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Commissioner's Decision #1553

Décision du Commissaire #1553

Date: 2020-12-23

TOPIC: O00 Obviousness

SUJET: O00 Évidence

Application No. : 2,845,954

Demande n° 2 845 954

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,845,954 having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019 (“the *former Patent Rules*”), has consequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to allow the application.

Agent for the Applicant:

CPST INTELLECTUAL PROPERTY INC.

Brookfield Place
181 Bay St., Suite 2425 Toronto, Ontario
M5J 2T3

INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,845,954 (“the instant application”), which is entitled “REMOTE START CONTROL SYSTEM FOR A VEHICLE WITH A BUS CONTROLLABLE TRANSMISSION AND ASSOCIATED METHODS” and is owned by Omega Patents L.L.C. (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 199(3)(c) of the *Patent Rules*. As explained in more detail below, the Board’s recommendation is that the Commissioner of Patents allow the application.

BACKGROUND

The Application

- [2] The instant application has a filing date of March 14, 2014. It was laid open to public inspection on September 14, 2014.
- [3] The instant application relates generally to remote vehicle starting devices and methods. The application has 28 claims as of the date of the Final Action (“FA”). These were received at the Patent Office on March 14, 2014.

Prosecution History

- [4] On June 5, 2018, an FA was written pursuant to subsection 30(4) of the *former Patent Rules*. The FA stated that the instant application was defective because all of the claims on file were obvious and therefore did not comply with section 28.3 of the *Patent Act*.
- [5] In a September 20, 2018 response to the FA (“R-FA”), the Applicant submitted arguments in favour of the patentability of the claims on file.
- [6] As the Examiner still considered the application not to comply with the *Patent Act*, pursuant to paragraph 30(6)(c) of the *former Patent Rules*, the application was forwarded to the Board for review on November 29, 2018 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR set out the position that the specification on file was still considered to be defective.

- [7] In a letter dated February 1, 2019, the Board forwarded to the Applicant a copy of the SOR and requested that the Applicant confirm its continued interest in having the application reviewed.
- [8] In a letter dated April 26, 2019, the Applicant confirmed its interest in having the review proceed.
- [9] A Panel of the Board (“The Panel”) comprised of the undersigned members reviewed the instant application under paragraph 199(3)(c) of the *Patent Rules*.

ISSUE

- [10] The sole issue to be addressed by the present review is whether the claims on file are directed to subject matter which is non-obvious according to section 28.3 of the *Patent Act*.

LEGAL PRINCIPLES

Purposive Construction

- [11] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52).

Obviousness

- [12] Section 28.3 of the *Patent Act* requires claimed subject-matter not to be obvious:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere;
and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere

[13] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at para 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow a four-step approach. Below we consider the claims according to that approach.

ANALYSIS

(1)(a) Identify the notional “person skilled in the art”

[14] The FA defined the skilled person thus:

The skilled person is skilled in the fields of computer/software engineering and automobile electronic control systems.

[15] The Applicant did not dispute this definition in the R-FA and we adopt it.

(1)(b) Identify the relevant common general knowledge (CGK) of that person

[16] The FA cited the following prior art:

D1: US20030214392A1 November 20, 2003 Flick

D2: 2012 Chevy Volt Manual, available at:

https://my.chevrolet.com/content/dam/gmownercenter/gmna/dynamic/manuals/2012/chevrolet/volt/2012_chevrolet_volt_owners.pdf

D3: 2012 Honda Civic Remote Engine Start System II User's Information Manual, available at:<https://owners.honda.com/Linked-Content/PDF/RemoteEnginestarter.pdf>

D4: 2012 Honda Civic Sedan Owner's Manual, available at:

<http://techinfo.honda.com/rjanisis/pubs/OM/R01212/R01212OM.PDF>

[17] In our view, D2-D4 indicate that remote starting of vehicles is CGK and that the need for a vehicle transmission to be disengaged when starting is CGK.

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[18] We will consider the independent claims 1, 13 and 22 first. These claims are directed to a system, controller and method, respectively. All recite the same elements; therefore we may consider claim 1 as representative. We consider the combination of all the elements of claim 1 to define the inventive concept, and the meaning of terms is clear. In this case, a detailed purposive construction analysis is not required. Claim 1 reads:

A remote start control system for a vehicle comprising a data communications bus extending through the vehicle, an engine, a transmission associated with the engine and having a selectable disengaged position based upon a disengage transmission position command on the data communications bus, and a vehicle climate control system operable based upon a climate control command on the data communications bus, the remote start control system comprising:

a remote start transmitter remote from the vehicle and configured to generate a remote start signal; and

a vehicle remote start controller at the vehicle and comprising

a receiver configured to receive the remote start signal from said remote start transmitter, and

at least one processor cooperating with said receiver and configured to, in response to the remote start signal,

generate the disengage transmission position command on the data

communications bus to select the disengaged position for the transmission, generate the climate control command on the data communications bus to operate the climate control system, and

start the engine.

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed

[19] In our view, D1 is the closest prior art. With respect to claim 1 above, D1 discloses:

- a remote start control system for a vehicle comprising a data communications bus extending through the vehicle, an engine, a transmission associated with the engine [abstract];
- having a selectable disengaged position based upon a disengage transmission position command on the data communications bus [para 0051];
- a vehicle climate control system operable based upon a climate control command on the data communications bus [para 0012];
- a remote start transmitter remote from the vehicle and configured to generate a remote start signal [Fig. 1, label 34];
- a vehicle remote start controller at the vehicle [Fig. 1, label 21];
- a receiver configured to receive the remote start signal from said remote start transmitter [Fig. 1, label 32];
- at least one processor cooperating with said receiver and configured to, in response to the remote start signal [Fig. 1, label 25];
- generate the climate control command on the data communications bus to operate the climate control system [para 0012]; and
- start the engine [para 0039].

[20] Although D1 discloses a transmission controller [Fig. 1, label 45c, para 0051] and notes that the engine may be prevented from starting if the gearshift lever is in or moved to a position other than Park [para 0039], D1 does not disclose the element of “generate the disengage transmission position command on the data communications bus to select the disengaged position for the transmission”.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[21] The FA took the position that an onboard electronic controller for the transmission exists, and that internal vehicle control bus commands exist for such a controller

to operate the transmission. The FA also stated that the skilled person would know that the transmission must be disengaged for the vehicle to start, and that it would be CGK for the remote starter to cause the issuing of such a command to actively disengage the transmission if it is engaged, when attempting to start the vehicle remotely. We note that the prior art does not show any prior existence of an over-the-air command to control a transmission, only the prior existence of an internal vehicle bus command. In our view, the existence of many possible internal commands that *could* be issued by a remote starting system does not mean that the skilled person invariably *would* use a remote command to cause the disengagement of the transmission without the exercise of at least a scintilla of invention. The prior art of record supports the condition of not being able to start the vehicle remotely if the transmission is engaged, but does not disclose actively changing the situation by remotely disengaging the transmission.

- [22] Therefore, in our view, claim 1 is not obvious and complies with section 28.3 of the *Patent Act*. Independent claims 13 and 22 also are not obvious as they recite the same inventive element of actively disengaging the transmission by remote command.
- [23] The dependent claims are also not obvious as they depend on non-obvious claims 1, 13 and 22.

CONCLUSION AND RECOMMENDATION OF THE BOARD

[24] For the reasons set out above, we are of the view that the rejection is not justified on the basis of the defect indicated in the Final Action notice and we have reasonable grounds to believe that the instant application complies with the *Patent Act* and the *Patent Rules*. We recommend that the Applicant be notified in accordance with subsection 86(10) of the *Patent Rules* that the rejection of the instant application is withdrawn and that the instant application has been found allowable.

Howard Sandler

Member

Alison Canteenwalla

Member

Mara Gravelle

Member

DECISION OF THE COMMISSIONER

[25] I concur with the findings and the recommendation of the Board. In accordance with subsection 86(10) of the *Patent Rules*, I hereby notify the Applicant that the rejection of the instant application is withdrawn, the instant application has been found allowable, and I will direct my officials to issue a Notice of Allowance in due course.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec
this 23rd day of December 2020