

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT J. ZIMMER and MICHAEL A. ROTHMAN

Appeal 2007-2284
Application 10/327,192
Technology Center 2100

Decided: February 27, 2008

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT, and
MARC S. HOFF, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-10, 12, 13, and 15-22, which are all of the claims pending in this application as claims 11 and 14 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented an accessing system management method and system for a processor-based system where seamless access to system management information in a foreground operating system is provided.

(Spec. 1). According to Appellants, the system management data obtained during pre-boot can be accessed during runtime of an operating system by a user through the operating system, for example to determine what system management event occurred, such as platform errors, thermal events, and other platform exceptions, and/or what actions the responding handler has taken. (Spec. 3-4).

Independent Claim 1 is representative and reads as follows:

1. A method comprising:

registering data regarding operating parameter information of a processor-based system obtained in a system management mode in the processor-based system;

converting the data in the processor-based system to an encoding for a user visible display; and

exporting the converted data to a database of the processor-based system for display in the processor-based system in an operating mode other than system management mode.

The Examiner relies on the following prior art references in rejecting the claims:

Kau	US 5,684,997	Nov. 4, 1997
Graf	US 6,317,798 B1	Nov. 13, 2001
Muhlestein	US 2002/0004815 A1	Jan. 10, 2002
McCoy	US 6,584,586 B1	Jun. 24, 2003 (filed Mar. 22, 2000)
Strongin	US 6,862,641 B1	Mar. 1, 2005 (filed May 11, 2001)

Claims 1-3, 10, 12, 15, and 16 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Strongin and McCoy.

Claims 4-9, 13, and 17-20 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Strongin, McCoy, and Muhlestein.

Claim 21 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over Strongin, McCoy, and Kau.

Claim 22 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over Strongin, McCoy, and Graf.

Rather than repeat the arguments here, we make reference to the Briefs¹ and the Answer for the respective positions of the Appellants and the Examiner.

We reverse.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103. The issue on appeal turns on whether substantial evidence before us shows that under 35 U.S.C. § 103, the combination of Strongin with McCoy teaches or suggests the claimed subject. Specifically, Appellants and the Examiner disagree as to whether McCoy discloses or suggests exporting the converted data to a database of a processor-based system, in which the data is obtained, for display in the processor-based system.

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal and are believed to be supported by substantial evidence.

1. Strongin relates to a programming code for interruptible and re-enterable system management mode (SMM). (Abstract).

¹ We refer to the Appeal Brief filed Sep. 14, 2006.

2. As depicted in Figure 5A and 5B, the security hardware for controlling SMM includes SMM access filters 410, mailbox RAM 415, and an SMM initiator 425A. (Col. 8, ll. 26-39; col. 10, ll. 34-43).

3. Strongin teaches that the operation parameters are controlled by BIOS during the booting process (col. 24, ll. 16-23), but does not provide any teachings related to displaying the converted data in an operating mode. (Col. 29, ll. 42-60).

4. McCoy relates to capturing and transferring the internal activity of a computer under test. (Abstract).

5. McCoy teaches that because many system-level malfunctions are transient and difficult to reproduce, one method for precisely locating the cause of most malfunctions is to generate a history of the operations performed by the system. Then, when a malfunction occurs, one can identify the state of the system when the malfunction was recognized and “trace backwards”, using the history to identify the source of the malfunction. (Col. 2, ll. 20-32).

6. McCoy provides for system-level testing wherein, as shown in Fig. 1, the system-under-test 12 includes a capture and transport expansion card (CTC) which forwards all of the detected activity to a second system 18 via a high speed connection 20. System 18 monitors for divergences or could be simply storing the detected activity for later review. (Col. 3, ll. 45-64).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of

obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). *See also In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

ANALYSIS

The Examiner’s characterization of the BIOS mode as an operating mode other than the system management mode (Ans. 20) appears to remain undisputed by Appellants. However, Appellants argue that although a summary screen of devices may be shown, Strongin does not teach exporting any operating parameter data for display (App. Br. 12). The Examiner responds by asserting that BIOS mode is known in the art to

enable a user to view operating parameter information and therefore, the BIOS mode in Strongin indicates that the operating parameter information is displayed (Ans. 20).

Appellants further argue that the disclosure of McCoy provides no teaching regarding exporting converted data to a database of the system in which the data is obtained for display in that system and instead, merely provides data to a second, separate system for review and further processing (App. Br. 12). Additionally, Appellants contend that displaying data in McCoy is not applicable to Strongin's storage of system data in BIOS mode since what McCoy provides to the second system is a history to identify system state when a malfunction is recognized (App. Br. 13) wherein the history data is previously obtained, but transferred during system management mode (Reply Br. 2).

The Examiner responds by clarifying that McCoy (col. 3, ll. 45-46, 50-51, 62-63) was relied on for teaching a user visible display and data conversion for displaying to the user (Ans. 20). The Examiner concludes that although McCoy uses a second, separate system for reviewing the system data of another system, identifying malfunctions would have suggested to one of ordinary skill in the art displaying the system data obtained in Strongin on a user visible display (Ans. 21-22).

As described above, Strongin teaches storing the data obtained in a system management mode in a RAM which is later accessed in the BIOS mode (FF 2-3). Contrary to the Examiner's assertion that the data is displayed in Strongin (Ans. 20), the cited portions of the references (Ans. 3-4) do not include any indication that the data sent to RAM is the converted data for display in the processor-based system (FF 1-3). Therefore, while

Strongin performs remote booting operations, the data regarding the operating parameters is neither converted for a user visible display, nor exported to the RAM after the data is converted.

McCoy, as argued by Appellants (App. Br. 12), obtains data regarding operating parameters of a system in a different computer (FF 4 & 6) where the detected activities are stored for later review in case of a failure. Therefore, McCoy includes no teachings to indicate that the operating parameter information of a processor-based system, whether converted for display or in the raw format, are stored in or exported to a database in the same processor-based system for display in the same system. Although generating a history of the operations performed by the system is suggested (FF 5), the large volume of the history data to be stored forces McCoy to monitor and store the activities in a second computer. This arrangement provides data for review in a second system, and not in a database of the system under test, as required by the claims.

CONCLUSION

On the record before us, we find that the Examiner fails to make a *prima facie* case that the combination of Strongin and McCoy would have suggested the recited features of claim 1 or other independent claims 10 and 15, which include similar limitations. Therefore, in view of our analysis above, the 35 U.S.C. § 103 rejection of claims 1-3, 10, 12, 15, and 16 over Strongin and McCoy cannot be sustained. Additionally, we do not sustain the 35 U.S.C. § 103 rejection of the remaining claims as the Examiner has not identified any teachings in Muhlestein, Kau, or Graf related to exporting the converted data to a database of the processor-based system for display in

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the same system to overcome the deficiencies of the combination of Strongin and McCoy discussed above.

DECISION

The decision of the Examiner rejecting claims 1-10, 12, 13, and 15-22 under 35 U.S.C. § 103 is reversed.

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REVERSED

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