

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

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* DINESH VENKATESH, XIAOYE JIANG,
12 JIANNAN ZHENG, and URESH VAHALIA

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15 Appeal 2007-0398
16 Application 10/308,445
17 Technology Center 2100

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20 Decided: April 6, 2007

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23 *Before:* JOSEPH F. RUGGIERO, JOSEPH L. DIXON, and ALLEN R.
24 MACDONALD, *Administrative Patent Judges.*

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26 MACDONALD, *Administrative Patent Judge.*

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32 DECISION ON APPEAL

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36 REVERSED

1 STATEMENT OF CASE

2 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
3 of claims 11-13, 16-18, 20-21, 23-24, 27, 29-30, and 36-43. We have
4 jurisdiction under 35 U.S.C. § 6(b) (2002).

5 Appellants invented a client-server protocol method and server for
6 directory access of snapshot file storage systems (Specification 13:11-12).

7 Exemplary independent claim 11 under appeal reads as follows:

8 11. A method of configuring a network file server for access to
9 a group of related snapshot file systems in data storage of the
10 network file server, each of the related snapshot file systems
11 being the state of a production file system at a respective point
12 in time, the network file server having a client-server protocol
13 layer of programming for client access to file system objects in
14 the data storage of the network file server, said method
15 comprising: configuring each of the related snapshot file
16 systems to have a common internal file identifier (fid') and a
17 different respective internal file system identifier (fsid'); and
18 programming the network file server for interchanging the
19 common internal file identifier (fid') with the different
20 respective internal file system identifier (fsid') of each related
21 snapshot file system for access using the client-server protocol
22 layer to said each related snapshot file system.
23

24 The Examiner rejected claims 11-13, 16-18, 20-21, 23-24, 27, 29-30,
25 and 36-43 under 35 U.S.C. § 103(a) (2004).

26 The prior art relied upon by the Examiner in rejecting the claims on
27 appeal is:

28	DeKoning	US 5,790,773	Aug. 4, 1998
29	Patel	US 6,643,654	Nov. 4, 2003
30	Chen	US 2003/0182253	Sep. 25, 2003

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1 Appellants contend that the claimed subject matter would not have
2 been obvious. More specifically, Appellants contend that:

3 (1) as to claims 11, 16, and 29, even if combined the reference
4 disclosures do not result in “decoding of the pathnames . . . for the
5 group of related snapshot systems” (Br. 31); and

6 (2) as to claims 20, 27, 36, and 38, improper hindsight has been used
7 as the references fail to show a production file system configured to
8 have related snapshot file systems (Br. 44, 47, and 50).

9 The Examiner contends that claims 11, 16, and 29 do not recite “decoding
10 the pathnames” (Answer 49) and any hindsight reasoning has been proper
11 (Answer 53-56).

12 We reverse.

13 ISSUES

14 Has Appellant shown that the Examiner has failed to establish one
15 skilled in the art would have combined Chen and DeKoning to provide
16 access to “a group of related snapshot file systems . . . ” as required by
17 claims 11, 16, and 29?

18 Has Appellant shown that the Examiner has failed to establish one
19 skilled in the art would have combined Chen and DeKoning and Patel to
20 provide a server for operating “related snapshot file systems . . . ” as
21 required by claims 20, 27, 36, and 38?

22 FINDINGS OF FACT

23
24 Appellants invented a client-server protocol method and server for
25 directory access of snapshot file storage systems (Specification 13:11-12).

1 Appellants' method and server for directory access of snapshot file
2 storage systems may operate with plural "related snapshot file systems" or
3 "a snapshot file system" (Specification 30:15).

4 DeKoning describes having "a snapshot" (singular) (col. 2, l. 29) in
5 the mirror (see col. 5, ll. 38-57).

6 All claims before us require plural related snapshot systems which are
7 configured according to claimed file structure.

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9 PRINCIPLES OF LAW

10 On appeal, Appellant bears the burden of showing that the Examiner
11 has not established a legally sufficient basis for the rejection. Appellant may
12 sustain this burden by showing that, where the Examiner relies on a
13 combination of disclosures, the Examiner failed to provide sufficient
14 evidence to show that one having ordinary skill in the art would have done
15 what Appellant did. *United States v. Adams*, 383 U.S. 39, 148 USPQ 479
16 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed.
17 Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H.*
18 *Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir.
19 2006).

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21 ANALYSIS

22 The Examiner correctly shows where at least one of each of the
23 claimed elements appears in the Chen, DeKoning, and Patel prior art
24 references. Further, the Examiner correctly combines first the Chen and
25 DeKoning and then the Chen, DeKoning, and Patel prior art references with

1 respect to a *single snapshot file system*. We conclude that the Examiner is
2 correct as to a method or server with a *single snapshot file system*.

3 However, Appellants correctly point out the claims before us require
4 plural “related snapshot file systems.” We find nothing, in the references or
5 rejection, which describes or suggests stretching the teachings of DeKoning,
6 to include plural related snapshot file systems.

7 Accordingly, we determine that the Examiner has not given any
8 reason why one skilled in the art would have combined the prior art elements
9 to make Appellants’ claimed invention. It follows that the Examiner erred in
10 rejecting Claims 11, 16, 20, 27, 29, 36, and 39 under § 103(a). Since the
11 remaining dependent claims are narrower than the independent claims from
12 which they depend, it also follows that those claims were not properly
13 rejected under § 103(a) over Chen, DeKoning, and Patel.

14
15 **CONCLUSION OF LAW**

16 On the record before us, Appellants have shown that the Examiner has
17 not given any reason why one skilled in the art would have combined Chen
18 and DeKoning to provide access to “a group of related snapshot file systems
19 . . . ” as required by claims 11, 16, and 29; and Appellants have shown that
20 the Examiner has failed to establish one skilled in the art would have
21 combined Chen and DeKoning and Patel to provide a server for operating
22 “related snapshot file systems . . . ” as required by claims 20, 27, 36, and 38.

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24 **DECISION**

25 The Examiner's rejection of claims 11-13, 16-18, 20-21, 23-24, 27,
26 29-30, and 36-43 is Reversed.

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REVERSED

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