

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAUL JOHNSON, ROGER BORCHERS,
and NIKIFOROS E. STAMATAKIS

Appeal 2007-4086
Application 10/267,513
Technology Center 2100

Decided: June 30, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-13 and 15-20, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates in general to the field of system testing, and more particularly to a method and system for test management of test cases, system configurations, and test results, such as test management of information handling systems. (Spec. 1: 7-10.) Claim 1 is illustrative.

1. A system for information handling system test management, the system comprising:

a test case engine operable to generate information handling system test cases, each test case having procedures for verification of one or more information handling system hardware component functions;

a configuration engine operable to generate information handling system configurations subject to test; and

a test iteration engine running on an information handling system and operable to define a matrix of test cells and render the matrix for presentation, each test cell having a test case and a configuration to validate.

The Examiner relies on the following references as evidence of unpatentability.

Tse US 5,742,754 Apr. 21, 1998

Boris Beizer, *Software Testing Techniques*, 2d. ed., International Thomson Computer Press, 448, (1990).

Claims 1, 2, 8, 9, 13, 15, 17, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tse.

Claims 3 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tse.

Claims 4-7, 11, 12, 16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tse and Beizer.

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1, 8, and 18, the only independent claims on appeal. The dependent claims subject to the § 103(a) rejections are not separately argued. Each dependent claim will thus stand or fall with the independent claim from which it depends. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner's rejection of claims 1, 8, and 18 over Tse is set forth in the Answer. Appellants contest the rejection insofar as the reference is not deemed to describe related limitations in the independent claims.

Claim 1 recites "a test case engine operable to generate information handling system test cases, each test case having procedures for verification of one or more information handling system hardware component functions." Claim 8 recites "generating system test cases, each test case having procedures for verification of one or more system hardware component functions." Claim 18 recites "a plurality of configurations, each configuration defining information handling system hardware components."

Appellants argue that Tse fails to describe the subject matter of the claims because Tse tests software components, not hardware components as recited.

In the Examiner's view, first, software runs or operates on hardware, and running software provides a function. Therefore, testing "hardware component function" reads on testing software running on hardware as described by Tse. Second, hardware components in Tse are tested because software is tested. The hardware must be functioning for software to function. Third, Tse describes testing different hardware configurations. The Examiner concludes that under the broadest reasonable interpretation of

the recitations in controversy, the claims are anticipated by Tse. (Final Rejection 10-11.)

Appellants characterize the rejection as being based on the doctrine of inherency and submit that testing software running on hardware does not necessarily test hardware. In Appellants' view, a failure of hardware on which the software is running would "defeat the purpose" of Tse's testing of software. Detection of a hardware failure would "render worthless" the software testing process of Tse. (App. Br. 4.)

The Examiner adds that the claim language is drawn to hardware component "functions," which reads on software because software is a function performed by hardware. Further, the Examiner finds that the Specification does not provide any particular discussion of what may constitute hardware component "functions," but provides examples of hardware component "functions" that may be considered software, such as booting an "operation system" and loading "drivers."¹ Further, the Examiner finds the Specification refers to the object of testing as the "configuration," but "configuration" is defined (Spec. 3: 26-28) as "hardware and software components." The Examiner concludes that a reasonable interpretation of "hardware component functions" thus reads on

¹ Appellants provide a "Summary of Claimed Subject Matter" at page 2 of the Appeal Brief but, for reasons unknown, do not submit where *the language that is argued as distinguishing over the prior art* is described in the Specification, except for that occurring in claim 8. Cf. 37 C.F.R. § 41.37(c)(1)(v). The support for the claim 8 recitation in controversy is purported to reside at Specification 7: 26-32, which, as the Examiner indicates, describes validating modem operation by running software -- including procedures for a series of boots of the operating system to recognize and load drivers for the modem.

the software elements of a programmed machine or piece of hardware.
(Ans. 13-14.)

Appellants respond, in turn, that the Examiner's response in the Answer fails to address the rejections under the doctrine of inherency. Appellants reiterate that Tse does not necessarily test hardware because, in order to test software as desired by Tse, the hardware has to be operating properly. The software of Tse can fail even though the hardware on which the software runs is working properly. Further, according to Appellants, hardware components do not necessarily run software. (Reply Br. 1-2.)

Appellants have thus responded to only one of the Examiner's various arguments in support of why the claims are found to be anticipated by Tse, the position which Appellants deem to be "under the doctrine of inherency." In our view, the Examiner has provided convincing reasons why the claim recitations in controversy include within their ambit the testing apparatus and method described by the reference. Even were we to find Appellants' arguments persuasive with respect to whether underlying hardware is tested when software running on the hardware is tested, Appellants have not demonstrated how the language that is argued as distinguishing over the prior art might do so.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. However, this is not an "ipsissimis verbis" test. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). We are not persuaded of error in the Examiner's rejections.

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CONCLUSION

The rejection of claims 1-13 and 15-20 under 35 U.S.C. § 102(b) or § 103(a) is affirmed.

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

AFFIRMED

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