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90/013,587	09/14/2015	8032278	C13-03895	8867

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EXAMINER

GRAHAM, MATTHEW C

ART UNIT	PAPER NUMBER
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3993

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Geotab Exhibit 1010
Geotab v. Omega



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/013,587.

PATENT NO. 8032278.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/013,587	Patent Under Reexamination 8032278	
	Examiner MATTHEW C. GRAHAM	Art Unit 3993	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a. ☒ Responsive to the communication(s) filed on 1/8/2016, 2/26/2016 and 3/8/2016.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- b. ☐ This action is made FINAL.
- c. ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. ☐ Notice of References Cited by Examiner, PTO-892. | 3. ☐ Interview Summary, PTO-474. |
| 2. ☒ Information Disclosure Statement, PTO/SB/08. | 4. ☐ ____. |

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 1-22 are subject to reexamination.
- 1b. ☐ Claims ____ are not subject to reexamination.
2. ☐ Claims ____ have been canceled in the present reexamination proceeding.
3. ☐ Claims ____ are patentable and/or confirmed.
4. ☒ Claims 1-22 are rejected.
5. ☐ Claims ____ are objected to.
6. ☐ The drawings, filed on ____ are acceptable.
7. ☐ The proposed drawing correction, filed on ____ has been (7a) ☐ approved (7b) ☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
1 ☐ been received.
2 ☐ not been received.
3 ☐ been filed in Application No. ____.
4 ☐ been filed in reexamination Control No. ____.
5 ☐ been received by the International Bureau in PCT application No. ____.
- * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: ____

cc: Requester (if third party requester)

NON-FINAL REJECTION

1. Receipt is acknowledged of the Patent Owner's Statement on 1/08/2016 and the Third Party Requester's Response on 3/8/2016.

2. The Flick '278 Patent is a continuation in part of application 11/076,259. This parent application did not disclose nor claim the multi-vehicle capability and the bus extending throughout the vehicle as described and claimed in Flick '278. Accordingly, the earliest effective filing date for Flick '278 is July, 3, 2007.

3. A substantial new question of patentability affecting claims 1-22 of United States Patent Number 8,032,278 to Flick is raised by the requester in the response of 3/8/2016 for *ex parte* reexamination.

In light of the Patent Owner's Response of 1/8/2016, the requester contends that the following US Patents and Patent Publication raise a substantial new question of patentability:

- A. U.S. Patent No. 6,009,363 to Beckert et al. (Beckert);
- B. U.S. Patent No. 7,484,008 to Gelvin et al. (Gelvin);
- C. U.S. Publication No. 2001/0033225 to Razavi et al. (Razavi).

a.) Beckert teaches a multi-vehicle compatible tracking unit in the form of a vehicle computer system (see col. 2, lines 10-17), which is for a vehicle comprising a vehicle data bus extending throughout the vehicle (see col. 1, lines 32 – 38);

a vehicle position determining device in the form of a GPS chipset (see col. 6, lines 50-53, and FIG. 3); a wireless communications device in the form of a wireless Internet link 76 (see col. 5, lines 9 - 12, and FIGS. 1 and 3);

a multi-vehicle compatible controller in the form of the computer module 65 for cooperating with said vehicle position determining device and said wireless communications device to send vehicle position information (see col. 5, lines 9 - 12);

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles (see col. 1, lines 32 – 35); and

multiple different types of downloading interfaces (see col. 5, lines 1 - 12) for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller (see col. 2, lines 15-17).

b.) Gelvin teaches a multi-vehicle compatible tracking unit in the form of the WINS vehicle internetwork architecture (see FIG 30), which is for a vehicle comprising a vehicle data bus extending throughout the vehicle (see Fig. 3; col. 1, lines 49 - 54; col. 8, lines 51 - 53 and col. 8, lines 63 - 67 – col. 9, lines 1 - 7);

a vehicle position determining device in the form of a GPS device a wireless communications device in the form of cellular modems (see Fig. 3; col. 9, lines 1 -4);

a multi-vehicle compatible controller in the form of the gateway 302 for cooperating with said vehicle position determining device (see Fig. 3; col. 8, lines 46-48; col. 8- lines 51 -53; col. 18, lines 23- 31; col. 18, lines 57 - 60) and said wireless

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communications device to send vehicle position information (see col. 9, lines 1 - 4, col. 18, lines 57 - 60, and col. 31, lines 43 - 47);

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication see with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles (see Fig. 3; col. 8, lines 63 - 67- col. 9, lines 1 - 7); and

multiple different types of downloading interfaces (see col. 7, lines 1 - 4) for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multivehicle compatible controller (see col. 23, line 64 - col. 24, line 4).

c.) Razavi teaches a multi-vehicle compatible tracking unit in the form of an in-car sub-network (see the Abstract and Fig. 2) which is for a vehicle comprising a vehicle data bus extending throughout the vehicle and interfaced via OBD and/or SAE standard J1979 and/or J1850 buses (see paragraph [0024]); a vehicle position determining device in the form of a GPS receiver (see paragraph [0031]);

a wireless communications device in the form of a wireless modem, a cellular phone, and/or wireless Ethernet; a multi-vehicle compatible controller in the form of a computer platform within the in- car sub-network for cooperating with said vehicle position determining device (see paragraph [0033]) and said wireless communications device to send vehicle position information;

said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles (see paragraph [0037]); and

multiple different types of downloading interfaces (see paragraph [0060]) for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller (see the disclosure regarding downloading vehicle upgrades that result in different device codes being received via devices including a wireless modem in paragraph [0060]).

Accordingly Beckert, Gelvin and Razavi each teach a vehicle computer system including a wireless communications device, a vehicle location determination device, a downloading interface, and a controller capable of communicating with a variety of vehicle devices.

There is a substantial likelihood that a reasonable examiner would have considered these teachings in Beckert, Gelvin and Razavi to be important in the determination of patentability of claims 1-22 of Flick '278. Accordingly, Beckert, Gelvin and Razavi each raises a substantial new question of patentability, which question has not been previously raised.

4. The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-22 are rejected under pre-AIA 35 U.S.C. 102(b) as being anticipated by Suman.

Suman discloses a multi-vehicle compatible tracking unit for a vehicle comprising a data bus, such as a multiplex bus. See col. 8, line 58-col. 9, line 16; Figs. 3, 5, 44, 45; see also col. 36, line 53-col. 37, line 17. This bus extends throughout the vehicle to the broad degree claimed. Suman notes that the multiplexing scheme for such a bus is set forth in SAE J1850. Suman further discloses a GPS or DGPS as a vehicle position determining device. See, Figs. 3, 5. Suman also discloses a transmitter (see Figs. 1a, 1b, 2; col. 3, lines 1-3; col. 7, lines 26-30) and a receiver (see Figs. 1b, 3, 44; col. 3, lines 1-3; col. 7, lines 31-34) for wirelessly receiving signals from the transmitter. In one embodiment the receiver is a cell phone (and thus also includes a transmitter) coupled to the vehicle bus. See Figs. 5, 45; col. 36, line 53- col. 37, line 17. Suman also shows a controller that cooperates with the GPS device and the wireless communication device to send vehicle position information. See col. 2 lines 3-10; see also col. 6, lines 19-49; col. 11, lines 8-13; col. 12, lines 7-13; col. 14, lines 11-21. Suman discloses that the controller is coupled to the vehicle data bus for communication with at least one vehicle device, using a corresponding vehicle device code, from among a plurality of codes for different vehicles. As the device uses different vehicle codes for different vehicles it is thus multi-vehicle compatible. The devices include sensors and controls for doors, windows, ignition, speedometer, RPMs, fuel level, turn signals, lights, gears,

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temperature, oil pressure, defroster, headlights, etc.). See Figs. 3, 5, 44, 45, 47; see also col. 43, lines 27-47. As noted in col. 37, lines 15 - 17: "The multiplexing scheme is set forth in SAE standard J1850 and is universally used in the automotive industry." It is also inherent that the J1850 bus described in the Suman '537 patent is included in a variety of different makes and models of vehicles per the federally mandated standard.

Suman notes in col. 36, lines 31-52: "To achieve these aspects and other advantages, the vehicle accessory control system of the present invention includes a plurality of electrically-operated vehicle accessories, a receiver to be mounted in a vehicle for receiving RF signals from a land-based transmitter, and a control circuit coupled to the receiver and to the vehicle accessories for controlling the operation of the vehicle accessories in accordance with a control program. The RF signals include an address uniquely identifying the vehicle and a reprogramming signal for reprogramming the operation of at least one of the vehicle accessories. The control circuit includes an input interface for receiving information regarding a plurality of sensed conditions, control means for controlling the operation of the vehicle accessories in accordance with the control program and in response to sensed conditions received from the input interface. The control circuit further includes reprogramming means for selectively reprogramming the control program in response to the detection of an RF signal including an address identifying the vehicle and the reprogramming signal, to selectively change the manner in which the control means controls the operation of at least one of the vehicle accessories."

Regarding claim 2, Suman discloses that the cellular phone could be connected through the vehicle bus, or a wired RS-232 serial connection of the controller, and thus the RS-232 connector provides an additional wired connection. See col. 42, line 52 - col. 43, line 6,

Regarding claim 3, it is inherent that a cellular telephone connected to a RS-232 serial port can be connected and disconnected.

Regarding claim 4, Suman teaches a wireless signal download interface-- see col. 36, lines 31-52.

Regarding claim 5, cellular and paging systems can inherently temporarily connect to the network to connect to a "downloading device".

Regarding claim 6, Suman teaches at col. 37, lines 1 - 17: "Microcontroller 735 includes an integral non-volatile memory for retaining data when the vehicle is not in operation. In vehicles including a single wire multiplex bus 742, an output terminal 743 of microcontroller 735 is coupled to the input of a multiplex communication circuit 744 comprising a 728 pin integrated circuit which is coupled by output conductor 747 to a single wire data bus 742. The average data rate for the multiplex circuit 744 is 10.4 kilobits per second. Microcontroller 735 communicates with circuit 744 through its SPI serial interface port 743. When circuit 744 receives a message over the bus 742, it interrupts the microprocessor, which in turn initiates communication with the circuit through its SPI port. Microprocessor 735 then reads the data from the SPI register and acts upon the information. The multiplexing scheme is set forth in SAE standard 11850 and is universally used in the automotive industry."

Regarding claim 7, Suman teaches that the vehicle code is for writing to the vehicle in that the system allows for personalization.

Regarding claim 8, Suman teaches reprogramming. See col. 44, lines 7 – 16. "Referring to FIG. 48A during system initialization, microcontroller 735 begins the execution of the main control program by clearing its RAM, recalling the last user ID by reading the same from the non-volatile memory, and reading a flag table associated with the last ID (step 1201). Initially, the associated flag table may be set in the factory or by the dealer to specify default values. As described below, the flags in the flag table may subsequently be modified by a reprogramming signal included in either a paging signal or a cellular RF control signal having the vehicle's ID." Suman also notes that to "achieve these aspects and other advantages, the vehicle accessory control system of the present invention includes a plurality of electrically-operated vehicle accessories, a receiver to be mounted in a vehicle for receiving RF signals from a land-based transmitter, and a control circuit coupled to the receiver and to the vehicle accessories for controlling the operation of the vehicle accessories in accordance with a control program. The RF signals include an address uniquely identifying the vehicle and a reprogramming signal for reprogramming the operation of at least one of the vehicle accessories. The control circuit includes an input interface for receiving information regarding a plurality of sensed conditions, control means for controlling the operation of the vehicle accessories in accordance with the control program and in response to sensed conditions received from the input interface. The control circuit further includes reprogramming means for selectively reprogramming the control program in response to

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the detection of an RF signal including an address identifying the vehicle and the reprogramming signal, to selectively change the manner in which the control means controls the operation of at least one of the vehicle accessories." See col. 36, lines 31-52.

Regarding claims 9-10, Suman teaches a remote control function that includes a security function. "It is an additional aspect of the present invention to provide a system allowing for remote control of vehicle functions and accessories using an RF signal. Thus, vehicle owners may lock their vehicle doors, roll up their windows, or activate an alarm system from any location in response to an RF signal. Further, the vehicle owner may use the system of the present invention to immobilize a vehicle to insure safe storage of the vehicle." See col. 2, lines 24 -32.

Regarding claim 11, Suman teaches at col. 9, line 65 - col. 10, line 4: "In addition, the vehicle communication and control system includes a navigation module 38 coupled to a suitable receiving antenna 40. In the preferred embodiment, module 38 is a commercially-available GPS module of the type manufactured by a number of suppliers including Motorola, Inc., Trimble Navigation, Ltd., or the like."

Regarding claim 12, the various components are housed within the vehicle.

Regarding claim 13, note the above discussions of claim 1, 3 and 5.

Regarding claims 14-15, note the above discussions of claims 6 and 7.

Regarding claims 16-17, note the above discussion of claims 8 and 9.

Regarding claim 18-22, note the previous discussion of claims 1-8.

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6. The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-22 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Spaur in view of Johnson.

Spaur teaches a vehicle data bus 46 and teaches that a wireless communications device can be utilized to download enabling data in a variety of forms including received information associated with vehicle devices and executable software downloaded from a remote site: "since bi-directional communications involving a vehicle are conducted wirelessly for at least a portion of the communications link, it is necessary for the Internet to communicate with an appropriate interface or network that wirelessly links with the vehicle. In one embodiment, the cellular digitized packet data (CDPD) network provides the desired link including arrangement of information being communicated and where the destination site, namely the particular vehicle, is found in the network." (See col. 2, lines 37 - 46).

Spaur also notes that a "combination of controller related components are containable in a vehicle for responding to requests from remote sites, obtaining and storing information associated with vehicle devices and running executable software that may be available in the program memory of the controller or downloaded from the remote site, while handling and configuring information including data that is

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communicative with the remote site over an established network, such as the Internet."

(See col. 4, line 64 - col. 5, line 5).

Furthermore, Spaur teaches that "the controller in the vehicle is also associated with an interface for communication with one or more available systems, such as an RS232 connection, an Ethernet connection and/or a PCMCIA unit. In a related embodiment, the controller includes a direct communications port for receiving and sending information without requiring the wireless device and the Internet connection to the wireless device." (See col. 4, lines 38 - 45).

The claimed invention differs only in the use of the location detection.

Johnson teaches that the "vehicle 200 is further equipped with a GPS receiver unit (internal to the control and communications unit 201) which is connected to a GPS antenna 220. The GPS receiver unit is a multi-channel GPS receiver and can thus receive time and location signals from multiple GPS satellites simultaneously." (See col. 4, lines 51 - 56).

It would have been obvious to one of ordinary skill in the art to have incorporated the global positioning system receiver in the system of Spaur in view of the teachings of Johnson in order to incorporate location determination capabilities into the controller of Spaur in those vehicles that do not have a global positioning system receiver incorporated into the vehicle.

A complete listing of how Spaur and Johnson relates to claims 1-22 is included in the request (Exhibit F) and is hereby incorporated by reference.

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8. Claims 1-22 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Spaur in view of Song.

Note the previous discussion of Spaur.

The claimed invention differs only in the use of the location detection.

Song teaches "an inexpensive, accurate system for determining a vehicle's location using the existing base stations and signals of a cellular telephone network." (See, col. 2, lines 57 - 60).

It would have been obvious to one of ordinary skill in the art to have incorporated the global positioning system receiver in the system of Spaur in view of the teachings of Song in order to incorporate location determination capabilities into the controller of Spaur using cellular capabilities as taught by Song.

A complete listing of how Spaur and Johnson relates to claims 1-22 is included in the request (Exhibit E) and is hereby incorporated by reference.

9. Claims 1-22 are rejected under pre-AIA 35 U.S.C. 102(b) as being anticipated by Beckert.

Note the above discussion of Beckert in paragraph 3.

A complete listing of how Beckert relates to claims 1-22 is included in the response by the Third Party Requester on 3/8/2016 and is hereby incorporated by reference.

10. The background litigation supplied by the Patent Owner is noted. Patent Owner contends that Suman was considered by the examiner in the patent at hand. However, this is incorrect. Suman was not cited or considered in the '278 patent even

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though it was cited in previous and copending patent applications. The comments filed by the third party requester on 3/8/2016 are correct. There is no record that the examiner considered Suman. As to Johnson, again the Patent Owner contends that it was considered by the examiner during the original prosecution. Again, this is incorrect. A family member of Johnson was cited in a family member of the '278 patent. Johnson was never cited in the application that became the '278 patent. As to Spaur, the Patent Owner contends that a similar reference was cited during the original prosecution. The examiner fails to see the significance of the citation of an alleged similar reference. Again, Spaur was not cited during the original prosecution of the '278 patent.

The Patent Owner further broadly contends that the references cited in the Order do not show the claimed features. However, there are no specific arguments as to how the features of the cited references fail to show the claimed features. The claimed features are clearly shown as discussed in the above rejection of the claims and as noted in the 3/8/2016 response by the Third Party Requester on pages 13-18.

11. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,032,278 throughout the course of this reexamination proceeding. The Third Party Requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

12. Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR

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1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

13. In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

14. Any inquiry concerning this communication should be directed to Matthew C. Graham at telephone number 571-272-7116.

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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Matthew C. Graham/

Matthew C. Graham
CRU Examiner
3993
(571) 272-7116

Conferees: /PCE/
/GAS/