

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HOWARD A. SHOOBE

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Appeal 2008-2007  
Application 10/407,703  
Technology Center 2100

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Decided: November 20, 2008

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Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III,  
and STEPHEN C. SIU, *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 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

The disclosed invention relates generally to the manufacture of information handling systems. More particularly, the present invention relates to a system and method for transition from existing to succeeding configurations of manufactured information handling systems. (Spec. p. 1, ll. 7-10).

Independent claim 1 is illustrative:

1. A system for managing information handling system configuration transitions, the system comprising:
  - a processing component relationship table associating information handling system processing components according to one or more transition factors;
  - a customer information handling system configuration database storing customer information handling system configurations, each customer information handling system configuration comprising physical processing components to build an information handling system; and
  - an automatic configuration transition engine interfaced with the processing component relationship table and customer information handling system configuration database, the automatic configuration transition engine operable to automatically apply the transition factors to a selected customer information handling system configuration to determine a transition configuration associated with the selected customer information handling system.

## THE REFERENCES

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

Thompson	US 6,535,975 B1	Mar. 18, 2003 (filed Oct. 13, 1999)
Fichtner	US 6,360,362 B1	Mar. 19, 2002 (filed Feb. 20, 1998)
Brown	US 2005/0188117 A1	Aug. 25, 2005

## THE REJECTIONS

1. The Examiner rejected claims 1, 2, and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Thompson.
2. The Examiner rejected claims 5, 10-14, 16-18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Fichtner.
3. The Examiner rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being obvious over Thompson in view of Brown.
4. The Examiner rejected claims 15 and 19 under 35 U.S.C. § 103(a) as being obvious over Thompson in view of Fichtner and Brown.

## APPELLANT'S CONTENTIONS

1. Appellant contends that the Examiner erred in rejecting independent claims 1, 10, and 16 because Thompson fails to teach or suggest the element of “transition configuration.” (App. Br. 5-6).
2. Appellant contends that Thompson fails to teach replacement of a physical component with a successor component. (App. Br. 7).

3. Appellant contends that the cited references fail to teach or suggest building of an information handling system from physical components. (Reply Br. 2).

#### EXAMINER'S FINDINGS

1. Thompson teaches that each of the application components 130-130n can go from one state to another. (Ans. 22).

2. Thompson teaches “transition configuration.” (Id.).

3. The feature of “replacement of a physical component with a successor component” is not recited in claim 1. (Ans. 22).

#### ISSUE

1. Has Appellant shown that the Examiner erred in determining that Thompson teaches or suggests the claimed “transition configuration?”

#### PRINCIPLES OF LAW

##### Anticipation

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from

practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (Internal citations omitted.)

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). Therefore, we look to Appellant’s Briefs to show error in the proffered prima facie case.

Only those arguments actually made by Appellant have been considered in this decision. 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).

### Findings of Fact

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

#### *Thompson*

1. Thompson is directed to a configuration system for an application having a plurality of application components. (Abst., ll. 1-2).
2. Thompson teaches a configuration information store that stores all of the configuration information necessary for completion of all state transitions for the components 130-130n. (Col. 8, ll. 36-39).
3. Thompson teaches that the components can go from one state to another, e.g., from a startup state to an operational state. (Col. 5, ll. 55-58).

4. Appellant admits that Thompson discloses that the application 13 “‘can be any kind of component-based application or component-based hardware/firmware system’ in which each component 130 performs a function for the application 13.” (App. Br. 7, ll. 13-15).
5. Thompson teaches that the structure of the component core varies in accordance with the designated functions. (Col. 6, ll. 23-24)

*Specification*

6. Appellant maps the claimed “transition configuration” to page 6, ll. 13-18 of the Specification.
7. The Specification teaches that an automatic configuration transition engine 18 determines a transition configuration for the selected configuration. (Spec. 7, ll. 4-8).

ANALYSIS

Claims 1, 2, and 6-9

We consider the Examiner’s rejection of claims 1, 2, and 6-9 under 35 U.S.C. § 102(e) as being anticipated by Thompson. Because Appellant has argued these claims as a single group, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant contends that Thompson fails to teach the element of transition configuration, as recited in claim 1. We disagree for the reasons discussed *infra*.

It is our view that Thompson teaches the claimed “transition configuration” in that the components 130-130n are transformed from one state to another. (FF 2-3). In addition, we note that Thompson teaches that the components can be component-based hardware/firmware, i.e., physical components. (See FF 4).

Appellant contends that the element “transition configuration” should be read in the context of replacing physical components. However, as noted by Appellant, while limitations are interpreted in light of the Specification, we cannot read the limitation of replacing components, physical or otherwise, into claim 1 as urged by the Appellant. Furthermore, Appellant’s Specification does not define the term “transition configuration” to be limited to the replacement of physical components. Thus, based on the above, we conclude that the element “transition configuration” is taught by Thompson.

As stated above, arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

Based on the record before us, we conclude that the Appellant has not shown that the Examiner erred in rejecting claim 1 and claims 2 and 6-9 that fall therewith, as being anticipated by Thompson. Accordingly, we sustain the Examiner’s rejections of claims 1, 2, and 6-9 as being anticipated by Thompson.

Obviousness Rejections

Claims 3-5, and 10-20

Regarding the obviousness rejection of claims 10 and 16 as being unpatentable over Thompson in view of Fichtner, Appellant merely argues that the combination of Thompson and Fichtner fails to teach or suggest the claimed “transition configuration.” (App. Br. 5-6). We have found that Thompson discloses this limitation, as discussed *supra*. Therefore, independent claims 10 and 16 fall with claim 1 for the same reasons discussed above.

Regarding claims 3-5, 11-15 and 17-20, Appellant did not present separate arguments for these claims. Therefore, Appellant has waived any arguments directed to the separate patentability of claims 3-5, 11-15 and 17-20. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Because Appellant has not shown the Examiner erred, we sustain the Examiner’s rejections of claims 3-5, and 10-20 under 35 U.S.C. §103(a).

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellant did not show that the Examiner erred in determining that Thompson teaches the claimed “transition configuration.”

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 1, 2, and 6-9 as being anticipated by Thompson under 35 U.S.C. § 102(e).

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 5, 10-14, 16-18 and 20 as being unpatentable over Thompson in view of Fichtner under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 3 and 4 as being unpatentable over Thompson in view of Brown under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 15 and 19 as being unpatentable over Thompson in view of Fichtner and Brown under 35 U.S.C. § 103(a).

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**DECISION**

The decision of the Examiner rejecting claims 1-20 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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