

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING-SYAN CHEN
KUN-LUNG WU and
PHILIP SHI-LUNG YU

Appeal No. 1998-0527
Application 08/344,325

ON BRIEF

Before MARTIN, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

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Application No. 08/344,325

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 3-6 and 8-11, which constitute all the claims remaining in the application. An amendment after final rejection was filed on January 13, 1997 and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for maintaining data coherency between servers and mobile remote units in a data communications system. More specifically, the invention is directed to a technique which enables a remote unit upon "waking up" to still maintain most of its cached storage. The technique of the invention is referred to as Grouping with Cold update set REtention (GCORE).

Representative claim 10 is reproduced as follows:

10. A method, for maintaining data coherency between one or more servers and one or more remote units adapted to operate in a disconnected mode, in an information handling system, comprising the steps of:

storing data objects in one or more servers;

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grouping data objects stored in the one or more servers into one or more groups;

periodically broadcasting one or more invalidation reports from one or more of the servers to one or more of the remote units, each invalidation report comprising information related to one or more data objects updated during one or more most recent broadcast intervals predetermined intervals;

excluding, by the one or more servers, one or more recently updated objects from a group; and

testing a group validity, when requested by a remote unit, without object-by-object comparison.

The examiner relies on the following references:

Nelson et al. (Nelson)	5,452,447	Sep. 19, 1995 (filed Dec. 21, 1992)
Hoover et al. (Hoover)	5,560,005	Sep. 24, 1996 (filed Feb. 25, 1994)

Claims 3-6 and 8-11 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Hoover in view of Nelson.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for

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the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants'

arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 3-6 and 8-11. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 3]. Consistent with this indication appellants have made no separate arguments with respect to any

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of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will only consider the rejection against independent claim 10 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so

doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having

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ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those

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arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

In the rejection of independent claims 10 and 11, the examiner essentially found that Hoover taught all the features of these claims except for the remote terminals each having a cache memory. The examiner cited Nelson for its disclosure of a cache memory. The examiner concluded that it would have been obvious to one having ordinary skill in the art to use Nelson's cache memories in Hoover's remote terminals [answer, pages 3-5].

Although there are similar recitations in claims 10 and 11, representative claim 10 makes no mention of cache memories or cache contents. Therefore, the cache memory teachings of Nelson are not relevant to the invention as recited in claim 10. For all practical purposes, the examiner's rejection of claim 10 is based on the examiner's position that every step of claim 10 is disclosed, taught or suggested by the system of Hoover. Our determination in this case is dictated simply by a consideration

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of whether the examiner has properly interpreted the teachings of Hoover and the scope of claim 10.

Appellants argue that Hoover does not teach periodically broadcasting one or more invalidation reports, grouping objects into one or more groups, or validity checking without object-by-object comparison as recited in claim 10 [brief, pages 4-5].

Although the examiner simply states that these steps are performed in Hoover, we agree with appellants that Hoover does not support the teachings attributed to it by the examiner.

We have carefully considered the specific portions of Hoover identified by the examiner as well as the rest of the document, and we are unable to find the teachings alleged to be there by the examiner. We basically agree with each of appellants' arguments regarding why the recitations of claim 10 are not taught or suggested by Hoover. The examiner does not respond to appellants' arguments, but merely repeats the broad assertion that all the features of claim 10 are met by Hoover. Since the examiner has not explained how he interprets the claim language to find the recitations present in Hoover, and since we are unable to find teachings within

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Hoover (or Nelson) for the

limitations of claim 10, we conclude that the examiner has failed to establish a prima facie case of obviousness.

In summary, we do not sustain the examiner's rejection of claims 3-6 and 8-11 based on the teachings of Hoover and Nelson. Therefore, the decision of the examiner rejecting claims 3-6 and 8-11 is reversed.

REVERSED

John C. Martin)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Joseph F. Ruggiero)	
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