

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL LEAK

Appeal No. 2003-1473
Application No. 09/336,649¹

ON BRIEF

Before KRASS, BARRY, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-8, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to a method and system for management of multiple storage devices coupled to a common small

¹ Application for patent filed June 18, 1999.

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We make reference to the answer (Paper No. 13, mailed December 17, 2002) for the Examiner's reasoning, and to the appeal brief (Paper No. 12, filed November 20, 2002) for Appellant's arguments thereagainst.

OPINION

In rejecting the claims, the Examiner asserts that each of the SCSI switches of IBM TDB, between the two sections of the bus connecting devices 1-6, is the same as the claimed repeater (answer, page 4). However, the examiner acknowledges that IBM TDB does not teach the step of automatically altering the SCSI ID of each SCSI device on the second bus in response to the enabling of the repeater and relies on Pascarella for disclosing selectively interconnecting host buses and automatically altering the SCSI device IDs (id.).

Appellant argues that the claimed term "repeater," as discussed on page 3 of the specification, is intended as a device "capable of picking up a signal, from a host, and reproducing the signal to provide an enhanced signal for devices on the bus (brief, page 4). Appellant specifically argues that the switches disclosed in IBM TDB are not repeaters since they do not reproduce a signal and are merely for opening and closing the

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connection and establishing a conductive path for the signal (brief, page 5).

In response, the Examiner argues that the claims do not recite the features that may be present in the definition of "repeater" (answer, page 7). The Examiner further asserts that the SCSI bus switches J-M of IBM TDB and the SCSI duplex-ready logic 42 of Pascarella are indeed repeaters because they repeat the signals of the first SCSI host (answer, page 8).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re

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Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). However, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

We find ourselves in agreement with Appellant that the combination of the references does not teach or suggest the claimed subject matter since the switch taught in IBM TDB is not the same as the recited repeater. IBM TDB, in fact, configures three devices on a bus communicating with each initiator wherein a switch merely connects the three devices (3,5,7) on one bus to another bus which has its own three devices (2,4,6) in case one of the initiators fails (page 343). Thus, the degraded bus mode will have a total of six devices (2-7), each having its own identification, that are connected to one initiator (id.). Contrary to the Examiner's assertion (answer, page 7), giving the ordinary meaning of the term "repeater" to the claimed term is not the same as reading limitations from the specification into the claims. A repeater, as disclosed by Appellant (specification, page 3), reproduces the signal on the next section of a cable and is different from a switch which merely

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connects or isolates two buses when closed or opened.² However, the switches of IBM TDB merely connect and disconnect buses in order to isolate devices connected to each initiator or connect all the devices to one initiator in case of failure of the other initiator.

We also note that the Examiner, for the first time in page 8 of the answer, characterizes the SCSI duplex-ready logic 42 of Pascarella as the claimed "repeater" and reasons that element 42 repeats all the signals of the first bus and uses switches 50 (Figures 13 and 14) for reproducing the signal. Although Appellant chose not to file a reply brief in order to address this point, it is imperative that we clarify whether the Examiner's position supports a prima facie case of obviousness. Pascarella, in col. 2, lines 24-34, discloses:

To enable a SCSI simplex mode, the bus switches are closed and the set or sets of terminators are selectively disabled and/or enabled. A primary SCSI bus and a secondary SCSI bus thereby form a single electrical bus.

If a primary SCSI cable and a secondary SCSI cable are present, the duplex-ready logic controller enables a SCSI duplex mode. To enable a SCSI duplex mode, the bus switches are opened and the terminators are selectively enabled and/or disabled. The primary SCSI bus and secondary SCSI bus thereby are electrically separate busses.
[Emphasis added.]

² To show a repeater in rejecting the claims, the Examiner should have probably considered the three references (specification, page 3, lines 8-10) cited by Appellant as examples of bus repeaters.

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Additionally, the primary and the secondary buses 17 and 19 are joined as a single bus in the simplex mode when switches 50 are closed (col. 9, lines 8-12 and Figure 13) whereas the buses are physically and electrically separate in the duplex mode when switches 50 are open (col. 9, lines 17-20 and Figure 14).

Therefore, logic 42 control the number of available channels by switching between a simplex and a duplex mode, at best, by connecting and disconnecting the primary and the secondary buses 17 and 19. This is also a switching function instead of what Appellant has described as reproducing the signal on the next section of a cable representing the function of a repeater.

Thus, assuming, arguendo, that it would have been obvious to combine IBM TDB with Pascarella, as held by the Examiner, the switches that connect and disconnect the two buses would still be different from the claimed repeater imposed between the first and the second buses. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of claims 1-8 over the combination of IBM TDB with Pascarella.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-8 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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LSI Logic Corporation
1621 Barber Lane
MS: D-106 Legal
Milpitas, CA 95035