

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROLAND M. HOCHMUTH, ROBERT PAUL MARTIN,  
ALASSANE SENE, BRYAN PROUTY, and STUART YOSHIDA

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Appeal 2007-2943  
Application 09/954,352  
Technology Center 2100

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Decided: June 17, 2008

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Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and  
HOWARD B. BLANKENSHIP, *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 1-26. We have jurisdiction under  
35 U.S.C. § 6(b).

We REVERSE.

## BACKGROUND

Appellants' invention relates to a system and method for providing secure access to network logical storage partitions. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for providing secure access to network logical storage partitions, comprising:

automatically associating at least one of a plurality of secure logical storage partitions in a storage device in a network with at least one of a plurality of uniquely identified servers in a cell in the network in response to a request for storage over the network;

automatically associating the cell with at least one client using network isolation of the cell; and

using network isolation of the storage device to restrict access to the at least one of the plurality of secure logical storage partitions to the one of the plurality of uniquely identified servers in the cell.

## PRIOR ART

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

Blumenau	US 6,421,711 B1	Jul. 16, 2002
		(filed Jun. 29, 1998)
Forslow	US 2002/0133534 A1	Sep. 19, 2002
		(filed Jan. 02, 2001)

## REJECTIONS

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blumenau in view of Forslow.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Dec. 22, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Oct. 10, 2006) and Reply Brief (filed Feb. 5, 2007) for the arguments thereagainst.

## OPINION

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

### 35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to

known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior

art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Throughout the Brief and Reply Brief, Appellants have repeatedly argued that the Examiner's proffered combination of Blumenau in view of Forslow does not appear to disclose, teach or suggest "in response to a request for storage," "automatically associating at least one of a plurality of secure logical storage partitions in a storage device in a network with at least one of a plurality of uniquely identified servers in a cell" and "automatically associating in the cell with at least one client using network isolation of the cell" as recited in independent claim 1. We agree with Appellants.

From our review of the teachings of Blumenau and Forslow, we find no clear teaching or fair suggestion of performing the recited steps automatically. Additionally, we note that the teachings of Forslow at paragraph (0034) expressly teaches that a "campus IT-administrator ensures load balancing and redundancy from one distribution node to another across the core." We cannot agree with the Examiner's reliance upon the recited teachings to support the Examiner's position when one of the references clearly teaches the use of an administrator rather than an automatic processing.

Furthermore, from our review of the Examiner's responsive arguments, the Examiner never squarely addresses the recited limitation of "automatically" performing the recited steps. Therefore, the Examiner has not made a proper initial showing that the prior art references teach or fairly suggest all of the recited limitations. Therefore, the Examiner has not set forth a proper initial showing of obviousness. Furthermore, the Examiner has not set forth any convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have performed these steps "automatically." Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-8.

Similarly, independent claims 9 and 19 contain similar limitations which the Examiner has not squarely addressed with respect to the "automatically" processing thereof. Therefore, the Examiner has similarly failed to establish a proper initial showing of obviousness, and we cannot sustain the rejection of independent claims 9 and 19 and their respective dependent claims 10-18 and 20-26.

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## CONCLUSION

To summarize, we have reversed the rejection of claims 1-26 under 35 U.S.C. § 103(a).

REVERSED

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400