

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHARLES ALLEN EVERHART

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Appeal No. 2004-1459  
Application No. 09/170,156

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ON BRIEF

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Before JERRY SMITH, RUGGIERO, and MACDONALD, 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 1-13, which constitute all the claims in the application.

The disclosed invention pertains to a mobile information system located in a vehicle for processing information which is wirelessly exchanged with a remote information server.

Representative claim 1 is reproduced as follows:

1. A mobile information system in a vehicle for processing information which is wirelessly exchanged with a remote information server, comprising:

a microphone for receiving spoken sounds;

a speech processor coupled to said microphone for recognizing said spoken sounds and identifying corresponding voice commands for processing said information;

a state controller responsive to commands including said voice commands from said speech processor, said state controller having a main menu mode and an electronic mail mode;

reconfigurable control elements coupled to said state controller and mounted on a steering wheel of said vehicle for generating control signals to select particular manual commands in accordance with a current state of said state controller;

a heads-up display coupled to said state controller and displaying at least one indicator above an instrument panel of said vehicle, said indicator identifying said manual commands available in said current state;

a voice synthesizer for generating audio output corresponding to said information; and

a wireless communication device for exchanging said information with said remote information server;

wherein said main menu mode provides selectable access to said electronic mail mode; and



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arguments set forth in the briefs along with the examiner's rationale in support of the rejection 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 1-13. 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, 837 F.2d 1071, 1074, 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

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(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 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, 1039-40, 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 appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

With respect to independent claims 1 and 9, the examiner essentially finds that Zeinstra teaches the claimed invention except for the particular claimed major functions such as an

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e-mail mode, a news mode, a calendar mode and a browser mode. The examiner cites COMDEX as suggesting a mobile information system for a vehicle which includes these major functions. The examiner finds that it would have been obvious to the artisan to incorporate Zeinstra's voice actuated control system with the advanced features of COMDEX. The examiner notes that the system of Zeinstra can be trained to recognize and activate these major functions (answer, pages 3-6).

Appellant argues that the cited references do not teach or suggest the feature of reconfigurable control elements within the context of the appealed claims. Specifically, appellant asserts that push button 20 of Zeinstra, identified as the reconfigurable control element by the examiner, has a permanent and singular function. Appellant notes that although Zeinstra can be trained to recognized additional speech, there are no reconfigurable control elements disclosed therein. With respect to the claimed states of the electronic mail mode, appellant argues that COMDEX is nothing more than a conceptual advertisement and does not teach or suggest the states as recited in claims 1 and 9 (brief, pages 9-14).

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The examiner responds that since Zeinstra's voice actuated control system can be trained to recognize and activate the major functions, then additional voice commands corresponding to the claimed states can be recognized by the system (answer, page 7).

Appellant responds that the training function in Zeinstra is limited to the learning of additional vocabulary, and that Zeinstra never contemplates the training of the overall system to incorporate new functions as claimed. Appellant also responds that COMDEX is completely devoid of mentioning states such as "initial mail," "reading note" and "next/previous note" as claimed. Finally, appellant reiterates that Zeinstra does not disclose a set of reconfigurable control elements as claimed (reply brief, pages 1-4).

We will not sustain the examiner's rejection of independent claims 1 and 9 for essentially the reasons argued by appellant in the briefs. Specifically, there are no reconfigurable control elements mounted on the steering wheel in

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Zeinstra. The push button 20 identified by the examiner has a single permanent function and is not reconfigurable. The conceptual teaching within COMDEX fails to suggest the specific three states of the mail mode as recited in claims 1 and 9. The fact that the references could be modified to implement the claimed invention does not support the rejection based on obviousness when there is no suggestion to make the modifications within the applied prior art. We agree with appellant that there are recitations within claims 1 and 9 which are neither taught nor suggested by the applied prior art.

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In summary, we have not sustained the examiner's rejection of independent claims 1 and 9. Accordingly, we also do not sustain the rejection of any of the dependent claims. Therefore, the decision of the examiner rejecting claims 1-13 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ALLEN R. MACDONALD	)	
Administrative Patent Judge	)	

JS/hh

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