

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte PAUL M. BOBER, URESH VAHALIA,  
AJU JOHN, JEFFREY L. ALEXANDER, and  
UDAY K. GUPTA

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Appeal No. 2004-1899  
Application No. 09/608,469

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ON BRIEF

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Before JERRY SMITH, RUGGIERO, and SAADAT, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1-5, 24-28, and 45-49. Claims 6-23, 29-44, and 50-65 have been allowed.

The claimed invention relates to the migration of a file system from a source file server to a target file server in a data network while permitting clients to have concurrent read/write access to the file system. In order to transfer the file system from the source file server to the target file server, the target server issues directory and file read requests to the source file server in accordance with a network file access

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protocol. Concurrently with the file transfer, the target file server responds to client read/write requests for access to the file system.

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

1. A method of migrating a file system from a source file server to a target file server in a data network while permitting clients to have concurrent read/write access to the file system, said method comprising:

the target file server issuing directory read requests and file read requests to the source file server in accordance with a network file access protocol to transfer the file system from the source file server to the target file server, and

concurrent with the transfer of the file system from the source file server to the target file server, the target file server responding to client read/write requests for access to the file system.

The Examiner relies on the following prior art:

Marsland	5,923,878	Jul. 13, 1999
Beeler, Jr. (Beeler)	5,974,563	Oct. 26, 1999
Rao	6,078,929	Jun. 20, 2000

Claims 1, 3, 24, 26-28, 45, and 47-49 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Beeler. In rejections under 35 U.S.C. § 103(a), the Examiner rejects claim 2 as being unpatentable over Beeler in view of Rao, and rejects claims 4, 5, 25, and 46 as being unpatentable over Beeler in view of Marsland.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

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<sup>1</sup> The Appeal Brief (Supplemental) was filed October 7, 2003 (Paper No. 14). In response to the Examiner's Answer dated December 29, 2003, (Paper No. 15), a Reply Brief was filed February 11, 2004 (Paper No. 16), which was acknowledged and entered by the Examiner as indicated in the communication dated May 21, 2004 (Paper No. 18).

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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.

It is our view, after consideration of the record before us, that the Beeler reference does not fully meet the invention as set forth in claims 1, 3, 24, 26-28, 45, and 47-49. With respect to the Examiner's obviousness rejection, we are also of the view 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 recited in claims 2, 4, 5, 25, and 46. Accordingly, we reverse.

We consider first the rejection of claims 1, 3, 24, 26-28, 45, and 47-49 under 35 U.S.C. § 102(e) as being anticipated by Beeler. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock,

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Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to the appealed independent claims 1, 24, and 45, the Examiner attempts to read the various limitations on the disclosure of Beeler. In particular, the Examiner directs attention to Beeler's Figures 1 and 9 along with the accompanying description at columns 3, 10, and 11 of Beeler.

Appellants' arguments in response assert a failure of Beeler to disclose every limitation in independent claims 1, 24, and 45 as is required to support a rejection based on anticipation. In the arguments appearing at pages 8 and 10 of the Brief and page 2 of the Reply brief, Appellants' assertions focus on the contention that, in contrast to the claimed invention, Beeler does not disclose that a target server (appealed claim 1) or a network file server (appealed claims 24 and 45) provides client access to the file system concurrently with file system migration from a source server to the target or network server.

After reviewing the Beeler reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Briefs. Our interpretation of the disclosure of Beeler coincides with that of Appellants, i.e., during file transfer, client access to the file system for read/write operations is to the source server and not the target server. In our view, this operation of the system of Beeler is verified by Beeler's disclosure at column 18, lines 20-51 in conjunction with the flow chart illustrated in Figure 32 of Beeler. As described, if a file to be replicated in target server 310 is in an open status as a result of being opened and in use by another application,

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the file transfer or replication procedure is placed on hold in an “open-file” queue. It is only when the file is closed that it becomes available for the replication operation, after which it is again closed and available for access by other applications. It is apparent to us, from the disclosure of Beeler, that client read/write access to the file system is to the source server since, as indicated by Beeler, the file to be transferred or replicated may remain open on the source server during the file transfer operation (Beeler, column 6, lines 18-27 and column 18, lines 37-44).

We recognize that the Examiner, at page 7 of the Answer, has cited several portions of Beeler as allegedly describing file system user access through the target server concurrently with file system transfer. We agree with Appellants, however, that none of these cited portions supports the Examiner’s position. Further, we find the record before us totally devoid of any support for the Examiner’s further assertion that, in Beeler, “the target server by default must be capable of interacting with users and at the very least, read and accept user requests even if replicating is taking place to avoid an error or deadlock.” (Answer, page 7). The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

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In view of the above discussion, since all of the claim limitations are not present in the disclosure of Beeler, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 24, and 45, nor of claims 3, 26-28, and 47-49 dependent thereon.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejections of dependent claim 2 (based on the combination of Beeler and Rao), and of dependent claims 4, 5, 25, and 46 (based on the combination of Beeler and Marsland), we do not sustain these rejections as well. In addressing the limitations in these dependent claims, which are directed to various specific features such as internet connections and Unix platforms, the Examiner looks to Rao and Marsland to remedy these deficiencies in Beeler. For all of the reasons discussed supra, however, the Examiner has failed to establish a prima facie case of obviousness since we find no teaching or suggestion in Rao or Marsland that would overcome the innate deficiency of Beeler in disclosing the particular claimed feature of client file system access through a target or network server concurrent with file system transfer from a source server.

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In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-5, 24-28, and 45-49 is reversed.

REVERSED

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Jerry Smith	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
Joseph F. Ruggiero	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Mahshid D. Saadat	)	
Administrative Patent Judge	)	

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Richard Auchterlonie  
Novak Druce LLP  
1615 L Street NW, Suite 850  
Washington, DC 20036