

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 557,756 having been rejected under Rule 47(2) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for Applicant

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Patent Application 557,756 (class 354-236) was filed on January 29, 1988 for an invention entitled "Programmable Option Select". The inventors are Chester A. Heath et al. The Examiner in charge of the application took a Final Action on May 14, 1992 refusing to allow the application to proceed to patent.

The application is directed to a data processing system with option cards for controlling peripheral devices. In the prior art, upon re-powering or resetting the system after a power-down, an initializing set up routine retrieves and stores the appropriate parameters in input/output cards and in slot positions in main memory. The present application discloses a routine to reduce the time delay experienced by a user on subsequent power-on routines by merely transferring parameters from the table to the card option registers if the status of all slots has not previously been changed.

Figure 1 shows a system board 1 containing a bus 17 which is joined to CPU 8 and memory modules 9, 10, 11 of which module 10 is non-volatile and stores information relative to slots 2-0 to 2-7 and its associated option card when the system is powered down. Option cards labelled 5-0 to 5-7 fit into slots 2-0 to 2-7 each containing a register 21 to store parameter information for controlling communication between the card and the system. Slot address decoder 14 and control logic 22 are described in detail in the disclosure to show their use in the setup routines of Figures 6 and 7 which are shown overleaf.

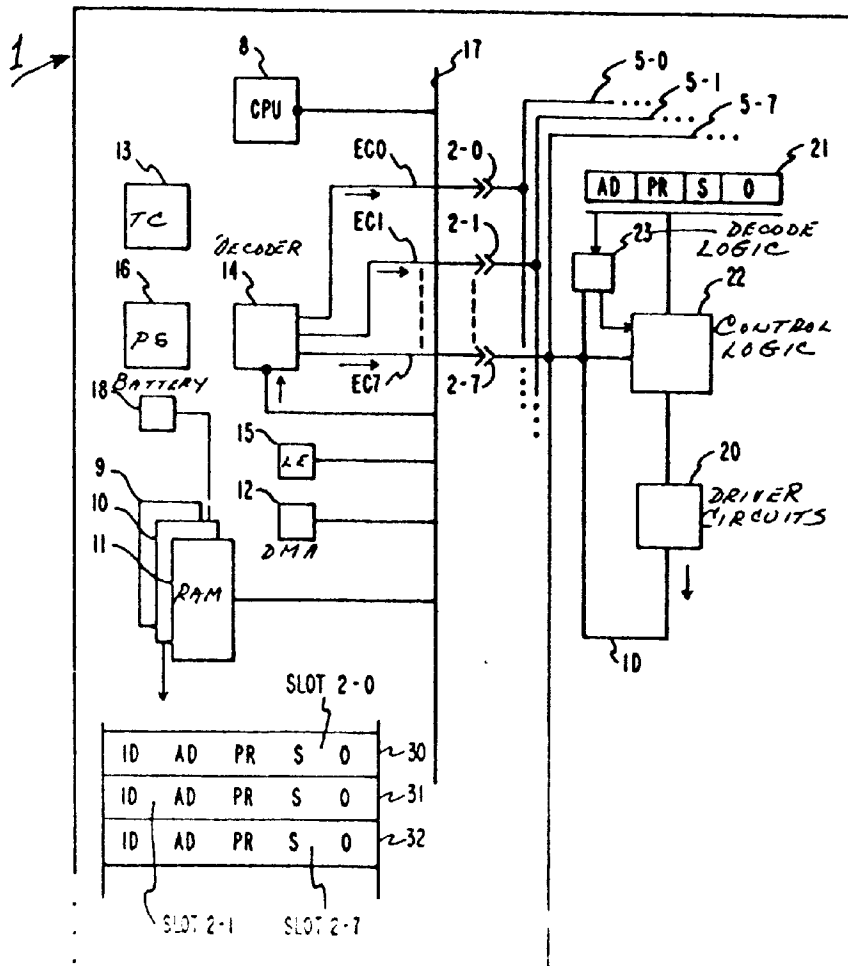
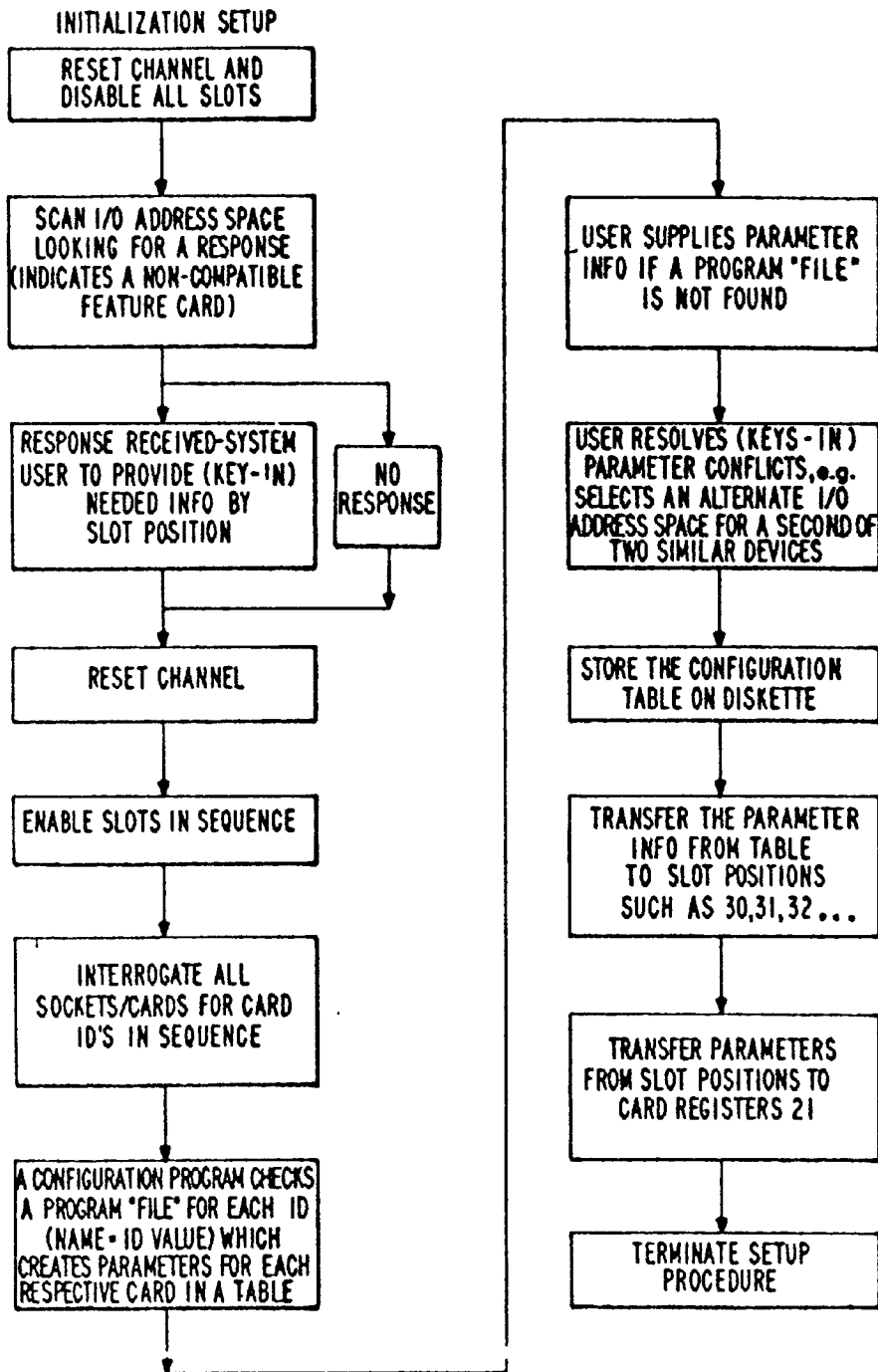
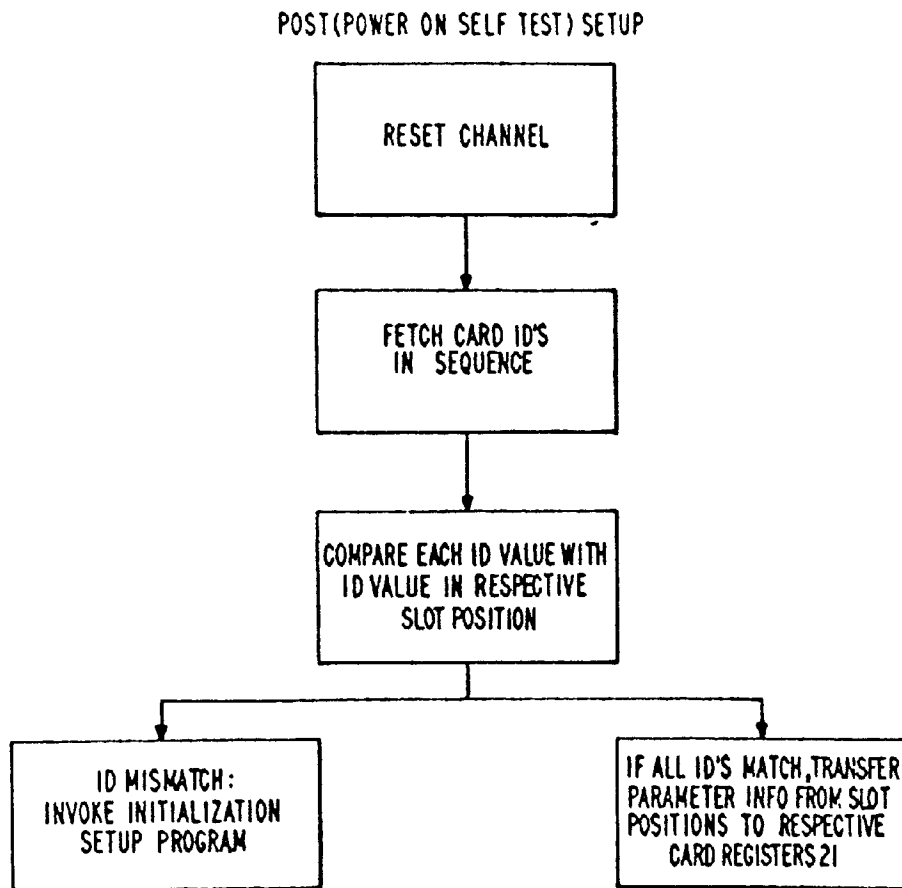


FIG. 6



The flow diagram of Figure 7, which is also described on page 6, line 18 to page 7, line 15 of the disclosure shows two possible paths that the setup routine may follow. The right-hand side path transfers parameter data directly from memory slot positions to the respective card registers on successful comparison of the ID values. The left-hand side path follows the lengthy procedure of Figure 6 when the ID values do not correspond.

FIG. 7



The examiner rejected the application in the Final Action for failure to comply with Sections 34(1) and 37 of the Patent Act and Rule 19(3). The application was held to be objectionable in that the flow chart of Figure 6 does not have written references corresponding to the description on page 7, line 15 to page 8, line 17. The rejection is not based on a demonstrable indefiniteness or insufficiency of the disclosure under Section 34(1) but rather on a desire to fulfil the formal requirements of Section 37(2) and Rule 19(3). In that action the examiner stated (in part):

It is clear from Section 37 that a drawing is required along with a specification and does not lessen the requirement of a specification as set out in Section 34(1). Section 37 requires that the drawing relate to the specification by having written references corresponding with the specification. The application is objectionable in this respect in that figure 6 does not have written references corresponding to the description on page 7 line 15 to page 8 line 17.

Applicant responded to the Final Action with a detailed reply and had, *inter alia*, this to say:

In broad, general terms, the present invention resides in the simplification of the power-on routines performed by computer systems following power-down occurrences. (Figure 6 is presented in the application merely to remind a reader of the many initialization steps necessary after a power-down situation has occurred.) The reduction of steps, as per the invention, is effected through the expedient of storing card I.D.s etc. in main, (non-volatile) memory. At

restart, providing the status of the cards remains unchanged, the power-on routine (POST) is significantly reduced, as can readily be seen through a simple comparison of Figures 6 and 7.

The entire invention per se is clearly and completely described with reference to Figures 1 through 5. All that is claimed in this application is there fully supported.

It is difficult for the Applicant to know how far to go in touching on the sufficiency of the disclosure to support the claims currently of record. No claims have been rejected for lack of support in the disclosure, nor for that matter could they be so rejected. It would seem that the Examiner's objection is based more on a desire to correct what he seems to view as an informality, than on demonstrable insufficiency of disclosure.

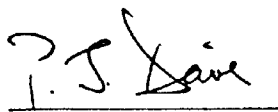
The Board notes that the specification, disclosure or description may not include drawings as specified by Rule 19(3) of the Patent Rules. Drawings must be attached on separate sheets to the application in sequence after the claims. A full description of the invention with reference to the drawings must be given in the specification in accordance with Sections 34 and 37 of the Patent Act.

In the Final Action the Examiner objected to the flow chart of Figure 6 as not being fully described in the disclosure. There is no objection to the sufficiency of the description in the flow chart. The examiner required amendment of the disclosure in order that all the steps of the flow chart in Figure 6 be listed in the disclosure.


Applicant pointed out in reply to the Final Action that Figure 6 does not illustrate the invention and that it is therefore not necessary for sufficiency of the disclosure to have a description of the same in the disclosure.

The Board agrees with the applicant that Figure 6 lists steps of a prior art initialization setup. The alleged invention resides in the simplification of the power-on routines following power-down occurrences. Figure 6 illustrates one of many prior art initialization steps which are significantly reduced by the invention. The flowchart of Figure 7, indicates a prior art initialization setup under "ID mismatch" and the new procedure according to the present invention is indicated under "ID match". Figure 7 is fully described on pages 6 and 7 of the specification.

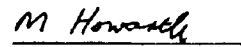
The Board finds, therefore, that the alleged invention has been fully disclosed in the specification in accordance with Sections 34 and 37 and recommends that the rejection under Sections 34(1) and 37 be withdrawn.



P.J. Davies
Acting Chairman
Patent Appeal Board




P. Ebsen
Member
Patent Appeal Board



M. Howarth
Member
Patent Appeal Board

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I agree that the rejection of the application under Sections 34(1) and 37 be withdrawn and that the application be returned to the examiner for further prosecution consistent with this decision.



M. Leesti
Commissioner of Patents

Dated at Hull, Quebec
this 24th day of January 1994