The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEREK ROBERT JAMES

Appeal No. 2001-2303
Application No. 09/029,581

HEARD: JANUARY 7, 2003

Before HAIRSTON, DIXON, and SAADAT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 8.

The disclosed invention relates to a method and apparatus for checking the consistency of an item of data in a cache database with a respective item of data in a master database by comparing a first key (e.g., a time-stamp) stored in association with the item of data in the cache database with a second key stored in association with an index entry for the respective item

of data in the master database.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

> 1. A method for checking the consistency of an item of data in a cache database with a respective item of data in a master database by comparing a first key stored in association with the item of data in the cache database with a second key stored in association with an index entry for the respective item of data in the master database.

The reference relied on by the examiner is:

Brunner et al. (Brunner) 5,550,971 Aug. 27, 1996

Claims 1 through 8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brunner.

Reference is made to the briefs (paper numbers 14 and 17) and the answer (paper number 16) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the anticipation rejection of claims 1 through 8.

According to the examiner (answer, pages 3 and 4), the claimed comparing step “is shown by the reference in the summary of the invention as essentially the same function as follows see col. 2 line 34 et seq.,” and “is an essential feature of the

cited reference."

We agree with the examiner (answer, page 4) that Brunner discloses a local cache database element 26 and a remote database element 12. Although a comparison between the data content in a cache and the data content in a master database is ordinarily performed to ensure consistency between the data in the two databases, Brunner does not, however, disclose a comparison of any type between the cache 26 and the database 12. Certainly, Brunner's silence concerning the type of comparison performed for data consistency does not mean that Brunner would have to use the comparison performed by appellant. To suggest otherwise is to fall victim to impermissible hindsight. The examiner's argument (answer, page 5) that "the applicant's invention is anticipated by the teaching of the prior art as represented in the applicant's brief" is without merit since appellant never admitted that the claimed comparison with an "index entry" was a part of the prior art. With respect to the examiner's inherency argument (answer, page 6), we agree with the appellant's argument (brief, page 10) that "any allegation that the specific comparison . . . would <u>necessarily</u> flow from the teachings of Brunner et al. is unfounded, particularly since Brunner et al. fails to provide any detail on checking data consistency."

In summary, the anticipation rejection is reversed because Brunner does not disclose "every limitation of the claimed invention, either explicitly or inherently." Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 3378 (1995).

DECISION

The decision of the examiner rejecting claims 1 through 8 under 35 U.S.C. § 102(e) is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

KWH:hh

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