

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN HALLADAY, DAVID ALLEN MAJOR, and
ROBERT B. WOOD

Appeal No. 2002-1576
Application No. 09/426,516

ON BRIEF

Before FLEMING, DIXON, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11, 13-17, 20, and 22-25.

We REVERSE.

BACKGROUND

The Appellants' invention relates to the management of virtual tape volumes using data page atomic units. An understanding of the invention can be derived from a reading of exemplary claim 11, which is reproduced below.

11. An intelligent data storage manager operational in a virtual data storage system that uses a plurality of high and low performance data storage elements to store data thereon for at least one host processor connected to the virtual data storage system, the intelligent data storage manager comprising:

a host interface for receiving a virtual tape volume having a plurality of virtual tape blocks from a host processor; and

a controller for sequentially segmenting the virtual tape volume into data pages, wherein each data page includes at least one virtual tape block of the virtual tape volume, wherein the controller generates a meta data page associated with the virtual tape volume to map the data pages to the respective virtual tape blocks of the virtual tape volume, wherein the controller uses the meta data page to selectively store the data pages onto the high and low performance data storage elements;

wherein each of the high and low performance data storage elements has a partitioning configuration, wherein the amount of the at least one virtual tape block included by each data page is a function of the partitioning configuration of at least one of the high and low performance data storage elements.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Allen et al. (Allen)

5,546,557

Aug. 13, 1996

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Claims 11, 13-17, 20, and 22-25 stand rejected under 35 U.S.C. § 102 as being anticipated by Allen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Nov. 30, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 10, filed Sep. 17, 2001) and reply brief (Paper No. 12, filed Feb. 12, 2002) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In determining novelty, the first inquiry must be into exactly what the claims define. **In re Wilder**, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). A patent is invalid for anticipation when the same device or method, having all of the elements contained in the claim limitations, is described in a single prior art reference.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); **Perkin-Elmer Corp. v. Computervision Corp.**, 732 F.2d 888, 894, 221

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USPQ 669, 673 (Fed. Cir. 1984). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. **See In re Spada**, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); **Diversitech Corp. v. Century Steps, Inc.**, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). To the extent that the rejection may be based on the principles of inherency, we note that our reviewing court has set out clear standards for a showing of inherency, which have not been attained in the instant case. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." **In re Robertson**, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

We are persuaded by appellants that the Section 102 rejection of each claim on appeal is in error. We thus do not sustain the rejection of claims 11, 13-17, 20, and 22-25 under 35 U.S.C. § 102 as being anticipated by Allen.

Appellants argue that the claimed invention recites the use of a meta data page to selectively store data pages and that the meta data page is associated with the virtual tape volume. (See brief at pages 6-7.) Appellants further argue that Allen does

not teach or suggest using marks or meta data page to selectively store segmented data onto a data storage element as a function of the partitioning configuration of a storage element. (See brief at page 7.)

The examiner maintains that Allen at columns 11-12 teaches the segmenting, partitioning and generating meta data pages. (See answer at page 4.) The examiner further maintains that the Volume identification and the Variable Partition Mark have information bearing signals and that these data elements with a volume of data would have been the meta data page. (See answer at pages 6-7.) We disagree with the examiner and do not find that the examiner has established a *prima facie* case of anticipation of the claimed invention.

We find no teaching of "the controller generates a meta data page associated with the virtual tape volume to map the data pages to the respective virtual tape blocks of the virtual tape volume, wherein the controller uses the meta data page to selectively store the data pages onto the high and low performance data storage elements." While the examiner maintains that Allen stores information with each volume and that also relates to partitions, we do not find that this information would be a meta data page to map the data pages to the virtual tape blocks of the virtual tape volume. (Specification at page 9, lines 9-10 and independent claim 11.) Since we find that the examiner has

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not established a *prima facie* case of anticipation of the invention claimed in independent claims 11 and 17, we cannot sustain the rejection of independent claims 11 and 17 and their dependent claims 13-16, 20 and 22-25.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11, 13-17, 20 and 22-25 under 35 U.S.C. § 102 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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