

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FU-TIEN CHANG and ASHUTOSH ASHUTOSH

Appeal No. 2006-1225
Application No. 10/244,825¹

ON BRIEF²

Before KRASS, JERRY SMITH, 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 1-24, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to a method for constraining access to a storage system by assigning a permanent

¹ Application for patent filed September 16, 2002.

² An oral hearing scheduled for June 7, 2006 was waived in a communication received via facsimile transmission on May 12, 2006.

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Rather than reiterate the opposing arguments, reference is made to the brief (filed April 18, 2005), the reply brief (filed July 20, 2005) and answer (mailed May 18, 2005) for the respective positions of Appellants and the Examiner.

OPINION

Starting with claim 1, Appellants argue that Ogata merely teaches (page 1) a server duplex system incorporating a working server and a standby server (brief, page 7). Appellants point to paragraph 18 of Ogata and argue that the reference describes two servers 1A and 1B which can alternately access the auxiliary storage unit whereas the claim requires grouping a switch and the storage device such that data only passes to the storage device from the switch (brief, page 8). Appellants also argue that Ogata describes a duplex system (paragraphs 0021-0024) which does not restrict access to the storage device from a server included in the storage system such that data only passes to the storage device from the switch (brief, pages 9-10).

In response, the Examiner argues by stating that the claim is not limited to only one switch and data can pass to the storage device from one or more switches (answer, page 5). The Examiner further reasons that even if the claim is limited to a single switching element, the claim is met since only one of the

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switches in Ogata allows data to pass to the storage device (answer, sentence bridging pages 5-6). In other words, the Examiner takes the position that the switch that allows data to pass, is considered as being grouped with the storage device (answer, page 6).

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Initially, we note that the claims clearly require "grouping a switch and the storage device included in the storage system" which allows data to only pass to the storage device from that switch. Therefore, we remain unconvinced by the Examiner's position that the claim may include more than one switch such that it reads on the alternate switches of Ogata. Upon a review of Ogata, we find that the switches SW1A/SW2A and SW1B/SAW2B limit access from computers 1A and 1B to the storage device by alternating their access (paragraphs 0014, 0022). In that

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regard, we agree with Appellants that the system in Ogata allows data to pass between a switch and storage system by only the host which is authorized to access the storage device according to which host has write-in authority (brief, page 10).

Although Ogata uses one or the other switch for access to the storage devices, we also agree with Appellants that it only constrains access to the switch, not to the storage devices, as recited in the claims (reply brief, page 2). As such, if any one of the switches in Ogata is characterized as the claimed switch, it cannot restrict access to the storage device such that data only passes to the storage devices from that switch since the storage device is also accessible from the other switch. What a reference teaches is a question of fact. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (citing In re Beattie, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). Here, the Examiner's interpretation of the alternate switches as the claimed switch grouped with the storage device allows access through another switch which is inconsistent with the claimed limitations.

In view of the discussion above, we find that the claimed "grouping a switch and the storage device included in the storage system" and "restricting access to the storage device from a

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server included in the storage system" is not taught or suggested by Ogata. Claims 9 and 17 include similar limitations related to grouping a switch and the storage device which, as discussed above with respect to claim 1, are absent in Ogata. Accordingly, since Ogata does not teach all the claimed limitations, the Examiner has failed to meet the burden of providing a prima facie case of anticipation and the 35 U.S.C. § 102 rejection of claims 1-24 over Ogata cannot be sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner
rejecting claims 1-24 under 35 U.S.C. § 102 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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