

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL A. BILLINGS, DANA H. BROWN, EARL A. CUNNINGHAM,
RICHARD GREENBERG and HAL H. OTTESEN

Appeal No. 1996-3078
Application 08/184,417¹

ON BRIEF

Before THOMAS, JERRY SMITH, and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 to 29, which constitute all of the pending claims in the application before us.

BACKGROUND

¹ Application for patent filed January 21, 1994.

The subject matter on appeal is directed to the field of direct access storage devices, and specifically to a data processing system and method for supporting user designation of physical file formats for files (see specification, page 1). As indicated in the specification (page 3), examples of physical formats for data to be stored pertain to physical location and arrangement of data such as in spiral and concentric tracks (see Figures 9B, 9C, and 9D). In general, appellants' invention recited in the independent claims on appeal (apparatus claim 1 and method claim 14) seeks provide a data processing system and method which stores files in accordance with a determined physical format type (i.e., spiral or concentric) and does so in response to user designation of the file type from a plurality of available physical format types. As further discussed, infra, we find that appellants' admitted prior art in the specification fails to teach or suggest at least this feature as it is recited in claims 1 to 29 on appeal.

Representative system claim 1 is reproduced below:

1. A data processing system, comprising:
 - a direct access storage device;
 - means for generating data files;
 - a user interface allowing user designation of the file type upon generation of a data file;
 - means responsive to user designation of the file type for a file for determining a physical format type for the file from a plurality of available physical format types; and
 - means for storing the file on the direct access storage device as at least a first record conforming with the determined physical format type.

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The following prior art is relied on by the examiner:

Applicants' admitted prior art at page 2 to 3 and 8 of the specification:

Rosen et al. (Rosen)	5,202,875	April 13, 1993
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Claims 1 to 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of appellants' invention (see page 2 of the final rejection).

Claims 1 to 29 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies appellants' admitted prior art alone.

Claims 8 and 21 stand newly rejected in the Answer under 35 U.S.C. § 103 (Answer, page 9). As evidence of obviousness, the examiner relies appellants' admitted prior art in view of Rosen.

We note that while the Answer discusses Hedlund et al. and Yoshida et al. as teaching or suggesting the salient features of dependent claims 10 and 23 on appeal (Answer, page 10), we note that neither the statement of the rejection in the Answer (Answer, page 5), nor the statement in the Final Rejection (Final Rejection, page 2), expressly rely upon Hedlund et al. or Yoshida et al. to reject claims 10 and 23. We note that even when a reference is relied upon in a minor capacity to support a rejection, "there would appear to be no excuse for not positively including the reference in the statement of rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ

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406, 407 n.3 (CCPA 1970). Hedlund et al. and Yoshida et al. have not been positively included in any statement of the rejection, and thus we find Hedlund et al. and Yoshida et al. not to be relied upon in the rejection of claims 10 and 23.

Rather than repeat the positions of appellants and the examiner, reference is made to the Briefs and the Answers for the respective details thereof.

OPINION

In reaching our conclusion on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the prior art, the respective viewpoints of appellants and the examiner, and all other evidence of record. As a consequence of our review, we are in agreement with appellants (Brief, pages 10 to 11) that the claims on appeal meet the requirements of 35 U.S.C. § 112, second paragraph. We are also in agreement with appellants that claims 1 to 29 are nonobvious under 35 U.S.C. § 103 over appellants' admitted prior art in the specification, and that claims 8 and 21 are nonobvious under 35 U.S.C. § 103 over appellants' admitted prior art in the specification in view of Rosen.

We find, for the reasons that follow, that the feature recited in claims 1 to 29 on appeal, of providing means responsive to a user designation of a file type to determine a physical format type for the file from plural available physical format types, is neither taught nor would have been suggested by the prior art explicitly applied by the examiner. Accordingly, we will reverse the decisions of the

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examiner rejecting claims 1 to 29 on appeal under 35 U.S.C. § 103. While we cannot say that there is not better prior art available than that applied by the examiner, we can say that the art relied upon does not support the rejection.

For the reasons generally set forth by appellants, we will reverse the decision of the examiner rejecting claims 1 to 29 under 35 U.S.C. § 112, second paragraph, and we will reverse the decisions of the examiner rejecting claims 1 to 29, and 8 and 21, under 35 U.S.C. § 103.

Rejection of Claims 1 to 29 Under 35 U.S.C. § 112, Second Paragraph:

We turn first to appellants' arguments (Brief, pages 7 to 8) that all of the claims on appeal are definite and properly point out and distinctly claim the subject matter regarded as the invention and that the examiner's rejection under 35 U.S.C. § 112, second paragraph, is in error. We agree with appellants. With respect to 35 U.S.C. § 112, second paragraph, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 194 (CCPA 1977) and In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claim is clear, then the claims comply with 35 U.S.C. § 112, second paragraph. See MPEP § 2173.04. In this case, we find that although the claims on appeal are very broad they are reasonably

precise in light of the disclosure and the prior art. Accordingly, we will not sustain the rejection of claims 1 to 29 under 35 U.S.C. § 112, second paragraph.

Rejection of Claims 1 to 29 Under 35 U.S.C. § 103:

We turn next to the question of patentability of claims 1 to 29 under § 103 over appellants' admitted prior art in the specification. We agree with appellants' principal argument (Brief, pages 8 to 9), that the admitted prior art in the specification fails to teach or suggest providing a user interface which allows a user to designate a file type along with means responsive to such designation for determining a physical format type for the file from amongst plural available physical format types and then storing the file on a direct access storage device in conformance with the determined physical format type. Specifically, we cannot agree with the examiner that appellants' admitted prior art (pages 2 to 3 and page 8) taught or would have suggested the recited "means responsive to user designation . . ." (independent system claim 1 on appeal) or the step of "responsive to user designation of the file type for a file determining . . ." (independent method claim 14 on appeal). We find that pages 2 to 3 of the specification merely admits that it was known in the prior art to store data in different physical formats such as spiral (e.g., for video data) and concentric tracks (e.g., for textual data), and that page 8 of the specification merely admits that it was known in the prior art to provide an interface for user selected programs/procedures in an operating system to invoke applications in a data processing system. Nowhere in the admitted prior art in the specification is there any indication that it was known to

determine a physical format type for a file from plural available physical format types in response to a user designation of a file type.

With respect to dependent claims 8 and 21, we note that Rosen also fails to teach or suggest the feature missing from the admitted prior art of providing a user interface which allows a user to designate a file type along with means responsive to such designation for determining a physical format type for the file from amongst plural available physical format types. Accordingly, we are in agreement with appellants (see Reply Brief, page 2) that claims 8 and 21 are nonobvious under 35 U.S.C. § 103 over the admitted prior art in view of Rosen.

In view of the foregoing, the decision of the examiner rejecting claims 1 to 29 under 35 U.S.C. § 103 is reversed. In addition, the decision of the examiner rejecting claims 8 and 21 under 35 U.S.C. § 103 is also reversed.

We note that our decision does not in any way preclude the examiner from presenting a prima facie case of obviousness of these claims under 35 U.S.C § 103 using the same admitted prior art, the prior art of record, or additional prior art. In fact, in our view, the obviousness of the invention as set forth in claims 1 to 29 does not only raise the question of whether it would have been obvious to store video and textual data in respective spiral and concentric tracks on a single disk, but also, whether it would have been obvious to provide a means for determining a physical file format type with the system and method set forth in the admitted prior art.

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For example, in the patent to Yoshida et al. (4,420,828) cited by appellants as prior art, a data processing system and method for storing both spiral and concentric tracks of data on a single disk is disclosed. See at least column 1, lines 38 to 42 and Figure 3 of Yoshida et al.. In addition, in the patent to Hedlund et al. (4,138,741) cited by appellants as prior art, a data processing system and method for storing both spiral and concentric tracks of data on a single disk is also disclosed. See at least column 2, lines 45 to 49 and Figure 1 of Hedlund et al..

In our view, the examiner should consider whether it would have been obvious to one of ordinary skill in the art to combine the feature of storing and designating concentric and spiral data tracks on a single disk to the admitted prior art data processing system and method in order to allow for improved data storage and access as taught by the admitted prior art. By storing and accessing text files in a concentric format, maximum utilization may be made of available memory space, and by storing and accessing video files in a spiral format, video data may be located quickly during a read operation. See admitted prior art at page 3 of the specification. We do not make a rejection under 37 C.F.R. § 1.196(b) nor prejudice the issue because any record in support of or against any such rejection should be initiated by the examiner and not by us.

Accordingly, we remand this application to the examiner for consideration of whether any rejections are appropriate under 35 U.S.C. § 103. The file wrapper in this case should reflect either why the claims are patentable over the art of record or the basis for any appropriate rejection.

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REVERSED AND REMENDED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ERIC FRAHM)	
Administrative Patent Judge)	

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EF/ki