

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN A. PAPIERNIAK
and LUO-JEN CHIANG

Appeal No. 2003-0342
Application 09/040,919

ON BRIEF

Before JERRY SMITH, BARRY and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 2 and 4-13, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for permitting an optical disk to be used as a primary server in a network. Information and software from a server in the network is copied to the optical disk. The copied software configures the disk to function as a primary server so that a user can access information at the server without directly accessing the server.

Representative claim 1 is reproduced as follows:

1. A method for using an optical disk as a primary server in a network, reducing network access time and traffic, comprising the steps of:

placing at least one optical disk in at least one device;

connecting the at least one device to the network;

copying information and software from a server in the network to the at least one optical disk;

accessing said software stored on the at least one optical disk by the at least one device to configure the at least one device for functioning as a primary server, and for properly accessing said information stored on the at least one optical disk; and

accessing, by a user, said information stored on the optical disk without directly accessing the server.

The examiner relies on the following references:

Griffin et al. (Griffin)	5,005,122	Apr. 02, 1991
Cook	5,860,068	Jan. 12, 1999
		(filed Dec. 04, 1997)

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J. Postel, RFC 0881, "The Domain Names Plan and Schedule,"
<http://rfe.fh-koeln.de/rfc/html/rfc0881>, pages 1-10 (Postel).

Ron Gustavson, "Marketscape's WebCD Pro Publisher," Emedia
Professional, December 1997, pages 1-4.

Claims 1, 2 and 4-13 stand rejected under 35 U.S.C.
§ 103(a). As evidence of obviousness the examiner offers
Gustavson in view of Griffin with respect to claims 1, 4-9 and
12, Gustavson in view of Griffin and Postel with respect to claim
13, and Gustavson in view of Griffin and Cook with respect to
claims 2, 10 and 11.

Rather than repeat the arguments of appellants or the
examiner, we make reference to the briefs and the answer for the
respective details thereof.

OPINION

We have carefully considered the subject matter on
appeal, the rejections advanced by the examiner and the evidence
of obviousness relied upon by the examiner as support for the
rejections. We have, likewise, reviewed and taken into
consideration, in reaching our decision, the appellants'
arguments set forth in the briefs along with the examiner's
rationale in support of the rejections and arguments in rebuttal
set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

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Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 4-9 and 12 based on Gustavson and Griffin. Independent claims 1, 7 and 12 stand or fall together [brief, page 7], and we will consider claim 1 to be the representative claim for this group. The examiner essentially finds that Gustavson teaches the claimed invention except that Gustavson does not teach that information

and software is copied directly from the network server as claimed. The examiner takes "Official Notice" that copying software from a server was well known in the art and cites Griffin as supporting evidence. The examiner finds that it would have been obvious to the artisan to incorporate the well known software distribution technique to distribute software to a device in a network and transfer the software to an optical disk as is done in creating Gustavson's WebCD. The examiner finds that the proposed combination would be faster, cheaper and would reduce damage [answer, pages 4-6].

Appellants argue that the examiner's rationale for the proposed combination of Gustavson and Griffin is inadequate. Specifically, appellants argue that the examiner's motivation fails to explain how the WebCD program would have benefited from distributing downloaded software in addition to web contents. Appellants also argue that the combined teachings of Gustavson and Griffin would still fail to teach the step of accessing the software which was downloaded from the server for configuring the Web-on-CD device accommodating the optical disk as a primary server, and allowing the information which was also previously downloaded from the server to be properly accessible. Specifically, appellants argue that the setup files would not be

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downloaded from a server together with the web contents, but instead, would be created locally by the Publisher component of Web-on-CD. Appellants note that there is no need to copy configuring software in Gustavson because the setup files are created locally in Gustavson [brief, pages 10-11].

The examiner responds that an artisan would have been motivated to copy software from a network server because it would reduce the time for acquiring the software by some other means. The examiner also responds that it would have been obvious to the artisan to either directly download software onto the optical disk as in appellants' invention or to indirectly download software onto the optical disk as is done in Gustavson [answer, pages 9-16].

Appellants respond that the setup software is created locally in Gustavson and is not downloaded from a network server. Appellants also respond that the examiner's rationale still lacks an appropriate suggestion or motivation to modify Gustavson [reply brief].

We will not sustain the rejection of independent claims 1, 7 and 12 for essentially the reasons argued by appellants in the briefs. Initially, we wish to make it clear that we agree with the examiner that it was well known in the art to download

software from a network server. Claim 1, however, requires that the software which is downloaded from the network server be accessed for the specific purpose of configuring a device to function as a primary server which access the information on the disk which was also downloaded from the network server. The problem with the examiner's rejection is that it fails to consider the fact that the configuring software in Gustavson is either already available at the local device or is placed on the optical disk by the distributor. Thus, the examiner's proffered rationales of faster, cheaper and less damage are irrelevant because the software to be downloaded is already available in Gustavson without any download at all. It is also clear that since Gustavson relates to a software distributor and not to a network of users, there is no suggestion that the configuring software be downloaded from a network server along with the information at the network site.

In summary, the examiner has acknowledged that the combined teachings of Gustavson and Griffin fail to teach the step of copying both software and information from a network server in which the software is used to configure a device as a primary server. We have found that the examiner's argument that it would have been obvious to the artisan to download the

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software in Gustavson is unsupported by the teachings of the applied prior art because the configuring software in Gustavson is either already at the local device or has been placed on the disk by the distributor. Therefore, there is no support on this record for the examiner's position.

Since we have not sustained the examiner's rejection of independent claims 1, 7 and 12, we also do not sustain the rejection with respect to any of the claims which depend therefrom. We note that the additional teachings of Postel and Cook fail to overcome the deficiencies in the combination of Gustavson and Griffin discussed above.

In conclusion, we have not sustained the examiner's rejection of any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2 and 4-13 is reversed.

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REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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LANCE LEONARD BARRY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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STUART S. LEVY)	
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