

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY W. HAMILTON, JOHN W. SLATTERY
and KERRY J. MONROE

Appeal No. 1998-0613
Application 08/554,998

ON BRIEF

Before THOMAS, FLEMING and HECKER, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 76 through 83. Claims 84 through 86 have been withdrawn from consideration as being directed to a non-elected invention. This constitutes all the

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claims remaining in this application.

Appellants' invention relates to automatic initialization and configuration of input/output (I/O) boards for a computer.

In accordance with the invention, each individual I/O board is adapted to recognize a unique sequence of commands, and then to activate some aspects of the board in response. Each I/O command has an associated address, but before a particular board is activated, there is no address associated with the particular board. Board addresses are assigned after activation. An inactive I/O board is commanded to become active, even though the I/O board address is not known by the processor or not yet assigned by the processor.

Representative independent claim 76 is reproduced as follows:

76. An apparatus in a computer, for activating an input/output (I/O) board in the computer, the apparatus comprising:

a processor;

an I/O bus electrically coupled to the processor and the I/O board;

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the processor adapted to send an I/O command and an address over the I/O bus;

the I/O board adapted to receive the I/O command and the address;

the processor configured to send a particular sequence of I/O commands and addresses over the I/O bus wherein addresses within the particular sequence are not all identical;

the I/O board configured to compare the particular sequence of I/O commands and addresses to a predetermined sequence; and

the I/O board configured to activate at least a portion of the I/O board when the particular sequence of I/O commands and addresses matches the predetermined sequence.

The Examiner does not rely on any references.

Claims 76 through 83 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which lacks support in the specification.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief, reply brief and answer for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that the disclosure in this application does comply with the written description requirement of 35 U.S.C. § 112.

At the outset, we note that Appellants have indicated on

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page 4 of the brief that claims 76 through 83 all stand or fall together. Therefore, we will treat claim 76 as the representative claim.

Initially we note that the Examiner's reasoning for lack of "support" for the claimed invention herein, implicitly refers to the written description portion of this statutory provision. *In re Higbee*, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976). The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity, to those skilled in the art, that they were in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." *Vas-cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The manner in which the specification as filed meets the written description requirement is not material. The requirement may be met by either an express or an implicit disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). An invention claimed need not be described in

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ipsis verbis in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. **In re Lukach**, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question is not whether an added word was the word used in the specification as filed, but whether there is support in the specification for the employment of the word in the claims, that is, whether the concept is present in the original disclosure. **See In re Anderson**, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

In the instant case the Examiner finds no support in the specification for the claim language:

the I/O board configured to compare the particular sequence of I/O commands and addresses to a predetermined sequence; and
the I/O board configured to activate at least a portion of the I/O board when the particular sequence of I/O commands and addresses matches the predetermined sequence.

The Examiner discusses the specification and arguments and concludes "The above passage clearly shows that an address is not needed to activate some aspects of the board." (Answer-page 4.)

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Appellants' brief argues:

1. The specification is not required to explicitly teach addresses associated with I/O commands if such knowledge was generally available to one of ordinary skill in the computer art prior to the date of the application.

2. Addresses are inherently associated with I/O commands as part of the general knowledge available to one of ordinary skill in the computer art prior to the date of the application.

3. There is support in the specification as filed for a sequence of non-identical addresses associated with I/O commands.
(Brief-page 4.)

The issue appears to be that the Examiner believes Appellants' specification provides for activation of an I/O board without using addresses. Thus, the Examiner would have us believe "and addresses" should not be included in the claim language. This brings us to Appellants' only relevant argument, number 3.

The specification is virtually littered with various references to "addresses" and "I/O commands". The central question is, are they used together to activate an I/O board. Skipping through the specification we see at page 11, lines 25-26, a base address is selected from a list. Page 11, lines 31-34, disclose this list as "designed to start with the most

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likely **address** to be available initially. It is prioritized based on widely disseminated industry specifications which specify what **addresses** some peripheral devices use."

(Emphasis added.) "This initial address is then assessed to see if it is unique to that I/O board. If it is not unique, the next on the list is tried and so on." (page 12-lines 15-17). "In some instances this may be enough, however, in order to accommodate the broad variation in system configurations, this initial choice needs to be checked....the present invention accomplishes this through the use of **common commands** in several unique manners." (page 12, lines 27-32, emphasis added). Finally, at page 15, lines 6-9, the specification states "Earlier, it was mentioned that the routine used to assess if the chosen **address** is unique is an escalating routine. By this it is meant that the routine next executes **commands** which have an even higher probability of discovering a conflict." (emphasis added).

Thus, we discern that combinations of **addresses** (selected from a list) **and commands** (e.g., a read command, write command, etc.) are applied to the I/O board to assess proper

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activation. Accordingly we find that the specification does support the claim language, and meets the written description requirement of 35 U.S.C. § 112.

Additionally we note that original claim 52 states in part, "e. a means for assessing if **said address** is unique to said I/O board wherein said means for assessing comprises said **command-response** sequence." (Emphasis added.) Again we find a combination of command **and** address being applied to the I/O board. Original claims are considered to be part of the original disclosure for written description purposes.

Thus, we agree with Appellants that there is support in the specification for the language in the claims. Consequently we will not sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

The decision of the examiner rejecting claims 76 through 83 is reversed.

REVERSED

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Administrative Patent Judge)	
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