

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

AUTO TELEMATICS LTD.,
Patent Owner.

IPR2023-00519
Patent 9,633,487 B2

PETITIONER'S REQUEST FOR REHEARING

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71(c)-(d), Petitioner respectfully requests rehearing of the Board’s Decision (Paper No. 10, “ID” or “Decision”) denying institution of *inter partes* review of claims 1-13 (“the Challenged Claims”) of U.S. Patent No. 9,633,487 (“the ’487 Patent”). Petitioner details the basis for this Motion below, specifically identifying all matters Petitioner believes “the Board misapprehended or overlooked” and “the place where each matter was previously addressed” in the Petition. 37 C.F.R. § 42.71(d). Petitioner requests that the Board grant rehearing and institute a trial on all Challenged Claims.

II. BASIS FOR RELIEF

The Board found that “the Petition fails to establish that P3 does not provide sufficient written description support for claim 1,”¹ and consequently that “the Petition fails to satisfy Petitioner’s burden to establish that Peng qualifies as prior art,” which is “fatal to the Petition.” ID, 21. In doing so, the Board misapprehended or overlooked a predicate position advanced by Petitioner, namely an argument found within the Petition concerning the proper construction for the term “driving period” as it relates to Element [1.6], and for that reason, the Board misapprehended or overlooked attendant shortcomings in Patent Owner’s arguments relating to P3’s alleged written description support for Element [1.6], properly construed.

¹ P3 is Priority Document GB 1109759.9 filed 10 June 10, 2011 (USAA-1505).

In particular, the Petition established that a “driving period,” which was recited in Element [1.6]², is properly construed within the context of that claim and based on its plain meaning as being defined by each of two independent attributes: “(1) ‘the mobile device is removably attached to the vehicle’ and (2) ‘the vehicle is in use.’” Pet., 3-4. The Decision did not find otherwise.

Indeed, on this record, Patent Owner does not dispute the Petition’s position that claim 1’s Element [1.6] recites a “mobile telecommunications device configured to” *determine “a start of a driving period” defined by the mobile device being “removably attached to the vehicle”* while “the vehicle is in use,” *“based on inputs received by the user interface and sensor data* from the device’s sensor set.” Pet., 3 (emphasis added); POPR, 12 (not disputing the Petition’s discussion of the plain and ordinary meaning of a “driving period”). Nor did the Decision resolve to a contrary construction of Element [1.6]. *See* ID, 9-15, 18.

And yet, Patent Owner’s Preliminary Response (POPR) suggests that written description support exists to establish priority, based on alleged disclosure of inputs that are not used to determine the “start of” anything—much less the “start of” a “driving period,” as claimed. *See* POPR, 14-19. The Decision’s analysis is similarly

² Petitioner sought to clarify the claim construction issue in a call with the Board. USAA-1082, 9:9-19, 10:1-16, 17:10-12.

limited to whether “inputs received by the user interface and sensor data from a mobile device’s sensor set” are used to determine any driving period—without regard for a driving period that is determined to exist—albeit based on the inputs and sensor data—when the mobile device is removably attached to the vehicle and the vehicle is in use. ID, 11-15.

And, rather than addressing how the mobile device determines whether the mobile device is “removably attached to the vehicle,” the Decision follows the POPR’s lead (again) by focusing on alleged disclosure of nothing more than mere attachment, unknown and unleveraged by the device itself toward any determination. *See* POPR, 18; ID, 13.

In the absence of the Board resolving a construction for Element [1.6] contrary to that proffered by the Petition, non-institution based on the POPR’s alleged written description support for that same element, which does not meet the proffered construction, represents a misapprehension or oversight. Moreover, the Board further misapprehended or overlooked Patent Owner’s reliance on an obviousness analysis rather than application of the written description standard in attempting to establish such support in the priority documents. *See, e.g.*, POPR, 15, 17-18; *see also id.*, 20, 21.

A. The Petition’s claim construction of “driving period.”

The Petition establishes that the plain meaning of a “driving period” as recited in Element [1.6] includes two attributes: “(1) ‘the mobile device is removably attached to the vehicle’ and (2) ‘the vehicle is in use.’” Pet., 3-4 (citing USAA-1003, ¶103). Element [1.6] explicitly recites these requirements: “**determine**, based on the inputs received by the user interface and sensor data from the device’s sensor set, a start of *a driving period during which the mobile device is removably attached to the vehicle* and the vehicle in use.” *Id.*, 3 (emphasis added). The emphasized portion of this claim language is key, as it expressly includes the words “during which” and “determining,” and together these words indicate that the claimed driving period is a period in which the aforementioned two attributes are determined to exist. To this point, absent denying meaning to these terms, priority for this claim must do more than describe mere coincidence of either or both of these two attributes; priority requires written description of using “inputs received by the user interface and sensor data from the device’s sensor set” **to determine** a “start of a driving period” where the driving period is a time during which “the mobile device is removably attached to the vehicle” and “the vehicle is in use.” *See id.*, 3-4; USAA-1003, ¶103.

A determination by the mobile device of the start of its driving period based on these attributes is present not only in the ’487 Patent claims, but also arguably in its specification. With respect to the start of a driving period being determined based

on the first attribute (“the mobile device is removably attached to the vehicle”), for instance, the ’487 Patent offers the following relevant disclosure: “the start of the driving period may be initiated *once the application determines that the mobile telecommunications device 17 has been affixed to the vehicle.*” USAA-1001, 19:6-10 (emphasis added); *see id.*, 3:31-61; Pet., 3-4. And alignment of the recited claim language with this embodiment becomes apparent when considering that this disclosure (and the recited claim language) stands in contrast with an embodiment that describes a driving period, the start of which is determined “once sensor data above a minimum threshold value is recorded.” USAA-1001, 18:63-19:6; *see id.*, 3:31-61; Pet., 3-4.

The Board appears to have overlooked or misunderstood Petitioner’s analysis of the plain meaning of “driving period,” as the Decision does not address Petitioner’s claim construction discussion of Element [1.6]. *See, generally*, ID; Pet., 3-4.

In discussing Element [1.6], the Decision states that the claim merely requires that the mobile device is “removably attached to the vehicle and the vehicle is in use,” without acknowledging the claim’s requirement that the start of a driving period is determined to exist—based on user inputs and sensor data—when the mobile device is removably attached to the vehicle (and the vehicle is in use). ID, 13. And this oversight or misapprehension led to a conclusion within the Institution

Decision that P3 disclosure of the mobile device “mounted adjacent the vehicle windscreen” (ID, 12, 13) is sufficient to provide written description for Element [1.6], but it is not. *See infra* §II.B. Rather, as discussed in the Petition and above, consistent with the plain language of Element [1.6] when read in context and consistent with the ’487 Patent specification, the claimed start of a driving period is ***determined to exist***—based on the inputs and sensor data—when the mobile device is removably attached to the vehicle and the vehicle is in use. Pet., 3-4; USAA-1001, 18:63-19:16. As such, the Board clearly misapprehended or overlooked the plain meaning of “driving period” as it relates to Element [1.6].

B. The Board misapprehended or overlooked the shortcomings of P3 as it relates to Element [1.6].

Unsurprisingly, the above misapprehension or oversight relating to construction of Element [1.6] leads to a misapprehension or oversight regarding the manner in which the Decision compared that claim element to the priority document disclosure when endorsing written description support and thus priority for the claim element. The Decision’s treatment of Element [1.6] and its priority thus propagates and represents an independent misapprehension or oversight of Petitioner’s arguments concerning the plain meaning of a “driving period.” *See* ID, 9-15; Pet., 3-4.

Specifically, the Board’s analysis does not address or even acknowledge Petitioner’s discussion of the plain meaning of a “driving period” that is

characterized and thus determined to exist when two attributes are present: (1) “the mobile device is removably attached to the vehicle” and (2) “the vehicle is in use.”

Id. Rather, and to the exclusion of these claimed attributes, the Board’s analysis is focused on unclaimed issues: (1) whether “inputs received by the user interface and sensor data from a mobile device’s sensor set” are used to determine ***any*** driving period—not a driving period defined by the two required attributes, and (2) whether “the mobile device is removably attached to the vehicle”—regardless of how the attachment (or non-attachment) is determined or even taken into account to determine a start of a driving period. *Id.*

After establishing the plain and ordinary meaning of a “driving period” of Element [1.6], the Petition demonstrates that “P1-P3 fail to provide support for a mobile telecommunications device that ‘determine[s], **based on the inputs received by the user interface and sensor data** from the device’s sensor set, **a start of a driving period during which the mobile device** is removably attached to the vehicle and the vehicle is in use.’” Pet., 3-4, 6-7 (footnote omitted) (emphasis in original). In doing so, the Petition highlights the failure of the priority document to leverage both the user interface inputs and the sensor data to determine “a start of a driving period during which the mobile device is removably attached to the vehicle and the vehicle is in use,” as claimed. *Id.* In support of this argument, for example, the Petition addresses (1) portions of P3 that “appear[] to disclose that the mobile

device determines a start of a driving period without inputs received by the user interface” (Pet., 11 (citing USAA-1505, 19-20)) and portions of P3 that relate to the “tracking distances from the Witness application and the vehicle odometer” (Pet., 11-12 (citing USAA-1505, 20)).

In the POPR, Patent Owner alleges support from P3³ in the form of a user pressing a “Start/Stop Recording” button and a mobile device “having a touch sensitive screen” (allegedly as “inputs received by the user interface”) (POPR, 14-16 (citing USAA-1505, 10:27, 10:33, 5:35, FIG. 1)) and using GPS to “determin[e] whether the driver is ‘[d]riving faster than the speed limit allocated to a given road (detected by GPS)’” (allegedly as “sensor data from the device’s sensor set”) (POPR, 16 (citing USAA-1505, 8:35, 10:16, 12:18-21)). In particular, Patent Owner first alleges that “one of the inputs to determine the start of a driving period may comprise a user pressing the ‘Start/Stop’ button on the touch screen,” POPR, 15-16. Patent Owner cites to a “safety feature of the witness application that hides the video feed during recording when the vehicle is detected as traveling above a pre-determined speed.” *Id.*, 17 (citing USAA-1505, 14:34-15:9). Patent Owner argues that “once the

³ While the Petition argues that none of the priority documents (P1-P3) provide support for the Element [1.6], Patent Owner alleges only that P3 provides support. Pet., 6-7, 9-12; USAA-1003, ¶¶74-90; POPR, 13-19.

vehicle reaches a predetermined speed (*e.g.*, 10 mph) as determined by the sensor set, then the driving period during which a distracted driver may be a real safety concern is initiated.” *Id.*, 18. In concluding that “Patent Owner has the better-supported position,” the Board misapprehended or overlooked several flaws in Patent Owner’s arguments. *ID*, 11.

First, Patent Owner does not cite to any portion of P3 that provides written description support for how any alleged “inputs received by the user interface and sensor data from the device’s sensor set” are collectively used to determine “a start” of any period, much less the particular claimed driving period. *See Pet.*, 3-4 (discussing the plain and ordinary meaning of a “driving period”). At best, the user input of pressing the “Start/Stop Recording” button “starts recording video footage and other data,” but this recording period is determined absent any sensor data concerning the vehicle’s speed. USAA-1505, 10. Patent Owner’s alleged “start of a driving period” occurs “once the vehicle reaches a predetermined speed,” which Patent Owner defines as “the driving period during which a distracted driver may be a real safety concern.” POPR, 18. Notably, however, P3 defines the “start” of no such driving period and merely describes a “safety feature” for switching between displaying a map or a video feed, depending on the driving speed. USAA-1505, 14-15, FIG. 8. Triggering the “safety feature” to display a map has no effect on the video recording, which “continues in the background.” *Id.*

Second, given that Patent Owner fails to show that P3 teaches the “start of” any period, it follows, then, that Patent Owner further fails to cite to any portion of P3 that teaches using “inputs received by the user interface and sensor data from the device’s sensor set” to determine “a start of a driving period *during which the mobile device is removably attached to the vehicle*,” as Element [1.6] requires. Patent Owner further fails to show how those relied-upon values in P3 relate to identifying that “*the mobile device is removably attached to the vehicle*,” a requisite attribute of the particular claimed “driving period.” *See, generally*, POPR, 14-19.

Rather, as noted above, the only portion of the POPR that attempts to address this aspect of “a driving period *during which the mobile device is removably attached to the vehicle*” arises in the form of a fictional “real-world example” discussed and described for the first time in the POPR (and nearly verbatim in the expert declaration). POPR, 18; AT-2001, ¶29. Neither the POPR nor the expert declaration includes a citation to any portion of P3 or any other priority document, affording such conclusory statements little to no weight. *Id.*; *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (Aug. 24, 2022) (“*Xerox*”) (finding an expert declaration that did not “cite to any additional support evidence or provide any technical reasoning to support his statement” to be “conclusory and unsupported” and thus “entitled to little weight”). Even if this “real-world example” had been included in P3, and it was not, it still does not address the shortcomings of

P3—that “the inputs received by the user interface and the sensor data from the device’s sensor set” are not disclosed as being used to determine “a start of a driving period during which the mobile device is removably attached to the vehicle.” Indeed, even though the “real-world example” states that the user has removably attached her smart phone to the car via a docking station, the user input of “the user press[ing] the start button” and “the vehicle reach[ing] a predetermined speed (*e.g.*, 10 mph) as determined by the sensor set)” are not used by the device to determine a start of a driving period during which the mobile device is removably attached. POPR, 18; AT-2001, ¶29; *see* Pet., 3-4. The “removably attached” state of the mobile device is known to the reader only because Patent Owner’s fictional scenario defines it as such, while being left unknown to the mobile device itself. POPR, 18. The user input and speed of the vehicle are irrelevant to any determination of the “removably attached” state of the mobile device. *Id.*

The Board’s analysis of this element misapprehends or overlooks the claim’s requirement that “the inputs received by the user interface and sensor data from the device’s sensor set” must be used to determine “a start of a driving period **during which the mobile device is removably attached to the vehicle.**” *See* ID, 9-15. Rather, the claim is oversimplified by reading out the language that characterizes the determined start of a driving period, concluding that P3’s blanket statement that “[i]n use, the mobile device is mounted adjacent the vehicle windscreen” provides

“support for the requirement that the mobile telecommunications device is ‘removably attached to the vehicle and the vehicle is in use.’ ID, 12, 13 (citing USAA-1505, 5). It does not address P3’s silence with respect to how the alleged “inputs” or “sensor data” are used to determine whether the mobile device is “removably attached to the vehicle,” and thus, whether a driving period has started. *Id.*

C. The Board misapprehended or overlooked Patent Owner’s flawed written description analysis as it relates to P3 and Element [1.6].

In alleging written description support from P3, Patent Owner relies on more than just P3’s disclosure, contrary to Patent Owner’s claim that it did not “argue anything outside of P3” when countering Petitioner’s request for reply briefing. USAA-1082, 13:7-9 (“We didn’t argue anything outside of P3. We just said, ‘Hey, P3 supports the ultimate - - the patent at issue here.’”). Instead, in instances where P3’s disclosure fell short of the written description requirement, Patent Owner relies on what a POSITA allegedly would have known—inexplicably confusing its written description analysis for obviousness. POPR, 15 (“a person of ordinary skill in the art would know that the device could receive user inputs...”), 17-18 (“a person of ordinary skill in the art would have known that the application could make this same determination”), 21. Significantly, the factual inquiry for written description is “whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention as

now claimed.” MPEP § 2163.02 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)). Patent Owner’s argument provides no indication as to what information a POSITA would have understood *the inventor* to be in possession of in light of P3, and its accompanying expert declaration is similarly lacking. *See, generally*, POPR, 14-19; AT-2001, ¶¶23-30.

The Board misapprehended or overlooked Patent Owner’s flawed analysis concerning P3 and Element [1.6]. Indeed, the ID’s discussion of Patent Owner’s arguments cites to Patent Owner’s claim that ““a person of ordinary skill in the art would have known that the application could’ determine when ‘to switch from a live video feed to a map view’”—a statement irrelevant to a written description analysis. ID, 11 (citing POPR, 17-18 (internal citations omitted)).

III. CONCLUSION

For the reasons stated in §§II.A-C, the Board should grant rehearing and institute *inter partes* review on Grounds 1A-1D.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on October 23, 2023, a complete and entire copy of this Petitioner's Request for Rehearing was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

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