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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AAMP OF AMERICA
Patent Owner and Appellant

Appeal 2019-004850
Reexamination Control 90/013,998
United States Patent US 8,014,540 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and KRISTEN L. DROESCH, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. §§ 134 and 306 the Examiner's decision to reject claims 1–16. We have jurisdiction under 35 U.S.C. §§ 134 and 306, and we heard the appeal on August 21, 2018. We reverse.

STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed on August 18, 2017 of United States Patent 8,014,540 ("the '540 patent"), issued to Riggs on September 6, 2011.

The '540 patent describes an interface device for interconnecting fixed controls of a vehicle to a replacement stereo. The interface device can receive control signals from fixed controls, such as steering wheel controls, and then transmit corresponding control signals to the replacement stereo. *See generally* Abstract. Claim 1 is illustrative of the invention and is reproduced below:

1. An aftermarket stereo control interface device adapted to be installed in a vehicle and to facilitate communication between a local stereo control configured to produce signals in a first format and a stereo receiver configured to receive signals in a second format, the aftermarket stereo control interface device comprising:

a receiver adapted to receive at least one input signal, the at least one input signal comprising a control signal in the first format configured to control the stereo receiver;

[1] Appellant identifies the real party in interest as AAMP of Florida, Inc. App. Br. 2.

a transmitter adapted to produce and broadcast to the stereo receiver an output signal in the second format, the output signal being based on the input signal; and

a memory;

wherein:

the local stereo control is mounted in the vehicle at a location remote from the stereo receiver;

the aftermarket stereo control interface device translates signals in the first format to signals in the second format so that the local stereo control can be operated to control the operation of the stereo receiver via the aftermarket stereo control interlace, and the aftermarket stereo control interface is programmable to store in the memory output signals corresponding to the local stereo control such that subsequent activation of the local stereo control results in the aftermarket stereo control interface recalling from the memory at least one output signal corresponding to the local stereo control and wherein the stereo receiver is an after-market stereo receiver and wherein the aftermarket stereo control interface is programmable so that the interface can be adapted for use with a plurality of different types of aftermarket stereo receivers.

RELATED PROCEEDINGS

This appeal is said to be related to various proceedings. First, the '540 patent is a continuation of U.S. Application No. 11/181,601, filed July 13, 2005 that is a continuation of Application No. 09/442,627, filed November 17, 1999 ("'627 application"), that issued as U.S. Patent 6,956,952 ("'952 patent"), and its corresponding provisional Application No. 60/108,711 filed November 17, 1998 ("'711 provisional application"). App. Br. 2.

The '540 patent was the subject of another *ex parte* reexamination proceeding (90/012,739) that was denied. *Id.* 3.

The '540 patent is also related to U.S. Patent 8,184,825 B1 ("'825 patent") that shares a common ancestor with the '540 patent, namely the '952 patent. *Id.* The '825 patent was the subject of an *ex parte* reexamination proceeding (No. 90/013,891) where we affirmed the Examiner's decision to reject the claims based on prior art that included the Daly reference—the very reference at issue here. *See Ex parte AAMP of America*, No. 2018-006347 (PTAB Aug. 27, 2018) ("Bd. Dec."). That decision is on appeal before the U.S. Court of Appeals for the Federal Circuit. App. Br. 3.

The '540 patent is also related to U.S. Patent 9,165,593 ("'593 patent") that was the subject of an *inter partes* review proceeding (IPR2016-00061) that was terminated. *Id.*

THE REJECTIONS

The Examiner rejected claims 1, 5, 6, 8, 9, 13, 14, and 16 under 35 U.S.C. § 102(e) as anticipated by Daly (US 2011/0046788 A1; published Feb. 24, 2011; filed Aug. 21, 2009). Ans. 3–9.[2]

The Examiner rejected claims 2–4 and 10–12 under 35 U.S.C. § 103 as unpatentable over Daly and either Yaroch (US 5,790,065; issued Aug. 4, 1998) or Barreira (US 5,515,345; issued May 7, 1996). Ans. 9–10.

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[2] Throughout this opinion, we refer to (1) the Appeal Brief filed February 14, 2019 ("App. Br."); (2) the Examiner's Answer mailed April 10, 2019 ("Ans."); and (3) the Reply Brief filed June 7, 2019 ("Reply Br.").

The Examiner rejected claims 7 and 15 under 35 U.S.C. § 103 as unpatentable over Daly and Ase (US 6,225,584 Bl; issued May 1, 2001). Ans. 10–11.

THE ANTICIPATION REJECTION

The Examiner finds that Daly discloses a stereo control interface device with every recited element of the independent claims, including a transmitter adapted to produce and broadcast to a stereo receiver an output signal in a second format, where the output signal is based on the input signal ("the second format limitation") recited in independent claim 1, and similar limitations in independent claim 9. Ans. 3–9.

Appellant does not dispute these findings, but rather contends that Daly does not qualify as prior art to the '540 patent because the '540 patent's priority date, namely the November 17, 1999 filing date of its grandparent '627 application and corresponding '952 patent, predates Daly's filing date. *See* App. Br. 11–29; Reply Br. 2–5. According to Appellant, the '540 patent's claimed invention is entitled to the 1999 filing date because, among other things, the '952 patent supports wired embodiments expressly, and record evidence—including Daly—shows that ordinarily skilled artisans understood the '952 patent's disclosure conveyed the recited subject matter, including the second format limitation, to show possession of that subject matter. *See* App. Br. 11–29.

Appellant further contends that not only do broadening statements in the written descriptions of the '952 and '540 patents inherently teach hardwired outputs, but record evidence shows the only two viable

possibilities taught by the '952 patent's broadening statement are wired and infrared (IR) wireless implementations. App. Br. 11–20. Appellant adds that although the '711 provisional application required equipping an aftermarket stereo with an infrared remote control, this requirement was deleted in the '952 patent's disclosure. App. Br. 19–22. According to Appellant, the '952 and '540 patents—unlike the '711 provisional application—refers to wireless transmission as merely one embodiment and, therefore, is not so limited. App. Br. 20–22.

ISSUE

Did the Examiner err in relying on Daly in rejecting claims 1, 5, 6, 8, 9, 13, 14, and 16 under § 102? This issue turns on whether Daly qualifies as prior art to the '540 patent.

ANALYSIS

The '540 patent that is the subject of the present reexamination proceeding issued from U.S. Application 12/605,950, filed October 26, 2009 ("'950 application"), which is a continuation of U.S. Application 11/181,601, filed July 13, 2005 ("'601 application"), which is a continuation of U.S. Application 09/442,627, filed November 17, 1999, the latter application claiming priority to U.S. Provisional Application 60/108,711, filed November 17, 1998. '540 patent, col. 1, ll. 7–12.

The Daly reference is a U.S. application that published on February 24, 2011, but was filed on August 21, 2009, which is *before* the '950

application's filing date. Daly's filing date, however, is *after* the filing dates of all other applications in the '540 patent's priority chain.

Turning to the '540 patent's claim 1, we note a significant difference in the relevant claim language at issue here compared to the claims at issue in earlier related proceedings. Notably, the claims at issue in our earlier decision involving the related '825 patent *explicitly* called for, among other things, a stereo control interface device adapted to (1) produce output signals in a second format, and (2) transmit the output signals *via hardwire connection* to a replacement aftermarket stereo receiver. *See* Bd. Dec. 2–3 (emphasizing the hardwire connection clause when reproducing the '825 patent's claim 1). A similar explicit hardwire connection clause was in the claims at issue before another panel of this Board in an *inter partes* review proceeding of the related '593 patent. *See Automotive Data Solutions, Inc. v. AAMP of Florida, Inc.*, IPR2016-00061 (PTAB May 13, 2016) ("'061 IPR"), at 4 (reproducing the '593 patent's claim 1).

But the '540 patent's claim 1 has no hardwire connection clause. Rather, the claim recites, in pertinent part, (1) a transmitter adapted to produce and broadcast to a stereo receiver *an output signal in a second format*, where the output signal is based on an input signal comprising a control signal in a first format configured to control the stereo receiver, and (2) the aftermarket stereo control interface *translates signals in the first format to signals in the second format* so that the local stereo control can be operated to control the stereo receiver's operation via the interface. Our emphasis underscores that instead of transmitting the output signal to the stereo receiver via a hardwire connection as in the related patents, the '540

patent's claim 1 merely recites that the transmitter can produce and broadcast an output signal *in a second format* that resulted from the recited first-to-second format translation.

This functionality is supported by the '540 patent's grandparent '627 application that best reflects the corresponding '952 patent's disclosure as originally filed. In the "Summary of the Invention" section, the '627 application explains that the disclosed stereo control interface device

> is adapted to receive signals from local stereo control devices located at positions within a vehicle that are remote from the stereo control unit or receiver and then *produce output signals which can be provided to a replacement stereo unit* so that the device will *translate the signal from the existing local stereo control device into a format which can be used to change the function of the replacement stereo* in the same manner that manipulation of the local controls would change the original stereo.

'627 Appl'n 3–4 (emphases added). The '627 application further explains that, in one embodiment,

> the local stereo control switches provide a signal to the interface device *via hardwiring* and the interface is adapted to receive the signal and *then produce a corresponding wireless signal that is transmitted to a wireless receiver on the after-market replacement stereo control unit* such that manipulation of the local stereo controls results in a corresponding control signal being sent to the after-market replacement stereo.

Id. 4 (emphases added).

This disclosed functionality in the '627 application amply supports the second format limitation in the '540 patent's claim 1. Although this disclosed transmission of *wireless* signals is dispositive

of this appeal, we nonetheless reiterate our finding from our decision involving a similar issue with respect to the '825 patent, namely that "despite the '627 application disclosing a wired connection on the interface circuit's *input*, there is no disclosure of a wired connection on its *output to the replacement stereo*—only a wireless connection." Bd. Dec. 8 (emphasis in original). We reached this finding, as did the Board in the related *inter partes* review proceeding, even if a wired connection on the output to the stereo receiver in the '627 application would have been obvious, for it is well settled that obviousness is insufficient to show written description support. *See id.* 9–10 (citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc)). *Accord* '061 IPR at 13 (noting this point). Rather than repeat our detailed analysis of the '627 application here, we incorporate our associated findings regarding the '627 application and its underlying '711 provisional application on pages 7 to 14 of our earlier decision here by reference. *See* Bd. Dec. 7–14.

As we indicated in the related Board decision, the fact that the '627 application on page 14, lines 1 to 6 states that the interface circuit 110's exact configuration can vary depending on the configuration of the vehicle and replacement stereo receiver does not change our conclusion in this regard. Bd. Dec. 9. Even assuming, without deciding, that the purported intent of this statement was that the interface could act with a wired connection as was tested (but not

sold) as the inventor, Mr. Riggs, declares,[3] ordinarily skilled artisans would nevertheless have to somehow draw such an inference from the broad and general statements in the above-noted passage from the '627 application which, when read in the context of that disclosure, falls short of showing possession in that regard. That is, even assuming, without deciding, that ordinarily skilled artisans could somehow infer an intention to use a wired connection from the broad and general statements in this passage, such an intention would have, at best, been obvious from that passage. But that is still insufficient to show possession of that feature, for obviousness does not satisfy the written description requirement as noted above. *Accord* Bd. Dec. 9–10 (noting this point).

Nevertheless, the above-noted disclosed *wireless* transmission functionality in the '627 application amply supports the second format limitation in the '540 patent's claim 1. We reach this finding noting that nothing in the claim nor the disclosure as originally filed in the '627 application precludes translating signals from a first *wireless* format to a second *wireless* format, particularly in view of the recited wireless input signal in the '540 patent's dependent claims 2 and 10 and associated disclosure in Figures 3 and 4A, and page 12 of the '627 application.

For the foregoing reasons, then, the '540 patent's claim 1 is supported by the '627 application and, therefore, predates Daly's

[3] *See Declaration of Brett D. Riggs Under 37 CFR 1.132*, dated Mar. 19, 2018 ("Riggs. Decl.").

filing date. Because Daly does not qualify as prior art to the '540 patent's claim 1, the Examiner's anticipation rejection of that claim is erroneous.

Therefore, the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 9 that recites commensurate limitations; and (3) dependent claims 5, 6, 8, 13, 14, and 16 for similar reasons. Because this issue is dispositive regarding our reversing the Examiner's rejection of these claims, we need not address Appellant's other associated arguments.

THE OBVIOUSNESS REJECTIONS

Because the Examiner's obviousness rejections of dependent claims 2–4, 7, 10–12, and 15 rely on the disqualified Daly reference, the Examiner's obviousness rejections of these claims are likewise erroneous.

CONCLUSION

The Examiner erred in rejecting (1) claims 1, 5, 6, 8, 9, 13, 14, and 16 under § 102, and (2) claims 2–4, 7, 10–12, and 15 under § 103.

DECISION

The Examiner's decision to reject claims 1–16 is reversed.

REVERSED

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