

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 J. GARNETT,  
JAMES E. KING, MARTIN P. MAYHEAD,  
AND PETER HEFFERNAN

---

Appeal No. 2006-1937  
Application No. 10/215,651

---

ON BRIEF

---

Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

This is a decision on appeal from the final rejection of claims 1-6 and 9-27.

The invention pertains to computer storage systems. In particular, information processing cartridges, so-called “blades” –because they resemble rectangular slabs or blades–, are removably receivable in a rack mountable shelf having a service processor.

Representative independent claim 12 is reproduced as follows:

12. A server blade configured to be removably receivable in a rack mountable shelf having a service processor, the server blade comprising:
  - a processor, and
  - a blade service controller, the blade service controller operable to transmit a signal to the service processor to identify the server blade as a particular one of a predetermined set of server blade types.

Appeal No. 2006-1937  
Application No. 10/215,651

The examiner relies on the following references:

Jackson et al. (Jackson)	6,452,809	Sep. 17, 2002 (filed Nov. 10, 2000)
Guyer et al. (Guyer)	6,583,989	Jun. 24, 2003 (filed Dec. 22, 2000)
Bottom et al. (Bottom)	2002/0124114	Sep. 05, 2002 (eff. filing date Mar. 05, 2001)

Claims 12-17 stand rejected under 35 U.S.C. § 102 (e) as anticipated by Guyer.

Claims 1-6, 9-11, and 18-27 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Bottom and Guyer with regard to claims 1-6 and 9-11, while offering Jackson and Guyer with regard to claims 18-27.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

#### OPINION

An anticipatory reference is one that describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

Independent claims 12 and 17 each requires that the blade service controller be “operable to transmit a signal to the service processor to identify the server blade as a particular one of a predetermined set of server blade types.”

While the examiner indicates that Guyer describes such a feature at column 18, lines 41-42, we disagree. The cited portion of Guyer describes a geography bus that assigns geographic identifiers for each compute element in a computer system, enabling server management software to determine the physical location of each device within the RAIC and to identify the location of a failed compute element. The identification of the location of a server blade is not the same as the identification of a “particular one of a predetermined set of server blade types,” as claimed.

We also do not agree with the examiner’s explanation, at page 7 of the answer, that the claim language “operable” is not a positive claim limitation and the device merely has to be capable of performing the function so the examiner gives the phrase “little patentable weight.”

Each limitation of a claim must be given patentable weight. Moreover, the recitation in the claim of an element being “operable” to do something is clearly a positive limitation since it defines the function that the element performs or must be capable of performing. The service management software in Guyer is described as determining the location of a device within the RAIC and identifying the location of a failed compute element. Nowhere in Guyer is there a suggestion of the software having the capability of identifying a particular one of a predetermined set of server blades, as claimed. The examiner indicates, at page 7 of the answer, that since Guyer teaches a blade service controller 125 of the server blade 29 with an assigned geographic identifier, “that would surely be capable of transmitting a signal to a service processor 67 to identify itself as being a particular one of a specific type of server blade.” This unsupported conclusion by the examiner is mere speculation since there is no evidence in Guyer,

Appeal No. 2006-1937  
Application No. 10/215,651

nor has the examiner pointed to anything, indicative of the software performing or capable of performing the function ascribed to it by the examiner. Such speculation is improper in a rejection under 35 U.S.C. § 102 (e).

Accordingly, we will not sustain the rejection of claims 12-17 under 35 U.S.C. § 102 (e).

Similarly, we will not sustain the rejection of claims 1-6, 9-11, and 18-27 under 35 U.S.C. § 103 since each of independent claims 1, 11, 18, and 24 contains the limitation of the blade service controller “operable to transmit a signal to an external service processor to identify the server blade as a particular one of a predetermined set of server blade types,” or something akin thereto, and the examiner, in each instance, relies on Guyer to provide this limitation.

Since neither Bottom nor Jackson provides for this deficiency, we will not sustain the rejection of claims 1-6, 9-11, and 18-27 under 35 U.S.C. § 103.

The examiner’s decision is reversed.

Appeal No. 2006-1937  
Application No. 10/215,651

REVERSED

JAMES D. THOMAS  
Administrative Patent Judge

ERROL A. KRASS  
Administrative Patent Judge

JERRY SMITH  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)  
)

EAK/kis

Appeal No. 2006-1937  
Application No. 10/215,651

B. NOEL KIVLIN  
CONLEY, ROSE & TAYON, P.C.  
P. O. BOX 398  
AUSTIN, TX 78767