

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM JOHN THOMAS III

Appeal 2008-1245
Application 10/192,184
Technology Center 2100

Decided: September 30, 2008

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to computer hardware configurations. (Spec. 1).

Independent claim 1 is illustrative:

1. A method for providing multiple component configurations in a computer system, said method comprising:

determining whether said computer system is in a first configuration, said computer system comprising a plurality of components, said first configuration indicating said plurality of components comprises at least one upgradeable component, wherein said upgradeable component is disabled in said first configuration;

provided said computer system is in said first configuration, determining whether upgrading said computer system to a second configuration is permitted, said second configuration indicating a configuration wherein access is provided to said upgradeable component, and wherein said determining whether said upgrading of said computer system to said second configuration is permitted is performed at said computer system and without a network connection; and

provided said upgrading to said second configuration is permitted, allowing configuring of said upgradable component, wherein said configuring is performed by a system configuration command and without requiring manual insertion of said upgradable component into said computer system at time of said upgrading, and wherein said first configuration is stored in a memory unit of said computer system.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Kenton	US 5,479,612	Dec. 26, 1995
Gold	US 2002/0188704 A1	Dec. 12, 2002
		(filed Jun. 12, 2001)

Capacity Upgrade on Demand Installing and Upgrading Processors, IBM, Enterprise Server Model S80, e server pSeries 680 Model S85, Second Ed., 2001 (“Capacity Upgrade” hereafter).

THE REJECTIONS

1. Claims 1-3, 5-11, and 13-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Capacity Upgrade in view of Gold.
2. Claims 4, 12, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Capacity Upgrade in view of Gold and Kenton.

CONTENTIONS BY APPELLANT

1. Appellant contends that the Examiner erred in rejecting claims 1-3, 5-11, and 13-19 as being unpatentable over Capacity Upgrade and Gold because the cited references fail to suggest the desirability of the claimed invention. More particularly, Appellant argues that the prior art teaches away from the limitation of performing an upgrade without a network connection, as recited in claim 1. (App. Br. 10-11).

2. Appellant contends that the Examiner erred in rejecting claims 4, 12, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over

Capacity Upgrade, Gold, and Kenton because Kenton fails to cure the deficiencies of Capacity Upgrade, and Gold regarding claims 1, 9, and 17. (App. Br. 17).

ISSUES

1. We consider the question of whether Appellant has shown that the cited references teach away from the claimed limitation of performing a capacity upgrade without a network connection.

2. We consider the question of whether Appellant has shown that the Examiner has failed to establish that the combination of Capacity Upgrade, Gold, and Kenton teaches or suggests all of the limitations recited in claims 4, 12, 20, and 21.

PRINCIPLES OF LAW

Obviousness

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 103, "[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the

predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The reasoning given as support for the conclusion of obviousness can be based on “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR*, 127 S. Ct. at 1740-41.

We note our reviewing court has recently reaffirmed that:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

Dystar Textilfarben GmbH v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006). *See also Leapfrog Enters., Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.”)

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d at 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant's Briefs to show error in the proffered prima facie case.

We note that arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Findings of Fact

The following findings of fact are supported by a preponderance of the evidence.

Specification

1. Appellant discloses that “[e]mbodiments of the present invention also do not require a network connection to perform a system upgrade.” (Spec., 13, ll. 13-14).
2. Appellant discloses that a license key, product number and a serial number of the computer system are received. The license key is obtained by contacting the manufacturer of the computer system and purchasing the license key. The product number and serial number, which are stored within the computer system, are verified by the license key. (Spec., 11, l. 23 – 12, l. 8).

Capacity Upgrade

3. Capacity Upgrade teaches a system that would allow extra processing capacity to be added to the computer system. (Pg. 1).

4. Capacity Upgrade teaches that the system configuration can be changed. *After the configuration is changed*, an Electronic Service Agent notifies the project office by communicating through a modem and a dedicated phone line. (Emphasis added) (*Id.*).

Gold

5. Gold is directed to upgrading licensed capacity in a headless computer entity. (Abst. ll. 1-3).
6. Gold further teaches that upgrades in capacity of the computer entity can be achieved without replacement of a data disk, by altering upgrade license key data to allow use of spare data storage capacity on the data disk. (*Id.* ll. 7-11).
7. Gold teaches that an upgrade capacity wizard is used to install an upgrade capacity license via a web browser on a separate entity connected to a headless computer entity connected to the headless local area network. (Para. [0106]).
8. Gold teaches that the wizard program stores the upgrade license key data in the primary operating system partition on the headless system. (Para. [0109]).

Claims 1-3, 5-11, and 13-19

We consider the Examiner's rejection of independent claims 1-3, 5-11, and 13-19 under 35 U.S.C. § 103(a) as being unpatentable over Capacity Upgrade and Gold and find that the Examiner has at least set forth a sufficient initial showing of obviousness with respect to independent claim 1. Since Appellant's arguments have treated these claims as a single group

which stand or fall together, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Capacity Upgrade and Gold teach away from each other

Appellant contends that the cited references fail to teach the feature of a computer system including an upgradeable component, without a network connection, as recited in claim 1, because the proposed combination would change the principle of operation of Capacity Upgrade. (See App. Br. 11). More specifically, Appellant contends that Capacity Upgrade requires a network connection in order to make changes to the system configuration. Thus, modifying Capacity Upgrade with Gold, would render Capacity Upgrade unsuitable for its intended purpose. (*Id.* 13). We disagree.

We do not find, and Appellant does not establish, that either Capacity Upgrade, or Gold, criticizes, discredits, or otherwise discourages upgrading a computer system's capacity without using a network connection. “The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives *because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...” In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). (Emphasis added). Thus, we do not find Appellant's arguments that the references teach away from each other to be persuasive.

Further, after considering the evidence before us, it is our view that Appellant's argument does not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner's *prima facie* case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. (citations omitted, emphasis added).

Keller, 642 F.2d at 425.

This reasoning is applicable in the present case.

Gold is relied upon by the Examiner to teach that the upgrade of the computer's capacity is performed without using a network connection. (Ans. 7). Thus, we find that the Examiner's *prima facie* case of obviousness does not rely on the bodily incorporation of Gold into Capacity Update, but rather the collective teachings and suggestions of the references. Therefore, it is our view that one skilled in the art would have been motivated to combine the analogous teachings of Capacity Upgrade and Gold in the manner proffered by the Examiner.

Gold requires a network environment

Still further, Appellant contends that Gold fails to cure the deficiencies of Capacity Upgrade because Gold requires a network environment. (Reply Br. 4). We disagree.

As discussed above, we find that Capacity Upgrade teaches upgrading a computer system's capacity. The network connection in Capacity Upgrade is required in order to complete the upgrade process. (FF 3-4). Gold teaches that the license key is stored on the headless computer via a web administrator interface. (FF 5-7). However, the verification of the license key and enablement the capacity upgrade, is performed *internally* on the

headless computer system. (FF 8). Thus, while Gold teaches that the headless system is connected to a network in order to load the wizard program, the same function of installing the wizard program onto the headless system could be performed by a laptop computer directly connected to the headless computer. Thus, we conclude that the teachings of Gold do not *require* a network connection to determine whether upgrading said computer system to a second configuration is permitted.

Based on the above, we conclude that the Appellant has not met the requisite burden of showing error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 1 (and claims 2, 3, 5-11, and 13-19 which fall therewith) as being unpatentable over Capacity Upgrade and Gold.

Claims 4, 12, 20, and 21

We next consider the Examiner's rejection of claims 4, 12, 20, and 21 as being unpatentable over Capacity Upgrade in view of Gold and Kenton. Since Appellant's arguments have treated these claims as a single group which stand or fall together, we select claim 4 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

With regards to the rejection of dependent claim 4, Appellant essentially contends that Capacity Upgrade and Gold are deficient at least for the reasons discussed above regarding claim 1 and Kenton fails to cure these deficiencies. (App. Br. 17). Appellant did not present any separate arguments regarding the patentability of claim 4. Thus, the patentability of claim 4 is urged based on the arguments discussed *supra* regarding claim 1, which we did not find to be persuasive.

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Therefore, we conclude that Appellant has not shown error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 4 (and claims 12, 20, and 21 which fall therewith) as being unpatentable over Capacity Upgrade in view of Gold and Kenton.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown the Examiner erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) for obviousness. Therefore, claims 1-21 are unpatentable.

DECISION

The decision of the Examiner rejecting claims 1-21 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)(1)(iv).

AFFIRMED

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