

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HITOSHI KAKUTA,
YOSHIHISA KAMO, and HAJIMI AOI

Appeal No. 1997-3851
Application No. 08/355,210

HEARD: Sep. 14, 2000

Before FLEMING, LALL, and BARRY, Administrative Patent Judges.
FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 27 and 28. Claims 1 through 24 have been canceled. Claims 25 and 26 have been allowed.

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The present invention relates to an array disk subsystem having a plurality of secondary storage controllers and a plurality of secondary storages wherein the subsystem is capable of achieving ordinary input/output processing even while a backup processor is being executed.

The independent claim 27 is reproduced as follows:

27. An array disk subsystem, comprising:

a) an ECC generator for producing an ECC for a plurality of data;

b) a plurality of data disks for storing said plurality of data and said ECC; and

(c) a write data storage means for, when a write instruction is issued to one of said data disks while said data disks execute an operation which prevents said data disks from inputting and outputting data, temporarily storing data to be written in said one of said data disks.

The Examiner relies on the following references:

Dishon et al. (Dishon)	4,849,978	Jul. 18, 1989
Satoh et al. (Satoh)	5,313,612	May 17, 1994
	(effective filing date Aug. 31, 1989)	

Claims 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dishon in view of Satoh.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs¹ and answers² for the respective details thereof.

OPINION

We will not sustain the rejection of claims 27 and 28 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6

¹Appellants filed an appeal brief on September 23, 1996. Appellants filed a reply brief on February 13, 1997. The Examiner responded by allowing claims 25 and 26 in view of the terminal disclaimer filed with the reply brief. The Examiner is silent as to whether the Examiner considered and entered the reply brief. However, in view of the fact that the Examiner had responded to the terminal disclaimer which was referenced in the reply brief and did not make a positive statement that the reply brief has not been entered, we will view that the Examiner did consider and enter the reply brief and the reply brief is properly before us for our consideration. Appellants filed an additional supplemental appeal brief on February 18, 2000.

²The Examiner filed an answer on December 13, 1996. The Examiner filed a supplemental Examiner's answer on March 12, 1997.

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(Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 519 U.S. 822 (1996) (**citing** *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984)).

On pages 2 and 3 of the reply brief, Appellants point out that claim 27 sets forth "when a write instruction is issued to one of said data disks all said data disks execute an operation which prevents said data disks from inputting and outputting data." Appellants further point out that this limitation sets forth that when the condition exists that an operation is being executed by the data disks which prevents the data disks from inputting and outputting data, the write data storage means temporarily stores data to be written in one of the data disks. On page 4 of the reply brief, Appellants argue that Satoh does not teach or disclose storing data temporarily when an operation is executed that prevents

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the data disks from inputting and outputting data to the optical disk drive 6.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. (BNA) 459, . . . (1966), focused on the procedural and evidentiary processes in reaching a conclusion under section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". [*Citing*] *In re Warner*, 54 C.C.P.A. 1628, 379 F.2d 1011, 1016, 154 U.S.P.Q. (BNA) 173, 177 (CCPA 1967).

Upon our review of Dishon and Satoh, we fail to find that either of these references teaches "a write data storage means

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for, when a write instruction is issued to one of said data disks while said data disks execute an operation which prevents said data disks from inputting and outputting data, temporarily storing data to be written in said one of said data disks" as recited in Appellants' claim 27. Satoh teaches in column 5, lines 31 through 45, that a disk cache 5 can be used to place a directory DIR whose rewriting frequency is maximized in order to decrease the number of excesses to the data optical disk drive 6. Thus, Satoh does not teach or disclose storing data temporarily in a disk cache or a work optical disk drive 7 when an operation is executed the prevents the data disk from inputting and outputting data to the optical disk drive 6. Satoh is concerned with accomplishing a reduction in the number of accesses of the data disk drive 6 by using cache memory 5 in the work optical disk drive 7. However, Satoh is not concerned with the problem of storing data temporarily because the data disks are not available because an operation is underway that prevents the data disks from inputting and outputting data.

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In view of the foregoing, we have not sustained the rejection of claims 27 and 28 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

	Michael R. Fleming)	
	Administrative Patent Judge)	
)	
)	
	Parshotam S. Lall)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Lance Leonard Barry)	
	Administrative Patent Judge)	

MRF:tdl

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