

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RALPH GUNDACKER,
BRIAN J. SKERRY, and
JAMES D. WARREN

Appeal No. 2005-2244
Application No. 10/157,386

ON BRIEF

Before KRASS, LEVY, and MacDONALD, **Administrative Patent Judges**.

MacDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-22.

Invention

Appellants' invention relates to a method, apparatus, article, and system for a first device to configure a second device. Initially, an indication is received that the first device has been granted access to a bus. In response to the indication and a signal from a processor, a control signal is generated to couple

the second device to the bus. Thereafter, the first device configures the second device.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method comprising:

receiving an indication that a first device has been granted access to a bus;

in response, at least in part, to the indication, asserting a control signal that results in coupling of signal line of a second device to the bus; and

after providing the control signal, configuring by the first device of the second device;

the first device comprising first logic to generate an output based upon the indication and another signal from a processor, and second logic to generate the control signal based upon the output and a clock signal propagated from the bus.

References

The references relied on by the Examiner are as follows:

Luse et al. (Luse) U.S. Pub. Appl. No. 2003/0212846 Nov. 13, 2003
(Filed May 7, 2002)

Solari et al. (Solari); “PCI and PCI-X Hardware Software Architecture and Design”; 5th ed.; 2001; pp. 3, 38, 41, 264, 265, and 749-751.

Rejections At Issue

Claims 1-22 stand rejected under 35 U.S.C. § 102 as being anticipated by Luse.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-22 under 35 U.S.C. § 102.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Whether the Rejection of Claims 1-22 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Luse does not fully meet the invention as recited in claims 1-22. Accordingly, we reverse. For purposes of our discussion we treat claim 1 as exemplary of all the claims on appeal.

¹ Appellants filed an appeal brief on October 5, 2004. Appellants filed a reply brief on February 1, 2005. The Examiner mailed an Examiner's Answer on January 13, 2005.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue at pages 6-7 of the brief, that the evidence does not show that the matter that is alleged by the Examiner to be inherent in Luse would be necessarily present in Luse. The Examiner responds at pages 3-8 of the answer that there necessarily must be an indication (A), a signal from a processor (B), and a clock signal (C) from the bus. Further, all must be input to logic that generates a control signal (D). We agree with the examiners reasoning that such would necessarily be present in Luse.

However, we do not agree with the Examiner that the remaining limitations of the last three lines of claim 1 are necessarily present in Luse. There is nothing in Luse that necessitates that the logic be comprised of first and second logic with the input/output relationships as in claim 1. Rather, Luse could equally be implemented with a single logic that receives (A), (B), and (C), and then outputs (D). Further, there is nothing in Luse that necessitates that the logic be comprised within rather than outside the first device. These distinctions may seem trivial given that they seem obvious in the extreme. However, they are in fact critical given that the Luse reference is not available as prior art under 35 U.S.C. § 103.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

Other Issues

We have noted the following typographical errors in Appellants specification:

At page 5, line 28, both occurrences of "48" should read --38--; and

At page 11, line 15, "200" should read --20--.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-22.

REVERSED

Errol Krass)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Stuart S. Levy)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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