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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* EDWARD J. BATEWELL

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Appeal 2015-006352  
Application 12/555,851  
Technology Center 2400

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Before THU A. DANG, JOHN P. PINKERTON, and  
JAMES W. DEJMEK, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> files this appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–3, 5–9, 11–15, and 17–19, which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellant identifies International Business Machines Corp. as the real party in interest. App. Br. 1.

## STATEMENT OF THE CASE

### *Introduction*

Appellant's described and claimed invention generally relates to a system, method, and program product for automatically configuring a storage device for a server. Abstract.<sup>2</sup>

Claim 1 is representative and reads as follows (with the disputed limitations *emphasized*):

1. A method for automatically configuring a storage device for each host of a plurality of host within a distributed environment, comprising:

*preconfiguring the storage device with a set of LUNs (logical unit numbers) and a plurality of empty configuration hostgroups, each empty configuration hostgroup having access authority for at least one of the set of LUNs;*

*preconfiguring each host to include a storage configuration package;*

*connecting the storage device to each host, each connection via a link including an in-band connection and a switched connection;*

*launching the storage configuration package on each host at one location of a plurality of locations within the distributed environment to run a set of scripts to perform the actions comprised of:*

*installing a set of drivers;*

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<sup>2</sup> Our Decision refers to the Final Office Action mailed June 27, 2014 ("Final Act."), Appellant's Appeal Brief filed Nov. 21, 2014 ("App. Br.") and Reply Brief filed June 8, 2015 ("Reply Br."), the Examiner's Answer mailed Apr. 8, 2015 ("Ans."), and the original Specification filed Sept. 9, 2009 ("Spec.").

resetting a UUID (universally unique identifier) and modifying a kernel;

installing a storage management system on each host;

discovering WWIDs (world wide identifiers), a hostname and the storage device;

*adding each host to at least one of the empty configuration hostgroups, wherein the empty configuration hostgroup is empty until the addition of a host;*

creating and adding the hostname to *the empty configuration hostgroup;*

passing the WWIDs to the storage device, and associating the WWIDs with each host;

mapping a set of disks; and

rebooting each host.

#### *Rejection on Appeal*

Claims 1–3, 5–9, 11–15, and 17–19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA (Applicant’s Admitted Prior Art Batewell (US 2011/0060815 A1, published Mar. 10, 2011)), Anderson et al. (US 2005/014474 A1, published May 26, 2005) (“Anderson”), Jewett et al. (US 2002/0049825 A1, published Apr. 25, 2002) (“Jewett”), Baldwin et al. (US 2007/0094378 A1, published Apr. 26, 2007) (“Baldwin”), and Ferreira et al. (US 2007/0162968 A1, published July 12, 2007) (“Ferreira”).

#### ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments in the Briefs (*see* App. Br. 6–8; Reply Br. 2–4) and are not persuaded that the Examiner has erred. Unless otherwise noted, we adopt as our own the findings and reasons set forth by the Examiner in the Office

Action from which this appeal is taken (Final Act. 4–19) and in the Examiner’s Answer (Ans. 2–4), and we concur with the conclusions reached by the Examiner. For emphasis, we consider and highlight specific arguments as presented in the Briefs.

*Rejection of Claim 1<sup>3</sup> under § 103(a)*

Appellant argues the combination of references cited by the Examiner fails to teach the steps of “configuring the storage device,” “adding each host,” and “creating” of claim 1 because the Examiner’s reliance on Ferreira “as allegedly teaching that the empty configuration hostgroup is empty until the addition of a host” is faulty as Ferreira requires an administrator. App. Br. 6–7. According to Appellant, the invention is directed to eliminating the necessity for an administrator to be involved and, because the Examiner has cited references which allegedly automatically fulfill their steps, “there would be no reason to combine them with Ferreira, which explicitly requires the intervention of an administrator.” *Id.* at 7; Reply Br. 2–3.

We are not persuaded by Appellant’s arguments that the Examiner has erred. The Examiner finds, and we agree, Ferreira teaches initially-empty hostgroups “wherein the process of adding a host to a preconfigured empty hostgroup (preconfiguration of hostgroups) is done by an administrator.” Final Act. 7 (citing Ferreira ¶¶ 53, 70, 83); Ans. 3. The Examiner also finds, and we agree, it would have been obvious to combine and automate the teaching of Ferreira with the other cited art “since the other prior art[] of record disclose[s] automated processes of configuring a storage device.”

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<sup>3</sup> We decide the rejection of claims 1–3, 5–9, 11–15, and 17–19, which are argued together as a group, on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Ans. 3; *see also* Final Act. 7. Appellant’s argument that there would be no reason or motivation to combine the references, which allegedly automatically fulfill their steps, with Ferriera, which requires an administrator “and provides a backwards step to the advancement of the art” (App. Br. 7; Reply Br. 2) is unpersuasive because, as the Examiner finds, the proposed combination would incorporate and automate the known, manual step taught by Ferriera with the automated steps of the other prior art.

Ans. 3.

Appellant also argues that Ferriera would not combine with the automated processes of the other cited art and “it would be entirely unclear how to automate the disclosure of Ferreira,” which Appellant further argues “would require undue experimentation.” Reply Br. 3. We are not persuaded by these arguments. “[A] determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F. 3d 1322, 1332 (Fed. Cir. 2012) (citations omitted). Nor is the test for obviousness whether a secondary reference’s features can be bodily incorporated into the structure of the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *Id.* Here, for the reasons stated, we conclude the preponderance of the evidence supports the Examiner’s findings that the combined teachings of the references teach the disputed limitations of claim 1.<sup>4</sup>

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<sup>4</sup> Appellant also argues the Examiner cites *In re Venner*, 262 F.2d 91, 95 (CCPA 1958) in an attempt to remedy the fact that Ferriera requires an administrator and Venner fails to remedy this as “Appellant has automated

Thus, we are not persuaded the Examiner erred in (1) finding the combined teachings of the cited prior art teaches or suggests the disputed limitations of claim 1 and (2) concluding that the combined teachings of the cited prior art render the subject matter of claim 1 obvious under 35 U.S.C. § 103(a). Accordingly, we sustain the Examiner's rejection of claims 1, 7, 13, and 19, as well as dependent claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 15, 17, and 18, which are not argued separately. *See* App. Br. 8; Reply Br. 4.

#### DECISION

We affirm the Examiner's decision rejecting claims 1–3, 5–9, 11–15, and 17–19 under 35 U.S.C. § 103(a).

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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the entire process, not just a step.” App. Br. 7; Reply Br. 2–3. Although we do not agree with Appellant's characterization of the Examiner's reason for citing *Venner* (*see* Ans. 3), it is not necessary for us to decide the applicability of *Venner* here because Appellant's have not persuaded us of error in the Examiner's findings or conclusions regarding the obviousness rejection of claim 1.