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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK SCHNEIDER, JENNIFER L. BRACE,
PAUL ALDIGHIERI, MICHAEL RAYMOND WESTRA,
SUKHWINDER WADHWA, and ARTHUR VAN JACK JR.

Appeal 2015-006546
Application 12/854,010¹
Technology Center 2400

Before ST. JOHN COURTENAY III, CARL L. SILVERMAN, and
KAMRAN JIVANI, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–18. Final Act. 1. We have jurisdiction under
35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Ford Global Technologies, LLC. App. Br. 2.

STATEMENT OF THE CASE

The disclosed and claimed invention relates to a vehicle computer system for establishing in-vehicle wireless connectivity to a remote computer network. Abstract.

Claims 1 and 8, reproduced below, are exemplary of the subject matter on appeal (emphasis added):

1. A system comprising:
a vehicle-based processor configured to:
wirelessly connect to a first portable device having internet connectivity provided thereto;
wirelessly connect to one or more second personal computing devices in the vicinity of a vehicle; and
provide a wireless Internet access point to the one or more second personal computing devices based on the wireless connection with the first portable device and Internet connectivity provided thereto.

Claims App'x 1 (App. Br.).

8. A method for in-vehicle wireless connectivity comprising:
receiving input defining two or more modes for wireless connectivity of a vehicle computer, the two or more modes comprising a client mode for connecting to a connection point outside of a vehicle and an in-vehicle access point mode for generating an in-vehicle connection point;
if the vehicle computer is in client mode,
searching for a connection to one or more connection points outside of the vehicle; and establishing the connection when the connection is found; and
if the vehicle computer is in in-vehicle access point mode, wirelessly tethering a portable device configured to establish an Internet connection to the vehicle computer; and
providing a wireless Internet access point for one or more personal computing devices based on the wireless tethering and the Internet connection.

Id. at 2.

THE REJECTIONS

Claims 1 and 5–7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc et al. (US 2004/0179512 A1; Sept. 16, 2004) (“Leblanc”) and Saito et al. (US 2002/0044049 A1; Apr. 18, 2002) (“Saito”). Final Act. 3–7.

Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Saito, and Souissi et al. (US 7,944,901 B2; May 17, 2011) (“Souissi”). *Id.* at 7–9.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Saito, Nakagawa et al. (US 2002/0128882 A1; Sept. 12, 2002) (“Nakagawa”), and Gustafsson et al. (US 2004/0218605 A1; Nov. 4, 2004) (“Gustafsson”). *Id.* at 9–11.

Claims 8, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren et al. (US 2009/0267774 A1; Oct 29, 2009) (“Enegren”), and Balogh (US 2001/0023446 A1; Sept. 20, 2001). *Id.* at 11–14.

Claims 9, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren, Balogh, and Souissi. *Id.* at 15–17.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren, Balogh, and Zuniga (US 2005/0122929 A1; June 9, 2005). *Id.* at 17–18.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren, and The Cable Guy (THE CABLE GUY -

NOVEMBER 2002, <https://technet.microsoft.com/en-us/library/bb878124>) (“The Cable Guy”). *Id.* at 18–19.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren, Balogh, The Cable Guy, and Gustafsson. *Id.* at 19–20.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc, Enegren, Balogh, and Wilhoite et al. (US 2006/0116127 A1; June 1, 2006) (“Wilhoite”). *Id.* at 20–21.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leblanc and Eisenbach (US 2006/0199536 A1; Sept. 7, 2006). *Id.* at 21–23.

ANALYSIS

Claims 1 and 5–7

Appellants argue Leblanc and Saito do not teach the claim 1 limitations “wirelessly connect to a first portable device having internet connectivity provided thereto,” and “provide a wireless Internet access point to the one or more second personal computing devices based on the wireless connection with the first portable device and Internet connectivity provided thereto.” App. Br. 6–9; Reply Br. 2–4.

According to Appellants, “[t]he Examiner cites the *installed* WAN interface of Leblanc . . . as the ‘first device having internet connectivity’” and “the Examiner admits, this WAN device providing connectivity is *integrated* into the vehicle.” App. Br. 6 (citing Leblanc ¶ 29). Appellants argue the Examiner errs in concluding:

It would have been obvious to one of ordinary skill in the art to modify Leblanc to include the teaching of wherein the mobile hotspot is made separable wherein the 802.11 access point 12, DHCP 14, LAN Router 16 and memory and processor are integrated into the mobile vehicle and the mobile WAN interface 42 is made portable shown in Fig[ure] 2 with the motivation to make integral/sep[a]rable under MPEP [§] 2144.04.

Id.

According to Appellants, the Examiner provides no support the proposed configuration is possible, and, Appellants' argue the proposed configuration is not a "mere reconfiguration of parts" and, instead, requires additional software and hardware. *Id.* According to Appellants: "From an engineering standpoint, the requirements of the claimed system and the Leblanc system far exceed a mere re-arrangement of parts. Significant engineering changes would be required to 'break out' a piece of the Leblanc system and utilize it as a stand-alone mobile device." *Id.* at 7. According to Appellants, Saito's wirelessly connecting a first phone does not cure this deficiency. *Id.*

Appellants argue:

the Examiner takes the automaton vs. creative human argument too far. Applicant doesn't submit that a skilled artisan is an automaton, but, rather, when presented with the fully functioning system of Leblanc, a creative, skilled artisan would not seek to break apart the fully functioning system, wherein the mobile WAN modem is included in the vehicle, and create a whole headache of re-engineering the system, when a perfectly functional system already exists. Further, Examiner's proposed revision of Leblanc would require adding, for example, gateway capabilities to the system of Leblanc.

Id. at 7–8.

Appellants argue the cited MPEP section refers to a change in physical structure, e.g. a lipstick cap being made removable, and generally results in the same system. App. Br 6–7. According to Appellants, this simplistic mechanical engineering is very different from the more complicated invention in which the Examiner’s suggested modification results in an entirely different system. *Id.*

The Examiner finds:

a person having ordinary skill in the art (PHOSITA) could make the WAN interface (42) a separate device that is capable of being plugged into the rest of the mobile hotspot using a wire with the reason being that making this portion separable allows the end-user the ability to take internet with them and allows the end user the ability to use the same data plan for one device (saving money (as opposed to registering a car, a mobile, phone, a tablet, etc. (each device generally has additional access fees charged))) which can be moved around to other locations or even possibly other cars. The alternative is having the WAN interface integrated into the car which means that the cellular internet can only be used on this device when in the one particular car. That is, if a person has more than one car, he or she would have to have more than one cellular plan for each car.

Ans. 3.

The Examiner applies the guidance of MPEP section § 2144.04 to the teachings *and* suggestions of Saito and finds Saito teaches a wired connection can be made wireless. *Id.* 3–4 (Saito, Fig. 1); The Examiner also finds the installed WAN interface (42) of Leblanc can be substituted with an equivalent portable cellular phone of Saito, for example, in that both

provide cellular internet connectivity. *Id.* at 4.² The Examiner also finds one of ordinary skill in the art of communication systems using ordinary creativity would know how to separate the devices. *Id.* at 4. The Examiner finds:

separating the WAN interface (42) of Leblanc is desirable because making this portion separable allows the end-user the ability to take internet with them and allows the end user the ability to use the same data plan for one device (saving money (as opposed to registering a car, a mobile, phone, a tablet, etc. (each device generally has additional access fees charged))) which can be moved around to other locations or even possibly other cars. (The alternative is having the WAN interface integrated into the car which means that the cellular internet can only be used on this device when in the one particular car. That is, if a person has more than one car, he or she would have to have more than one cellular plan for each car.) Just because *In re[]Dulberg*^[3] references a mechanical device does not mean that it does not apply to electrical devices.

Id. at 5.

Appellants argue Figure 3 of Leblanc teaches when the MHS is acting as a client device, the device is also no longer in access point mode. App. Br. 8 (citing Leblanc ¶ 31). The Examiner states, and we agree, “[i]t is unclear what Applicant is attempting to argue because [Figure] 2 of Leblanc

² See MPEP § 2144.04(V)(A) (“Making Portable [citing] *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.”).

³ *In re Dulberg*, 289 F.2d. 522, 523 (CCPA 1961) is cited in MPEP § 2144.04(V)(C). The court held “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.” Ans. 5.

shows this” Ans. 6. In response to the Answer, Appellants argue the “teachings of Leblanc in the un-used portions cannot simply be ignored” because Leblanc Figure 3 has a solution for a mobile hotspot acting in client mode which would be used by a skilled artisan. Reply Br. 2–4.

We are not persuaded by Appellants’ arguments and, instead, agree with the Examiner’s findings above that the combination of Leblanc and Saito teaches all the contested limitations of claim 1. Regarding Figure 3, we are not persuaded by Appellants’ argument because Appellants assert an unreasonably narrow teaching of Leblanc as would be understood by one of ordinary skill in the art.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

As stated by the Supreme Court, the Examiner’s obviousness rejection must be based on:

[S]ome articulated reasoning with some rational underpinning to support the legal conclusion of obviousness [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l. Co. v. Teleflex, Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Here, the Examiner’s legal conclusion regarding obviousness is supported by articulated reasoning based on reasonable findings of fact and

Appellants present no persuasive argument to the contrary. Appellants' argument regarding the difficulties of making Leblanc's WAN portable is conclusory. Mere lawyer's arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

The Examiner's findings are reasonable because the skilled artisan would "be able to fit the teachings of multiple patents together like pieces of a puzzle" since the skilled artisan is "a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 420–21.

On this record, Appellants do not present sufficient evidence that the combination of the cited references was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19). Nor have Appellants provided objective evidence of secondary considerations, which our reviewing court guides "operates as a beneficial check on hindsight." *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys., Inc.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

In view of the above, we sustain the first-stated rejection of representative independent claim 1, and the first-stated rejection of grouped dependent claims 5–7 as these claims are not separately argued. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claims 2–4

To the extent Appellants urge that the additional cited secondary references “do not cure the noted deficiencies of LeBlanc/Saito with respect to claim 1” (App. Br. 9), we find no deficiencies with the Examiner’s proffered combination of LeBlanc and Saito for the reasons discussed above regarding claim 1. Therefore, we sustain the second-stated rejection of claims 2 and 4, and the third-stated rejection of claim 3.

Claims 8, 15, and 16

Regarding independent claim 8, Appellants argue Leblanc does not teach the limitations:

if the vehicle computer is in in-vehicle access point mode,
wirelessly tethering a portable device configured to establish an Internet connection to the vehicle computer; and
providing a wireless Internet access point for one or more personal computing devices based on the wireless tethering and the Internet connection.

App. Br. 9–10.

According to Appellants, Leblanc, in the presence of an extra-vehicular access point, expressly switches into client mode, making the limitation *providing a wireless . . . based on the wireless tethering* impossible. *Id.* at 10.

The Examiner finds Leblanc and Energen teach the limitation *providing a wireless . . . based on the wireless tethering*. Final Act. 11–13 (citing Leblanc, Fig. 2; Enegren ¶ 44). The Examiner additionally finds this limitation “is an obvious expedient to one of ordinary skill possessing

ordinary creativity of the embodiments provided within Leblanc including but not limited to [Figures] 2, and 3.” Ans. 8.

We are not persuaded by Appellants’ arguments and, instead, agree with the Examiner’s findings above.

In addition, we note claim 8 recites conditional method steps (emphasis added):

*if the vehicle computer is in client mode . . . and
if the vehicle computer is in in-vehicle access point mode . . .*

As reasonably broadly interpreted, therefore, these steps need not occur. For example, the vehicle computer may only be in client mode or only be in access point mode. Or, the vehicle computer may not be in either mode. While we agree the Examiner’s findings above that the cited references teach these method steps, we note such teaching is not required for conditional method steps. *See Ex parte Schulhauser*, Appeal No. 2013-007847, at *9 (PTAB, April 28, 2016) (precedential) (holding “[t]he Examiner did not need to present evidence of the obviousness of the remaining method steps of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim (e.g., instances in which the electrocardiac signal data is not within the threshold electrocardiac criteria such that the condition precedent for the determining step and the remaining steps of claim 1 has not been met.”); *see also Ex parte Katz*, Appeal No. 2010-006083, 2011 WL 514314, at *4–5 (BPAI Jan. 27, 2011).⁴

⁴ *See, e.g., Applera Corp. v. Illumina, Inc.*, 375 Fed. App’x 12, 21 (Fed. Cir. 2010) (unpublished) (affirming a district court’s interpretation of a method claim as including a step that need not be practiced if the condition for

In view of the above, we sustain the fourth-stated rejection of representative independent claim 8, and the fourth-stated rejection of grouped dependent claims 15 and 16, which fall with claim 8. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Remaining Dependent Claims 9–14 and 17

To the extent Appellants have not advanced separate, substantive arguments regarding the rejections of the remaining dependent claims on appeal, such arguments are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). (*See* App. Br. 10–11).

Independent Claim 18

For essentially the same reasons discussed above regarding claims 1 and 8, we sustain the last-stated rejection of independent claim 18, wherein Appellants restate arguments we have fully addressed, *supra* (App. Br. 12).

DECISION

We affirm the Examiner’s decision rejecting claims 1–18 under 35 U.S.C. § 103(a).

practicing the step is not met); *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 Fed. App’x 603, 607 (Fed. Cir. 2007) (unpublished) (“It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.”).

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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