

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES HAYTER

Appeal No. 1999-2263
Application 08/581,721

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-10, which constituted all the claims in the application. An amendment filed concurrently with the appeal brief cancelled claims 2-4 and 7-10 and was entered by the examiner. Accordingly, this appeal is now directed to the rejection of claims 1, 5 and 6.

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The disclosed invention pertains to a method and apparatus for migrating a source data center to a target data center to support the migration of one or more applications from the source data center to the target data center.

Representative claim 1 is reproduced as follows:

A method for migrating volumes of data supporting a source data center, comprising a source mainframe and a source DASD, to a target data center, comprising a target mainframe and a target DASD, to support the migration of one or more applications from the source mainframe to the target mainframe, comprising the steps of:

- (a) verifying data integrity on the source DASD;
- (b) initiating one or more processes to mirror the volumes of data from the source DASD to the target DASD, and to mirror one or more data updates to the volumes of data by the applications of the source mainframe to the target DASD;
- (c) synchronizing said data updates to the volumes of data by the applications of the source mainframe with corresponding data updates to the target DASD;
- (d) deactivating the applications of the source mainframe;
- (e) mirroring one or more remaining data updates to the volumes of data by the applications of the source mainframe to the target DASD;
- (f) disconnecting the source data center from the target data center; and
- (g) bringing the target data center on-line and initiating the applications of the target mainframe.

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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 1, 5 and 6. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 6]. Consistent with this indication appellant has made no separate arguments with respect to any 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 consider the rejection against independent claim 1 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

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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 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

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Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Yanai provides a data storage backup by migrating data from a source data center to a target data center which can be used in the event that the source data center is hit by a major disaster. With respect to representative, independent claim 1, the examiner finds that Yanai teaches steps (a), (b), (c) and (g). Although Yanai does not explicitly disclose steps (d), (e) and (f), the examiner finds that these steps would have been obvious to the artisan when the data transfer of Yanai is applied to an intentional data migration of a data center as described in the admitted prior art [answer, pages 3-5].

Appellant makes three main arguments in response to the rejection. First, appellant argues that the examiner has failed to establish a prima facie case of obviousness because Yanai and the admitted prior art do not teach steps (d), (e) and (f) of claim 1. Second, appellant argues that the only

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suggestion to apply the teachings of Yanai to a controlled data center migration comes from appellant's own disclosure. Third, appellant argues that the successful results of his Beta Test are evidence of improved/unexpected results which is evidence of nonobviousness [brief, pages 11-21].

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With respect to appellant's first argument, the examiner responds that Yanai inherently performs steps (d) and (f), and that step (e) is suggested by the combined teachings of Yanai and the prior art data center migrations. With respect to appellant's second argument, the examiner responds that the artisan would have recognized the obviousness of applying Yanai's mirroring method to a data center migration event as described in the prior art. With respect to appellant's third argument, the examiner responds that the Beta Test evidence submitted by appellant as part of the specification of this application does not establish nonobviousness of the claimed invention [answer, pages 6-11].

Appellant responds that the claimed invention is directed to the migration of applications from a source mainframe to a target mainframe, and not just the transfer of data for backup purposes [reply brief].

After a careful review of the record in this case, we agree with the position argued by appellant. In our view, the disposition of this appeal is determined by appellant's second argument discussed above. We agree with appellant that there is no suggestion within the applied prior art that the

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techniques of Yanai should be applied to a data center migration. The mere fact that it was known to migrate data from one data center to another data center in the prior art does not establish the obviousness of using Yanai's teachings in that environment. The only suggestion to apply data mirroring techniques to a data center migration comes from appellant's own disclosure of the invention. As argued by appellant, it is improper to use his own disclosure to provide the motivation necessary for modifying the prior art to arrive at the claimed invention. We can find no suggestion in Yanai and the admitted prior art data migration techniques to apply the techniques of Yanai to these prior art data migration techniques.

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In summary, since we do not find the examiner's proposed modifications to be suggested by the applied prior art, we do not sustain the examiner's rejection of claims 1, 5 and 6. Therefore, the decision of the examiner rejecting claims 1, 5 and 6 is reversed.

REVERSED

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KENNETH W. HAIRSTON))
Administrative Patent Judge)	
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JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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