

0The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DIETER FEST and MARKUS EDSPERGER

Appeal No. 2004-1598
Application No. 09/250,878¹

ON BRIEF

Before HAIRSTON, LEVY, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-3 and 5-7, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to a theft protection system for an automobile and a method for initializing the theft protection system.

¹ Application for patent filed February 16, 1999, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of German Application No. 198 05 969.8, filed February 13, 1998.

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Representative independent claim 1 is reproduced below:

1. A method for initializing a theft protection system of an automobile, which comprises:

 sending a starting signal to a central control unit, for initiating an initialization;

 transmitting a challenge signal from the central control unit over a data line;

 sending identification code signals to the central control unit from control units connected to the data line and answering the challenge signal;

 providing at least one of the control units as an electronically coded plug part containing small electronics, and pluggably and releasably connecting the coded plug part to the data line in a location in the automobile being difficult to find; and

 storing all of the identification code signals or information regarding all of the answering control units in the central control unit as belonging to the theft protection system, for requesting identification code signals from all of the control units and checking them as to authorization, during future authentication operations.

The Examiner relies on the following references in rejecting the claims:

Posner et al. (Posner)	5,254,842	Oct. 19, 1993
Bachhuber (Bachhuber '490)	5,675,490	Oct. 7, 1997
Bachhuber (Bachhuber '329)	5,796,329	Aug. 18, 1998 (filed Jul. 22, 1996)

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bachhuber '329 and Posner.

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Claims 3 and 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bachhuber '329, Posner and further in view of Bachhuber '490.

We make reference to the answer (Paper No. 19, mailed February 25, 2004) for the Examiner's reasoning, and to the appeal brief (Paper No. 18, filed December 1, 2003) and the reply brief (Paper No. 20, filed April 21, 2004) for Appellants' arguments thereagainst.

OPINION

Appellants argue that one skilled in the art would not be motivated to add the mechanically encoded, pluggable module of Posner to the anti-theft device of Bachhuber '329 since the plug connections of Posner only serve to install the parts more easily (brief, page 14). Appellants further assert that even if the two references were to be combined, the result would not have taught the claimed invention because Posner's pluggable module is not just an independent pluggable component and, without the other components connected to it, would not function properly in another anti-theft device (brief, page 15). Additionally, Appellants assert that in Posner, the code of the pluggable part will not be queried for its identification by the central unit during authentication (reply brief, page 4).

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In response to Appellants' arguments, the Examiner asserts that while Bachhuber '329 teaches an anti-theft system with multiple control units, Posner was relied on for suggesting how to physically connect a control unit more easily (answer, page 7). The Examiner reasons that since Posner provides for a pluggable memory and provides "memorized identification to the processor," similar to the memory function in Bachhuber '329, it would have been obvious to combine the references (answer, page 8).

The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Where, as here, a conclusion of obviousness is premised upon a combination of references, the examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. V. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996).

After reviewing the arguments and the applied references, we agree with Appellants that a skilled artisan would not have combined Bachhuber '329 and Posner. The closest Posner comes to the claimed invention is that it relates to an anti-theft system. The module of Posner may be easily installed in an automobile by

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plugging the related modules between the engine control module and its memory module (col. 5, lines 11-20). This arrangement, relied on by the Examiner (answer, page 9) as the reason for combining the references, merely suggests that the modules may be easily installed within the existing connection ports of the vehicle. Posner, in fact, contains no suggestion of adding the modules as an additional control unit to the anti-theft system of Bachhuber '329 which is queried for its identification by the central unit during the authentication process.

While one of the control devices of Bachhuber '329 may be capable of being pluggable as required by claim 1, there must be a suggestion or motivation in the references to do so. The Examiner provides no such suggestion, nor do we find any teaching, suggestion, or reason in the prior art to select parts of the prior art and combine them in the manner required by the claims. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."). The fact that the pluggable

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module 22 of Posner can be pluggably and releasably installed in a vehicle does not suggest that such coded module, formed in a fixed wiring, be substituted for a control unit in Bachhuber '329 and be queried for its identification by the central unit during the authentication operation, as recited in claim 1.

Based on our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions for using the module of Posner as one of the control units of Bachhuber '329, are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claim 1, as well as claim 2 dependent thereon, over Bachhuber '329 and Posner.

With respect to the rejection of claims 3 and 5-7, the Examiner further relies on Bachhuber '490 for teaching the central control unit being an antenna (answer, page 5). We also note that independent claim 3, similar to claim 1, recites the pluggable control unit. However, Bachhuber '490 does not teach an electronically coded plug as one of the control units and fails to overcome the deficiencies of the combination of the references as discussed above. Therefore, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 3 and 5-7 over Bachhuber '329, Posner and Bachhuber '490.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-3 and 5-7 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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