

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. SMOLSKI

Appeal No. 2000-1209
Application No. 08/711,180

ON BRIEF

Before HAIRSTON, LALL, and LEVY, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which constitute all the pending claims in the application.

According to appellants (brief at page 3 and 4), the present invention relates generally to methods and program products operable in a computer for changing configuration/setup parameters in an embedded controller type computer system, which computer system is characterized by the absence of any keyboard or video

display, as accomplished from a remote terminal. The invention allows the changing of configuration/set up parameters in the embedded controller using the keyboard and video display of the remote terminal. The entry of the changes is responsive to a physical audio-visual signal timed and generated by the embedded controller, and concludes with a rerun of the power on test in the embedded controller.

The following claim is illustrative of the invention.

1. A method of remotely specifying configuration/setup parameters in a computer system not having a keyboard or a display, comprising the steps of:

initiating a power on test mode in the computer system;

generating an audio-visual signal by the computer system;

monitoring within the computer system for first control signals from a remote terminal generated in response to the audio-visual signal;

communicating configuration/setup data between the computer system and the remote terminal if first control signals are detected during the monitoring;

completing the power on test mode if first control signals are not detected within a specified time; and

returning the computer system to an initiation of the power on test mode responsive to second control signals generated within the remote terminal following the communicating of configuration/setup data.

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The examiner relies on the following references:

Collins, Jr. (Collins)	4,926,481	May 15, 1990
Basu	5,452,454	Sep. 19, 1995
Yee	5,471,576	Nov. 28, 1995

Claims 1-3, and 10-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Basu in view of Yee, while claims 4-9, and 13-18 stand rejected over Basu in view of Yee and Collins

Rather than repeat the arguments of appellant and the examiner, we make reference to the brief (paper no. 10) and the answer (paper no. 11) for the respective details thereof.

OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellant's arguments set forth in the brief.

We reverse.

As a general proposition, in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d

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1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); **In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and **In re Rinehart**, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

At the outset, we note that appellant elects to have claims 1-18 stand or fall together (brief, at page 5). We take claim 1 as representative of the group. In the response to the rejection of claim 1 (answer at page 2-4), appellant argues (brief at page 6) that "[t]he examiner cites neither a reference nor any technical inducement to combine the audio-to-video synchronization operation of Yee into the booting of a client workstation from a remote data processing system over a network as taught in Basu."

The examiner responds (answer at page 9) that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning."

In providing a motivation or a suggestion to combine, we recognize that the Federal Circuit states, in **In re Lee**, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002),

[t]he essential factual evidence on the issue of obviousness is set fourth in **Graham v. John Deere Co.**, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a

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teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., **McGinley v. Franklin Sports, Inc.**, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fe. Cir. 2001) ("the central question whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

We note that in the present case the examiner has made no factual findings in either reference, let alone to make a rational inference that the teachings of Yee can be combined with Basu. We agree with appellant that Yee is concerned with audio-to-video synchronization and has nothing to do with the booting of a client workstation of Basu. Therefore, the examiner has not shown any justification for the combination.

Furthermore, even if the references to Basu and Yee were combinable, **arguendo**, appellant argues (brief at page 6) that

[T]he claimed invention requires a generation of an audio-visual signal by the computer followed by a monitoring by such computer system for control signals from a remote terminal responsive to the generated audio-visual signal. In contrast, the teaching in Basu at column 8, lines 9-17, involves an activity in which the computer system sends a download request to a remote terminal, and the remote terminal responds by a download action. . . . Therefore, the direction of control flow is both specified in the claims and opposite that of Basu."

The examiner responds (answer at page 8) that "the client [of Basu] which is a remote computer and the VMS server 10 which is the parameters [sic, controller] not having keyboard and display.

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Nowhere to be found in the body of these claimed [sic, claims] indicating configuring/setup parameters by the remote terminal."

In our view, the examiner has missed the argument raised by appellant. Indeed, in Basu the process of downloading or communicating the configuring/setup parameters between client workstation 18 and VMS server 10 is initiated by a signal which is initiated and transmitted by workstation 18, as opposed to the recited initial signal sent by embedded controller which corresponds to VMS server 10 by examiner's designation. Therefore, the recited limitation of generating an audio-visual signal by the computer (controller) system is not met by the combination suggested by the examiner.

For the rationale above, we do not sustain the rejection of claim 1 over Basu in view of Yee. In passing, we note the other independent claim 10 is a product claim containing the program recited in claim 1. Therefore, for the same rationale we do not sustain the rejection of claim 10 over Basu in view Yee. Consequently, we reverse the rejection of claims 1-3, and 10-12 over Basu and Yee.

With respect to claims 4-9, and 13-18, since Collins does not cure the deficiency in the combination of Basu and Yee we do not

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sustain the rejection of these claims over Basu in view of Yee and Collins.

Accordingly, the decision of the examiner rejecting claims 1-18 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
PARSHOTAM LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
STUART S. LEVY)	
Administrative Patent Judge)	

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JUDGE LALL

APPEAL NO. 2000-1209

APPLICATION NO. 08/711,180

APJ LALL

APJ HAIRSTON

APJ LEVY

DECISION: **REVERSED**

PREPARED: Jun 6, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK