

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL M. GOSHEY,
GUIDO MAFFEZZONI,
and KRISTINE N. LUONG

Appeal No. 2004-0933
Application 09/256,680¹

ON BRIEF

Before BARRETT, RUGGIERO, and NAPPI, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 23, 1999, entitled "Method of Finding Application Components in an Intelligent Backup and Restoring System," which is a continuation-in-part of Application 09/11,783, filed July 6, 1998, now U.S. Patent 6,205,527, and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/075,687, filed February 24, 1998.

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We refer to the final rejection (Paper No. 10) (pages referred to as "FR__") and the examiner's answer (Paper No. 15) for a statement of the examiner's rejection, and to the appeal brief (Paper No. 14) (pages referred to as "Br__") and reply brief (Paper No. 16) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

The examiner errs in stating the claims stand or fall together

Appellants identify the following groups of claims, where the claims within each group stand or fall together (Br3):

- Group I - claims 1-3, 6-9, 12-17, 20, and 21
- Group II - claims 4, 10, and 18
- Group III - claims 5, 11, and 19

The examiner states that claims 1-21 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together (EA2) and that appellants have elected to rely on the discussion of claim 1 to contend that claims 2-21 are patentable (EA6). This is error. As noted by appellants (RBr1-2), appellants have expressly grouped the claims into three groups and have made arguments why the claims in each group are separately patentable. However, since we reverse the rejection of the independent claims in

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Group I, it is not necessary to remand the application for consideration of the dependent claims in Groups II and III.

The claims are not anticipated

Claim 1 is taken as representative of Group I. We address the limitations one at a time.

The examiner finds that "Pongracz discloses the invention including a method and apparatus for identifying back up files for restoring a file in a transactional system (abstract, lines 1-2 et seq)" (FR2).

Appellants argue that the claimed invention is directed towards a method for finding application components installed on a computer system for use in a backup system, not identifying backup files that will be used to restore a file (Br4).

We do not find where the examiner addresses this argument. The examiner has not explained how identifying backup files is the same thing as "finding application components installed on a computer system for use in a backup system" in the preamble of claim 1, i.e., finding application components to be backed up is not seen to be the same as identifying backup files. Backup files are not application components and, even if the backup files are backups of application components, the backup files are not necessarily installed on computer system but could be stored.

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The fact that Pongracz describes a backup system does not imply that it is doing the same thing as the claims. Nevertheless, we proceed to the limitations in the body of claim 1.

The examiner finds that Pongracz teaches the claim step of "creating a linked list of application components installed on the computer system" at column 4, lines 23-36 et seq. (FR2).

Appellants argue that this portion of Pongracz "does not, directly or indirectly, mention a linked list, the creation of a linked list, or application components" (Br5). It is argued that Pongracz does not disclose creating a linked list of application components installed on the computer system (Br5). It is argued that Pongracz makes a list of backup files corresponding to the filename of the requested file, but does not create a linked list of application components installed on a computer (Br6). Appellants argue that Pongracz uses reset stamps to identify the backup files and not a linked list of application components and other features in the claims (Br6).

The examiner responds that (EA4):

As noted by Appellants in the Appeal Brief, Pongracz' list of files includes all files pertaining to a requested filename or application including all components of said requested filename or application. Thus, as conceded by Appellants, by disclosing a list of all files or components related to the requested application, Pongracz implicitly teaches the retrieval of a list of components of the requested application.

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Appellants argue that the examiner misrepresents their remarks about Pongracz by omitting the word "backup" used in the brief, "thus leading the Board to believe that Appellants in fact believe or 'concede' that Pongracz discloses the creation of a list of all files or components of an application" (RBr2). It is argued that appellants' position is exactly the opposite and the list of backup files in Pongracz is not equivalent to a linked list of application components (RBr3).

We agree that appellants never said that Pongracz disclosed creation of a list of all files or components of an application. Appellants only stated that Pongracz makes a list of backup files corresponding to a requested filename. In the examiner's first sentence above, there is only support for the following statement (additions underlined and deletions in brackets]: "As noted by Appellants in the Appeal Brief, Pongracz' list of files includes all backup files pertaining to a requested filename [or application including all components of said requested filename or application]." We find no support for the examiner's second sentence. The examiner misapprehends appellants' arguments.

The examiner also notes that Pongracz teaches a linked list of reset stamps, where the reset stamps are used to identify the backup files associated with a requested filename or application

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in the order provided by the linked list (EA5). The examiner finds that upon receiving a request "for an application or a filename, a reset stamp identifier module (260) uses a linked list of reset stamps to retrieve all backup files including all components of said requested application" (EA5). The examiner refers to column 8, lines 20-36 (EA5).

Appellants reply that it is not understood on what basis the examiner asserts that building a linked list of reset stamps in conjunction with the file list builder module and the linked list identifier module leads to the creation of a linked list of application components installed in a computer (RBr4).

We find that Pongracz does not disclose "creating a linked list of application components installed on the computer system." Pongracz discloses creating a list of backup files, not a list of application components installed on the computer system. Moreover, the list is not a linked list. The portion of Pongracz originally cited for a linked list does not mention a linked list and the examiner changes the portion relied on in the answer. The only linked list mentioned in Pongracz is the linked list of reset stamps at column 3, lines 17-19, and column 8, lines 25-28. A reset stamp is a unique identifier created by coupling the current value of the transaction counter with the integer

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representation of the current system date and time (col. 2, lines 56-59. The reset stamp is not an application component. Thus, Pongracz does not teach the first step of claim 1.

The examiner finds that Pongracz teaches "tracing back nested directories to find a target directory for each application component in the linked list" at column 8, lines 25-28 et seq. (FR2).

Appellants argue this passage teaches tracking reset stamps using a linked list of reset stamps, and makes no mention of the use of a linked list of application components (Br6-7). It is argued that "[t]he passage relied upon by the Examiner does not mention directories, nested directories, a target directory, application components, application components in a linked list, or the tracing of nested directories" (Br7) and that the examiner has failed to provide any explanation of how tracking of reset stamps using a linked list meets the limitation or how reset stamps have any correlation with directories and application components (Br7).

The examiner responds (EA5-6):

It is submitted that such teaching of searching or tracing directories to find files pertaining to a requested application is implicit and inherent from the cited textual portions of Pongracz. . . . Further, it goes without saying that in order to retrieve all files pertaining to a requested application, the cited storages must be searched

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and traced in the order prescribed by the linked list of reset stamps. Consequently, such searching must involve the tracing of all directories and subdirectories, where the files are stored. Thus, Pongracz does disclose the limitation of tracing directories to find each application in the linked list, as broadly claimed.

Appellants reply that the examiner errs in asserting that tracing back nested directories is implicit and inherent (RBr4).

An inherent property must necessarily be present, and it must be so recognized by persons of ordinary skill in the art. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). We have already found that Pongracz does not teach "a linked list of application components installed on the computer system" and, therefore, necessarily would not teach "tracing back nested directories to find a target directory for each application component in the linked list." Assuming Pongracz did teach a linked list of application components (although it is not apparent how this would fit in with the Pongracz backup system) and assuming that it is probable that the computer system in Pongracz uses directories and nested

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directories (since we are unaware of any modern computer system that does not), there is simply no evidence or reason to believe Pongracz would trace back nested directories to find a target directory. Pongracz makes no mention of directories, nested directories, or target directories for applications or filenames. Even if Pongracz taught a need for finding target directories, the examiner has not shown that tracing nested directories is the only available method. The examiner's finding of inherency is without factual basis. Thus, Pongracz does not teach the second step of claim 1.

We find that Pongracz does not teach "creating a linked list of application components installed on the computer system" and "tracing back nested directories to find a target directory for each application component in the linked list" as recited in claim 1. Therefore, it is not necessary to address the last limitation of "receiving a request to find a selected application from a calling module." The rejection of claim 1 and its dependent claims 2-8 is reversed. Independent claim 9 contains the same limitations of claim 1 plus additional limitations. Therefore, the rejection of claim 9 and its dependent claims 10-14 must also be reversed. Independent claim 15 recites a computer readable media containing program instructions for

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performing the steps of claim 1. Therefore, the rejection of claim 15 and its dependent claims 16-21 must also be reversed. In summary, the rejection of claims 1-21 is reversed.

REVERSED

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| LEE E. BARRETT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
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| Administrative Patent Judge |) | AND |
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