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EXAMINER

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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 1011
Geotab v. Omega



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

REEXAMINATION CONTROL NO. 90/013,851.

PATENT NO. 8032278.

ART UNIT 3992.

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)).

Karin M. Reichle

Primary Examiner

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Decision

Third Party requester submitted a request for reexamination with a filing date of October 28, 2016, requesting reexamination of claims 1-22 of U.S. Patent No. 8,032,278 (hereinafter also referred to as '278). A substantial new question of patentability affecting claims 1-22 of U.S. Patent No. 8,032,278 in effect at this time is raised by the request for *ex parte* reexamination. Accordingly, claims 1-22 will be reexamined.

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Notification of Concurrent Proceedings

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. See MPEP §§ 2207, 2282 and 2286.

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Amendment in Reexamination Proceedings

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

Submissions

In order to insure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

Waiver of Right to File Patent Owner Statement

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Service of Papers

After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

References Asserted as Raising a Substantial New Question

The asserted substantial new question of patentability (SNQP) regarding claims 1-22 of the '278 Patent is based upon the following references:

(1) U.S. Patent No. **6,009,363** to **Beckert et al**, published December 28, 1999, filed June 24, 1996, (hereinafter also referred to as '**363** or **Beckert**).

(2) U.S. Patent No. **5,732,074** to **Spaur et al**, published March 24, 1998, filed January 26, 1996 (hereinafter also referred to as '**074** or **Spaur**).

(3) U.S. Patent No. **6,028,537** to **Suman et al**, published February 22, 2000, filed June 3, 1997 (hereinafter also referred to as '**537** or **Suman**).

(4) U.S. Patent No. **6,330,499** to **Chou et al**, published December 11, 2001, filed July 21, 1999 (hereinafter also referred to as '**499** or **Chou**).

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(5) SAE HS-3000 publication, "SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual" (1994 Edition), copyright 1994, (hereinafter also referred to as SAE HS-3000). [Exhibit G].

Filing Date

The earliest effective filing date the '278 patent is entitled to is July 3, 2007 (see paragraph 2 of the 5/6/2016 non-final rejection of the 90/013,587 discussed *infra*).

Availability of Asserted References as Prior Art

The patents to **Beckert , Spaur, Suman and Chou** and publication to SAE 3000 include a/an publication/issue date more than one year prior to the effective filing date of June 3, 2007 of the '278 patent, see discussion *supra*, and thus are available as prior art under 35 USC 102(b) and 35 USC 103.

Summary of Prosecution History

U.S. Application 11/773,272 was filed on July 3, 2007 (hereinafter also referred to as '272 or the '272 application). The '272 application claimed continuity-in-part from Application No. 11/076,259 filed March 9, 2005 (hereinafter also referred to as '259 or the '259 application), which issued as Patent No. 7,720,597. The '259 application itself claimed continuity from Application No. 10/383,496 filed March 7, 2003 (hereinafter also referred to as '496 or the '496 application), which issued as Patent No. 7,149,623. The '496 application itself claimed continuity from Application No. 09/859,972 filed May 17, 2001 (hereinafter also referred to as

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‘972 or the ‘972 application), which issued as Patent No. 6,606,561. The ‘972 application itself claimed the benefit of provisional patent application Serial Nos. 60/264,811 filed on January 29, 2001; 60/258,005, filed December 22, 2000; 60/251,552, filed December 6, 2000; 60/252,125, filed November 20, 2000; 60/236,890, filed September 29, 2000; 60/246,463, filed November 7, 2000; 60/222,777, filed August 3, 2000; and 60/205,178, filed May 17, 2000, the entire contents of each of which are incorporated herein by reference by ‘272.

Below are the pertinent Examiner’s findings of fact relevant to this discussion:

‘972 Application

U.S. Application 09/859,972 was filed on May 17, 2001. The application included a specification, claims, abstract and nine Figures. Claims 1-49 were directed to a vehicle tracking unit/system and claims 50-64 directed to a method for operating a vehicle tracking unit. On September 9, 2001, a preliminary amendment was filed including drawing modifications and a substitute specification.

A first non-final Office action was mailed by USPTO on January 23, 2001 rejecting all the claims. A PTO-892 accompanied such action cited US Patent No. **6,330,499** to **Chou et al.**

On December 13, 2002 a second FINAL rejection was mailed by the USPTO rejecting claims 1-29 and 50-50, allowing claims 30-49 and 58-64 and objecting to claims 5, 17 and 25. Claim 10 depending from claim 1 was rejected under 35 USC 103(a) as being unpatentable over Maggiora et al in view of “**Chou et al (6,330,499)**” (emphasis added) (“...Chou teaches a user interface for accepting at least one command from a user and sending at least one alert to the user (column 3, lines 5-15)”).

In response an amendment after final was filed on February 7, 2003 amending claims 1, 13 and 22 and cancelling claims 5, 17, 25 and 50-57.

A Notice of Allowance indicating the allowability of claims 1-4, 6-16, 18-24, 26-49 and 58-64 was mailed by the USPTO on February 13, 2003.

The application issued as US Patent No. 6,606,561 on August 12, 2003.

'272 Application:

U.S. Application 11/773,272 was filed on July 3, 2007. The application included a specification, an abstract, thirty claims and fifteen Figures.

An Office action was mailed by USPTO on December 24, 2009. Claims 1-30 were subject to an election requirement between claims 1-22 drawn to a multi-vehicle tracking device/unit and claims 23-30 drawn to a method of using a multi-vehicle tracking device/unit.

A response to such Office Action was filed February 24, 2010. The response amended claims 13 and 18 to overcome various objections and provisionally elected claims 1-22 and withdrew claims 23-30.

A non-final Office action was mailed by USPTO on June 22, 2010. Claims 1-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkmeyer et al. (US Pat. 5,940, 007).

A response to such Office Action was filed October 22, 2010. The response cancelled claims 23-30. The response also presented remarks submitting that Brinkmeyer et al. failed to disclose the multi-vehicle compatible controller being coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding

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vehicle device code from among a plurality thereof for different vehicles, as recited by independent claim 1.

Another non-final Office Action was mailed by the USPTO on January 5, 2011. Claims 1-22 were rejected. The prior art combination of Monroe (US Pat. 6,253,064 B1) in view of Brinkmeyer et al. (US Pat. 5,940,007) was used to reject the claims.

A response to the Office Action was filed on April 5, 2011. The response presented remarks, i.e.:

...the proposed prior art combination fails to disclose or fairly suggest each and every feature of the claimed invention. For example, the proposed prior art combination fails to disclose the multi-vehicle compatible controller coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles, as recited by independent Claim 1, for example.... Furthermore, none of the applied prior art references discloses the multi-vehicle compatible tracking unit including a connector for temporary connection to a downloading device and a wireless receiver for temporary connection to a downloading device, as recited by the independent claims. Applicant notes that this claim feature enables a user to quickly download new vehicle codes into the multi-vehicle compatible tracking unit without removing and reinstalling the unit. (Emphasis original.)

A Notice of Allowance allowing claims 1-22 issued on June 28, 2011. The Notice set forth:

Pending claims 1-22 are patentable over cited references of Monroe in view of Brinkmeyer et al., because these prior art do not make obvious a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle, the multi-vehicle compatible vehicle tracking unit comprising: a vehicle position determining device; a wireless communications device; a multi-vehicle compatible controller for cooperating with said vehicle position determining device 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 thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles wherein the corresponding at least one vehicle code is for writing to the at least one vehicle device; and a downloading

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interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller; said downloading interface comprising a connector for temporary connection to a downloading device.

(See finally rejected claims 13 and 15).

The application issued as US Patent No. 8,032,278 on October 4, 2011.

'587 Reexam:

On September 14, 2015 a first request for *ex parte* reexamination of claims 1-22 of U.S. Patent No. 8,032,278 was filed by a third party requester, hereinafter also referred to as TPR.

The Request at pages 10-11 in a section entitled "**V. STATEMENTS POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY**" set forth:

As explained in greater detail below, A) the *Suman* '537 patent; B) the *Spaur* '074 patent; and C) the Flick '876 patent, *either alone or in combination with a variety of references* published prior to the earliest claimed priority date of the Flick '278 patent, raise substantial new questions of patentability based on new teachings not previously considered or addressed in the prior examination of the Flick '278 patent.

A. U.S. Patent No. 6,028,537

...

1. Technological Teaching: Obtaining and Transmitting Location Data using a Standard Vehicle Bus

The *Suman* '537 patent teaches a vehicle communication and control system including a wireless communications device, a vehicle location determination device, and *a controller capable of communicating with a variety of vehicle devices via a standardized vehicle data bus*....

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Thus, the *Suman* '537 patent discloses technological teachings that the Examiner previously found to be missing from the prior art of record disclosed in the Flick 2278 patent.

...

3. Substantial New Question of Patentability as to Claims 1 - 22 because the Suman '537 Patent Teaches all Claim Elements

Each of claims 1- 22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit B, the *Suman* '537 patent discloses this and all other required limitations, explicitly disclosing communicating via a "vehicle data bus" and a "downloading interface." Accordingly, it is submitted that *all aspects of claims 1 - 22 are disclosed by the Suman '537 patent* in at least as complete detail as contained in the claims. A reasonable examiner would consider the teachings important in deciding whether or not claims 1 - 22 of the Flick '278 patent are patentable. For these reasons, the *Suman* '537 patent raises a substantial new question of patentability as to claims 1 - 22.

B. U.S. Patent No. 5,732,074

...

1. Technological Teaching: Obtaining and Transmitting Location Data using a Standard Vehicle Bus

The *Spaur* '074 patent teaches *a controller* having a wireless device, a direct communications port, and *a connection to a vehicle standardized network* that can be utilized to read data from vehicle devices and transmit that data via the wireless device....

Thus, *the Spaur* '074 patent discloses technological teachings that the Examiner previously found to be missing from the prior art of record disclosed in the Flick '278 patent.

...

3. Substantial New Question of Patentability as to Claims 1-22 Because Spaur '074 Teaches all Claim Elements

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Each of claims 1-22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereof with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit C, the Spaur '074 patent discloses this and all other required limitations, explicitly disclosing communicating via a "vehicle data bus" and a "downloading interface." Accordingly, it would have been obvious to one skilled in the art that all aspect of claims 1-22 are disclosed by the Spaur '074 patent. A reasonable examiner would consider the teachings important in deciding whether or not claims 1-22 of the Flick '278 patent are patentable. For these reasons, the Spaur '074 patent raises a substantial new question of patentability as to claims 1 - 22. (Bold original, underlined italics added.)

On November 10, 2015, an Order Granting the Request for *ex parte* reexamination was mailed by the USPTO. The Order set forth:

Key to each of these claims is the reaction [sic] of a "vehicle data bus" and a "downloading interface for permitting downloading of enabling data".

Suman teaches a vehicle data bus - an SAE standard J1850 [sic] See col. 37, lines 15 - 17. In addition Suman teaches a downloading interface for permitting downloading of enabling data. In particular, Suman teaches at 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."

There is a substantial likelihood that a reasonable examiner would have considered these teachings in Suman to be important in the determination of

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patentability of claims 1-22 of Flick '278. Accordingly, Suman raises a substantial new question of patentability, which question has not been previously raised.

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 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).

There is a substantial likelihood that a reasonable examiner would have considered these teachings in Spaur to be important in the determination of patentability of claims 1-22 of Flick '278. Accordingly, Spaur raises a substantial new question of patentability, which question has not been previously raised. (Underlined italics emphasis added.)

On January 8, 2016 the Patent Owner (hereinafter also referred to as PO) filed a statement asserting Suman '537 had already been considered in the parent '278 while Spaur '074

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was similar to a co-assigned reference 7,366,892 which had also been considered in the parent

‘278. Furthermore, PO asserted:

A. The Claims Are Patentable Over the Suman et al. ‘537 Patent

The Suman et al. ‘537 patent is directed to vehicle personalization to be remotely effected by a service provider using a radio frequency (RF) system such as a paging or cellular system. A vehicle owner, wishing to reprogram a vehicle, calls the service provider who effects reprogramming of an option control by transmitting RF control signals to the vehicle from a land-based transmitter to a receiver mounted in the vehicle. Thus, because the service provider effects vehicle personalization, the vehicle owner need not have any technical knowledge as to how to operate the vehicle programming system. Vehicle personalization may also be provided for each person who may operate the vehicle.

To achieve these aspects, the vehicle accessory control system 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.

The Patent Owner respectfully submits that the Suman et al. ‘537 patent fails to disclose, as recited in Claim 1, for example, a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle. More particularly, the Suman et al. ‘537 patent fails to disclose a multi-vehicle compatible controller for cooperating with a vehicle position determining device and a wireless communications device to send vehicle position information, wherein the multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles, and wherein a downloading interface permits downloading of enabling data related to the at least one corresponding vehicle device code for use

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by the multi-vehicle compatible controller. Along these lines, the Suman et al. '537 patent fails to disclose these features with the downloading interface comprising a connector for the temporary connection to a downloading device as recited in independent Claim 13, or a wireless receiver as recited in independent Claim 18.

None of the other references identified by the Examiner supply the deficiencies of the Suman et al. '537 patent. Accordingly, independent Claims 1, 13 and 18 are patentable. Their dependent claims, which recite further distinguishing features, are also patentable and require no further discussion herein.

B. The Claims Are Patentable Over the Spaur et al. '074 Patent

The Spaur et al. '074 patent discloses communication to and from a controller at the vehicle. As helpfully pointed out by the Examiner, the reference discloses an interface for the controller, such as an RS-232 connection, an Ethernet connection, a Personal Computer Memory Card International Association (PCMCIA) unit, or a direct communications port. Moreover, as noted at col. 4, lines 51-57, the Spaur et al. '074 patent recites:

“[] each vehicle device on the CAN has its own IP designation or address so that the remote user can utilize this designation or address for communication with the selected vehicle device having that designation or address. The controller uses the received IP address or designation for the particular device and acts as a link or bridge for the remote user to the particular device”.

In other words, the Spaur et al. '074 patent fails to disclose, as recited in Claim 1, a multi-vehicle compatible tracking unit for a vehicle comprising a vehicle data bus extending throughout the vehicle. The Spaur et al. '074 patent fails to disclose a multi-vehicle compatible controller for cooperating with a vehicle position determining device and a wireless communications device to send vehicle position information, wherein the multi-vehicle compatible controller is to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles, and wherein a downloading interface permits downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller. The Spaur et al. '074 patent fails to disclose these features with the downloading interface comprising a connector for the temporary connection to a downloading device, as recited in independent Claim 13, or a wireless receiver, as recited in independent Claim 18.

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None of the other references identified by the Examiner supply the deficiencies of the Spaur et al. '074 patent. Accordingly, the Patent Owner submits that independent Claims 1, 13 and 18 are patentable, and the dependent claims, which recite further distinguishing features, are also patentable and require no further discussion herein.

The Patent Owner also respectfully submits that the Spaur et al. '074 patent adds nothing to the deficiencies of the Suman et al. '537 patent - its respective deficiencies being pointed out above.

On March 8, 2016 TPR filed a reply to PO's statement. TPR reasserted that both the Spaur '074 and Suman '537 patents were not previously considered by the Examiner during the prosecution of the '278 and the Order's conclusion that these patents raised a substantial new question of patentability was correct. TPR continues:

Furthermore, under the broadest reasonable interpretation, a multi-vehicle compatible tracking unit as recited in claims 1 - 22 of the Flick '278 patent could be compatible with *multiple vehicles of the same year, make, and/or model...*

...the SAE standard J1850 bus referenced in the Suman et al. '537 patent is "universally used in the automotive industry" (Suman et al. publication, column 37 lines 15 - 17) and therefore is used in many different vehicle year, makes, and models....

...

...The above referenced portion of the Spaur et al. '074 [col. 4, lines 51-57] teaches connecting the disclosed multi-vehicle compatible controller to a CAN bus. However the Spaur et al. '074 reference is not limited to disclosing CAN buses and teaches that the multi-vehicle compatible controller can connect with any of a variety of standardized buses: "[o]ther available networks could be utilized instead of the CAN, such as Arcnet, which has a protocol similar to CAN". (Spaur et al. '074 patent, column 4, lines 5 - 7). Standardized vehicle data buses include the CAN bus standard published by the CAN in Automation group. Standardized vehicle data buses also include the SAE J1850 bus standard published by the Society of Automotive Engineers.

...

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...Requester further notes that, since 1991, the CAN specification has required support for two message formats that can be present on any given vehicle's CAN bus (i.e. the CAN 11-bit message format and CAN 29-bit message 16 format). Therefore, communication via the CAN bus requires support for a plurality of different message formats for the different vehicle devices that may be present on any of the myriad of year, make, and model of vehicles that support the CAN bus, which includes a significant percentage of the vehicles sold in the U.S. dating back to 1991 and almost every passenger vehicle sold in the U.S. since 2008 due to Federal mandate.
(Underlined italics emphasis added.)

TPR also cited pertinent and applicable additional prior art believed to have bearing on patentability, i.e. 1) the *Beckert* '363 patent; 2) the Gelvin '008 patent; and 3) the Razavi et al. publication, raise substantial new questions of patentability based on new teachings not previously considered or addressed in the prior examination of the Flick '278 patent.
Specifically:

1. U.S. Patent No. 5,794,164

....

a) Technological Teaching: Transmitting Location Data, Communicating Via One of the OBD II vehicle Data Bus Protocols and Downloading Means Downloading Enabling Data

The Beckert et al. '363 patent teaches 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 via the OBD II standardized vehicle data bus mandated for inclusion in 1996 or later model vehicles. By way of background, at the time of the filing of the Beckert et al. '363 patent, federal mandate required all vehicles to conform to California Code of Regulations (CCR) 1968.1. CCR 1968.1 permitted vehicles to implement three different on-board to off-board network

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communications protocols:

(1.6) Either SAE Recommended Practice J1850, "Class B Data Communication Network Interface", July, 1995, or ISO 9141-2, "Road vehicles - Diagnostic Systems - CABB Requirements for Interchange of Digital Information," February, 1994, or ISO 14230-4, "Road vehicles - Diagnostic systems - KWP 2000 requirements for Emission-related systems," April, 1996, which are incorporated by reference, shall be used as the on-board to off-board network communications protocol. All SAE J1979 emission related messages sent to the J1978 scan tool over a J1850 data link shall use the Cyclic Redundancy Check and the three byte header, and shall not use inter-byte separation or checksums.

(1968.1 Malfunction and Diagnostic System Requirements--1994 and Subsequent Model-Year Passenger Cars, Light-Duty Trucks, and Medium Duty Vehicles and Engines, p 36, Exhibit U).

...

The Beckert et al. '363 patent also incorporates by reference the disclosure of U.S. Patent 5,794,164 to Beckert et al. (the Beckert et al. '164 patent) in its entirety at col. 7, lines 44-51. The Beckert et al. '164 patent provides additional detail concerning the modules of the vehicle computer system disclosed in the Beckert et al. '363 patent and specific detail concerning the OBD interpreter and APIs that are exposed to remote devices by the vehicle computer system, which include a diagnostic API (amongst others). Thus, the Beckert et al. '363 patent discloses technological teachings that the Examiner previously found to be missing from the prior art of record disclosed in the Flick '278 patent.

c) Substantial New Question of Patentability as to Claims 1-22 because the Beckert et al, '363 Patent Teaches all Claim Elements

Each of claims 1-22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit R, the Beckert et al. '363 patent discloses this and all other required limitations, explicitly disclosing communicating via a "vehicle data bus" and a "downloading interface." Accordingly, it is submitted that all aspects of claims 1 - 22 are disclosed by the Beckert et al. '363 patent in at least as complete detail as contained in the claims. A reasonable examiner would consider the teachings important in deciding whether or not claims 1 - 22 of the Flick '278 patent are patentable. For these reasons, the Beckert et al. '363 patent raises a substantial new question of patentability as to claims 1-22.

(Bold emphasis original, underlined italics added.)

A non-final action was mailed by the USPTO on May 6, 2016. Such action determined the earliest effective filing date for Flick '278 to be July 3, 2007. The action also determined that the '363, '008 and '225 references each taught 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 and therefore, there was 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 were determined to each raise a substantial new question of patentability, which question has not been previously raised. The action also included rejections of claims 1-22 under pre-AIA 35 U.S.C. 102(b) as being anticipated by Suman or Beckert and under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Spaur in view of other references used for the teaching of location detection. Finally the action concluded with the Examiner finding the PO'S remarks regarding the art being previously considered and the claim features not being shown thereby not persuasive.

On June 16, 2016 a personal interview was held. The PTOL-404 Summary set forth:

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Spaur and Suman references were discussed. Examiner agreed to drop the 102 rejection based upon Beckert. Examiner suggested that the Patent Owner provide evidence relating to the use of device codes in vehicles at the time of the invention in relation to their inherent use in Suman and Spaur. The scope of the claims was also discussed. Patent Owner's representative provided the attached agenda and various documents pertaining to related court proceedings.
(Emphasis added.)

while the PO Summary of July 6, 2016 set forth, e.g.:

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While discussing Suman et al., the Patent Owner contended that Suman et al. failed to disclose: “said multivehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”, as recited in independent Claim 1, for example.

In reply, the Examiners cited Col. 2, lines 3-11 of Suman et al. as teaching the “multi-vehicle compatible controller” of the claimed invention. The Patent Owner contended that this was a mischaracterization of the teachings of Suman et al. The Examiner’s invited the Patent Owner to submit evidence supporting this contention.

The Patent Owner also contended that Suman et al. fails to disclose: “a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by said multi-vehicle compatible controller”, as recited by independent Claim 1, for example.

The Examiners noted that Col. 24, lines 8-13 of the present application recite: “[t]he enabling data may be the vehicle device code or codes, an instruction to select a code or codes from among those already stored, or the data or sequence to allow the controller 111 to generate the vehicle device code or codes, for example”. The Examiners also correctly noted that Suman et al. fails to disclose the downloading interface for permitting downloading of vehicle device codes. While discussing Spaur et al., the Patent Owner contended that Spaur et al. failed to disclose: “said multivehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”, as recited in independent Claim 1, for example.

In reply, the Examiners contended similarly that since Spaur et al. discusses potential application in different vehicles, therefore Spaur et al. discloses the multi-vehicle compatible controller of the claims. The Patent Owner contended that this was a mischaracterization of the teachings of Spaur et al. The Examiner’s invited the Patent Owner to submit evidence supporting this contention. The Examiners also correctly noted that Spaur et al. fails to disclose the downloading interface for permitting downloading of vehicle device codes.

Additionally, while discussing Spaur et al., the Patent Owner noted that Spaur et al. discloses a vehicle position determining device. Accordingly, for purposes of clarity, the Patent Owner agreed to also discuss the Spaur et al. patent with regards to its failure to anticipate the claimed invention.

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The Examiners determined that the rejection over Beckert et al. was withdrawn.
(Emphasis added.)

The Agenda attached to the Summary indicated that PO intended to argue that the references or combination of references used to reject the claims did not teach the features of a multi-vehicle compatible controller nor a downloading interface.

A response to the non-final Office Action was also filed on July 6, 2016. The response included remarks and a Rule 132 declaration by Michael J. Suman and a Rule 132 declaration by Joseph C. McAlexander, III.

On December 1, 2016, a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was issued by the USPTO. The Statement of Reasons for Patentability and/or Confirmation set forth:

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: the Examiner agrees that the declarations by Suman and McAlexander provide sufficient evidence that Suman and Spaur each fail to disclose the multi-vehicle compatible controller as recited in independent claims 1,13 and 18. Claims 2-12, 14-17 and 19-22 are considered to be patentable due to their dependency on claims 1, 13 and 18, respectively.

The Suman declaration provided:

12. ...The embodiments contemplated by me at the time of my '537 patent, the disclosure in my '537 patent, and the related commercial developments within my work responsibilities were not directed to a multi-vehicle compatible controller ... as in the '278 patent claims. The embodiments contemplated by me at the time of my '537 patent did not include multi-vehicle compatibility, and at the time I left Johnson Controls in 2002 I had never contemplated or worked with any multi-vehicle compatible controller as described in the '278 patent. I point out that at

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the time of my '537 patent, the vehicle device codes were proprietary to different manufacturers, and even different model lines offered by manufacturers. Moreover, the device codes were not made freely available, and were quite difficult to obtain.

13. ...Based upon my knowledge and experience, the reprogramming means [of 537] is not related to vehicle codes or to providing a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller, as in the '278 patent claims. Instead, the reprogramming means is for vehicle personalization and was not capable of making communications level changes that would be necessary to provide multi-vehicle compatibility.

14. I would also like to clarify that the following passage from my '537 patent does not support the contention that my patent discloses a multi-vehicle compatible controller and downloading interface as in the '278 patent claims: ... (Col. 2, lines 3-10).

It was expected that the vehicles in a given fleet would be the same type vehicle having the same device codes.

15. ... It is my position, based upon my knowledge and experience, that none of the cited portions of my '537 patent supply these teachings relating to a wired or wireless interface. Indeed, I was simply not working on the problem of multi-vehicle compatibility, and there was no project to develop any software to give the connector the functions as contended in the Official Action. Moreover, the embodiments conceived and described in the '537 patent were not capable of modifying the communications level to allow for multi-vehicle compatibility. Along these lines, there is also no disclosure in my 537 patent of using the telephone to provide a wireless interface as in the '278 patent.

The McAlexander declaration provided:

10. I have also reviewed the Rule 132 Declaration being submitted concurrently herewith by Michael J. Suman, the lead inventor on U.S. Patent No. 6,028,537, i.e., another reference being cited in the Official Action. In that Declaration, Mr. Suman confirms my understanding that at the time of the Spaur et al. patent (filed about six months before the filing of the provisional application leading to the Suman et al. patent), the vehicle device codes were proprietary to different manufacturers, and even different model lines offered by manufacturers; and that the device codes were not made freely available, and were quite difficult to obtain.

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...

19. The Official Action incorporates by reference a listing of how Spaur et al. (and Johnson et al.) relates to the claims of the '278 patent from Requester's Exhibit F. From Exhibit F, the following sections of Spaur et al. are asserted as disclosing a multi-vehicle controller using at least one corresponding device code from among a plurality thereof for different vehicles:

... (Col. 6, lines 31-50) .

... (Col. 10, lines 15-29).

... (Col. 10, lines 55-64. [sic]

Based upon my knowledge, experience and analysis, I do not believe that these cited portions of Spaur et al. disclose the multi-vehicle compatible controller as in the claims of the '278 patent. In addition, I also believe that, based upon these portions of Spaur et al., or any other portions of Spaur et al., there is no inherent teaching of the multi-vehicle compatible controller as in the '278 patent claims. In other words, it does not necessarily flow that Spaur et al. would have a multivehicle compatible controller using the device codes as in the '278 patent claims.

20. I also point out that Exhibits 14 and 15 from Requester's technical trial expert, Mr. Andrews, and describing the actual CellPort Labs products as disclosed in Spaur et al., also fail to have any express or inherent teaching of the multivehicle compatible controller as in the '278 patent claims....

21. The Official Action also cites to the following language from col. 4, lines 38-45 of Spaur et al. for the alleged teaching of the downloading interface as recited in the '278 patent claims...

Again, based upon my knowledge, experience and analysis, I do not believe that these cited portions of Spaur et al., or any other portions of Spaur et al., disclose (either directly or through inherency) a downloading interface for permitting downloading of enabling data related to the at least one corresponding vehicle device code for use by the multi-vehicle compatible controller as found in the claims of the '278 patent. Spaur et al. does disclose an interface in combination with a controller; however, Spaur et al. fails to disclose the multivehicle compatible controller and the downloading interface as recited in the claims of the '278 patent. In addition, there is nothing in the description of the corresponding CellPort Labs actual products (Exhibits 14 and 15) that discloses the multivehicle compatible controller and the downloading interface as recited in the claims of the '278 patent.

Instant '851 Request for Reexam:

The instant '851 Request, hereinafter also referred to as the '851 Request, was filed October 28, 2016 by the same TPR which filed the '587 reexam.

SNQP/Reference Analysis

Attention is directed to MPEP 2216, i.e.:

Under 35 U.S.C. 304, the Office must determine whether “a substantial new question of patentability” affecting any claim of the patent has been raised. 37 CFR 1.510(b)(1) requires that a request for ex parte reexamination include “a statement pointing out each substantial new question of patentability based on prior patents and printed publications.” If such a new question is found, an order for ex parte reexamination of the patent is issued. **It is therefore important that the request clearly set forth in detail what the requester considers the “substantial new question of patentability” to be in view of prior patents and printed publications. The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office.**

It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents **a new, non-cumulative technological teaching** that was **not previously considered and discussed on the record during the prosecution of the application** that resulted in the patent for which reexamination is requested, **and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.** See also MPEP § 2242.

The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C.303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office **if the reference is presented in a new light or a different way that escaped review during earlier examination.**

....

After the enactment of the Patent and Trademark Office Authorization Act of 2002 (“the 2002 Act”), a substantial new question of patentability can be raised by patents and printed publications “previously cited by or to the Office or

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considered by the Office” (“old art”). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002 Act, MPEP § 2242, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, **but only if the old art is “presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.”** Thus, a request may properly raise a substantial new question of patentability by raising a material new analysis of previously considered reference(s) under the rationales authorized by KSR.

Questions relating to grounds of rejection other than those based on prior art patents or printed publications should not be included in the request and will not be considered by the examiner if included. Examples of such questions that will not be considered are public use, on sale, and conduct by parties. (Emphasis added.)

Attention is also invited to MPEP 2242, I., i.e.:

The presence or absence of “a substantial new question of patentability” determines whether or not reexamination is ordered. The meaning and scope of the term “a substantial new question of patentability” is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, **unless the same question of patentability has already been decided** by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent. A “previous examination” of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find “a substantial new question of patentability” **unless the same question of patentability has already been decided as to the claim** in a final holding of invalidity by the Federal court

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system or **by the Office in a previous examination**. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to *similar* prior art already fully considered by the Office in a previous examination of the claim.

For “a substantial new question of patentability” to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; **and** (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. It is not necessary that a “prima facie” case of unpatentability exist as to the claim in order for “a substantial new question of patentability” to be present as to the claim....
(Emphasis added.)

Attention is also invited to 2258.01:

...For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different....

Finally, see also MPEP 2247.

Suman ‘537:

Requester asserts **Suman ‘537** alone or in combination with SAE HS-3000, raises a substantial new question of patentability as to claims 1-22 of the ‘278 patent. See, e.g., page 7 of the Request.

The prosecution history indicates that SAE HS-3000 was not of record during the prosecution of any application to which the benefit of priority is claimed. Accordingly, such references is not precluded from raising a substantial new question of patentability.

Suman ‘537 however was not only cited but applied by the examiner during the prosecution of at least ‘587 reexam.

Accordingly, at least the **Suman ‘537** reference/evidence is “old art”. However, as set forth *supra*, e.g., MPEP 2242 states:

“for example, a substantial new question of patentability may be based solely on old art where the old art is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request.”

In this instance, Requester, see, e.g., Sections V (pages 3-7) and VI, C. (pages 18-23) of the Request, asserts the combination of **‘537** (previously before/considered by the Examiner during the examination/prosecution of the ‘587 reexam) with SAE HS-3000, see *supra*, a combination which was not considered during prosecution since the reference to, e.g., SAE HS-3000 was not even cited during prosecution. Accordingly, such combination is not precluded from raising a substantial new question of patentability.

During prosecution of the ‘272 application that led to the issuance of the ‘278 patent and the confirmation of patentability in the 90/013,587 reexam, the independent claims were allowed for reasons set forth by Examiner, see summary of prosecution history *supra*.

See the Request at, e.g., Sections V (pages 3-7) and VI, C. (pages 18-23) and Exhibit C, e.g., bridging pages 2-3 and page 8. Such sections of the instant Request set forth:

**V. CITATION OF PERTINENT AND APPLICABLE PRIOR ART
BELIEVED TO HAVE BEARING ON PATENTABILITY**

...

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Requester notes that these references were not previously considered during the original prosecution of the Flick '278 patent, but that the Beckert '363 patent, the Spaur '074 patent and the Suman '537 patent are being considered in the pending Flick '587 Reexam. However, these references are being presented in a new light in this Request. In particular, the Examiner in the Flick '587 Reexam had requested "evidence relating to the use of device codes" as related to their inherent use in the Spaur '074 patent and the Suman '537 patent. ... Accordingly, Requester is submitting this material prior art evidence in the form of the SAE HS- 3000 Manual published in 1994.

The SAE HS-3000 Manual is one of numerous publications published by the Society of Automotive Engineers ("SAE") that set forth the standards for communicating with vehicle devices via a vehicle data bus using various device codes, as was used in the Spaur '074 patent, the Suman '537 patent, and the Beckert '363 patent in order to communicate with the vehicle devices. Requester also notes that these communications standards have been federally mandated for all new vehicles sold in the United States since 1996.

As detailed in the accompanying claim charts, the SAE HS-3000 Manual provides details regarding hundreds of device codes, or "PRN" device codes, for communicating with vehicle devices, including standard codes and up to seven manufacturer specified vehicle device codes. For example, SAE J2178/2, which starts on page 211 of the SAE HS-3000 Manual, provides the "Standardized Parameter Definitions" for standardized messages on SAE J1850 Class B networks. SAE J2178/2 sets out respective sets of device codes for a host of vehicle devices that may be present on a given vehicle. For example, Table 2 on page 215, partially reproduced below, provides the address map of the SAE standard and reserved manufacturer specific (Reserved MFG) subgroups of messages for different classes of vehicle devices.

...

SAE J2178/2 provides the details of device codes for hundreds of different vehicle devices within the address map ranges indicated in the above table. Section 4 of SAE J2178/2 on page 213 specifies that three bits are used to define eight different device codes for a given vehicle device including a SAE standard device code for the specific type of vehicle device and seven manufacturer reserved device codes for that particular vehicle device.

Furthermore, the SAE HS-3000 Manual teaches a bus discovery procedure that can be used by systems interfacing with a vehicle bus, which involves communicating with vehicle devices using at least one vehicle device code from among a plurality thereof for different vehicles. In particular, the bus discovery procedure sends a plurality of device codes, referred to as "mode 1 PID 0

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response message” in a manner appropriate for each of the SAE J1850 41.6 Kbps PWM bus, SAE J1850 10.4 Kbps VPW, and ISO 9141-2 in order to determine a type of bus used in a vehicle. (See SAE HS-3000 Manual section 6.5.1 on page 37).

Accordingly, the Beckert ‘363 patent, Spaur ‘074 patent, and the Suman ‘537 patent are each being presented in a new light in view of the SAE HS-3000 Manual and continue to raise substantial new questions of patentability with respect to the Flick ‘278 patent. Requester also notes that the Chou ‘499 patent was not previously considered in either the original prosecution of the Flick ‘278 patent or the currently pending Fick ‘587 Reexam and that this prior art reference presents a substantial new question of patentability with respect to the Flick ‘278 patent.

VI. STATEMENTS POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

...as explained in greater detail below, A) the Beckert ‘363 patent; B) the Spaur ‘074 patent; C) the Suman ‘537 patent; and D) the Chou ‘499 patent either alone or in combination with the SAE HS-3000 Manual, all of which were published more than a year prior to the earliest priority date to which the Flick ‘278 patent is entitled to, raise substantial new questions of patentability with respect to the Flick ‘278 patent.

...

C. U.S. Patent No. 6,028,537 to Suman (inherently disclosing the SAE HS-3000 Manual)

The Suman ‘537 patent issued February 22, 2000 and the SAE HS-3000 Manual published in 1994 and therefore are prior art to the Flick ‘278 patent under 35 U.S.C. §§102(a), 102(b) and 102(e). These references were not considered during the original prosecution of the Flick ‘278 patent, but the Suman ‘537 patent is currently being considered in the Flick ‘587 Reexam. Furthermore, as noted above ..., the Examiner in the Flick ‘587 Reexam had requested evidence related to the use of device codes as related to the Suman ‘537 patent, ... Accordingly, Requester is submitting material prior art, in particular, the SAE HS-3000 Manual which provides material evidence related to the use of device codes as related to the Suman ‘537 patent. Accordingly, the Suman ‘537 patent is being presented in a new light in view of the SAE HS-3000 Manual and continues to raise a substantial new question of patentability.

1. Technological Teaching: Obtaining and Transmitting Location Data using

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a Standard Vehicle Bus and Multi-Vehicle Compatibility

The Suman '537 patent teaches a vehicle communication and control system including a wireless communications device, a vehicle location determination device, and a controller capable of communicating with a variety of vehicle devices via a standardized vehicle data bus....

...

The Suman '537 patent notes that the multiplexing scheme (e.g., item 744 illustrated in Fig. 44 above) is set forth in SAE standard J1850 and "is universally used in the automotive industry." The SAE HS-3000 Manual is a publication that provides details regarding the SAE J1850 standard, and provides implementation details for communicating with vehicle devices on a plurality of different makes and models of vehicles via an SAE J1850 bus.

Accordingly, a vehicle controller (as illustrated in Fig. 44 above) implemented according to the SAE J1850 standard would communicate with a plurality of vehicle devices using the SAE messaging protocols defined in SAE J2178 (Class B Data Communication Network Messages) as required by the SAE J1850 standard, which provides details of the various device codes that may be utilized to communicate with hundreds of vehicle devices, ...

...

...As noted above, vehicle data busses, such as those described by the SAE HS-3000 Manual have been federally mandated for inclusion in all vehicles sold in the United States since at least 1996.

Thus, the Suman '537 patent is being presented in a new light in view of the SAE HS- 3000 Manual that raises a substantial new question of patentability with respect to the Flick '278 patent.

...

3. Substantial New Question of Patentability as to Claims 1 - 22 because the Suman '537 patent, including the SAE HS-3000 Manual, Teaches all Claim Elements

Each of claims 1 - 22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit D [sic], the Suman '537 patent, which inherently discloses communicating with vehicle devices in accordance with the manner disclosed in the SAE HS-3000 Manual, discloses this and all other required limitations, explicitly disclosing

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communicating via a ‘vehicle data bus’, ‘using at least one corresponding device code from among a plurality thereof for different vehicles’, and ‘downloading interface’. *In particular, the manner in which the Suman ‘537 patent’s disclosure requires “using at least one corresponding vehicle device code from among a plurality thereof for different vehicles” can be appreciated by reviewing the details of the disclosed processes as set out in the SAE HS-3000 Manual, which provides the implementation requirements for the multiplexing communication circuit 744 described in the Suman ‘537 patent. Accordingly, it is submitted that all aspects of claims 1 - 22 are disclosed by the Suman ‘537 patent, which inherently discloses use of the processes required by the standards contained in the SAE HS-3000 Manual, in at least as complete detail as contained in the claims.* A reasonable examiner would consider the teachings important in deciding whether or not claims 1 - 22 of the Flick ‘278 patent are patentable. For these reasons, the Suman ‘537 patent in view of the SAE HS-3000 Manual raises a substantial new question of patentability as to claims 1 - 22. (Underlined italics added.)

Therefore, Suman ‘537 (e.g. “The multiplexing scheme is set forth in SAE standard J1850 and is universally used in the automotive industry) is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request (e.g. the details/vehicle device codes/implementations constituting the SAE standard J1850 provided in the form of SAE HS-3000 Manual) raising a substantial new question of patentability with respect to “the multi-vehicle compatible controller as recited in independent claims 1,13 and 18 , i.e. “said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”.

Given the teachings of the combination of Suman ‘537 and SAE HS-3000, a reasonable examiner would consider these teachings important in evaluating the patentability of the

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independent claims of the '278 patent. This art was not applied/so combined during a previous examination of US Patent No. 8,032,278, and the claims at issue are not the subject of a final holding by a Federal Court. Accordingly, prior art patents and printed publications asserted by the Request raise a substantial question of patentability with respect to at least one claim, e.g. claim 1, of the '278 patent.

Spaur '074:

Requester asserts **Spaur '074** alone or in combination with SAE HS-3000, raises a substantial new question of patentability as to claims 1-22 of the '278 patent. See, e.g., page 7 of the Request.

The prosecution history indicates that SAE HS-3000 was not of record during the prosecution of any application to which the benefit of priority is claimed. Accordingly, such references is not precluded from raising a substantial new question of patentability.

Spaur '074 however was not only cited but applied by the examiner during the prosecution of at least '587 reexam.

Accordingly, at least the **Spaur '074** reference/evidence is "old art". However, as set forth *supra*, e.g., MPEP 2242 states:

"for example, a substantial new question of patentability may be based solely on old art where the old art is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request."

In this instance, Requester, see, e.g., Sections V (pages 3-7) and VI, B. (pages 14-18) of the Request, asserts the combination of **'074** (previously before/considered by the Examiner

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during the examination/prosecution of the '587 reexam) with SAE HS-3000, see *supra*, a combination which was not considered during prosecution since the reference to, e.g., SAE HS-3000 was not even cited during prosecution. Accordingly, such combination is not precluded from raising a substantial new question of patentability.

During prosecution of the '272 application that led to the issuance of the '278 patent and the confirmation of patentability in the 90/013,587 reexam, the independent claims were allowed for reasons set forth by Examiner, see Summary of Prosecution History *supra*.

Finally, see the Request at, e.g., Sections V (pages 3-7), and VI, B. (pages 14-18) and Exhibit D, e.g., bridging pages 4-5 and page 9-10. Such section V of the instant Request is set forth *supra* and section VI, B. sets forth:

VI. STATEMENTS POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

...as explained in greater detail below, A) the Beckert '363 patent; B) the Spaur '074 patent; C) the Suman '537 patent; and D) the Chou '499 patent either alone or in combination with the SAE HS-3000 Manual, all of which were published more than a year prior to the earliest priority date to which the Flick '278 patent is entitled to, raise substantial new questions of patentability with respect to the Flick '278 patent.

...

B. U.S. Patent No. 5, 732,074 to Spaur in view of the SAE HS-3000 Manual

...Furthermore, as noted above..., the Examiner in the Flick '587 Reexam had requested evidence related to the use of device codes as related to the Spaur '074 patent, ... Accordingly, Requester is submitting the SAE HS-3000 Manual which provides material evidence related to the use of device codes as related to the Spaur '074 patent. Accordingly, the Spaur '074 patent is being presented in a new

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light in view of the SAE HS-3000 Manual and continues to raise a substantial new question of patentability.

1. Technological Teaching: Obtaining and Transmitting Location Data using a Standard Vehicle Bus and Vehicle Device Codes for Different Vehicles

The Spaur '074 patent teaches a controller having a wireless device, a direct communications port, and a connection to a vehicle standardized network that can be utilized to read data from vehicle devices and transmit that data via the wireless device....

...

The Spaur '074 patent teaches communicating with vehicle devices via a “standardized network ... commonly used in a number of makes and models of vehicles” (Spaur '074 patent, col. 10, lines 18-21). The SAE standards, and in particular the SAE HS-3000 Manual, were published for the specific purpose of teaching people of ordinary skill in the art how to communicate with vehicle devices via one of the “standardized networks” present within a vehicle.

In particular, the SAE HS-3000 manual provides details of communicating with a plurality of vehicle devices using the SAE messaging protocols defined in SAE J2178 (Class B Data Communication Network Messages), ...

...

Accordingly, it would have been obvious to utilize the teachings described in the SAE HS-3000 Manual because the Spaur '074 patent expressly directs using standards, such as the SAE standards as described by the SAE HS-3000 Manual, for the purpose for which the standards were created. Thus, the Spaur '074 patent in view of the SAE HS-3000 Manual disclose technological teachings that the Examiner previously found to be missing from the prior art of record disclosed in the Flick '278 patent.

...

3. Substantial New Question of Patentability as to Claims 1 - 22 Because Spaur '074 in view of the SAE HS-3000 Manual Teaches all Claim Elements

Each of claims 1 - 22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit D, the Spaur '074 patent in view of the SAE HS-3000 Manual discloses this and all other required limitations, explicitly disclosing communicating via a “vehicle data bus”, “using at least one corresponding device code from among a plurality thereof for different vehicles”, and “downloading interface”. In particular, the

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limitation “using at least one corresponding vehicle device code from among a plurality thereof for different vehicles” is discussed in greater detail in the SAE HS-3000 Manual, which provides the implementation details for communicating via the standardized vehicle network described in the Spaur ‘074 patent.

Accordingly, it would have been obvious to one skilled in the art that all aspect of claims 1 - 22 are disclosed by the Spaur ‘074 patent in view of the SAE HS-3000 Manual. A reasonable examiner would consider the teachings important in deciding whether or not claims 1 - 22 of the Flick ‘278 patent are patentable. For these reasons, the Spaur ‘074 patent in view of the SAE HS-3000 Manual raises a substantial new question of patentability as to claims 1 - 22.

(Underlined italics added.)

Therefore, Spaur ‘074 (e.g. “The vehicle standardized network...includes a controller unit...that provides appropriate message and data handling functions associated with sending and receiving information including data from each of a plurality of physical vehicle devices...that are operatively connected to a bus...of the vehicle standardized network...the vehicle standardized network is an established and previously developed network that interfaces with components in a vehicle...in order to provide desired or requested data concerning operations or status of these components”, “...this further standardized network is a network that has been previously devised and is commonly used in a number of makes and models of vehicles”) is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request (e.g. the details/vehicle device codes/implementations constituting a previously established and developed vehicle standardized network that provides appropriate message and data handling functions associated with sending and receiving information including data from each of a plurality of physical vehicle devices that are operatively connected to a bus and used in

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a number of makes and models of vehicles, e.g. the SAE standards, e.g. J1850, provided in the form of SAE HS-3000 Manual) raising a substantial new question of patentability with respect to “the multi-vehicle compatible controller as recited in independent claims 1,13 and 18 , i.e. “said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”.

Given the teachings of the combination of Spaur ‘074 and SAE HS-3000, a reasonable examiner would consider these teachings important in evaluating the patentability of the independent claims of the ‘278 patent. This art was not applied/so combined during a previous examination of US Patent No. 8,032,278, and the claims at issue are not the subject of a final holding by a Federal Court. Accordingly, prior art patents and printed publications asserted by the Request raise a substantial question of patentability with respect to at least one claim, e.g. claim 1, of the ‘278 patent.

Beckert ‘363:

Requester asserts **Beckert ‘363** alone or in combination with SAE HS-3000, raises a substantial new question of patentability as to claims 1-22 of the ‘278 patent. See, e.g., page 7 of the Request.

The prosecution history indicates that SAE HS-3000 was not of record during the prosecution of any application to which the benefit of priority is claimed. Accordingly, such references is not precluded from raising a substantial new question of patentability.

Beckert ‘363 however was not only cited but applied by the examiner during the prosecution of at least ‘587 reexam.

Accordingly, at least the **Beckart ‘363** reference/evidence is “old art”. However, as set forth *supra*, e.g., MPEP 2242 states:

“for example, a substantial new question of patentability may be based solely on old art where the old art is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request.”

In this instance, Requester, see, e.g., Sections V (pages 3-7) and VI, A. (pages 7-14) of the Request, asserts the combination of **‘363** (previously before/considered by the Examiner during the examination/prosecution of the ‘587 reexam) with SAE HS-3000, see *supra*, a combination which was not considered during prosecution since the reference to, e.g., SAE HS-3000 was not even cited during prosecution. Accordingly, such combination is not precluded from raising a substantial new question of patentability.

During prosecution of the ‘272 application that led to the issuance of the ‘278 patent and the confirmation of patentability in the 90/013,587 reexam, the independent claims were allowed for reasons set forth by Examiner, see Summary of Prosecution History *supra*. Note also the June 2016 and July 2016 Interview Summaries with regard to ‘363 in Summary of Prosecution History *supra*.

Finally, see the Request at, e.g., Sections V (pages 3-7), and VI, A. (pages 7-14) and Exhibit B, e.g., bridging pages 4-6 and page 11-12. Such section V of the instant Request is set forth *supra* and section VI, A. sets forth:

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VI. STATEMENTS POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

...as explained in greater detail below, A) the Beckert '363 patent; B) the Spaur '074 patent; C) the Suman '537 patent; and D) the Chou '499 patent either alone or in combination with the SAE HS-3000 Manual, all of which were published more than a year prior to the earliest priority date to which the Flick '278 patent is entitled to, raise substantial new questions of patentability with respect to the Flick '278 patent.

A. U.S. Patent No. 6,009,363 to Beckert (inherently disclosing the SAE HS-3000 Manual)

...These references were not considered during the original prosecution of the Flick '278 patent. However, the Beckert '363 patent was considered during the Flick '587 Reexam, but was inexplicably withdrawn from the Flick '587 Reexam with no reasons being made on the record as to why this rejection was being withdrawn. Accordingly, Requester is again resubmitting this reference for at least the following reasons:

1. No Reasons Provided Why Beckert '363 Patent Withdrawn From Rejection in the Flick '587 Reexam --- Examiner Interview Summary filed 6-21- 2016 in the Flick '587 Reexam

...

Accordingly, Requester is re-submitting the Beckert '363 patent, including the SAE HS- 3000 Manual which is inherently disclosed by the OBD II interface being used in the Beckert '363 patent (see e.g., Beckert '363 col. 1, lines 32 - 35 stating: "Most late model vehicles are also constructed with a diagnostic system that analyzes performance of the vehicle's engine, transmission and fuel system, and other components (1996 or later for OBD II, 1993 or later for OBD I)...").... These references provide new technological teachings that raise a substantial new question of patentability with respect to the Flick '278 patent.

2. Technological Teaching: Transmitting Location Data, Communicating Via an OBD II Vehicle Data Bus, and Downloading Means Downloading Enabling Data

The Beckert '363 patent teaches 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

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devices via the OBD II standardized vehicle data bus mandated for inclusion in 1996 or later model vehicles. ...

The Beckert '363 patent also incorporated by reference the disclosure of U.S. Patent 5,794,164 to Beckert et al. (the Beckert '164 patent) in its entirety at col. 7, lines 44-51. The Beckert '164 patent provides additional detail concerning the modules of the vehicle computer system disclosed in the Beckert '363 patent and specific detail concerning the OBD interpreter and APIs that are exposed to remote devices by the vehicle computer system, including a diagnostic API (amongst others). The SAE standards, and in particular the SAE HS-3000 Manual, were published for the specific purpose of teaching people of ordinary skill in the art how to communicate with vehicle devices via the OBD II interface. In particular, the SAE HS- 3000 Manual teaches a bus discovery procedure that can be used by systems interfacing with a vehicle bus via an OBD II diagnostic connector, which involves communicating with vehicle devices using at least one vehicle device code from among a plurality thereof for different vehicles. ...

Accordingly, the Beckert '363 patent teaches that the modules inherently disclose the use of the bus discovery protocols that involve sending a plurality of device codes for different vehicles required by the SAE standards as that specify the implementation details for the OBD II interface. Furthermore, it would have been obvious to utilize the teachings described in the SAE HS-3000 Manual because the Beckert '363 patent expressly directs communicating with the OBD system built into the vehicle using the OBD interface. Thus, the Beckert '363 patent is being presented in a new light in view of the SAE HS-3000 Manual that raises a substantial new question of patentability.

...

4. Substantial New Question of Patentability as to Claims 1 - 22 because the Beckert '363 Patent in view of the SAE HS-3000 Manual Teaches all Claim Elements

Each of claims 1 - 22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit B, the Beckert '363 patent in view of the SAE HS-3000 Manual disclose this and all other required limitations, explicitly disclosing communicating via a "vehicle data bus" and a "downloading interface". Accordingly, all aspects of claims 1-22 are disclosed by the Beckert '363 patent and the SAE HS-3000 Manual. A reasonable examiner would consider the teachings important in deciding whether or not claims 1-22 of the Flick '278 patent are patentable. For these reasons, the Beckert '363 patent, including the SAE HS-3000 Manual, raises a substantial new question of patentability as to claims 1-22.

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(Underlined italics added.)

Therefore, Beckart '363 (e.g. “Most late model vehicles are also constructed with a diagnostic system that analyzes performance of the vehicle’s engine, transmission and fuel system, and other components (1996 or later for OBD II, 1993 or later for OBD I). The diagnostic system can be coupled to an external computer to download or monitor diagnostic information that is useful to a vehicle mechanic during servicing of the vehicle.”, “...the vehicle computer system...can be used to integrate multiple vehicle-related systems onto one open platform hardware and software architecture. For instance, the vehicle computer system...can serve as, a navigation system, a communications system, a security system, and a diagnostics system. ...FIG. 2 shows the computer 22 according to one implementation of the invention. Computer 22 has three primary modules: a faceplate module 60, a support module 62, and a computer module 64. The computer module 64 is operatively connected to the support module 62 via a multi-bit bus 66. In FIG. 2, the support module 62 is also connected to a universal serial bus (USB) hub 70 via a multi-bit connector 72 (e.g., 8 bits). The USB hub 70 provides connections to many peripheral devices (e.g., 128 devices). Example peripheral devices include the OBD (On Board Diagnostic) system 28, the security system 26, navigation system 74, a wireless link 76 to the Internet, a CD-ROM changer 78, a TV tuner 80, and user I/O devices such as a joystick, keyboard or a mouse 82. This USB hub could be separate as shown in FIG. 2 or it could be integrated into one or more of the USB peripherals.”, “A more detailed explanation of the three modules in the vehicle computer system is provided in ...U.S. Pat. No. 5,794,164 ... incorporated herein by reference” and thereby, “The computer module 64 has a navigation

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system 112 which includes both a GPS (global positioning system) receiver and a map application, such as Automap.TM., a program produced by Microsoft Corporation. A security system 114 is provided in the computer module 64 to manage vehicle security. The security system 114 monitors the security sensors 26 (FIG. 1) for any potential threat of theft or vandalism. The security system 114 is connected to actuators which lock/unlock doors and windows, and to an alarm which can be activated upon detection of unwanted tampering. An OBD (On Board Diagnostic) interpreter 116 is provided in the computer module to communicate with the OBD system built into the vehicle by the manufacturer. The OBD interpreter 116 interprets the status data received and provides performance related information from the vehicle's OBD system to the microprocessor 100. Also, commands can be provided to the interpreter which allows non-critical car systems to be controlled.”) is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request (e.g. the details/vehicle device codes/implementations constituting On Board Diagnostics for Light and Medium Duty Vehicle standards , e.g. the SAE standard J1850, provided in the form of SAE HS-3000 Manual) raising a substantial new question of patentability with respect to “the multi-vehicle compatible controller as recited in independent claims 1,13 and 18 , i.e. “said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”.

Given the teachings of the combination of Beckart ‘363 and SAE HS-3000, a reasonable examiner would consider these teachings important in evaluating the patentability of the

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independent claims of the '278 patent. This art was not applied/so combined during a previous examination of US Patent No. 8,032,278, and the claims at issue are not the subject of a final holding by a Federal Court. Accordingly, prior art patents and printed publications asserted by the Request raise a substantial question of patentability with respect to at least one claim, e.g. claim 1, of the '278 patent.

Chou'499:

Requester asserts that **Chou '499** either alone or in combination with SAE HS-3000, raises a substantial new question of patentability as to claims 1-22 of the '278 patent. See, e.g., page 7 of the Request.

The prosecution history indicates that SAE HS-3000 was not of record during the prosecution of any application to which the benefit of priority is claimed. Accordingly, such reference is not precluded from raising a substantial new question of patentability.

Chou '499 was not explicitly cited and discussed during the prosecution of the '278 patent or the '587 Reexam. However '499 was cited and discussed during the prosecution of the '972 application, see Summary of Prosecution History *supra*

Accordingly, at least the **Chou '499** reference/evidence is "old art". However, as set forth *supra*, e.g., MPEP 2242 states:

"for example, a substantial new question of patentability may be based solely on old art where the old art is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request."

In this instance, Requester, see, e.g., Sections V (pages 3-7) and VI, D. (pages 23-25) of the Request, asserts **'499** (previously before/considered by the Examiner during

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examination/prosecution of the '972 application) alone or in combination of '363 with SAE HS-3000, see *supra*, a combination which was not considered during prosecution since the reference to, e.g., SAE HS-3000 was not even cited during prosecution. Accordingly, such combination is not precluded from raising a substantial new question of patentability.

During prosecution of the '272 application that led to the issuance of the '278 patent and the confirmation of patentability in the 90/013,587 reexam, the independent claims were allowed for reasons set forth by Examiner, see Summary of Prosecution History *supra*.

Finally, see the Request at, e.g., Sections V (pages 3-7), and VI, D. (pages 23-25) and Exhibit B, e.g., bridging pages 4-5. Such section V of the instant Request is set forth *supra* and section VI, D. sets forth:

VI. STATEMENTS POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

...as explained in greater detail below, A) the Beckert '363 patent; B) the Spaur '074 patent; C) the Suman '537 patent; and D) the Chou '499 patent either alone or in combination with the SAE HS-3000 Manual, all of which were published more than a year prior to the earliest priority date to which the Flick '278 patent is entitled to, raise substantial new questions of patentability with respect to the Flick '278 patent.

...

D. U.S. Patent No. 6,330,499 to Chou et al.

The Chou '499 patent issued December 11, 2001 and therefore is prior art to the Flick '278 patent under 35 U.S.C. §§ 102(a), 102(b), and 102(e). This reference was not considered during the prosecution of the Flick '278 patent or the currently pending Flick '587 Reexam. This reference provides a new technological teaching that raises a substantial new question of patentability.

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1. Technological Teaching: Obtaining and Transmitting Location Data using a Standard Vehicle Bus and using model dependent codes

The Chou '499 patent teaches a vehicle information system including a wireless communication device, a vehicle location determining device, and a controller capable of communicating with a variety of vehicle devices via a standardized vehicle data bus using a vehicle bus interface that may support different vehicle bus standards such as CAN (Controller Area Network) and the Society of Automotive Engineers' SAE J1850 - Class B Data Communications Network Interface. (Chou, col. 3, lines 33-40)....

...

The Chou '499 patent further teaches multi-vehicle compatibility, whereby a vehicle bus adaptor (120C) "translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be **Original Equipment Manufacturer (OEM) and model dependent** A listing of such codes may be found in the publication of the Society of Automotive Engineers, "SAE On-Board Diagnostics for Light and Medium Duty Vehicle Standards Manual". (Chou, col. 4, lines 25-35, [bold original] emphasis added).

Thus, the Chou '499 patent discloses technological teaching that the Examiner previously found to be missing from the prior art of record disclosed in the Flick '278 patent.

...

3. Substantial New Question of Patentability as to Claims 1 - 22 because the Chou '499 Patent Teaches all Claim Elements

Each of claims 1 - 22 require a multi-vehicle compatible controller coupled to a vehicle data bus for communication thereover with at least one vehicle device. As shown above, and in more detail in the claim charts attached as Exhibit E, the Chou '499 patent discloses this and all other required limitations, explicitly disclosing communicating via a "vehicle data bus", translating "messages from the fault detector into the language of the vehicle bus" where the fault code specifications may be "Original Equipment Manufacturer (OEM) and model dependent" and a downloading interface for permitting downloading of enabling data.

Accordingly, it is submitted that all aspect of claims 1 - 22 are disclosed by the Chou '499 patent. A reasonable examiner would consider the teachings important in deciding whether or not claims 1 - 22 of the Flick '278 patent are patentable.

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For these reasons, the Chou '499 patent raises a substantial new question of patentability as to claims 1 - 22.
(Underlined italics added.)

Therefore, Chou '499 (e.g. "The processor 300 is coupled to a vehicle bus 335 through a vehicle bus interface 330....The vehicle bus interface may support one of vehicle bus standards such as CAN (Controller Area Network) and the Society of Automotive Engineers' SAE J1850 - Class B Data Communication Network Interface. Alternatively, the processor supports some or all of the functions of the vehicle bus interface and connects directly to the vehicle bus 335. The vehicle bus shown in FIG. 2 is an inherent part of all new automobiles. The dotted line is used as an indication that the vehicle bus is built into the vehicle." or "The vehicle bus interface 120 includes the following modules: vehicle bus adapter 120C, fault detector 120B, and diagnostic data service 120A. The fault detector 120B polls the vehicle bus 104 through the vehicle bus adapter 120C checking for fault codes reported by the vehicle ECUs 103. The vehicle bus adapter 120C translates the messages received from the vehicle bus into the language of the fault detector. It also translates messages from the fault detector into the language of the vehicle bus. The fault code specifications and protocols of the vehicle may be Original Equipment Manufacturer (OEM) and model dependent. The term 'vehicle fault codes' is meant to be synonymous with the term 'trouble code' or 'diagnostic trouble code'. A listing of such codes may be found in the publication of the Society of Automotive Engineers, 'SAE On-Board Diagnostics for Light and Medium Duty Vehicles Standards Manual'. The diagnostic data service 120A accepts request for vehicle parametric data and retrieves the data using the vehicle bus adapter.", "The remote service center 200 of FIG. 3 comprises a diagnostic server 201 that has access to data related to the vehicle such as as-built, history, diagnostics, warranty, service

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information and failure mode data. The diagnosis server 201 is linked to the data repository 203 via a TCP/IP link, LAN, or the like”, “...remote health monitoring and diagnostics shares many features with other automotive applications and services. It may be desirable to bundle the remote health monitoring and diagnostics with other services or to extend it with related application functions. For example, the remote diagnostics service could certainly be offered on top of an Emergency/Mayday service (e.g., ‘OnStar’). Other applications and services that can be developed or bundled as extensions of the diagnostics services include: breakdown service, network diary, vehicle user manual update, OEM Callback Services, fleet management, theft prevention, vehicle parameter update/change, remote vehicle access, concierge services, etc.”) is being presented viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request (e.g. the details/vehicle device codes/implementations constituting On Board Diagnostics for Light and Medium Duty Vehicle standards, e.g. the SAE standard J1850-Class B Data Communications Network Interface beginning on page 146, provided in the form of SAE HS-3000 Manual or being presented other than for its teachings of “...a user interface for accepting at least one command from a user and sending at least one alert to the user (column 3, lines 5-15)”) raising a substantial new question of patentability with respect to “the multi-vehicle compatible controller as recited in independent claims 1,13 and 18 , i.e. “said multi-vehicle compatible controller to be coupled to the vehicle data bus for communication thereover with at least one vehicle device using at least one corresponding vehicle device code from among a plurality thereof for different vehicles”.

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Given the teachings of the combination of Chou '499 and SAE HS-3000, a reasonable examiner would consider these teachings important in evaluating the patentability of the independent claims of the '278 patent. This art was not applied/so combined during a previous examination of US Patent No. 8,032,278, and the claims at issue are not the subject of a final holding by a Federal Court. Accordingly, prior art patents and printed publications asserted by the Request raise a substantial question of patentability with respect to at least one claim, e.g. claim 1, of the '278 patent.

Conclusion

Accordingly, as a substantial new question of patentability is present, reexamination is granted, see MPEP 2242. Claims 1-22 of '278 **will be** reexamined.

Correspondence

8. **All** correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
 Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office

P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
 Central Reexamination Unit

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By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/my_portal/efs-registered. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

Other useful telephone numbers:

Reexamination Practice (571) 272-7703

Reexamination Facsimile Transmission No. (571) 273-9900

/Karin M. Reichle/
Examiner, CRU
Art Unit 3992

Conferees:
/J. W./
Primary Examiner, Art Unit 3992

/WHC/
SPRS, Art Unit 3992

Order Granting Request For Ex Parte Reexamination	Control No. 90/013,851	Patent Under Reexamination 8032278
	Examiner Karin Reichle	Art Unit 3992

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

The request for *ex parte* reexamination filed 28 October 2016 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/Karin Reichle/ Primary Examiner, Art Unit 3992	/J. W./ Primary Examiner, Art Unit 3992	
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cc:Requester (if third party requester)