

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ENRIQUE GUILLEN

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Appeal No. 2006-3284  
Application No. 10/061,871

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ON BRIEF

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Before KRASS, JERRY SMITH and HOMERE, **Administrative Patent Judges.**

HOMERE, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 4 through 9, 18 through 34, all of which are pending in this application. Claims 2, 3, 10 through 17 have been cancelled by Appellant.

We affirm.

***Invention***

Appellant's invention relates generally to a method and system for configuring a server using a configuration file image.

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The server includes a processor (100), which is coupled to a non-volatile memory (106) and a read only memory (ROM) (110), which in turn includes a plurality of configuration profile images. The server subsequently accesses the configuration profile images from the ROM, and writes the retrieved configuration images in the non-volatile memory (106).

Claims 1 and 18 are representative of the claimed invention and are reproduced as follows:

1. A server, comprising:

a processor;

a non-volatile memory coupled to the processor; and

a read only memory coupled to the processor, the read only memory code comprising:

code containing a plurality of server configuration profile images; and

code adapted to read server configuration information indicative of one of the server configuration profile images; and

to write the indicated configuration profile image of to the non-volatile memory.

18. A machine readable medium, comprising:

processor executable configuration code to perform processor executable steps of:

generating a server configuration profile image based on a current configuration of a server;

storing the server configuration profile image in a non-volatile random access memory of the server;

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parsing the server configuration profile image; and  
writing the server configuration profile image to a read  
only memory of the server.

### **References**

The Examiner relies on the following references:

Sun et al. (Sun)	6,636,962	Oct. 21, 2003 (Filed on Dec. 10, 1999)
Trimberger	6,654,889	Nov. 25, 2003 (Filed on Feb. 19, 1999)
Kamper	6,654,797	Nov. 25, 2003 (Filed on May 25, 2000)

### **Rejections at Issue**

A. Claims 1, 4 through 9, 31 through 34, stand rejected under  
35 U.S.C. § 102 as being anticipated by Kamper.

B. Claims 18, 20 through 30 stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over the combination of Kamper and  
Sun.

C. Claim 19 stands rejected under 35 U.S.C. § 103 as being  
unpatentable over the combination of Kamper, Sun and Trimberger.

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Rather than reiterate the arguments of Appellant and the Examiner, the opinion refers to respective details in the Briefs<sup>1</sup> and the Examiner's Answer.<sup>2</sup> Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the Briefs have not been taken into consideration. See 37 CFR 41.37(c)(1) (vii) (eff. Sept. 13, 2004).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the Examiner's rejections, 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 Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in the rebuttal set forth in the Examiner's Answer.

After full consideration of the record before us, we agree with the Examiner that claims 1, 4 through 9, 31 through 34 are

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1 Appellant filed an Appeal Brief on March 3, 2006. Appellant filed a Reply Brief on July 24, 2006.

2 The Examiner mailed an Examiner's Answer on May 22, 2006. The Examiner mailed an office communication on August 14, 2006 stating that the Reply Brief has been entered and considered.

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properly rejected under 35 U.S.C. § 102 as being anticipated by Kamper. We also agree with the Examiner that claims 18, 20 through 30 are properly rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Kamper and Sun.

Additionally, we agree with the Examiner that claim 19 is properly rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Kamper, Sun and Trimberger. Accordingly, we affirm the Examiner's rejections of claims 1, 4 through 9, 18 through 34 for the reasons set forth in the Examiner's Answer, as further expanded upon here, and for the reasons set forth **infra**.

**I. Under 35 U.S.C. § 102(e), is the Rejection of Claims 1, 4 through 9, 31 through 34 as Being Anticipated By Kamper Proper?**

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 representative claim 1, Appellant argues in the Appeal and Reply Briefs that the Kamper reference does not disclose the limitation of a plurality of server configuration

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profile images stored in a ROM. Particularly, at pages 11 and 13 of the Appeal Brief, Appellant states the following:

[T]he Appellant believes that the Examiner is misconstruing the sections of the Kamper reference that mention configuring a "plurality of servers" as somehow necessarily disclosing the storage of a "plurality of server configuration profile images," as recited in independent claim 1. This innovation, however, is clearly not present in the Kamper reference.

... On the contrary, the Appellant respectfully asserts that the sections of the Kamper reference relied upon by the Examiner merely disclose a removable storage device that stores a *single profile image* that may then be used to configure a *plurality of different servers*. See Kamper, col. 5, lines 20-26. In other words, a user could employ the smart card 320 of the Kamper reference to configure multiple servers, but each of these multiple servers would be *configured identically*, because there is *only one set of configuration data* on the smart card 320.

Further, at page 4 of the Reply Brief, referring to column 6, lines 35 through 42 of the Kamper reference, Appellant states the following:

This text actually teaches a process for searching devices coupled to the server to locate a configuration profile- not identifying a particular profile based on what devices are coupled to the server.

To determine whether claim 1 is anticipated, we must first determine the scope of the claim. We note that representative claim 1 reads in part as follows:

[C]ode containing a plurality of server configuration profile images.

At page 5, paragraph 14, lines 4 through 7, Appellant's specification states the following:

The ROM 110 in Figures 1-2 or the ROM 314 contains server configuration profile images 300. These profile images 300, which may be stored in a reserved or protected area of Basic Input/Output System (BIOS) code, enable a single high-end server to adopt any of the corresponding server appliance personalities.

Thus, representative claim 1 does require a plurality of server configuration profile images stored in a ROM.

Now, the question before us is what Kamper would have taught to one of ordinary skill in the art? To answer this question, we find the following facts:

1. At column 4, lines 6 through 13, Kamper states the following:

The server 118 is provided with boot instructions such that, upon power-up, the server 118 sends a request to the removable storage device reader 120 to read configuration data from the removable storage device inserted therein. **This configuration data may include, for example, the IP address of the server, the hostname, the netmask, the gateway, domain and nameserver information for the server 118.** [Emphasis added].

2. At column 5, lines 20 through 26, Kamper states the following:

With the present invention, **the same removable storage device reader may be used to configure a plurality of servers.** That is, the

removable storage device reader is capable of being easily moved and coupled to a plurality of servers one after the other. The user may make use of the same removable storage device or different removable storage devices for each of the plurality of servers. [Emphasis added].

3. Further, at column 6, lines 35 through 47, Kamper states the following:

If a configuration profile does not exist, the server looks to a specific location for a configuration profile on a smart card. This specific location is based on a determination made by the server of which devices are coupled to the server. For example, the server may have settings indicating an order in **which devices are to be searched for configuration profiles**. This may be similar to setting the boot sequence in BIOS with conventional computers. In response to finding a configuration profile on the removable medium, in this example a smart card, the smart card reader reads the configuration profile data from the smart card and stores it in the server. The server is thereby configured for use in the appropriate network. [Emphasis added].

With the above discussion in mind, we find that with regard to representative claim 1, Kamper teaches a method for configuring a plurality of servers using corresponding configuration files located on a removable storage device. Particularly, Kamper teaches that in order to determine the location of a desired configuration profile, a server must first determine which devices that it is coupled to. Then, the server

subsequently searches configuration files stored in the identified devices for a desired configuration profile. Upon finding that the desired configuration profile is located on the removable storage device, the server sends a request to the storage device reader, which reads configuration data from the removable storage device inserted therein to thereby configure the particular server.

It is our view that one of ordinary skill in the art at the time of the present invention would have readily found that Kamper's teachings amount to the Appellant's invention as set forth in representative claim 1. The ordinarily skilled artisan would have duly recognized that Kamper's disclosed mechanism for configuring a plurality of servers performing different functions would require the use of different configuration data in order for the servers to distinctly operate as intended. Further, the ordinary skilled artisan would have also recognized that Kamper's teaching of allowing a server to search for a particular configuration profile among configuration files stored in devices connected to said server (column 6, lines 37 through 40) amounts to more than one configuration file being available to configure the different servers. Consequently, the ordinary skilled artisan would have aptly recognized that Kamper's teaching of locating for each distinct server a desired configuration file on

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the removable storage device necessarily amounts to locating a corresponding configuration file from among a plurality of configuration files stored on the removable storage device when different servers are being configured. Consequently, we do not find error in the Examiner's stated position, which concludes that Kamper teaches the limitation of storing a plurality of server profile images on the ROM.

It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to the ordinarily skilled artisan the invention as set forth in claim 1. Accordingly, we will sustain the Examiner's rejection of claims 1, 4 through 9, 31 through 34.

**II. Under 35 U.S.C. § 103, is the Rejection of Claims 18, 20 through 30 under 35 U.S.C. § 103 as being unpatentable over the combination of Kamper and Sun Proper?**

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in

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the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788. Thus, the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. **In re Kahn**, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing **In re Kotzab**, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also **In re Thrift**, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

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An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to representative claim 18, Appellant argues in the Briefs that neither Kamper nor Sun teaches generating a server configuration profile image based on a current configuration server. Particularly, at page 24 of the Appeal Brief, Appellant states the following:

Appellant respectfully asserts that the Kamper reference does not teach or suggest "generating a server configuration profile image based on a *current configuration of a server*," as recited in claim 18. (Emphasis added). Moreover, the Sun reference, which discloses a self-initializing chipset designed to initialize without interruption by a processor, cannot cure this deficiency in the Kamper reference, because it does not even mention configuration profile images. See Sun, abstract, lines 1-4; see also, col. 2, lines 1-3.

In order for us to decide the question of obviousness, "[t]he first inquiry must be into exactly what the claims define." **In re Wilder**, 429 F.2d 447, 450, 166 USPQ 545, 548

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(CCPA 1970). "Analysis begins with a key legal question-- what is the invention claimed ?"...Claim interpretation...will normally control the remainder of the decisional process."

**Panduit Corp. v. Dennison Mfg.**, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

We note that representative claim 18 reads in part as follows:

[G]enerating a server configuration profile image based on a current configuration of a server.

We note at paragraph 26, lines 5 through 8, Appellant's specification states the following:

In step 802, the utility generates a profile in NVRAM based on the current server configuration. This step involves creating and saving an image in NVRAM based on the devices in the server. In other words, the utility creates a "snapshot" of the current highly optimized configuration of the server.

Thus, the claim does require generating a server configuration profile image based on a current configuration server.

With the above discussion in mind, we find that with regard to representative claim 18, Kamper teaches a method for configuring a plurality of servers using corresponding configuration files located on a removable storage device. Particularly, Kamper teaches searching a plurality of devices connected to a server in order to determine which of said devices

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contain the necessary profiles for configuring the server. It is our view that that one of ordinary skill in the art at the time of the present invention would have readily recognized that Kamper's teaching of determining which of the files stored on the removable media is more suitable for configuring a particular server amounts to selecting a current file for configuring said server. The ordinarily skilled artisan would have duly recognized that since the server polls the devices attached thereto each time it needs to locate configuration files, such acquired files are, from the standpoint point of the selecting server, necessarily the most currently and pertinently available configuration files on the storage device at the time of selection. We further find that Sun's teachings are cumulative to Kamper's. Consequently, we do not find error in the Examiner's stated position, which concludes that the combination of Kamper and Sun teaches the limitation of generating a server configuration profile image based on a current configuration server.

It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to the ordinarily skilled artisan the invention as set forth in claim 18. Accordingly, we will sustain the Examiner's rejection of claims 18, 20 through 30.

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**III. Under 35 U.S.C. § 103, is the Rejection of Claim 19 under 35 U.S.C. § 103 as being unpatentable over the combination of Kamper, Sun and Trimberger Proper?**

With respect to claim 19, Appellant argues in the Appeal and Reply Briefs that neither Kamper nor Sun nor Trimberger teaches the claimed invention. Particularly, Appellant asserts that the combination of Kamper and Sun does not teach the limitation of generating a server configuration profile image based on a current configuration server. We have already addressed this argument in the discussion of claim 18 above, and we disagree with Appellant. Further, Appellant argues that Trimberger does not cure the deficiencies of the Kamper and Sun combination. We find no such deficiencies in the stated combination for Trimberger to cure. It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to the ordinarily skilled artisan the invention as set forth in claim 19. Accordingly, we will sustain the Examiner's rejection of claim 19.

**CONCLUSION**

In view of the foregoing discussion, we have sustained the Examiner's decision rejecting claims 1, 4 through 9, 31 through 34 under 35 U.S.C. § 102. We have also sustained the Examiner's

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decision rejecting claims 18 through 30 under 35 U.S.C. § 103.

Therefore, we affirm.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
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