

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SILVIU PALALAU and TIMOTHY J. BOMYA

Appeal No. 1999-2068
Application 08/650,038

ON BRIEF

Before FLEMING, SMITH and LALL, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-14, 17, 19 and 20, all of the claims pending in the present application. Claims 15, 16 and 18 have been

anceled¹.

The invention relates to (specification, page 1, lines 24-25 through page 2, lines 1-8) a driver control interface system (figure 1, item numbered 20) for a vehicle having plural feature groups, such as audio and climate, and each feature group having a plurality of associated features, such as volume, balance, tuning, temperature and fan speed. Each of these features has an associated value which is adjustable by the driver. Other features have a value which is only communicated to the driver for information purposes, such as engine temperature, tachometer, fuel level, and speed.

The driver controlled interface system includes a display (figure 1, item numbered 22) located on the instrument panel (figure 1, item numbered 24) in front of the steering wheel (figure 1, item numbered 26), or as a heads-up display projected onto the windshield. A plurality of feature group switches (figure 1, item numbered 28) are located inside the periphery of the steering wheel and a plurality of select switches (figure 1, item numbered 30) are located inside the

¹ Amendment received March 11, 1998.

periphery of the steering wheel spaced from the feature group switches. Control circuitry (figures 12a or 12b or 13a or 13b) implement the value adjustments of the activated features of the vehicle.

This system is said (specification, page 1, lines 24-25 through page 2, lines 1-2) to minimize the time and travel distance that the driver's attention is diverted from the road, and the time and distance that the driver's hands are diverted from the steering wheel while operating the various systems.

Independent claim 1 is reproduced as follows:

1. A driver control interface for controlling the values of a plurality of user-adjustable features in a vehicle, said driver control interface comprising:

a steering wheel for steering the vehicle;

a plurality of feature group switches supported on said steering wheel, each said feature being associated with a feature group, said feature group switches selectively activating said feature groups;

a plurality of selection switches supported on said steering wheel and spaced from said feature group switches, said selections switches adjusting the values of said features associated with said activated feature group;

a display supported on an instrument panel in the vehicle

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forward of said steering wheel and displaying an activated feature group, said display indicating the current value of a feature in said activated feature group; and

control circuitry for implementing said adjusted value of said activated feature in said vehicle.

The Examiner relies on the following reference:

Fujisawa et al. (Fujisawa) 1995	5,467,277	Nov. 14,
Yano et al. (Yano) 1996	5,539,429	Jul. 23,

Claims 1-14, 17, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yano in view of Fujisawa.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief², Reply Brief³, and the Examiner's Answer⁴ for the respective details thereof.

OPINION

² The Brief was received December 15, 1998.

³ The Reply Brief was received February 22, 1999. The Examiner mailed a letter March 9, 1999 stating that Appellants' Reply Brief had been entered and considered but no further response by the Examiner was deemed necessary.

⁴ The Examiner's Answer was mailed January 21, 1999. The amendment after final received July 30, 1998 was not entered.

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We will not sustain the rejections of claims 1-14, 17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Yano in view of Fujisawa.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." *Pro-Mold & Tool Co.*

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v. Great Lakes Plastics, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have reasonably expected to use the solution that is claimed by Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.** 721 F.2d 1551, 1553, 220 USPQ 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3D 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

On pages 5 and 6 of the Appeal Brief (hereinafter "brief"), Appellants assert that the Examiner does not provide any indication of any suggestion or motivation to make the modification and combination of the cited references from within the references themselves, and the Examiner is not entitled to rely on Appellants' disclosure or claims to provide the necessary motivation to modify the teachings of the prior art or to make a combination of the references.

In addition, Appellants argue⁵ that both Yano and Fujisawa teach away from the Examiner's proposed combination. Firstly, as to Yano, Appellants assert that Yano discloses⁶ that the primary object of his invention is to provide a touch screen device where switches are displayed directly on a touch screen. Therefore, if one were to modify the teachings of Yano and separate the activation switches from the display screen, that would defeat the very object of Yano.

Secondly, as to Fujisawa, Appellants argue that the Fujisawa system is taught to operate only when the vehicle is

⁵ Brief, pages 6-9.

⁶ Column 1, line 56 through column 2, line 19.

not moving, whereas the Examiner's reasons for the combination of the references requires that the vehicle be in motion.

In addition, Appellants assert that one skilled in the art would not be motivated to place a touch screen device forward of a steering wheel and on an instrument panel of the vehicle, as the driver's access to the screen would be hindered by the steering wheel, and the resulting system would be awkward and most likely unsafe to utilize.

In the answer⁷ the Examiner admits that Yano does not disclose a display located forward of the steering wheel, a plurality of switches located on the steering wheel for selectively activating a feature group on the display, and means located on the steering wheel for activating a feature from the activated feature group on the display and for adjusting a value of the activated feature. All of these limitations are required by the pending claims. However, the Examiner asserts that it would have been obvious to a person of ordinary skill in this art at the time the invention was made to have the switching means, as taught by Fujisawa, in

⁷ Answer, page 4.

the apparatus of Yano because by having the switching means located on the steering wheel of the automobile the driver has the switching means closer, which minimizes the driver's distraction from the road while trying to reach the switching means.

The Examiner also finds⁸ it obvious to one of ordinary skill in the art to have the touch screen feature group switches separate from the display device because it is commonly known in the art to integrate or not circuit elements into one integrated circuit in order to make the device more or less compact, and by having the display on the front panel of the vehicle, the driver does not have to distract the view from the road.

Finally, the Examiner asserts⁹ that it is not necessary that the references actually suggest the changes or improvements that Appellant has made, but that the test for combining the references is what the references as a whole would have suggested to one of ordinary skill in the art.

⁸ Answer, page 5.

⁹ Answer, page 7.

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The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d at, 1266 n.14, 23 USPQ2d at 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d at, 902, 221 USPQ at 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d at 1000-01, 50 USPQ2d at 1617-19 (Fed. Cir. 1999).

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

Turning first to Appellants' claim 1, we first note that the Examiner admits that Yano does not disclose the following claim limitations: the display located forward of the steering wheel; a plurality of switches located on the steering wheel for selectively activating a feature group on the display; and means located on the steering wheel for activating a feature from the activated feature group on the display and for adjusting a value of the activated feature group.

The Examiner has made multiple assertions of obviousness in the rejection to allocate the components of the references to provide these limitations. The first assertion is that it would have been obvious to a person of ordinary skill in this art at the time the invention was made to have the switching means, as taught by Fujisawa, in the apparatus of Yano because by having the switching means located on the steering wheel of the automobile the driver has the switching means closer, which minimizes the driver's distraction from the road while trying to reach the switching means.

The second assertion is that it would have been obvious to one of ordinary skill in the art to have the touch screen feature group switches separate from the display device

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because it is commonly known in the art to integrate or not circuit elements into one integrated circuit in order to make the device more or less compact, and by having the display on the front

panel of the vehicle, the driver does not have to distract the view from the road. These statements of obviousness are bald assertions without evidentiary basis.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

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The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, *Graham* is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103". Citing *In re Warner*, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

In addition, one important indicium of non-obviousness is "teaching away" from the claimed invention by the prior art. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988), *In re Bell*, 991 F.2d 781, 784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). Here Fujisawa teaches away from the reason proposed by the Examiner for the combination, as the system operation unit of Fujisawa is disclosed¹⁰ to operate only when the vehicle is at a stop, in an idling state, or in a park position. In fact, Fujisawa states "Since the driver watches the display . . . steps 524, 526 are executed for danger averting purposes only under conditions where the

¹⁰ Column 12, lines 45-50 and column 8, lines 40-52.

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engine is idling or where the select lever 60 is in a parked state." As this system operates when the vehicle is not in motion there is no concern of driver's distraction from the road.

Therefore, we will not sustain the rejections of claims 1-14, 17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Yano in view of Fujisawa. Accordingly, the Examiner's decision is reversed.

REVERSED

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	Administrative Patent Judge)	
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