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.
90/012,614	09/14/2012	7,974,750 B2	87355.9667	1052

30734 7590 11/02/2016
BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER
CORSARO, NICK

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
11/02/2016	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 ROBERT BOSCH TOOL CORPORATION and
ROBERT BOSCH GmbH,

Appeal 2016-006687
Application 90/012,614
Technology Center 3900

Before MARC S. HOFF, STEPHEN C. SIU, and
JENNIFER L. McKEOWN, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(b) from the Examiner's Final Rejection of claims 2–9 and 14–18. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on October 12, 2016.

The disclosed invention relates generally to a cellular phone configured to connect to a vehicle diagnostic system. Spec 1:29–30. Independent claim 2 reads as follows:

> 2. A method of retrieving diagnostic information from a vehicle comprising the steps of:
>
> connecting a cellular phone with an adaptor configured to connect with a vehicle diagnostic system;
>
> connecting the adaptor with the vehicle diagnostic system;
>
> communicating with the vehicle diagnostic system with a communications circuit of the adaptor;
>
> retrieving the vehicle diagnostic information with a processor in the adaptor;
>
> processing the vehicle diagnostic information with the processor of the adaptor; and
>
> displaying the processed diagnostic information on a display of the cellular phone.

Patent Owner appeals the Examiner's rejection of claims 2–9 and 14–18 under 35 U.S.C. § 103(a) as unpatentable over Katagishi (US 6,438,471 B1, issued August 20, 2002) and any one of either Knight (US 7,778,750 B2, issued August 17, 2010), or Pajakowski (US 6,718,425 B1, issued April 6, 2004).

ISSUE

Did the Examiner err in rejecting claims 2–9 and 14–18?

ANALYSIS

Knight

Claim 2 recites processing the vehicle diagnostic information with the processor of the adaptor. Patent Owner argues that Knight fails to disclose "processing" information. *See, e.g.*, App. Br. 14. We are not persuaded by Patent Owner's argument for at least the reasons set forth by the Examiner. *See, e.g.*, Ans. 20–23.

For example, Knight discloses a "USB adapter" that includes a "central processing unit (CPU)" that "comprises a microcontroller." Knight 12:35–36, 13:26. One of skill in the art would have understood that a "central processing unit" would process data as a generally accepted function of a CPU. For at least this reason, we are not persuaded by Patent Owner's argument that the CPU of Knight does not process data or information.

Knight further discloses that the "CPU [of the adapter] . . . assembles the raw data into messages" and "reformats the message as one or more properly addressed USB frames." Knight 16:5–7, 10–11. In other words, the "adapter" of Knight "assembles the raw data" to create "messages" and formats the message based on a determined destination of the messages. We agree with the Examiner that one of skill in the art would have understood that assembling data to create messages and properly formatting the data in the messages based on a determined destination of the message would constitute "processing" (or "manipulation") of data.

Patent Owner argues that Knight only discloses that processing data "must take place outside the USB adapter." App. Br. 9–10, 14–16, 17, 19, 28–30, 38, 41–43, 45. In other words, Patent Owner argues that Knight fails to disclose an adapter processing data. We are not persuaded by Patent Owner's argument at least because, as previously discussed, Knight explicitly discloses the adapter "processing" data.

Patent Owner argues that one of skill in the art would have broadly but reasonably construed the term "processing" of data or information to require "producing results" because, according to Patent Owner, the Examiner finds that "processing" must include this additional feature.

Patent Owner also argues that Knight fails to disclose or suggest processing information that "produces results." *See, e.g.*, App. Br. 9, 26, 38. We are not persuaded by Patent Owner's arguments.

We note that contrary to Patent Owner's assertion, the Examiner does not find that one of skill in the art would have broadly but reasonably construed the term "processing" data in light of the Specification to require "producing results." Instead, as Patent Owner points out, the Examiner finds that one of skill in the art would have broadly but reasonably understood the term "processing," as recited in claim 2, for example, in light of the Specification and based on the plain and customary meaning of the term to mean:

> Processing: "Manipulation of data within a computer system." Processing is the vital step between receiving data (input) and producing results (output).

Ans. 6 (citing Microsoft Press Computer Dictionary, 2nd Ed., Microsoft Press, 1994).

In other words, the Examiner finds that a broadest reasonable interpretation of the term "processing" (of data), in light of the Specification, means "manipulation" of data. We agree with the Examiner.

Patent Owner also argues that one of skill in the art would have broadly but reasonably construed the term "processing" of data to include the additional requirement of "producing results" because US Patent No. 4,853,850 ("Krass" or "the '850 patent") "is consistent with [the claim term] processing [as requiring] 'producing results' as [Krass] suggest[s] possible cures." App. Br. 11–12. We are not persuaded by Patent Owner. It is well established that the broadest reasonable interpretation of a claim term is determined in light of the Specification corresponding to the claim term

itself and not in light of some other Specification not corresponding to the claim in question (i.e., a Specification of a different matter, such as Krass). In any event, Patent Owner merely states that Krass discloses an example of providing "possible cures" and does not assert or demonstrate sufficiently that Krass also discloses that "processing" data must also include "producing results."

Even assuming that one of skill in the art would have broadly but reasonably construed "processing" data to require "producing results," as Patent Owner contends, we are still not persuaded by Patent Owner's argument that Knight supposedly fails to disclose or suggest such a feature. As noted above, Knight discloses, at least, creating "messages" and formatting the message based on a determined destination of the messages. Patent Owner does not explain a sufficient difference between creating and properly formatting messages and "producing results." In both cases, a "result" (of properly formatted messages in Knight, for example) is produced.

Claim 7 recites a memory that stores "diagnostic software." Claim 14 recites a similar feature. The Examiner finds that one of skill in the art would have broadly but reasonably understood the term "diagnostic software," in light of the Specification, to mean "code for diagnosing problems" but Patent Owner argues that "diagnostic software" must further include the requirement that the "software . . . does not include codes to convert from one protocol to another protocol." App. Br. 33–35, 46, 47 (citing Third Newton Dec. ¶¶ 24, 25 and Krass 9:29–36). Patent Owner further argues that Knight discloses an "adapter [that] comprises vehicle diagnostic software" that formulates a "first protocol . . . into a second USB

protocol" but that "protocol conversion is not consistent with the . . . definition of diagnostic software." App. Br. 34, 48 (citing Knight 3:32–34, 4:35–37; Third Newton Dec. ¶ 23); *see also* App. Br. 39–40. We are not persuaded by Patent Owner's argument.

Patent Owner cites to expert testimony (Mr. Frank Newton) testifying that the Specification of a different matter (i.e., Krass) discloses that "diagnostic software" cannot convert one protocol to another protocol. *See, e.g.*, App. Br. 11 (citing Third Newton Dec., ¶ 13; Krass 9:29–36). As explained above, a broadest reasonable interpretation of claim terms is determined in light of the Specification containing the disputed claims, not some other Specification. However, even assuming that the Specification of Krass is relevant, as Patent Owner and Patent Owner's Declarant appear to contend, Patent Owner (or Patent Owner's Declarant) does not demonstrate sufficiently that Krass discloses that "diagnostic software" must exclude code "to convert from one protocol to another protocol." Rather, Patent Owner's Declarant merely states that Krass discloses that one example of diagnostic software "will comprise a so called 'expert system' which is able to diagnose problems in a wide range of different makes and models of engines and is further able to suggest possible cures, based on artificial intelligence algorithms." Third Newton Dec. ¶ 24 (citing Krass 9:29–36). Neither Patent Owner nor Patent Owner's Declarant explain how one of skill in the art would have understood that one example of the potential *presence* of an "expert system" would require the *absence* of code to "convert from one protocol to another protocol" in all instances of diagnostic software.

We also note that claim 7 recites a memory that stores "diagnostic software" but does not recite additional features of the "diagnostic

software." For example, claim 7 does not recite a function or a use of the diagnostic software. Patent Owner does not explain how "diagnostic software," as recited in claim 7, would constitute any more than mere non-functional descriptive material that would not be entitled to patentable weight.

Pajakowski

Patent Owner argues that Pajakowski fails to disclose "processing" of data because Pajakowski only discloses that the "processing of . . . information takes place in PC 18" and that the adapter "carries out no processing of the message itself." App. Br. 17–18, 26, 32, 38 (citing Pajakowski 6:4–5, 16:60–61); *See also* App. Br. 36, 49 (citing Third Newton Dec. ¶ 33). In other words, Patent Owner argues that Pajakowski fails to disclose "processing" information, as recited in claim 2, for example. We are not persuaded by Patent Owner's argument for at least the reasons set forth by the Examiner. *See, e.g.*, Ans. 26–29.

For example, Pajakowski discloses that the "adapter" has a "microprocessor." Pajakowski 6:64–65. One of skill in the art would have understood that an "adapter" that receives "data" and contains a "processor" would "process" the data at least based on the general understanding by those of skill in the art that a "processor" would function to "process" data. Patent Owner does not explain sufficiently how or why one of skill in the art would understand a "processor" to not "process" data.

Also, Pajakowski discloses that the "processor" functions to "encapsulate messages . . . into a package." Pajakowski 7:17–18. We agree with the Examiner that one of skill in the art would understand that

"encapsulating" data into a "package" would entail "processing" (or "manipulating") the data. Otherwise, if no manipulation of data takes place, the data would not be able to be "encapsulated," as disclosed by Pajakowski.

Pajakowski also discloses that the "adapter" "processes messages for effective use." Pajakowski 7:48. In other words, Pajakowski explicitly discloses "processing" data. Patent Owner does not explain sufficiently a difference between "processing" data as disclosed by Pajakowski and "processing" data as recited in claim 2, for example.

Patent Owner argues that one of skill in the art would have broadly but reasonably construed the term "processing" data to "not include converting from one protocol to another protocol" because U.S. Patent Publication 2002/0016655 ("Joao") discloses that "various operations are performed when processing vehicle diagnostic information" including "diagnos[ing] vehicle problems and/or determin[ing] vehicle problems, malfunctioning, and/or state of disrepair" so that the term "processing" "should be defined so as not to include conversion from one protocol to another protocol." App. Br. 10–12, 27. Patent Owner further argues that Pajakowski fails to disclose or suggest such data or information "processing." App. Br. 10–11, 27. We are not persuaded by Patent Owner's argument.

As stated earlier, the broadest reasonable interpretation of a claim term is in light of the Specification, not a different Specification. Also, even assuming Joao discloses diagnosing vehicle problems and/or determining vehicle problems, malfunctioning, and/or state of disrepair, as Patent Owner asserts, Patent Owner does not assert or demonstrate that Joao also discloses that one of skill in the art would have broadly but reasonably understood the

term "processing" of data to require any of these features or to explicitly exclude conversion of protocols. Hence, we are not persuaded by Patent Owner's argument.

Patent Owner argues that Pajakowski discloses "a handheld computer is utilized for monitoring, extracting, processing, and displaying standard vehicle data" but fails to disclose "processing" information "and then displaying the processed diagnostic information on a display." App. Br. 19. Hence, Patent Owner argues that Pajakowski fails to disclose or suggest displaying data on a display. However, Pajakowski discloses that "handheld software allows the user to view real-time data by providing a display," the data "will be displayed on the handheld screen," and "the handheld software allows the user to browse the data records" and "view a record at a time." Pajakowski 14:1–3, 5–6, 26–27, 29–30. One of skill in the art would have understood that Pajakowski discloses displaying data on a display at least in view of these explicit disclosures of Pajakowski. Nor does Patent Owner explain a sufficient difference between the "displaying" of data disclosed by Pajakowski and the "displaying" of data as recited in claim 2, for example.

Katagishi

Patent Owner also argues that Katagishi fails to disclose "processing" data and "does not include any diagnostic software." App. Br. 16–17, 19, 31, 43–44. In view of the previous discussion that Knight and Pajakowski each discloses these features, we need not consider whether or not Katagishi also discloses these features.

COMBINABILITY OF THE REFERENCES

Knight and Katagishi

The Examiner finds that Knight discloses the method of claim 2 using a PDA instead of the claimed "cellular phone," that Katagishi discloses a similar method of retrieving diagnostic information comprising connecting a cellular phone (instead of a PDA, as disclosed by Knight) with an adaptor, and that it would have been obvious to one of skill in the art to have combined the known method of retrieving and displaying information on a handheld device (PDA, Knight) with the known method of retrieving and displaying information on a handheld device (cellular phone, Katagishi) to achieve the predictable result of retrieving and displaying information on a handheld device. In addition, the Examiner concludes that it would have been well within the purview of one of skill in the art to select between a finite number of choices (i.e., 2 choices – either a PDA or a cellular phone) of components known in the art, the ordinarily skilled artisan having a high level of skill in the art and not being an automaton. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). *See* Final Rej. 11–22.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Knight and Katagishi because "the personal digital assistant [of Knight has] service tool software" but that "Katagishi fails to teach a cellular phone with the capability to execute service tool software." App. Br. 21. We are not persuaded by Patent Owner, at least because one of skill in the art, not being an automaton, would have understood to use software appropriate for a cellular phone when using the cellular phone of Katagishi and would have further understood not to use incompatible software in the cellular phone of

Katagishi. This is particularly true given the fact that even if one of skill in the art would have selected (e.g., inadvertently) software that was incompatible with the known cellular phone, after only routine experimentation, such a person would have realized that the cellular phone was inoperable and, since the skilled artisan is not an automaton, would have known to select *compatible* software in order to use the cellular phone.

Also, to the extent that Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have bodily incorporated the features of Katagishi into the method of Knight, we note that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller,* 642 F.2d 413, 425 (CCPA 1981).

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Knight and Katagishi because "the Katagishi cellular phone would not be able to operate in the same way that the personal digital assistant of Knight operated." App. Br. 22–23, 52–54. We are not persuaded by Patent Owner's argument. As previously discussed, Katagishi discloses a method for retrieving and displaying information on a cellular phone and Knight discloses a method for retrieving and displaying information on a personal digital assistant. Given that both the cellular phone of Katagishi and the personal digital assistant of Knight display information, we disagree with Patent Owner's assertion that the two devices do not "operate in the same way."

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Knight and Katagishi because "the combination would not be expected to work for the intended purpose . . . [of Knight] of being able to utilize service tool software." App. Br. 22, 52. As previously discussed, both Katagishi and Knight disclose a method for retrieving and displaying information on a device and, therefore, both accomplish the same "intended purpose." We are not persuaded by Patent Owner's argument that retrieving and displaying information on a device "would not be expected to work" if the device used is a cellular phone as opposed to a personal digital assistant. Indeed, Katagishi discloses such a method using a cellular phone.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Knight and Katagishi because "Katagishi leads one away from the claimed invention as Katagishi desires to process diagnostic information in the responding center 6." App. Br. 22. However, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed…." *In re Fulton,* 391 F.3d 1195, 1201(Fed. Cir. 2004). In the present case, Patent Owner does not demonstrate persuasively that Knight or Katagishi, for example, criticizes, discredits, or otherwise discourages other alternatives.

Pajakowski and Katagishi

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Katagishi and

Pajakowski because "Pajakowski teaches away from such a combination" because "Katagishi desires to process diagnostic information [in] the responding center 6." App. Br. 23. We are not persuaded by Patent Owner's argument at least because Patent Owner does not demonstrate persuasively that Katagishi "desires" to process diagnostic information in "responding center 6." However, even assuming that Katagishi has such a "desire," "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed…." *In re Fulton,* 391 F.3d 1195, 1201(Fed. Cir. 2004). In the present case, Patent Owner does not demonstrate persuasively that Pajakowski or Katagishi, for example, criticizes, discredits, or otherwise discourages any alternatives.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Katagishi and Pajakowski because "the combination of Pajakowski and Katagishi would change the principle of operation" and the combination of Pajakowski and Katagishi would "render the combination . . . unsatisfactory for its intended purpose." App. Br. 23. As previously discussed, both Pajakowski and Katagishi disclose methods for retrieving and displaying information on a device. The combination of a known process for retrieving and displaying information on a device (Pajakowski) with another known process for retrieving and displaying information on a device (Katagishi) would have resulted in a known and predictable result of retrieving and displaying information on a device. Also, the "principle of operation" or "intended purpose" of retrieving and displaying information on a device, being the

same in both of Pajakowski and Katagishi, would not have been rendered "unsatisfactory," as both Pajakowski and Katagishi accomplish the same "intended purpose" with the same "principle of operation."

The Examiner did not err in rejecting claims 2–9 and 14–18.

SUMMARY

We affirm the Examiner's rejection of claims 2–9 and 14–18 under 35 U.S.C. § 103(a) as unpatentable over Katagishi and any one of either Knight or Pajakowski.

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

CC: THIRD PARTY REQUESTER

DOWELL & DOWELL P.C.
103 ORONOCO ST.
SUITE 220
ALEXANDRIA, VA 22314