

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

~~Ex parte~~ CHRISTOPHER J. WEST
and DAVID A. SERIS

Appeal No. 2004-2227
Application 09/726,868

ON BRIEF

Before THOMAS, RUGGIERO and SAADAT, ~~Administrative Patent Judges.~~

THOMAS, ~~Administrative Patent Judge.~~

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1-8, 10-24 and 26-35.

Representative claim 1 is reproduced below:

1. A storage system comprising:

a target storage device storing old data, the target storage device operable for receiving first delta difference data indicative of the

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differences between first new data and the old data and for receiving second delta difference data indicative of the differences between second new data and the old data, the target storage device further operable for storing the first and second delta difference data at the same point in time, the target storage device further having a processor for processing the old data with the first delta difference data to determine the first new data and for processing the old data with the second delta difference data to determine the second new data.

The following references are relied on by the examiner :

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|----------------------|-----------|---------------|
| Bodnar | 6,012,063 | Jan. 4, 2000 |
| Burns et al. (Burns) | 6,018,747 | Jan. 25, 2000 |

Claims 1-3, 5, 7, 8, 10-12, 18-20, 22, [23], 24, 26-31 and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burns. On the other hand, claims 4, 6, 13-17, 21 and 32-34 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Burns in view of Bodnar.¹

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the answer for the examiner's positions.

¹ Among the formal statements of the rejections of the claims on appeal as set forth in the answer, there is no formal statement with respect to claim 23. This is consistent with the final rejection although the cover sheet thereof indicates otherwise. Page 4 of the brief also recognizes that claim 23 is rejected under 35 U.S.C. §102 in the first stated rejection above.

OPINION

We reverse.

In representative independent claim 1 on appeal, it is stated “the target storage device further operable for storing the first and second delta difference data at the same point in time.” This same concept of storing the delta difference data at the same point in time is repeated in similar terms in other independent claims on appeal or alternatively recited in the manner of “simultaneously storing” this data. In this respect then we agree with the common argument set forth by appellants in the brief and reply brief that this is the point of distinction leading to the reversal of the rejection of the claims on appeal under 35 U.S.C. §§ 102 and 103.

In studying the statement of the rejection of the claims on appeal under 35 U.S.C. § 102 as set forth in the answer, in some instances for some of the independent claims the examiner does allege that Burns teaches this feature. In other independent claims, even though it is recited, it not argued to be recognized by the examiner to be a feature for which the examiner is responsible to determine a correlation to Burns. We therefore do not agree with the examiner’s observation in the Responsive

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Remarks portion of the answer beginning at page 16 that the noted feature is not recited in the rejected claims.

In those instances in which the examiner asserts that this simultaneity of the storing function is said to occur, the examiner only relies upon portions of columns 3 and 4 of Burns. Our study of this reference leads us to the same conclusion as asserted by appellants in the brief and reply brief that the reference does not address this feature. Even the flow chart versions of the principal embodiment in Figure 5 and the alternative embodiment in Figure 6 of Burns do not indicate to us the concept of storing a first and second delta difference data at the same point in time/simultaneously as recited in some fashion in each independent claim on appeal. It is believed that this is the case in the context of Burns since Burns does not essentially address the basic concept otherwise set forth in each independent claim on appeal that at least two types of delta difference data must be resident in the memory to accommodate first new data and old data and second new data with respect to old data. Only a single or one type of old data such as the prior file 200a of Burns and a single update 206 appear to be contemplated by

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this reference.

In the rejection of claims 13-17 and 32-34 under 35 U.S.C. § 103, the examiner only relies upon Bodnar to provide further specific details of a data transferring unit that is only conceptualized in Burns as alleged by the examiner such as at page 11 of the answer. Appellants' response to this rejection initially at page 12 of the principal brief on appeal does not allege that Burns and Bodnar are not properly combinable within 35 U.S.C. § 103.

On the other hand, as stated there, we agree with the conclusion that even if they were properly combinable within 35 U.S.C. § 103, the same features otherwise argued that are recited in independent claims 13 and 32 in this rejection that the storing operation of the first and second delta difference data must occur at the same point in time or simultaneously is not met. Bodnar does not make up for the already stated deficiencies of Burns in this respect.

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In view of the foregoing, the decision of the examiner rejecting various claims under 35 U.S.C. § 102 and 35 U.S.C. § 103 is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| James D. Thomas |) | |
| Administrative Patent Judge |) | |
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| |) | |
| |) | BOARD OF PATENT |
| Joseph F. Ruggiero |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| |) | |
| Mahshid D. Saadat |) | |
| Administrative Patent Judge |) | |

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