

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY F. BIRCHFIELD and BOUNTHAVY K. MANIVONE

Appeal No. 2002-1281
Application No. 08/857,711

ON BRIEF

Before KRASS, FLEMING and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-21, 44 and 45, all of the pending claims.

The invention is directed to remotely starting a vehicle without disabling the vehicle's passive anti-theft security system. In conventional systems employing passive anti-theft security systems, remote starting was a problem because a transponder in the key inserted into the ignition switch was

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required for the anti-theft system to allow the vehicle to start. In order to overcome this problem, prior techniques required disengaging the passive anti-theft security system or removal of the transponder from the key and placement of that transponder inside or near first and second coils at the ignition switch.

Since these prior techniques incapacitated the passive anti-theft security system, thus removing the protection afforded by the security system, the instant invention is said to overcome the shortcomings of the prior art by employing a second transponder and an extra coil, wherein the second transponder is positioned about the ignition switch in order to receive the signal transmitted by the first coil. Further, the extra coil is wound around the shell of the second transponder. The extra coil is normally shorted/closed via a relay so transmitted energy from the first coil is blocked. The energy is blocked because the second transponder is placed about the ignition switch and is always in a position to receive the signal from the first coil and to transmit its authorized code to a controller via the second coil. If the second transponder is always operable, then it will always receive the signal and it will always transmit at the same time as the first transponder transmits. In this case, the vehicle would be inoperable by the passive anti-theft

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security system. Accordingly, only one of the two transponders should be in communication with the controller.

Thus, the invention provides the second transponder for selectively receiving the transmission from the controller via the first coil, and transmitting to the controller an authorized code via the second and third coils, when the system remotely starts the vehicle and the key, with its first transponder are not about the ignition switch.

Representative independent claim 1 is reproduced as follows:

1. A vehicle starting system comprising a remote starting system that is co-operable with a passive anti theft security system, wherein the security system comprises a first coil connected to a passive anti theft security system controller for transmitting a first signal to a first transponder having a third coil and a first code therein, said first transponder being responsive to said first signal to transmit said first code to said first coil, and wherein the remote starting system comprises:

(a) a second selectively operable transponder having a second code and a fourth coil with two terminal ends, said fourth coil being wound about said second transponder; and

(b) a relay that shorts said terminal ends of said fourth coil to disable said second transponder and prevent transmission of said second code to said controller when said passive anti-theft security system is in operation, and that selectively opens said terminal ends of said fourth coil to enable said second transponder and allow transmission of said second code to said controller when said remote starting system is in operation.

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The examiner relies on the following references:

Nysen	4,737,789	Apr. 12, 1988
Keller	4,847,614	Jul. 11, 1989
Cantrell	5,184,584	Feb. 9, 1993
Nose et al. (Nose)	5,648,764	Jul. 15, 1997
		(filed Jul. 31, 1992)

Additionally, the examiner relies on admitted prior art (APA), i.e., those things admitted to be known in various portions of the instant specification.

Claims 1-21, 44 and 45 stand rejected under 35 U.S.C. § 103 as unpatentable over APA, Cantrell and Nysen in view of either one of Nose or Keller.

Claims 8 and 18 stand further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we determine the propriety of the rejections based on 35 U.S.C. § 112, second paragraph, since, clearly, one cannot apply art under 35 U.S.C. § 103 if claim interpretation is confusing under 35 U.S.C. § 112, second paragraph. In re Steele, 305 F.2d 859, 134 USPQ 292, 295 (CCPA 1962).

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The inquiry under 35 U.S.C. § 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Conflict between the specification description of the invention and what is claimed as the invention gives rise to a valid rejection based upon the second paragraph of 35 U.S.C. § 112. In re Cohn, 438 F.2d 989, 169 USPQ 95 (CCPA 1971).

The examiner has rejected claims 8 and 18 because these claims require that the first and second codes are identical. It is the examiner's position that this "contradicts applicant's arguments that the claimed codes need not be the same. Therefore, the claims do not point out what applicant regards as the invention" (answer-page 3).

First, we find no contradiction between the specification description of the invention and what is claimed. In fact, the original disclosure contained claims (e.g., original claims 18

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and 19) which provided for both "identical" and "unique" codes. Therefore, the codes may or may not be the same. Second, the examiner's rejection is clearly erroneous on its face. The examiner indicates that appellants argued that the codes "need not be the same" but claims 8 and 18 require the codes to be identical. There is no contradiction here. While the codes are required by claims 8 and 18 to be identical, the statement that they "need not be the same" covers the situation where the codes are identical as well as the situation where the codes are unique, i.e., not identical. We find no indefiniteness or contradiction of any kind.

Accordingly, the rejection of claims 8 and 18 under 35 U.S.C. § 112, second paragraph, is reversed.

Turning now to the rejection of all the claims under 35 U.S.C. § 103, we note that it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 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

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references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications 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).

We have reviewed the examiner's rationale for making the rejection under 35 U.S.C. § 103 and we conclude that the examiner has failed to establish the requisite prima facie case of obviousness.

Initially, the examiner notes that APA describes a remote control vehicle starting system with many of the claimed elements, including a transponder, but the examiner recognizes that APA lacks a selectively operable second transponder for operation with a passive anti-theft system. Accordingly, the

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examiner correctly recognizes that APA teaches everything but appellants' improvement over APA.

That improvement is the use of a selectively operable second transponder having a second code and a fourth coil, wherein the fourth coil is wrapped around the second transponder. Moreover, the claims require a relay connected to normally disable the second transponder and prevent transmission of the second code to a controller when the passive anti-theft system is in operation, but to enable the second transponder, by opening terminal ends of the fourth coil, to allow transmission of the second code to the controller when the remote starting system is in operation.

In order to provide for this improvement over APA, the examiner turns to Cantrell for a teaching of using a resistor key for providing a code to a decoder module, allowing operation of a vehicle if the correct code is provided. A second resistor key, located in the vehicle, is used by Cantrell to produce a second code to the decoder module and this second resistor is selectively enabled/disabled by a relay in response to a remote control signal in order to start the vehicle remotely without activating the security system.

The examiner turns to Nysen for a transponder with a second antenna or loop placed about the transponder for extending

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transmission. Further, the examiner relies on Nose for a vehicle remote control system wherein the vehicle is programmed to switch or enable/disable different codes for controlling the vehicle. The examiner cites Keller for a teaching of each remote transmission incrementing a code in a receiver to a different code for comparison to the next code transmitted, for improving security by preventing intercepted previous transmissions. See page 4 of the answer.

Incredibly, and without any convincing reason for doing so, other than possible hindsight, the examiner finds, from these cited teachings, that it would have been

obvious...to have combined the remote controlled relay for bypassing a resistor key disclosed by Cantrell with a transponder key system of the admitted prior art wherein a second transponder rather than a second resistor is selectively enabled by the relay in order operate [sic] with the security system because the resistor and transponder are obvious substitutions for providing authorized codes and the transponder includes known advantages such as contactless communication which overcomes errors caused by incomplete contact connection" (answer-pages 4-5).

The examiner's reasoning, even if arguably acceptable, does not address the claim limitation of a "fourth coil" and its specifically claimed interconnection with the second transponder and the relay.

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Moreover, we find no reason, and the examiner has not convinced us of one, as to why the skilled artisan would have sought to combine the references in any manner so as to result in the instant claimed subject matter. It is not clear why resistors and transponders are considered to be "obvious substitutions" by the examiner. We find nothing in the cited references suggesting a modification to APA so as to result in the use of a second transponder and a fourth coil, wherein the fourth coil is wrapped around the second transponder and a relay is connected to normally disable the second transponder and prevent transmission of a second code to a controller when the passive anti-theft system is in operation, but to enable the second transponder, by opening terminal ends of the fourth coil, to allow transmission of the second code to the controller when the remote starting system is in operation.

Accordingly, we will not sustain the rejection of claims 1-21, 44 and 45 under 35 U.S.C. § 103.

CONCLUSION

We have not sustained either the rejection of claims 8 and 18 under 35 U.S.C. § 112, second paragraph, or the rejection of claims 1-21, 44 and 45 under 35 U.S.C. § 103.

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Accordingly, the examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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