

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN I. GARNEY

Appeal No. 1997-2056
Application No. 08/019,798¹

ON BRIEF

Before THOMAS, SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17-36, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed February 19, 1993.

BACKGROUND

The appellant's invention relates to a process of storing dynamically loaded device drivers on a mass storage device to support access to removable computer cards. An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced below.

17. In a computer system having a processor, a system memory, a mass storage memory device and an interface for receiving a removable system resource, a process for dynamically configuring device drivers of removable computer system resources, said process comprising the steps of:

configuring the system memory in a bootstrap initialization; and

after said bootstrap initialization while an application program is running and prior to any subsequent bootstrap initialization, performing the following steps,

(a) receiving a removable system resource at the interface;

(b) retrieving a device driver identifier from the removable system resource;

(c) copying a device driver corresponding to said device driver identifier from the mass storage memory device to the system memory; and

(d) executing said device driver from the system memory.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hughes et al. (Hughes)	5,109,484	Apr. 28, 1992
Fuller et al. (Fuller)	5,302,947	Apr. 12, 1994 (Filed Jul. 31, 1992)
Lien et al. (Lien)	5,386,567	Jan. 31, 1995 (Filed Oct. 14, 1992)

Claims 17-36² stand rejected under 35 U.S.C. § 103 as being unpatentable over Lien in view of Hughes and Fuller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed Aug. 20, 1996) and the supplemental examiner's answer³ (Paper No. 23, mailed Dec. 30, 1996) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 20, filed Jul. 19, 1996) and reply brief (Paper No. 22, filed Oct. 28, 1996) for the appellant's arguments thereagainst.

OPINION

² We note that the appendix to the appeal brief only includes claims 17-35, but we note that claim 36 has not been canceled, therefore, we include this rejected claim in our decision.

³ We note that the supplemental examiner's answer appears to be a copy of the examiner's answer. We find no additional response by the examiner to address appellant's arguments which were made in the reply brief.

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In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to store the device drivers for removable devices in mass memory for retrieval and use after bootstrap initialization. The language of claim 17 states that "after said bootstrap initialization while an application program is running and prior to any subsequent bootstrap initialization, performing the following steps, (a) receiving a removable system resource at the interface; (b) retrieving a device driver identifier from the removable system resource; [and] (c) copying a device driver corresponding to said device driver identifier from the mass storage memory device to the system memory."

"To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to

a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we find that appellants have overcome the *prima facie* case of obviousness by showing insufficient evidence by the examiner of obviousness. Therefore, we will not sustain the rejection of process claim 17 nor corresponding apparatus claim 27 which contains the same claim language.

Appellant argues that the Lien patent teaches the storage of the device driver in the adapter rather than in mass memory in the computer system for input of the device driver to the RAM of the computer after the computer has been initially booted. (See brief at page 5.) The examiner acknowledges this deficiency in Lien and relies upon the teaching of Hughes. Hughes is directed to a networked system where the remote terminals initially perform booting by interfacing with a controller and downloading relevant files and drivers from the mass memory of the controller to perform the initial bootstrap initialization or initial program load. (See answer at pages 3-4 and brief at pages 9-10.) Therefore, the Hughes reference does not teach or suggest the storage of the device drivers for retrieval and use after the bootstrap initialization while an application program is running, as recited in the language of claim 17. (See brief at page 10.) The examiner

realizes that neither the Hughes reference or the Lien reference clearly teach or suggest the use of the identification and use thereof to retrieve the device driver. (See answer at page 5.) The examiner relies on Fuller to teach this feature. Appellant argues that Fuller does not teach or suggest the storage of the device driver in the mass memory since Fuller stores the driver in the memory of the removable system resource/radio modem. (See brief at page 10.)

Appellant argues that both Lien and Fuller disclose the advantage of storing device drivers in the removeable resource rather than in the mass storage. (See brief at page 13.) We agree with appellant. Appellant further argues that the combination of Hughes and Lien would motivate skilled artisans to load a device driver from mass memory at initial program load rather than “after said bootstrap initialization while an application program is running and prior to any subsequent bootstrap initialization, performing . . .” as set forth in the language of claim 17. (See brief at page 11.) We agree with appellant. We find that the examiner has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to store the device drivers in mass memory for use after the bootstrap initialization as set forth in the language of claim 17.

For the above discussed reasons we agree with appellant that it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the

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teachings of the three references to achieve the claimed invention as set forth in the language of claim 17 as the examiner maintains. Therefore, we will not sustain the rejection of claims 17 or 27 and dependent claims 18-26 and 28-36.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17-36 under 35 U.S.C. § 103 is REVERSED.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 WILSHIRE BLVD.
7TH FLOOR
LOS ANGELES, CA 90025