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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WOLFGANG ARNDT, JOACHIM BOCHMANN,
and FRANK SCHELER

Appeal 2010-008837
Application 11/233,641
Technology Center 2100

Before MAHSHID D. SAADAT, JUSTIN BUSCH, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1-13, 17 and 18. Claims 14, 15 and 16 have been cancelled. An amendment adding claims 19-28 has not been entered by the Examiner. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellants' invention relates to a device as well as a method for the saving or storage of data on physically different storage devices.

CLAIMED SUBJECT MATTER

Claims 1 and 17 are the independent claims on appeal. Claim 1 is representative of the subject matter on appeal, and recites:

1. A computer device comprising
a controller and a plurality of data storage devices,
wherein the data are selectively stored in one of the
plurality of storage devices,
wherein the plurality of data storage devices are
physically separate from one another and
wherein the selection criteria for data storage are at last
one of description of data, content of data, relevance of data,
time of data creation or data processing.

REJECTIONS

Claims 1-4, 7, 10, 12, 13, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hsiao et al. (U.S. Patent No. 6,266,784 B1, Jul. 24, 2001; "Hsiao") in view of the publication by McNamara, entitled "The Document Database: Relational, Object Oriented or Hybrid?" ("McNamara").

Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsiao in view of McNamara and Chow et al. (U.S. Patent Application Publication No. 2002/0069318 A1, Jun. 6, 2002; "Chow").

Claims 6, 8, 9 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hsiao in view of McNamara and the publication by

Mullins, entitled “Optimizing Database Performance, Part I: Partitioning and Indexing” (“Mullins”).

APPELLANTS’ CONTENTIONS

With respect to the 35 U.S.C. § 103(a) rejection of claim 1, Appellants contend that the combination of Hsiao and McNamara does not produce the claimed feature that data is selectively stored and the selection criteria for data storage are at least one of description of data, content of data, relevance of data, time of data creation or data processing.

Appellants argue that Examiner erred in his conclusion of obviousness because McNamara is in a different field of endeavor. Appellants contend that “the present claimed invention is drawn to the field of physically separating sensible data, for later, safe and total deletion,” whereas McNamara “relates to table partitioning to reduce I/O contention.” (Br. 7, emphasis removed).

Appellants also contend that “[t]he disclosure in McNamara in combination with Hsiao would not render the present claimed invention obvious, absent the specification of the present invention as a template.” (Br. 7).

Additionally, Appellants argue that Hsiao teaches away from the proposed combination. Appellants argue that reducing I/O contention as taught by McNamara “would interfere with the main task in Hsiao of data safely stored and having the place of storing logged in the recovery plan file in order to rapidly determine an alternative storage device .” (Br. 7) (citation omitted) (emphasis in original).

With respect to the rejection of claims 2-13, 17 and 18 Appellants allow those claims to fall with claim 1 by relying on the same reasons presented for the patentability of claim 1 (*see* Br. 8-9).

ISSUE

Did the Examiner err in rejecting claim 1 as unpatentable under 35 U.S.C. § 103(a) over the teachings of Hsiao in view of the teachings of McNamara?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred. We disagree with Appellants' conclusion. We adopt as our own the findings and reasons set forth by the Examiner in the action from which this appeal is taken and the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. However we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

We agree with the Examiner that Hsiao discloses all the recited elements of claim 1 except for the feature of claim 1 that "the selection criteria for data storage are at least one of description of data, content of data, relevance of data, time of data creation or data processing." We also agree with the Examiner that McNamara teaches the feature of claim 1 that "the selection criteria for data storage are at least one of description of data, content of data, relevance of data, time of data creation or data processing." As correctly noted by the Examiner, "McNamara discloses that table

partitioning enables companies to store data on separate disks based on content.” (Ans. 4).

Regarding whether a skilled artisan would combine the teachings of Hsiao and McNamara, the Examiner also correctly concludes that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Hsiao to include selectively storing data based on content, as taught by McNamara, in order to reduce I/O contention.” (Ans. 4-5).

We are not persuaded by Appellants’ arguments that McNamara is in a different field of endeavor. We observe that Claim 1 includes no recitation of the deletion of data or how data could be safely or totally deleted. The Examiner correctly noted that McNamara discloses the claimed feature of storing data on “separate disks based on content.” (Ans. 4).

The Examiner has provided adequate rationale to support combining Hsiao and McNamara. We agree with the Examiner’s analysis and reasoning on page 12 of the Answer that Appellants’ recognition of another advantage of the resulting system cannot be the basis for patentability.

We are also not persuaded by Appellants’ argument that the specification of the present invention was needed as a template.

Any judgment on obviousness is . . . necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.

In re McLaughlin, 443 F.2d 1392, 1395 (CCPA 1971). *See also Radix Corp. v. Samuels*, 13 U.S.P.Q. 2d 1689, 1693 (D.D.C. 1989) (“[A]ny obviousness inquiry necessarily involves some hindsight.”).

Here, the Examiner's reasons for combining teachings from Hsiao with McNamara are based on the teachings of McNamara. These reasons do not include knowledge gleaned only from Appellants' disclosure.

Accordingly, we are not persuaded that one having ordinary skill in the art would not have been motivated to combine Hsiao and McNamara

Additionally, we are not persuaded that Hsiao teaches away from the proposed combination. Contrary to Appellants' position, the system of McNamara supports data recovery.

In late 1993, Informix (Menlo Park, CA) announced its own parallized database engine, allowing users to perform concurrent sorts, indexes, and back-up-and-restore functions.

In future versions, the company plans to support table partitioning, enabling companies to store data on separate disks, based on content, to reduce I/O contention.

(McNamara at 2, emphasis added). The future version to support table partitioning to reduce I/O contention is implicitly an enhancement and not in conflict with the back-up-and-restore function of the database engine of McNamara. Appellants have not provided evidence of how the combination of Hsiao and McNamara would interfere with the main task of Hsiao of having data safely stored or how partitioning data would prevent its location from being stored in a recovery plan. We agree with the Examiner's findings and conclusion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hsiao and McNamara.

Regarding Appellants' contentions with respect to the remaining claims, Appellants do not present additional arguments with sufficient specificity, so they fall with Claim 1. For the same reasons noted above, we

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agree with the Examiner's findings and stated conclusions with respect to the remaining claims.

CONCLUSION

Based on the foregoing, we conclude that the Examiner did not err in rejecting claim 1 as unpatentable under 35 U.S.C. § 103(a) over Hsiao and McNamara. Therefore, we sustain the 35 U.S.C. § 103(a) rejection of claim 1 and of claims 2-13, 17 and 18 falling therewith.

DECISION

We affirm the Examiner's rejection of claims 1-13, 17 and 18.

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

AFFIRMED

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