

Appeal No. 2009-1400  
(Serial No. 09/725,737)

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**IN RE PETER JOSEPH GIACOMINI,  
WALTER MICHAEL PITIO, HECTOR FRANCISCO RODRIGUEZ,  
AND DONALD DAVID SHUGARD**

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

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**BRIEF FOR APPELLEE –DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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**35 U.S.C. § 102(e)(2)**

“A person shall be entitled to a patent unless . . . the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . . .”

**35 U.S.C. § 111(b)(8)**

“The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135 and 157 of this title.”

**35 U.S.C. § 119(e)(1)**

“An application for patent filed under section 111(a) . . . for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title . . . shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) . . . is filed not later than 12 months after the date on which the provisional application was filed . . . .”

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## **STATEMENT OF RELATED CASES**

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences (“Board”) for the United States Patent and Trademark Office (“USPTO”) in connection with this application that has previously been before this or any other court. The Director is also unaware of any other case pending in this or any other court that will directly affect, or be directly affected, by this Court’s decision in the pending appeal.

Appeal No. 2009-1400  
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**BRIEF FOR APPELLEE - DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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**I. STATEMENT OF THE ISSUE**

According to 35 U.S.C. § 102(e)(2), an applicant is not entitled to a patent if the claimed invention was disclosed in another's patent issued from an earlier filed U.S. "application for patent." Under § 119(e)(1), a nonprovisional application is treated as though filed on the date of filing of a provisional application to which it claims priority. Additionally, § 111(b)(8) requires that provisional applications be treated the same as nonprovisional applications for all sections of the Patent Act—with a list of exceptions that do not include § 102(e). The issue is whether, under § 102(e)(2), a patent reference is entitled to the filing date of a provisional application. The answer to that question is dispositive here because Giacomini did

not dispute below that the prior art reference at issue, Tran, teaches all of the features claimed.

Alternatively, the Court may affirm the Board's decision that a second reference, Teoman, likewise teaches all of the limitations of Giacomini's claimed invention. Giacomini's invention is a method for managing data stored in a cache; a readily accessible memory with limited capacity. In the claimed invention, a "resource" that is requested more than once is stored in the cache. Similarly, Teoman discloses storing an entire directory of files in a cache after receiving multiple requests for files in the directory. Thus, the issue is whether substantial evidence supports the Board's findings that Teoman anticipates.

## **II. STATEMENT OF THE CASE**

This case concerns Giacomini's patent application, Serial No. 09/725,737, styled "Method and Apparatus for Economical Cache Population." A82-A102.<sup>1</sup> The examiner had rejected claims 1, 8, 11, 12, 15, 22-24, 27, 28, 31 and 32 as anticipated over three different prior art references, and had also rejected claims 2, 9, 16 and 25 as not enabled.<sup>2</sup> A140-A166. Relying on representative claim 1, the

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<sup>1</sup> Throughout this brief the Joint Appendix is referred to as "A\_\_\_," and Giacomini's Brief is referred to as "Br. at \_\_\_."

<sup>2</sup> At the time of the appeal, claims 3-7, 10, 13, 14, 17-21, 26, 29 and 30 stood objected to, as dependent on a rejected base claim, but the examiner indicated that those claims would be allowed if rewritten in independent form. A3. On the same day that Giacomini filed a notice of appeal in this case, Giacomini also: 1) submitted an amendment cancelling the remaining claims from this application,

Board of Patent Appeals and Interferences (“Board”) issued a final decision affirming the examiner’s rejection of the present claims as anticipated by two of the three prior art references relied on by the examiner. A2-A13. The Board reversed the examiner’s rejection of the same claims as anticipated by the third reference, and reversed his rejection of claims 2, 9, 16 and 25 as not enabled. Id. Giacomini appeals the Board’s decision to this Court.

### **III. STATEMENT OF THE FACTS**

#### **A. Giacomini’s Application**

Giacomini’s application is directed to a method for selecting data to be stored in a cache. A82. Caching is a known technique whereby data is retrieved from a source and stored in a readily accessible memory, so that the stored data may be retrieved more quickly when next requested. A82. Caching is often employed to enhance use of the Internet by reducing the time needed to retrieve and display frequently requested Web pages. Id. This eliminates the time needed to fetch the data from a more distant source. Id.

Because space in a cache is limited, data is stored selectively. Giacomini’s application discloses selecting data to be stored in a cache based on the number of requests for that data. A84. According to Giacomini, by populating a cache only

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and 2) filed a continuation application, 12/467,000, containing claims 1-32 matching those currently found in this application. A103-A107.

if at least two requests for the data have been made, the cache will not include “infrequently requested” data. Id.

## **B. The Claimed Invention**

Claim 1 is broadly directed to a method for selecting data to be stored in a cache based on the number of requests for that data. A133. The claim specifically requires populating a cache “only when at least  $i$  requests” have been received, where “ $i$  is an integer and is at least occasionally greater than one.” Id.

Representative claim 1 recites:

1. A method comprising:

populating a cache with a resource only when at least  $i$  requests for said resource have been received;

wherein  $i$  is an integer and is at least occasionally greater than one.

Id.

## **C. The Prior Art**

In affirming the examiner’s rejection of Giacomini’s claims as anticipated, the Board relied on two prior art references: Tran (U.S. Patent No. 7,039,683) and Teoman (U.S. Patent No. 6,463,509). Both references relate to selectively storing data in a cache.

### **1. Tran**

Tran discloses a system and method for electronic information caching based on the popularity of the requested information. A6, A9, A40-A63. Tran

recognized the desirability of anticipating requests for on-line information and caching that information to improve its accessibility. A52 (col. 1, ll. 14-39). Specifically, Tran discloses anticipating future requests for information based on past requests for the same information, and storing a duplicate copy of it in a more accessible memory (a cache). A52 (col. 1, ll. 40-64). To that end, Tran's invention uses an "anticipating module" designed to determine the frequency or the number of past requests for information, and select that information for storage in the cache. A53 (col. 3, ll. 20-36, col. 4, ll. 25-42). Tran claims priority to U.S. Provisional Application No. 60/234,996, which also discloses selecting data to be stored in a cache based on past requests for information. A6, A10.

## **2. Teoman**

Teoman discloses a system and method for caching data in a memory of a computer. A17-A39. Via caching, "the host computer can access the data virtually instantly, avoiding the performance and reliability issues inherent in the network and reducing the overall network traffic." A34 (col. 8, ll. 60-64).

Data may either be preloaded or stored in response to requests ("responsive caching"). A35 (col. 9, ll. 15-38). Data that has not already been preloaded may be stored in a "user-configurable cache memory." A17 (Abstract). Caching is managed using a "user cache manager." A35 (col. 10, ll. 34-37). Caching may be triggered based on access statistics, such as the number of requests. A35 (col. 10,

ll. 34-54). For example, Teoman discloses that “a user may specify that, after a threshold number of files within a directory have been accessed, all the files in the directory are to be preloaded.” A35 (col. 10, ll. 40-43).

#### **D. The Board’s Decision**

The Board affirmed the examiner’s rejection of the currently pending claims as anticipated by Tran and Teoman. A2-A13; A140-A166. Because Giacomini had not separately argued the patentability of his claims (see e.g., A126), the Board selected claim 1 as representative. A3.

First, the Board found that Tran anticipated. A9. Specifically, the Board found that Tran teaches electronic information caching including an “anticipating module” designed to cache information when it determines that the rate, or number of requests for information, is “high.” A9-A10. Because Tran “caches electronic information that has been subject to plural ‘requests,’” the Board found that it teaches populating a cache with data when it receives “at least occasionally greater than one” request for that data. A10.

The Board agreed with the examiner that Tran qualified as prior art. Citing MPEP § 706.02(f) for authority, the examiner concluded that Tran was prior art as of the date that Tran had filed his provisional application, to which the examiner found Tran’s patent had properly claimed priority under 35 U.S.C. § 119(e).

A149. Before the Board, Giacomini’s sole argument was: “The 102(e) filing date

of Tran is 29 December 2000, which is after the filing date of the present application (29 November 2000), and, therefore, it is a [sic] invalid prior art reference.” A126. The Board agreed with the examiner, however, noting that Tran claims priority to a provisional application filed prior to Giacomini’s earliest filing date. A9. As a result, it concluded that “Tran therefore does qualify as prior art, based on the filing date of the provisional application.” Id. The Board further noted that Giacomini offered “no argument . . . that the provisional application does not support the subject matter relied upon” to reject the claim. Id.

In addition, the Board found that Teoman anticipated. A11. It relied on Teoman’s disclosure of a caching method for storing all of the files in a directory after receiving at least a threshold number of requests for files within that directory. The Board found that “Teoman thus teaches populating a cache with a resource (i.e., a directory) when at least *i* requests for that resource (i.e., files making up that directory) have been received.” Id. As a result, it found that Giacomini had failed to show error in the examiner’s reliance on Teoman as an anticipating reference. A12.

Giacomini did not request reconsideration of the Board’s decision. Instead, Giacomini filed this appeal.



#### IV. SUMMARY OF THE ARGUMENT

This Court can affirm the Board's decision if it concludes that Tran is prior art as of the date Tran filed his provisional application. Giacomini does not dispute that the patent issued to Tran discloses all of the limitations of his claims. Rather, he simply argues that Tran is not prior art because it is not entitled to the benefit of the filing date of the provisional application. But Giacomini is mistaken.

Under § 102(e), an applicant is not entitled to a patent if “the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant . . . .” Under well established precedent, a patent that issues from a series of U.S. applications is prior art as of the date the first in the series was filed, so long as that first application was filed in the U.S.

Treating provisional applications the same as nonprovisional applications for purposes of determining the effective prior art date is required by statute. Under 35 U.S.C. § 119(e)(1), “[a]n application for patent filed under section 111(a) . . . shall have the same effect, as to such invention, as though filed on the date of the provisional application under section 111(b) . . . .” Furthermore, when Congress created provisional applications in 35 U.S.C. § 111(b)(8), it stated clearly its intent that provisional applications be treated the same as nonprovisional applications. Even though Congress identified four provisions within the Patent Act excepted

from this treatment, Congress chose not to include § 102(e) among them. Thus, whether this Court reviews the USPTO's statutory interpretations de novo or with deference, the Court should uphold the USPTO's present interpretation of the applicable statutes; it is the only reasonable one.

The USPTO's interpretation of the applicable statutes is also entirely consistent with case law interpreting § 102(e). Those cases explain that the main policy rationale for crediting a patent reference with an earlier filing date is based on a fundamental principle of patent law—that an applicant that was not the first to invent the claimed subject matter in the U.S. is not entitled to a patent. According to those cases, patent references will benefit from the earlier filing as long as those genres of filings are a sufficient vehicle for disclosing inventions in the U.S., and in each case do lead to disclosure.

Even if the Court concludes that Tran does not qualify as prior art, it can affirm the Board's decision on the basis that Teoman anticipates. Representative claim 1 is directed to a method for selecting a "resource" to be stored in a cache based on "at least occasionally greater than one" request for that resource. Relying on Teoman's disclosure of a caching method for storing all of the files in a directory after receiving at least a threshold number of requests for files within that directory, the Board properly found that Teoman anticipates. All. Although Giacomini objects to the Board's interpretation of his claims, and in particular, its

decision to interpret “resource” as to encompass files within a directory, in doing so he ignores his own definitions for that term provided in his specification.

## V. ARGUMENT

### A. Standard of Review

Anticipation is a question of fact. In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997). What a prior art reference teaches is a question of fact. Para-Ordnance Mfg. v. SGS Importers Int’l, Inc., 73 F.3d 1085, 1088 (Fed. Cir. 1995). This Court upholds fact findings made by the Board that are supported by substantial evidence, 5 U.S.C. § 706(2)(E)<sup>3</sup>, and reviews the Board’s legal conclusions de novo. In re Gartside, 203 F.3d 1305, 1315-1316 (Fed. Cir. 2000). Substantial evidence is “something less than the weight of the evidence but more than a mere scintilla of evidence,” In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000), and refers to “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion,” Consol. Edison Co. v. NLRB, 305 U.S. 197, 229 (1938). “If the evidence in record will support several reasonable but contradictory conclusions, [the Court] will not find the Board’s decision

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<sup>3</sup> Citing to In re Zurko, 142 F.3d 1447 (Fed. Cir. 1998), Giacomini mistakenly argues that the Board’s findings are reviewed for clear error. In Dickinson v. Zurko, 527 U.S. 150, 165 (1999), however, the Supreme Court held that the clearly erroneous standard was not the correct standard of review. This Court has since held that the Board’s fact findings are reviewed for substantial evidence. In re Gartside, 203 F.3d 1305, 1315-1316 (Fed. Cir. 2000).

unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative.” In re Jolley, 308 F.3d 1317, 1320 (Fed. Cir. 2002).

Claim construction is a matter of law that the Court reviews de novo. In re Baker Hughes, Inc., 215 F.3d 1297, 1301 (Fed. Cir. 2000). The Court reviews the Board’s claim construction to determine whether it was reasonable. In re Crish, 393 F.3d 1253, 1256 (Fed. Cir. 2004) (citing In re Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997)).

**B. Tran Discloses the Claimed Cache Management Technique**

**1. It Is Undisputed That Tran Discloses Every Limitation Of Representative Claim 1**

Claim 1 is directed to the generalized concept of selecting data to be stored in a cache based on the number of requests for that data. A133. The claim broadly recites populating a cache “only when at least *i* requests” have been received, where “*i* is an integer and is at least occasionally greater than one.” Id.

Giacomini did not challenge the Board’s findings that the patent issued to Tran discloses every limitation of representative claim 1. Br. at 17-28. Like that claim, Tran discloses a system and method for providing quicker access to certain information by caching it based on the number of requests for it. A6, A9, A52 (col. 1, ll. 28-64; col. 2, ll. 40-56). Specifically, Tran’s “anticipating module” is

designed to determine the rate or number of “past requests.” A53 (col. 3, ll. 25-28). Information is selected for storage in the cache when the “cache value or frequency of requests for the electronic information is high.” A53 (col. 3, ll. 28-36; col. 4, ll. 25-42). Thus, Tran anticipates.

Tran claims priority to U.S. Provisional Application No. 60/234,996, which the Board found also discloses selecting data to be stored in a cache based on past requests for information.<sup>4</sup> A6, A10. Before the examiner and the Board, Giacomini did not challenge Tran’s provisional application as failing to teach the claimed invention. A9. In his opening brief, however, Giacomini for the first time asserts that Tran’s provisional application fails to anticipate the claimed invention. He now argues that the Board “never made any effort to identify the supported matter in Tran’s patent.” Br. at 24. Having deprived the Board the opportunity to respond to this new argument, Giacomini has waived it. As this Court explained in In re Watts, 354 F.3d 1362 (Fed. Cir. 2004), “it is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.” Id. at 1367.

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<sup>4</sup> The provisional application describes caching information based on the frequency or volume of requests for selected information, and based on past requests by a plurality of requestors. A202-A204, A227-A228.

**C. An Issued Patent Claiming Priority to a Provisional Application, Such As Tran, Is Prior Art Under 35 U.S.C. § 102(e) as of the Date the Provisional Application Was Filed**

This Court can affirm the Board's decision if it agrees that Tran qualifies as prior art. For the reasons that follow, it does.

**1. The USPTO's Interpretation of the Statutes Is Correct**

Given the plain language of § 102(e)(2), § 119(e)(1) and § 111(b)(8), in determining a reference's § 102(e) prior art date the USPTO is required to credit a patent reference with a proper claim to an earlier filed provisional application.

35 U.S.C. § 102(e) states: “[a] person shall be entitled to a patent unless . . . the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . . .” 35 U.S.C. § 102(e)(2) (emphasis added).<sup>5</sup> Thus, according to the statute, another's earlier-filed U.S. “application for patent” that issues as a patent is prior art as of its filing date.

Under § 119(e)(1), a nonprovisional application (§ 111(a)) must be treated as though filed on the filing date of the provisional application (§ 111(b)), to which it claims the benefit of priority, where the remaining requirements of the statute are met. Specifically, § 119(e)(1) provides: “[a]n application for patent filed under

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<sup>5</sup> Although this case involves a rejection under § 102(e)(2) based on an application that matured into an issued patent, the analysis here applies equally to published applications relied on under § 102(e)(1).

section 111(a) . . . shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b),” if the applicant, among other things, files the nonprovisional application within twelve months.

And there can be no dispute that for patent references that claim priority through a series of U.S. nonprovisional applications, the 102(e) date is the filing date of the earliest application in the series to which the claim is proper. Br. at 19, 25; In re Klesper, 397 F.2d 882 (CCPA 1968); In re Wertheim, 646 F.2d 527, 534 (CCPA 1981) (quoting Klesper); In re Lund, 376 F.2d 982 (CCPA 1967); 1 Donald S. Chisum, Chisum on Patents, §3.07[3] (“Continuation Applications”).<sup>6</sup> In Klesper, the CCPA held that under § 102(e), the earliest effective date of a patent reference is the filing date of the first application in a series. Id. at 885.

The Klesper court explained that § 102(e) was a codification of the historical treatment of a U.S. patent disclosure “as prior art as of the filing date of the earliest U.S. application to which the patent is entitled, provided the disclosure was contained in substance in the said earliest application,” as much as it was a codification of the holding in Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390 (1926), that an earlier-filed U.S. patent application is prior art as of

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<sup>6</sup> “‘Application . . . filed’ in Section 102(e) includes the right of priority afforded by Section 120 to prior co-pending United States applications.”

the filing date of the application. Id. Indeed, in Milburn the Supreme Court acknowledged the existence of this doctrine, stating: “A new application and a claim may be based on the original description . . . and the original priority established notwithstanding intervening claims.” 270 U.S. at 402. Thus, the prior art date of a § 102(e) reference must be the filing date of the first in a succession of U.S. applications claiming priority to it.

Through 35 U.S.C. § 111(b)(8), Congress made clear that provisional applications must be treated the same as nonprovisional applications. Section 111(b)(8) provides:

The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135 and 157 of this title.

Id. Thus, § 111(b)(8) makes clear that provisional applications are to be treated like nonprovisional applications under the Patent Act unless otherwise provided. Nothing in § 111(b)(8) or § 102(e)(2) provide for different treatment of provisional applications in defining a proper § 102(e) date for a patent reference. Thus, because patents are credited with the filing date of earlier nonprovisional applications in a series of applications to which they claim priority, in accordance with § 111(b)(8) such treatment must also apply where a provisional application is



the first in a series of U.S. applications.<sup>7</sup>

When Congress enacted § 111(b) and created provisional applications, had it chosen not to allow provisional applications to provide the § 102(e) prior art date, it could have added § 102(e) to the list of enumerated sections within the Patent Act excepted from § 111(b)(8). But it did not. And it could have amended § 102(e) to expressly apply only to patents issued from § 111(a) applications. For example, Congress could have narrowed the scope of § 102(e) by amending the language “application for patent” by, for example, simply rephrasing it to read “applications for patent filed under 111(a).” Again, Congress did not impose such limitations on § 102(e). Accordingly, those limitations cannot be read into the statute.

In 1995, shortly after Congress enacted § 111(b), the USPTO first interpreted the statutes as it does today. In a Federal Register Notice containing the initial set of rules implementing 35 U.S.C. § 111(b), in response to a request for clarification on this very point, the USPTO stated:

If a patent is granted on a 35 U.S.C. 111(a) application claiming the benefit of the filing date of a provisional application, the filing date of the provisional application will be the 35 U.S.C. 102(e) prior art date. A pending application will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a 35

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<sup>7</sup> But dating back a patent reference is limited to the filing of the last provisional application, because a provisional application may not claim priority to any earlier application. 35 U.S.C. § 111(b)(7).

U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.

Changes To Implement 20-Year Patent Term and Provisional Applications, 60 FR 20195, 20206 (April 25, 1995) (Response to Comment 13).<sup>8</sup> The current language of the MPEP tracks that statement closely. MPEP § 901.04 (“Prior Art...”, “U.S. Patents”) (“the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application for subject matter that is disclosed in the provisional application”); see also MPEP § 706.02(f)(1) (“Examination Guidelines for Applying References Under 35 U.S.C. 102(e)”) (Example 2). As shown above, the USPTO’s consistent interpretation of the words of the statute is mandated by their plain meaning.<sup>9</sup>

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<sup>8</sup> At least one commentator agreed. Charles E. Van Horn, Practicalities and Potential Pitfalls When Using Provisional Patent Applications, 22 AIPLA Q. J. 259, 277-280 (1994).

<sup>9</sup> In this case, the USPTO’s interpretation of § 102(e), when read in light of procedural statutes § 119(e)(1) and § 111(b)(8), is arguably “interpretative” and, if so, entitled to Chevron deference. Cooper Technologies Co. v. Dudas, 536 F.3d 1330, 1336 (Fed. Cir. 2008) (holding that USPTO interpretations are entitled to Chevron deference where the agency merely interprets an ambiguous statute it is charged with administering, but not where the agency effects a change in the law). At least one court has defined the issue of whether a reference can claim the benefit of an earlier U.S. application as “being a question of effective date.” In re Hilmer, 359 F.2d 859, 872 (CCPA 1966). Even if Chevron deference does not apply, an agency’s construction of a statute that it is charged with administering is still subject to some deference under the standard set forth by the Supreme Court in

## **2. Pre-§102(e) and Pre-§111(b) Case Law Is Consistent With the USPTO's Interpretation**

The USPTO's interpretation of the applicable statutes is entirely consistent with Milburn and the "fundamental rule" of that case, that an applicant is entitled to a patent only if the applicant was the first to invent. 270 U.S. at 402 ("The fundamental rule we repeat is that the patentee must be the first inventor"). In Milburn, the Supreme Court applied that rule to hold that an earlier-filed U.S. patent is prior art as of the filing date of the application. That holding was later codified in the 1952 Patent Act as § 102(e). Similarly, many of the relevant cases that have issued since Milburn were also decided long before Congress first created provisional applications and chose how they should be treated. So even though Congress' enactment of § 111(b)(8) appears to answer the question posed by this case, Milburn and the cases that follow provide helpful guidance that, when viewed in light of the enactment of 35 U.S.C. § 111(b), supports the USPTO's interpretation here.

At bottom, in Milburn the Supreme Court decided that a patent reference must be effective as prior art as of the date the application was filed in the U.S.

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Skidmore v. Swift & Co., 323 U.S. 134 (1944). Under the Skidmore standard, the deference afforded an agency's interpretation depends on the agency's exercise of care, its expertise, and its "power to persuade." Structural Industries, Inc. v. U.S., 356 F.3d 1366, 1370 (Fed. Cir. 2004). For the reasons stated, the agency's rationale for its interpretation is at least persuasive, and should also pass muster under the less deferential Skidmore standard.

because “one is not the first inventor if . . . somebody else has made a complete and adequate description of the thing claimed before the earliest moment to which the alleged inventor can carry his invention back . . . .” 270 U.S. at 400 (emphasis added). In other words, “one really must be the first inventor in order to be entitled to a patent.” Id. (citing Coffin v. Ogden, 85 U.S. (18 Wall.) 120 (1873)).

Rejecting a similar challenge to the USPTO’s reliance on the filing date of a patent reference in connection with a rejection under § 103, the Supreme Court in

Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 256 (1965), aptly explained:

To adopt the result contended for by petitioners would create an area where patents are awarded for unpatentable advances in the art. We see no reason to read into § 103 a restricted definition of ‘prior art’ which would lower standards of patentability to such an extent that there might exist two patents where the Congress has plainly directed that there should be only one.

Id. at 256.

Just like § 111(a) applications, as of their filing § 111(b) provisional applications evidence that someone other than the applicant was the first to invent and has a priority right to patent that invention. Thus, while the USPTO’s interpretation of the statute ensures that one other than the first inventor will not be granted a patent on the invention claimed, consistent with the above cases, Giacomini’s interpretation of § 102(e) would create an anomalous result—someone other than the first to invent and file an

application that led to a patent also would be granted a patent.

Concerns that secret prior art is being used to reject applications are unfounded. Under § 102(e), only provisional applications that become public—as published applications (§ 102(e)(1)) or issued patents (§102(e)(2))—may be used to establish an earlier prior art date. Because their inventions are disclosed, these provisional applications do provide “the gain to the public that the patent laws mean to secure,” and that the Supreme Court in Milburn found so critical. 270 U.S. at 399. Stating that disclosure of the invention is the key, the Milburn Court noted that whether the invention is disclosed in a periodical or an earlier filed application, “[t]he invention is made public property as much in the one case as in the other.” Id. at 400-401 (emphasis added); see also, OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1402 (Fed. Cir. 1997) (“Even the ‘secret prior art’ of § 102(e) is ultimately public in the form of an issued patent before it attains prior art status”).

Milburn and cases citing it indeed justify treating a patent as prior art as of the date the application was filed based in part on the idea that the applicant has done all he or she could do by filing the application, and should not be punished by delays in the USPTO. But when it addressed this issue, this new type of U.S. application did not exist and the Milburn Court’s hands were not bound by, nor afforded the benefit of, the language now found in 35 U.S.C. § 111(b)(8) requiring

that provisional applications be treated the same as § 111(a) applications. Thus, Congress' choice in § 111(b)(8) was to require that the two types of applications be treated the same, including for purposes of § 102(e). That decision controls here. In addition, as noted above, the USPTO's interpretation is consistent with the main policy rationale underlying those cases; that in the U.S. only the first to invent is entitled to a patent, as evidenced by a U.S. application or otherwise.

**D. Giacomini Cannot Show Error in the USPTO's Interpretation**

**1. Giacomini's Interpretation of § 102(e) is Based on a Misreading of § 119(e) and the Cases Interpreting Those Two Sections**

**a. Giacomini Misinterprets the Plain Language of § 119(e)**

Giacomini argues that § 119(e) does not provide any authority for according a patent reference the benefit of a claim of priority to an earlier provisional application. Br. at 17-20. Citing In re Hilmer, 359 F.2d 859 (CCPA 1966), he argues that that 35 U.S.C. § 119 simply authorizes an applicant to claim the benefit of priority to an earlier application, but as is the case with foreign applications, cannot shift the effective prior art date of a reference. Br. at 19, 24, 33-37. Giacomini's analysis is wrong. As the case law makes clear, the key distinction is between foreign filed applications and U.S. filed applications, and § 119(e)'s treatment of provisional applications maintains that distinction.

At the time the cases *Giacomini* cites were decided, § 119 was purely limited to priority claims based on foreign filed applications. While the claims for priority in those cases happened to be based on § 119, those opinions make clear that one seeking to reject or invalidate a claim could not rely on an earlier foreign application to assign an earlier prior art date to a patent reference. In fact, they define the test for determining whether a patent reference is entitled to claim priority to an earlier application as whether that application was one “filed in the United States.” *Hilmer*, 359 F.2d at 877; *Klesper*, 397 F.2d at 885.

For example, as the CCPA explained in *Klesper*, § 102(e) was the codification of a line of precedent treating the disclosure of a U.S. patent as prior art as of the filing date of the earliest U.S. application in a series, and explaining that the reference date could not be based on a foreign filed application. *Id.* at 885. The reason provided by that court for analyzing § 102(e) without regard for a prior art reference’s claim to foreign priority (under § 119 at the time) was that “domestic and foreign filing dates stand on entirely different footings.” *Id.* (discussing *Hilmer*). Justice Holmes made the same point in *Milburn*: “The policy of the statute as to foreign inventions obviously stands on its own footing and cannot be applied to domestic affairs.” 270 U.S. at 402. Similarly, in *Hilmer*, the CCPA rejected the Board’s reliance on a foreign filed application to attribute an earlier date to the prior art patent, explaining:

We have seen that section 119 originated in 1903 and that its purpose was to grant protective priority rights so that the United States might be a participating member in the International Convention by giving reciprocal priority rights to foreign applicants with respect to the obtaining of patents. We have also seen that section 102(e) was the codification of a court-developed patent-defeating rule based on a statutory requirement that an applicant's invention must not have been previously known by others in this country. We see no such relation between these two rules of law as requires them to be read together and it is our view that section 119 should not be so read with 102(e) as to modify the express limitation of the latter to applications 'filed in the United States.'

Id. at 877 (emphasis added). Therefore, even under the very cases Giacomini cites, a reference shall be accorded the filing date of an earlier application if "filed in the United States," but that is not so for foreign applications.

While it is true that § 119 was once limited to priority claims to foreign filed applications, along with the enactment of § 111(b) in 1994, Congress amended § 119 to add subsection 119(e), and thereby enable applicants to claim priority to an earlier-filed U.S. provisional application, among other things. Uruguay Round Agreements Act, Pub. L. 103-465 (Dec. 8, 1994). Thus, while the rationale found in those cases for treating references differently depending on whether priority is based on foreign applications or based on U.S. applications still applies, and trumps any similarities Giacomini may point to, it is no longer accurate to reference § 119 as a simple shorthand test for distinguishing between a priority date and an effective prior art date.



Moreover, Giacomini's analysis is based on a misreading of § 119(e). Br. at 34. That statute does not prohibit applicants from claiming the benefit of an earlier-filed provisional application, if the applicant meets the other requirements of the statute (e.g., the later application references the provisional, and all applicable fees are paid). 35 U.S.C. §§ 119(e)(1) and (e)(2). As the USPTO correctly noted in 1995, "As long as the requirements of 35 U.S.C. 119(e) are satisfied, a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application has a 35 U.S.C. 102(e) prior art effect as of the filing date of the provisional application . . . ." Changes To Implement 20-Year Patent Term and Provisional Applications, 60 FR 20195, 20197, 20206 (April 25, 1995) (Response to Comment 14). When read together, § 102(e), § 119(e), and § 111(b)(8) impose no limitation on the number of earlier applications to which an application may claim priority, for either provisional or nonprovisional applications.

**b. Giacomini Misinterprets § 119(e) as Establishing Priority Only for Application Claims and Not Prior Art**

Pointing to the word "invention" as used in § 119(e), Giacomini argues that § 119(e) "applies only to the priority date of each claim" to avoid prior art. Br. at 20. First, Giacomini takes the language of the statute out of context. Section 119(e)(1) actually refers to "an invention disclosed in the manner provided by the

first paragraph of section 112.” That language merely requires an adequate description in the provisional of the subject matter found in the later filed nonprovisional application. See In re Scheiber, 587 F.2d 59, 62 (CCPA 1978) (interpreting the same language in § 120). In Milburn, the Supreme Court rejected a similar argument explaining that the right to claim an earlier filing date depends on whether the earlier application provides a sufficient disclosure of the invention to show that the applicant was not the first to invent, regardless of what that earlier application claims. 270 U.S. at 401-402. Moreover, given that § 120 employs the same language, under Giacomini’s theory § 120 could only be relied on for purposes of priority but not to provide an earlier effective date for a patent reference—which is clearly wrong.

**c. Giacomini’s New Matter Argument Is Unfounded**

Giacomini further argues that the USPTO’s interpretation of the statutes is “silly” because new matter can be added to a provisional application and, therefore, an applicant should not be allowed to claim priority to it. Br. at 12, 21. Giacomini’s new matter argument concerns are unfounded. As discussed above, in order to date a prior art reference back to an application to which it claims priority, that earlier application must provide § 112, first paragraph support for the

invention claimed. See e.g., Wertheim, 646 F.2d at 537;<sup>10</sup> Klesper, 397 F.2d at 885.

That is true for any type of application to which a later filed application claims the benefit of priority, regardless of the number or types of applications in the series.

In fact, in Klesper the CCPA noted that even a patent that issued from a continuation-in-part of an earlier application can be used as prior art as of the earlier date for all subject matter “carried over into it from the parent application.”

Id. Resolution of whether the subject matter relied on in a particular patent reference is supported by the provisional application is a separate matter from whether a particular type of application can provide an earlier prior art date.

## **2. Giacomini’s § 102(e) Arguments Are Based on a Misreading of That Statute and the Cases Interpreting It**

Giacomini offers three new arguments to challenge the Board’s interpretation of § 102(e). First, he argues that because § 102(e) does not refer to “provisional applications,” it cannot be read as allowing them to supply the earliest effective prior art date. Br. at 13, 26-30. Second, he argues that one who files a provisional application has not done all that he or she can to make the invention public, so such filings cannot be relied upon. Br. at 14. Third, he again argues that

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<sup>10</sup> In Wertheim, another case decided well before Congress enacted § 111(b), the Court of Customs and Patent Appeals refused to treat a reference as prior art based on the filing date of the first in a series of applications because the series included multiple continuation-in-part applications, some of which introduced new matter into the disclosure of the earlier application. Id. at 537.

provisional applications must be treated as foreign applications for purposes of determining the earliest prior art date. Br. at 15.

**a. Giacomini Misinterprets the Plain Language of § 102(e)**

Giacomini argues that because provisional applications do not issue as patents, they cannot be relied on under § 102(e), which is limited to “a patent granted on an application for patent.” Br. at 26.

Giacomini is mistaken. His argument ignores the line of cases, including Milburn, holding that the effective prior art date of a patent is the earliest application to which it is entitled to claim the benefit of priority, regardless of whether any application in the series went abandoned or issued as a patent. Milburn, 270 U.S. at 401; Klesper, 397 F.2d 882, 885 (CCPA 1968) (holding that a patent reference dated to the filing of an earlier application that became abandoned). So the issue is not as Giacomini has framed it: “Can a patent be granted on a provisional?” Br. at 27. Rather, the issue is whether a patent reference is effective as prior art as of the filing date of an earlier filed U.S. application to which it claims priority, including a provisional. The answer to that question, as explained above, is yes. Just like nonprovisional applications, the subject matter of a provisional application can ultimately issue as a patent, as Giacomini admits. Br. at 29 (explaining that a patent can issue from a provisional application that has been converted into a nonprovisional application). When it

does, the issued patent is prior art as of the provisional application's filing date.

Even though § 111(b)(8) requires the USPTO to interpret § 102(e) to apply equally to provisional and nonprovisional applications, Giacomini argues that § 111(b)(8) provides an exception for provisionals under § 102(e). Br. at 28. Parsing the statutes carefully, he argues that the “except as otherwise provided” language of § 111(b)(8), along with the fact that § 102(e) fails to mention provisional applications, means that provisional applications are excepted from § 102(e). *Id.* But section 102(e) cannot be read as precluding reliance on provisional applications to establish the effective date of a reference as much as it could be read to preclude reliance on nonprovisional applications. The statute makes no such distinction. Rather, because § 102(e) must be read to permit reliance on earlier-filed nonprovisional applications, and since § 111(b)(8) requires provisional applications to be treated the same, § 111(b)(8) demands the USPTO's present interpretation.

Giacomini argues that it is improper to rely on the filing of a provisional application because under § 111(b)(8) they are not subject to examination (§ 131). Br. at 27-28. But arguing that a provisional application is not required to have a claim or be examined is irrelevant to the question of whether a patent qualifies as prior art. Disclosure of the invention within the earlier filing is the key to whether the reference is prior art. Milburn, 270 U.S. at 401-402 (stating that reliance on the

claims is a “fiction” because the issue is whether the invention described proves that the later applicant is not entitled to a patent). Moreover, under Giacomini’s theory, only examined applications and issued patents could qualify as prior art.

**b. When Read In Context, Milburn Does Not Support Giacomini’s Interpretation**

Giacomini relies heavily on statements in Milburn regarding one rationale for treating a patent as prior art as of its filing date. Specifically, Giacomini makes much of the Supreme Court’s statements that by filing an application, the first inventor had done “all that he could to make his description public,” and that USPTO delay was the only obstacle to disclosure. Br. at 32.

First, as explained earlier, the Milburn Court’s hands were not then bound by the language now found in 35 U.S.C. § 111(b)(8), requiring that provisional applications be treated the same as § 111(a) applications. Second, the Supreme Court’s rationale in that case was not as narrow as Giacomini argues. Rather, the principal reason the Supreme Court decided to treat patents as references as of the date they were filed, was to prevent a second inventor from obtaining a patent on the invention of another where both made some efforts to patent it. Milburn, 270 U.S. at 400 (“one really must be the first inventor in order to be entitled to a patent.”); Hazeltine, 382 U.S. at 256 (to hold otherwise “would create an area where patents are awarded for unpatentable advances in the art”). The Supreme

Court even acknowledged the flaw in Giacomini's "all that he could do" argument, when it recognized that applicants often are the cause of the delay, presumably where they file broad claims that must be amended to be patentable. Milburn, 270 U.S. at 401 (stating that "amendments might be required" before the claims of the application are in condition to be allowed). And while Giacomini emphatically embraces the language in Milburn regarding the rush to the Patent Office, he fails to mention that applicants who first file § 111(b) applications have in fact won that race and their inventions do publish as applications or patents and are, therefore, made publicly available.

Other recent changes in the law further render Giacomini's "secret prior art" complaint meritless. In 1999, Congress took major steps to make patent prosecution more transparent. It amended 35 U.S.C. § 122 so that most pending applications are no longer preserved in secret until allowed. Now, applications are published after 18 months, unless the applicant requests otherwise and agrees not to file the application elsewhere. 35 U.S.C. § 122(b); BondPro Corp. v. Siemens Power Generation, Inc., 463 F.3d 702, 707 (7th Cir. 2006) (noting that patent applications used to be secret but are now published after 18 months). In BondPro, the 7th Circuit noted that one reason Congress required the publication of applications was to "disseminate the knowledge revealed in the application to the inventor community so that other inventors can build upon it [and that p]ublished

patent applications are in fact studied by inventors in the relevant field . . . .” Id. (citing Vital State Canada, Ltd. v. DreamPak, LLC, 303 F. Supp. 2d 516, 525 (D.N.J. 2003)).

**E. Teoman Discloses Every Limitation Of Representative Claim 1**

If the Court disagrees with the Board’s rejections based on Tran, then it must address the Board’s alternative rejection based on Teoman. Claim 1 is directed to a method for selecting “a resource” to be stored in a cache based on “at least occasionally greater than one” request for that resource. A133. Relying on Teoman’s disclosure of a caching method for storing all of the files in a directory after receiving at least a threshold number of requests for files within that directory, the Board found that Teoman anticipates. A11. Specifically, the Board found that, “Teoman thus teaches populating a cache with a resource (i.e., a directory) when at least *i* requests for that resource (i.e., files making up that directory) have been received . . . .” Id.

The Board properly construed the term “resource” to include a directory and the multiple files making up that directory, the entire contents of which are stored after multiple requests for certain of its contents have been received. During examination, claims are to be given their broadest reasonable interpretation, without reading limitations into the claims from the specification. In re Hyatt, 211 F.3d 1367, 1372 (Fed. Cir. 2000); In re Graves, 69 F.3d 1147, 1152 (Fed. Cir.



1995); In re Etter, 756 F.2d 852, 858 (Fed. Cir. 1985) (en banc). Because nothing in Giacomini's specification calls for an interpretation of the term "resource" inconsistent with that reached by the Board, the Board correctly upheld the rejection.

In fact, the Board's interpretation is entirely consistent with Giacomini's definition for that term as found in his specification. There, Giacomini defines the term "resource" as a bundle of information, stating: "root node . . . comprises a vast amount of information, arranged in bundles called 'resources,' that are individually addressable." A87 (ll. 16-19). While Giacomini provides examples in which he defines a resource as "a file" (in the context of the Internet, as either "a World Wide Web page, a .gif file, a Java script, etc."), he goes on to explain, "[i]t will be clear to those skilled in the art how to make and use embodiments of the present invention in which a resource is something other than a file." A87 (ll. 16-23). Thus, the Board's construction of the term "resource" as a bundle of files within a directory is consistent with the scope of that term as defined in Giacomini's own specification. Accordingly, the Board's construction is reasonable. In re Heck, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (prior art patents are not to be limited to preferred embodiments but are "relevant for all they contain"). And the Board's finding that the claim anticipates is supported by substantial evidence.

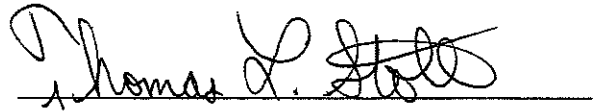
Giacomini argues that Teoman fails to teach populating the cache only when at least *i* requests are made, such that there are occasions when a resource is not stored until two or more requests are received. Br. at 38. Teoman discloses storing the entire contents of the directory after a user specified threshold number of requests for files in the directory have been made. A35 (col. 10, ll. 40-47). Thus, the entire “resource” (the directory itself) is not stored until a threshold number of requests for its contents have been made.

## **VI. CONCLUSION**

As shown above, the USPTO’s interpretations of the relevant statutes are correct as a matter of law, its constructions of the claim are reasonable, and substantial evidence supports the Board’s findings. Accordingly, the Board’s decision should be affirmed.

Respectfully submitted,

October 23, 2009

A handwritten signature in black ink, appearing to read "Raymond T. Chen", is written over a horizontal line.

RAYMOND T. CHEN  
Solicitor

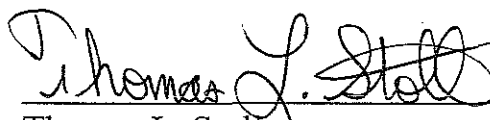
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**RULE 32(a)(7)(C) CERTIFICATE OF COMPLIANCE**

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing BRIEF FOR APPELLEE- DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing brief, excluding table of contents and table of authorities, is 8,046 words as calculated using the Word<sup>®</sup> software program.


A handwritten signature in black ink, appearing to read "Thomas L. Stoll", written over a horizontal line.

Thomas L. Stoll  
Associate Solicitor

## CERTIFICATE OF SERVICE

I certify that on October 23, 2009, I caused two copies of the foregoing  
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