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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT BRUCE KLEVE, CHRISTIAN KROZAL,
and DAVID RANDOLPH ROBERTS

Appeal 2017-009527
Application 14/541,522¹
Technology Center 3600

Before CARL W. WHITEHEAD JR., JOHN R. KENNY, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 10–12 and 14–18. Claims 1–9, 13, 19, and 20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants’ Brief (“App. Br.”) identifies Ford Global Technologies, LLC as the real party in interest. App. Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to a method and apparatus for automated rental key dispensal and return. Spec., Title. Claim 10, reproduced below, is illustrative of the claimed subject matter:

10. A system comprising:
 - a processor configured to:
 - receive rental information from a user mobile device;
 - verify the received rental information;
 - dispense a key fob in accordance with the received rental information; and
 - responsive to the dispensing of the key fob, instruct a vehicle data gathering process executing on a processor provided as part of the key fob to begin gathering rental data, including at least beginning a rental time tracking process.

App. Br. (Claims Appendix 1).

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Webb	US 2002/0071076 A1	June 13, 2002
Mervine	US 2007/0093215 A1	Apr. 26, 2007
Picard	US 2009/0062978 A1	Mar. 5, 2009
Robinson	US 2010/0106534 A1	Apr. 29, 2010

REJECTIONS

Claims 10–12 and 14–18 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 2–4.

Claims 10, 12, 14–16, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mervine and Robinson. Final Act. 4–11.

Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mervine, Robinson, and Picard. Final Act. 11–13.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mervine, Robinson, and Webb. Final Act. 13–16.

DISCUSSION

35 U.S.C. § 101 REJECTION

Legal Standard for Patent Eligibility

In issues involving subject matter eligibility, our inquiry focuses on whether the claims satisfy the two-step test set forth by the Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). The Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept” (*id.* at 2355), and, in this case, the inquiry centers on whether the claims are directed to an abstract idea. If the initial threshold is met, we then move to the second step, in which we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). The Supreme Court describes the second step as a search for “an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

Examiner's Findings

The Examiner rejects the claims under the two-step *Alice* framework. Under the first step, the Examiner determines the claims are directed to the abstract idea of “vehicle rental.” Final Act. 3. The Examiner notes “receiving rental information, verifying the rental information, gathering vehicle usage information, verifying the presence of the vehicle and terminating the rental are activities that are considered both fundamental economic or business practices and methods of organizing human activity.” *Id.* (citing *Alice*, 134 S. Ct. at 2360).

With respect to the second *Alice* step, the Examiner determines the claims do not amount to significantly more than the abstract idea because “[t]he claims require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry. In the current case the claims merely recite generic elements known in the industry and use them in the generic known fashions.” *Id.* at 4.

Appellants' Contentions

Appellants present several arguments in favor of eligibility. First, Appellants argue the Examiner's analysis is inconsistent with the December 2016 Eligibility Guidance issued by the Office. App. Br. 4. Appellants argue the *Alice* step 2 determination is in error because the combination of claim elements amount to significantly more than the abstract idea because the claimed practice of using a fob to gather vehicle information is not well-known, routine, and conventional, and the Examiner has not provided sufficient evidence in support of the determination. App. Br. 4–5; Reply Br. 2.

Analysis

We are persuaded by Appellants’ argument that the Examiner has not provided sufficient evidence to sustain the finding that the claims are ineligible under *Alice* step 2. Under the examination procedure published online by the USPTO on April 19, 2018, entitled “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)² there is a fact finding requirement for Examiners, as applicable to rejections under § 101. Specifically, Examiners must provide specific types of evidence to support a finding that claim elements (or combinations of elements) are well-understood, routine, and conventional.

Here, the Examiner’s determination that the claims are directed to an abstract idea and do not amount to significantly more than the abstract idea is predicated, at least in part, on an unsupported finding that Appellants’ claims are directed to routine, conventional, computer operations. *See, e.g.*, Ans. 3–5. Appellants have challenged this finding in their Reply Brief. Reply Br. 2 (“Second, and far more importantly, the simple fact that a single instance of this exists (even if we believe the Examiner for the sake of argument), hardly establishes this fob-data-gathering as a long standing, long-practiced or well-known business practice.”) In light of this challenge, the burden shifts to the Examiner to provide evidence in support of the finding—but the only evidence provided is a statement that the prior art reference cited under § 103 (Mervine) demonstrates “this process is known

² USPTO, *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)* 1–5 (2018), <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF> (“*Berkheimer Memorandum*”).

to be done by hand and done by rental agents as such none of these elements are considered to be improvement[s] or advancements in the field.” Ans. 6. However, the *Berkheimer Memorandum* makes clear that “[t]he mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.” *Berkheimer Memorandum* 3 (quoting *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).) Consequently, we do not sustain the rejection under 35 U.S.C. § 101 for lack of supporting evidence based on: (1) *Berkheimer* (881 F.3d at 1369), and (2) the *Berkheimer Memorandum*, which changed the examination procedures to be fully compliant with *Berkheimer*.

35 U.S.C. § 103 REJECTIONS

Issues

First Issue: Has the Examiner erred in finding Mervine and Robinson teach or suggest “responsive to the dispensing of the key fob, instruct a vehicle data gathering process executing on a processor provided as part of the key fob to begin gathering rental data, including at least beginning a rental time tracking process,” as recited in claim 10?

Second Issue: Has the Examiner erred in finding Mervine, Robinson, and Picard teach or suggest “wherein the processor is further configured to instruct a vehicle data gathering process executing on an onboard data bus (ODB) connected device to begin gathering vehicle data when a vehicle is started using the key fob,” as recited in claim 11?

First Issue

In rejecting claim 10, the Examiner finds Mervine teaches most of the claim limitations, but “fails to explicitly state that the fob was physically

provided by the rental agency and that the fob explicitly has a processor and that information is gathered from a mobile device of the user.” Final Act. 7. The Examiner relies on Robinson to cure these deficiencies, finding it “teaches it is known for the rental agency to physically provide the user with monitoring device or fob which contains a processor for collecting information including the beginning of the rental period which includes beginning a rental time tracking process.” Final Act. 7 (citing Robinson ¶¶ 59–60).

The Examiner explains:

The sole difference between the primary reference Mervine and the claimed subject matter is that . . . Mervine does not explicitly disclose that the fob was physically provided by the rental agency and that the fob explicitly has a processor and that information is gathered from a mobile device of the user. The secondary reference Robinson . . . shows that it was known to physically provide a fob by the rental agency and that the fob explicitly has a processor and that information is gathered from a mobile device of the user known in the prior art at the time of the invention.

Id. at 8.

Appellants argue the prior art fails to teach or suggest “responsive to the dispensing of the key fob, instruct a vehicle data gathering process executing on a processor provided as part of the key fob to begin gathering rental data, including at least beginning a rental time tracking process.”

Id. at 5. More specifically, Appellants argue “the Examiner provides no example whereby the processor of the kiosk of Mervine instructs the fob to gather data, let alone instructs the fob to gather data responsive to dispensing the fob.” App. Br. 5–6. Appellants also argue “Robinson, introduced to cure certain deficiencies of Mervine, never discloses or

suggests that a rental agency would instruct a mobile device to begin tracking anything.” *Id.* at 6. According to Appellants, “neither Mervine nor Robinson teaches or suggests that anyone instructs a fob to begin gathering data” and that even if such an instruction were taught, it is not “‘responsive to the dispensing of the key fob,’ as claimed.” Reply Br. 3.

We are not persuaded by Appellants’ arguments, and we agree with and adopt as our own the response and analysis set forth in the Examiner’s Answer. Ans. 6–11. We make the following points for emphasis.

Appellants’ arguments primarily rest on overly narrow interpretations of the claim limitations and language not recited in the claims. For example, Appellants argue “the Examiner provides no example whereby the processor of the kiosk of Mervine instructs the fob to gather data, let alone instructs the fob to gather data responsive to dispensing the fob.” App. Br. 5–6. This argument is flawed because the claim does not require the “processor” be part of a kiosk, rather, it merely needs to be part of a “system.” As such, Appellants’ argument that Mervine is deficient because its *kiosk* fails to issue a data gathering instruction is not commensurate with the broad scope of the argued limitation. Appellants also argue Robinson “never discloses or suggests that a rental agency would instruct a mobile device to begin tracking anything.” *Id.* at 6. This argument is also not commensurate with the scope of the argued limitation because the claim does not recite that “a rental agency” must provide the instruction to perform the “vehicle data gathering process” recited in the claims. Finally, Appellants’ contention even if the prior art teaches a processor instructing a fob to begin gathering data, it does not teach doing so “responsive to dispensing the fob,” is also not persuasive.

As explained by the Examiner, Mervine teaches dispensing a key fob to a renter, and only after doing so, using the fob to gather vehicle information during the rental. Mervine ¶¶ 13, 25, Fig. 3 (blocks 312, 314). Further, as explained by the Examiner, Robinson teaches that it was known for an external, remote computer processor to activate the tracking process. Ans. 9–10 (citing Robinson ¶ 15); *see also* Robinson ¶ 36 (“In one embodiment, certification entity 102 can be designed to turn on a tracking device that is associated with the user (e.g., phone) or the vehicle.”). As such, we are not persuaded that the cited prior art does not teach instructing a vehicle data gathering process using the fob responsive to dispensing the fob, and we sustain the rejection under 35 U.S.C. § 103.

Second Issue

Appellants argue separately for the patentability of claim 11, which depends from claim 10 and recites the additional limitation “wherein the processor is further configured to instruct a vehicle data gathering process executing on an onboard data bus (ODB) connected device to begin gathering vehicle data when a vehicle is started using the key fob.” App. Br. (Claims Appendix 1). In rejecting claim 11, the Examiner finds Mervine teaches beginning a vehicle data gathering process when the vehicle is started using the key fob. Final Act. 11–12 (citing Mervine ¶¶ 12–13). The Examiner finds that Mervine and Robinson do not specifically teach the use of an onboard data bus, but that Picard cures this deficiency because it demonstrates that it was “known to communicate directly with the vehicle wirelessly using the on-board diagnostic system.” Final Act. 12 (citing Picard ¶ 40). The Examiner finds that “because Mervine already establishes it is known to transmit information from the vehicle it would have been

obvious to do this wirelessly using the on-board diagnostic system as shown in Picard as this is merely substituting one known method for another.”

Final Act. 12.

Appellants argue the Examiner’s findings are in error because the claim requires “that the same processor that dispensed the key *actively instructs* the data gathering process of the vehicle to being gathering data when the vehicle is started using the fob.” App. Br. 6. Appellant asserts that “[a]ll of the art cited includes *nothing* about the processor which dispensed a fob performing such an instruction.” App. Br. 7.

We are not persuaded by Appellants’ argument. As explained by the Examiner, a processor does not physically dispense a fob. Rather, the recited processor executes an instruction which results in a fob being “dispensed.” Mervine teaches that “system 110 assigns a rental vehicle 102 and an associated fob 106 to the customer.” Mervine ¶ 25. Thus, in doing so, a processor of the system 110 executes an instruction that causes the fob to be dispensed to a customer. Similarly, and as noted above, Robinson teaches the use of an external processor to instruct the gathering of vehicle information to begin. Robinson ¶¶ 15, 36. Thus, the Examiner has relied upon the combined teachings of Mervine and Robinson to show that it would have been obvious for a processor, separate from any processor in the fob, to instruct both dispensing of the key fob and instructing vehicle data gathering. Arguing, as Appellants have done here, that no single reference shows a single processor providing both the dispensing and vehicle data gathering amounts to an attack on the references individually, when the Examiner relied on a combination to show obviousness of the claim. Appellants do not provide any argument or explanation for why the

Examiner's combination is improper or why the *combined* teachings of the references to not teach or suggest the claimed configuration. Accordingly, we are not persuaded the Examiner erred with respect to claim 11, and we sustain its rejection under 35 U.S.C. § 103.

Remaining Claims

Appellants offer no separate arguments for patentability for any other claim. Accordingly, we treat claim 10 as representative of the remaining claims not specifically discussed above, and they fall along with claim 10.

DECISION

We reverse the Examiner's rejection of claims 10–12 and 14–18 under 35 U.S.C. § 101.

We affirm the Examiner's rejections of claims 10–12 and 14–18 under 35 U.S.C. § 103.

Because we have affirmed at least one ground of rejection for each claim on appeal, we affirm the Examiner's decision to reject the claims. 37 C.F.R. § 41.50(a)(1).

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

AFFIRMED