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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STUART ALLEN BERKE and
MUKUND PURSHOTTAM KHATRI

Appeal 2020-002713
Application 14/304,276[1]
Technology Center 3600

Before BRUCE T. WIEDER, KENNETH G. SCHOPFER, and AMEE A. SHAH, *Administrative Patent Judges*.

WIEDER, *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 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Dell Products, L.P. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellant's invention relates "to information handling systems, and more particularly to distinguishing, via a system license, information handling resources that are supported by a provider (e.g., manufacturer, vendor, etc.) of an information handling system from unsupported information handling resources." (Spec. 2, ll. 5–10.)

Claims 1, 8, and 15 are the independent claims on appeal. Claim 1 is illustrative. It recites:

> 1. An information handling system comprising:
>
> a processor;
>
> at least one information handling resource communicatively coupled to the processor, wherein the at least one information handling resource is a hardware information handling resource; and
>
> a basic input/output system (BIOS) comprising a program of instructions executable by the processor and configured to cause the processor to initialize one or more information handling resources of the information handling system, wherein the BIOS is configured to:
>
> record information regarding the at least one information handling resource, wherein the information identifies a manufacturer of the at least one information handling resource;
>
> compare the information to a license for the information handling system to determine if the at least one information handling resource is supported by a provider of the information handling system; and
>
> responsive to determining that the information handling system is unsupported by the provider based on the manufacturer being an unsupported manufacturer, initiate a remedial action with respect to at least one information handling resource to improve stability of the information handling system to a greater stability level than would be present in the absence of the remedial action, wherein the remedial action includes disabling the

> at least one information handling resource from being used by the information handling system such that the information handling system is configured to continue functioning without using the at least one information handling resource.

REJECTIONS

Claims 1–21 are rejected under 35 U.S.C. § 103 as unpatentable in view of Venkatachalam (US 2007/0143462 A1, pub. June 21, 2007) and Nadon (US 2013/0111197 A1, pub. May 2, 2013).

ANALYSIS

Appellant does not separately argue claims 1–21. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Obviousness is a legal conclusion involving a determination of underlying facts.

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966)).

With regard to the scope and content of the prior art, the Examiner finds Venkatachalam discloses all of the limitations of claim 1 except "Venkatachalam does not explicitly teach determining . . . **the**

manufacturer being an unsupported manufacturer." (Final Action 8–15.) Specifically, the "Examiner found Venkatachalam taught compliance auditing measures in at least ¶¶0043-0045 to determine whether a system is supported or not, but not explicitly in relation to a manufacturer." (Answer 3–4.) The Examiner finds that "Nadon teaches determining . . . **the manufacturer being an unsupported manufacturer**." (*Id.* at 15 (citing Nadon ¶ 31); *see also* Answer 4–5 (citing Nadon ¶¶ 31, 64).)

Appellant argues that Nadon "describe[s] allowing for customization of components in a way that differs from the standard configuration of the OEM license. But this customization has nothing to do with a determination that a manufacturer is an '**unsupported manufacturer**.'" (Appeal Br. 6.)

As an initial matter, we construe the claim term "unsupported manufacturer." The term is not defined or even used in Appellant's Specification. The Examiner "established the broadest reasonable interpretation of the contested claim language by citing to [page 17, line 25 through page 18, line 13] of Applicant's . . . Specification." (Answer 4.) Based on this, the Examiner determines that "[b]y broadest reasonable interpretation of the claims, determining an unsupported manufacturer requires steps of obtaining a licensed information handling system ('IHS') configuration and comparing a manufacturer's product with that permissible (*i.e.*, licensed) configuration." (*Id.*) We disagree.

Claims are construed in light of the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990) ("During examination, 'claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the

specification as it would be interpreted by one of ordinary skill in the art.'")). We are also mindful that "[t]he general rule . . . is that the claims of a patent are not limited to the preferred embodiment." *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 973 (Fed. Cir. 1999).

In describing the problem to be addressed, Appellant's Specification recites in the "BACKGROUND" section:

> A provider of an information handling system (e.g., a manufacturer, vendor, seller, or other provider) may expend significant amounts of time and financial resources to develop, test, and validate information handling resources that are installed in an information handling system, in order to ensure compatibility and robustness of operation. However, some customers of information handling systems may choose (e.g., to save on cost) to install information handling resources which are not validated or supported by the provider of the information handling system. Such unsupported information handling resources may cause instabilities in an information handling system, or may lack robustness required to utilize advanced capabilities of an information handling system.

(Spec. p. 3, l. 26–p. 4, l. 8.)

Appellant's Specification further discloses that

> during manufacturing of information handling system 102 (e.g., during factory configuration and testing), information handling system 102 may record information regarding information handling resources (e.g., memory system 104) installed in information handling system 102 which are validated during such configuration and testing, and store that information in a per-system license for information handling system 102, which may be maintained in license information 114 of information handling system 102 . . . .
>
> At step 202, licensing engine 116 may, for each memory module 106 present in information handling system 102, record information regarding memory modules 106. *Such information may include, without limitation, a unique identifier (e.g., a serial*

> *number) of each memory module 106, a manufacturer of each memory module 106*, version/revision information of each memory module 106 . . . .
>
> [L]icensing engine 116 may generate a memory license for information handling system 102, wherein such memory license may include some or all of the information collected in step 202. . . . [L]icensing engine 116 may securely store such memory license in license information 114, license information 134, or supported resource database 136.

(*Id.* at p. 17, l. 25–p. 19, l. 24. (emphasis added).)

In view of the above, and applying a broadest reasonable interpretation, we determine that the term "unsupported manufacturer" includes a manufacturer of at least one information handling resource in an information handling system where that manufacturer is not included in the license information for that information handling system.[2]

Venkatachalam discloses a system and method for "monitor[ing] computer system timer(s) relative to other timers to detect discrepancies . . . . The invention may also provide a method to detect power source tampering using a last known good time and may provide a means to securely initialize system time using an encrypted time stamp." (Venkatachalam, Abstract.) Venkatachalam also discloses a license provision module (LPM) that "may be incorporated to measure and authorize use of the computer in a pay-per-use or pay-per-period configuration." (*Id.* ¶ 33.) Venkatachalam also discloses a "separately-booted isolated computing environment **125** [that] may have configuration data that allows operation of the computer according to its licensed capability" where "the isolated computing environment **125**

[2] We note that claim 1 recites both "a *provider* of the information handling system" and "a *manufacturer* of the at least one information handling resource." (Emphasis added.)

may assume the role of the LPM with respect to valid hardware configuration of the computer." (*Id.* ¶ 34.)

The Examiner does not point to any disclosure in Venkatachalam regarding the LPM making a determination based on a manufacturer being an unsupported manufacturer. However, the Examiner finds that "Nadon teaches determining an unsupported manufacturer by determining how a manufacturer (*e.g.*, factory) configured an IHS and determining whether or not it is what it should be (*i.e.*, is supported or unsupported by the license). (Answer 5; *see also id.* 4–5 (citing Nadon ¶¶ 31, 64).)

Nadon discloses "a method of configuring an information handling system." (Nadon, Abstract.) The method includes a personality module on the base platform of the system wherein "[t]he personality module is configured to store personality information associated with an information handling resource of the information handling system." (*Id.*) Nadon discloses that "a configuration system **120** of the manufacturer or vendor may be communicatively coupled to information handling system **100** and may be configured to pre-install personality module **116** and one or more information handling resources upon information handling system **100**." (*Id.* ¶ 31.) Nadon further discloses that "configuration system **120** may enable or disable information handling resources associated with information handling system **100** depending on the licensing of operation and use of those resources by information handling system **100**." (*Id.* ¶ 62.) Nadon also discloses that with respect to licensing information handling resources in the information handling system,

> a standard original equipment manufacture [sic] (OEM) license may be applied to enable a default set of resources associated with information handling system 100. In some instances,

> personality module **116** may include licensing information that may enable or disable resources not enabled or disabled according to the standard OEM license, such that personality module **116** may customize the licensing of information handling system **100** away from the standard OEM license.

(*Id.* ¶ 64.)

In short, the portions of Nadon cited by the Examiner disclose a personality module in an information handling system that may contain licensing information to enable or disable resources based on whether the resource is licensed. And, Nadon discloses that the licensing information in the personality module may be set by the manufacturer of the information handling system. (*Id.*) Claim 1 recites that the licensing "information identifies a manufacturer of the . . . information handling resource," and the "determin[ation] that the information handling system is unsupported by the provider [is] based on the manufacturer [of the information handling resource] being an unsupported manufacturer." We do not find in the cited portions of Nadon a disclosure of what is included in the licensing information, e.g., we do not find a disclosure that the licensing information includes identification of the manufacturer of the resource. Therefore, we disagree with the Examiner's finding that the cited portions of "Nadon teach[] determining . . . the manufacturer being an unsupported manufacturer." (*Id.* at 15 (emphasis omitted) (citing Nadon ¶ 31).) In view of the above, we are persuaded of reversible error.

Independent claims 8 and 15 contain similar language and for similar reasons, we are persuaded of reversible error.

CONCLUSION

The Examiner's rejection of claims 1–21 under 35 U.S.C. § 103 is reversed.

Specifically:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–21	103	Venkatachalam, Nadon		1–21

REVERSED