

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY A. HOLT
and ELDEN E. DURAND

Appeal No. 95-3175
Application 08/124,361¹

HEARD: September 16, 1997

Before HAIRSTON, BARRETT, and FLEMING, Administrative Patent Judges.

¹ Application for patent filed September 20, 1993, entitled "Device For The Computerized Recording Of Mileage And Expenses In Vehicles," which is a continuation of Application 07/927,244, filed August 7, 1992, now abandoned, which is a continuation of Application 07/771,511, filed October 1, 1991, now abandoned, which is a continuation of Application 07/529,937, filed May 29, 1990, now abandoned.

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BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 15-19, 26-27, and 31. Claims 1-14, 20-25, and 29-30 have been cancelled. We reverse but enter a new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The invention is directed to a system for storing and transferring data related to the operation of a vehicle. In particular, the system automatically keeps track of the number of miles driven and provides for recording of vehicular and non-vehicular information by the operator.

Claim 15, the sole independent claim, is reproduced below.

15. A computerized information processing system mounted in a vehicle and comprising:

a mileage sensor securable to the vehicle for automatically inputting information from said vehicle representative of distance traveled by said vehicle;

a manual menu-driven input, operable by the occupant of said vehicle, having a display and a keypad for entering both vehicular and non-vehicular information, said vehicular information including data regarding cumulative vehicle travel mileage and vehicle operating expenses, said non-vehicular information including travel expenses and characterization of said vehicle operating expenses and said travel expenses for tax purposes;

a data storage and internal processor responsive to said mileage sensor and manual input, having a microcomputer, a real time clock, and random access memory;

transfer circuitry attachable to said data storage and internal processor for transferring data from said data storage and internal processor to an external data processor; and

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a calibration system operable to calibrate the computerized information processing system with an odometer of the vehicle, such that said information representative of distance traveled corresponds to actual distance traveled as measured by said odometer.

The examiner relies on the following references:

Juhasz	4,067,061	January 3, 1978
Eshelman	4,646,042	February 24, 1987
Webb et al. (Webb)	4,852,000	July 25, 1989

Claims 15-19, 26-27, and 31 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. The examiner states (Examiner's Answer, page 3): "As per claim 15, it is unclear what is meant by 'calibration system' (line 20), since an 'information processing system' is recited in the preamble (line 2, emphasis added)."

Claims 15-19 and 26-27 stand rejected under 35 U.S.C. § 103² as being unpatentable over Webb and Eshelman. The examiner finds that Webb teaches a computerized information processing system for keeping track of vehicular and non-vehicular expenses. The examiner finds Webb's disclosure of a "direct mileage input" to mean "automatically inputting information" from a mileage sensor of the vehicle to the processing system. The examiner finds that Webb does not disclose the sensor to provide the "direct mileage input," but concludes that it would have been obvious to use a sensor as described in Eshelman. The examiner finds that Webb does not disclose calibration, but finds that calibration is inherently

² The first paragraph of § 103 was redesignated as § 103(a) as of November 1, 1995. Pub. L. 104-41, sec. 1, 109 Stat. 351 (Nov. 1, 1995). This was after the Final Rejection was entered but before the Examiner's Answer. Accordingly, the rejection should refer to § 103(a).

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necessary in Webb and concludes that it would have been obvious to calibrate the system in Webb to the odometer so the system will receive an accurate indication of mileage.

Claim 31 stands rejected under 35 U.S.C. § 103 as being unpatentable over Webb, Eshelman, and Juhasz.

OPINION

35 U.S.C. § 112, second paragraph

The second paragraph of 35 U.S.C. § 112 requires that a claim set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the person of ordinary skill in the art. See In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

We agree with appellants' arguments (Brief, pages 3-4) that it is unclear from the examiner's statement of the rejection in the Final Rejection exactly what the problem is with the term "calibration system." In the response to argument section of the Examiner's Answer, the examiner explains the rejection in more detail. The examiner apparently does not understand how the calibration system is "operable to calibrate the computerized information processing system with an odometer of the vehicle,"

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as claimed, stating (Examiner's Answer, page 8):

It is not clear to the examiner how the "calibration system" (lines 21-25) is meant to fit within the context of a "computerized information processing system" (line 1) as a whole. . . . [T]he examiner referred to the specification (pages 15-17) for clarification on the claimed "calibration system". However, the description found merely describes a "calibration procedure" (page 15, paragraph 1, lines 5-6) from which the examiner cannot discern how the description comprises a "calibration system."

The examiner apparently misses the detailed description of the calibration procedure, as performed with the microcomputer attached to a mileage sensor on the vehicle and the vehicle odometer, at page 16, last paragraph, of the specification. The claimed "calibration system" is not indefinite in view of the specification. The "calibration system" is one subsystem of the overall "information processing system."

For these reasons, the rejection of claims 15-19, 26-27, and 31 is reversed.

35 U.S.C. § 103

The examiner's obviousness conclusion is based on an erroneous factual finding regarding the content of Webb and must be reversed.

Webb states (column 1, lines 62-63): "Mileage data can be entered using a direct mileage input or an odometer entry." This supports the examiner's finding that (Final Rejection, page 3; Examiner's Answer, page 4): "Webb et al. teach that the mileage data can be entered using a direct mileage input in column 1, lines 62-63." However, the examiner erroneously finds "direct mileage input" to mean "automatically inputting information" from a mileage sensor of the vehicle and that Webb just fails to describe a mileage sensor. Both entry methods in Webb involve manual entry of mileage or odometer

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readings by an operator via a keyboard as shown in figure 4B, steps 61 and 62 (entering odometer reading) and steps 67 and 68 (entering mileage directly), and described at column 4, line 57, to column 5, line 20. Since Webb does not suggest "automatically inputting information" from a mileage sensor of the vehicle, and Eshelman does not suggest inputting the sensor output to a mileage recording device as claimed, the examiner fails to provide the requisite motivation to combine the sensor teaching of Eshelman with the computer system of Webb. For this reason, the rejection of claims 15-19, 26-27, and 31 is reversed.

The examiner also concludes, based on the erroneous finding that Webb discloses "automatically inputting information" from a mileage sensor of the vehicle, that (Final Rejection, pages 4-5; Examiner's Answer, pages 5-6):

Furthermore, calibration of the system of Webb et al. at the time of installation, although not disclosed in Webb et al., is inherently necessary in the system of Webb et al. since the generated reports of Webb et al. would not correspond to the correct mileage. For instance, if the system were installed at a vehicle mileage of 10,000 miles and not calibrated then the reports would be generated starting [sic] at 0 miles. One of ordinary skill in the art at the time of the invention would thus have found it obvious to calibrate the system to the odometer because it would eliminate this discrepancy.

Because Webb does not disclose "automatically inputting information" from a mileage sensor of the vehicle and, because Webb involves manual input of mileage and odometer readings, there is no reason to provide a calibration system in Webb. Webb just accepts the inputs from the operator. The rejection of claims 15-19, 26-27, and 31 is also reversed for this reason.

NEW GROUND OF REJECTION PURSUANT TO 37 CFR § 1.196(b)

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We are always reluctant to enter new grounds of rejection because the appeal should be the end of prosecution. That is especially true in this case where this is the third continuation application. Nevertheless, neither appellants nor the patent system are served by granting a patent where the best prior art has not been considered. The duty of the Patent and Trademark Office is to issue valid patents. See *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877) ("[In the Patent Office, applicant's] claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to."); *Burns v. Meyer*, 100 U.S. 671, 672 (1880); *Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) ("[T]he primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is--for all practical purposes--to debilitate the patent system."). A new ground of rejection is warranted in the present case.

Claim 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Webb, Fogg et al. (Fogg) (U.S. Patent 5,337,236, issued August 9, 1994, filed May 21, 1990, eight days before the effective filing date of this application), Gulas et al. (Gulas) (U.S. Patent 4,755,832, issued July 5, 1988), and Whitaker (U.S. Patent 4,685,061, issued August 4, 1987). We intentionally have not considered the patentability of the dependent claims because it is not our responsibility to examine all the claims in the first instance, and because it is our experience with Rule 196(b) rejections that examiners adopt whatever rejection has been made without trying to find better art and without listening to arguments or showings of facts to overcome the rejection. The examiner should independently decide whether the dependent claims are patentable.

Every obviousness determination is based on the four factual inquiries of Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claimed invention; (3) level of ordinary skill in the art; and (4) any objective evidence such as commercial success, failure of others, long-felt need, and unexpected results.

Scope and content of the prior art

Webb discloses a menu-driven system for maintaining expense records. The system "can be tailored to operate in several environments such as a lap computer, desk-top computer, pocket calculator or mainframe computer" (column 1, lines 28-31). The system has a display and keyboard for manual entering of information and inherently has "a microcomputer, a real time clock, and random access memory," as recited in claim 15. "Manual data entry can be accomplished on hardware integral to the storage and calculating system or through external hardware interfaced to a computing system, such as a modem or cellular telephone" (column 1, lines 34-37), which suggests that information can be transferred to an external computer. Webb also discloses that "[d]ata can be provided to a disc memory" (column 1, line 68), which would permit the disc to be taken to another computer. The system has twelve modular expense routines for manually entering both vehicular information "including data regarding cumulative vehicle travel mileage and vehicle operating expenses" (figure 1: mileage module 11, fuel module 15, tolls module 17, miscellaneous module 18) and non-vehicular information "including travel expenses" (figure 1: meals module 12, lodging module 13, etc.). "The user can enter unique identifying titles and descriptive

information for inclusion on printed reports" (column 1, lines 60-62), which allows "characterization of said vehicle operating expenses and said travel expenses for tax purposes," as recited in claim 15. For example, in figure 4B "the user is prompted at step 69 to enter the reason for the mileage traveled" (column 5, lines 6-7).

Fogg discloses a trip distance recorder for a motor vehicle connected to a mileage sensor to measure the distance traveled (e.g., column 3, approx. lines 30-42; column 4, lines 24-30). The sensor may be a drive shaft sensor (column 3, lines 30-42). Fogg discloses that the trips may be characterized by one of ten trip types (column 3, lines 64-66; column 4, table I). The system in figure 2 of Fogg is "a data storage and internal processor responsive to said mileage sensor and manual input, having a microcomputer, a real time clock, and random access memory," as recited in claim 15. The real time clock is not shown but is described, for example, in column 4. Fogg further discloses a calibration procedure to calibrate the TICKS/TENTH parameter value (e.g., column 6, lines 30-68; column 5, line 52, to column 10, line 20).

Whitaker shows a device for recording distances for personal and business use using a vehicle speed sensor. A mileage sensor attached to the vehicle is connected to the device for recording miles driven (column 3, lines 43-46). "The speed pick-up can be from the drive shaft, transmission, speedometer cable or electronic control module (ECM)/electronic control unit (ECU)" (column 3, lines 10-12). The purpose of the trip can be characterized as "business," "investment," or "personal" (default) (column 3, line 62, to column 4, line 10). The system in figures 3-6 of Whitaker is "a data storage and internal

processor responsive to said mileage sensor and manual input, having a microcomputer, a real time clock, and random access memory," as recited in claim 15. Whitaker discloses (column 7, lines 64, to column 8, line 8):

The calculated odometer reading may, however, vary somewhat from the reading of the mechanical odometer within the vehicle. Therefore, to prevent loss of confidence by the operator in the data stored by the apparatus, microprocessor 60 is programmed to compare the next odometer reading entered through keypad 12 with that stored in data file 112, and to calculate therefrom a correction factor that is applied to all calculated updates of vehicle mileage until the next odometer reading is manually entered. In this manner, the calculated values will more closely correspond with values indicated by the mechanical odometer.

Therefore, Whitaker teaches a calibration system.

Gulas shows a device for recording distances traveled on personal and business use including a vehicle speed sensor. A mileage sensor attached to the vehicle is connected to the device for recording miles driven (column 3, lines 27-45). The device in Gulas "can include input keys for inputting details of gas purchase and amount to keep an accurate record of the total costs for later division into the separate characteristics" (column 2, lines 32-35); see also column 4, lines 35-41. Thus, Gulas provides for recording "vehicle travel mileage and vehicle operating expenses." The mileage and expenses can be characterized as business or non-business for tax purposes (e.g., column 3, lines 9-11; column 4, lines 26-34).

Differences between the prior art
and the claimed invention

Webb does not disclose (1) "automatically inputting information" from a mileage sensor of the vehicle, and (2) "a calibration system operable to calibrate the computerized information processing system with an odometer of the vehicle."

Fogg and Whitaker do not disclose (1) a "menu-driven input," (2) recording "vehicle operating expenses," (3) recording "non-vehicular information including travel expenses," and (4) "transfer circuitry."

Gulas does not disclose (1) "menu-driven input," (2) recording "non-vehicular information including travel expenses," (3) "transfer circuitry," and (4) "a calibration system."

Level of ordinary skill in the art

The level of ordinary skill is not argued, so we find the references to be representative of the level of skill in the art. See In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (the Board did not err in adopting the approach that the level of skill in the art was best determined by the references of record). Cf. Chore-Time Equipment Inc. v. Cumberland Corp., 713 F.2d 774, 779 n.2, 218 USPQ 673, 676 n.2 (Fed. Cir. 1983) ("We hold only that an invention may be held to have been either obvious (or nonobvious) without a specific finding of a particular level of skill . . . where, as here, the prior art itself reflects an appropriate level and a need for such expert testimony has not been shown."). Those of ordinary skill in the art must also be presumed to know something about the art apart from what the references expressly disclose. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

Objective evidence of nonobviousness

There is no objective evidence of nonobviousness in the record.

Obviousness

The exact alignment of references (which reference is being modified) is not important. See In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961). The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

It would have been obvious to one of ordinary skill in the art to modify Webb to provide "automatically inputting information" from a mileage sensor of the vehicle in view of the teachings of Fogg, Whitaker, and Gulas to allow more accurate inputting of mileage information. It would have been obvious to provide a "calibration system operable to calibrate the computerized information processing system with an odometer of the vehicle" with such an automatic mileage input system given the teaching of calibration systems in Fogg and Whitaker.

Alternatively, it would have been obvious to one of ordinary skill in the art to modify Fogg or Whitaker to provide a "menu-driven input" and recording of "vehicle operating expenses" and "non-vehicular information including travel expenses" in view of the teachings of menus and recording of such information for expense account purposes in Webb and in view of the teaching of recording vehicle operating expenses in Gulas (cost and amount of gasoline purchases at column 4, lines 35-41). It would further have been obvious to provide circuitry for transferring information from the devices of Fogg and

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Whitaker to an external computer in view of the teaching in Webb at column 1, lines 34-37, because that would allow working on the data outside the vehicle and would allow the main program to be on the external computer. The transfer circuitry does not have to be a cable as shown in appellants' figure 1. Webb discloses that "[d]ata can be provided to a disc memory" (column 1, line 68), which would permit the disc to be taken to another computer.

CONCLUSION

The rejections of claims 15-19, 26-27, and 31 are reversed.

A new ground of rejection is entered against claim 15 pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED | § 1.196(b)

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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