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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUKE WOOD, MICHAEL D. PARMETT, and GREG SLATER

Appeal 2013-003321[1]
Application 11/708,429[2]
Technology Center 3600

Before NINA L. MEDLOCK, BRUCE T. WIEDER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–11. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Our decision references Appellants' Appeal Brief ("Br.," filed February 20, 2012) and the Examiner's Answer ("Ans.," mailed October 5, 2012).

[2] Appellants identify Trigpoint Solutions, Inc. as the real party in interest. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "relates to the field of asset tracking and maintenance, and more particularly relates to a system and method for scheduling and verification of equipment maintenance activities" (Spec. 1, ll. 2–4).

Claims 1 and 5, reproduced below, are illustrative of the subject matter on appeal:

> 1. An asset tracking and maintenance scheduling and verification system for a collection of assets, comprising:
>
> for each asset in said collection of assets, a machine readable identifier comprising machine readable data sufficient to distinguish each asset from all others;
>
> a system server programmed to generate at least one task list for said collection of assets;
>
> a handheld remote programmable device operable to read said machine readable identifier when a user selectively positions said handheld remote programmable device in proximity with a selected asset, said handheld remote programmable device being selectively coupled to said system server for receiving said at least one task list from said system server;
>
> said handheld remote programmable device further comprising a user interface readable by said user, said user interface being operable for directing said user to conduct a sequence of user performable steps relating to said collection of assets specified in said at least one task list;
>
> wherein said user interface comprises user inputs so as to be interactive with said user responsively to said user performing said user performable steps;
>
> said handheld remote programmable device being programmed for communicating data from said user inputs and said machine readable identifier to said system server;
>
> and wherein said system server is responsive to communication of said data from said user inputs to update a database corresponding to said collection of assets.

5. A method of asset tracking and maintenance scheduling and verification for a collection of assets, comprising:

for each asset in said collection of assets, providing a machine readable identifier having information sufficient to distinguish each said asset from all others;

implementing a system server adapted to generate at least one task list for said collection of assets;

providing a handheld remote programmable device adapted to be selectively coupled to said system server for receiving said at least one task list from said system server;

providing that said handheld remote programmable device comprises a user interface for directing a user to conduct a sequence of tasks specified in said at least one task list;

providing that said handheld remote programmable device is programmed for electronically interrogating a respective asset to obtain said machine readable identifier for said respective asset;

producing user instructions with said user interface to direct a user for performing an action involving physical properties of said respective asset and programming said handheld remote programmable device for electronically receiving a response from said user and for generating data relating to said physical properties of said respective asset; and

communicating said data relating to said physical properties of said respective asset to said system server;

wherein said system server is responsive to communication of said data reflecting performance of said action to update a database including at least one record corresponding to said collection of assets.

REJECTIONS

Claims 5–8 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 2, 4, 5, 6, 8, and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bishop (US 6,611,201 B1, iss. Aug. 26, 2003) and Mian (US 2005/0259273 A1, pub. Nov. 24, 2005).

Claims 3 and 7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bishop, Mian, and Rutherford (US 2007/0193348 A1, pub. Aug. 23, 2007).

Claims 10 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bishop, Mian, and Dougherty (US 5,689,799, iss. Nov. 18, 1997).

Claim 11 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bishop, Mian, and Official Notice.

ANALYSIS

Non-Statutory Subject Matter

In rejecting claims 5–8 under 35 U.S.C. § 101, the Examiner concludes that the claims are directed to non-statutory subject matter because "there is no transformation of data or a tie to a particular machine or apparatus" (Ans. 3). Appellants argue that the claims satisfy the machine-or-transformation test, and that the claimed subject matter is neither a mental process nor an abstract idea (Br. 17–24).

Before the mailing date of the Examiner's Answer, the Supreme Court held in *Bilski v. Kappos*, 561 U.S. 593 (2010) that a patent claim's failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. *Id.* at 604. Because the Examiner relies only on the machine-or-

transformation test, the Examiner has failed to establish a prima facie case of patent-ineligibility.

Therefore, we do not sustain the Examiner's rejection of claims 5–8 under 35 U.S.C. § 101.

Obviousness

Independent claim 1 and dependent claims 2 and 4

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because a person of ordinary skill in the art at the time of Appellants' invention would not have had an apparent reason, in view of the combined teachings of Bishop and Mian, to modify the Bishop system to utilize a handheld device, as the Examiner proposes (Br. 26–31).

Bishop discloses an apparatus for providing two-way communication between a vehicle and a remote communication station; the apparatus is mounted in the vehicle and comprises a master control unit for communicating over a first wireless interface with the communication station and over a second wireless interface with at least one slave unit controlling a function in the vehicle (Bishop, col. 2, ll. 1–9). Bishop discloses, with reference to Figure 1, that master control unit 1 is installed in the trunk of vehicle 13, and comprises main receiver 1a, controller 1b, and wireless transmitter/transceiver 1c, capable of transmitting digital codes to a plurality of slave units 2, 7; the slave units are in wired electrical communication with relay-based vehicle accessories or system features, e.g., the starter motor, vehicle lights, ignition switch, door locks, etc. (*id.*, col. 4, ll. 32–65). As shown in Bishop's Figure 1, vehicle 13 is in communication with main transmitter system 20 comprising paging dispatch center 19 in

communication with a customer database and message/control processing center 18 having one of more subscribing customers, e.g., automobile manufacturers, automobile lending institutions, automobile services businesses; processing center 18 interfaces between its subscribing customers and automobiles having in-vehicle communication systems (*id.*, col. 3, ll. 52–67). In operation, transmitter system 20 transmits a signal over the air to in-vehicle receiver 1a, which passes the signal to controller 1b for interpretation; the signal includes a vehicle identifier which identifies the vehicle to which the signal is addressed and an instruction to enable or disable a particular function or functions. If controller 1b recognizes the signal as an instruction to enable and/or disable one or more functions in the vehicle, controller 1b transmits a signal through transmitter 1c to the appropriate slave relay unit(s) (*id.*, col. 12, ll. 13–26).

Bishop describes that the apparatus may be used for various purposes, e.g., to permit a rental or service agency to automatically unlock vehicle doors from a remote location on being notified that the renter or owner has locked his/her keys in the car; to immobilize a vehicle by disabling the vehicle starter as a method of collection enforcement for a credit agency; to prevent drivers convicted of automobile violations from using their vehicles altogether or during certain hours of the day; or as a theft deterrent (*id.*, col. 12, ll. 48–64; col. 13, ll. 13–33).

In rejecting independent claim 1 under 35 U.S.C. § 103(a), the Examiner concludes that Bishop discloses substantially all the limitations of claim 1 except that Bishop does not explicitly disclose a "handheld remote programmable device further comprising a user interface readable by said user . . . wherein said user interface comprises user inputs," as recited in

claim 1 (Ans. 4–6). The Examiner cites Mian to cure the deficiency of Bishop (*id.* at 5–6).

Mian discloses a handheld electronic gauge configured to obtain measurement data for an object, such as a railway wheel and a handheld computing device, including a user interface, in communication with the gauge (Mian, Abstract). The handheld computing device automatically determines when the gauge is in the measurement position, obtains measurement data using the gauge, and communicates the measured attributes to a remote system (*id.* ¶¶ 9, 10, 36, 39).

The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to modify the system and method of Bishop to include the handheld device disclosed in Mian "in order to provide for more accurate gauging and measurement of the assets when performing asset tracking and maintenance scheduling . . . since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results" (Ans. 5–6). Yet an obviousness analysis requires more than simply showing that each limitation is found in the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). The Examiner also must show that "there was an apparent reason to combine the known elements in the fashion claimed." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *see also Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F. 3d 1296, 1303 (Fed. Cir. 2010) (citing *KSR*, 550 U.S. at 401) ("[I]t is not enough to simply show that the references disclose the claim limitations; in

addition, 'it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."').

Bishop discloses that "[an] object of the present invention is to provide an apparatus which can access, monitor, control, disable, and/or enable functions of a vehicle, and/or deliver information to/from the vehicle, and *which is virtually impossible to detect or locate*" (Bishop, col. 1, ll. 63–67) (emphasis added). Bishop, thus, contemplates use of the disclosed apparatus (e.g., as a theft deterrent tool, a debt collection or law enforcement mechanism) by loan agencies, credit agencies, rental agencies, law enforcement agencies, or any other agency that wishes to have some control and/or monitoring capability over a vehicle.

The Examiner has not shown that a person of ordinary skill in the art would have had an apparent reason to modify the Bishop system by substituting the Mian handheld device for the Bishop master control unit, which communicates with the remote communication station. Not only would such a substitution be contrary to Bishop's stated object of providing an apparatus "which is virtually impossible to detect or locate," it also seemingly would allow the system to be easily defeated, e.g., by a delinquent borrower, an individual charged with an auto violation, or an auto thief, by simply removing the handheld device from the vehicle.

On the present record, we are not persuaded that the Examiner has established a prima facie case of obviousness. Therefore, we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner's rejection of dependent claims 2 and 4. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992)

("dependent claims are nonobvious if the independent claims from which they depend are nonobvious").

Independent claims 5 and 9 and dependent claims 6 and 8

Independent claims 5 and 9 include language substantially similar to the language of claim 1. Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 5 and 9 and claims 6 and 8, which depend from claim 5, for the same reasons set forth with respect to claim 1.

Dependent claims 3, 7, 10, and 11

Each of claims 3, 7, 10, and 11 depends from one of independent claims 1, 5, and 9. The rejections of these claims based on Rutherford, Dougherty, or Official Notice, in combination with Bishop and Mian, do not cure the deficiency in the Examiner's rejection of claims 1, 5, and 9. Therefore, we do not sustain the Examiner's rejections of claims 3, 7, 10, and 11 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner's rejection of claims 5–8 under 35 U.S.C. § 101 is reversed.

The Examiner's rejections of claims 1–11 under 35 U.S.C. § 103(a) are reversed.

REVERSED

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