

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner,

v.

AUTO TELEMATICS LTD.,
Patent Owner.

Case IPR2023-00769
Patent No. 10,192,369

**PATENT OWNER AUTO TELEMATICS LTD's PRELIMINARY
RESPONSE PURSUANT TO 37 C.F.R. §42.107**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	SUMMARY OF ARGUMENTS	2
III.	THE '369 PATENT	3
IV.	PRIMARY PRIOR ART REFERENCE RELIED ON BY PETITIONER – US PATENT APPLICATION PUB. NO. US 2011/0307188 TO PENG <i>et al.</i>	7
V.	PERSON OF ORDINARY SKILL IN THE ART.....	9
VI.	CLAIM CONSTRUCTION.....	10
VII.	PENG MAY NOT BE CONSIDERED AS PRIOR ART	11
	a. P3 Sufficiently Describes Feature 1.9.....	12
	(i) <i>P3 Sufficiently Discloses to a POSITA the Derivation of Driving Information “Without Data from Vehicle Sensors”</i>	12
	(ii) <i>P3 Sufficiently Discloses the Derivation of Driving Information Using Data from Both Vehicle and Mobile Device Sensors such that the Claim of Deriving Driving Information Without Data from Vehicle Sensors is Supported.....</i>	15
	b. The '369 Patent’s Specification Provides Sufficient Support for the Negative Limitation	19
	c. P3 Sufficiently Describes Features 1.10-1.13.....	20
VIII.	CONCLUSION	29

TABLE OF AUTHORITIES

<i>Ariad Pharms., Inc. v. Eli Lilly & Co.</i> , 598 F. 3d 1336(Fed. Cir. 2010).....	13
<i>Ex parte Grasselli</i> , 231 USPQ 393 (Bd. App. 1983), <i>aff'd mem.</i> , 738 F.2d 453 (Fed. Cir. 1984)	17, 20
<i>In re Johnson</i> , 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977)	17, 20
<i>Novartis Pharmaceuticals v. Accord Healthcare, Inc.</i> , Docket no. 2021-1070 (Fed. Cir. June 21, 2022)	13
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	10
 37 C.F.R. § 42.100(b).....	 10
35 U.S.C. § 103	2
35 U.S.C. § 112.....	13,18,20
35 U.S.C. § 282(b)	10
MPEP § 2173.05(i)	13

EXHIBITS

AT-2001 Declaration and *Curriculum Vitae* of Christopher Wilson

Patent Owner Auto Telematics Ltd. (“Patent Owner” or “Auto Telematics”) submits this Preliminary Response to the Petition filed by United Services Automobile Association (“Petitioner” or “USAA”) for *Inter Partes* Review (“IPR”) of claims 1-27 (the “Challenged Claims”) of U.S. Patent No. 10,192,369 (“the ’369 patent”). This response is being timely filed.

I. INTRODUCTION

A dispute in a UK county court over the cause of a minor traffic accident led to the conception of the inventions claimed in the family of patents in which the ’369 patent is included. Initially, the inventors developed a mobile device application that simply recorded video of a user’s vehicle journey in a rolling loop while also recording other useful information such as time of day, speed and GPS position (this latter information converted into a trace of the vehicle’s journey on a map). This application became known as the Witness App. Subsequently, a new app – Witness Pro – was developed allowing recordings of additional aspects of a vehicle’s journey recorded in a rolling loop which were then uploaded to a central server. Soon thereafter, a smartphone-based insurance telematics product was developed and offered to insurance companies in the UK as a cost-effective alternative to traditional vehicle insurance policies.

The ’369 patent describes methods and systems for logging driving information associated with a vehicle when driven. In one aspect, a mobile

telecommunications device is provided that may be adapted for installation to a vehicle and configured to log driving information associated with that vehicle. The mobile device is arranged to register the start of a driving period during which the mobile device is installed to the vehicle and the vehicle is being driven. Importantly, the mobile device is also arranged to process sensor data during the driving period to derive driving information associated with how the vehicle is driven. That driving information is then stored to the mobile device.

II. SUMMARY OF ARGUMENTS

As set forth in detail below, each and every argument raised by USAA in its Petition primarily relies on U.S. Patent Application No.: US 2011/0307188 to Peng *et al* (“Peng”) being combined with certain prior art references which USAA argues render the claims of the ’369 patent obvious under 35 U.S.C. § 103. While the Peng reference is most certainly distinguishable from the teachings and claims of the ’369 patent, there is no need for the Board to examine these distinctions (nor does the Patent Owner ask the Board to do so at this stage) as the Peng reference does not qualify as prior art.¹ In this regard, the Peng reference has a filing date of June 29, 2011 and a publication date of December 15, 2011, while the latest date to

¹ Patent Owner reserves the right to assert the distinctions between the ’369 patent and Peng, as well as the other references asserted by USAA, in the event that the Board institutes *inter partes* review.

which the '369 patent may claim priority is June 10, 2011. As such, the Board may summarily dismiss USAA's Petition as the primary reference on which that Petition relies is not prior art.

III. THE '369 PATENT

The '369 patent includes three independent claims. Claim 1 provides:

1. A mobile telecommunications device configured to log driving information associated with a vehicle, the mobile telecommunications device comprising:

a sensor set comprising an image sensor, an audio sensor, an accelerator or a positioning module, or a combination thereof;

a user interface;

a processor; and

a memory;

the mobile telecommunications device configured to:

determine, based on at least one of 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;

process the sensor data from the sensor set during the driving period to derive driving information associated with how the vehicle is driven;

store a selection of the driving information to the memory;

wherein the driving information is derived without data from vehicle sensors, and the memory comprises:

a long term memory for persistently storing driving information and a short term memory for transiently storing driving information, wherein the short term memory receives driving information at a higher update rate than the long term memory, the mobile telecommunications device being further configured to:

write driving information to the short term memory at a predetermined update rate during the driving period in a predetermined sequence; and,

overwrite the driving information previously written to short term memory in accordance with the predetermined sequence.

USAA-1001 at 31:42-32:10.² The dependent claims claim a number of other elements of the invention including, among other things, controlling the mobile device by a downloaded application to detect occurrence of a predetermined event and in response take at least one predetermined action, transferring data from the short term to the long term memory, capturing driving information at a higher

² Claim 26 recites the same language except “attached” is replaced with “affixed.” Claim 27 similarly replaces “attached” with “affixed” while also adding a processing step not raised by Petitioner as relevant to its argument that Peng is, in fact, prior art.

sampling rate when an event is not detected, and transmitting data regarding a predetermined event to a remote system, among others. USAA-1001 at 31:41-32:53.

Critical to the invention claimed in the '369 patent is the fact that the driving information is derived without any reliance on data derived from any of the vehicle's sensors. In this regard, each of the independent claims specifically provide that "the driving information *is derived without data from vehicle sensors*" USAA-1001 at 32:62-63; 34:15-16; 34:57-58. This is critical as one of the primary purposes of the invention is to determine driving information specific to an individual, not information specific to the vehicle which is all that would be collected if the invention relied on data collected from the vehicle's sensors. Because multiple people may drive a single vehicle, reliance on data generated by vehicle sensors would frustrate the primary purpose of the invention of generating individual specific driving data.³ The claimed invention further requires that the

³ The '369 patent specification, however, does disclose the potential "supplemental" use of data from vehicle sensors.

It will be appreciated that the sensor set onboard the mobile device *may be supplemented by a sensor set external to the mobile device. For example, the external device may be an engine management system of the vehicle and/or the external device may be arranged to connect to the on-car data network of the vehicle.* Thus, the external

mobile telecommunications device include a long term memory for persistently storing driving information and a short term memory for transiently storing driving information wherein the short term memory receives driving information at a higher update rate than the long term memory at a predetermined update rate in a predetermined sequence such that driving information is overwritten in accordance with a predetermined sequence.

Preferably, the memory comprises a long term memory for persistently storing driving information and/or sensor data. Preferably the memory comprises a buffer. The buffer may comprise a short

device may have access to information associated with the behavior of the vehicle (for example, the speed of the vehicle, how much the brake pedal is being pressed, etc.). Such driving information may be processed and/or stored by the mobile device under control of the executed application in a manner similar to driving information derived from sensor data internal to the mobile device.

USAA-1001 at 9:59-10:4 (emphasis added). While the inventors contemplated the use of data from a vehicle sensor to supplement data derived from the mobile devices' sensors, each of the independent claims of the '369 patent includes explicit language that the driving information is derived "without data from vehicle sensors." This claim element makes clear that data derived from vehicle sensors is not to be utilized or otherwise relied on in the invention claimed in the '369 patent.

term memory for transiently storing driving information and/or sensor data. Preferably, the short term memory is arranged to receive driving information and/or sensor data at a higher update rate than the long term memory....

Preferably, the executed application controls the mobile device to write driving information and/or sensor data to the short term memory at a predetermined update rate during the driving period. Ideally, the driving information and/or sensor data is written to the short term memory in a predetermined sequence, ideally a chronological sequence. Preferably, the executed application controls the mobile device to overwrite driving information and/or sensor data previously written to the short term memory. Advantageously, this ensures that recording of sensor data and/or driving information, especially data that is recorded at a relatively high update rate, is not prevented during the driving period due to the short term memory becoming full. Preferably the driving information and/or sensor data is overwritten in accordance with the predetermined sequence....

Preferably the action taken in response to a detected event comprises transferring data from the short term memory to the long term memory.

USAA-1001 at 7:53-8:14.

IV. PRIMARY PRIOR ART REFERENCE RELIED ON BY PETITIONER – US PATENT APPLICATION PUB. NO. US 2011/0307188 TO PENG *et al.*

Peng discloses a system and method for evaluating driving related data that may be collected from sensors on a mobile device and “from sensors and/or

devices external to [the] mobile device (e.g., speed sensors, blind spot information sensors, seat belt sensors, GPS device, etc.).” USAA-1005 at [0021]. As further set forth in Peng, the invention comprises a mobile device that includes a data collection module that manages “the collection of driving data ... from any number and types of data sources, including (a) data sources provided by handheld mobile device ... (b) data sources in [the] vehicle ... (e.g., on-board vehicle computer, seat belt sensors, GPS system, etc.), and/or (c) data sources external to [the] vehicle (e.g., data sources accessible to handheld mobile device 100 by a satellite network or other telecommunication links)” USAA-1005 at [0033]. These data sources in the vehicle may include the “engine RPM, speedometer, fuel usage rate, exhaust components or other combination indications, suspension system monitors, seat belt use indicators, tracking systems for other vehicles in vicinity, [and] blind spot indicators.” *Id.*

The trigger to start and stop the collection of driving data in Peng is based on the physical orientation of the mobile device relative to the vehicle. USAA-1005 at [0036]. “[D]ata collection module may allow driving data collection to be manually or automatically started (or restarted after an interruption) only if the physical orientation of [the] mobile device is suitable for collecting driving data, according to predefined rules. Further, during driving data collection, module may

automatically stop or interrupt the driving data collection if [the] mobile device is moved such that it is no longer suitably oriented for collecting driving data.” *Id.*

This invention is distinct from the invention claimed in the ’369 patent wherein driving information about how a vehicle is being driven is derived by the mobile device from data collected solely by the mobile device’s sensors. Moreover, Peng does not disclose the ’369 patent’s collection of information at different rates in a predetermined sequence depending on whether such information is being stored in long or short term memory, nor does it disclose the overwriting of certain data in accordance with a predetermined sequence to conserve memory. Again, however, the Board need not decide these issues as Peng may not be considered as prior art to the ’369 patent.

V. PERSON OF ORDINARY SKILL IN THE ART

For the purpose of this Preliminary Response, Auto Telematics does not challenge USAA’s proposed definition of a person of ordinary skill in the art (“POSITA”) in this matter would have at least a Bachelor of Science Degree (or its equivalent) in an academic area such as electrical engineering, computer engineering, computer science, or a related technical field and about 2-3 years of

experience in the field of telematic systems. Auto Telematics, however, reserves the right to provide an alternative definition of a POSITA if an IPR is instituted.⁴

VI. CLAIM CONSTRUCTION

In an *inter partes* review, the same claim construction standard is applied that would be used in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). In applying this standard, claim terms are generally given their ordinary and customary meaning as would be understood by an ordinarily skilled artisan at the time of the invention and in the context of the entire patent disclosure. *See id.*; *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (*en banc*).

Here, the Petitioner asserts that because the Challenged Claims are obvious under any reasonable interpretation, no express constructions are required. While Patent Owner disagrees with the characterization that the Challenged Claims are

⁴ Patent Owner's expert, Christopher Wilson, nonetheless opines that a person of ordinary skill in the art would also include individuals with a Bachelor of Science degree in other fields, including physics, and that the particular educational experience becomes less relevant as the individual's experience in the telematics field increases. AT-2001 at ¶ 11. In this regard, Mr. Wilson opines that a person of ordinary skill in the art would include individuals with a Bachelor of Science Degree in any discipline and 3 – 5 years of experience in the field of telematics systems. *Id.*

IPR2023-00769

U.S. Patent No. 10,192,369

obvious under any construction of the claims, it agrees that no constructions are required here.

It should also be noted that in a proceeding pending before the United States District Court for the Western District of Texas (Waco Division) (Case No. 6:22-cv-00474-ADA) wherein Patent Owner is asserting allegations of infringement of the '369 patent, among others, Petitioner sought construction of several terms including “sensor set,” “driving period,” “driving information,” and “driving score.” As to each of these terms, the Court agreed with the Patent Owner that no construction was required and that the plain and ordinary meaning of each term would be utilized by the Court.

VII. PENG MAY NOT BE CONSIDERED AS PRIOR ART

U.S. Patent Application Publication No. US2011/0307188 to Peng, *et al.* titled “Systems and Methods for Providing Driver Feedback Using a Handheld Mobile Device” claims an earliest priority date of June 29, 2011. As conceded by the Petitioner, the priority history on which the '369 patent relies includes at least three (3) applications with filing dates that predate the Peng priority date. These applications include:

- Application No. 1021292.6 filed in Great Britain on December 15, 2010 (“P1”);⁵
- Application No. 1101259.8 filed in Great Britain on January 25, 2011 (“P2”); and
- Application No. 1109759.9 filed in Great Britain on June 10, 2011 (“P3”).

At least P3 includes particular descriptions supporting each and every element of the independent claims of the ’369 patent. Accordingly, the claims of the ’369 patent have a priority date of no later than June 10, 2011, which predates Peng’s priority date. As such, Peng may not be relied on to invalidate the ’369 patent.

a. P3 Sufficiently Describes Feature 1.9

(i) P3 Sufficiently Discloses to a POSITA the Derivation of Driving Information “Without Data from Vehicle Sensors”

Petitioner argues that five (5) features of the ’369 patent are not sufficiently described in P3 to allow the ’369 patent to rely on a filing date prior to that of Peng. The first of these elements, described by the Petitioner as Feature 1.9 (along

⁵ For the Board’s convenience, the Patent Owner is using the same naming convention for the priority filings as the Petitioner in its Petition. The Patent Owner denies any meaning or inference that may be associated with these naming conventions.

with the same limitations in claims 26 (26.9) and 27 (27.9)), provides for the derivation of driving information “without data from the vehicle sensors.” Contrary to USAA’s assertions, however, P3 sufficiently describes this limitation.⁶ In this

⁶ The ’369 patent’s claim term of deriving driving information “without data from vehicle sensors” is an example of a negative limitation. As the Manual of Patent Examining Procedure (“MPEP”) makes clear, there is nothing inherently ambiguous or uncertain about a negative limitation so long as the boundaries of the patent protection being sought are sufficiently set forth to comply with the requirements of 35 U.S.C. § 112. MPEP § 2173.05(i). As with any claim limitation, to satisfy the written description requirement when evaluating a negative limitation, a patent’s specification 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 Pharmaceuticals v. Accord Healthcare, Inc.*, Docket no. 2021-1070 (Fed. Cir. June 21, 2022) citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F. 3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). A negative limitation need not be recited in the specification *in haec verba*. *Novartis, supra*. It need only generally include sufficient disclosure in the specification to convey to a skilled artisan that the inventor intended the exclusion. *Id.* A negative limitation may be satisfied when a skilled artisan would understand the specification as inherently disclosing it. *Id.*

regard, P3 makes clear that the witness application “interfaces with the hardware on a mobile device, such as a smart phone.” USAA-1505 at 5:14. P3 goes on to state that “it will be appreciated that a more sophisticated telephone (*e.g.*, a smart phone) has a ***richer*** sensor set with which to record and determine the occurrence of an incident.” USAA-1505 at 5:20-21 (emphasis added).⁷ This disclosure makes clear that the sensor set on which the invention is relying to gather driving data is that of the smart-phone, and not sensors that are included in some other component with a “less rich” sensor set (*i.e.*, vehicle sensors). AT-2001 at ¶ 32.⁸

Further support is found in P3 wherein a full list of sensor/data inputs common to modern smart phones is identified. USAA-1505 at 5:25-35 (“The Witness application can receive the following sensor/data inputs, ***as is typical for modern smart-phones***: G-force/accelerator; Microphone (Audio); Camera

⁷ “Richer sensor set” is a comparative term – the sensor set being “richer” than some other sensor set. While the disclosure does not expressly identify the sensor set which is less rich than the mobile device’s sensor set, it would have been recognized by a POSITA that the less rich sensor set would be that of the vehicle as the vehicle’s sensor set is the only other sensor set that reasonably could have been used as part of the disclosed invention. AT-2001 at ¶ 32.

⁸ AT-2001 is a declaration of Patent Owner’s auto telematics expert, Christopher Wilson.

(Picture/Video); GPS module (Speed, location, evaluation, direction etc); 3D compass (Orientation; Pitch, Roll and Yaw); Time/date; [and] Touch-sensitive screen (receiving user data inputs)"). (Emphasis added). P3 goes on to make clear that the application "is arranged to record a number of *these sensor inputs* continuously." USAA-1505 at 6:1-2 (emphasis added). Reference to "*these sensor inputs*" is a reference to the sensor inputs of the smart phone referenced immediately above on p. 5. AT-2001 at ¶ 33.

These references to the mobile phone sensor set would make clear to a person of ordinary skill in the art that the Witness application disclosed in P3 was designed to rely on inputs received from the sensor set of the mobile phone. This, combined with the disclosure's teaching that the smart-phone's sensor set is "richer" than any other sensor set that could be utilized by the invention makes clear that that the claim limitation of deriving driving information without data from the "less rich" vehicle sensors is clearly disclosed in P3. AT-2001 at ¶ 34.

(ii) *P3 Sufficiently Discloses the Derivation of Driving Information Using Data from Both Vehicle and Mobile Device Sensors such that the Claim of Deriving Driving Information Without Data from Vehicle Sensors is Supported*

Support for P3's disclosure of the derivation of driving information without data from vehicle sensors does not end there. P3 discloses the notion of utilizing the vehicle's sensors to, among other things, derive driving information. In this regard, P3 provides:

It would not be beneficial from the perspective of the insurance company if the user could choose when to enable the application. For example, if a user could choose to disable the application when speeding then the effectiveness of the application would be reduced.

Accordingly, the application may include measures to guarantee that the application is enabled whenever a given insured vehicle is being driven. *Such measures may involve matching data recorded by the Witness application with that recorded independently by the vehicle.* For example, the Witness application records the distance travelled during every journey. To ensure the summed distances of all journeys tracked by the Witness application tally with the total travelled distance of the vehicle, *the user may be prompted to enter the odometer mileage periodically.*

If the distance recorded by the Witness application does not correlate with the difference between odometer readings, then the discrepancy will be flagged to the user and/or the insurance company. A substantial discrepancy will typically indicate that the Witness application has not been monitoring all vehicle journeys and the appropriate action can be taken (e.g. the user can be warned, insurance premium may be raised etc).

USAA-1505 at 19:31 – 20:14 (emphasis added). Here, the odometer, which itself is a vehicle sensor, is used to confirm that the application is accurately tracking the beginning and end of each driving period. As such, P3 discloses the use of both mobile device and vehicle sensors to derive driving information. AT-2001 at ¶ 35.

While any negative limitation included in a claim must have a basis in the disclosure, that basis may be met, among other ways, if alternative elements are positively recited in the specification and then explicitly excluded in the claims. *See, e.g., In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”); *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). For example, the invention at issue in *Johnson* related to linear thermoplastic polyarylene polyether polymers composed of recurring units having the general formula –O-E-O-E’—where O represents an oxygen atom, E represents the residuum of a dihydric phenol compound, and E’ represents the residuum of a benzenoid compound having one or more inert electron withdrawing groups. The claim at issue included a negative limitation that “E and E’ may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei. *Id.* at 13.

While the specification did not include any express language supporting this negative limitation, it did include a description of a broad set of fifty (50) potential options for the E precursor compound and fifteen (15) species of polyarylene polyethers. *Id.* at 1018. Only fourteen (14) of those species fell within the scope of the negative limitation in the claim. *Id.* Notwithstanding the lack of any

expressed support for the negative limitation, the Court still found that the claim met the requirements of Sec. 112.

The notion that one who fully discloses, and teaches those skilled in the art how to make and use a genus and numerous species therewithin has somehow failed to disclose and teach those skilled in the art how to make and use that genus minus two of those species, and has thus failed to satisfy the requirements of § 112 ... appears to result from a hypertechnical application of legalistic prose relating to that provisions of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a [prior art reference] [The] specification, having described the whole, necessarily described the part remaining.

Id. at 1019. This is exactly the situation here.

As described above, the use of data from the mobile device's sensor set, as well as from the vehicle's sensor set, to derive driving information is disclosed as an alternative embodiment in P3. As such, like in *Johnson*, the claim's exclusion of data from one of those sensor sets, *i.e.*, the vehicle's sensor set, is also disclosed and supported. Having described the use of data from both vehicle and mobile device sensors, the inventor necessarily described the use of data only from the mobile device's sensors. Accordingly, P3 provides the necessary disclosure to support Claim Element 1.9 thereby providing support for the '369 patent's reliance

on the June 10, 2011 priority date; predating Peng by several weeks. AT-2001 at ¶

37. As such, Peng may not be relied on as prior art to the '369 patent.

(iii). The '369 Patent's Specification Provides Sufficient Support for the Negative Limitation

Petitioner also curiously takes the position that not only is there no support for the negative limitation in priority application P3, but that the '369 specification itself also fails to provide any support for the claim element that “the driving information is derived without data from vehicle sensors” As set forth below, this position is simply incorrect.

The '369 specification includes multiple references to the mobile device's sensor set and the processing of data from that sensor set to derive driving information. See, e.g., USAA1001 at 2:1-5; 6:11-15; 10:50-67. These multiple references to the mobile device's sensor set and the processing of data collected from that sensor to derive driving information sufficiently disclose to a POSITA claim element 1.9 of deriving driving information without data from the vehicle sensors. AT-2001 at ¶¶ 21-25.

Like with P3, the '369 specification also discloses the use of data from both the mobile device's sensor set and the vehicle's sensor set to derive driving information.

It will be appreciated that the sensor set onboard the mobile device may be supplemented by a sensor set external to the mobile device.

For example, the external device may be an engine management system of the vehicle and/or the external device may be arranged to connect to the on-car data network of the vehicle. Thus, the external device may have access to information associated with the behavior of the vehicle (for example, the speed of the vehicle, how much the brake pedal is being pressed, etc). Such driving information can be processed and/or stored by the mobile device under control of the executed application in a manner similar to driving information derived from sensor data internal to the mobile device.

USAA-1001 at 9:59-10:4.

As such, the '369 patent's specification discloses multiple means to accomplish a goal but then explicitly excludes one of those multiple means in the claims. *See, e.g., In re Johnson, supra; Ex Parte Grasselli, supra.* In particular, the inventors disclosed use of data from both the vehicle's sensor set ("the on-car data network of the vehicle") and the mobile device's sensor set but then claimed the use of data from the mobile device sensor set alone. USAA-1001 at 9:64. As demonstrated above, this is perfectly appropriate and provides all the disclosure necessary to support Claim Element 1.9 in the specification, thereby meeting the requirements of 35 U.S.C. § 112.

c. P3 Sufficiently Describes Features 1.10-1.13

Petitioner further asserts that P3 does not support claim elements 1.10 – 1.13 (nor the same limitations found in claims 26 and 27) which provide for a long term

memory for persistently storing driving information and a short term memory for transiently storing driving information wherein the short term memory receiving driving information at a higher rate than the long term memory and the mobile device is configured to write driving information to the short term memory at a predetermined rate in a predetermined sequence, and overwrite driving information previously written to the short term memory in accordance with the predetermined sequence. USAA1001 at 31:64 – 3:10; 34:18 - 29; 34:59 – 35:3. Petitioner, however, does not offer any evidence or even any analysis in support of this contention.⁹

As set forth below, Petitioner's position is misplaced as P3 provides more than ample support for each of these limitations. In that regard, P3 includes the following relevant disclosures:

- The Witness application is arranged to record a number of these sensor inputs continuously.
- The recording takes place at the highest update rate possible.

However, to conserve storage space on the smart-phone, data is

⁹ Petitioner's sole mention of this position in its Petition is the following: "Specifically, each priority document fails to provide support for at least [1.9]-[1.13] of independent claim 1 (nor the same limitations found in claims 26 and 27) of the '369 patent." No further analysis is offered.

stored/overwritten according to a recording strategy, to attempt to preserve the most relevant data.

- The recording strategy could be set up as follows:
 - The Witness application is arranged to register the occurrence of ‘an event of significance’ – for example, a potential vehicle crash.
 - All data recorded close to, and immediately after the time of the event of significance is preserved. Data recorded further away in time can be overwritten.
 - In effect, the data preservation/overwriting is such that the closer in time that recorded data is to the ‘event of significance’, the higher the quality of data. This can also be thought of the recorded data having a higher update rate closer to the event of significance.

USAA1505 at 6:1 – 16.

P3 includes additional relevant disclosures:

- On detection of a crash (or other event of significance) the Witness application is arranged to take one or more of the following actions:

- Protect the high quality recorded data so it is not overwritten. USAA1505 at 8:8.
- Displayed in a left column of the Recording Screen are additional user selectable buttons:
 - Keep current video (pressing this button will automatically copy the current video – and the previous video segment – to the ‘kept videos’ section of the smart-phone and so prevents that information from being overwritten via a Recording Strategy – as will be described. The user is advised to press this button in the event of a traffic incident that needs to be recorded).
USAA1505 at 10:18 – 24.

The stored data is contained in either a “Kept” area of storage or in a “Recording Stack.” Data files in the Kept area are saved and so not overwritten as part of a Recording Strategy. In contrast, data files in the Recording Stack may be overwritten as part of the Recording Strategy. USAA1505 at 11:8 – 10.

The Setting Screens allows the operation of the Recording Strategy to be controlled. Specifically, the Settings Screen allows a user to select the number of video segments that the application should store, and

the size of those segments. Accordingly, the user is able to set a limit to the storage usage of the Recording Stack part of the program. The user can also control the storage usage of the Recording Stack through the use of the video quality buttons. USAA1505 at 14:3-8.

The Recording Strategy involves maintaining a user-controlled number of video segments. When a new video recording is initialized ... this is written over the oldest video segment. Thus only the most recently recorded videos are maintained in the Recording Stack. USAA1505 at 14:14-17.

The Accident Management Screen can be invoked by the user via the Main Menu, or can be automatically switched to after the Witness application has detected that there has been an incident (e.g., via G-forces exceeding a threshold level). Similarly, data can automatically permanently stored as “Kept” and/or sent if high G-forces are detected. USAA1505 at 16:5-9.

These disclosures in P3 sufficiently disclose each of claim elements 1.10, 1.11, 1.12 and 1.13 to allow the '369 patent to claim priority to P3's filing date of June 10, 2011; nearly three weeks before Peng's priority date of June 29, 2011. The following chart makes this point clear:

Claim Element	Disclosure in P3
---------------	------------------

[1.10] the memory comprises: a long term memory for persistently storing driving information and a short term memory for transiently storing driving information,	Long term memory for persistently storing driving information: “All data recorded close to, and immediately after the time of the event of significant is preserved.” “On detection of a crash (or other event of significance), the Witness application is arranged to ... [p]rotect the high quality recorded data so it is not overwritten” “Data files in the Kept area are saved and so not overwritten as part of a Recording Strategy.” Short term memory for transiently storing driving information: “[T]o conserve storage space on the smart-phone, data is stored/overwritten according to a recording strategy....” “Data recorded further away in time [from an event of significance] can be overwritten.” “[D]ata files in the Recording Stack may be overwritten as part of the Recording Strategy.”
[1.11] wherein the short term memory receives driving information at a higher update rate than the long term memory	“The recording takes place at the highest update rate possible. However, to conserve storage space on the smart-phone, data is stored/overwritten according to a recording strategy, to attempt to preserve the most relevant data.”

	USAA1505 6:4-6. “All data recorded close to, and immediately after the time of the event of significance is preserved.” USAA1505 6:10-11. “This stored data is contained in either a “Kept” area of storage or in a “Recording Stack.” Data files in the Kept area are saved and so not overwritten as part of a Recording Strategy.” USAA1505 11:7-9. “The recording strategy could be set up as follows: • The Witness application is arranged to register the occurrence of ‘an event of significance’ – for example, a potential vehicle crash. • All data recorded close to and immediately after the time of the event of significance is preserved. Data recorded further away in time can be overwritten.”
[1.12] the mobile telecommunications device being further configured to: write driving information to the short terms memory at a predetermined update rate during the driving period in a predetermined sequence; and	“[T]o conserve storage space on the smart-phone, data is stored/overwritten according to a recording strategy....” “[D]ata files in the Recording Stack may be overwritten as part of the Recording Strategy.” “The recording takes place at the highest update rate possible.

	However, “to conserve storage space on the smart-phone, data is stored/overwritten according to a recording strategy, to attempt to preserve the most relevant data.” “This stored data is contained in either a “Kept” area of storage or in a “Recording Stack.” Data files in the Kept area are saved and so not overwritten as part of a Recording Strategy.”
[1.13] overwrite the driving information previously written to the short term memory in accordance with the predetermined sequence.	“[T]o conserve storage space on the smart-phone, data is stored/overwritten according to a recording strategy....” “Data recorded further away in time [from an event of significance] can be overwritten.” “[D]ata files in the Recording Stack may be overwritten as part of the Recording Strategy.”

As confirmed by Patent Owner’s telemetrics expert Christopher Wilson, the disclosures in P3 teach a POSITA each of claim elements 1.10 through 1.13, as well as those same limitations in independent claim 26 and 27. USAA2001 at ¶¶33-8.

In particular, Mr. Wilson testifies that as to claim element 1.10, at least P3’s disclosure of a “Kept” area of storage would disclose to a POSITA the “long term

memory” while P3’s “Recording Stack” would disclose to a POSITA the “short term memory.” He further testifies that as to claim element 1.11, at least P3’s disclosure of recording taking place at the “highest rate possible” and that data is “stored/overwritten according to a recording strategy, to attempt to preserve the most relevant data” in comparison to the long term memory receiving driving information recorded “close to, and immediately after, the time of [an] event of significance” would disclose to a POSITA the “short term memory receiv[ing] driving information at a higher rate than the long term memory.”

As to claim element 1.12, Mr. Wilson testifies that at least P3’s disclosure that recording driving information at the “highest rate possible” would disclose to a POSITA “writing driving information to the short term memory at a predetermined update rate” while its disclosure of a “recording strategy” discloses to a POSITA claim element 1.12’s requirement to write driving information in a “predetermined sequence.”

Finally, as to claim element 1.13, Mr. Wilson opines that at least P3’s disclosure of “overwrit[ing] according to a recording strategy” and that “data files in the Recording Stack may be overwritten as par to of the Recording Strategy” would disclose to a POSITA the claim element that driving information previously written to the short term memory may be overwritten “in accordance with the predetermined sequence.” As such, the priority date of the ’369 patent is no later

IPR2023-00769

U.S. Patent No. 10,192,369

than the filing date of P3 – June 10, 2011. This is prior to Peng’s priority date of June 29, 2011, and therefore, Peng may not be relied upon to invalidate the ’369 patent.

VIII. CONCLUSION

In summary, USAA’s Petition fails as each and every argument raised therein is based primarily on the Peng reference. As set forth above, the Peng reference does not predate the priority date applicable to the ’369 patent, and therefore, Peng may not be relied on as prior art. Accordingly, Patent Owner Auto Telematics Ltd. respectfully requests that the Board deny USAA’s request for *inter partes* review as there is no likelihood of success that USAA will succeed on any of the challenged claims.

August 10, 2023

Respectfully submitted,

/Steven E. Tiller/

Steven E. Tiller, Reg. No. 39,859

Gregory Stone, Reg. No. 43,165

Whiteford, Taylor & Preston L.L.P.

Seven Saint Paul Street – Suite 1500

Baltimore, Maryland 21202-1636

(410) 347-9425

Attorneys for Patent Owner,

Auto Telematics Ltd.

IPR2023-00769

U.S. Patent No. 10,192,369

CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

Pursuant to 37 C.F.R. § 42.24, Patent Owner Auto Telematics Ltd., certifies that, based on the word count of the word processing application used to prepare this paper, the number of words in this Patent Owner Preliminary Response is 6213. This word count does not include the items that may be excluded from the count under 37 C.F.R. § 42.24(a) including the table of contents, table of authorities, list of exhibits and this certificate.

August 10, 2023

Respectfully submitted,

/Steven E. Tiller/

Steven E. Tiller, Reg. No. 39,859

Gregory Stone, Reg. No. 43,165

Whiteford, Taylor & Preston L.L.P.

Seven Saint Paul Street – Suite 1500

Baltimore, Maryland 21202-1636

(410) 347-9425

*Attorneys for Patent Owner,
Auto Telematics Ltd.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), undersigned counsel certifies that on June 29, 2023, this paper – Patent Owner Auto Telematics Ltd’s Preliminary Response Pursuant to 37 C.F.R. §42.107 – was served via electronic mail upon the following counsel of record for Petitioner:

Via Email Only (by consent):
W. Karl Renner
IPR36137-0026IP2@fr.com

Grace Kim
gkim@fr.com

Thomas Rozylowicz
tar@fr.com

Andrew B. Patrick
patrick@fr.com

Michael T. Zoppo
zoppo@fr.com

Baile Xie
xie@fr.com

PTABInbound@fr.com

axf-ptab@fr.com

IPR2023-00769

U.S. Patent No. 10,192,369

August 10, 2023

Respectfully submitted,

/s/ Steven E. Tiller

Steven E. Tiller, Reg. No. 39,859

Gregory Stone, Reg. No. 43,165

Whiteford, Taylor & Preston L.L.P.

Seven Saint Paul Street – Suite 1500

Baltimore, Maryland 21202-1636

(410) 347-9425

Attorneys for Patent Owner,

Auto Telematics Ltd.