

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 YAO WANG, YUN WANG, and DAVID KENDLER

Appeal No. 2006-2001
Application No. 09/957,219

ON BRIEF

Before THOMAS, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-29, which are all the claims in the application.

We affirm.

BACKGROUND

The invention relates to a system and method for managing replication of data in a data storage environment by grouping logical devices. (Abstract.) Representative claim 1 is reproduced below.

1. A method for managing data replication for data stored in a data storage environment, the method comprising the computer-executed steps of:
providing a graphical user interface in communication with a first data replication management (DRM) agent which is in communication with a first data storage system, wherein the user interface is configured to allow a user to communicate with the DRM agent in order to manage replication on the first data storage system and to use replication policies that involve groupings of logical devices that are part of the first data storage system and which store at least some data for replication.

The examiner relies on the following references:

Saxon	5,758,359	May 26, 1998
Davis et al. (Davis)	5,918,229	Jun. 29, 1999
Dobson et al. (Dobson)	US 6,256,628 B1	Jul. 3, 2001 (filed Jun. 24, 1998)

Claims 1-20, 22-26, 28, and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saxon and Davis.

Claims 21 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saxon, Davis, and Dobson.

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We refer to the Final Rejection (mailed Mar. 8, 2005) and the Examiner's Answer (mailed Nov. 1, 2005) for a statement of the examiner's position and to the Brief (filed Aug. 15, 2005) and the Reply Brief (filed Dec. 12, 2005) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner finds that Saxon teaches all of the subject matter of instant claim 1 except for a graphical user interface, for which the rejection relies upon Davis. Appellants submit in the Brief, however, that Saxon does not include any reference to logical devices, or groupings of logical devices.

The examiner responds in the Answer that Saxon discloses logical devices at least at column 3, lines 63 through 67. The examiner submits that a "logical device" is known in the art, as evidenced by a technical dictionary definition, as a device named by the logic of a software system regardless of its physical relationship to the system. (Answer at 10.)

Appellants respond, in turn, in the Reply Brief that a "better understanding" of logical devices can be obtained from the instant specification. Appellants provide examples of embodiments of logical devices or logical volumes, and groupings thereof, in the instant specification, and in a U.S. patent that appellants contend is incorporated into the instant specification.

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While we agree that the examples provided may be considered more complex than the teachings of Saxon, appellants fail to point out how the specification might provide a definition for “logical device” that requires any or all of the complexities described in the relied-upon embodiments. Nor do appellants even offer, by way of argument, some definite meaning for “logical device” that is different from that offered by the examiner.

Appellants’ arguments are not commensurate with the scope of instant claim 1. During prosecution before the USPTO, the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” In re Zletz, F.2d 893 at 321, 13 USPQ2d at 1322. Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. Phillips v. AWH Corp., 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). Appellants have not shown that one skilled in the art at the time of invention would have understood the claim terms to be limited to the disclosed embodiments.

Saxon describes, in the paragraph bridging columns 3 and 4, mass storage system 14 (Fig. 1) as comprising a primary store, a secondary store, and a backup

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store. Saxon goes on to describe examples of physical implementations of the storage elements (e.g., disk drives, optical storage drives, or tape drives). The reference thus supports the examiner's finding that Saxon teaches replication and replication policies that "involve groupings of logical devices" within the meaning of instant claim 1. The primary, secondary, and backup stores are logical devices that are not constrained, at the system level, by how they might be implemented as physical devices. We note in passing that Davis, also applied against claim 1, makes reference to logical drives (col. 8, ll. 9-23) in a manner consistent with the examiner's position as it relates to the artisan's understanding of a "logical device."

Appellants also submit there is no reason for Saxon to have a graphical user interface as taught by Davis because Saxon is directed to a backup scheduler (software routine), such that no user interface is needed. (E.g., Brief at 13.) The examiner points to column 4, lines 29 through 35 of Saxon in support of the view that a user interface is actually taught by the reference. (Answer at 11.)

Saxon at column 4 describes schedules and selection criteria for the backup system as being specified and adjusted by the system administrator or user as needed. We agree with the examiner that Saxon teaches a user interface. Saxon does not specify the form of user interface (e.g., graphical or text-based). However, we agree with the examiner that the combination of Saxon and Davis would have suggested using a graphical user interface in the Saxon system.

Appellants submit in the Brief that claims 25, 26, and 28 are separately patentable from the other claims rejected over the combination of Saxon and Davis. The only additional argument in support of the claims, however, is the allegation of a lack of motivation to combine the references. Appellants do not support the allegation with any reasoning as to why one would conclude the prior art did not suggest the combination. Moreover, appellants do not specifically address, much less show error in, the examiner's findings in support of why the references would have suggested the combination proposed.¹

Representative claim 21 requires that the user-interface of claim 1 be Java-based. The examiner adds Dobson, teaching a Java-based interface, to the basic combination of Saxon and Davis in the rejection applied against claims 21 and 27. Appellants' arguments in response are based on the supposed differences between the Saxon reference and instant claim 1. Other than an express teaching that the user interface is graphics-based, as recognized by the rejection, appellants have not demonstrated any difference between the Saxon reference and subject matter embraced by instant claim 1.

¹ The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

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We have considered representative claims 1, 21, and 25 to the extent separate arguments have been provided. See 37 CFR § 41.37 (c)(1)(vii). We are not persuaded that any of the claims on appeal have been rejected in error. We thus sustain the rejection of claims 1-20, 22-26, 28, and 29 under 35 U.S.C. § 103 as being unpatentable over Saxon and Davis and the rejection of claims 21 and 27 under 35 U.S.C. § 103 as being unpatentable over Saxon, Davis, and Dobson.

CONCLUSION

The rejection of claims 1-29 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
HOWARD B. BLANKENSHIP) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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MAHSHID D. SAADAT)
Administrative Patent Judge)

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EMC CORPORATION
OFFICE OF THE GENERAL COUNSEL
176 SOUTH STREET
HOPKINTON, MA 01748