

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL PHILLIP GUSLER, RICK A. HAMILTON, II,
and STEPHANIE E. WOODS

Appeal No. 2003-1515
Application No. 09/364,014

ON BRIEF

Before RUGGIERO, GROSS 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 1-30, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to a method and system for providing standardized methodology for assessing a system's health and making appropriate recommendation. According to Appellants, depending on the type of the performed test and the

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assigned risk level, various courses of action can be recommended in order to reduce the risk to the system (Specification, page 13).

Representative independent claim 1 is reproduced below:

1. A methodology for performing a risk assessment for providing standardized and accurate risk indications for a computing system, comprising:

executing a first sub-system risk test on a system, wherein the first sub-system risk test on the system is specific to the first sub-system;

receiving an output in response to executing the sub-system risk test;

categorizing the output from a plurality of risk categories;

assessing a first risk level with the risk category of the output; and

determining sub-system action based on the first sub-system risk test and the first risk level.

The Examiner relies on the following references in rejecting the claims:

Hill et al. (Hill)	5,047,977	Sep. 10, 1991
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Skeie	5,500,940	Mar. 19, 1996
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Claims 1-9, 11-22 and 24-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Skeie.

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Skeie in view of Hill.

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We make reference to the final Office action (Paper No. 6, mailed June 27, 2002) and the answer (Paper No. 11, mailed January 28, 2003) for the Examiner's reasoning, and to the brief (Paper No. 10, filed November 25, 2002) and the reply brief (Paper No. 12, filed March 28, 2003) for Appellants' arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 102 rejection of claims 1-9, 11-22 and 24-30, the main point of contention is whether assessing the criticality of a failure, as disclosed by Skeie, is equivalent to assessing a risk level, as recited in the claims. The Examiner generally argues that assessing the criticality of a failure is the same as assessing a risk level whereas Appellants direct their arguments to the contrast between assessing a risk level prior to failure and evaluating the effect of an existing failure on the other systems. Furthermore, Appellants assert that the Examiner ignores the fact that the claimed sub-system risk test is not just determining some risk information, but requires subjecting the sub-system to a "test"¹ in order to establish a risk (reply brief, page 3).

¹ Appellants rely on a dictionary definition of the term "test" as a procedure intended to establish the quality, performance, or reliability of something.

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We agree with Appellants that the claim does require that the level of risk associated with the sub-system be measured by a risk test which, in effect, is subjecting the sub-system to a test or procedure for establishing the risk. Although the claim does not recite executing the risk test whether or not a failure occurs, as argued by the Examiner (answer, page 5), the step of executing a sub-system risk test, as correctly defined by Appellants, does clearly require that the system be subjected to a procedure for evaluating risk.

Having established the meaning of the claimed term, we now address the arguments related to the teachings of the reference relied on by the Examiner. Initially, it is noted that a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). See also Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

We observe that Skeie relates to a method for analyzing a storage system and how partial or full failure of one component adversely affects the system operation and notifying the user of the component failure, its criticality and its effect on data

availability (col. 2, lines 52-58). In particular, a level of criticality is assigned once a failure is detected (col. 6, lines 8-10), which maps the causal effect of a failed component with respect to the system usability (col. 6, lines 40-43).

Therefore, since the analysis is performed in response to a component failure and based on the failure itself, we agree with Appellants (reply brief, page 3) that Skeie determines risk solely based on detecting a failure instead of executing a risk test. The Examiner's characterization (answer, page 5) of risk as the possibility of harm or loss notwithstanding, the difference is in the process of determining the risk. Skeie predicts risk based on detecting a failure instead of executing a risk test which has nothing to do with a component failure.

Skeie further describes the way risk of complete inoperability, the likelihood of additional failure and reduction of data availability may be predicted (col. 7, lines 4-10), which the Examiner characterizes as predicting the risk of the system failure (answer, page 7). However, we find ourselves in agreement with Appellants' argument that neither the failed component nor any related components of Skeie are subjected to a test to assess risk (reply brief, page 4). In fact, as correctly pointed out by Appellants (id.), Skeie uses look-up tables of

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various risks and probabilities or complex equations and functions to perform such analysis (col. 7, lines 10-12).

In view of the discussion above, we find that the claimed step of "executing a first sub-system risk test," as recited in the independent claims, is absent in the method for evaluating failure in a storage system of Skeie. Accordingly, since the Examiner has failed to meet the burden of providing a prima facie case of anticipation, the 35 U.S.C. § 102 rejection of claims claim 1-9, 11-22 and 24-30 over Skeie cannot be sustained.

Turning now to the 35 U.S.C. § 103 rejection of claims 10 and 23, we note that the Examiner further relies on Hill for teaching the step of logging the results (final, page 7). However, similar to Skeie, Hill provides no teaching related to executing a risk test and therefore, cannot overcome the deficiencies of Skeie discussed above. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 10 and 23 over Skeie and Hill.

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CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 1-9, 11-22 and 24-30 under 35 U.S.C. § 102 and claims 10 and 23 under 35 U.S.C. § 103 is reversed.

REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
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