

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN BEGIS and LONNIE MCALISTER

Appeal No. 2001-0517
Application No. 08/586,611

ON BRIEF

Before HAIRSTON, JERRY SMITH, and LALL, Administrative Patent Judges.

LALL, 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, 3-8 and 10-14. Claims 2 and 9 have been objected to by the examiner and claims 15-21 have been indicated as allowable by the examiner.

According to appellants (brief at pages 2, 3 and 4), the claimed invention is directed to an innovative function which enables a computer system to optimally interface with any hard

Appeal No. 2001-0517
Application No. 08/586,611

Claims 1, 3-8 and 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martins in view of Choudhary and Osterlund.

Rather than repeat the arguments of appellants and the examiner, we make reference to the brief¹ (Paper No. 17) and the examiner's answer (Paper No. 18) for the respective details thereof.

OPINION

We have considered the rejection advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellants' arguments set forth in the brief.

We reverse.

Before embarking on any analysis, we note that appellants have selected to have all the claims considered as one group (brief at page 4). We select claim 8, the broadest independent claim, for our analysis.

¹ The examiner in the examiner's answer (page 1) refers to the appeal brief filed on August 19, 1998, however, we find that no such appeal brief with that filing date. There is listed in the contents of the file an appeal brief (Paper No. 15) which was filed on November 29, 1999, however, that appeal brief was noted to be defective (Paper No. 16). Therefore, we take the appeal brief filed as Paper No. 17 to be the appeal brief which the examiner really is referring to in his examiner's answer and the response the examiner has given to the arguments in the appeal brief seems to correspond to the arguments stated in this appeal brief.

Appeal No. 2001-0517
Application No. 08/586,611

Before we enter into the analysis of the claim, it is imperative that the claim is interpreted properly. The claim interpretation is the starting point for any claim analysis as stated by the Federal Circuit. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

In this case, the examiner asserts (answer at pages 5-13) that the claims do not require the dynamic benchmarking which appellants argue in the brief. Specifically, the examiner contends (id. at pages 5 and 6) that "it is noted that the features upon which appellants rely (i.e., **dynamic benchmarking on an actual implementation in a system, new paradigm**) are not recited in the rejected claim(s)." Again, the examiner contends regarding claim 8 (id. at page 8) that:

It should also be noted that **claim 8 simply** states a function to determine an optimal transfer block size for a hard drive by benchmarking accesses to the hard drive for a plurality of benchmarking transfer block sizes in accordance with a set of bench marking parameters, but never states any requirement for a circuit board endowed with a function for dynamic determining.

Appeal No. 2001-0517
Application No. 08/586,611

We disagree with the examiner's interpretation of claim 8 and consequently the interpretation of the other claims since the same or similar feature appears in the other claims. Our reading of the claim states that it requires a processor, a hard drive and a function, wherein, when executed by the processor, the function determines an optimal access block size of the hard drive by benchmarking accesses to the hard drive for a plurality of benchmarking access block sizes in accordance with a set of benchmarking parameters. It is clearly recited in the claim that the processor has embedded in it a function which determines for a particular hard drive in use the optimum transfer block size when that function is executed by the processor during its processing operation. Even though the word dynamic does not appear as such in the claim, the claim requires a dynamic processing as the processor is executing the function. This interpretation is further illustrated by the disclosure of appellants in Figures 3-6. Having established the interpretation of claim 8, we now analyze claim 8 and the rejection of claim 8.

The examiner rejects claims 1, 3-8 and 10-14 at pages 3, 4 and 5 of the examiner's answer. The examiner concludes (id. at page 4) that:

It would have been obvious . . . to combine Choudhary with Martins because it would provide for a system to

Appeal No. 2001-0517
Application No. 08/586,611

increase data transfer rates by allowing benchmarking during the simulation to obtain the optimal solution for the block size. . . . It would have been obvious . . . to combine Osterlund with the combined system of Martins and Choudhary because it would allow the combined system to optimize data transfer across busses which require long delays.

Appellants argue each reference in detail at pages 5-9 of the appeal brief and conclude (id. at page 9) that:

Insofar as each of the cited references is representative of the old paradigm, Appellants respectfully submit that nothing in the combination of the cited references would motivate one skilled in the art to embed a function including the limitations of rejected claim 1 [or claim 8] in a circuit board to dynamically determine the optimum access block size of a system hard drive enabling the circuit board to optimally interface with any hard drive.

In providing motivation or a suggestion to combine, we recognize that the Federal Circuit states, in In re Lee, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002),

[t]he essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

Appeal No. 2001-0517
Application No. 08/586,611

In this case, we find that the examiner has not explained how he is combining the various features from Choudhary and Osterlund to the disclosure in Martins. Instead, the examiner merely states in his obviousness statement that the teachings of Choudhary and Osterlund would have been obvious to be combined with the teachings of Martins. The examiner has not established any factual basis in each of these references where an artisan would have been motivated to combine these references. We, instead, agree with the appellants' position that the processor in Martins is devoid of any capability of dynamically determining an optimum block size for its hard drive. Instead, Martins is concerned with optimizing the block length near its optimum values by adapting to the channel bit error rate, see page 737. As the examiner admits, Martins does not show the use of benchmarking in connection with a hard drive. Answer at page 4. We find that Choudhary is directed to a different type of problem. In Choudhary, the performance results capture the effects of block size, cache size, ratio of secondary and primary cache sizes, and, write-through and write-back protocols on hit ratios, access times, relative speedups and bus utilizations, see page 409. Choudhary also does not disclose any method or function which when executed by the processor attempts to optimize the block

Appeal No. 2001-0517
Application No. 08/586,611

size transfer of data from the hard drive. We further find that Osterlund is concerned with the interplay of buffering and the hard drive and studies the transfer rate of blocks of data from the buffering to the hard drive. Osterlund also does not address the same problem as appellants.

Therefore, we do not find that the examiner has established a set of facts which would lead an artisan to make the modifications of Martins reference with the teachings of Choudhary and Osterlund to arrive at the invention recited in claim 8. Since the other claims contain the same or similar limitations, they too cannot be rejected by the combinations suggested by the examiner.

Appeal No. 2001-0517
Application No. 08/586,611

The decision of the examiner rejecting claims 1, 3-8 and 10-14 over Martins, Choudhary and Osterlund is not sustained.

REVERSED

Kenneth W. Hairston)	
Administrative Patent Judge)	
)	
)	
)	
Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Parshotam S. Lall)	
Administrative Patent Judge)	

PSL:tdl

Appeal No. 2001-0517
Application No. 08/586,611

Blakely, Sokoloff, Taylor & Zafman
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025