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CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			GILKEY, CARRIE STRODER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRISTIAN SUESS and ASTRID SCHROEDER

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Appeal 2015-001146<sup>1</sup>  
Application 11/924,071<sup>2</sup>  
Technology Center 3600

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Before ANTON W. FETTING, JAMES A. WORTH, and  
BRADLEY B. BAYAT, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 1–5, 9–15, and 18–23. We have jurisdiction under 35 U.S.C. §§ 134 and 6(b).

We REVERSE.

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<sup>1</sup> Our decision refers to the Appellants' Appeal Brief ("Appeal Br.," filed May 23, 2014) and Reply Brief ("Reply Br.," filed Oct. 28, 2014), and the Examiner's Final Office Action ("Final Act.," mailed Feb. 24, 2014) and Answer ("Ans.," mailed Sept. 9, 2014).

<sup>2</sup> According to Appellants, the real party in interest is Bayerische Motoren Werke Aktiengesellschaft (Appeal Br. 1).

*Introduction*

Appellants' application relates to "a configuration system for a vehicle having at least a functional unit, a control unit pertaining to the functional unit, and a parametrizing unit which is provided in the vehicle and is operatively connected with the control unit" (Spec. ¶ 2).

Claims 1, 10, and 23 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A configuration system of a vehicle, comprising:
  - a plurality of functional units which are each operable in a plurality of different configurations;
  - a plurality of control units, each configured as one or more processors, to control corresponding ones of the plurality of functional units according to any one of their respective plurality of different configurations;
  - a parametrizing unit, configured as one or more processors, arranged in the vehicle and operatively coupled with the plurality of control units;
  - wherein each of the plurality of control units further comprises a storage device arranged therein which is readable by the parametrizing unit and contains configuration information for a corresponding one of the plurality of control units in which said storage device is arranged, the configuration information comprising sets of parameters which correspond to parametrizing and/or initializing possibilities of the corresponding control unit in which said storage device is arranged;
  - wherein the parametrizing unit is further configured to utilize vehicle context information and evaluation rules, the evaluation rules being utilized by the parametrizing unit to determine configuration data for configuring the corresponding control unit from the vehicle context information and the configuration information for the control unit, whereby the parametrizing unit configures the plurality of control units, in accordance with the configuration data, to

operate the corresponding plurality of functional units in a particular one of the plurality of different configurations in which each of the respective functional units is capable of operating.

(Appeal Br., Claims App.)

*Rejections on Appeal*

The Examiner maintains, and Appellants appeal, the following rejections:

- I. Claims 10–15, 18–20, and 22 stand rejected under 35 U.S.C. § 101 as claiming an invention directed to non-statutory subject matter.<sup>3</sup>
- II. Claims 1–3, 5, 9–15 and 18–23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dabbish (US 2004/0002799 A1, Jan. 1, 2004).
- III. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dabbish and Official Notice.

ANALYSIS

Rejection I (Patentable Subject Matter)

*Claims 10–15, 18–20, and 22*

The Examiner reasons, *inter alia*, that:

the claims are directed towards configuring control units which is considered to be an abstract idea inasmuch as configuring control units are activities that are considered both fundamental economic or business practices. . . . The fact that the parametrizing unit is configured as one or more processors, as

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<sup>3</sup> This rejection was set forth in the Answer as a new ground pursuant to the procedures for new grounds

stated by the preamble, does not indicate that the claims are anything more than an abstract idea. . . . This does not involve anything more than a generic processor in the form of a generic computing device.

Ans. 3.

Appellants argue, inter alia, that:

the claims do not recite any of the particularly-identified examples of abstract ideas set forth in the Preliminary Examination Instructions, but rather recites a number of detailed operations performed by a “parametrizing unit” of a motor vehicle, which is expressly “configured as one or more processors.”

Reply Br. 4.

We are persuaded by Appellants’ argument inasmuch as we agree that the Examiner has not articulated an abstract idea. In any event, we disagree with the Examiner that configuring control units are a fundamental economic practice or business practice, and conclude that the Examiner has not sufficiently explained why “configuring” is necessarily an abstract idea. Nor does the use of a general purposes computer necessarily indicate that there is an abstract idea under *Alice Corp., Pty. Ltd. v CLS Bank Intl*, 134 S.Ct. 2347, 2355 (2014). As such, we do not sustain the Examiner’s rejection under § 101 of claims 10–15, 18–20, and 22.

#### Rejection II (Anticipation)

##### *Independent claim 1*

We are persuaded by Appellants’ argument that Dabbish fails to disclose “the parametrizing unit configures the plurality of control units, in accordance with the configuration data, to operate the corresponding plurality of functional units in a particular one of the plurality of different

configurations in which each of the respective functional units is capable of operating,” as recited in independent claim 1 (Appeal Br. 7–12). Appellants argue that Dabbish fails to teach or suggest the recited “parametrizing unit” because the claims require a parametrizing unit that configures a control unit to operate (Appeal Br. 11–12). Appellants assert that neither authenticating a component, authorizing a component, nor maintaining a configuration history for a component would be understood by one of ordinary skill in the art as affirmatively configuring a control unit (Appeal Br. 12).

The Examiner relies on the disclosure in Dabbish (¶¶ 37–38, 48–58) in which a component may be installed based on the presence of another unit (Final Act. 3–4; Ans. 6–7). However, we agree with Appellants inasmuch as this portion of Dabbish fails to disclose “a plurality of different configurations” of a functional unit for operation. To the extent this portion of Dabbish is disclosing configurations of a functional unit, the configurations are on/off or installed/uninstalled. However, the configuration of being installed or uninstalled is not a configuration of “operating,” as recited by independent claim 1. As such, this portion of Dabbish does not disclose a “plurality” of configurations of “operating,” as recited.

Accordingly, we do not sustain the Examiner’s rejection under § 102 of independent claim 1 and its dependent claims. For similar reasons, we do not sustain the Examiner’s rejection under § 102 of independent claims 10 and 23 and their dependent claims.

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Rejection III (Obviousness)

*Dependent claim 4*

Claim 4 depends from claim 1, and stands rejected under § 103 as unpatentable over Dabbish and the Official Notice that generic formats may be used to store data (Final Act. 17–18). Because the Official Notice does not remedy the aforementioned deficiency in the Examiner’s rejection of independent claim 1 under § 102 over Dabbish, we do not sustain the Examiner’s rejection of claim 4 under § 103, for similar reasons.

DECISION

The Examiner’s decision to reject claims 1–5, 9–15, and 18–23 is reversed.

REVERSED