

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH G. BOYER, RICHARD A. GILL,
and THOMAS H. GOHL

Appeal No. 1998-2072
Application No. 08/777,054

ON BRIEF

Before KRASS, JERRY SMITH, and BLANKENSHIP, 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 18-34, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The disclosed invention is directed to a method and system for allowing data written in one direction on a magnetic medium to be read therefrom in the opposite direction.

Representative claim 18 is reproduced below.

18. A method for retrieving uni-directional encrypted data, comprising the steps of:

reading the encrypted data from a storage media in an opposite direction from which it was written;

storing the encrypted data read from the media in a data buffer in the order in which the data was read; and

decrypting the stored data from the data buffer in an opposite direction from which it was stored.

The examiner relies on the following reference:

McLaughlin	3,766,529	Oct. 16, 1973
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Claims 18-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over McLaughlin.

We refer to the Final Rejection (Paper No. 17) and the Examiner's Answer (Paper No. 21) for a statement of the examiner's position and to the Brief (Paper No. 20) and the Reply Brief (Paper No. 22) for appellants' position with respect to the claims which stand rejected.

OPINION

The section 103 rejection of independent claim 26 as being unpatentable over McLaughlin is set forth on pages 3 and 4 of the Answer. In view of the commentary on pages 3 through 5 of the Answer, it is unclear what the examiner considers the difference to be between the other independent claim -- method claim 18 -- and the disclosure of McLaughlin.

In any event, the examiner finds that the reference discloses a feature relevant to each of the independent claims on appeal. “[T]he reference teaches the feature of reading data in opposite direction from which it was stored in a storage media [see col. 1 (lines 26-35), col. 3 (lines 61-62), col. 9 (lines 9-12)].”

However, we do not see where that particular teaching is found in the cited sections of McLaughlin. The reference does disclose transporting magnetic tape in a reverse direction and reading the data in that reverse direction. However, as appellants point out on page 4 of the Brief, McLaughlin at column 4, lines 27-35 clearly discloses that data are written on the tape in the direction in which the data are to be read. Blocks of data which are read in the reverse direction are, at the time of writing, written in that reverse direction.

We thus agree with appellants that the examiner erred in determining the difference between the claims and what McLaughlin discloses. We note that the examiner has not (nor have appellants) commented on a passage which appears at column 3, lines 19-23 of

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the reference: "It is preferred also to write alternate blocks...in reverse order to avoid having to reverse the order of the bits in the block after read out from the tape."

McLaughlin thus at least recognizes that data may be read in reverse order to that written. We do not interpret the disclosure as referring to an alternative embodiment of the invention. Further, we find the teaching falls short of an objective suggestion to modify McLaughlin's disclosed embodiment. When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). In the prior art applied, we fail to see any teaching or suggestion of an incentive to read data in an order reverse to that written.

What is missing in the instant rejection, at the least, is an evidentiary showing of some salient reason from the prior art to do what appellants have done -- reading data from a storage medium in an opposite direction from which it was written, as required by independent claims 18 and 26 -- and thereby add complexity to the system of McLaughlin, even though the reference teaches that the disclosed, simpler embodiment is preferred. Moreover, on this record, an opinion on our part with regard to whether the above-noted disclosure at column 3 of McLaughlin might suggest the ordered procedures of encryption and decryption required by the instant claims would be mere speculation.

Since we disagree with the examiner's findings with respect to what the reference teaches, and the examiner has not provided any other showing of motivation from the prior

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art to modify the system of McLaughlin to meet the terms of the independent claims at issue, we do not sustain the rejection of claims 18-34.

CONCLUSION

The rejection of claims 18-34 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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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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