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**Datasheet for the decision
of 19 November 2014**

Case Number: T 1337/12 - 3.5.05
Application Number: 05736396.2
Publication Number: 1763734
IPC: G06F3/06, H04L29/06, G06F11/14
Language of the proceedings: EN

Title of invention:

System and method for supporting block-based protocols on a virtual storage appliance executing within a physical storage appliance

Applicant:

NetApp, Inc.

Headword:

Virtual filers/NETAPP

Relevant legal provisions:

EPC Art. 84, 123(2), 111(1)

Keyword:

Clarity - main request (yes, after amendment)
Added subject-matter - main request (no, after amendment)
Remittal to the first instance for further prosecution - (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1337/12 - 3.5.05

**D E C I S I O N
of Technical Board of Appeal 3.5.05
of 19 November 2014**

Appellant: NetApp, Inc.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 17 October 2011 refusing European patent application No. 05736396.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair A. Ritzka
Members: K. Bengi-Akyuerek
F. Blumer

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division, posted on 17 October 2011, to refuse European patent application No. 05736396.2 on the grounds of lack of clarity (Article 84 EPC), added subject-matter (Article 123(2) EPC) and lack of inventive step (Article 56 EPC), having regard to the disclosure of

D1: US-A-2003/0195942,

with respect to a main request.

Moreover, an auxiliary request was not admitted into the examination proceedings under Rule 137(3) EPC on the ground that it was late-filed and not clearly allowable under Articles 123(2) and 84 EPC.

II. Notice of appeal was received on 23 December 2011. The appeal fee was paid on the same day. With the statement setting out the grounds of appeal, received on 27 February 2012, the appellant filed new claims according to a main request and three auxiliary requests. It requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main request or one of the auxiliary requests.

III. A summons to oral proceedings scheduled for 19 November 2014 was issued on 24 July 2014. In an annex to this summons, the board gave its preliminary opinion on the appeal pursuant to Article 15(1) RPBA. In particular, it raised objections under Articles 123(2), 84 and 56 EPC, having regard to D1 and the disclosures of

D2: US-A-2004/0030822 and

D3: EP-A-1 100 001.

Prior-art documents D2 and D3, cited in the present application as filed and in its International Search Report, were introduced by the board under Article 114(1) EPC into the appeal proceedings due to their relevance for the assessment of novelty and inventive step of the underlying subject-matter.

- IV. With a letter of reply dated 15 October 2014, the appellant submitted amended claims according to a new main request and three new auxiliary requests, and essentially requested, as its main request, that the decision under appeal be set aside, that the case be remitted to the examining division "for further consideration of Article 56 EPC" and that the oral proceedings be cancelled.
- V. With a fax dated 28 October 2014, the appellant was informed that the oral proceedings would take place as announced.
- VI. Oral proceedings were held as scheduled on 19 November 2014, during which the appellant filed a new main request (claims 1 to 18) in response to objections raised by the board during the oral proceedings.

The appellant's final request was that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination on the basis of the main request as filed during the oral proceedings before the board, or, subsidiarily, on the basis of the first auxiliary request, filed as "Main Request" with letter dated 15 October 2014, or on the basis of the second auxiliary request, filed as "Second Auxiliary Request"

with letter dated 15 October 2014.

At the end of the oral proceedings, the decision of the board was announced.

VII. Claim 1 of the **main request** reads as follows:

"A system for creating and maintaining block-based protocols on a virtual storage appliance executing in a physical storage appliance (100), the system comprising:

- a plurality of network resources adapted to process block-based protocols; and
- one or more vfilers (VF1, VF2, VF3), each of the one or more vfilers (VF1, VF2, VF3) being a virtual server, such as a virtual storage Appliance[sic], and comprising a logical partitioning of the network resources establishing an instance of a multi-protocol server configured to service data access requests in response to both the block-based and file-based protocols, wherein the logical partitioning of network resources includes allocating dedicated and distinct units of storage resources and network addresses to the vfilers, and each vfiler is maintained and executed independently of other vfilers on the physical storage appliance,

wherein each vfiler is provided with a vfiler context that includes information pertaining to a security domain of the vfiler and that operates to control access to the resources of the vfiler;

the system further comprising a user interface (UI) for creating a virtual disk (vdisk), for increasing or decreasing the size of a vdisk, and/or destroying a vdisk;

wherein block-based commands supported by the UI only operate within the particular vfiler context in which they are executed, and a vdisk must be created on a storage unit owned by the vfiler in whose vfiler context the command to create the vdisk was executed;

and wherein a vdisk is a special file type that emulates a disk for a storage area network (SAN) client of the system who has a storage viewpoint of blocks and disks."

The further independent claims 14 and 18 of the main request are directed to a corresponding method and computer program respectively.

Reasons for the Decision

2. The appeal is admissible.
3. MAIN REQUEST

In spite of the fact that this request was submitted during the oral proceedings before the board, i.e. at a very late stage of the overall procedure, the board admitted it into the appeal proceedings under Article 13(1) and 13(3) RPBA, since it was considered a legitimate and successful attempt to overcome the objections under Articles 123(2) and 84 EPC raised in the board's communication and at the oral proceedings, and since the board could deal with it without having to adjourn the oral proceedings.

Claim 1 of this request differs from claim 1 of the main request underlying the appealed decision, apart from minor re-wordings, substantially in that it now specifies that

- A) the logical partitioning of network resources includes allocating dedicated and distinct units of storage resources and network addresses to the vfilers (emphasis added by the board);
- B) each vfiler is provided with a vfiler context that includes information pertaining to a security domain of the vfiler and that operates to control access to the resources of the vfiler;
- C) the system further comprises a user interface for creating a vdisk, for increasing or decreasing the size of a vdisk, and/or destroying a vdisk;
- D) block-based commands supported by the user interface only operate within the particular vfiler context in which they are executed;
- E) a vdisk must be created on a storage unit owned by the vfiler in whose vfiler context the command to create the vdisk was executed;
- F) a vdisk is a special file type that emulates a disk for a storage area network client of the system who has a storage viewpoint of blocks and disks,

while the further independent claims 14 and 18 as amended recite the above features in terms of corresponding method steps.

Feature A) is based on page 13, lines 19-30 in conjunction with Fig. 3 of the application as filed. Feature B) is supported e.g. by page 14, lines 2-6 and claim 14 as filed, while feature C) is based on page 22, lines 7-11 of the original application.

Moreover, feature D) is based on page 22, lines 18-20, whilst feature E) is supported by page 24, lines 17-19. Lastly, feature F) is based on page 6, lines 3-8 of the application as filed.

3.1 Article 123(2) EPC

3.1.1 The examining division held that the former independent claims contravened Article 123(2) EPC, since the application as filed did not disclose that "logical partitioning of network resources *is* allocating dedicated and distinct units of storage resources and network addresses to the vfilers" and that "the system is adapted to modify block-based commands ... so that they become vfiler context aware" (cf. appealed decision, page 4, sections 1.2.2 and 1.2.3).

3.1.2 Following the amendments made in features A) and D), the board is satisfied that those objections are overcome and that the present independent claims do not contain subject-matter which extends beyond the content of the application as filed, in compliance with Article 123(2) EPC.

3.2 Article 84 EPC

3.2.1 The examining division held that the former independent claims were not clear, since the term "vfiler" did not have a well-known meaning in the relevant technical field, while the terms "virtual server" and "virtual storage appliance" were vague (cf. appealed decision, page 3, section 1.1.1).

However, the board takes the view that the skilled reader, based on the wording of the present independent claims, would understand that a "vfiler" is meant to be

a virtual (non-physical) server, which operates on a single physical server. Therefore, the above objection is considered unfounded.

- 3.2.2 Furthermore, the examining decision held that the phrase "a logical partitioning of the network resources establishing an instance of a multi-protocol server" of former claim 1 was not clear, since it did not specify how such a partitioning would affect the technical features of the claimed "vfilers" and in what sense an "instance of a multi-protocol server" would thereby be established, while the expression "such that each vfiler is maintained and executed independent[ly] of other vfilers on the physical storage appliance" constituted a result to be achieved (cf. appealed decision, page 3, sections 1.1.2 and 1.1.3).

The board is not convinced by this finding. Rather, the board holds that the phrase "a logical partitioning of network resources" is reasonably to be understood as assigning different network resources to different logical units within the context of the independent claims and that the phrase "establishing an instance of a server" relates to the "vfilers being a virtual server" rather than to "logical partitioning". Furthermore, independent maintenance and execution of a vfiler is considered to be a well understandable constraint of the claimed system rather than a result to be achieved. Hence, those clarity objections are likewise considered unfounded.

- 3.2.3 In addition, according to the decision under appeal, the clause "wherein the system is further adapted to modify block-based commands ... so that they become vfiler context aware", included in former claim 1 and, correspondingly, in the other previous independent

claims, constituted a result to be achieved (cf. appealed decision, page 3, section 1.1.4).

By way of the amendments made in features A) and D), this objection is considered to be remedied and thus no longer applies either (see also point 3.1 above).

3.2.4 In conclusion, the present independent claims are considered to be clear within the meaning of Article 84 EPC.

3.3 Article 52(1) EPC: Novelty and inventive step

In view of the numerous objections under Articles 84 and 123(2) EPC, the examining division was apparently not in a position to conduct a complete and detailed assessment of novelty and inventive step in respect of the then pending claim set. Rather, it stated in the decision under appeal (cf. page 4, last paragraph) that

"... the subject-matter of current claim 1 only seems to differ from the disclosure of D1 in terms of features which are not directly and unambiguously derivable from the original application ... and moreover unclear ... Amended claim 1 of the main request is therefore considered to lack an inventive step in the sense of Article 56 EPC ..."

Therefore, it comes as no surprise to the board that a conclusive assessment of inventive step with regard to the claimed subject-matter, e.g. using the "problem-solution approach", could not be carried out during the first-instance proceedings. However, following the substantial amendments made in the new main request, the above line of argument in respect of previous

claim 1 no longer applies to the newly defined subject-matter of this request.

4. *Remittal to the department of first instance*

The appellant requested that the case be remitted to the department of first instance for further examination on the basis of the main request (cf. point VI above). The board has acceded to this request, for the following reasons:

- 4.1 The amended claims according to the main request were filed for the very first time in the appeal proceedings in reaction to several objections raised in both the examination and appeal proceedings, notably under Articles 123(2) and 84 EPC. Consequently, added features A) to F) as such and their associated technical effects could not be addressed at all by the examining division in the course of the examination proceedings. Thus, the patentability of the new main request, including substantial amendments, could not be examined and decided upon by the department of first instance, nor could any complete assessment of novelty and inventive step with respect to those requests be made, in particular in view of documents D2 and D3, which were additionally introduced into the appeal proceedings by the board (cf. point III above). Even the question whether D1 still represents the closest prior art for the subject-matter of the present claims (cf. board's communication under Article 15(1) RPBA, section 3.3.1) may need to be re-assessed. The board therefore does not consider itself in a position to pass final judgment on the matter of novelty and inventive step with regard to the present main request.

4.2 In view of the above, the board has decided to set the impugned decision aside and to exercise its discretion to remit the case to the department of first instance for further prosecution under Article 111(1) EPC, on the basis of the claims of the present main request.

5. AUXILIARY REQUESTS

As the board is remitting the case to the department of first instance on the basis of the main request, it is neither necessary nor appropriate to consider the first and second auxiliary requests further.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further examination on the basis of the main request (claims 1 to 18) as filed during the oral proceedings before the board.

The Registrar:

The Chair:



K. Götz-Wein

A. Ritzka

Decision electronically authenticated