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IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. 17304 PRESTON ROAD SUITE 200 DALLAS, TX 75252			WILLIS, AMANDA LYNN	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JANET E. ADKINS, DAVID J. CRAFT,  
THOMAS S. MATHEWS, and FRANK L. NICHOLS III

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Appeal 2014-003169  
Application 13/449,860  
Technology Center 2100

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Before CARLA M. KRIVAK, MICHAEL J. STRAUSS, and  
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–4, 6–9, and 21–31. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Appellants' claimed invention is directed to "mechanisms for importing pre-existing data of a prior storage solution into a storage pool for use with a new storage solution." Spec. ¶ 1.

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method, in a data processing system, for importing pre-existing data into a first storage system of the data processing system utilizing a current storage management system that is different from an original storage management system used to create the pre-existing data, the method comprising:

integrating one or more data storage devices into the first storage system in-place without modification of the pre-existing data stored on the one or more data storage devices;

creating metadata for the pre-existing data based on a linear progression of data in the pre-existing data, wherein the metadata specifies location information for locating portions of data in the pre-existing data of the one or more data storage devices based on an assumption of a linear progression of data in the pre-existing data;

executing read access requests targeting the pre-existing data using the created metadata; and

executing write access requests targeting the pre-existing data by redirecting the write access requests to a copy of the pre-existing data created in another storage location,

wherein the metadata that is created has a configuration, corresponding to the current storage management system used to manage storage devices of the first storage system, that is a different configuration from metadata used by the original storage management system when creating the pre-existing data in a second storage system different from the first storage system.

App. Br. 27 (Claims App'x).

## REFERENCES and REJECTIONS

Claims 1–4, 6–9, 21, and 22 stand provisionally rejected on the ground of non-statutory, obviousness-type double-patenting over claims 10–13, 15–18, 21, and 22 of co-pending U.S. Patent Application No. 13/100,332 (the “’332 application”). Final Act. 3–6.

Claims 24–31 stand provisionally rejected on the ground of non-statutory, obviousness-type double-patenting over claims 10–18, 23, and 24 of the ’332 application. Final Act. 6–10.

Claims 1, 2, 4, 6, 21–25, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over Leroux et al. (US 2009/0193063 A1; July 30, 2009), Watanabe (US 2007/0260840 A1; Nov. 8, 2007), and Winter et al. (US 5,778,414; July 7, 1998). Final Act. 10–22.

Claims 3, 7–9, 26, and 29–31 stand rejected under 35 U.S.C. § 103(a) as obvious over Leroux, Watanabe, Winter, and Murase (US 2010/0082765 A1; Apr. 1, 2010). Final Act. 22–28.

## ANALYSIS

### *Provisional Non-Statutory Obviousness-type Double-Patenting*

We decline to rule on the provisional obviousness-type double-patenting rejection. *See Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential).

### *Rejections under 35 U.S.C § 103*

Appellants argue the Examiner errs in finding the combination of Leroux and Watanabe teaches or suggests “creating metadata for pre-existing data based on a linear progression of data in the pre-existing data” as recited in claim 1. App. Br. 14–16; *see also* Final Act. 10–14.

Appellants contend, contrary to the Examiner’s findings, that although Winter discloses a linear progression, Winter’s teachings are directed “to a *memory* map for purposes of processing data frames received, i.e. putting the header of the frame in a first memory and the payload of a frame in a second memory” and that “[t]he memory map of Winter is not used for mapping logical volumes to physical addresses of a storage subsystem” by creating new metadata for the pre-existing data based on a linear progression of data in the pre-existing data as claimed. App. Br. 15. We agree.

Appellants further contend Winter’s teaching of processing streams of data sent over a network connection using a memory interleaver is inapposite to the teachings of Leroux. App. Br. 15–16; Reply Br. 6–9. We again agree. Winter discloses a memory map in which a linear address space stores part of a data frame in a first memory and part in a second memory (*see* Figure 6; col. 4, l. 62 to col. 5, l. 14). In other words, Winter merely teaches the well-known technique of a memory map having a linear progression of addresses for storing a stream of data.

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

All machines are made up of the same elements; rods, pawls, pitmans, journals, toggles, gears, cams, and the like, all acting their parts as they always do and always must. All compositions are made of the same substances, retaining their fixed chemical properties. But the elements are capable of an infinity of permutations, and the selection of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selection which is the invention . . . .  
*B.G. Corp. v. Walter Kidde & Co., Inc.*, 79 F.2d 20, 21–22 (2d Cir. 1935).

We agree with Appellants that Winter's teachings are unrelated to creating metadata for pre-existing data as claimed, and that the Examiner selects language from Winter and combines it with the teachings of Leroux in a way that inappropriately disregards the actual teachings of Winter and Leroux. *See* Reply Br. 6–9; *see also* App. Br. 9–10, 14–16.

On this record, therefore, we do not sustain the Examiner's rejection of independent claim 1. For the same reasons we do not sustain the rejection of claims 23 and 24, which recite commensurate limitations. We also therefore do not sustain the rejection of the dependent claims 2–4, 6–9, 21, 22, and 25–31.

#### DECISION

We do not reach a decision regarding the Examiner's provisional rejection of claims 1–4, 6–9, 21, 22, and 24–31 on the ground of non-statutory, obviousness-type double-patenting.

We reverse the Examiner's rejection of claims 1–4, 6–9, and 21–31 as obvious under 35 U.S. C. § 103.

REVERSED