

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 Steven J. Gormley

Appeal No. 2006-3096
Application No. 10/116,676
Technology Center 2100

ON BRIEF

Before DIXON, BARRY, and SAADAT, *Administrative Patent Judges*.

DIXON, *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 1-18, 21, and 22, which are all of the claims pending in this application. Claims 19 and 20 have been canceled.

We REVERSE.

BACKGROUND

The Appellant's invention relates to a method and system for maintaining enhanced file availability in a Virtual Storage Access Method (VSAM) system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for enhancing VSAM files online availability, comprising:

switching online traffic from a first group of files to a second group of files, wherein the first group of files is identified by a first name and the second group of files is identified by a second name, and the first group of files identified by the first name contain old data and the second group of files identified by the second name contain new data;

obtaining exclusive control of the first group of files;

renaming the first group of files from the first name to a third name, during which online traffic accesses the second group of files;

switching online traffic from the second group of files to the first group of files currently identified by the third name;

obtaining exclusive control of the second group of files;

renaming the second group of files from the second name to the first name, during which online traffic accesses the first group of files;

switching online traffic from the first group of files currently identified by the third name to the second group of files currently identified by the first name;

obtaining exclusive control of the first group of files currently identified by the third name; and

renaming the first group of files currently identified by the third name to the second name, during which online traffic accesses the second group of files;

whereby at least one of the first and second groups of files is available for online traffic during each of the renaming steps.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

BARRY et al. (BARRY)	5,887,274	Mar. 23, 1999
JONES et al. (JONES)	6,622,176	Sep. 16, 2003 (filed Apr. 19, 1995)
BASANI et al. (BASANI)	2004/0215709	Oct. 28, 2004 (effective date Apr. 7, 2000)

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellant regarding the above-noted rejections, we make reference to the Examiner's answer (mailed April 27, 2006) for the reasoning in support of the rejection, and to Appellant's brief (filed July 22, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert.denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize- Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” In re Hiniker Co., 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. From our review of the Examiner’s rejection, we find the same deficiencies in the rejections which Appellant notes at pages 5-9 of the Brief.

Appellant argues that:

Barry has neither the purpose nor the novel elements of Appellant's invention. In **Barry**, a DB2 data base is periodically reorganized, i.e., updated data is reordered in the database file to make accessing more efficient (see col. 2, lines 6 through 19 and col. 12, lines 8 through 23). This is different than Appellant's invention, where the purpose is providing access to updated data in a VSAM system [Emphasis added.] [Br. 5].

We agree with Appellant that the Examiner has not provided a teaching or a convincing line of reasoning as to the use of the claimed method in a VSAM system. In a later discussion with respect to independent claim 18, the Examiner mentions column 10, line 54 of **Barry** which mentions a VSAM data set (Answer 15). While the reference mentions VSAM in one location with respect to a data set format, we cannot find that this teaches a method for enhancing VSAM files online availability in a system. In response to Appellant’s argument, the Examiner merely states that the Basani reference teaches file renaming of live, temp and backup designations and switching access (Answer 10). We do not find this response addresses Appellant’s argument. Therefore, Examiner's response to the argument is not sufficient or persuasive.

Appellant additionally argues that:

Barry does not provide for sequentially switching online access between two files (the old data files and the new updated data files) in order to provide continued access during a file renaming process. While the Examiner is correct in pointing out that the database files in **Barry** are renamed (and exclusive access is provided to the renaming process), **Barry** specifically acknowledges that access to the files is disabled during the renaming process in order to permit the renaming (see col. 7, lines 4 though 24) (Br. 5-6).

In response to Appellant’s argument, the Examiner merely states that the Basani reference teaches file renaming of live, temp and backup designations and switching

access (Answer 10). We do not find this response addresses Appellant's argument especially in light of the express teaching in Barry that access is disabled during the renaming process. Moreover, we find that the Examiner has not identified an express teaching in Basani which teaches that the access to files is not disabled during the renaming process. Therefore, Examiner's response to the argument is not sufficient or persuasive.

With respect to the Examiner's responses in the Answer to Appellant's arguments concerning claim 1, we do not find that the Examiner has clearly addressed these arguments and has not provided a convincing line of reasoning as to how the individual references teach the claimed steps in a VSAM system for continued access to the files during the renaming process. We find the Examiner's reliance upon paragraph [0089] of Basani does not clearly show or explain that access is maintained during the renaming process. In light of this base deficiency, we additionally do not find that the Examiner has provided a convincing line of reasoning why it would have been obvious to one skilled in the art at the time of the invention to have combined these two teachings to achieve the claimed method in a VSAM system. From the above deficiencies, we cannot find that the Examiner has met the initial burden of establishing a prima facie case of obviousness. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims.

We additionally find similar deficiencies in the Examiner's presentation of a prima facie case of obviousness of independent claims 7 and 13 and their respective dependent claims. Therefore, we cannot sustain the rejection of independent claims 7 and 13 and their respective dependent claims.

With respect to independent claim 18, Appellant argues that the Examiner has not made the requisite showing for claim 18 as with independent claim 1. We agree with Appellant and find that the Examiner has not shown where either Barry or Basani teaches or fairly suggests the claim language "at least one of the groups of old and new files remains available for online access when either of the groups of files is renamed" which is similar to that found in independent claim 1. Additionally, Appellant argues that the

Examiner has not shown the batch program modules with the recited functions as set forth in independent claim 18. The Examiner's response seems to generally address Appellant's argument and the Examiner maintains that "both Barry et al. and Basani et al. teach renaming file, especially, Basani et al. allow access or switching access during the renaming process" (Answer 15). We find that the Examiner has not provided a clear teaching or suggestion to support this position. Therefore, Examiner's argument is not persuasive, and we cannot find that the Examiner has met her initial burden of establishing a prima facie of obviousness of independent claim 18. Therefore, we cannot sustain the rejection of independent claim 18 and its respective dependent claims.

CONCLUSION

To summarize, the Examiner's rejection of claims 1-18, 21, and 22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JOSEPH L. DIXON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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