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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GARY HERBERT HEINE, DAVID TSAI,  
BRUCE ANDREW MUTTER, and THOMAS FALLOW TRISDALE<sup>1</sup>

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Appeal 2014-006121  
Application 12/562,859  
Technology Center 3600

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Before STEFAN STAICOVICI, LEE L. STEPINA, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gary Herbert Heine et al. (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s February 13, 2013 non-final rejection of claims 1–32 (“Non-Final Act.”). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> According to Appellants, the Real Party in Interest is Toyota Motor Sales, U.S.A., Inc. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

The claimed invention concerns a system for diagnosing vehicle problems. Spec., Abstract. Claim 1 is illustrative of the subject matter on appeal, and recites:

1. A system comprising:  
a client device comprising:  
a connector to *selectively connect* to a vehicle,  
a vehicle interface to send and receive information  
from the vehicle,  
a communication system,  
an input/output system, and  
a processor; and  
a central device communicatively connected to the client device,  
wherein after the client device is selectively connected to the vehicle, the client device detects the connection to the vehicle, receives the vehicle's VIN from the vehicle based on detecting the connection, and transmits the vehicle's VIN and geographic information to the central device,  
wherein *the client device passively captures diagnostic information from the vehicle in response to receiving instructions from the central device* and transmits the diagnostic information to the central device, and  
wherein the central device transmits further instructions to the client device in response to the received diagnostic information.

Appeal Br. 13 (Claims App.) (emphases added). Independent claims 12 and 21 contain similar language to that emphasized in claim 1. *Id.* at 14–16 (Claims App.).

## REJECTIONS

The claims stand rejected as follows:

- I. Claims 1–32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- II. Claims 1–32 under 35 U.S.C. § 102(e) as anticipated by Chen (US 2009/0276115 A1, pub. Nov. 5, 2009).

## ANALYSIS

### *Rejection I*

The Examiner finds that Appellants have not explained or shown support in the original disclosure for the claim language “selectively connected,” appearing in claims 1–32.<sup>2</sup> Non-Final Act. 2; *see also* Ans. 3–6.

Appellants contend that this language “corresponds to the capability of the client device to be connected and disconnected from the service vehicle” and is supported by Figures 1–3 and paragraphs 20, 26, and 27 of the Specification.<sup>3</sup> Appeal Br. 6–8.

We agree with Appellants that paragraphs 20, 26, and 27 of the Specification reasonably convey to a person of ordinary skill in the art that Appellants had possession of the subject matter of claims 1–32 at the time the application was filed. Specifically, these paragraphs disclose that the client device may be connected and disconnected from the vehicle at will, consistent with the plain and ordinary meaning of “selectively connected.”

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<sup>2</sup> Claims 1 and 21 recite “selectively connect,” and claim 12 recites “selective connection.” Appeal Br. 13, 14, 16.

<sup>3</sup> Although the Appeal Brief cites paragraph 25, this appears to be a typographical error. *Compare* Appeal Br. 7, with Spec. ¶¶ 25–26.

*See, e.g.*, Spec. ¶ 20 (disclosing that the client device “is connectable”), ¶ 26 (disclosing exemplary connectors, as well as a sensor for detecting whether the client device is connected), ¶ 27 (disclosing that a technician “may connect” the client device at a repair shop). This disclosure satisfies the requirements of 35 U.S.C. § 112, first paragraph. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (“[T]he test for [compliance with Section 112, first paragraph] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”). Although the Examiner appears to require *in haec verba* support for the exact claim terminology, this is not necessary. *See* Ans. 3–6; *see also Ariad*, 598 F.3d at 1352 (“[T]he description requirement does not demand any particular form of disclosure or that the specification recite the claimed invention *in haec verba*.”).

Therefore, we reverse the Examiner’s rejection of claims 1–32 under 35 U.S.C. § 112, first paragraph.

#### *Rejection II*

The Examiner finds that Chen discloses each element of independent claim 1, including a client device (all elements on the “vehicle side” of Chen’s Figure 6, e.g., 12, 30, 20, 10, 90, 92, 80) and a central device (computer terminal 104, Central Automotive Diagnostic and Services Center 100, 103).<sup>4</sup> *Ans.* 6–7; *see also* Non-Final Act. 3–4. With respect to the

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<sup>4</sup> The Examiner identifies element 103 as part of the central device, but Chen does not utilize reference number 103. *Ans.* 7; *see generally* Chen. It

claim limitation “the client device passively captures diagnostic information from the vehicle in response to receiving instructions from the central device,” the Examiner finds that Chen’s client device cannot capture diagnostic data without an appropriate permission. Ans. 9. The Examiner finds that the client device either has the necessary license or “obtain[s] the licensed computer instructions i.e. diagnostic protocol[,] from the central device[,] e.g. [,] dealer, repair shop, or remote service provider.” *Id.* The Examiner finds that once these permissions are “purchased from the central device and installed in the client device,” the client device is able to passively capture diagnostic data. *Id.* “As such the diagnostic data is captured by the client device *in response* to obtaining permission and computer instructions from the central device.” *Id.*; *see also id.* at 10–12.

Appellants contend that Chen’s client device does not capture diagnostic information *in response* to instructions from the central device, but rather captures diagnostic information independently. Appeal Br. 10. (citing Chen ¶¶ 72–74, Fig. 5). Appellant also contends that “the diagnostic protocol is not transmitted from Chen’s service center. Instead, the diagnostic protocols are pre-stored in the diagnostic device 10.” Reply Br. 5 (citing Chen ¶ 72, Fig. 3).

We agree with Appellants that Chen’s client device does not capture diagnostic information *in response* to instructions from the central device, as required by claim 1. Chen discloses a vehicle diagnostic system in which handheld automotive diagnostic tool 10 retrieves a vehicle’s VIN (vehicle

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appears the Examiner relies upon either operator or human interface 102 or automotive diagnostic database 106. *See* Chen ¶ 82, Fig. 6.

identification number) in order to determine the communication protocol for the onboard computer located in the vehicle. Chen ¶¶ 32, 43, 53.

Specifically, diagnostic tool 10 includes VIN protocol sequencer 60 and diagnostic protocol database 62, such that “vehicle specific data obtained from the VIN [] is correlated to a diagnostic protocol, [such that] higher level diagnostic information may be obtained from the vehicle.” *Id.* ¶ 53.

Chen discloses that “VIN protocol sequencer 60 may determine if the user has obtained a license, or other permission from the vehicle manufacturers to use a particular diagnostic protocol.” *Id.* ¶ 54. If a license has been obtained, the needed diagnostic protocol will likely be located in the database of the diagnostic tool. *Id.* However, if “the particular protocol needed is not located on the database, the diagnostic tool may provide the user with various options.” *Id.* For example, “[a] pop-up window on the tool’s display may provide the user the option of purchasing/licensing the protocol when needed” or the user may be directed “to a repair facility which has licensed the protocol.” *Id.* ¶¶ 55, 63; *see also id.* ¶ 73.

Alternatively, the tool may communicate with a remote database, such as a vehicle manufacturer’s website, to download the required protocol. *Id.* ¶ 55.

The diagnostic protocol is then used to retrieve diagnostic data from the vehicle, which is transmitted to a user’s cell phone and subsequently transmitted to a remote database for diagnostic analysis. *Id.* ¶¶ 32, 57–58.

The Examiner’s finding that Chen’s diagnostic tool 10 “obtain[s] the licensed computer instructions i.e. diagnostic protocol[,] from the central device[,] e.g.[,] dealer, repair shop, or remote service provider” is unsupported by evidence. Ans. 9. Specifically, Chen discloses that the

diagnostic protocols are either located in database 62 of the diagnostic tool (Chen ¶ 54), or are obtained by other means including through a pop-up window on the tool (*id.* ¶ 55), through communication with a remote database such as a vehicle manufacturer’s website (*id.*), or through direction to a licensed repair facility (*id.* ¶ 63). Chen does not support the Examiner’s finding that the diagnostic protocol is obtained *from the central device*, which the Examiner identifies as Central Automotive Diagnostic and Services Center 100, which has computer terminal 104, operator or human interface 102, and automotive diagnostic database 106. Ans. 7, 9.

To the extent the Examiner construes “central device” to include a “dealer, repair shop, or remote service provider,” this interpretation is improper. *Id.* at 9 (finding that the client device obtains a diagnostic protocol “from the central device[,] e.g.[,] dealer, repair shop, or remote service provider”). First, this interpretation is inconsistent with the Examiner’s identification of Central Automotive Diagnostic and Services Center 100 (and its constituent elements) as the “central device.” *Id.* at 7. Second, this is an unreasonably broad interpretation of “central device,” which the Specification describes as, for example, an information processing system. Spec. ¶ 21; *see also Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (“A construction that is unreasonably broad and which does not reasonably reflect the plain language and disclosure will not pass muster.”). The Examiner provides no persuasive basis from which to conclude the claimed central device includes a “dealer, repair shop, or remote service provider.” Ans. 9.

Therefore, a preponderance of evidence does not support the Examiner's findings that Chen's client device obtains diagnostic protocols from the central device and that diagnostic data is captured "*in response* to obtaining permission and computer instructions from the central device." *Id.* at 9. Accordingly, we reverse the Examiner's 35 U.S.C. § 102(e) rejection of claim 1, and claims 2–11 and 30, which depend therefrom.

Independent claims 12 and 21 also include limitations requiring the client device passively capture diagnostic information "*in response to*" instructions received from the central device. Appeal Br. 14–16 (Claims App.). The foregoing discussion of claim 1 applies equally to claims 12 and 21. Accordingly, we reverse the Examiner's 35 U.S.C. § 102(e) rejection of claims 12 and 21, and claims 13–20, 22–29, 31, and 32, which depend therefrom.

#### DECISION

The rejection of claims 1–32 under 35 U.S.C. § 112, first paragraph is REVERSED; and

the rejection of claims 1–32 under 35 U.S.C. § 102(e) is REVERSED.

REVERSED