



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/133,944	06/09/2011	Syed S. Azam	82741810	6898
22879	7590	11/02/2016	EXAMINER	
HP Inc. 3390 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528-9544			CHOUDHURY, ZAHID	
			ART UNIT	PAPER NUMBER
			2116	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipa.mail@hp.com
barbl@hp.com
yvonne.bailey@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SYED S. AZAM
and
ZUBAIR BEYABANI

Appeal 2015-003593
Application 13/133,944
Technology Center 2100

Before JEFFREY A. STEPHENS, MELISSA A. HAAPALA, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–15. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

INVENTION

Appellants' invention is directed to booting a computer system using preboot data. *See* Abstract. Claim 1 is exemplary of the subject matter on appeal:

1. A method of booting a computer system using a preboot data, the method comprising:
 - transmitting a boot request;
 - receiving, in response to the boot request, a boot loader that is adapted to read the preboot data;
 - transmitting a request for a boot data corresponding to the preboot data;
 - receiving the boot data corresponding to the preboot data;and
 - booting the computer system using the boot data.

REJECTIONS ON APPEAL

Claims 1–5, 7–13, and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dickens (US 2007/0198819 A1; publ. Aug. 23, 2007).

Claims 6 and 14 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Dickens and Brown (US 2006/0010315 A1; publ. Jan. 12, 2006).

ISSUES

Appellants' contentions present us with the following issues:

A) Did the Examiner err in finding Dickens discloses the *preboot data* recited in independent claim 1?

B) Did the Examiner err in finding Dickens discloses *the preboot data comprises a request to perform a specific action*, as recited in dependent claim 4?

C) Did the Examiner err in finding Dickens discloses *the preboot data comprises a request to modify a configuration file*, as recited in dependent claim 5?

ANALYSIS

We have reviewed the Examiner's rejections in consideration of Appellants' contentions and the evidence of record. We disagree with Appellants' conclusions that the Examiner's rejections of claims 1–3, 6–11, 14, and 15 are in error. Appellants have persuaded us the Examiner has failed to establish that claims 4, 5, 12, and 13 are unpatentable over the cited prior art.

Issue A: Claim 1–3, 6–11, 14, and 15

Appellants contend Dickens does not disclose the preboot data recited in independent claim 1. App. Br. 7–9; Reply Br. 2–3. Specifically, Appellants argue the boot application of Dickens must perform the described test on each system to determine the system architecture because no preboot data identifying the system architecture exists. App. Br. 9. Appellants further argue that the preboot data recited in claim 1 is read by the adapted boot loader, which is not the same as performing a test that includes setting a value for a particular control option in a register to determine whether a processor is 64-bit compatible. Reply Br. 2. We are not persuaded by these arguments.

The Examiner finds, and we agree, that Dickens discloses the preboot data and the specific use of the preboot data that is recited in claim 1. *See*

Final Act. 3–4; Ans. 10–11. The cited sections of Dickens describe that a boot application performs a test for identifying whether a client is 64-bit compatible by setting a value for a particular control option in the register of the client processor, identifying another value as a response, and using the received response to identify the computing architecture of the client and transmit the appropriate boot image file, which is then executed to boot the client. *See* Dickens ¶¶ 26–29. Although Appellants are correct that the response value is created as a result of a test performed by the boot application, claim 1 does not preclude additional steps being performed by the claimed “boot loader” to create the claimed “preboot data,” and thus, does not exclude Dickens’ teaching of the boot application creating the response value. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim”) (internal citation omitted).

Appellants fail to persuade us the Examiner errs in finding Dickens discloses the preboot data recited in claim 1. Accordingly, we sustain the 35 U.S.C. § 102(b) rejection of: (1) claim 1; (2) independent claims 8 and 15, for which Appellants rely on the same arguments made for claim 1 (*see* App. Br. 8); and (3) dependent claims 2, 3, 7, 9–11 and 15, for which Appellants do not present separate arguments for patentability.

With respect to dependent claims 6 and 14, Appellants merely contend the additional reference used in the rejection of these claims (Brown) does not make up for the purported deficiencies present in the rejection of independent claims 1 and 8. App. Br. 11–12. For the reasons

discussed *supra*, Appellants fail to establish any deficiencies in the rejection of claims 1 and 8. Accordingly, we sustain the 35 U.S.C. § 103(a) rejection of claims 6 and 14.

Issues B and C: Claims 4, 5, 12, and 13

The Examiner finds Dickens discloses the preboot data comprises a request to perform a specific action, as recited in dependent claim 4. Final Act. 5; Ans. 11–12. The Examiner further finds Dickens discloses the preboot data comprises a request to modify a configuration file, as recited in dependent claim 5. Final Act. 5; Ans. 12–13.

Appellants contend that the computer architecture of the client that the Examiner has identified as the preboot data does not include either of the requests recited in dependent claims 4 and 5. *See* App. Br. 9–10; Reply Br. 3. We agree. The cited sections of Dickens describe that a response value (equated by the Examiner to be the preboot data) is identified which indicates whether the client supports 64-bit computer executable instructions. Dickens ¶¶ 27–28. Although the response value is *used* to request the appropriate boot file, it does not itself comprise either a request to perform a specific action or a request to modify a configuration file.

For the reasons stated above, Appellants persuade us the Examiner errs in finding Dickens discloses the limitations set forth in claims 4 and 5. Claims 12 and 13 recite substantially the same limitations as those recited in claims 4 and 5 respectively. Accordingly, we do not sustain the 35 U.S.C. § 102(b) rejection of claims 4, 5, 12, and 13.

DECISION

We affirm the Examiner’s decision to reject claims 1–3, 6–11, 14, and 15.

Appeal 2015-003593
Application 13/133,944

We reverse the Examiner's decision to reject claims 4, 5, 12, and 13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART