee in the USPTO falls

[3] The parent '787 application claims priority to Canadian Patent Application 2,244,626 ("CA '626") filed on July 31, 1998. The '864 patent, however, cannot directly claim priority to CA '626 because the '864 patent was not filed within 12 months from the earliest date on which CA '626 application was filed. *See* 35 U.S.C. § 119(a).

on a holiday, the action may be taken on the next secular or business day. *See* Prelim. Resp. 7–9. Patent Owner contends that because January 1, 2002, was a holiday, the applicants had until January 2, 2002, to file the continuing application that ultimately became the '864 patent. *Id.* at 8–9.

We agree with Patent Owner that the application giving rise to the '864 patent is entitled to claim priority to the parent '787 application's March 19, 1999, filing date.

Section 21(b) of the Patent Act states in relevant part:

> When the day, or the last day, *for taking any action* or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

See 35 U.S.C. § 21(b) (emphasis added).

Because January 1, 2002, was a Federal holiday within the District of Columbia, the day for taking any action that was due that day was extended to January 2, 2002, "the next succeeding secular or business day." *See id.* Here, the '787 application issued as a patent on January 1, 2002; therefore, the last day for taking the legal act of filing a continuing application that claims priority to the '787 application, fell on January 1, 2002. *See Immersion Corp. v. HTC Corp.*, 826 F.3d 1357, 1365 (Fed. Cir. 2016) (determining that a continuing application that is filed on the same day that its parent application issues as a patent is timely filed under § 120). The holiday rule of § 21(b) applies to the "the day . . . for taking any action" and does not make any distinction among the types of "action" to which it applies. 35 U.S.C. § 21(b). We agree with Patent Owner that the legal act of filing of a continuation is an "action" as set forth in § 21(b). *See Immersion*, 826 F.3d at 1359 (stating that the "filing" of a continuing

application and the "patenting" of a parent application are "both legal acts"). Petitioner has not directed us to persuasive legal authority to support its argument that the filing of a continuing application is a "condition-precedent" to which § 21(b) does not apply. *See* Pet. 6 (stating "there is a distinction between taking an 'action' relative to an existing application and the existence of a condition-precedent for the filing of a continuing application under § 120"). Thus, we determine that if the last day for taking the action of filing a continuing application falls on a Federal holiday (e.g., January 1, 2002), the action of filing such a continuing application can be taken on the following business day (e.g., January 2, 2002).

We disagree with Petitioner's argument that application of the holiday exception would "violate the plain text of § 120,"[4] which affords a continuing application the priority date of its parent only if the continuing application is filed *before the patenting* of the parent. *See* Pet. 3–5. The Federal Circuit in *Immersion* determined that the "filed before patenting" requirement of § 120 does not strictly require that the continuing application be filed *before* the first application issues as a patent, as the Federal Circuit determined that a filing that occurs *on the same day* that the first application

[4] Section 120 of the Patent Act states, in relevant part:

> An application for patent for an invention . . . in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application, if *filed before the patenting* or abandonment of or termination of proceedings on the first application . . . and if it contains or is amended to contain a specific reference to the earlier filed application.

35 U.S.C. § 120 (emphasis added).

issues as a patent satisfies the "before the patenting" requirement. *See Immersion*, 826 F.3d at 1365. The Federal Circuit explained that § 120 should be read to accommodate "obvious practical considerations" such as when the filing of the continuing application does not occur "before patenting" of the parent, but rather occurs "within a single day." *Id.* Here, when the holiday rule is applied to § 120, the "day" for compliance expands to include the next business day as the day for taking any action. Thus, under the facts before us, the day for taking action included January 2, 2002.

We are also not persuaded by Petitioner's argument that because Congress amended § 119[5] to expressly extend the 12-month pendency "for claiming priority to a provisional application that would otherwise end in a holiday," but did not similarly amend § 120, we should infer that Congress intended § 21(b) should not apply to § 120. *See* Pet. 7–8; *see also id.* at 7 (stating the "absence of a similar holiday exception in § 120 creates an inference that none exists for § 120"). As noted by Patent Owner, the likelihood that the deadline for filing an application claiming priority to a provisional application under § 119 (i.e., "the day that is 12 months after the filing date of a provisional application") would fall on a Saturday, Sunday, or holiday is relatively great. *See* Prelim. Resp. 14 (noting that such a deadline could occur on a weekend or holiday could happen scores of times

[5] In 1999, Congress made a "Technical Amendment Relating to Weekends and Holidays" and amended 35 U.S.C. § 119(e) to add the following: "(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day." *See* Consolidated Appropriations Act, Pub L. No. 106–113, 113 Stat. 1501, § 4801 (1999).

per year and could affect thousands of filings every year). In contrast, the likelihood that the deadline for filing an application claiming priority to a non-provisional application under § 120 would occur on a weekend or holiday is relatively rare. *Id.* Patent Owner explains that traditionally the USPTO never issues a patent on a Saturday or Sunday, but rather, issues new patents on Tuesdays at 12:01 a.m. *See id.* at 13. Thus, the only time that the deadline for filing a non-provisional application *before the patenting* deadline of § 120 would occur is when a Federal holiday (e.g., January 1, July 4, or December 24) falls on a Tuesday, which occurs, on average, on only three dates every seven years. *Id.* Given the differences between the types of deadlines set forth in §119(e) (e.g., "not later than 12 months after the date on which the provisional application was filed") and § 120 (e.g., "before the patenting or abandonment of or termination of proceedings on the first application") and the relative likelihood of any such deadline occurring, we decline to infer that Congress intended that § 21(b) should not apply to § 120 when it amended § 119, as suggested by Petitioner.

We are also not persuaded by Petitioner's argument that 37 C.F.R. § 1.78(d) precludes the '864 patent from claiming priority to the filing date of its parent '787 application because the rule-based holiday exception set forth in 37 C.F.R. § 1.7(a)[6] applies only to "time periods," and

[6] 37 C.F.R. § 1.7(a) states, in pertinent part, that whenever "periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday or a Federal holiday."

like the statute, does not apply to the "copending" requirement. *See* Pet. 8–10. Section 1.78(d) states, in relevant part, that an applicant "may claim the benefit of one or more prior-filed copending nonprovisional applications . . . under the conditions set forth in 35 U.S.C. § 120 . . . ." As stated above, Patent Owner has satisfied the conditions set forth in § 120. Petitioner has not identified a single instance when the Patent Office has applied 37 C.F.R. § 1.78(d) to preclude an application from claiming priority under 35 U.S.C. § 120.

Rather, the Patent Office has repeatedly stated that the holiday exception of 35 U.S.C. § 21(b) and 37 C.F.R. § 1.7(a) applies to the filing of continuing applications under § 120, deeming filings to be timely when filed the next business day after the Federal Government offices in the Washington, D.C. metropolitan area are officially closed. *See, e.g.*, https://www.uspto.gov/learning-and-resources/operating-status (stating that Patent Office will consider various dates that the Federal government offices in the Washington, D.C., metropolitan area were officially closed, including January 14, 2019, December 24, 2018, December 5, 2018, to be Federal holidays within the District of Columbia under, *inter alia*, 35 U.S.C. § 21, and that any action or fee taken on these dates will "be considered as timely for the purposes of, e.g., [35 U.S.C. § 120] if the action is taken, or the fee paid, on the next succeeding business day on which the USPTO is open"); https://www.uspto.gov/web/offices/com/sol/og/2015/week18/TOC.htm#ref20 (stating that in view of the official closing of the Federal government offices in the Washington, D.C. metropolitan area on Tuesday, February 17, 2015, the USPTO will consider Tuesday, February 17, 2015, to be a Federal holiday within the District of Columbia under, *inter alia*, 35 U.S.C. § 21 and

that any "action or fee due on Tuesday, February 17, 2015, will be considered as timely for the purposes of, e.g., [35 U.S.C. § 120] if the action is taken, or the fee paid, on the next succeeding day on which the USPTO is open"); *see also* https://www.uspto.gov/about-us/news-updates/dec-22-2015-power-outage-updates##electronicsystemsDec2015 (stating that in light of an "emergency situation, the USPTO will consider each day from Tuesday December 22, 2015, through Thursday, December 24, 2015, to be a 'Federal holiday within the District of Columbia' under 35 U.S.C. § 21 . . . ." and that any "action or fee due on these days will be considered as timely for the purposes of, e.g., [35 U.S.C. § 120] if the action is taken, or the fee paid, on the next succeeding day on which the USPTO is open"). Petitioner provides no meaningful argument for overturning the Patent Office's practice of permitting continuation applications to claim the holiday exception under 35 U.S.C. § 21(b) and 37 C.F.R. § 1.7. *See* Pet. 9–10.

Thus, for the foregoing reasons, we determine the '864 patent is entitled to claim priority to the March 15, 1999, filing date of its parent '787 application and that the CA '651 patent does not qualify as § 102 prior art to the '864 patent.

3. Anticipation of Claims 1–3, 5, 6, and 9

Petitioner asserts claims 1–3, 5, 6, and 9 are anticipated by CA '651. Pet. 11–15. Because we determine Petitioner has not persuasively shown that CA '651 qualifies as prior art under § 102(b) to the '864 patent, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that at least one of the challenged claims of the '864 patent is anticipated by CA '651.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner not has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the ’864 patent is unpatentable over CA ’651. Accordingly, we deny institution of *inter partes* review.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is denied as to all challenged claims of the ’864 patent and no trial is instituted.

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