

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 JEFF A. ZIMNIEWICZ, GARY P. RADEN,
RYAN M. HELGESON and WILLIAM M. NELSON

Appeal No. 2006-2064
Application No. 09/771,761

HEARD: September 13, 2006

Before KRASS, RUGGIERO, and SAADAT, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-31, which are all of the claims pending in this application.

The claimed invention relates to a system and method for managing the installation and/or removal of components including at least one shared component which is used by other components and has substantially no

useful purpose by itself. Further included is a validation engine which provides a valid order for components identified for installation ensuring that each shared component is installed subsequent to non-shared components.

Claim 1 is illustrative of the invention and reads as follows:

1. A system to facilitate installation and/or removal of components including at least one shared component, comprising:

a validation engine operative to provide a valid order; and

an installer operative to control at least one of an install and removal operation of the components based on the valid order and operative to effect manipulation of at least one property associated with the at least one shared component to reflect dependency for the at least one shared component according to the installation or removal thereof.

The Examiner relies on the following prior art:

Taylor	5,721,824	Feb. 24, 1998
Kruger et al. (Kruger)	6,367,075	Apr. 02, 2002 (filed Jun. 30, 1999)
Curtis	6,442,754	Aug. 27, 2002 (filed Mar. 29, 1999)

Claims 1, 8-13, 16, 18, 21, 22, 25, and 26 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Curtis. Claims 2-7, 14, 15, 17, 19, 20, 23, 24, and 27-31 stand finally rejected under 35 U.S.C. § 103(a). As

evidence of obviousness, the Examiner offers Curtis in view of Taylor with respect to claims 2-4, 14, 15, 17, 23, 24, and 29-31, and Curtis in view of Kruger with respect to claims 5-7, 19, 20, 27, and 28.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for their respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

¹ The Appeal Brief was filed February 22, 2005. In response to the Examiner's Answer mailed April 25, 2005, a Reply Brief was filed June 27, 2005 which was acknowledged and entered by the Examiner as indicated in the communication mailed April 3, 2006.

It is our view, after consideration of the record before us, that the disclosure of Curtis fully meets the invention as recited in claims 1, 8-13, 16, 18, 21, 22, 25, and 26. In addition, with respect to the Examiner's obviousness rejection, we are of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the appealed claims 2-7, 14, 15, 17, 19, 20, 23, 24, and 27-31. Accordingly, we affirm.

We consider first the Examiner's 35 U.S.C. § 102(e) rejection of claims 1, 8-13, 16, 18, 21, 22, 25, and 26 based on Curtis. At the outset, we note that it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

With respect to independent claims 1, 13, 25, and 26, the Examiner indicates (Answer, pages 9-14) how the various limitations are read on the disclosure of Curtis. In particular, the Examiner directs attention to the illustrations in Figures 3-6 of Curtis as well as the disclosure at various portions of columns 4, 9, and 11-13 of Curtis.

In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Curtis so as to establish a case of anticipation. In particular, Appellants' arguments (Brief, pages 6 and 7; Reply Brief, pages 6-8) focus on the contention that, in contrast to the claimed invention, Curtis does not provide for the

establishment of a valid order in which components are to be installed or removed. According to Appellants, Curtis merely provides a list of dependent components which must be installed before depending programs, but does not provide a valid order for the installation of the dependent components.

After reviewing the Curtis reference in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. We find no error in the Examiner's finding (Answer, pages 9-14) that the Curtis reference which discloses (e.g., column 12, lines 13-50) that dependent program components be installed before depending components therefore provides a valid order for the installation of components as set forth in the appealed claims.

In our view, Appellants' argument asserting that Curtis does not provide a valid order of component installation is not commensurate with the scope of the claims. As pointed out by the Examiner (Answer, page 6), there is no language in the appealed claims which requires a relative order of installation of plural dependent components as argued by Appellants. It is

our opinion that Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Curtis, the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 13, 25, and 26, as well as dependent claims 8-12, 16, 18, 21, and 22 not separately argued by Appellants, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 2-4, 14, 15, 17, 23, 24, and 29-31 in which the Taylor reference is added to Curtis to address the claimed "subsequent installation" and "first and second part" installation features, we sustain this rejection as well. As alluded to by the Examiner (Answer, pages 7 and 8), Appellants' arguments (Brief, pages 8 and 9; Reply Brief, pages 6 and 7) attacking Taylor focus on the contention that Taylor does not disclose the establishment of a valid order for component installation, a feature which, for all of the reason discussed supra, we find to be present in the disclosure of Curtis.

Lastly, we also sustain the Examiner's obviousness rejection of dependent claims 5-7, 19, 20, 27, and 28 in which Kruger is added to Curtis to address, inter alia, the "reference count" feature of the rejected claims. Appellants' arguments in response (Brief, page 9; Reply Brief, page 7) rely on the previously asserted contention that Curtis lacks a disclosure of the establishment of a valid order for component installation, arguments we found to be unpersuasive as previously discussed.

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) rejection of claims 1, 8-13, 16, 18, 21, 22, 25, and 26 , as well as the 35 U.S.C. § 103(a) rejection of claims 2-7, 14, 15, 17, 19, 20, 23, 24, and 27-31. Therefore, the decision of the Examiner rejecting claims 1-31 is affirmed.

Appeal No. 2006-2064
Application 09/771,761

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

JFR:pgc

Appeal No. 2006-2064
Application 09/771,761

Amin & Turocy, LLP
24th Floor, National City Center
1900 East Ninth Street
Cleveland, OH 44114