

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY L. PHILLIPS ET AL.

Appeal No. 2003-0302
Application 09/107,539

ON BRIEF

Before HAIRSTON, RUGGIERO, and LEVY, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 36.

The disclosed invention relates to a method and system for moving data between a first storage unit and a second storage

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unit under the command of a host, but without passing the data through the host.

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

1. A computer system comprising:

a first storage unit;

a storage area network coupled to the first storage unit;

a second storage unit;

an intelligent controller coupled to the storage area network and to the second storage unit, the intelligent controller controlling both the first storage unit and the second storage unit; and

a host coupled to the storage area network comprising an application module for generating and transmitting a command to the intelligent controller,

where the intelligent controller, in response to the command, transfers data, under the autonomous control of the intelligent controller, between the first storage unit and the second storage unit through the storage area network while bypassing the host.

The references relied on by the examiner are:

Blickenstaff et al. (Blickenstaff)	5,537,585	July 16, 1996
Chin et al. (Chin)	6,000,020	Dec. 7, 1999
		(filed Apr. 1, 1997)
Yanai et al. (Yanai)	6,173,377	Jan. 9, 2001
		(effective filing date May 28, 1996)

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Claims 1 through 6, 9 through 13, 17, 21 through 23, 25 through 27, 30, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chin in view Yanai.

Claims 7, 8, 14 through 16, 18 through 20, 24, 28, 29, 32 and 34 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chin in view of Yanai and Blickenstaff.

Reference is made to the briefs (paper numbers 20 and 22) and the answer (paper number 21) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejections of claims 1 through 36.

In the alternative embodiment of Chin (i.e., Figure 12), a single transaction processor 1210 performs the function of a host, and controls data flow between a storage unit 12, 14 in a primary loop 10 and another storage unit 32, 34 in a secondary loop 26. A first parallel processor 1216 and a second parallel processor are provided for control of the primary loop 10 and the secondary loop 26, respectively.

The examiner acknowledges (answer, page 4) that "Chin does not specifically teach bypassing the host while transferring data

between the first and second storage unit through the storage area network as recited in the claims." For such a teaching, the examiner turns to Yanai which discloses "the use of storage area network to transfer data between a first and second storage unit while bypassing the host [Col. 2, Lines 39-45]" (answer, page 4). Based upon the teachings of Yanai, the examiner is of the opinion (answer, page 4) that:

It would have been obvious to one of ordinary skill in the art, having the teachings of Chin and Yanai before him at the time the invention was made, to modify the system of Chin to include using a storage area network to transfer data between a first and second storage unit while bypassing the host as taught by Yanai because (1) it would have improved system performance by permitting one data storage system to read or write data to or from the other data storage system; (2) it would have improved system performance by releasing the host of the burden of writing the data to a secondary storage system as taught by Yanai (3) it would have increased system performance by increasing available host bus bandwidth or by minimizing bus contention.

Appellants argue (reply brief, pages 1, 3 and 4) that the examiner has failed "to state a proper motivation for the combination of the Chin and Yanai references under 35 U.S.C. § 103 and to support that motivation with proper evidence, as required by governing law, such as *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)," and that "[e]ven if the combination of Chin and Yanai is legally proper, the resulting combination does not

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render the Appellant's [sic, Appellants'] claims obvious" because "each independent claim (1, 21 and 31) recites that: (1) a host transmits a command to the intelligent controller to initiate the transfer of data from a first storage unit to a second storage unit, and (2) the intelligent controller then transfers the data as commanded by the host while bypassing the host."

In view of the clearly stated advantage noted by Yanai (column 2, lines 22 through 45) for bypassing a host when transferring data from one storage system to another, we disagree with the appellants' argument that the examiner has not provided sufficient motivation to justify the modification of the Chin system with the teachings of Yanai. On the other hand, we agree with the appellants' argument that the modified teachings of Chin do not render the claims obvious because the bypassed host in Chin cannot issue "a command" to transfer data between the first and second storage units. If the host is bypassed for one purpose, then it is bypassed for all other purposes. To state otherwise, would invite impermissible hindsight into the obviousness determination. We respectfully decline to use the appellants' disclosed and claimed teachings against them.

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In summary, the obviousness rejection of claims 1 through 6, 9 through 13, 17, 21 through 23, 25 through 27, 30, 31 and 33 is reversed.

The obviousness rejection of claims 7, 8, 14 through 16, 18 through 20, 24, 28, 29, 32 and 34 is reversed because the teachings of Blickenstaff fail to cure the noted shortcoming in the teachings of Chin and Yanai.

DECISION

The decision of the examiner rejecting claims 1 through 36 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
STUART S. LEVY)	
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