



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/764,552	06/18/2007	David W. Rockett	GP-303782-US-DIV	5817
60770	7590	04/11/2016	EXAMINER	
General Motors Corporation c/o REISING ETHINGTON P.C. P.O. BOX 4390 TROY, MI 48099-4390			NGUYEN, THUY-VI THI	
			ART UNIT	PAPER NUMBER
			3689	
			MAIL DATE	DELIVERY MODE
			04/11/2016	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID W. ROCKETT, FREDERICK J. BEIERMEISTER, and
GARY M. GUMUSHIAN

Appeal 2013-009676¹
Application 11/764,552²
Technology Center 3600

Before NINA L. MEDLOCK, KENNETH G. SCHOPFER, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–16. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Our decision references Appellants' Appeal Brief ("App. Br.," filed March 11, 2013) and Reply Brief ("Reply Br.," filed July 31, 2013), and the Examiner's Answer ("Ans.," mailed May 31, 2013) and Final Office Action ("Final Act.," mailed October 10, 2012).

² Appellants identify General Motors LLC as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates generally to automated enrollment and activation of mobile telematics systems. In particular, the invention relates to a computer usable medium and means for automatic enrollment in a telematics system and activation of system service" (Spec. ¶ 2).

Claims 1 and 10, reproduced below, are the only independent claims and are representative of the subject matter on appeal:

1. A method for processing a vehicle that has recently been sold or leased, comprising the steps:
 - (a) receiving customer-related data from a vehicle sales facility at one or more database(s), wherein the customer-related data is electronically sent from the vehicle sales facility and is received in response to the recent sale or lease of the vehicle to a customer;
 - (b) using the customer-related data to produce a first command signal;
 - (c) electronically sending the first command signal to a computer-based communications service manager;
 - (d) automatically enrolling the customer in a telematics unit access system in response to receipt of the first command signal by the computer-based communications services manager;
 - (e) using the customer-related data to produce a second command signal; and
 - (f) sending the second command signal to a telematics unit of a vehicle, wherein receipt of the second command signal causes the telematics unit to become activated as part of a telematics unit access system enrollment.

10. A method for processing a vehicle that has recently been sold or leased, comprising the steps:

(a) determining one or more feature(s) that are desired by the customer;

(b) electronically sending a customer delivery report to a database, wherein the customer delivery report includes the feature(s) desired by the customer;

(c) configuring a command signal to activate a telematics unit with the feature(s) desired by the customer; and

(d) electronically sending the command signal to the telematics unit, wherein receipt of the command signals causes the telematics unit to become activated as part of a telematics unit access system enrollment with the feature(s) desired by the customer.

REJECTIONS

Claims 1–16 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–16 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellants regard as the invention.

Claims 1–7 and 9 are rejected under 35 U.S.C. § 102(e) as anticipated by Hikida (US 2003/0177133 A1, pub. Sept. 18, 2003).

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hikida and Official Notice.

Claims 10–16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ikeda (US 2002/0174360 A1, pub. Nov. 21, 2002) and Hikida.

ANALYSIS

Non-Statutory Subject Matter

The Examiner finds that independent claims 1 and 10 fail the machine-or-transformation test because the claimed steps are neither tied to a particular machine nor result in a particular article being transformed from one state to another (Final Act. 2–3). And the Examiner concludes that claims 1 and 10, and claims 2–9 and 11–16, which depend therefrom, are, therefore, directed to non-statutory subject matter (*id.* at 3–4).

Before the mailing date of the Examiner’s Answer, the Supreme Court held in *Bilski v. Kappos*, 561 U.S. 593 (2010) that a patent claim’s failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. *Id.* at 604. Because the Examiner relies only on the machine-or-transformation test, the Examiner has failed to establish a prima facie case of patent ineligibility.

Therefore, we do not sustain the Examiner’s rejection of claims 1–16 under 35 U.S.C. § 101.

Indefiniteness

Independent claim 1 and dependent claims 2–9

In rejecting independent claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite, the Examiner notes that claim 1, step (e) recites “using the customer related data to produce a second command signal” while dependent claim 3 recites “using the vehicle-related data to produce the second command signal” (Final Act. 4). And the Examiner posits that “[i]t is not clear how the two different data (customer data and vehicle data) can be produc[ing] the same signal” (*id.*).

Appellants argue for the first time in their Reply Brief that “with respect to step (e) of claim 1 both ‘customer-related data’ and ‘vehicle-related data’ can be used to produce the second command signal” (Reply Br. 4). But that argument is untimely and will not be considered in the absence of any good faith showing why it could not have been timely presented in Appellants’ Appeal Brief. *In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (noting that an argument not first raised in the brief to the Board is waived on appeal); *Ex parte Atsuhisa Nakashima*, 93 USPQ2d 1834, 1840–41 (BPAI 2010) (informative) (explaining that arguments and evidence not timely presented in the principal Brief will not be considered when filed in a Reply Brief, absent a showing of good cause explaining why the argument could not have been presented in the Principal Brief); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.”).

Therefore, we summarily sustain the Examiner’s rejection under 35 U.S.C. § 112, second paragraph, of independent claim 1, and claims 2–9, which depend therefrom.

Independent claim 10 and dependent claims 11–16

We are persuaded that the Examiner erred in rejecting claims 10–16 under 35 U.S.C. § 112, second paragraph. The Examiner notes that although the preamble of claim 10 recites “a method for processing a vehicle that has recently been sold or leased,” the body of claim 10 does not relate to the method of processing the vehicle that has recently been sold or leased. The Examiner concludes that this “is confusion [sic, confusing]” (Final Act. 5).

Yet the Examiner does not identify any controlling precedent, nor otherwise explain why the preamble or body of claim 10 renders the claim indefinite under 35 U.S.C. § 112, second paragraph.

We are aware of no legal authority to support the Examiner's position. Therefore, we do not sustain the Examiner's rejection of claims 10–16 under 35 U.S.C. § 112, second paragraph.

Anticipation

Independent claim 1 and dependent claims 2–7 and 9

Appellants argue that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 102(e) because Hikida does not disclose either of steps (e) and (f), as recited in claim 1 (App. Br. 7–9). The Examiner maintains that the rejection is proper, and cites paragraphs 25, 26, 29, 30, and 48 of Hikida as disclosing the argued limitations (Final Act. 7–8).

Hikida is directed to a method and device for managing vehicle related services in which information regarding vehicles and customers is stored in a management database at a management center after the vehicle is sold (Hikida, Abstract). Hikida discloses that when a customer purchases a vehicle, the sales company sends customer information to the management center; the management center also receives vehicle information from the vehicle manufacturer (*id.* ¶¶ 19, 20). The management center stores this information in a management database, and sends required portions of the management database to the customer, the sales company, and any service entities with which the customer has contracted to receive vehicle related services (*id.* ¶ 21; *see also id.* ¶ 48 (describing that when a customer purchases a vehicle, he or she can enter into various types of service contracts)). The management center also sends a certification ID, e.g.,

membership certificate, contract, ID, password, etc., to the customer to certify that a contract was formed, and may also send information regarding new services (*id.* ¶ 25). Hikida discloses that examples of paid services include roadside assistance service, emergency notification service, navigation operation agent service, and Auto DJ. (*id.* ¶ 26). Describing the navigation operation agent service, Hikida discloses that the service is one that will guide the driver to a destination, and further discloses that because it can be troublesome for a driver to operate the navigation system while driving, the driver can connect to the service via a mobile telephone, and the service will perform the navigation operations and display the results on the vehicle navigation system (*id.* ¶ 29).

The Examiner interprets a customer's purchase in Hikida of the navigation operation agent service, for example, as enrolling for telematics service (Ans. 23). And the Examiner interprets the control of the navigation system by the service center, as disclosed in paragraph 29 of Hikida, as causing a telematics unit to become activated as part of a telematics unit access system enrollment:

This [i.e., the example of navigation agent service in Hikida, paragraph 29] would be interpreted to be using customer related data (e.g., customer phone number) to produce a second command signal, and sending the second command signal to a telematics unit of a vehicle (service center), [“]wherein receipt of the second command signal causes the telematics unit to become activated as part of a telematics unit access system enrollment[,]” as recited in claim 1.

Id. at 23–24.

During examination, claims are to be given their broadest reasonable interpretation. *See In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). But that interpretation must be consistent with the specification, and claim

language should be read in light of the specification as it would be interpreted by a person of ordinary skill in the art. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Here, we agree with Appellants that “caus[ing] the telematics unit to become activated as part of a telematics unit access system enrollment,” as called for in claim 1, cannot reasonably be equated, in light of Appellants’ Specification (including the claim language), to controlling a navigation service as part of its normal functionality, as the Examiner suggests (App. Br. 8).

We also cannot agree with the Examiner that the clause “wherein receipt of the second command signal causes the telematics unit to become activated as part of a telematics unit access system enrollment,” as recited in claim 1, is “merely a desire[d] result of when the second signal is received without indicating an actual ‘activating’ step” and, therefore, not entitled to patentable weight (Final Act. 8). The Examiner asserts that “there is no positively recited action of ‘activating the telematics unit’” (*id.*). Yet rather than being a “desired result,” the activation of the telematics unit is an action directly resulting from receipt of the second command signal, i.e., claim 1 recites that receipt of the second telematics unit *causes* the telematics unit to become activated as part of a telematics unit access system enrollment. As such, the wherein clause is entitled to patentable weight, and cannot properly be ignored.

In view of the foregoing, we do not sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 102(e). For the same reasons, we also do not sustain the Examiner’s rejection of dependent claims 2–7 and 9.

Obviousness

Dependent claim 8

Claim 8 depends from claim 3, which depends, in turn, from independent claim 1. The Examiner's rejection of claim 8 under 35 U.S.C. § 103(a) is based on the same erroneous finding described above with respect to claim 1. Therefore, we do not sustain the Examiner's rejection of claim 8 under 35 U.S.C. § 103(a) for substantially the same reasons set forth above with respect to claim 1.

Independent claim 10 and dependent claims 11–16

Appellants argue that the Examiner erred in rejecting independent claim 10 under 35 U.S.C. § 103(a) because Ikeda, on which the Examiner relies, fails to disclose or suggest, *inter alia*, step (d), as recited in claim 10 (App. Br. 10–12). The Examiner maintains that the rejection is proper, and cites paragraphs 209–212 and 219–221 and Figures 8 (steps 505–603) and 9 (steps 804–902) of Ikeda as disclosing the argued limitation (Final Act. 12).

Ikeda is directed to a service providing system that can be utilized by the owner of a vehicle, equipped with a navigation system, to access additional services, e.g., security-related control over his or her vehicle (*see, e.g.,* Ikeda ¶¶ 60, 165). Ikeda discloses a procedure, in paragraphs 209 through 221, with reference to Figures 8 and 9, by which an individual uses his or her mobile phone to inquire whether his or her vehicle is locked; in response to the inquiry, the system sends a command to the navigation system to inquire into the status of the vehicle locks; if the vehicle is not locked, the user can perform a remote control operation using the mobile phone to have the vehicle locked (*see also id.* ¶¶ 165–168).

The Examiner takes the position that sending the command signal to the navigation system (which the Examiner characterizes as the telematics unit) causes the navigation system to perform the security check and locking of the vehicle, i.e., it cause the telematics unit to be activated with the feature desired by the customer (Final Act. 12). And the Examiner concludes that Ikeda meets the language of claim 10, step (d) because the wherein clause is not entitled to patentable weight:

as for statement “wherein . . . as part of a telematics unit access system enrollment with the feature(s) desired by the customer”, this is merely a desire[d] result of when the second signal is received without indicating an “activating” step. In the [sic] other words, there is no positively recited action of “activating the telematics unit” as Applicant argued and the “wherein . . . enrollment” step does not impact the manipulative step/action of the "sending the second command signal to a telematics unit of a vehicle”, and thus is given little patentable weight.

Id. at 13.

We are persuaded for the reasons set forth above that the Examiner erred in refusing to give patentable weight to the wherein clause, as recited in claim 10, step (d). Therefore, we do not sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of independent claim 10, and claims 11–16, which depend therefrom.

DECISION

The Examiner’s rejection of claims 1–16 under 35 U.S.C. § 101 is reversed.

The Examiner’s rejection of claims 1–9 under 35 U.S.C. § 112, second paragraph, is affirmed.

Appeal 2013-009676
Application 11/764,552

The Examiner's rejection of claims 10–16 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's rejection of claims 1–7 and 9 under 35 U.S.C. § 102(e) is reversed.

The Examiner's rejections of claims 8 and 10–16 under 35 U.S.C. § 103(a) are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART