

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

Before GEORGE R. HOSKINS, FRANCES L. IPPOLITO, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

United Services Automobile Association (“Petitioner”) has filed a timely Request for Rehearing (Paper 11, “Petitioner’s Request” or “Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 10, “the Decision” or “Dec.”) of U.S. Patent No. 9,633,487 B2 (Ex. 1001, “the ’487 patent”). We deny the request for two reasons. First, it relies on arguments not made in the Petition (Paper 3, “Pet.”) or the Preliminary Response (Paper 6, “Prelim. Resp.”). Second, even considering Petitioner’s new arguments, Petitioner’s Request does not persuade us that we should have instituted review.

II. DISCUSSION

A. *Statement of Law*

A party dissatisfied with a decision may file a request for rehearing. *See* 37 C.F.R. § 42.71(d). “The burden of showing a decision should be modified lies with the party challenging the decision.” *Id.* Petitioner’s Request “must specifically identify all matters [Petitioner] believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in” the Petition or the Preliminary Response. *Id.*

B. *Element [1.6] of Claim 1 of the ’487 Patent*

Petitioner’s Request concerns what Petitioner has identified as Element [1.6] of claim 1. *See* Req. 1; Dec. 4–5 (reproducing claim 1 of the ’487 patent with Petitioner’s bracketed identifications). Element [1.6] recites, with our emphasis added to the language that is the focus of Petitioner’s Request: a “mobile telecommunications device configured to: *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 is in use.*” Ex. 1001, 31:51–56 (emphasis added).

C. Summary of the Decision

The Decision denied institution on the basis that the Petition did not demonstrate a reasonable likelihood of showing that Peng (Ex. 1005) qualifies as prior art to the ’487 patent. *See* Dec. 22. The Decision particularly determined, on the record presented, that the Petition failed to establish the ’487 patent’s parent application P3 (Ex. 1505) does not provide written description support for claim 1. *See* Dec. 21.

D. Petitioner’s Request

Petitioner’s Request argues the Decision’s consideration of P3 “misapprehended or overlooked a predicate position advanced” in the Petition relating to “the proper construction for the term ‘driving period’ as it relates to Element[1.6].” Req. 1. This claim construction is “that a ‘driving period[’] . . . is properly construed . . . 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.”’” *Id.* at 1–2 (quoting Pet. 3–4).¹ Petitioner argues the Petition relied on that claim construction as a basis for asserting P3 lacks written description support for claim 1, which was

¹ Petitioner’s Request also states “Petitioner sought to clarify the claim construction issue in a call with the Board.” Req. 2 n.2 (citing Ex. 1082 (Transcript of Telephone Conference held July 25, 2023), 9:9–19, 10:1–16, 17:10–12). However, the issue presented here is what were the arguments Petitioner made in the Petition, not in a later telephone conference held after Petitioner had reviewed the Preliminary Response.

overlooked in the Decision. *See id.* at 1–2, 4, 6–8 (citing Pet. 3–4 (claim construction) and Pet. 6–7, 11–12 (argument concerning P3)). Petitioner concludes that, applying this claim construction, P3 does not provide written description support for claim 1, and the Decision accordingly misapprehended or overlooked this deficiency. *See id.* at 8–12.

Petitioner’s Request also argues the Decision “misapprehended or overlooked Patent Owner’s [improper] reliance on an obviousness analysis rather than application of the written description standard” in arguing P3 provides written description support for claim 1 of the ’487 patent. Req. 3, 12–13 (citing Prelim. Resp. 14–21; Dec. 11). Petitioner asserts “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.’” *Id.* at 12–13 (quoting MPEP § 2163.02 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991))).

E. Analysis

We deny Petitioner’s Request because: (1) it relies on arguments not made in the Petition or the Preliminary Response; and (2) even considering Petitioner’s new arguments, they do not persuade us that we should have instituted review.

1. Petitioner’s Request Relies on Arguments Not Made in the Petition or the Preliminary Response

(i) Arguments Not Made in Petition

Petitioner’s Request relies on at least three arguments that were not made in the Petition.

First, we determine Petitioner did not argue in the Petition that P3 fails to disclose the claimed “driving period” based on the claim’s definition of that term as corresponding to a period “during which the mobile device is removably attached to the vehicle and the vehicle is in use.” The Petition’s claim construction does state that Element [1.6] “establishes just two ‘driving period’ attributes: (1) ‘the mobile device is removably attached to the vehicle’ and (2) ‘the vehicle is in use.’” Pet. 4. However, that definition of the term “driving period” is not the thrust of the proffered construction. Instead, Petitioner’s construction in the Petition seeks to impart a breadth to claim 1—that the recited “start of a driving period” need not correspond to the start of driving, in part because neither of the two attributes refers to “driving” or an analog thereof. *See id.* at 3 (stating Element [1.6] “leaves open the possibility of the driving period corresponding to the beginning, middle or end of, a vehicle’s operation”), 4 (concluding “[t]hese attributes may be satisfied by a start of a data collection period, whether at the onset of vehicle driving or whether instead before or thereafter”).

Petitioner in the Petition then relies on that imparted breadth to argue the combination of Peng and Chatterjee determines “the start of a driving period,” equating that claim phrase in various fashions to the start of any period “during vehicle usage.” *See, e.g., id.* at 21 (stating “Peng’s handheld device 10 *determines a start of a driving period, e.g., determines whether **during vehicle usage** data collection can begin*” (emphases added)); *id.* at 26–28 (arguing “it would have been obvious to a POSITA to have leveraged those same sensors to *determine a start of a driving period, e.g., when the device is releasably attached (e.g., docked) **during vehicle usage*** in at least two ways” (emphases added)); *id.* at 41 (stating “a POSITA would

have found obvious to configure the Peng-Chatterjee's handheld mobile to *determine a start of a driving period, e.g., starting a data collection session on the device, **during vehicle usage***" (emphases added)).

Critically, the Petition does not rely on the claim's definition of "driving period" in Element [1.6] as corresponding to a period "during which the mobile device is removably attached to the vehicle and the vehicle is in use" as a basis for arguing P3 lacks written description support for Element [1.6]. The Petition's argument on this point is as follows:

With regard to element [1.6], P3 appears to disclose that the mobile device determines a start of a driving period without inputs received by the user interface. USAA-1505, 19–20; USAA-1003, ¶¶ 83–85. For example, P3 describes that the user should not be allowed to selectively activate the application because "it would not be beneficial from the perspective of the insurance company if the user could choose when to enable the application" and that "if a user could choose to disable the application when speeding then the effectiveness of the application would be reduced." USAA-1505, 19.

"Accordingly, the application may include measures to guarantee that the application is enabled whenever a given insured vehicle is being driven." *Id.*, 19–20.

P3 also fails to describe how sensor data from the device's sensor set is used to determine a start of a driving period during vehicle usage. USAA-1003, ¶¶ 81–85, 89. Although P3 describes tracking distances from the Witness application and the vehicle odometer, it lacks detail as to how the distance is calculated, let alone determination of the start of a driving period based on sensor data from the mobile device itself. USAA-1505, 20; USAA-1003, ¶¶ 84–85, 89. Furthermore, although P3 provides added disclosure directed to the use of a smart-holster, it fails to describe features of [1.6] — that is, the determination of a driving period based on inputs received by the user interface and sensor data are from the sensor set *of the mobile device*. *Id.*

Pet. 11–12. Although there are a few references to the claim term “driving period” in that argument, the argument is that P3 fails to disclose the claimed “inputs” to determining the start of a driving period, not that P3 fails to disclose the claimed “driving period” *per se*. *See id.* Indeed, despite emphasizing various points in **bold** or *italicized* typeface, the argument does not so emphasize “driving period.” *See id.* Nor does the argument emphasize the two claimed attributes of the term “driving period” (i.e., “the mobile device is removably attached to the vehicle” and “the vehicle is in use”). *See id.* Instead, the argument refers once in passing to “determin[ing] a start of a driving period *during vehicle usage*,” thereby applying the same broad claim construction to P3 that Petitioner applies to the Peng-Chatterjee combination as discussed above. *Id.* (emphasis added). Petitioner does not rely on a *restrictive* understanding of the “driving period” claim term, requiring the period to correspond to both (1) the device being removably attached to the vehicle and (2) the vehicle being in use, in an attempt to distinguish claim 1 from P3’s disclosure. *See id.*

The Request also cites the Petition’s introductory statement 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. 6–7 (alterations in original); *see* Req. 7. However, as with Petitioner’s supporting argument for this introductory statement (discussed above), the emphasis in the introduction is on the claimed “**inputs**” to determining the start of a driving period (Pet. 6–7), not on the two attributes of a driving period which are not bolded.

Second, Petitioner’s Request places some emphasis on the claim term “determine” in the Request’s overall discussion of the two “driving period” attributes specified in claim 1. *See* Req. 4–6. However, as can be seen from the discussion of the two attributes above, this argument was not made in the Petition. *See* Pet. 3–4 (discussing claim construction), 10–12 (discussing P3 disclosure).

Third, Petitioner’s Request expresses disagreement with the Decision’s explanation of how P3 demonstrates possession of the mobile device determining, based on inputs received by the user interface and sensor data from the device’s sensor set, a start of a driving period. *See* Dec. 11–15; Req. 8–12. However, the underlying analysis in the Request comparing Element [1.6] with the P3 disclosure is not expressed in the Petition. *Compare* Req. 8–12, *with* Pet. 10–12.

Because the foregoing arguments were not made in the Petition, they are not a proper basis for granting Petitioner’s Request for rehearing. *See* 37 C.F.R. § 42.71(d) (“*The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.*” (emphasis added)).

(ii) *Argument Not Made in Preliminary Response*

We also determine that Patent Owner in the Preliminary Response does not rely on an obviousness argument in asserting that P3 provides written description support for claim 1 of the ’487 patent.

Patent Owner’s argument concerns *what a person of ordinary skill in the art would have understood P3 to disclose what its Witness application*

can do (and thereby demonstrate written description support), as opposed to what a person of ordinary skill in the art could or would have modified P3 to do. *See* Prelim. Resp. 14–21. This is simply the application of the written description test, which requires that the document (here, P3) “must ‘reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 1016 (Fed. Cir. 2022) (emphasis added) (quoting *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)).

Just as important, the Decision is to the same effect. *See* Dec. 11–15 (Element [1.6]), 18–21 (Element [1.9]). Thus, because the obviousness argument posited in Petitioner’s Request was not made in the Preliminary Response, or adopted in the Decision, it cannot be not a basis for granting Petitioner’s Request for rehearing. *See* 37 C.F.R. § 42.71(d).

2. *P3 Discloses Determining A Start of a Driving Period During Which the Mobile Device is Removably Attached to the Vehicle and the Vehicle is in Use*

Next, even considering Petitioner’s new argument that P3 lacks written description support for determining a start of a driving period during which the mobile device is removably attached to the vehicle and the vehicle is in use, we conclude this argument is unavailing.

The Decision explains why Petitioner’s argument in the Petition does not demonstrate a reasonable likelihood of showing P3 fails to provide written description support for determining a start of a driving period “based on the inputs received by the user interface and sensor data from the device’s sensor set” as recited in Element [1.6]. *See* Dec. 9–10 (summarizing

Petitioner’s argument in the Petition), 11–15 (explaining determinations). The Decision focuses on the disclosure in P3 relating to its “example of operation” where “*the mobile device is mounted adjacent the vehicle windscreen so that a camera on the phone can see the road ahead.*” *Id.* at 12 (citing Ex. 1505, 5) (emphasis added); *see* Ex. 1505, 5:16–18 (“In use, the mobile device is mounted adjacent the vehicle windscreen so that a camera on the mobile telephone can see the road ahead.”).

The result of this mounting is shown in the bottom half of Figure 1 in P3, reproduced below:

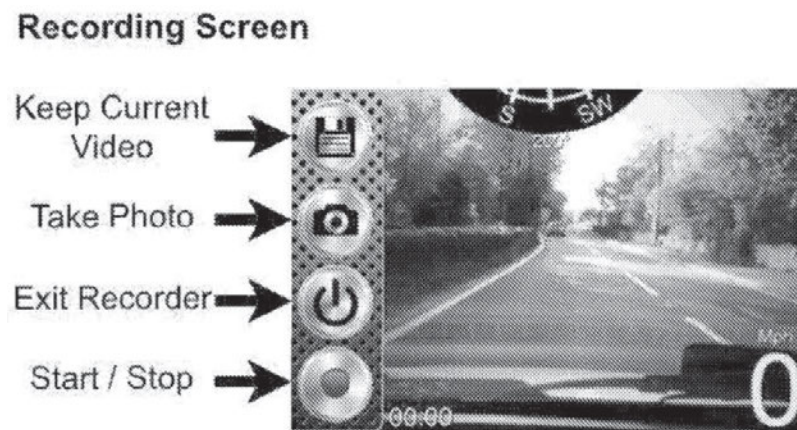


Figure 1 of P3 (Excerpt).

This portion of Figure 1 shows a “Recording Screen” presented on a smart phone (i.e., the mobile device of claim 1), which “contains a video feed from the camera of the smart-phone” with an overlay of “the detected speed of the vehicle (e.g. 0 mph), heading (e.g. south by south-west) and the elapsed recorded time (e.g. 00:00).” Ex. 1505, 10:13–19; *see also* Dec. 12 (“This allows the user to select the record button that starts a video feed from the mobile device camera, while the camera can see the road.” (citing Ex. 1505, 10)). These disclosures of P3 (Ex. 1505, 5:16–18, 10:13–19 (Fig. 1))

demonstrate possession of a mobile device being removably attached to the vehicle while the vehicle is in use, as recited in Element [1.6].

Further, the Decision explains how P3 also demonstrates possession of the mobile device *determining, based on inputs received by the user interface and sensor data from the device's sensor set, a start of a driving period* during which the device is removably attached to the vehicle while the vehicle is in use. *See* Dec. 11–15.

F. Conclusion

We deny Petitioner's Request because: (1) it relies on arguments not made in the Petition or the Preliminary Response; and (2) even considering Petitioner's new arguments, they do not persuade us that we should have instituted rather than denied review.

III. ORDER

In consideration of the foregoing, it is ORDERED that Petitioner's Request for Rehearing is *denied*.

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