

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 Paul E. Luse, Dieter E. Massa, and Norbert Lewalski-Brechter

Appeal No. 2006-0721
Application No. 10/113,458

ON BRIEF

Before JERRY SMITH, BARRY, and MacDONALD, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-30. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal concerns "device resource allocation." (Spec., p. 1, l. 4.) In a modular redundant array of independent or inexpensive disks on a motherboard ("MROMB"), MROMB circuitry on a circuit card is used to configure and control an input/output ("I/O") controller independently of a host processor. More specifically, the circuitry allocates predetermined addresses to the I/O controller. Depending upon the addresses that the host processor allocates to other devices,

however, the I/O controller's addresses may conflict with those of the other devices. (*Id.* at II. 7-19.)

In contrast, the appellants' invention allocates of a set of addresses to an I/O processor on a MROMB circuit card. The I/O processor, in turn, allocates a subset of those addresses to an I/O controller. If the set of addresses to an I/O processor is changed, the I/O processor changes the subset of of those addresses allocated to the I/O controller. (*Id.*, p. 29, II. 5-10.) An further understanding of the invention can be achieved by reading the following representative claims.

1 . A method comprising:

if a first device determines that a processor has initiated a configuration cycle, holding off by the first device the configuration cycle;

after the holding off the configuration cycle, allocating by the processor a first set of resources to the first device;

allocating, by the first device, a second set of resources to a second device, the first set of resources comprising the second set of resources; and

if the first set of resources is changed, changing, by the first device, the second set of resources.

5. A method comprising:

enabling, by a first device, a second device to perform one or more pending operations; and

prior to the enabling of the second device to perform the one or more pending operations, determining, by the first device, whether a change has occurred to a first set of resources associated with the first device;

wherein the second device is associated with a second set of resources comprised in the first set of resources, and the first set of resources is allocated to the first device by a processor after the first device has held off a configuration cycle initiated by the processor.

Claims 1-30 stand rejected under 35 U.S.C. § 102(a) as anticipated by Intel Corporation, *MROMB Design Considerations Using the Intel 80303® I/O Processor Application Note* ("MROMB Note").

II. OPINION

At the outset, we remind the appellants that in a specification "[a] brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed." 37 C.F.R. § 1.73. "The brief

summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches." M.P.E.P. § 608.01(d). Here, because the appellants' instant specification omits such a brief summary, one should be added.

"When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (Sep. 30, 2004).

Here, the only claims that the appellants argue individually are claims 1 and 5. (Appeal Br.¹ at 12.) Therefore, we select claim 1 as the sole claim on which to decide

¹We cite to the appellants' amended appeal brief, filed June 6, 2005, because their original appeal brief was defective. (Notification of Non-Compliant Appeal Br.) The latter brief has not been considered in deciding the appeal.

the appeal of claims 1-4, 8-11, 15-18, and 22-24 and claim 5 as the sole claim on which to decide the appeal of claims 5-7, 12-14, 19-21, and 25-30.

A. CLAIMS 1-4, 8-11, 15-18, AND 22-24

With the aforementioned representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. The examiner finds, "MROMB Note does disclose the limitation 'if the first set of resources (i.e. address range) is changed (i.e. host relocates the base address originally assigned to the IOP BAR), changing (i.e. reprogramming), by the first device, the second set of resources (Section 4.1 , Second Paragraph).'" (Examiner's Answer at 10.) The appellants do not address the examiner's specific application of Section 4.1 of the MROMB Note. Instead, they merely underline limitations in claim 1 and allege, "These specific combinations of limitations of the independent claims are nowhere disclosed or suggested in the MROMB Note." (Appeal Br. at 12.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated." *Ex parte Pittaro*, No. 2005-2057, 2006 WL 1665401, at *2 (Bd.Pat.App & Int. 2006).

1. Claim Construction

"Analysis begins with a key legal question — *what* is the invention *claimed*?"

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations: "if the first set of resources is changed, changing, by the first device, the second set of resources." Giving the representative claim its broadest, reasonable construction, the limitations require a first device to change resources allocated to a second device in response to a change in the resources allocated to the first device.

2. Anticipation Determination

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.'" *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Of course, anticipation "is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 & n.11, 1 USPQ2d 1241, 1245 & n.11 (Fed. Cir. 1986)). "An anticipatory reference . . . need not duplicate word for word what is in the claims." *Standard Havens Prods. v. Gencor Indus.*, 953 F2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).

Here, "[t]he purpose of th[e] [MROMB Note] is to provide to system design engineers the design considerations to take into account when designing Modular RAID on Motherboard (MROMB) solutions using the Intel® 80303 I/O Processor (80303 IOP)." (§ 1.0 (internal footnote omitted.)) The reference explains that "[t]he 80303 IOP communicates with the I/O controller via the 80303 IOP's primary PCI bus which is visible to the host system" (§ 2.1.) Such communication enables "the 80303 IOP . . . to setup the necessary resources in host memory for the I/O controller," (§ 3.2, ¶ 2), and "to reserve space for the I/O controller within the BAR (Base Address Register) of the 80303 IOP," (§ 4.1, ¶ 2); "[t]he IOP configures the I/O controller to respond to PCI transactions within this address range." (*Id.*)

"[I]t is possible for the host to relocate the base address originally assigned to the IOP BAR." (*Id.*) We agree with the examiner's finding that reallocating such address resources to the IOP teaches the claim's change in resources allocated to a first device. Such a reallocation, explains the MROMB "require[s] the IOP to . . . reprogram the I/O controller accordingly," (*id.*), i.e., to change the space reserved for the I/O controller within the IOP's relocated BAR so that the I/O controller can respond to PCI transactions within the relocated address range. We further agree with the examiner's finding that the IOP's changing of the space reserved for the I/O controller teaches the claim's first device's changing resources allocated to a second device in

response to a change in the resources allocated to the first device. Therefore, we affirm the rejection of claim 1 and of claims 2-4, 8-11, 15-18, and 22-24, which fall therewith.

B. CLAIMS 5-7, 12-14, 19-21, AND 25-30

The examiner finds, "MROMB Note discloses . . . determining, by the first device (i.e. IOP), whether a change has occurred to a first set of resources (i.e. address range) associated with the first device (i.e. host relocates the base address originally assigned to the IOP BAR), wherein the second device is associated with a second set of resources comprised in the first set of resources (section 4.1). . . ." (Examiner's Answer at 4.) The appellants do not address the examiner's specific application of Section 4.1 of the MROMB Note. Instead, they merely underline limitations in claim 5 and allege, "These specific combinations of limitations of the independent claims are nowhere disclosed or suggested in the MROMB Note." (Appeal Br. at 12.)

1. Claim Construction

Claim 5 recites in pertinent part the following limitations: "prior to the enabling of the second device to perform the one or more pending operations, determining, by the first device, whether a change has occurred to a first set of resources associated with the first device." Giving the representative claim its broadest, reasonable construction, the limitations require a first device to determine whether resources allocated thereto

have been changed before the first device enables a second device to perform additional operations.

2. Anticipation Determination

As explained regarding claim 1, *supra*, the MROMB Note discloses that the IOP changes the space reserved for the I/O controller in response to the host relocating the base address originally assigned to the IOP's BAR. A skilled artisan knows that the IOP must first determine that the base address originally assigned to its BAR has been relocated before it responds to the relocation. We agree with the examiner's finding that the IOP's determining that the base address originally assigned to its BAR has been relocated teaches the first device's determining whether resources allocated thereto have been changed as claimed.

As also explained regarding claim 1, *supra*, the reference further discloses that its IOP responds to the relocation of the address originally assigned to its BAR by changing of the space reserved for the I/O controller. A skilled artisan knows that such a change must be performed before the I/O controller is enabled to perform additional operations; the I/O controller's proceeding before making the change cold lead to errors. Therefore, we affirm the rejection of claim 5 and of claims 6, 7, 12-14, 19-21, and 25-30, which fall therewith.

III. CONCLUSION

In summary, the rejection of claims 1-30 under § 102(a) is affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the appellant's amended appeal brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

BLAKELY SOKOLOFF TAYLOR & ZAFMAN12400 WILSHIRE BOULEVARDSEVENTH
FLOORLOS ANGELES, CA 90025-1030

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