

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. SHIRK, JAMES PIWOWARSKI,
MARK MALINOWSKI, and PATRICK FINDLING

Appeal No. 2000-1663
Application No. 08/691,663

ON BRIEF

Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 4, 5 and 10 through 22 which are the only claims pending in the application. Claims 2, 3 and 6 through 9 have been canceled.

The appellants' invention is a method and device for controlling a vehicle assistance request system. An understanding of the invention can be derived from a reading of

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exemplary claims 1 and 11 which appear in the appendix to the brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tatematsu et al. (Tatematsu)	5,579,443	Nov. 26, 1996 (filed Mar. 3, 1995)
Tang et al. (Tang)	5,701,232	Dec. 23, 1997 (filed Aug. 29, 1996)
Simms et al. (Simms)	5,808,564	Sep. 15, 1998 (filed May 28, 1996)

The rejections

Claims 1, 4, 10 and 17 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tatematsu in view of Simms.

Claims 5, 11 through 16 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tatematsu and Simms as applied to claims 1, 4, 10 and 17 through 21 and further in view of Tang.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 16) for

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the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1, 4, 10 and 17 through 21 under 35 U.S.C. § 103. It is the examiner's view that Tatematsu discloses the invention as claimed except for the hand-held fob that includes a button for generating a request signal. The examiner relies on Simms as evidence that such a hand held fob is old and well known at the time of the invention. The examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Simms et al. into the system of Tatematsu et al. in order to provide additional hand-held remote "panic button" unit to allow a call for help from the general location around the vehicle (see the abstract) [answer at page 4].

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Appellants argue that neither Simms nor Tatematsu discloses pressing a button on the fob and generating the request signal for an amount of time that corresponds to an amount of time that the button is pressed and determining whether the amount of time is at least as long as a preselected time period. Appellants admit that Tatematsu does disclose holding a button for a predetermined time period but state that Tatematsu does not disclose that the button is on the fob.

Tatematsu teaches that it is desirable to be able within a predetermined time period (10 seconds) to cancel a request mistakenly made.

Simms discloses that it is desirable to have a hand held fob to permit a person to push a "panic button" to allow a person to request assistance in an emergency situation in which the person is not within reach of security. However, the fob of Simms is a panic button which communicates with a receiver inside the vehicle (col. 7, lines 21 to 23). Upon receipt of the communication from the fob, the receiver within the vehicle of the mobile unit dials the telephone number of the central station (col. 7, lines 53 to 55). Therefore, the Simms fob does not communicate with the central station. The Simms fob communicates only with the receiver within the vehicle. We find no suggestion

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in Simms for a fob with the capabilities of generating a request signal to a distant location remote to the vehicle location.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing a fob to communicate with a location remote from the vehicle are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is

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used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

Therefore, we will not sustain this rejection as it is directed to claim 1. We will, likewise, not sustain the rejection as it is directed to claims 4, 10 and 21 as these claims are dependent on claim 1.

In regard to claim 17, we note that the appellants have not specifically argued the patentability of this claim. We also note that claim 17 does not require that the data communication assistance request to a remote location be transmitted by the fob. Rather, claim 17 requires that the controller supported on the vehicle sends an assistance request via a transmitter supported on the vehicle based upon the receipt of a wireless signal from said remote activation button.

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We will sustain the rejection as it is directed to claim 17 because the appellant has not argued the separate patentability of this claim.¹

Claims 18 through 20 require that the controller initiate an assistance request only when the button on the fob is continuously pressed by the user for at least a preselected amount of time.

Tatematsu discloses that there is a need to correct incorrect operation of switches in the case of an emergency when a large number of buttons or switches are provided. These large number of buttons indicate that the police, an ambulance or a tow truck should be contacted. Therefore, Tatematsu requires that each button or switch be activated for a predetermined time frame before a microcomputer determines that an emergency item has been selected. However, Simms provides for a single panic button.

¹ We further note, however, that Simms teaches a transmitter supported on the vehicle and communicates with the transmitter as we discussed above. In addition, the transmitter within the vehicle communicates with a remote location based upon receipt of the wireless signal from the remote activation module. As such, in our view, Simms discloses each element of claim 17. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

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The Simms fob does not include a large number of buttons. As such, in our view, the prior art does not provide the necessary motivation for a person of ordinary skill in the art to combine the teachings of the prior art so that a timer is incorporated to determine whether Simms' panic button is actuated for a predetermined period of time. Therefore, we will not sustain the rejection of claims 18 through 20.

We turn next to the examiner's rejection of claims 5, 11 through 16 and 22 under 35 U.S.C. § 103 as being unpatentable over Tatematsu in view of Simms and Tang.

It is the examiner's view that Tatematsu in view of Simms suggests the invention as claimed except that Tatematsu and Simms do not teach or suggest a moveable cover with a first position which prevents the buttons from being pressed and a second position where the cover is clear of the buttons. The examiner relies on Tang for suggesting a slidable door.

We will not sustain this rejection as it is directed to claim 5, because claim 5 is dependent on claim 1 and Tang does not cure the deficiencies noted above for the combination of Tatematsu and Simms.

In regard to claim 11, we agree with the appellants that Tang does not teach or suggest a clear cover. Rather, the Tang

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cover is comprised of plastic and is utilized to cover up a connector that is not in use (col. 2, line 25 to 32; col. 3, lines 64 to 66). As Tatematsu likewise does not suggest a clear cover, the examiner's rationale of providing a clear cover so that the LEDs on Tatematsu can be visible is nothing more than impermissible hindsight reconstruction or the prior art.

Therefore, we will not sustain this rejection as it is directed to claim 11. We will, likewise, not sustain this rejection as it is directed to claims 12-16 and 22 as these claims are dependent on claim 11.

In summary,

The examiner's rejection under 35 U.S.C. § 103 of claims 1, 4, 5, 10 to 16 and 18 to 22 is reversed.

The examiner's rejection of claim 17 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Charles E. Frankfort)	
Administrative Patent Judge)	
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Jeffrey V. Nase)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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Murriel E. Crawford)	
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