

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTON BACHHUBER, MAXIMILLIAN KERN and
CHRISTIAN SCHNEIDER

Appeal No. 1999-0497
Application 08/760,922

ON BRIEF

Before JERRY SMITH, LALL and LEVY, Administrative Patent Judges.

JERRY SMITH, 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 1, 2 and 4-17, which constitute all the claims remaining in the application. All amendments filed by appellants have been entered by the examiner. The disclosed invention pertains to a system with optical or radio remote control for initializing a

system for locking and/or unlocking the doors of a motor vehicle.

Representative claim 1 is reproduced as follows:

1. A system with optical or radio remote control for initializing a system for locking and/or unlocking doors of motor vehicles, comprising:

a portable transmitter corresponding to a key for a motor vehicle, said transmitter broadcasting a digital code upon actuation by a user for locking and/or unlocking doors of the motor vehicle;

said broadcast digital code received by a receiver in the motor vehicle, which receiver controls a relevant lock or locks of the doors of the motor vehicle after a comparison and correlation of the received digital code with a predetermined code stored in the receiver;

the digital code being initialized a the predetermined code at least when the motor vehicle is first used and, possibly when changes are later made to the digital code, being reinitialized, that is fixed for following actuations, by storing in the receiver the broadcast digital code as a new predetermined code that replaces a previous predetermined code, the broadcast digital code being also storable in the transmitter;

an external diagnostic device for supplying at least an external signal for (re)initialization, that is for initialization and/or for (re)initialization, the receiver being switched only after reception of the external signal to a (re)initialization readiness status before the receiver is (re)initialized;

the motor vehicle having a diagnostic interface for electrical testing of motor vehicle units in the motor

Appeal No. 1999-0497
Application 08/760,922

vehicle, said diagnostic interface connected to said receiver;
and

the receiver being switchable to the (re)initialization
readiness status only after reception of the external signal
fed to the receiver via the diagnostic interface from the
external diagnostic device;

wherein a new code signal is generated using the
transmitter and is transmitted to the receiver, the new code
signal then being stored as a new-predetermined code signal in
the receiver.

The examiner relies on the following references:

Lutz	4,366,466	Dec. 28, 1982
Sanders et al. (Sanders)	4,754,255	June 28, 1988
Keller	4,847,614	July 11, 1989
De Vaultx	4,888,575	Dec. 19, 1989
Sues et al. (Sues)	5,229,648	July 20, 1993
		(filed Jan. 04,
1991)		
Batey	GB 2,144,249	Feb. 27, 1985

Claims 1, 4, 6-8, 12, 14 and 17 stand rejected under
35 U.S.C. § 103 as being unpatentable over the teachings of
Sanders and Lutz and either Sues or De Vaultx. Claims 2, 5,
10, 11 and 13 stand rejected under 35 U.S.C. § 103 as being
unpatentable over the teachings of Sanders and Lutz and either
Sues or De Vaultx and further in view of Batey. Claims 9, 15
and 16 stand rejected under 35 U.S.C. § 103 as being
unpatentable over the teachings of Sanders and Lutz and either

Appeal No. 1999-0497
Application 08/760,922

Sues or De Vaultx and further in view of Batey and Keller.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 2 and 4-17. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

Appeal No. 1999-0497
Application 08/760,922

837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

Appeal No. 1999-0497
Application 08/760,922

and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 4, 6-8, 12, 14 and 17 based on the teachings of Sanders and Lutz and either Sues or De Vault. These claims stand or fall together as a single group [brief, page 3]. Therefore, we will consider the examiner's rejection with respect to claim 1 as representative of all the claims subject to this rejection.

With respect to representative, independent claim 1, the examiner finds that Sanders teaches all the features of

Appeal No. 1999-0497
Application 08/760,922

the claimed invention except for the diagnostic interface to switch or control the receiver in a (re)initialization state from the external of the vehicle. The examiner cites Sues or De Vault as teaching the use of external equipment for (re)initializing the status of a vehicle locking and unlocking system. The examiner finds that it would have been obvious to the artisan to have utilized an external apparatus as taught by Sues or De Vault to send signals to the locking/unlocking system of Sanders. The examiner cites Lutz as teaching the use of a vehicle diagnostic interface. The examiner finds that use of the Lutz diagnostic interface would have been obvious because it would reduce the number of communication interfaces required for the vehicle [answer, pages 4-5].

After pointing out the individual deficiencies of the applied prior art, appellants argue that none of the applied references teach the last feature of claim 1, specifically, "wherein a new code signal is generated using the transmitter and is transmitted to the receiver, the new code signal then being stored as a new-predetermined code signal in the receiver." According to appellants, since none of the applied

Appeal No. 1999-0497
Application 08/760,922

references teach this feature of claim 1, then no combination of these references can be said to teach this feature of claim 1. Appellants also argue that there is no motivation for combining the disparate teachings of the applied prior art.

The examiner responds that the argued feature of claim 1 is met by Sues and De Vault which "attach external equipment to the vehicle system so that the external equipment can (re)initialize the status of the locking and unlocking system to set a new code" [answer, page 7]. The examiner also disagrees with appellants' assertion that there is no motivation to combine the applied prior art.

We agree with appellants that none of the applied prior art references teach the last feature of claim 1, and the examiner has failed to properly consider this feature of claim 1. Specifically, this last feature of claim 1 requires that "the transmitter" generate the new code to the receiver. The phrase "the transmitter" of claim 1 refers to the portable transmitter corresponding to the key for a motor vehicle. Thus, even though the claimed invention uses an external diagnostic device for supplying an external signal for (re)initialization, the new code signal comes from the

Appeal No. 1999-0497
Application 08/760,922

portable transmitter and not from the external device. The examiner has never addressed this particular feature of the invention.

In responding to appellants' argument that this feature is not taught by the applied references, the examiner notes that the external equipment of Sues and De Vaultx can (re)initialize the system. This is not, however, what is recited in the claimed invention. The fact that Sues and De Vaultx generate a new code signal from the external equipment does not meet the claim recitation that the new code signal is generated using the portable transmitter. The examiner has not addressed the obviousness of this actual claim limitation relating to this particular feature of the claimed invention. Since the rejection does not address the fact that this claim limitation is not met by any of the applied references, the rejection fails to establish a prima facie case of the obviousness of the claimed invention.

Based on the discussion above, we do not sustain the rejection of the claims based on the collective teachings of Sanders, Lutz, Sues and De Vaultx as set forth by the examiner. Since neither Batey nor Keller overcomes the deficiency in the

Appeal No. 1999-0497
Application 08/760,922

rejection noted above, the rejections based on the additional teachings of Batey or Batey and Keller are also not supported by the current record. Therefore, we do not sustain any of the rejections as set forth by the examiner.

The decision of the examiner rejecting claims 1, 2 and 4-17 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	
PARSHOTAM S. LALL)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
STUART S. LEVY)	
Administrative Patent Judge)	

JS/ki

Appeal No. 1999-0497
Application 08/760,922

Schiff, Hardin & Waite
Patent Department
7100 Sears Tower
Chicago, IL 60606-6473