

42 (new). The method according to claim 37, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the satellite positioning system; a last time determined by the satellite positioning system; a previous position.

43 (new, amended). A mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said mobile wireless communication device comprising:

a processor; a memory coupled to said processor; an embedded satellite positioning system module coupled to said processor providing a satellite positioning capability for said mobile wireless communication device; and means for

determining when said embedded satellite positioning system module should be powered on, said embedded satellite positioning system module then being powered on,

said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,

said determining when said embedded satellite positioning system module should be powered on being dependant on a position determined from the wireless communications network,

said wireless communications network being different from said satellite positioning system.

44 (new). The mobile device according to claim 43, wherein said satellite positioning system is a Global Positioning System (GPS).

45 (new). The mobile device according to claim 43, wherein said embedded satellite positioning system module comprises an embedded satellite positioning system device.

46 (new). The mobile device according to claim 43, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

47 (new). The mobile device according to claim 43, wherein said powered on comprises

said module powering up from a low-power mode such as a TricklePower power-down mode.

48 (new). The mobile device according to claim 43, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of: a last satellite position; a last position determined by the satellite positioning system; last time determined by the satellite positioning system; a previous position.

49 (new, amended). A computer program product for a mobile wireless communication device for a wireless communication network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said computer program product having a non-transitory computer readable medium storing a computer program for acquiring a satellite positioning system position on a said mobile wireless communication device, comprising: computer program code means for interfacing with the satellite positioning system capability of said mobile wireless communication device; and computer program code means for determining when said embedded satellite positioning system module should be powered on, said embedded satellite positioning system module then being powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits, said determining when said embedded satellite positioning system module should be powered on being dependant on position determined from the wireless communications network, said wireless communications network being different from said satellite positioning system.

50 (new). The computer program product according to claim 49, wherein said satellite positioning system is a Global Positioning System (GPS).

51 (new). The computer program product according to claim 49, wherein said embedded satellite positioning system module comprises an embedded satellite positioning system device.

52 (new). The computer program product according to claim 49, wherein any dependency on

said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

53 (new). The computer program product according to claim 49, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

54 (new). The computer program product according to claim 49, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of: a last satellite position; a last position determined by the satellite positioning system; a last time determined by the satellite positioning system; and a previous position.

Recipient Information

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AUG 16 2019

Assignmnet for Application 15/376,627

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PTO/AIA/96 (08-12)

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(c)Applicant/Patent Owner: Robert Anderson MalaneyApplication No./Patent No.: 11/661/707 / 8,022,870 Filed/Issue Date: 31 August 2005/ 20 September 2011Titled: SELF MONITORING GPS ON MOBILE DEVICE_____, a _____
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)states that, for the patent application/patent identified above, it is (choose one of options 1, 2, 3 or 4 below):

1. ☒ The assignee of the entire right, title, and interest.
2. ☐ An assignee of less than the entire right, title, and interest (check applicable box):
- ☐ The extent (by percentage) of its ownership interest is _____. Additional Statement(s) by the owners holding the balance of the interest must be submitted to account for 100% of the ownership interest.
- ☐ There are unspecified percentages of ownership. The other parties, including inventors, who together own the entire right, title and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

3. ☐ The assignee of an undivided interest in the entirety (a complete assignment from one of the joint inventors was made). The other parties, including inventors, who together own the entire right, title, and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

4. ☐ The recipient, via a court proceeding or the like (e.g., bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose one of options A or B below):

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Robert Anderson Malaney To: Nariste Networks Pty LtdThe document was recorded in the United States Patent and Trademark Office at
Reel 020990, Frame 0609, or for which a copy thereof is attached.2. From: Nariste Networks Pty Ltd To: Robert Anderson MalaneyThe document was recorded in the United States Patent and Trademark Office at
Reel 040887, Frame 0213, or for which a copy thereof is attached.

(Page 1 of 2)

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/AIA/96 (08-12)
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STATEMENT UNDER 37 CFR 3.73(c)

3. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

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6. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
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☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

☒ As required by 37 CFR 3.73(c)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

/Robert A. Malaney/

17 August 2019

Signature

Date

Robert A. Malaney

Printed or Typed Name

Title or Registration Number

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064
132250	7590	08/30/2019		
Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA			EXAMINER PEIKARI, BEHZAD	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 08/30/2019	DELIVERY MODE 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.

<i>Applicant-Initiated Interview Summary</i>	Application No. 15/376,627	Applicant(s) Malaney, Robert Anderson	
	Examiner BEHZAD PEIKARI	Art Unit 3992	AIA (FITF) Status No

All participants (applicant, applicants representative, PTO personnel):

(1) B. James Peikari (USPTO). (3) Michelle Tarae (USPTO).

(2) Alexander Kosowski (USPTO). (4) Dr. Robert Malaney (Inventor).

Date of Interview: 15 August 2019.

Type: ☒ Telephonic ☐ Video Conference
 ☐ Personal [copy given to: ☐ applicant ☐ applicant's representative]

Exhibit shown or demonstration conducted: ☒ Yes ☐ No.
 If Yes, brief description: [See Attached Proposed Amendments].

Issues Discussed ☒101 ☒112 ☐102 ☐103 ☒Others
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: 37-54.

Identification of prior art discussed: N/A.

Substance of Interview
(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant raised questions regarding the Office action of August 18, 2017 and the Notice of Non-Compliant Amendment of June 19, 2019. Applicant provided possible corrections (see attached). The examiners offered specific guidance on how to correct the errors in the ADS, Form PTO 96, specification, and the format of claim amendments in reissue. The examiners offered some general guidance regarding the rejections under 35 USC 101 and 112, 1st paragraph..

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☒ Attachment

/B. James Peikari/ Primary Examiner, Art Unit 3992	/A.J.K/ Supervisory Patent Examiner, Art Unit 3992
---	---

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiners responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicants correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted, -
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicants record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiners version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, Interview Record OK on the paper recording the substance of the interview along with the date and the examiners initials.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR/ PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
15/376,627	12/12/2016	Malaney, Robert Anderson	

Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070		EXAMINER	
		BEHZAD PEIKARI	
		ART UNIT	PAPER
		3992	20190815

DATE MAILED: _____

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

Commissioner for Patents

[see attached interview summary]

/B. JAMES PEIKARI/
Primary Examiner, Art Unit 3992

IN THE CLAIMS

The following is a complete listing of the claims, and replaces all earlier versions and listings.

37 (currently amended). A method of acquiring a satellite positioning system position on a mobile wireless communication device for a wireless communications network, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system for satellite positioning system capability, said method comprising:

determining when said embedded satellite positioning system module should be powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,

said when said embedded satellite positioning system module should be powered on being dependant on ~~at least one of a position error determined from the wireless communications network and~~ a position determined from the wireless communications network, said wireless communications network being different from said satellite positioning system.

38 (original). The method according to claim 37, wherein said satellite positioning system is a Global Positioning System (GPS).

39 (original). The method according to claim 37, wherein said embedded satellite positioning system module comprises an embedded satellite positioning system device.

40 (original). The method according to claim 37, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

41 (original). The method according to claim 37, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

42 (original). The method according to claim 37, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the satellite positioning system; a last time determined by the satellite positioning system; a previous position.

43 (currently amended). A mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said mobile wireless communication device comprising: a processor; a memory coupled to said processor; an embedded satellite positioning system module coupled to said processor providing a satellite positioning capability for said mobile wireless communication device; and means for determining when said embedded satellite positioning system module should be powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits, said determining when said embedded satellite positioning system module should be powered on being dependant on ~~at least one of a position error determined from the wireless communications network and~~ a position determined from the wireless communications network, said wireless communications network being different from said satellite positioning system.

44 (original). The mobile device according to claim 43, wherein said satellite positioning system is a Global Positioning System (GPS).

45 (original). The mobile device according to claim 43, wherein said embedded satellite positioning system module comprises an embedded satellite positioning system device.

46 (original). The mobile device according to claim 43, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

47 (original). The mobile device according to claim 43, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

48 (original). The mobile device according to claim 43, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the satellite positioning system; last time determined by the satellite positioning system; a previous position.

49 (currently amended). A computer program product for a mobile wireless communication device for a wireless communication network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said computer program product having a non-transitory computer readable medium storing a computer program for acquiring a satellite positioning system position on a said mobile wireless communication device, comprising: computer program code means for interfacing with the satellite positioning system capability of said mobile wireless communication device; and computer program code means for determining when said embedded satellite positioning system module should be powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,
said determining when said embedded satellite positioning system module should be powered on being dependant on ~~at least one of a position error determined from the wireless communications network and~~ a position determined from the wireless communications network, said wireless communications network being different from said satellite positioning system.

50 (original). The computer program product according to claim 49, wherein said satellite positioning system is a Global Positioning System (GPS).

51 (original). The computer program product according to claim 49, wherein said embedded satellite positioning system module comprises an embedded satellite positioning system device.

52 (original). The computer program product according to claim 49, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

53 (original). The computer program product according to claim 49, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

54 (original). The computer program product according to claim 49, wherein said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the satellite positioning system; a last time determined by the satellite positioning system; and a previous position.

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT4181537

SUBMISSION TYPE:	NEW ASSIGNMENT	
NATURE OF CONVEYANCE:	ASSIGNMENT	
CONVEYING PARTY DATA		
	Name	Execution Date
	NARISTE NETWORKS PTY LTD	12/12/2016
RECEIVING PARTY DATA		
Name:	ROBERT ANDERSON MALANEY	
Street Address:	16 CARLYLE RD	
City:	EAST LINDFIELD	
State/Country:	AUSTRALIA	
Postal Code:	2070	
PROPERTY NUMBERS Total: 2		
	Property Type	Number
	Patent Number:	8022870
	Application Number:	14031992
CORRESPONDENCE DATA		
Fax Number:		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>		
Phone:	61294161983	
Email:	robert@nariste.com	
Correspondent Name:	ROBERT A MALANEY	
Address Line 1:	16 CARLYLE RD	
Address Line 4:	EAST LINDFIELD, AUSTRALIA 2070	
NAME OF SUBMITTER:	ROBERT A. MALANEY	
SIGNATURE:	/Robert A. Malaney/	
DATE SIGNED:	12/12/2016	
	This document serves as an Oath/Declaration (37 CFR 1.63).	
Total Attachments: 2		
source=deed1#page1.tif		
source=deed1#page2.tif		

DEED

DEED made 13th December 2016.

BETWEEN: ROBERT ANDERSON MALANEY of 16 Carlyle Road, Lindfield, New South Wales (the "Assignee")

AND: NARISTE NETWORKS PTY LIMITED (ACN 117 199 363) of 16 Carlyle Road, Lindfield, New South Wales (the "Assignor")

RECITALS:

- A. By patent US 8,022,870 ("the patent") the Assignor has obtained a patent in the United States of America for an invention entitled "SELF MONITORING GPS ON MOBILE DEVICE" ("the invention").
- B. The Assignor has agreed to assign to the Assignee all his right, title and interest in and to the patent and the invention, including the right to apply for and obtain patents in any country for the invention, including all reissue and continuation reissue patents derived from the patent US 8,022,870.

THIS DEED WITNESSES AS FOLLOWS:

1. In consideration of the payment of the sum of \$10.00 by the Assignee to the Assignor, the Assignor hereby assigns to the Assignee all his right, title and interest in and to the patent and the invention, including the right to apply for and obtain patents in any country for the invention.
2. The Assignor agrees, at the expense of the Assignee, to do all such further acts and execute all such further documents as may be necessary to transfer to the Assignee the patent and any patent that may be granted as a result of the patent.
3. For the avoidance of doubt, it is agreed that all fees, costs and expenses incurred by the Assignor (whether before or after the date of this Deed) in connection with enabling the Assignee to be registered as the sole owner of any patent that may be granted as a result of the patent, are to be borne and paid by the Assignee or (as the case may be) reimbursed to the Assignor by the Assignee, at the request of the Assignor.

EXECUTED AS A DEED

Signed, sealed and delivered by
ROBERT ANDERSON MALANEY
in the presence of



Witness:
Title:

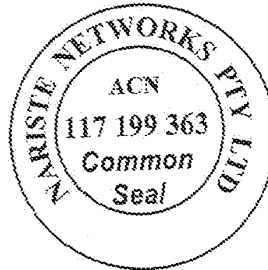
Robert Anderson Malaney

PATENT

REEL: 040887 FRAME: 0214

The Common Seal of
NARISTE NETWORKS PTY LIMITED
(ACN 117 199 363)
was affixed in accordance with
its Constitution


Director



From: Robert
To: Peikari, Behzad James
Subject: RE: Interview Request
Date: Thursday, August 15, 2019 5:08:16 AM
Attachments: Final claimsCX2412_amended_2019.docx
assignmentcover.pdf
assignment-pat-40667-213.pdf

Dear Mr Peikari;

Please find attached an updated claim set which I think is now corrected as you suggested it should be. I have also attached the last assignment cover - as they should help me understand the issue re chain of title you refer to. The copy from the USPTO database of the assignment is also attached - although I am not sure these are what you are looking for.

I look forward to our call later. Regards, Robert.

----- Original Message -----

Subject: RE: Interview Request
From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>
Date: Wed, August 14, 2019 11:58 pm
To: Robert <robert@malaney.net>

Dear Dr Malaney,

Thank you for your reply. You can reach me at the following numbers:

571-272-4185 (phone)

571-273-4185 (fax)

Sending a proposed amendment prior to the interview could be helpful. I look forward to speaking with you tomorrow.

Regards,
B. Peikari
Primary Examiner, Art Unit 3992

From: Robert <robert@malaney.net>
Sent: Tuesday, August 13, 2019 11:36 PM
To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>
Subject: RE: Interview Request

Dear Mr Peikari;

Thank you for your note and I look forward to chatting with you. The purpose of

the interview is for you to clarify for me some of the issues you raised in your recent report, especially given the fact that the other re-issue application you referred to in that report has now been abandoned. Please be advised that I am not an attorney and have no legal training.

Could you also advise if you are open to me attempting to fulfil your requests and emailing a copy of those attempts to you for your review prior to the interview? This may facilitate a more efficient call and a speedier resolution.

Please advise the telephone number I should call 4 pm EST on August 15.

Regards, Robert Malaney.

----- Original Message -----

Subject: Interview Request

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Wed, August 14, 2019 12:52 am

To: "robert@malaney.net" <robert@malaney.net>

Dear Dr Malaney,

I have received your interview request in application no. 15/376,627 and I will be available for a telephonic interview at 4 pm EST on August 15, 2019, as proposed.

I will endeavor to set up a panel for the interview.

You had previously authorized internet communications. Therefore, I will use email for scheduling purposes with regard to the interview.

Please send a proposed interview agenda (i.e., a brief description of the issues to be discussed) in accordance with MPEP 713, as soon as possible.

Regards,

B. Peikari

Primary Examiner, Art Unit 3992

STATEMENT UNDER 37 CFR 3.73(c)

Applicant/Patent Owner: Robert Anderson Malaney

Application No./Patent No.: 11/661/707 / 8,022,870 Filed/Issue Date: 31 August 2005/ 20 September 2011

Titled: SELF MONITORING GPS ON MOBILE DEVICE

_____, a _____
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that, for the patent application/patent identified above, it is (choose **one** of options 1, 2, 3 or 4 below):

1. ☒ The assignee of the entire right, title, and interest.
2. ☐ An assignee of less than the entire right, title, and interest (check applicable box):
- ☐ The extent (by percentage) of its ownership interest is _____. Additional Statement(s) by the owners holding the balance of the interest must be submitted to account for 100% of the ownership interest.
- ☐ There are unspecified percentages of ownership. The other parties, including inventors, who together own the entire right, title and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

3. ☐ The assignee of an undivided interest in the entirety (a complete assignment from one of the joint inventors was made). The other parties, including inventors, who together own the entire right, title, and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

4. ☐ The recipient, via a court proceeding or the like (e.g., bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose **one** of options A or B below):

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Robert Anderson Malaney To: Nariste Networks Pty Ltd

The document was recorded in the United States Patent and Trademark Office at
Reel 020990, Frame 0609, or for which a copy thereof is attached.

2. From: Nariste Networks Pty Ltd To: Robert Anderson Malaney

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

[Page 1 of 2]

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

STATEMENT UNDER 37 CFR 3.73(c)

3. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

4. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

5. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

6. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

☒ As required by 37 CFR 3.73(c)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

/Robert A. Malaney/

Signature

Robert A. Malaney

Printed or Typed Name

13 Dec 2016

Date

Title or Registration Number

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064
132250	7590	09/30/2019		
Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA			EXAMINER PEIKARI, BEHZAD	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 09/30/2019	DELIVERY MODE 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.

Office Action Summary	Application No. 15/376,627	Applicant(s) Malaney, Robert Anderson	
	Examiner BEHZAD PEIKARI	Art Unit 3992	AIA (FITF) Status No

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

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 16 August 2019.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 37-54 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.

6) ☐ Claim(s) ____ is/are allowed.

7) ☒ Claim(s) 37-54 is/are rejected.

8) ☐ Claim(s) ____ is/are objected to.

9) ☐ Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☒ The specification is objected to by the Examiner.

11) ☒ The drawing(s) filed on 12 December 2016 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
Certified copies:
a) ☒ All b) ☐ Some** c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 11/661,707.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date ____.

3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.

4) ☐ Other: ____.

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

NON-FINAL OFFICE ACTION

This Office Action addresses U.S. Application No. 15/376,627, which is a continuation of reissue Application No. 14/031,992 (hereinafter, the '992 application), which issued as U.S. Patent No. RE46237, which is a reissue of U.S. Application No. 11/661,707 (hereinafter, the '707 application), entitled "SELF MONITORING GPS ON MOBIL DEVICE", which issued as U.S. Patent No. 8,022,870, (hereinafter, the '870 patent).

Claims 37-54 are pending. Claims 1-36 were canceled in a preliminary amendment filed December 12, 2016.

Note: Because the present action includes rejections that could have been made in the previous Office action on the merits, the present action is made non-final.

PRIOR OR CONCURRENT PROCEEDINGS

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which the patent is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3.73(c) STATEMENT

The previous objection to the Statement Under CFR 3.73(c) is withdrawn due to the corrected Statement Under CFR 3.73(c) filed August 16, 2019.

APPLICATION DATA SHEET

The previous objection to the Application Data Sheet is withdrawn due to the corrected Application Data Sheet filed August 16, 2019.

DRAWING OBJECTIONS

The drawings are objected to for the following reasons:

- The drawings are not in accordance with 37 CFR 1.83(a), which requires that “the drawing in a nonprovisional application must show every feature of the invention specified in the claims”. The drawings in the application do not show every feature of new claims 37-54.
- The drawings are not in accordance with 37 CFR 1.84(I), which states, “Every line, number, and letter must be durable, clean, black (except for color

drawings), sufficiently dense and dark, and uniformly thick and well-defined ...

This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views". The current drawings are blurry and/or pixelated to the extent that they are difficult to understand.

- The drawings are not in accordance with 37 CFR 1.84(u)(2), which states, "The view numbers must be larger than the numbers used for reference characters". For example, "FIG. 1" should be larger than "100", "FIG. 2" should be larger than "210", etc.
- The drawings are not in accordance with 37 CFR 1.84(p)(5), which states, "Reference characters not mentioned in the description shall not appear in the drawings". Note for example reference character 218 is not mentioned in the specification. The description "210-220" is not adequate to describe element 218. Also, several elements of Figure 6 were not described in the specification.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note 37 CFR 1.173 for reissue drawing amendments. Note also MPEP 1413.

SPECIFICATION

The disclosure is objected to because of the following informalities:

- The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which new claims 37-54 are directed.
- The specification must be amended to include "Cross-Reference to Related Application" section at the beginning of the specification. Should the application result in a reissue patent, the reissue information will appear in item [64] on the front page of the reissue patent. An example of the suggested language to be inserted is as follows:

"Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 8,022,870. The present reissue Application No. 15/376,627 is a continuation of reissue Application No. 14/031,992, which issued as U.S. Patent No. RE46237, both of which are reissues of U.S. Patent No. 8,022,870."

- In line 1 of the abstract, "and" should replace "arid".
- In column 2, line 63, "to determine" should replace "of".
- In column 5, line 15, "to determine" should replace "of".

Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to 37 CFR 1.173(b)(1).

Appropriate correction is required.

CLAIM SUPPORT

In accordance with 37 CFR 1.173(c), the reissue applicant must provide an explanation of the support in the disclosure of the patent for the changes made to the claims. The explanation of support must be on page(s) separate from the page(s) containing the amendment.

The remarks attached to the amendment of December 12, 2016 include a page of citations in support of the new claims.

However, citations are not the same as explanations.

An explanation of support for each of the amended claims is required in response to this Office action. Mere citations in the disclosure will not be sufficient.

Note also MPEP 1411.02.

CONSENT

The Consent of Assignee filed December 12, 2016 has been entered and acknowledged.

CLAIM OBJECTIONS

Claims 37-54 are objected to because all occurrences of “dependant” should be replaced with “dependent”.

Claim 49 is objected to because the two “computer program code means” should be distinguished, i.e., “first computer program code means” and “second computer program code means”.

Appropriate correction is required.

Further, applicant is advised that should claim 37, 43 and 49 be found allowable, claims 38, 44 and 50 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

OBJECTIONS BASED ON DEFECTIVE OATH/DECLARATION

The statement of error in the declaration filed December 12, 2016 is as follows:

“Original claim 1 specified a GPS system and not a satellite positioning system. A new claim 37 is added to current application that rectifies that point thus broadening the original scope of the invention. All new claims have a different allowed set of parameters used to make determinations on the controlling of power.”

The reissue declaration is objected to as defective for the following reasons:

(1) The fact that original claim 1 did not include a “satellite positioning system” is not an error. The original disclosure was directed to a Global Positioning System (GPS). A “satellite positioning system” was not included in the original disclosure. Thus, to broaden the claims to a “satellite positioning system” would be to incorporate new matter. A valid statement of error may not be based on new matter.

(2) With the amendment filed August 30, 2019 to clarify that the “satellite positioning system” is limited to a GPS, the claims are no longer broadened by the “satellite positioning system”, thus rendering the statement of error incorrect.

(3) The statement of error is not in accordance with 37 CFR 1.175(a), which requires that the declaration “specifically identify at least one error pursuant to 35

U.S.C. 251 being relied upon as the basis for reissue". The language "All new claims have a different allowed set of parameters used to make determinations on the controlling of power" does not include a specific example of a new parameter included in a specific claim.

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. See MPEP 1414(II)(c).

REJECTIONS BASED ON DEFECTIVE OATH/DECLARATION

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. §251 that form the basis for the rejections under this section made in this Office action:

(a) IN GENERAL.—Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

Claims 37-54 are rejected as being based upon a defective reissue declaration under 35 U.S.C. §251. The declaration is defective for all of the reasons set forth above with regard to the objections to the declaration. See 37 CFR 1.175.

Furthermore, claims 37-42 and 49-54 lack subject matter surrendered during the prosecution of the '707 application.

- Claim 37 lacks the following language which was added to claim 1 to overcome rejections based on the prior art during the prosecution of the '707 application:

"an embedded GPS module" for GPS capability

“current radio position and error of said mobile device”

- Claim 49 lacks the following language which was added to claim 23 to overcome rejections based on the prior art during the prosecution of the '707 application:

“current radio position and error of said mobile device”

On May 19, 2010, a non-final Office action was mailed in the '707 application , wherein claims 1 and 23 (among others) were rejected based on prior art. In an amendment filed November 7, 2010, the language “current radio position and error of said mobile device” was added to both claims 1 and 23. On page 17 of the remarks submitted with the amendment November 7, 2010, it was argued that the prior art did not teach “current radio position and error of said mobile device”, among other features.

On January 20, 2011, a final Office action was mailed in the '707 application, wherein claims 1 (among others) was rejected based on prior art. In an amendment filed April 20, 2011, the language “an embedded GPS module” (for GPS capability) was added to claim 1. On page 13 of the remarks submitted with the amendment April 20, 2011, it was argued that the prior art did not teach “an embedded GPS module”, among other features.

The three step test for recapture:

Step 1 - Is There Broadening?

Are the reissue claims are broader than the original patent claims in at least some respects? Yes, for example, claim 37 lacks “current radio position and error of said mobile device”, which is required of claim 1.

Step 2 - Does Any Broadening Aspect of the Reissued Claim Relate to
Surrendered Subject Matter?

Substep 1 – Did applicant surrender any subject matter in the prosecution of the original application that became the patent to be reissued? Yes, the surrendered subject matter is noted above.

Substep 2 - Does the broadening in the reissue claims result from eliminating limitations surrendered in the original prosecution? Yes, independent claims 37 and 49 omit limitations that the prosecution record shows as added to claims 1 and 23 respectively, to overcome prior art during the original prosecution.

Step 3 - Are the Reissue Claims Materially Narrowed in Other Respects, and
Hence Avoid the Recapture Rule?

The reissue claims are not materially narrowed in other respects. The reissue claims 37-42 and 49-54 do include some different terminology and some different aspects of the invention, but do not significantly differ from claim 1-11 and 23-36 of the '870 patent.

Thus, claims 37-42 and 49-54 are rejected under 35 U.S.C. §251 because they lack the subject matter added to obtain patentability during prosecution of the original patent.

See *Greenliant Systems, Inc. et al v. Xicor LLC*, 692 F.3d 1261, 103 USPQ2d 1951 (Fed. Cir. 2012); *In re Shahram Mostafazadeh and Joseph O. Smith*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005); *Pannu v. Storz*

Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claimed subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*,

686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 37-54 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-39 of U.S. Patent No. RE46237. Although the claims at issue are not identical, they are not patentably distinct from each other because each

limitation of independent claims 37, 43 and 49 of the present application is either taught or suggested by claims 1, 12 and 23 of U.S. Patent No. RE46237. Note the following side-by-side comparison of the claims:

U.S. Application No. 15/376,627	U.S. Patent No. RE46237
37. A method of acquiring a satellite positioning system position on a mobile wireless communication device for a wireless communications network,	1. A method of acquiring position a mobile wireless communication device for a wireless communications network,
said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system for satellite positioning system capability, said method comprising:	and an embedded Global Positioning System (GPS) module for GPS capability, said method comprising:
determining when said embedded satellite positioning system module should be powered on, said embedded satellite positioning system module then being powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,	adaptively predicting when said GPS module should be powered on to meet specifications on at least one of positioning accuracy and GPS acquisition time,
said when said embedded satellite positioning system module should be powered on being dependent on a position determined from the wireless communications network,	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network,
said wireless communications network being different from said satellite positioning system.	said wireless communications network being different from said GPS.
43. A mobile wireless communication device for a wireless communications network,	12. A mobile wireless communication device for a wireless communications network,
said mobile wireless communication device possessing wireless communications capability for said	said mobile wireless communication device possessing wireless communications capability for said

wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites, said mobile wireless communication device comprising:	wireless communications network, said mobile wireless communication device comprising:
a processor,	a processor;
a memory coupled to said processor,	a memory coupled to said processor;
an embedded satellite positioning system module coupled to said processor providing a satellite positioning capability for said mobile wireless communication device; and	an embedded Global Positioning System (GPS) module coupled to said processor providing a GPS capability for said mobile wireless communication device; and
means for determining when said embedded satellite positioning system module should be powered on, said embedded satellite positioning system module then being powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,	means for adaptively predicting when said GPS module should be powered on to meet specifications on at least one of positioning accuracy and GPS acquisition time,
said determining when said embedded satellite positioning system module should be powered on being dependent on a position determined from the wireless communications network.	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network, said wireless communications network being different from said GPS.
49. A computer program product for a mobile wireless communication device for a wireless communication network,	23. A computer program product for a mobile wireless communication device for a wireless communication network,
said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system module for satellite positioning system capability, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites,	said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded Global Positioning System (GPS) module for GPS capability,

said computer program product having a non-transitory computer readable medium storing a computer program for acquiring a satellite positioning system position on a said mobile wireless communication device, comprising:	said computer program product having a computer readable medium storing a computer program for acquiring position on said mobile wireless communication device, comprising:
computer program code means for interfacing with the satellite positioning system capability of said mobile wireless communication device; and	computer program code means for interfacing with the GPS capability of said mobile wireless communication device; and
computer program code means for determining when said embedded satellite positioning system module should be powered on, said embedded satellite positioning system module then being powered on, said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits,	computer program code means for adaptively predicting when said GPS module should be powered on to meet specifications on at least one of positioning accuracy and GPS acquisition time
said determining when said embedded satellite positioning system module should be powered on being dependent on a position determined from the wireless communications network,	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network,
said wireless communications network being different from said satellite positioning system.	said wireless communications network being different from said GPS.

Claims 37, 43 and 49 of the present application include only obvious differences from claims 1, 12 and 23 of U.S. Patent No. RE46237, including limiting a satellite positioning system to a GPS or explaining that the module is indeed powered on.

In addition, claims 38-42, 44-48 and 50-54 are rejected as being dependent on base claims 37, 43 and 49, respectively.

CLAIM REJECTIONS - 35 USC § 101

The previous rejections under 35 USC § 101 are *withdrawn* due to the amendment filed August 16, 2019.

CLAIM INTERPRETATION

The following is a quotation of 35 U.S.C. 112(f):

(f) Element in Claim for a Combination. – An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The following is a quotation of pre-AIA 35 U.S.C. 112, sixth paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The claims in this application are given their broadest reasonable interpretation using the plain meaning of the claim language in light of the specification as it would be understood by one of ordinary skill in the art. The broadest reasonable interpretation of a claim element (also commonly referred to as a claim limitation) is limited by the description in the specification when 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is invoked.

As explained in MPEP § 2181, subsection I, claim limitations that meet the following three-prong test will be interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph:

- (A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
- (B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and
- (C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

Use of the word “means” (or “step”) in a claim with functional language creates a rebuttable presumption that the claim limitation is to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is rebutted when the claim limitation recites sufficient structure, material, or acts to entirely perform the recited function.

Absence of the word “means” (or “step”) in a claim creates a rebuttable presumption that the claim limitation is not to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is not interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function.

Claim limitations in this application that use the word “means” (or “step”) are being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action. Conversely, claim limitations in this application that do not use the word “means” (or “step”) are not being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action.

This application includes one or more claim limitations that use the words “means for” and also limitations that do not use the word “means,” but are nonetheless being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, because the claim limitation(s) uses a generic placeholder that is coupled with functional language without reciting sufficient structure to perform the recited function and the generic placeholder is not preceded by a structural modifier.

Three Prong Analysis

To invoke 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, a claimed phrase must meet the three prong analysis as set forth in MPEP § 2181, subsection I.

(A) Regarding Prong (A), the MPEP states:

(A) the claim limitation uses the term "means" or "step" or a term used as a substitute for "means" that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function....

The claim limitations listed below do not use the language "means" or "step". However, each of these is found to be a generic placeholder. The limitations are listed below the claim in which they first appear.

With regard to claim 43,

- satellite positioning system module
- means
- electronic circuits

With regard to claim 49,

- non-transitory computer readable medium
- computer program
- (first) computer program code means
- (second) computer program code means

Note: With regard to the claimed “electronic circuits”, the circuitry as claimed, combined with a description of the function of the circuits (switching on power), should provide sufficient structure to one of ordinary skill in the art. See *Mass. Inst. of Tech.*, 462 F.3d at 1355-1356, 80 USPQ2d at 1332 (“circuitry” is generally determined to have sufficient structure). However, because the claimed “electronic circuits” do not include sufficient structure in the claims themselves, this limitation also meets Prong (A) of the analysis.

(B) Regarding Prong (B), the MPEP states:

(B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”...

The claim limitations listed below are each modified by functional language, as shown.

- satellite positioning system module (“*for satellite positioning system capability*”)

- means (“for”)
- electronic circuits (*no functional language*)
- non-transitory computer readable medium (“*storing*”)
- computer program (“*for acquiring*”)
- (first) computer program code means (“for”)
- (second) computer program code means (“for”)

The limitation “electronic circuits” does not meet Prong (B) and will not be further considered in this analysis. Each of the other limitations meet Prong (B) of the analysis.

(C) Regarding Prong (C), the MPEP states:

(C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

With regard to where the limitations may be found in the disclosure, note the following:

- satellite positioning system module (*column 3, lines 49-59, “A module, and in particular its functionality, can be implemented in either hardware or software. In the software sense, a module is a process, program, or portion thereof that usually performs a particular function or related functions ... In the hardware sense, a module is a functional hardware unit designed for use with other components or modules”*)

- means for determining when said embedded satellite positioning system should be powered on (*note column 6, lines 60 et seq., which discusses determining the best fit for a power up period*)
- non-transitory computer readable medium (*adequate structure not found*)
- computer program (*adequate structure not found*)
- (first) computer program code means (*adequate structure not found*)
- (second) computer program code means (*adequate structure not found*)

With regard to the claimed “non-transitory computer readable medium”, this was not mentioned in the disclosure.

With regard to the claimed “computer program”, a particular computer program for performing the functions listed in the claim was not shown in the disclosure.

With regard to the claimed “computer program code means”, the disclosure notes “method steps may be put into effect by computer code”, but no particular code was disclosed for the claimed computer program product.

With regard to the “satellite positioning system module” and the “means for determining when said embedded satellite positioning system should be powered on”, these limitations do not meet Prong (C) of the analysis and thus do not invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph.

With regard to the “non-transitory computer readable medium”, the “computer program”, and the “computer program code means”, each of these limitations meet

Prong (C) of the analysis. Because all three prongs of the analysis have been met, these terms invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph.

Note: In order to rebut the assertion that the “non-transitory computer readable medium”, the “computer program”, and the “computer program code means” invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph, applicant must either (a) amend the claims or (b) show where in the disclosure adequate structure for these limitations is found (*cf.* the section on “Claim Support” above) or (c) both.

CLAIM REJECTIONS - 35 USC § 112, 1st PARAGRAPH

The previous rejections under 35 U.S.C. §112, first paragraph, are *withdrawn* due to the amendment filed August 16, 2019, wherein:

- (1) The claimed “satellite positioning system” is now limited to a GPS embodiment only.
- (2) The examiner notes that column 6, line 42, discloses “A number of techniques are known for predicting the next position of a mobile device based on its past history of positions, such as regression, Kalman filter, particle filter”.
- (3) The claims now clarify that a wireless network (not a satellite network) determines a position prior to power up of the GPS module.

However, further rejections under 35 U.S.C. §112, first paragraph, are necessary, as described below.

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 49-54 are rejected under 35 U.S.C. §112 (1st ¶) as failing to comply with the written description requirement.

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventors, at the time the application was filed, had possession of the claimed invention. As discussed above, the disclosure does not provide a sufficient corresponding structure and/or algorithm for the following elements of the computer program product:

- non-transitory computer readable medium
- computer program
- (first) computer program code means
- (second) computer program code means

Since the specification fails to disclose the corresponding structures for these functional limitations, Applicant has not satisfactorily demonstrated possession of the corresponding structures of the claimed invention. See MPEP 2181(II).

Additionally, claims 37-54 are rejected under 35 U.S.C. §112 (1st ¶) as failing to comply with the written description requirement.

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the claimed “a switch on of power... using electronic circuits” (i.e., to the embedded satellite positioning system module) is not described in the disclosure and appears to be new matter.

CLAIM REJECTIONS - 35 USC § 112, 2nd PARAGRAPH

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-54 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. As discussed above, the disclosure does not provide a sufficient corresponding structure and/or algorithm for the following elements of the computer program product:

- non-transitory computer readable medium
- computer program
- (first) computer program code means
- (second) computer program code means

Since the disclosure fails to describe the corresponding structures for these functional limitations, claims 49-54 are indefinite under 35 U.S.C. §112 (2nd ¶). See also *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 86 USPQ2d 1235, 1243 (Fed. Cir. 2008) (means-plus-function limitations lacking sufficient disclosure of structure renders the claims indefinite). See also MPEP 2181(II).

In addition, claims 37-54 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

- In claims 37-42, “said satellite positioning system module” has no antecedent basis. [Note: to overcome this rejection, “module” should be inserted in claim 37, line 6, between “system” and “for”.]
- In claims 39, 45 and 51, the claimed “device” vs “module” is unclear.
- In claims 40, 46 and 52, the determination of speed is unclear because only one “position” is referenced. However, speed must be determined by at least *two* positions (and the time between at least two positions).

- In claims 42, 28 and 54, “previous position” is vague.
- In claims 43-48, the claimed “processor” and “memory” are confusing as they appear to perform no function with respect to the rest of the claims.

CLAIM REJECTIONS - 35 USC § 103

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

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

Claims 37-54 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Pande, U.S. Patent No. 6,703,971, in view of applicant’s admitted prior art.

With regard to claim 37, a method of acquiring a satellite positioning system position on a mobile wireless communication device (*note Figure 1, 104*) for a wireless communications network, said satellite positioning system being Global Positioning Systems technologies using line-of-sight measurements to satellites (*note Figure 1, 102*), said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded satellite positioning system for satellite positioning system capability (*note, e.g., column 3, lines 38-39, “Wireless Aided GPS” or column 4, lines 19-20, “network-centric GPS”*), said method comprising:

determining when said embedded satellite positioning system module should be powered on (*note column 7, TABLE 1*),

said embedded satellite positioning system module then being powered on (*note the "start" of the GPS section, column 6, lines 36-38, "call processor 200 then sends a session open request to the GPS section 202 to start a position determination in a GPS standalone mode"*),

said powered on being a switch on of power to said embedded satellite positioning system module using electronic circuits (*note in column 6, lines 2-3, that if position accuracy is not found in the CP centric mode, then the system "will switch GPS section 202 into the SLS centric mode"*),

said when said embedded satellite positioning system module should be powered on being dependent on a position determined from the wireless communications network (*as stated above, in column 6, lines 2-3, if the mobile device is in a position / location where position accuracy is not found in the CP centric mode, then the SLS mode of the system will start by switching "GPS section 202 into the SLS centric mode"*),

said wireless communications network being different from said satellite positioning system (*note the teaching of the two different systems being utilized by the wireless handset, column 3, lines 30-39, "The wireless handset location technology of the present invention uses GPS technology ... as well as the wireless network communication services, the wireless handset location technology of the present invention provides highly reliable and economical solutions to the Wireless Aided GPS"*).

To the extent that “starting” the GPS section might not be considered “powering on”, it would have been obvious to one having ordinary skill in the art at the time the invention was made to power on the GPS section of Pande at the time of starting, since this might have the benefit of saving power, which was, in fact, one of the objectives of the Pande system (*note column 3, lines 33-34, “taking the advantage of the ... low power”*) and since applicant’s admitted prior art stated that “Battery power in a mobile device is a precious resource, and any steps that can be taken to maximize battery life are adfentageous. Simply keeping a GPS device powered on at all times to avoid the cold start is generally considered an unacceptable solution” (*note the '870 patent, column 1, lines 60-64, emphasis added; cf. column 7, TABLE 1 of Pande*)

With regard to claim 38, said satellite positioning system is a Global Positioning System (*note Figure 1, 102*).

With regard to claim 39, said embedded satellite positioning system module comprises an embedded satellite positioning system device (*note Figure 2, GPS section 202*).

With regard to claim 40, any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network (*note column 7, lines 56 et seq., can measure speed but does not always rely on it, inasmuch as interface 310 can issue any one of several types of messages 308 – only one of which is a Speed Over Ground (SOG) message*).

With regard to claim 41, said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode (*note applicant's admitted prior art in the '870 patent, column 2, lines 18-32*).

With regard to claim 42, said determining when said embedded satellite positioning system module should be powered on is also dependent on at least one of: a last satellite position; a last position determined by the satellite positioning system; a last time determined by the satellite positioning system; a previous position (*note column 7, TABLE 1, and column 7, lines 56, et seq.*).

With regard to claims 43-54, these are rejected for reasons similar to those given above for claims 37-42. The following additional limitations of claims 43-54 are noted: a processor (*note column 4, lines 49-50, "digital processor" of GPS section 202*) and a memory coupled to said processor (*note column 6, lines 59-61, the RAM storing information which is sent to GPS section 202*).

RESPONSE TO ARGUMENTS

Applicant's arguments and amendments filed August 16, 2019 have overcome all of the issues raised in the previous Office action.

However the current examiner has made new objections and rejections, some of which could have been made in the previous Office action. Consequently, this action is made *non-final*.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. James Peikari whose telephone number is (571)272-4185. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski, SPE Art Unit 3992, can be reached at (571) 272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. James Peikari/
Primary Examiner
Art Unit 3992

Conferees:
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Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

Notice of References Cited	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson	
	Examiner BEHZAD PEIKARI	Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-7076256-B1	07-2006	Orler; Anthony J.	H04W64/00	455/455
*	B	US-6389291-B1	05-2002	Pande; Ashutosh	G01S5/0009	342/357.64
*	C	US-6703971-B2	03-2004	Pande; Ashutosh	G01S5/0009	342/357.23
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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	CPC Classification
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20190921

<i>Search Notes</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
G01S 19/34	8/9/2017	mcg
G01S 19/34; G01S 19/42	09/23/2019	BJP

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
342	357.74	09/23/2019	BJP

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
See attached EAST Search History	8/9/2017	mcg
WEST Search Enclosed / inventor name search	09/23/2019	BJP
G01S 19/34; G01S 19/42 - limited by text search	09/23/2019	BJP
342/357.74 - limited by text search	09/23/2019	BJP
Interference search by text search of claim language	09/23/2019	BJP

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
342	357.74	09/23/2019	BJP

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<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM		DATE								
Final	Original	09/21/2019								
	1	-								
	2	-								
	3	-								
	4	-								
	5	-								
	6	-								
	7	-								
	8	-								
	9	-								
	10	-								
	11	-								
	12	-								
	13	-								
	14	-								
	15	-								
	16	-								
	17	-								
	18	-								
	19	-								
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	26	-								
	27	-								
	28	-								
	29	-								
	30	-								
	31	-								
	32	-								
	33	-								
	34	-								
	35	-								
	36	-								
	37	✓								
	38	✓								
	39	✓								
	40	✓								
	41	✓								
	42	✓								

<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CLAIM		DATE								
Final	Original	09/21/2019								
	43	✓								
	44	✓								
	45	✓								
	46	✓								
	47	✓								
	48	✓								
	49	✓								
	50	✓								
	51	✓								
	52	✓								
	53	✓								
	54	✓								

Refine Search

Search Results

Term	Documents
COMMUNICATIONS	1935614
COMMUNICATION	4029188
CAPABILITY	1751628
CAPABILITIES	1185123
CAPABILITYS	11
WIRELESS	2065251
WIRELESSES	229
NETWORK	3151798
NETWORKS	1550997
EMBEDDED	1547456
EMBEDDEDS	2
((communications capability and wireless communications network and embedded satellite positioning system and satellite positioning system capability).clm.).PGPB.USPT.USOC.EPAB.JPAB.DWPI.TDBD.FPRS.	0

There are more results than shown above. [Click here to view the entire set.](#)

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IBM Technical Disclosure Bulletin Database

Search Type: ☒ Prior Art ☐ Interference

Search:

L18

Refine Search

Order By: ☒ Date ☐ Hits

Recall Text

Clear

Interrupt

Search History

DATE: Monday, September 23, 2019 [Purge Queries](#) [Printable Copy](#) [Create Case](#)

Order By	Set Name	Query	Hit Count	Set Name Result Set	Set Name Grid	Set Name Classification
<i>Prior Art Searches</i>						
DB=PGPB,USPT,USOC,EPAB,JPAB,DWPI,TDBD,FPRS; PLUR=YES; OP=ADJ						
Date	L18	((communications capability and wireless communications network and embedded satellite positioning system and satellite positioning system capability).clm.	0	L18	L18	L18
Date	L17	L16 and (wireless or wifi or Wi-Fi) SAME (GPS OR global position\$ OR (satellite NEAR1 position\$)).ab.ti.bsum.clm.	1304	L17	L17	L17
Date	L16	L15 and (mobile or portable)	2278	L16	L16	L16
Date	L15	L14 and L11	2593	L15	L15	L15
Date	L14	(wireless or wifi or Wi-Fi) SAME (GPS OR global position\$ OR (satellite NEAR1 position\$))	241319	L14	L14	L14
Date	L13	L12 and L7	467402	L13	L13	L13
Date	L12	(wireless or wifi or Wi-Fi)	3931370	L12	L12	L12
Date	L11	L9 and (wireless or wifi or Wi-Fi)	3643	L11	L11	L11
Date	L10	L9 and wireless	3545	L10	L10	L10
Date	L9	L8 and L7	7572	L9	L9	L9
Date	L8	L2 or L3 or L4 or L5 or L6	12985	L8	L8	L8
Date	L7	(GPS OR global position\$ OR (satellite NEAR1 position\$))	1202471	L7	L7	L7
Date	L6	(Robert and Malaney).in.	59	L6	L6	L6
Date	L5	L4 or L3	12933	L5	L5	L5

WEST

Date	L4	(342/357.74).ccls.	800	L4	L4	L4
Date	L3	(G01S19/34 OR G01S19/42).cpc.	12644	L3	L3	L3
		DB=USPT,PGPB; PLUR=YES; OP=ADJ				
	L2	('5592173' '5864315' '6141570' '6298229' '6584331' '6590525' '20020091956' '20030083814' '20030107514' '20050162306')![pn]	10	L2	L2	L2
		DB=USPT; PLUR=YES; OP=ADJ				
Date	L1	8022870.pn.	1	L1	L1	L1

END OF SEARCH HISTORY



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064
132250	7590	11/27/2019		
Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA			EXAMINER PEIKARI, BEHZAD	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 11/27/2019	DELIVERY MODE 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.

<i>Applicant-Initiated Interview Summary</i>	Application No. 15/376,627	Applicant(s) Malaney, Robert Anderson	
	Examiner BEHZAD PEIKARI	Art Unit 3992	AIA (FITF) Status No
All participants (applicant, applicants representative, PTO personnel): (1) <u>B. James Peikari (USPTO).</u> (3) <u>Michelle Tarae (USPTO).</u> (2) <u>Alex Kosowski (USPTO).</u> (4) <u>Dr. Robert Malaney (Inventor).</u> Date of Interview: <u>07 November 2019.</u> Type: ☒ Telephonic ☐ Video Conference ☐ Personal [copy given to: ☐ applicant ☐ applicant's representative] Exhibit shown or demonstration conducted: ☒ Yes ☐ No. If Yes, brief description: <u>[note attached email correspondence].</u> Issues Discussed ☐101 ☒112 ☐102 ☒103 ☒Others (For each of the checked box(es) above, please describe below the issue and detailed description of the discussion) Claim(s) discussed: <u>37-54.</u> Identification of prior art discussed: <u>Pande, U.S. Patent No. 6,703,971, in view of applicant's admitted prior art.</u> Substance of Interview (For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...) <u>Applicant raised questions regarding the Office action of September 30, 2019. Every issue in the Office action was discussed. Where possible, the examiners offered guidance on how it might be possible to correct each of these issues..</u> Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview. Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised. ☒ Attachment			
/B. JAMES PEIKARI/ Primary Examiner, Art Unit 3992		/A.J.K/ Supervisory Patent Examiner, Art Unit 3992	

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiners responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicants correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted, -
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicants record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiners version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, Interview Record OK on the paper recording the substance of the interview along with the date and the examiners initials.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR/ PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
15/376,627	12/12/2016	Malaney, Robert Anderson	

Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070		EXAMINER	
		BEHZAD PEIKARI	
		ART UNIT	PAPER
		3992	20191125

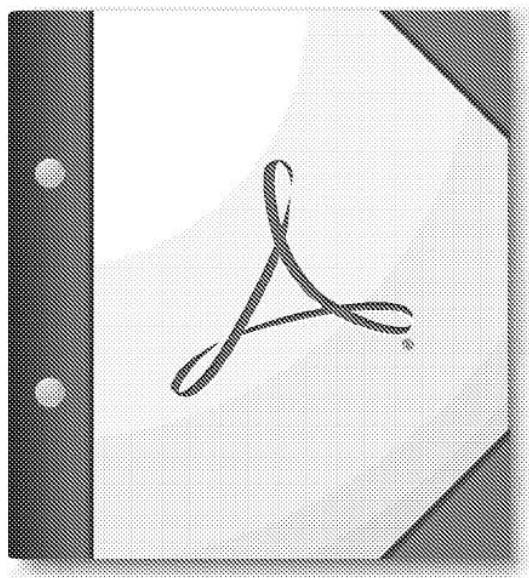
DATE MAILED: _____

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Commissioner for Patents

[See attached interview summary]

/B. James Peikari/
Primary Examiner, Art Unit 3992



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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875				Application or Docket Number 15/376,627		Filing Date 12/12/2016		☐ To be Mailed		
ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO										
APPLICATION AS FILED - PART I										
		(Column 1)	(Column 2)							
FOR		NUMBER FILED	NUMBER EXTRA	RATE (\$)		FEE (\$)				
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A	N/A	N/A						
☐ SEARCH FEE (37 CFR 1.16(k), (l), or (m))		N/A	N/A	N/A						
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))		N/A	N/A	N/A						
TOTAL CLAIMS (37 CFR 1.16(j))		minus 20 =	*	x \$40 =						
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 =	*	x \$210 =						
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))										
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL						
APPLICATION AS AMENDED - PART II										
		(Column 1)	(Column 2)	(Column 3)						
AMENDMENT	12/30/2019	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)		ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))	* 6	Minus	** 20	= 0	x \$50 =		0		
	Independent (37 CFR 1.16(h))	* 3	Minus	*** 3	= 0	x \$230 =		0		
	☐ Application Size Fee (37 CFR 1.16(s))									
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
					TOTAL ADD'L FEE		0			
AMENDMENT		(Column 1)	(Column 2)	(Column 3)						
		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)		ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))	*	Minus	**	=	x \$0 =				
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x \$0 =				
	☐ Application Size Fee (37 CFR 1.16(s))									
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))										
					TOTAL ADD'L FEE					
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.					Examiner					
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".					/PATRICIA A VOLPE/					
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".										
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert Anderson Malaney

Group Art Unit: 3992

Application No.: 15/376,627

Examiner: PEIKARI, BEHZAD

Confirmation No.: 2064

For: SELF MONITORING GPS ON MOBILE DEVICE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the examiner's points I note the following in the attached;

Respectfully Submitted,

/Robert A. Malaney/

Robert A. Malaney, Customer Number 132250

16 Carlyle Rd

East Lindfield, NSW 2070,

Australia

Please note the remarks below and the potential cancellation of claims are submitted without prejudice. It is hoped they help expediate prosecution (page numbers refer to examiner report).

1. Drawing Objections (p3-4)

New drawings supplied (see attached new sheets). Figure labels are increased in size where appropriate.

With regard to examiner's statement that drawings are not showing every feature specified in original claims, applicant notes the claims have been amended and several cancelled. If examiner believes an important feature of amended claims is not shown, applicant kindly requests the examiner assist applicant by identifying that feature, and applicant will supply a new drawing in an amendment. Applicant understands features that are obvious to implement by someone ordinarily skilled in the art are not required in drawings, and therefore such obvious features are not included in current drawings.

To remedy fact item 218 of Fig 2 not explicitly mentioned in text of specification, the specification is to be amended as follows: In column 6 the paragraph at line 23 to be amended as follows:

FIG. 2 is a block diagram of the system 200 that may be implemented using the PDA of FIG.1. The system 200 comprises a neural network module 230 that receives various inputs 210-220 to produce a predicted period of the power-up phase P_u , 240. The neural network module 230 predicts the next time to power on the GPS device. This module 230 does so dependent upon various inputs including the last satellite positions 210, the last GPS position/time 212, the last GPS error 214, the current power-up time 216, information about whether or not the last target (i.e. were the accuracy requirements satisfied or not) was achieved 218, and the current radio position and error 220. The latter information 220 may be determined using Cramer-Rao bounds. Further details of the neural network 200 are set forth hereinafter.

To remedy fact some items in Fig 6. not explicitly mentioned in text of specification, the specification is to be amended as follows: In column 10 the paragraph at line 52 to be amended as follows:

FIG. 6 illustrates the computer system 600 in block diagram form with video display 610, video interface 660, storage device 662, processing unit (e.g. a CPU) 666, memory 670, and I/O interface 672, coupled to a wireless network 620. An operator may use the keyboard 630 and/or a pointing device such as the mouse 632 (or touchpad, for example) to provide input to the computer 650. The computer system 600 may have any of a number of output devices, including line printers, laser printers, plotters, and other reproduction devices connected to the computer. The computer system 600 can be connected to one or more other computers via a communication interface 664 using an appropriate communication channel 640. The computer network 620 may comprise a wireless local area network (WLAN), or a 3G network, for example. While not depicted in FIG. 6 to simplify the drawing, it will be readily appreciated by those skilled in the art that the computer system 600 may be equipped with a GPS module, for example, in the manner shown in FIG. 1.

2. Specification (p5)

The specification is to be amended as follows:

On front page of the re-issue

"Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 8,022,870. The present reissue Application No. 15/376,627 is a continuation of reissue Application No. 14/031,992, which issued as U.S. Patent No. RE46237, both of which are reissues of U.S. Patent No. 8,022,870."

Title to be amended to "Reduced power use in mobile GPS-based technologies". That is,

(54) page 1 amended as follows

(54) ~~SELF-MONITORING GPS ON MOBILE~~ REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

All other recommended corrections on p5 are actioned.

- In line 1 of the abstract, "and" should replace "arid".
- In column 2, line 63, "to determine" should replace "of".
- In column 5, line 15, "to determine" should replace "of".

More specifically:

Replace abstract as follows:

A method, a mobile device ~~and~~ and a computer program product for acquiring GPS on a mobile device possessing GPS capability are disclosed. The method comprises the step of setting a current value of the period of the power-up phase of the GPS dependent upon adaptive predictions of when the GPS should be powered on to meet specifications on positioning accuracy and GPS acquisition time.

Replace paragraph commencing column 2 line 54 as follows:

According to yet another aspect of the present invention, there is provided a computer program product for a mobile device possessing GPS capability. The computer program product having a computer readable medium storing a computer program for acquiring GPS on the mobile device. The computer program product comprises computer program code means for interfacing with the GPS capability of the mobile device and computer program code means for setting a current value ~~of to determine~~ a period of the power-up phase of the GPS module dependent upon adaptive predictions of when the GPS module should be powered on to meet specifications on positioning accuracy and GPS acquisition time.

Replace paragraph commencing column 5 line 15 as follows:

Adaptive predictions are made ~~of~~ to determine when a GPS device, embedded in a wireless communication device, should be powered on to meet specifications on positioning accuracy, and GPS acquisition time. The embodiments of the invention address the issue of setting the period of the power-up phase, P_u , whilst retaining the accuracy of the position fix and the acquisition times of the position fix within acceptable bounds. Simply setting P_u to some value at the onset of operation may provide the required bounds for some time epoch, but there is no guarantee that this will also be the case in the future. Also, this simple approach provides no sense of an optimized value of P_u . By this, what is meant is the maximum value of P_u , allowable whilst still retaining the accuracy of the position fix and the acquisition times of the position fix within acceptable bounds. An example of an inefficient system design would be a GPS system reporting positions every second when an acceptable error bound (accuracy) of 50 meters was required on a device moving at 1 meter per second. The embodiments of the invention allow a GPS device to determine dynamically an optimal P_u in response to such a circumstance.

3. Claim Support (p6)

New claim 1 is amended as follows (other independent claims are modified in same fashion):

In addition to citations in the text supporting these changes we add some additional explanations below.

Inclusion of "said GPS referring to GPS-based techniques". Support for the use of 'GPS-based techniques' is provided at col 1 line 42. That is, the invention is not directed solely at the United States' GPS system but all similar satellite positioning systems that use 'GPS-based techniques'. In further support we also note the term GPS technologies (col 1 lines 21-24) is meant to convey all GPS-like systems. 'GPS-based techniques' can be thought of as those that use line of sight measurements to satellites' (col 1 lines 23-24). In the invention the word 'GPS' is meant to refer to any GPS-based technology, e.g. Glonass (Russia), Galileo (Europe), QZSS (Japan) BeiDou (China) as well as the original GPS (USA).

Inclusion of "dependent on at least one of a current radio position and error determined from the wireless communications network". Support for this is in Fig 2 which shows an implementation on a PDA which takes various inputs as part of the decision process of which the current radio position and error are listed. See also column 6 lines 33-34. Discussion on adapting how many inputs are then used in the decision-making process are given in column 9 lines 16-18, lines 34-40. That is, it is made clear that the invention allows all for all, or only one, of the inputs (or any other combination) to be used in the decision-making process.

Inclusion of "embedded GPS module" is cited column 5 line 56 and is used to make clear the GPS is actually embedded in the device (i.e. forms a part of the device – and the device possesses GPS capability).

4. Claim Objections (p6-7)

Suggested alteration to claims 37-54 are actioned (dependant replaced with dependent) as well as that requested for claim 49 (program codes are now distinguished as requested by examiner). The new claim set is attached. In order to expediate prosecution, claims 38, 44, 50 are cancelled (p7) without prejudice.

5. Objections/Rejections Based on Defective Oath/Declaration (p7)

The error in original claims was the fact that as per the specification, the invention was aimed at all satellite systems using 'GPS-based techniques' (col 1 line 42), not only GPS. The term GPS technologies (col 1 lines 21-24) is meant to convey all GPS-like systems. That is, the invention is not directed solely at the United States' GPS system but all similar satellite positioning systems that use 'GPS-based techniques', i.e. 'line of sight measurements to satellites' (col 1 lines 23-24). However, examiner notes original declaration invalid due to use of term "satellite positioning systems" which was not in original specification.

A new oath/declaration is attached which uses the term 'GPS-based techniques' (col 1 line 42). The new revised claims (see at end of this document) use the term 'GPS-based techniques' (col 1 line 42), specifying that the word GPS is to mean any GPS-based technology, e.g. Glonass (Russia), Galileo (Europe), QZSS (Japan) BeiDou (China) as well as the original GPS (USA) - thereby correcting the error in original claim 1 that specified only a 'GPS system'.

As one error, is now clearly identified the applicant has removed all other original text in the oath. If this fails to meet requirements, examiner is kindly requested to suggest alternate text that can be filed in an amendment.

(p8-11)

Matter is argued by examiner as surrendered previously. Putting aside whether applicant agrees with examiner on this point, applicant proposes the following. To overcome such an objection, the revised claims now have the following language "an embedded GPS module, where said GPS module is a module using GPS-based techniques and "at least one of a current radio position and error of said mobile device".

6. Double Patenting (p11-15)

Examiner has stated a double patenting issue based on original claims. However, the claims are now amended. Applicant respectfully submits that the new claims are patently distinct from original claims, and someone ordinarily skilled in the art will understand that the use of "position" in addition to "position error" enables a distinct physical feature to be used in controlling power in a non-obvious manner. In mobile position technology the phrases "position" and "position error" are well known. and have unambiguous (and different) meanings to someone ordinarily skilled in the art. If examiner disagrees and this remains as the sole objection, applicant will file a terminal disclaimer in an amendment.

7. Claim Interpretation (p16-22)

The phrase

"said computer program product having a non-transitory computer readable medium" is deleted from the revised claims.

The phrase 'non transitory' is deleted from the revised claims (computer readable medium is detailed in the specification col 4 line 56-67).

"computer program code means" is replaced by computer program code designed to" in revised claim.

The phrase "computer program" is detailed in column 2 line 42-55. It is applicant's understanding a specific code listing is not an absolute requirement, but the requirement is less stringent in that it is whether a person skilled in the art can read the description given in specification and understand what program code means in the context of the invention. Given the simplicity of any code construction for this stated function applicant believes this to be the case in this instance.

If the above does not suffice, examiner is kindly requested to suggest alternate modifications to the claim language.

Failing this, in order to expediate prosecution, claims 49, 53 and 54 may be cancelled without prejudice if examiner cannot suggest new text that overcomes the objection to his satisfaction.

8. Claim Rejections USC 112 1st Paragraph (p22-24)

To overcome objection raised on p24 the phrase "a switch on of power...using electronic circuits." Is removed from the claim. Applicant submits the term "powered on" is well-known to persons skilled in the art, and that said persons will fully understand the meaning of that phrase and how it is accomplished by simple means well-known in the art, e.g. the closing of a circuit to enable electricity to flow.

9. Claim Rejections USC 112 2nd Paragraph (p24-26)

Claims 49-54 are adjusted as described above.

Regarding claims 37-42, the term "satellite positioning system module" has been removed.

In original claims 39, 45, 52 the word module is used only in reference to a GPS module. The meaning of module is discussed col 3 lines 49-65 in specification. In order to expediate prosecution claims 39, 45 and 52 are cancelled without prejudice.

In order to expediate prosecution claims 40, 46, 52 are cancelled without prejudice.

In claims 42, 48 (note examiner listed 28 which applicant takes to mean 48) and 54 the term "previous position" is deleted.

In claims 43-48 any reference to processor and memory is deleted.

10. Claim Rejections USC 103 2nd Paragraph (p26-29)

On p27 the examiner appears to argue that Pande uses a position determined from a wireless network said wireless network being different from the satellite positioning system. However, applicant respectfully submits that Pande is entirely silent on the use of a position determined from the wireless communications network, said wireless communications network being different from said GPS. Pande makes clear that all positions determined and utilised in the Pande invention are derived from the GPS. Pande refers to the "wireless location technology of the present invention uses GPS technology". Pande also refers to 'wireless communication services' and 'Wireless aided GPS'. All these terms in Pande refer to a GPS-only solution well known to persons skilled in the art, whereby the GPS technology in a mobile device is aided by GPS information - received by a base station (part of the wireless network) - and communicated by the base station to the mobile device over the wireless network. This GPS information contains frequency settings and positions of the GPS satellites currently in view. This technique, well-known to those skilled in the art, is used to speed up the mobile devices acquisition of GPS signals, and is deployed in almost all current smartphones. The GPS information sent by the base station does not contain any information on the position of the mobile device as determined by the wireless network. Again, Pande is entirely silent on the use of such a position and makes clear any position of the device referred to by him is one determined only via GPS. Pande makes clear the aided information sent by base station to the mobile device contains only information on the GPS system - used to aid the mobile device acquiring a GPS location.

IN THE CLAIMS

The following is a complete listing of the claims and replaces all earlier versions and listings.

37 (new, amended). A method of acquiring a position on a mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said method comprising:
determining when said embedded GPS module should be powered on, said embedded GPS module then being powered on,
said when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

38 (cancelled). The method according to claim 37, wherein said satellite positioning system is a Global Positioning System (GPS).

39 (cancelled). The method according to claim 37, wherein said embedded GPS module comprises an embedded satellite positioning system device.

40 (cancelled). The method according to claim 37, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

41 (new). The method according to claim 37, wherein said powered on comprises
said module powering up from a low-power mode such as a TricklePower power-down mode.

42 (new). The method according to claim 37, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

43 (new, amended). A mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said mobile wireless communication device comprising:

an embedded GPS module providing a GPS capability for said mobile wireless communication device; and means for

determining when said embedded GPS module should be powered on,

said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

44 (cancelled). The mobile device according to claim 43, wherein said satellite positioning system is a Global Positioning System (GPS).

45 (cancelled). The mobile device according to claim 43, wherein said embedded GPS module comprises an embedded satellite positioning system device.

46 (cancelled). The mobile device according to claim 43, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

47 (new). The mobile device according to claim 43, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

48 (new). The mobile device according to claim 43, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

4

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4

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49 (new, amended). A computer program product for a mobile wireless communication device for a wireless communication network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said computer program storing a computer program for acquiring a GPS position on said mobile wireless communication device, comprising:

A first computer program code designed to interface with the GPS capability of said mobile wireless communication device; and a second computer program code designed to determine when said embedded GPS module should be powered on,

said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

50 (cancelled). The computer program product according to claim 49, wherein said satellite positioning system is a Global Positioning System (GPS).

51 (cancelled). The computer program product according to claim 49, wherein said embedded GPS module comprises an embedded satellite positioning system device.

52 (cancelled). The computer program product according to claim 49, wherein any dependency on said position determined from the wireless communications network comprises a dependency independent of the speed of said mobile wireless communication device, said speed derived from said position determined from the wireless communications network.

53 (new). The computer program product according to claim 49, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

54 (new). The computer program product according to claim 49, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

New Sheet

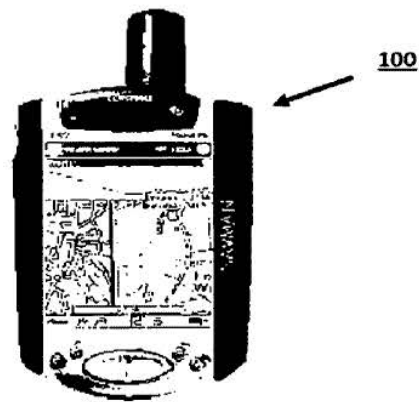


FIG. 1

New Sheet

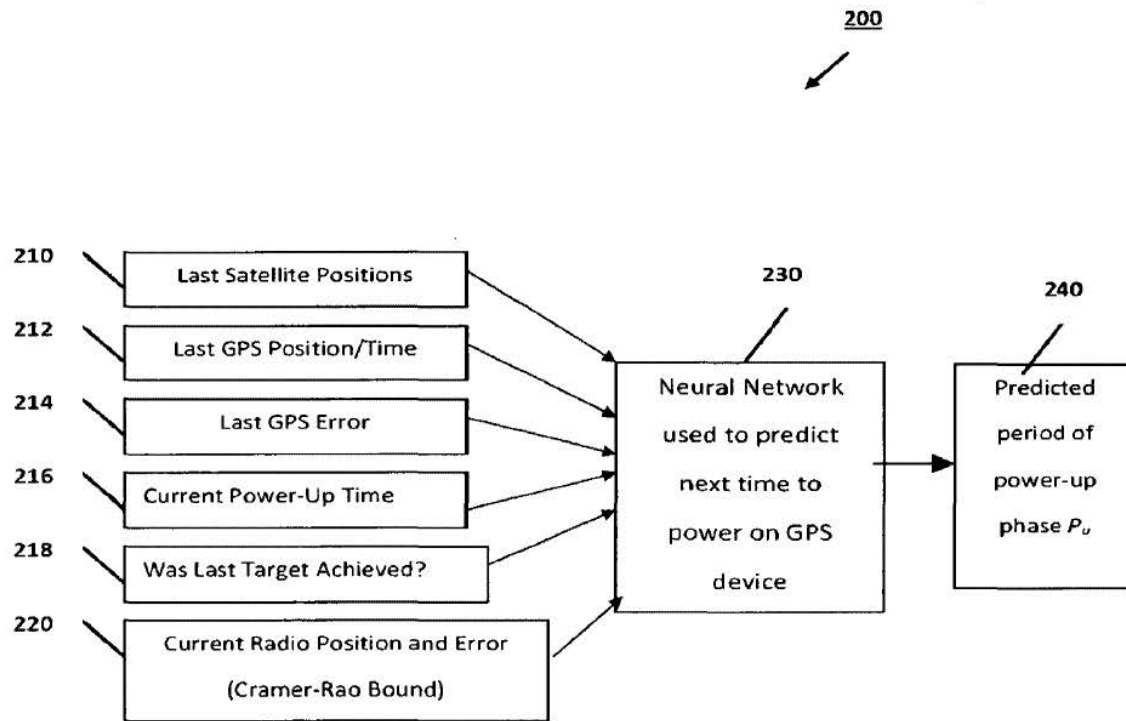


FIG. 2

New Sheet

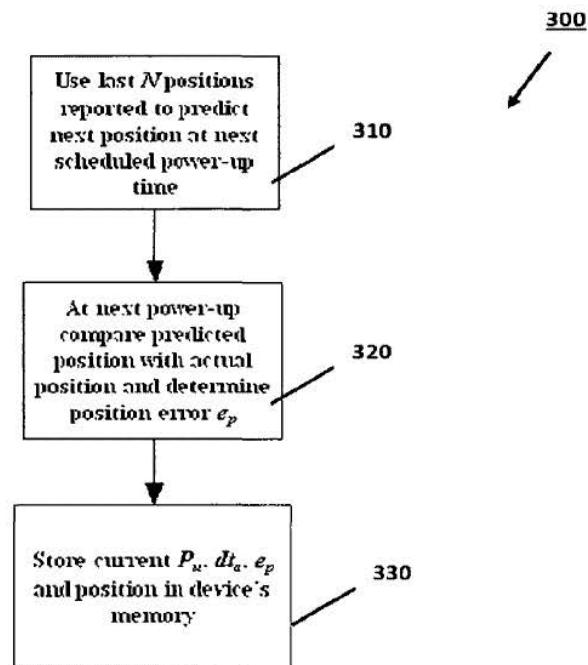


FIG. 3

New Sheet

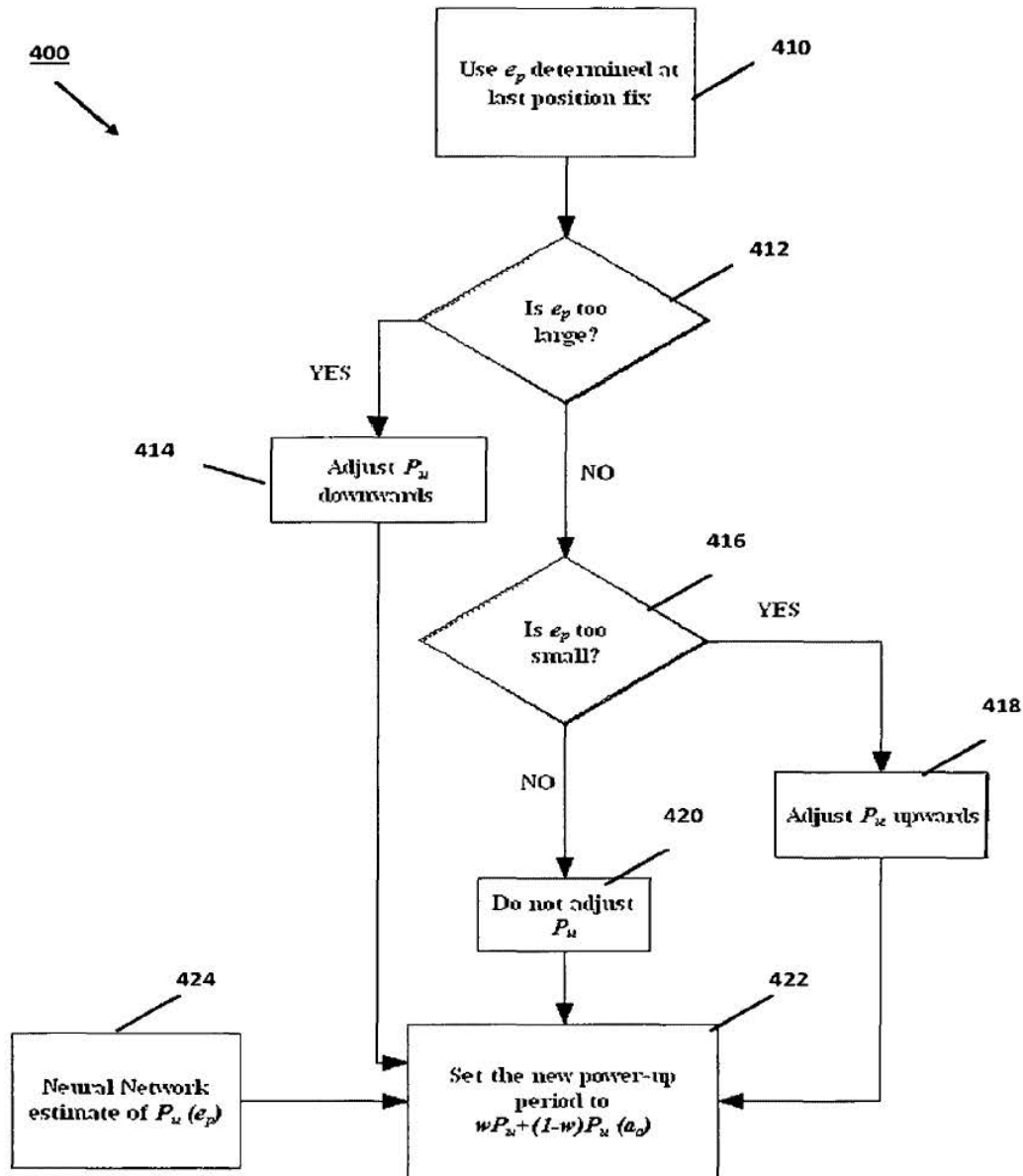


FIG. 4

New Sheet

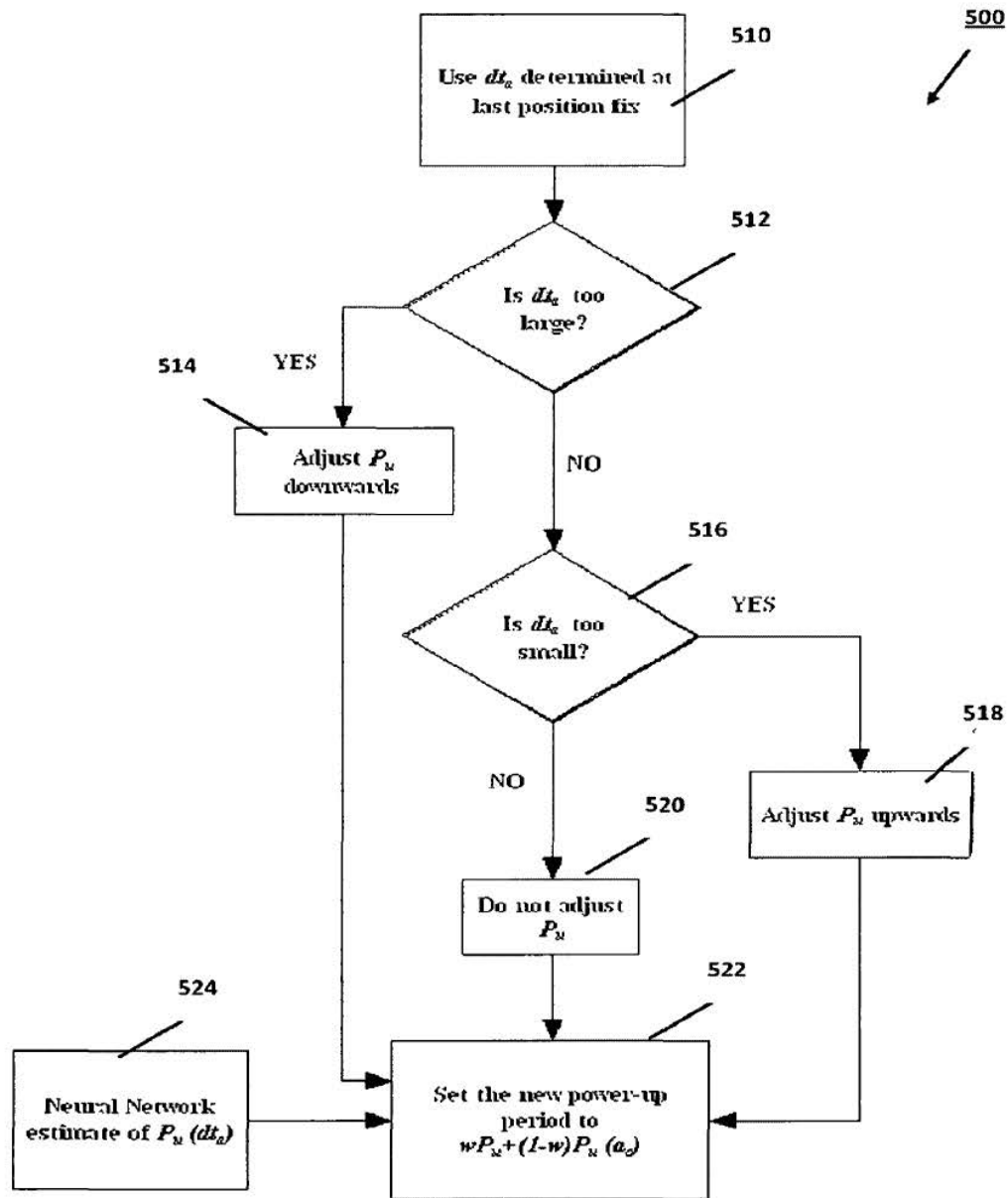


FIG. 5

New Sheet

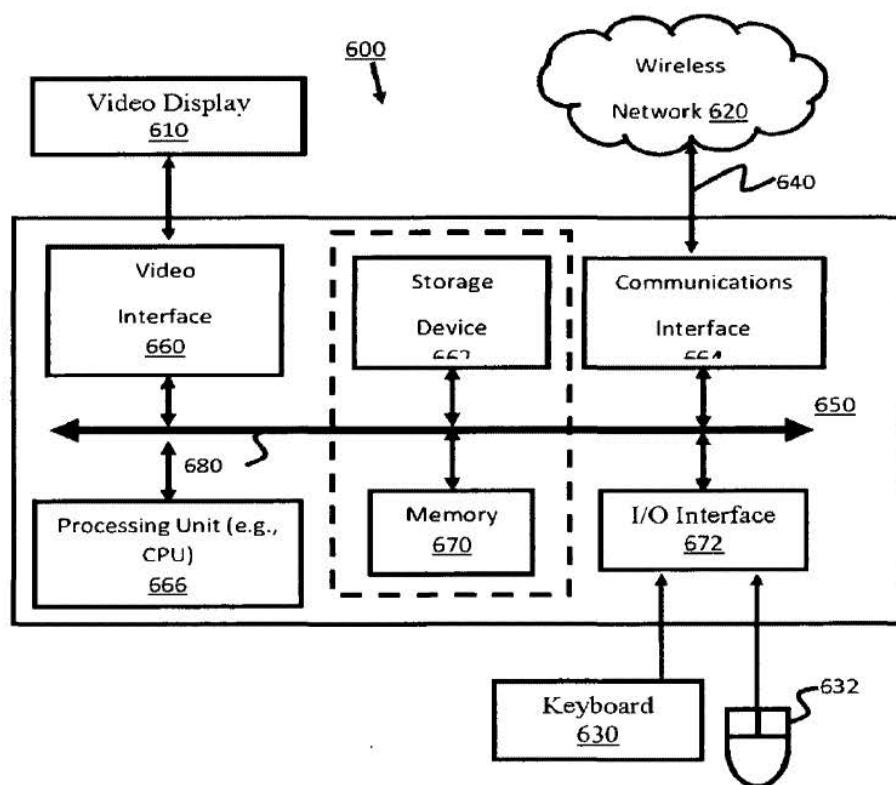


FIG. 6

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PTO/AIA/05 (08-12)

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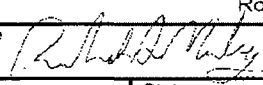
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REISSUE APPLICATION DECLARATION BY THE INVENTOR	Docket Number (Optional):
I hereby declare that: Each inventor's residence and mailing address are stated below next to their name. I believe I am the original inventor or an original joint inventor of the subject matter which is described and claimed in patent number <u>8022870</u>, granted <u>09-20-2011</u> and for which a reissue patent is sought on the invention titled <u>Self Monitoring GPS on Mobile Device</u> the specification of which ☒ is attached hereto. ☐ was filed on _____ as reissue application number _____. The above-identified application was made or authorized to be made by me. I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both. I believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.) ☐ by reason of a defective specification or drawing. ☒ by reason of the patentee claiming more or less than he had the right to claim in the patent. ☐ by reason of other errors. At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, a claim that the application seeks to broaden must be identified: Original Claim 1 specified a GPS system only and not other systems relying on GPS-based techniques. A new claim 37 is added to current application that rectifies that point thus broadening the original scope of the invention.	

[Page 1 of 2]

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(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)				Docket Number (Optional)	
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Legal name of sole or first inventor (E.g., Given Name (first and middle (if any) and Family name or Surname)					
Robert Anderson Malaney					
Inventor's Signature 					Date (Optional)
Residence: City		State		Country	
East Lindfield		NSW		Australia	
Mailing Address:					
16 Carlyle Rd					
City		State		Country	
East Lindfield		NSW		Australia	
☐ Additional joint inventors are named on the _____ supplemental sheet(s) PTO/AIA/10 attached hereto					

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Sender Information

In re Application of: Robert Anderson Malaney Group Art Unit: 3992
Application No.: 15/376,627

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064
132250	7590	04/01/2020		
Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA			EXAMINER PEIKARI, BEHZAD	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 04/01/2020	DELIVERY MODE 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.

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

FINAL OFFICE ACTION

This Office Action addresses U.S. Application No. 15/376,627, which is a continuation of reissue Application No. 14/031,992 (hereinafter, the '992 application), which issued as U.S. Patent No. RE46237, which is a reissue of U.S. Application No. 11/661,707 (hereinafter, the '707 application), entitled "SELF MONITORING GPS ON MOBIL DEVICE", which issued as U.S. Patent No. 8,022,870, (hereinafter, the '870 patent).

Claims 37, 41-43, 47-49 and 53-54 are pending. Claims 1-36 were canceled in a preliminary amendment filed December 12, 2016. Claims 38-40, 44-46 and 50-52 were canceled in an amendment filed December 30, 2019.

PRIOR OR CONCURRENT PROCEEDINGS

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which the patent is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

DRAWING OBJECTIONS

The drawings are objected to for the following reasons:

- The drawings are not in accordance with 37 CFR 1.83(a), which requires that “the drawing in a nonprovisional application must show every feature of the invention specified in the claims”. More specifically, because the drawings are not clear, they do not clearly show the features of new claims 37-54.
- The drawings are not in accordance with 37 CFR 1.84(I), which states, “Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined ... This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views”. The current drawings are blurry and/or pixelated to the extent that they are difficult to understand. Note, for example, Figure 1 shown below:

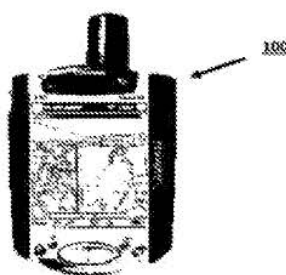


FIG. 1

- The drawings are not in accordance with 37 CFR 1.84(p)(5), which states, “Reference characters not mentioned in the description shall not appear in the drawings”. Note for example reference character 218 is not mentioned in the specification. The description “210-220” is not adequate to describe element 218. Also, several elements of Figure 6 were not described in the specification.

Note: the objection based on 37 CFR 1.84(p)(5) would be overcome if the proposed amendments to the specification were submitted in proper format such that the amendments could be entered (see the discussion of the specification below).

- The amended drawings are not in accordance with 37 CFR 1.173(b)(3), which requires that each amended drawing figure be labeled “Amended” (note that this is in addition to the entire sheet being designated “Replacement Sheet” or “New Sheet”).

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note 37 CFR 1.173 for reissue drawing amendments. Note also MPEP 1413.

SPECIFICATION

The disclosure is objected to because of the following informalities:

- The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which new claims 37-54 are directed.
- The specification must be amended to include "Cross-Reference to Related Application" section at the beginning of the specification. Should the application result in a reissue patent, the reissue information will appear in item [64] on the front page of the reissue patent. An example of the suggested language to be inserted is as follows:

"Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 8,022,870. The present reissue Application No. 15/376,627 is a continuation of reissue Application No. 14/031,992, which issued as U.S. Patent No. RE46237, both of which are reissues of U.S. Patent No. 8,022,870."

- In line 1 of the abstract, "and" should replace "arid".
- In column 2, line 63, "to determine" should replace "of".
- In column 5, line 15, "to determine" should replace "of".

Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to 37 CFR 1.173(b)(1).

Appropriate correction is required.

Note: The amendment to the specification filed December 30, 2019 would, if entered, have overcome the objections to the specification noted above. However, the amendment has *not* been entered because it is not in proper format for entry.

- The amendment is not in accordance with 37 CFR 1.121(h), which requires that each section of an amendment be presented on a separate sheet (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks). The amendment filed December 30, 2019 has the amendments intermingled with the remarks. Further, some of the amendments to the specification are included with the discussion of the drawings and others with the discussion of the specification.
- If any corrected amendment to the specification is to be filed, the following format is suggested for legibility:
 - (i) Lines that are 1 1/2 or double spaced;
 - (ii) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier), preferably a font size of 12; and
 - (iii) Only a single column of text.

CLAIM SUPPORT

In accordance with 37 CFR 1.173(c), the reissue applicant must provide an explanation of the support in the disclosure of the patent for the changes made to the claims. The explanation of support must be on page(s) separate from the page(s) containing the amendment.

An explanation of support for each of the amended claims is required in response to this Office action. Mere citations in the disclosure will not be sufficient.

Note also MPEP 1411.02.

Note: (i) The remarks submitted with the amendment of December 12, 2016 included a page of citations in support of the new claims. However, citations are not the same as explanations.

(ii) The remarks submitted with the amendment of December 30, 2019 included a discussion of claim support for the features of claim 1 (presumably meant to be claim 37).

Thus, a discussion (explanation) of support for each limitation of each of new claims 37, 41-43, 47-49 and 53-54 is still required.

CLAIM OBJECTIONS

The previous objections to the claims are *withdrawn* due to the amendment filed December 30, 2019.

OBJECTIONS BASED ON DEFECTIVE OATH/DECLARATION

The previous objections to the declaration are *withdrawn* due to the corrected reissue declaration filed with the amendment of December 30, 2019.

REJECTIONS BASED ON DEFECTIVE OATH/DECLARATION

The previous rejections based upon a defective reissue declaration under 35 U.S.C. §251 are *withdrawn* due to the corrected reissue declaration filed with the amendment of December 30, 2019.

The previous rejections based upon impermissible recapture under 35 U.S.C. §251 are *withdrawn* due to the amendment to the claims filed December 30, 2019.

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be

commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(I)(1) - 706.02(I)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 37, 41-43, 47-49 and 53-54 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-39 of U.S. Patent No. RE46237. Although the claims at issue are not identical, they are not patentably distinct from each other because each limitation of independent claims 37, 43 and 49 of the present application is either taught or suggested by claims 1, 12 and 23 of U.S. Patent No. RE46237. Note the following side-by-side comparison of the claims:

U.S. Application No. 15/376,627	U.S. Patent No. RE46237
37. A method of acquiring a position on a mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said method comprising:	1. A method of acquiring position a mobile wireless communication device for a wireless communications network, and an embedded Global Positioning System (GPS) module for GPS capability, said method comprising:
determining when said embedded GPS module should be powered on, said embedded GPS module then being powered on,	adaptively predicting when said GPS module should be powered on to meet specifications on at least one of positioning accuracy and GPS acquisition time,
said when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network,	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network,
said wireless communications network being different from said GPS.	said wireless communications network being different from said GPS.
43. A mobile wireless communication device for a wireless communications network,	12. A mobile wireless communication device for a wireless communications network,
said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said mobile wireless communication device comprising:	said mobile wireless communication device possessing wireless communications capability for said wireless communications network, said mobile wireless communication device comprising:
	a processor;
	a memory coupled to said processor;
an embedded GPS module providing a GPS capability for said mobile wireless communication device; and means for	an embedded Global Positioning System (GPS) module coupled to said processor providing a GPS capability for said mobile wireless communication device; and
determining when said embedded GPS module should be powered on, said	means for adaptively predicting when said GPS module should be powered on

embedded GPS module then being powered on,	to meet specifications on at least one of positioning accuracy and GPS acquisition time,
said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network, said wireless communications network being different from said GPS.
49. A computer program product for a mobile wireless communication device for a wireless communication network,	23. A computer program product for a mobile wireless communication device for a wireless communication network,
said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability,	said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded Global Positioning System (GPS) module for GPS capability,
said GPS referring to GPS-based techniques, said computer program storing a computer program for acquiring a GPS position on said mobile wireless communication device, comprising:	said computer program product having a computer readable medium storing a computer program for acquiring position on said mobile wireless communication device, comprising:
A first computer program code designed to interface with the GPS capability of said mobile wireless communication device; and	computer program code means for interfacing with the GPS capability of said mobile wireless communication device; and
and a second computer program code designed to determine when said embedded GPS module should be powered on,	computer program code means for adaptively predicting when said GPS module should be powered on to meet specifications on at least one of positioning accuracy and GPS acquisition time
said embedded GPS module then being powered on,	
said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network,	said adaptively predicting when said GPS module should be powered on being dependent on a position error of said mobile wireless communication device in the wireless network, said position error being determined from the wireless communications network,
said wireless communications network being different from said GPS.	said wireless communications network being different from said GPS.

Thus all of the features of claims 37, 43 and 49 of the present application are taught or suggested by the features of claims 1, 12 and 23 of U.S. Patent No. RE46237, including limiting a satellite positioning system to a GPS or explaining that the module is indeed powered on.

In addition, claims 41-42, 47-48 and 53-54 are rejected as being dependent on base claims 37, 43 and 49, respectively.

CLAIM INTERPRETATION

The following is a quotation of 35 U.S.C. 112(f):

(f) Element in Claim for a Combination. – An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The following is a quotation of pre-AIA 35 U.S.C. 112, sixth paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The claims in this application are given their broadest reasonable interpretation using the plain meaning of the claim language in light of the specification as it would be understood by one of ordinary skill in the art. The broadest reasonable interpretation of a claim element (also commonly referred to as a claim limitation) is limited by the description in the specification when 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is invoked.

As explained in MPEP § 2181, subsection I, claim limitations that meet the following three-prong test will be interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph:

- (A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
- (B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and
- (C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

Use of the word “means” (or “step”) in a claim with functional language creates a rebuttable presumption that the claim limitation is to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is rebutted when the claim limitation recites sufficient structure, material, or acts to entirely perform the recited function.

Absence of the word “means” (or “step”) in a claim creates a rebuttable presumption that the claim limitation is not to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is not interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth

paragraph, is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function.

Claim limitations in this application that use the word "means" (or "step") are being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action. Conversely, claim limitations in this application that do not use the word "means" (or "step") are not being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action.

This application includes one or more claim limitations that use the words "means for" and also limitations that do not use the word "means," but are nonetheless being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, because the claim limitation(s) uses a generic placeholder that is coupled with functional language without reciting sufficient structure to perform the recited function and the generic placeholder is not preceded by a structural modifier.

Three Prong Analysis

To invoke 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, a claimed phrase must meet the three prong analysis as set forth in MPEP § 2181, subsection I.

(A) Regarding Prong (A), the MPEP states:

(A) the claim limitation uses the term "means" or "step" or a term used as a substitute for "means" that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function....

The claim limitations listed below do not use the language "means" or "step". However, each of these is found to be a generic placeholder. The limitations are listed below the claim in which they first appear.

With regard to claim 43,

- means

With regard to claim 49,

- computer program
- first computer program code
- second computer program code

Each of these limitations meets Prong (A) of the analysis.

(B) Regarding Prong (B), the MPEP states:

(B) the term "means" or "step" or the generic placeholder is modified by functional language, typically, but not always linked by the transition word "for" (e.g., "means for") or another linking word or phrase, such as "configured to" or "so that"...

The claim limitations listed below are each modified by functional language, as shown.

- means ("*for*")
- computer program ("*for acquiring*")
- first computer program code ("*designed to*")
- second computer program code ("*designed to*")

Each of these limitations meet Prong (B) of the analysis.

(C) Regarding Prong (C), the MPEP states:

(C) the term "means" or "step" or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function.

With regard to where the limitations may be found in the disclosure, note the following:

- means for determining when said embedded GPS module should be powered on (*note column 6, lines 60 et seq., which discusses determining the best fit for a power up period*)
- computer program (*adequate structure not found*)
- first computer program code (*adequate structure not found*)
- second computer program code (*adequate structure not found*)

With regard to the claimed "computer program", a particular computer program for performing the functions listed in the claim was not shown in the disclosure.

With regard to the claimed "computer program code", the disclosure notes "method steps may be put into effect by computer code", but no particular code was disclosed for the claimed computer program product. Note also column 2, lines 49-65 of the specification.

With regard to the "means for determining when said embedded GPS module should be powered on", this limitation does not meet Prong (C) of the analysis and thus does not invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph.

With regard to the "computer program", and the "computer program code", these limitations meet Prong (C) of the analysis.

Because all three prongs of the analysis have been met, these terms invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph.

Note: In order to rebut the assertion that the “non-transitory computer readable medium”, the “computer program”, and the “computer program code means” invoke 35 U.S.C. § 112, 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph, applicant must either (a) amend the claims or (b) show where in the disclosure adequate structure for these limitations is found (*cf.* the section on “Claim Support” above) or (c) both.

CLAIM REJECTIONS - 35 USC § 112, 1st PARAGRAPH

The previous rejections under 35 U.S.C. §112 (1st ¶) as failing to comply with the written description requirement for “a switch on of power... using electronic circuits” is *withdrawn* due to the amendment filed December 30, 2019.

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 49 and 53-54 are rejected under 35 U.S.C. §112 (1st ¶) as failing to comply with the written description requirement.

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventors, at the time the application was filed, had possession of the claimed invention. As discussed above, the disclosure does not provide a sufficient corresponding structure and/or algorithm for the following elements of the computer program product:

- computer program
- first computer program code
- second computer program code

Since the specification fails to disclose the corresponding structures for these functional limitations, Applicant has not satisfactorily demonstrated possession of the corresponding structures of the claimed invention. See MPEP 2181(II).

CLAIM REJECTIONS - 35 USC § 112, 2nd PARAGRAPH

Some of the previous rejections under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, is *withdrawn* due to the amendment filed December 30, 2019. These rejections have been removed.

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49 and 53-54 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. As discussed above, the disclosure does not provide a sufficient corresponding structure and/or algorithm for the following elements of the computer program product:

- computer program
- first computer program code
- second computer program code

Since the disclosure fails to describe the corresponding structures for these functional limitations, claims 49-54 are indefinite under 35 U.S.C. §112 (2nd ¶). See also *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 86 USPQ2d 1235, 1243 (Fed. Cir. 2008) (means-plus-function limitations lacking sufficient disclosure of structure renders the claims indefinite). See also MPEP 2181(II).

Further:

In claim 49, line 4, “said computer program” has no antecedent basis.
(Presumably, this should read “said computer program product”).

In claim 49, line 4, it is not clear how “said computer program” (or “said computer program product”) could be “storing” a computer program.

CLAIM REJECTIONS - 35 USC § 103

The previous rejections of the claims as being unpatentable under 35 U.S.C. §103, based on prior art, are *withdrawn* due to the remarks submitted with the amendment of December 30, 2019. Applicant's arguments regarding the Pande, U.S. Patent No. 6,703,971, reference are deemed convincing.

RESPONSE TO ARGUMENTS

Applicant's arguments and amendments filed on December 30, 2019 have been carefully considered by the examiner.

With regard to the issues of claim interpretation and corresponding rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph and second paragraph, the following is suggested: replace "storing a computer program" in claim 49, line 4, with "product embodied on a computer readable storage medium, said computer program product"; then, identify (either by a particular limitation in the claim or in applicant's remarks) support for the computer readable medium in the disclosure (note column 4, lines 56 *et seq.* of the specification).

If the above suggestions are incorporated into claim 49, the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph and second paragraph would be overcome.

Further, if a proper terminal disclaimer is filed, the double patenting rejections would be overcome.

With regard to the objections to the drawings, specification, etc., this Office action has been structured to address each of these amendments and arguments within their relevant sections, with guidance added where deemed necessary to assist applicant in overcoming any outstanding objections.

CONCLUSION

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. James Peikari whose telephone number is (571)272-4185. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski, SPE Art Unit 3992, can be reached at (571) 272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. James Peikari/
Primary Examiner
Art Unit 3992

Conferees:

/C.M.T/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art
Unit 3992

<i>Search Notes</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
G01S 19/34	8/9/2017	mcb
G01S 19/34; G01S 19/42	09/23/2019	BJP

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
342	357.74	09/23/2019	BJP

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
See attached EAST Search History	8/9/2017	mcb
WEST Search Enclosed / inventor name search	09/23/2019	BJP
G01S 19/34; G01S 19/42 - limited by text search	09/23/2019	BJP
342/357.74 - limited by text search	09/23/2019	BJP
Interference search by text search of claim language	09/23/2019	BJP
Google update search performed	03/25/2020	BJP

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<i>Search Notes</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
342	357.74	09/23/2019	BJP

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<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS									
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47									
CLAIM		DATE							
Final	Original	09/21/2019	03/25/2020						
	1	-	-						
	2	-	-						
	3	-	-						
	4	-	-						
	5	-	-						
	6	-	-						
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	31	-	-						
	32	-	-						
	33	-	-						
	34	-	-						
	35	-	-						
	36	-	-						
	37	✓	✓						
	38	✓	-						
	39	✓	-						
	40	✓	-						
	41	✓	✓						
	42	✓	✓						

<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CLAIM		DATE							
Final	Original	09/21/2019	03/25/2020						
	43	✓	✓						
	44	✓	-						
	45	✓	-						
	46	✓	-						
	47	✓	✓						
	48	✓	✓						
	49	✓	✓						
	50	✓	-						
	51	✓	-						
	52	✓	-						
	53	✓	✓						
	54	✓	✓						

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875				Application or Docket Number 15/376,627		Filing Date 12/12/2016		☐ To be Mailed		
ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO										
APPLICATION AS FILED - PART I										
		(Column 1)	(Column 2)							
FOR		NUMBER FILED	NUMBER EXTRA	RATE (\$)		FEE (\$)				
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A	N/A	N/A						
☐ SEARCH FEE (37 CFR 1.16(k), (l), or (m))		N/A	N/A	N/A						
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))		N/A	N/A	N/A						
TOTAL CLAIMS (37 CFR 1.16(j))		minus 20 =	*	x \$40 =						
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 =	*	x \$210 =						
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))										
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL						
APPLICATION AS AMENDED - PART II										
		(Column 1)	(Column 2)	(Column 3)						
AMENDMENT	06/30/2020	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)		ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))	* 9	Minus	** 20	= 0	x \$50 =		0		
	Independent (37 CFR 1.16(h))	* 3	Minus	*** 3	= 0	x \$230 =		0		
	☐ Application Size Fee (37 CFR 1.16(s))									
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
						TOTAL ADD'L FEE		0		
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)		ADDITIONAL FEE (\$)			
	Total (37 CFR 1.16(i))	*	Minus	**	=	x \$0 =				
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x \$0 =				
	☐ Application Size Fee (37 CFR 1.16(s))									
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
						TOTAL ADD'L FEE				
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.						Examiner				
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".						/PATRICIA A VOLPE/				
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".										
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert Anderson Malaney

Group Art Unit: 3992

Application No.: 15/376,627

Examiner: PEIKARI, BEHZAD

Confirmation No.: 2064

For: SELF MONITORING GPS ON MOBILE DEVICE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the examiner's last report I note the following in the attached;

Respectfully Submitted,

/Robert A. Malaney/

Robert A. Malaney, Customer Number 132250

16 Carlyle Rd
East Lindfield, NSW 2070,
Australia

Please note the remarks below and the cancellation of claims are submitted without prejudice. It is hoped they help expediate prosecution.

Drawing Objections

New drawings supplied (see attached replacement sheets).

Fig 1 is replaced with a schematic diagram of a PDA rather than an image of a PDA.

Fig. 2, Fig.3, Fig.4, Fig 5, and Fig.6 are replaced with corrected labels of numbers related to elements of the drawing.

To remedy fact item 218 of Fig 2 not explicitly mentioned in text of specification, the specification is amended.

To remedy fact some items in Fig 6. not explicitly mentioned in text of specification, the specification is amended:

Amendment to Specification

Title page 1 to be amended as follows:

[SELF MONITORING GPS ON MOBILE DEVICE] REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

On front page of the re-issue add Cross-reference to related Application, add the following:

Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 8,022,870. The present reissue Application No. 15/376,627 is a continuation of reissue Application No. 14/031,992 which issued as Patent No. RE46237, both of which are reissues of U.S. Patent No. 8,022,870.

Replace abstract as follows:

A method, a mobile device [arid] and a computer program product for acquiring GPS on a mobile device possessing GPS capability are disclosed. The method comprises the step of setting a current value of the period of the power-up phase of the GPS dependent upon adaptive predictions of when the GPS should be powered on to meet specifications on positioning accuracy and GPS acquisition time.

Replace paragraph commencing column 2 line 54 as follows:

According to yet another aspect of the present invention, there is provided a computer program product for a mobile device possessing GPS capability. The computer program product having a computer readable medium storing a computer program for acquiring GPS on the mobile device. The computer program product comprises computer program code means for interfacing with the GPS capability of the mobile device and computer program code means for setting a current value [of] to determine a period of the power-up phase of the GPS module dependent upon adaptive predictions of when the GPS module should be powered on to meet specifications on positioning accuracy and GPS acquisition time.

Replace paragraph commencing column 5 line 15 as follows:

Adaptive predictions are made [of] to determine when a GPS device, embedded in a wireless communication device, should be powered on to meet specifications on positioning accuracy and GPS acquisition time. The embodiments of the invention address the issue of setting the period of the power-up phase, P_u , whilst retaining the accuracy of the position fix and the acquisition times of the position fix within acceptable bounds. Simply setting P_u to some value at the onset of operation may provide the required bounds for some time epoch, but there is no guarantee that this will also be the case in the future. Also, this simple approach provides no sense of an optimized value of P_u . By this, what is meant is the maximum value of P_u , allowable whilst still retaining the accuracy of the position fix and the acquisition times of the position fix within acceptable bounds. An example of an inefficient system design would be a GPS system reporting positions every second when an acceptable error bound (accuracy) of 50 meters was required on a device moving at 1 meter per second. The embodiments of the invention allow a GPS device to determine dynamically an optimal P_u in response to such a circumstance.

In column 6 the paragraph at line 23 to be amended as follows:

FIG. 2 is a block diagram of the system 200 that may be implemented using the PDA of FIG. 1. The system 200 comprises a neural network module 230 that receives various inputs 210-220 to produce a predicted period of the power-up phase P_u , 240. The neural network module 230 predicts the next time to power on the GPS device. This module 230 does so dependent upon various inputs including the last satellite positions 210, the last GPS position/time 212, the last GPS error 214, the current power-up time 216, information about whether or not the last target (i.e. were the accuracy requirements satisfied or not) was achieved 218, and the current radio position and error 220. The latter information 220 may be determined using Cramer-Rao bounds. Further details of the neural network 200 are set forth hereinafter.

In column 10 the paragraph at line 52 to be amended as follows:

FIG. 6 illustrates the computer system 600 in block diagram form with video display 610, video interface 660, storage device 662, processing unit (e.g. a CPU) 666, memory 670, and I/O interface 672, coupled to a wireless network 620. An operator may use the keyboard 630 and/or a pointing device such as the mouse 632 (or touchpad, for example) to provide input to the computer 650. The computer system 600 may have any of a number of output devices, including line printers, laser printers, plotters, and other reproduction devices connected to the computer. The computer system 600 can be connected to one or more other computers via a communication interface 664 using an appropriate communication channel 640. The computer network 620 may comprise a wireless local area network (WLAN), or a 3G network, for example. While not depicted in FIG. 6 to simplify the drawing, it will be readily appreciated by those skilled in the art that the computer system 600 may be equipped with a GPS module, for example, in the manner shown in FIG. 1.

Claim Support

New claim 37 is amended.

Inclusion of “said GPS referring to GPS-based techniques”. Support for the use of ‘GPS-based techniques’ is provided at col 1 line 42. That is, the invention is not directed solely at the United States’ GPS system but all similar satellite positioning systems that use ‘GPS-based techniques’.

In further support we also note the term GPS technologies (col 1 lines 21-24) is meant to convey all GPS-like systems. ‘GPS-based techniques’ can be thought of as those that use line of sight measurements to satellites’ (col 1 lines 23-24). In the invention the word ‘GPS’ is meant to refer to any GPS-based technology, e.g. Glonass (Russia), Galileo (Europe), QZSS (Japan) BeiDou (China) as well as the original GPS (USA).

Inclusion of “dependent on at least one of a current radio position and error determined from the wireless communications network”. Support for this is in Fig 2 which shows an implementation on a PDA which takes various inputs as part of the decision process of which the current radio position and error are listed. See also column 6 lines 33-34.

Discussion on adapting how many inputs are then used in the decision-making process are given in column 9 lines 16-18, lines 34-40. That is, it is made clear that the invention allows all for all, or only one, of the inputs (or any other combination) to be used in the decision-making process.

Inclusion of “embedded GPS module” is cited column 5 line 56 and is used to make clear the GPS is actually embedded in the device (i.e. forms a part of the device – and the device possesses GPS capability).

New Claim 41.

The use of Tricklepower and its role is discussed in specification (col 2 lines 24-32, col 7 lines 24-25). This is a functionality well known to all skilled in the art and is used to put the GPS chipset effectively to sleep or effectively in a power-off mode. This claim speaks to fact that the invention also refers to powering up the GPS from this effective power-off mode.

New Claim 42.

The numerous input features that can be used to control the power to the GPS are discussed throughout the specification (col 6 lines 28-36, col 6 line 10, col 6 line 41, col 6 line 44, col 9 line 25, Fig 2). This new claim describes some more specific inputs that can be used as part of the invention.

New Claim 43 is amended.

Inclusion in the device of “said GPS referring to GPS-based techniques”. Support for the use of ‘GPS-based techniques’ is provided at col 1 line 42. That is, the invention is not directed solely at the United States’ GPS system but all similar satellite positioning systems that use ‘GPS-based techniques’.

In further support we also note the term GPS technologies (col 1 lines 21-24) is meant to convey all GPS-like systems. ‘GPS-based techniques’ can be thought of as those that use line of sight measurements to satellites’ (col 1 lines 23-24). In the invention the word ‘GPS’ is meant to refer to any GPS-based technology, e.g. Glonass (Russia), Galileo (Europe), QZSS (Japan) BeiDou (China) as well as the original GPS (USA).

Inclusion of “dependent on at least one of a current radio position and error determined from the wireless communications network”. Support for this is in Fig 2 which shows an implementation on a PDA which takes various inputs as part of the decision process of which the current radio position and error are listed. See also column 6 lines 33-34.

Discussion on adapting how many inputs are then used in the decision-making process are given in column 9 lines 16-18, lines 34-40. That is, it is made clear that the invention allows all for all, or only one, of the inputs (or any other combination) to be used in the decision-making process.

Inclusion of “embedded GPS module” is cited column 5 line 56 and is used to make clear the GPS is actually embedded in the device (i.e. forms a part of the device – and the device possesses GPS capability).

New Claim 47:

The use of Tricklepower by the device and its role is discussed in specification (col 2 lines 24-32, col 7 lines 24-25). This is a functionality well known to all skilled in the art and is used to put the GPS chipset effectively to sleep or effectively in a power-off mode. This claim speaks to fact that the invention also refers to powering up the GPS from this effective power-off mode.

New Claim 48.

The numerous input features that can be used by the device to control the power to the GPS are discussed throughout the specification (col 6 lines 28-36, col 6 line 10, col 6 line 41, col 6 line 44, col 9 line 25, Fig 2). This new claim describes some more specific inputs that can be used as part of the invention.

New Claim 49 is amended.

Inclusion in the computer program of “said GPS referring to GPS-based techniques”. Support for the use of ‘GPS-based techniques’ is provided at col 1 line 42. That is, the invention is not directed solely at the United States’ GPS system but all similar satellite positioning systems that use ‘GPS-based techniques’.

In further support we also note the term GPS technologies (col 1 lines 21-24) is meant to convey all GPS-like systems. ‘GPS-based techniques’ can be thought of as those that use line of sight measurements to satellites’ (col 1 lines 23-24). In the invention the word ‘GPS’ is meant to refer to any GPS-based technology, e.g. Glonass (Russia), Galileo (Europe), QZSS (Japan) BeiDou (China) as well as the original GPS (USA).

Inclusion of “dependent on at least one of a current radio position and error determined from the wireless communications network”. Support for this is in Fig 2 which shows an implementation on a PDA which takes various inputs as part of the decision process of which the current radio position and error are listed. See also column 6 lines 33-34.

Discussion on adapting how many inputs are then used in the decision-making process are given in column 9 lines 16-18, lines 34-40. That is, it is made clear that the invention allows all for all, or only one, of the inputs (or any other combination) to be used in the decision-making process.

Inclusion of “embedded GPS module” is cited column 5 line 56 and is used to make clear the GPS is actually embedded in the device (i.e. forms a part of the device – and the device possesses GPS capability).

The phrase “storing a computer program” is replaced by “product embodied on computer readable storage medium, said computer program product”, and is supported in the specification (col 4 line 56). This specifies in a clearer fashion how the computer program may be stored. It is made clear in the specification how a variety of readable mediums can be used for this purpose.

New Claim 53.

The use of Tricklepower by the computer program and its role is discussed in specification (col 2 lines 24-32, col 7 lines 24-25). This is a functionality well known to all skilled in the art and is used to put the GPS chipset effectively to sleep or effectively in a power-off mode. This claim speaks to fact that the invention also refers to powering up the GPS from this effective power-off mode.

New Claim 54.

The numerous input features that can be used by the computer program to control the power to the GPS are discussed throughout the specification (col 6 lines 28-36, col 6 line 10, col 6 line 41, col 6 line 44, col 9 line 25, Fig 2). This new claim describes some more specific inputs that can be used as part of the invention.

Double Patenting

A terminal disclaimer has been filed.

Claim Interpretation (Response to Arguments)

The applicant takes advice from Examiner in Response to Arguments regarding Rejected claim 49

New Claim 49 is amended.

The phrase “storing a computer program” is replaced by “product embodied on computer readable storage medium, said computer program product”

Applicant respectfully submits the remaining dependent claims 53 and 54 are therefore also in condition for allowance.

IN THE CLAIMS

The following is a complete listing of the claims and replaces all earlier versions and listings.

37 (new, amended). A method of acquiring a position on a mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said method comprising:
determining when said embedded GPS module should be powered on, said embedded GPS module then being powered on,
said when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

38 (cancelled).

39 (cancelled).

40 (cancelled).

41 (new). The method according to claim 37, wherein said powered on comprises
said module powering up from a low-power mode such as a TricklePower power-down mode.

42 (new). The method according to claim 37, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of, a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

43 (new, amended). A mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS

capability, said GPS referring to GPS-based techniques, said mobile wireless communication device comprising:

an embedded GPS module providing a GPS capability for said mobile wireless communication device; and means for

determining when said embedded GPS module should be powered on,

said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

44 (cancelled).

45 (cancelled).

46 (cancelled).

47 (new). The mobile device according to claim 43, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

48 (new). The mobile device according to claim 43, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of: a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

49 (new, amended). A computer program product for a mobile wireless communication device for a wireless communication network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said computer program product embodied on computer readable storage medium, said computer program product for acquiring a GPS position on said mobile wireless communication device, comprising:

A first computer program code designed to interface with the GPS capability of said mobile wireless communication device; and a second computer program code designed to determine when said embedded GPS module should be powered on,

said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

50 (cancelled).

51 (cancelled).

52 (cancelled).

53 (new). The computer program product according to claim 49, wherein said powered on comprises said module powering up from a low-power mode such as a TricklePower power-down mode.

54 (new). The computer program product according to claim 49, wherein said determining when said embedded GPS module should be powered on is also dependent on at least one of; a last satellite position; a last position determined by the GPS; and a last time determined by the GPS.

REPLACEMENT SHEET

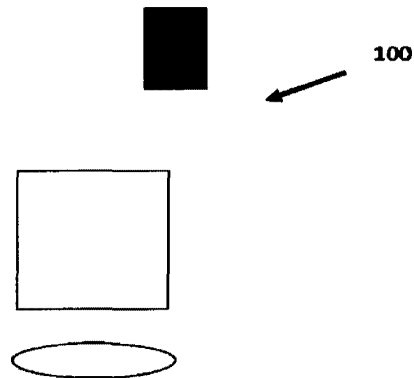


FIG. 1 (Amended)

REPLACEMENT SHEET

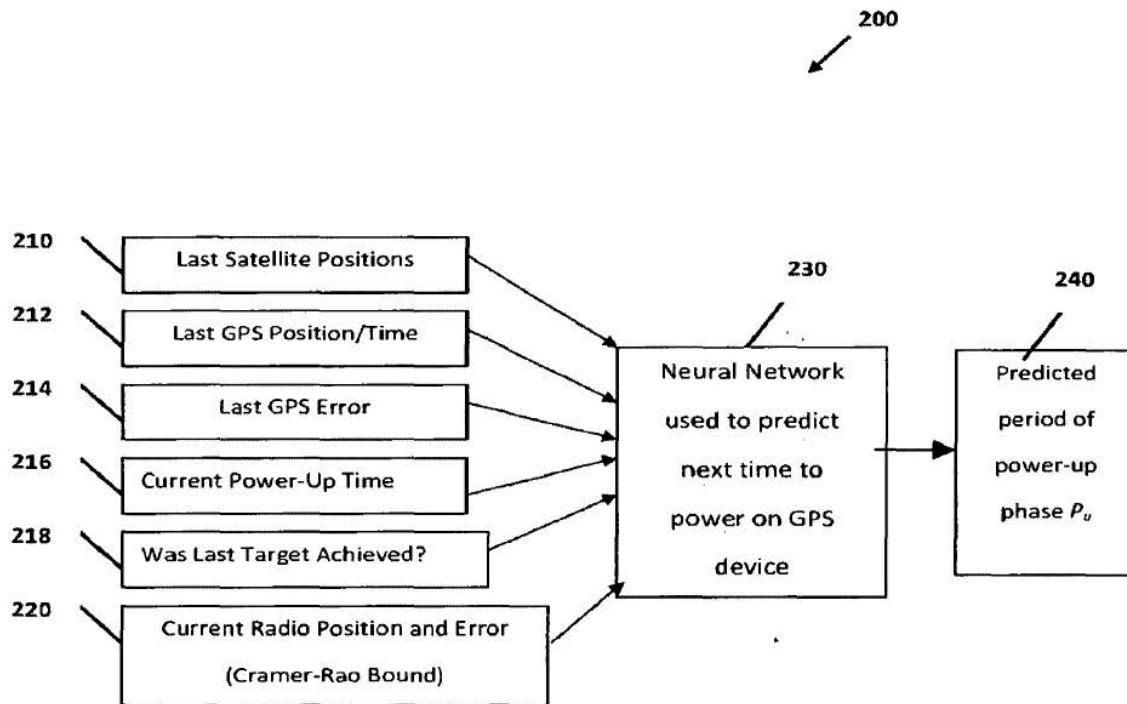


FIG. 2 (Amended)

REPLACEMENT SHEET

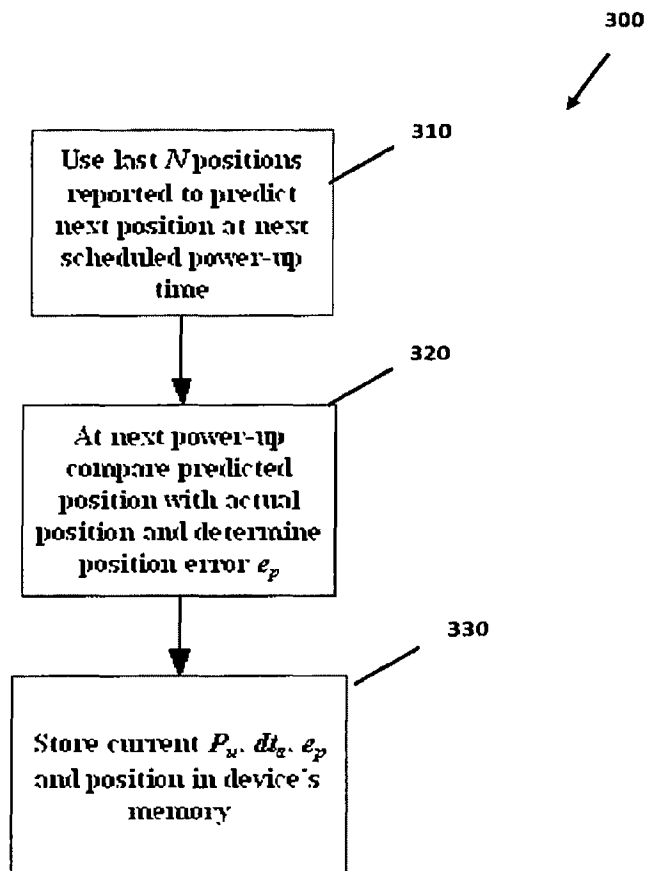


FIG. 3 (Amended)

REPLACEMENT SHEET

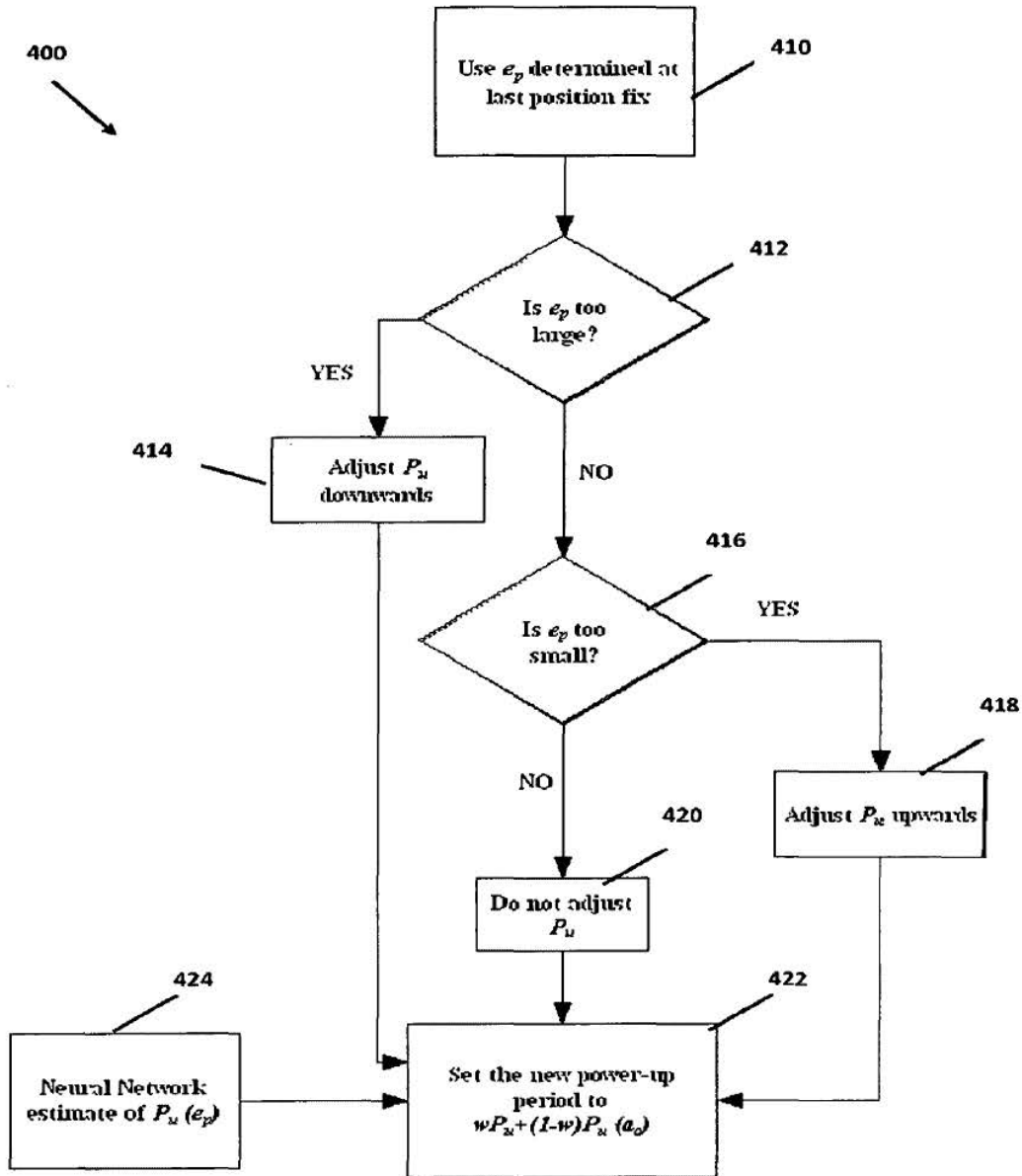


FIG. 4 (Amended)

REPLACEMENT SHEET

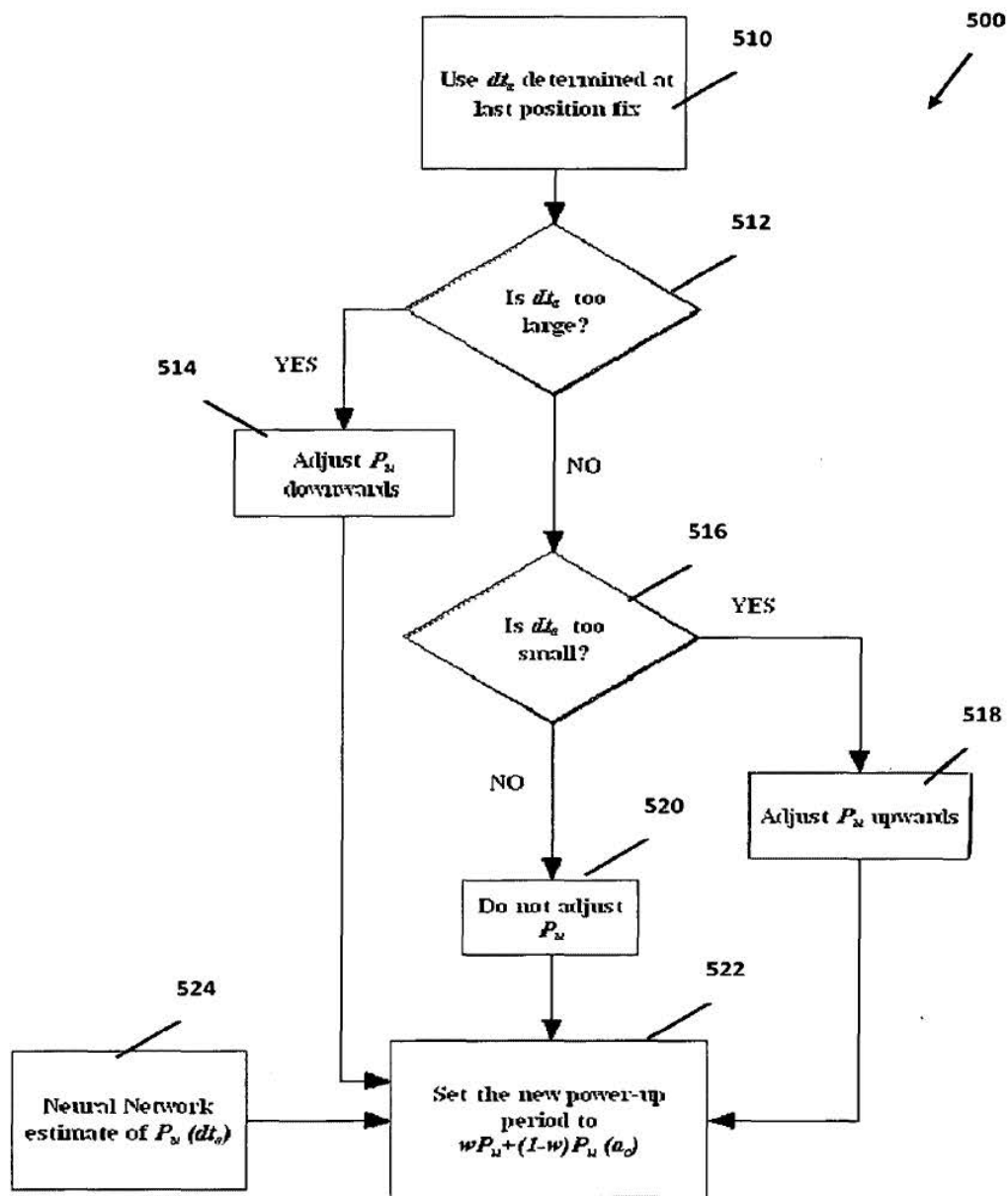


FIG. 5 (Amended)

REPLACEMENT SHEET

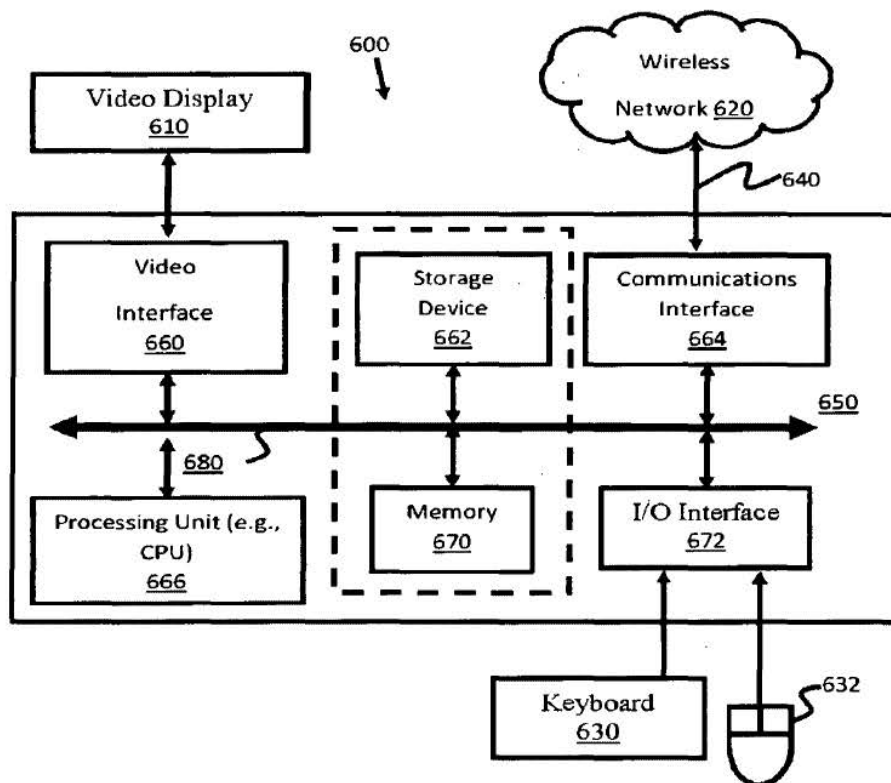


FIG. 6 (Amended)

30-Jun-2020 04:47 From Robert Malaney. Phone #61294161983

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p.1

Recipient Information

To: Patent Office
Company: USPTO
Fax #: 15712738300

JUN 30 2020

fax

Sender Information

From: Robert Malaney
Email address: robert@malaney.net (from 122.106.241.103)
Phone #: 61294161983
Sent on: Tuesday, June 30 2020 at 12:41 AM EDT

Payment, Terminal Disclaimer, and response to Examiner 19 pages total (not including cover)

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1/1

PAGE 1/20 * RCVD AT 6/30/2020 12:47:31 AM [Eastern Daylight Time] * SVR:W-PTOFAX-002/30 * DNIS:2738300 * CSID:FaxZero.com * ANI:7075618496 * DURATION (mm-ss):07-03

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TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT		Docket Number (Optional)
In re Application of: ROBERT ANDERSON MALANEY		
Application No.: 15/376,627		
Filed: 12-12-2016		
For: SELF MONITORING GPS ON MOBILE DEVICE		
The owner*, <u>ROBERT ANDERSON MALANEY</u>, of <u>100</u> percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. <u>8,022,870</u> as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns. In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later: - expires for failure to pay a maintenance fee; - is held unenforceable; - is found invalid by a court of competent jurisdiction; - is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; - has all claims canceled by a reexamination certificate; - is reissued; or - is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer Check either box 1 or 2 below, if appropriate 1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon 2. ☐ The undersigned is an attorney or agent of record. Reg No _____ _____ /Robert A. Malaney/ Signature _____ 29 June 2020 Date _____ ROBERT A. MALANEY Typed or printed name _____ 62 2 94161980 Telephone Number ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. *Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324		

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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Application Number * 15/376,627 *	Application/Control No. 15/376,627	Applicant(s)/Patent under Reexamination Malaney, Robert Anderson	
	Examiner PEIKARI, BEHZAD	Art Unit 3992	
Document Code - DISQ		Internal Document - DO NOT MAIL	

TERMINAL DISCLAIMER	☒ APPROVED	☐ DISAPPROVED
Date Filed: <u>30 June 2020</u>	This patent is subject to a Terminal Disclaimer	

Approved/Disapproved by:
/ MANUEL SALDANA JR/ Technology Center: <u>OCRU</u> Telephone: <u>(571)272-7740</u> _____

30-Jun-2020 04:49 From Robert Malaney. Phone #61294161983

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p. 4

JUN 30 2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert Anderson Malaney

Group Art Unit: 3992

Application No.: 15/376,627

Examiner: PEIKARI, BEHZAD

Confirmation No.: 2064

For: SELF MONITORING GPS ON MOBILE DEVICE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the examiner's last report I note the following in the attached;

Respectfully Submitted,

/Robert A. Malaney/

Robert A. Malaney, Customer Number 132250

16 Carlyle Rd

East Lindfield, NSW 2070,

Australia

Dear Dr Malaney,

I will be online at that time.

Or you could call right now, if you are available.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>

Sent: Friday, July 10, 2020 7:57 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Yes, I will call you at the number below at noon, which is 2 hours from now.

571 272 4185

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: 7/11/20 9:35 am

To: "robert@malaney.net" <robert@malaney.net>

Dear Dr Malaney,

Will noon today, Sydney time, work for you?

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>

Sent: Friday, July 10, 2020 7:09 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Hi Mr Peikari, just let me know any time that suits you suits you 6am through 6pm Sydney time, any day.
Thanks Robert

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: 7/11/20 12:53 am

To: "robert@malaney.net" <robert@malaney.net>

Dear Dr Malaney,

Thank you for your amendment. Could you please set up a phone call as soon as possible? I will be available through the weekend and even at times that would accommodate your time zone.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>
Sent: Friday, June 26, 2020 8:32 PM
To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>
Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

PS. The Terminal Disclaimer form to be filed will be as attached. I have put the original title on this, which I presume is the correct thing to do. If not so please advise.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]
From: "robert@malaney.net" <robert@malaney.net>
Date: 6/27/20 10:04 am
To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Many thanks, Mr. Peikari for your assistance.

I will officially file the attached response Monday. Please note the amended figures 1 through 6 are in this word doc should you need them to file an examiner's amendment.

Regards, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]
From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>
Date: 6/26/20 11:34 am
To: "robert@malaney.net" <robert@malaney.net>
Dear Dr. Malaney,

Please keep in mind that this is not an official decision, but rather informal guidance directed to your proposed amendments. I have not considered the amendments on the merits at this time. Rather, I have focused only on errors in formal matters in the presentation of your amendments. I hope these suggestions will be helpful:

Drawings:

All sheets should be labeled "REPLACEMENT SHEET" (the drawing figures are not new, they are replacements).

The word "Amended" should not be in the upper left hand corner, but after the view number. For example, the view numbers should read "FIG. 1 (Amended)", "FIG. 2 (Amended)", etc.

Elements 100, 200, 300, etc. should not be underlined. Elements should be underlined when they appear within the drawing itself. Otherwise, when outside the drawing (such as 100, 200, 300, etc), they should have arrows pointing to the drawing. No element should have an both underlining and an arrow.

In Figure 6, element numbers 662 and 664 should be corrected.

Specification:

The title correction does not need (54) in front of it. Also, "DEVICE" is missing.

Matter to be omitted in reissue applications must be enclosed in brackets. Strikethrough is not permitted in reissue application amendments. For subject matter added, this should be underlined. See 37 CFR 1.173(d). This applies to all amendments to the specification.

For example, the proposed amendment to the title should look like this:

[SELF MONITORING GPS ON MOBILE DEVICE] REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

In the last line of the Cross-reference language, replace "8022,870" with "8,022,870".

Claims:

Canceled claims should not be presented. See 37 CFR 1.173(b)(2).

For example,

45. (Canceled)

Regarding your question about the drawing submissions, I think it would be best if you submit them in the usual way. If there is still an issue with legibility, I will contact you for a .pdf copy of the drawings to see if I would be allowed to enter them by examiner's amendment, should the application be otherwise in condition for allowance.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>

Sent: Thursday, June 25, 2020 3:12 AM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Thanks Mr Peikari - I would appreciate that very much. One other question is whether you can use the images I send to you by email directly as part of the submission - so as to avoid any blurring by the fax process? Regards, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: 6/25/20 4:03 am

To: "robert@malaney.net" <robert@malaney.net>

Dear Dr. Malaney,

I've been looking through your proposed response and writing up some quick suggestions.

I hope to have a full response by tomorrow.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>

Sent: Monday, June 22, 2020 4:23 AM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari - I would greatly appreciate it if you could quickly look over the attached draft response to your report to check if there are any issues you see that are not in order prior to my formal submission.

Many thanks, Robert Malaney

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: 6/16/20 9:30 am

To: "robert@malaney.net" <robert@malaney.net>

Dear Dr. Malaney,

I sent you an email about a week ago. As I look over the sent email, it seems that my reply went to an entirely different address ('accounts@solutionsandinnovations.com.au'). I am not sure why that happened, since I replied to your email.

Here is a copy of the email that I sent:

Dear Dr. Malaney,

Thank you for your patience. I will endeavor to answer your questions as accurately as possible:

Q1) Is it ok to replace fig 1 with a new schematic drawing of a generic mobile device? (as current image used in fig 1 is not being reproduced properly by USPTO fax).

Yes, that would be preferable.

Q2) All other drawings have been previously accepted by USPTO as clear, so I am assuming the rest are ok? If there is anything else specific, please let me know by pointing to the issue in the specific drawing.

All of the drawings we have received by fax are blurry. Drawings (such as FIG. 2 and FIG. 6) which have elements that were not described in the specification should either be amended to remove those elements, or the specification should be amended to include them (without introducing new matter).

Q3) Re Claims Interpretation: If understand correctly you are stating claim 43 (and dependent claims 44-48) are not rejected under this section?

The claim interpretation section sets the groundwork for the rejections that follow in the next sections. Claims 43-48 do not appear to include the language "computer program", "first computer program code" or "second computer program code", so claims 43-48 have not been rejected based on the written description requirement in view of the claim interpretations.

However, although claim 49 (and dependent claims 50-54) are currently rejected, you state remaining objections raised can be overcome by use of new claim language outlined by you (page 20, Response to Arguments, of your report)?

Yes, this is my best suggestion at the present time. Also, please make sure to demonstrate support in the disclosure, as recommended in the Response to Arguments section.

PS I can find nothing on USPTO regarding fees associated with after final amendments just that they must be compliant. I did notice the <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20> scheme. Is this a better way to proceed?

At this time, the pilot program is not available for reissue applications.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: robert@malaney.net <robert@malaney.net>

Sent: Monday, June 15, 2020 7:13 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr. Peikari - The time-limit is almost up. I would greatly appreciate your help with this pro se application. Thanks, Robert Malaney

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "robert@malaney.net" <robert@malaney.net>

Date: 6/5/20 1:59 pm

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Thanks Mr Peikari - I look forward to your answers. Please be aware the deadline is now only about 3 weeks away. Much appreciated. Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: 5/16/20 10:22 am

To: "Robert" <robert@malaney.net>

Dear Dr. Malaney,

I just received a blank email from you. Just to let you know, I have been reviewing everything to answer your questions properly.

I will try to have answers for all of your questions by early next week.

From what I gathered, as long as you submit the After Final amendment within 3 months of the mail date of the Final Rejection, you will avoid a fee.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

+1 (571) 272-4185

From: Robert <robert@malaney.net>

Sent: Friday, May 15, 2020 8:15 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Mon, May 11, 2020 3:06 pm

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

PS I can find nothing on USPTO regarding fees associated with after final amendments just that they must be compliant. I did notice the <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20-scheme>. Is this a better way to proceed?

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Mon, May 11, 2020 2:47 pm

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Dear Mr Peikari; - thank you very much for your response. In order to expedite prosecution and avoid further delays and costs, it would be much appreciated if you could respond the three questions/clarifications below regarding this pro se application.

Q1) Is it ok to replace fig 1 with a new schematic drawing of a generic mobile device? (as current image used in fig 1 is not being reproduced properly by USPTO fax).

Q2) All other drawings have been previously accepted by USPTO as clear, so I am assuming the rest are ok? If there is anything else specific, please let me know by pointing to the issue in the specific drawing.

Q3) Re Claims Interpretation: If understand correctly you are stating claim 43 (and dependent claims 44-48) are not rejected under this section? However, although claim 49 (and dependent claims 50-54) are currently rejected, you state remaining objections raised can be overcome by use of new claim language outlined by you (page 20, Response to Arguments, of your report)?

Please note I plan the other following corrections:

Drawings: 37 CFR 1.84(p)(5) objection will be responded to by proper formatting of amendments to specification .37 CFR 1.173(b)(3) -- all drawings will be labelled "Amended" and entire sheet marked "Replacement Sheet"

Specification: I will follow advice on formatting so that previous amendment Dec 30, 2019 be acceptable:

Claim Support: An explanation of the type given in support of claim 37 in amendment Dec 30, 2019 (incorrectly marked claim 1) will be given for the remaining claims.

Double patenting: A terminal disclaimer will be filed.

Best regards, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Mon, May 04, 2020 10:10 am

To: Robert <robert@malaney.net>

Dear Dr. Malaney,

I do not believe that there is any way to avoid a fee entirely.

Based on what you are proposing, I would recommend that you file an After Final amendment. That fee should be less than if you file a fee for a Request for Continued Examination (RCE).

If your After Final amendment is proper and complete, then there may be no need to file an RCE. This works on a case-by-case basis, depending on the facts of the case and the content of the proposed amendment, so I cannot be sure until I have had time to review your amendment.

But I think that your best move at this time would be to file an After Final amendment as soon as it is ready.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>
Sent: Monday, April 27, 2020 12:36 AM
To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>
Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari;

Thank you for your recent examiner report on application 15/376,627. I propose to adopt all your suggestions to overcome remaining objections, including providing new drawings, corrected formalities regarding changes to the specification and filing a terminal disclaimer. Presuming all done to your satisfaction, can all these changes be accepted as an amendment and with no further fee for going examination?

Regards, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]
From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>
Date: Thu, March 26, 2020 8:32 am
To: Robert <robert@malaney.net>
Dear Dr. Malaney,

I regret that I was unable to answer your emails prior to your deadline. I was on extended travel during the month of December, which ended up going awry due to a measles outbreak in Samoa, and ended up rerouting to Sydney, where I stayed in Darling Harbor for an extra week. Very close to your university, as I later realized. By the time I was back in the USA and back to work, your deadline had passed.

However, I am working on your application today and will endeavor to provide as much guidance as possible in the next Office action.

Best Regards,
B. James Peikari

Primary Examiner, Art Unit 3992
United States Patent and Trademark Office

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From: Robert <robert@malaney.net>
Sent: Monday, December 30, 2019 5:18 PM
To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>
Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari,

Re 15,376, 627

I never heard back from you before the deadline of today. I am assuming you were just too busy. Please find attached the doc file of the formal response just submitted to the USPTO, should you need this in order to expedite prosecution. Some minor changes are in this from my previous version sent to you, including the cancellation of additional claims. Please do not hesitate to contact me by email should any questions or issues remain.

Regards, Robert Malaney

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]
From: "Robert" <robert@malaney.net>
Date: Sun, December 29, 2019 12:19 pm
To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Dear Mr Peikari,

Re 15,376, 627

please find attached the final documentation (pdf and word format) I will be submitting for the formal response. Hopefully the original files (rather than the faxed copy) will assist you if any amendments are suggested by you and can be returned to me by email. If by quick informal review you see anything that is amiss in this response I would greatly appreciate if you point it out to me prior to the deadline of 30th Dec so as to expedite this application.

Regards, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Fri, December 27, 2019 2:26 pm

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Dear Mr Peikari;

Re 15,376, 627

As I prepare the formal response letter I note your comments in your report on the figures. Please find attached the original figures as sent to the patent office in 2004, but where I have increased the size of the font in the figure labels. I believe the issue with the production quality in figures you first looked at may lie the production office at the USPTO (or by the low resolution of the USPTO fax). Can you please advise if these figures will now be acceptable to you in light of the now adjusted claims (see end of my informal report attached)? If not can you please advise how the figures need adjusted exactly. I am hoping you can do this before I formally respond so as to expedite this process.

Many thanks again for your time spent on this application attached - it is much appreciated.

Regards, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Sun, November 17, 2019 10:02 am

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Dear Mr Peikari - thank you for your call last week. Please find attached an informal response to the current non-final rejection (pdf and doc format for your convenience). I would greatly appreciate your informal advice on this. I have focused largely on the method claims as the other claims can be set once I have your feedback. Thanking you in advance for your time on this -it is greatly appreciated.

Regards, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Sat, November 02, 2019 6:28 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

I have confirmed Thursday, November 7, 2019 at 3:30 pm EST for your interview in this case.

Also participating will be Alexander Kosowski (Supervisor) and Michelle Tarae (Primary Examiner/Reissue Specialist), both of whom joined us in our previous interview, since they are familiar with the application.

Please send your agenda as soon as possible. I would like to have some answers/advice prepared for you ahead of time, since we may have to cover a lot of topics in a short amount of time.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>
Sent: Tuesday, October 29, 2019 11:48 PM
To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>
Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari - Nov 1, Nov 7 or Nov 8 are convenient for me. Regards, Robert

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]
From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>
Date: Wed, October 30, 2019 2:29 pm
To: Robert <robert@malaney.net>
Dear Dr Malaney,

I have been off work today (October 29) and I will be off work tomorrow (October 30), except to check and reply to emails. I will be back at work on Thursday and Friday. Next week I will be in training Monday through Wednesday, and again available on Thursday and Friday.

If any of the days Oct 31, Nov 1, Nov 7 or Nov 8 are convenient for you, let me know and I will set up another reissue interview.

Best Regards,
B. James Peikari
Primary Examiner, Art Unit 3992
United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Tuesday, October 29, 2019 6:14 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari -I have not heard back from you on the proposed date/time Wed October 30th 3pm (EST) . Please advise. The agenda will be to cover all the issues you have raised in your most recent report.

Thanks, Robert Malaney.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Thu, October 24, 2019 8:33 am

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Thanks Mr Peikari- Wed October 30th 3pm (EST) would be ideal for me. Once the time is confirmed I will send you the requested agenda well before the time-slot.

Regards, Robert

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Wed, October 23, 2019 6:42 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

The interview agenda is important inasmuch as it is required before an interview. Beyond that, there is not much to it. You could simply list all of the topics that you wish to address during the time allotted for the interview. This could be in order that the issues appear in the Office action, in the order of importance to you, or in no particular order at all. Preliminary/informal responses to the office action would be helpful. It is important to note, however, that anything you send would become part of the permanent file record as an attachment to the Interview Summary Form.

Please suggest an interview day and time from October 28-30 and I will try to set that up today.

One thing that I would like to make available to you is the Inventor Assistance Center. They may be able to provide some additional help to you. Their toll free number is : 800-786-9199

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Sunday, October 20, 2019 10:06 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari - I did not realise that an agenda outline in advance from me was a formal requirement for an interview with the USPTO. Given I am not sure about the importance and form of this written agenda, and given the late notice for this requirement, I am afraid I will not have time to put this together before I leave for the airport (in a few hours). As such, please postpone the interview until October 28 onward (any time after 2pm EST). Apologies for any inconvenience caused.

Can you please advise the format and rules (if any) regarding this agenda? E.g, should the listing necessarily be in the order to be discussed, and must all topics to be discussed necessarily be in the agenda? Should I also provide some preliminary/informal responses to your new objections (as I currently understand them) raised in the last report?

Regards, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Sun, October 20, 2019 2:17 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

Any interview with the USPTO requires an interview agenda to be sent in advance of the interview. Please send an agenda with all of the topics that you would like to cover, as soon as possible. You could send it by email (understanding our policy on email communications) or fax it to me at

FAX NUMBER: +1 (571) 273-4185.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Saturday, October 19, 2019 12:24 AM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Thanks Mr Peikairi, I confirm I will call you 3.30pm EST on Tuesday Oct 22. I will call the 4185 number below. Thanks, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Sat, October 19, 2019 8:47 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

Today I received a confirmation from two colleagues, whom you spoke with during our previous interview. They are both available for an interview on October 22 and 3:30 pm EST (12:30pm in Los Angeles). If I need to cancel that interview time, please advise.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Friday, October 18, 2019 5:29 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Hi Mr Peikari;

I have not heard back from you on a possible call Tuesday 22 October, and given now I will be airborne when you are back at work Monday I will now plan to have a call with you anytime Oct 28 onward. Please arrange the call in your late afternoon (2pm onward) as that will be 6am onward in Sydney, Australia. Please advise a time and date Oct 28 onward that is suitable for you.

Regards, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Thu, October 17, 2019 11:17 am

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Hi Mr Peikari; I will am travelling to LA - arriving LAX early on Oct 22- so we could arrange a call anytime after 11am (PST) if that makes things easier for you and your colleagues. Otherwise given your schedule we can arrange for the following week. Please advise.

Regards, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Thu, October 17, 2019 10:52 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

Thank you for passing along your schedule. Do you think it would be possible to meet on Oct 22, or will you be en route during that time? The reason I ask is that if you are already in the USA and closer to the Eastern Standard time zone, it will be easier for me to find a time that would work for two other colleagues to join the reissue conference.

As for my schedule, I will also be on travel Oct 23 – 26.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Wednesday, October 16, 2019 4:10 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari, as time is moving on it looks like I will need to alter my preferred time for our call as I will be on conference travel Oct 22nd through Oct 26 to the US. As such, can you please ensure our call is not scheduled in that week. Apologies for any inconvenience this may cause.

thanks, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Robert" <robert@malaney.net>

Date: Wed, October 16, 2019 6:37 am

To: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Dear Mr Peikari - Can you please arrange a telephone interview with me regarding your new Office action. Thanks, Robert.

----- Original Message -----

Subject: RE: [FWD: RE: Proposed Examiner's Amendment]

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Fri, October 04, 2019 10:59 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

I will be on leave and then in training for the next several days, but I should be able to start to make arrangements late next week for an interview the following week. Thank you for your patience.

Best Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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able to start making the arrangements when I return late next week.

From: Robert <robert@malaney.net>

Sent: Thursday, October 3, 2019 7:23 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: [FWD: RE: Proposed Examiner's Amendment]

Dear Mr Peikari - Can you please arrange a telephone interview with me regarding your new Office action.

Please arrange a time late in your day due to the time difference with Australia. Any day but your Tuesday will work for me. Please advise a number and time to call.

Regards, Robert Malaney

----- Original Message -----

Subject: RE: Proposed Examiner's Amendment

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Sun, September 22, 2019 4:15 am

To: Robert <robert@malaney.net>

Dear Dr Malaney,

I will not be able to prepare a notice of allowance at this time. In preparing the Office action, I noticed some further issues which must be addressed. I do apologize for any confusion with earlier communications.

I will issue an Office action in due course. The action will be made non-final, to give you further opportunity to respond.

Where applicable, I will include clear instructions on how to resolve the outstanding issues. I will be available to answer any questions that you might have and provide whatever help I can.

Sincere Regards,

B. James Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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From: Robert <robert@malaney.net>

Sent: Thursday, September 19, 2019 6:44 PM

To: Peikari, Behzad James <Behzad-James.Peikari@USPTO.GOV>

Subject: RE: Proposed Examiner's Amendment

Dear Mr Peikari;

Yes, you have my permission to cancel claims 38, 44 and 50 by an Examiner's Amendment.

Thank you very much for the time spent on my application.

Regards, Robert Malaney.

----- Original Message -----

Subject: Proposed Examiner's Amendment

From: "Peikari, Behzad James" <Behzad-James.Peikari@USPTO.GOV>

Date: Thu, September 19, 2019 11:12 pm

To: Robert <robert@malaney.net>

Dear Dr Malaney,

I have reviewed your amended papers filed August 16, 2019 in Application No. 15/376,627.

With the entry of the amendment, it appears that claims 38, 44 and 50 are now redundant claims and would be objected to on that basis.

Otherwise, the application is in condition for allowance.

Do I have your consent to cancel claims 38, 44 and 50 by an Examiner's Amendment?

If your answer is yes, then I will prepare a Notice of Allowance with an attached Examiner's Amendment canceling those claims.

If your answer is no, or if I do not receive an answer from you within three business days, then I will prepare an Office action under Ex Parte Quayle, with an objection to claims 38, 44 and 50, further noting that the application is otherwise in condition for allowance.

No other action on your part is required at this time. Please do not hesitate to contact me with any questions you may have about this matter.

Regards,

B. Peikari

Primary Examiner, Art Unit 3992

United States Patent and Trademark Office

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NOTICE OF ALLOWANCE AND FEE(S) DUE

132250 7590 07/15/2020
Robert Malaney
16 Carlyle Rd
East Lindfield, NSW, 2070
AUSTRALIA

EXAMINER

PEIKARI, BEHZAD

ART UNIT

PAPER NUMBER

3992

DATE MAILED: 07/15/2020

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064

TITLE OF INVENTION: REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$500	\$0.00	\$0.00	\$500	10/15/2020

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 1/2 the amount of undiscounted fees, and micro entity fees are 1/2 the amount of small entity fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Maintenance fees are due in utility patents issuing on applications filed on or after Dec. 12, 1980. It is patentee's responsibility to ensure timely payment of maintenance fees when due. More information is available at www.uspto.gov/PatentMaintenanceFees.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via EFS-Web.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

By fax, send to: (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

132250 7590 07/15/2020

Robert Malaney
16 Carlyle Rd
East Lindfield, NSW, 2070
AUSTRALIA

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via EFS-Web or by facsimile to (571) 273-2885, on the date below.

(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064

TITLE OF INVENTION: REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$500	\$0.00	\$0.00	\$500	10/15/2020

EXAMINER	ART UNIT	CLASS-SUBCLASS
PEIKARI, BEHZAD	3992	342-357150

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-09 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. Fees submitted: ☐ Issue Fee ☐ Publication Fee (if required) ☐ Advance Order - # of Copies _____

4b. Method of Payment: (Please first reapply any previously paid fee shown above)

☐ Electronic Payment via EFS-Web ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. Change in Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29

☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	12/12/2016	Robert Anderson Malaney		2064
132250	7590	07/15/2020	EXAMINER	
Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA			PEIKARI, BEHZAD	
			ART UNIT	PAPER NUMBER
			3992	

DATE MAILED: 07/15/2020

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.** Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Notice of Allowability	Application No. 15/376,627	Applicant(s) Malaney, Robert Anderson	
	Examiner BEHZAD PEIKARI	Art Unit 3992	AIA (FITF) Status No

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 30 June, 2020.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
3. ☒ The allowed claim(s) is/are See Continuation Sheet. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov**.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
Certified copies:
a) ☒ All b) ☐ Some *c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 11/661,707.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892) 2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date ____. 3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material ____. 4. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____.	5. ☒ Examiner's Amendment/Comment 6. ☒ Examiner's Statement of Reasons for Allowance 7. ☒ Other <u>Email Correspondence / Drawings</u> .
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/B. JAMES PEIKARI/ Primary Examiner, Art Unit 3992	
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Continuation of 3. The allowed claim(s) is/are: 37,41-43,47-49 and 53-54

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in an interview with Dr. Robert Malaney on July 10, 2020:

- The drawings submitted June 30, 2020 have not scanned properly.

The drawings will be replaced with the drawings attached to this Office action.

- The amendment to the "Cross-Reference to Related Application" section at the beginning of the specification submitted June 30, 2020 has not been properly formatted (underlined).

Instead, the following language will be inserted at the beginning of the specification:

"Notice: More than one reissue application has been filed for the reissue of U.S. Patent No. 8,022,870. The present reissue Application No. 15/376,627 is a continuation of reissue Application No. 14/031,992, which issued as U.S. Patent No. RE46237, both of which are reissues of U.S. Patent No. 8,022,870."

- The claims will be amended as follows:

37. (New, Amended) A method of acquiring a position on a mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said method comprising:

determining when said embedded GPS module should be powered on, said embedded GPS module then being powered on,

said when said embedded GPS module should be powered on being dependent on at least one of a current radio position and a position error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

43. (New, Amended) A mobile wireless communication device for a wireless communications network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said mobile wireless communication device comprising:

an embedded GPS module providing a GPS capability for said mobile wireless communication device; and means for

determining when said embedded GPS module should be powered on. said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and a position error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

49. (New, Amended) A computer program product for a mobile wireless communication device for a wireless communication network, said mobile wireless communication device possessing wireless communications capability for said wireless communications network and an embedded GPS module for GPS capability, said GPS referring to GPS-based techniques, said computer program product embodied on computer readable storage medium, said computer program product for acquiring a GPS position on said mobile wireless communication device, comprising:

a first portion designed to interface with the GPS capability of said mobile wireless communication device; and a second portion designed to determine when said embedded GPS module should be powered on,

said embedded GPS module then being powered on,

said determining when said embedded GPS module should be powered on being dependent on at least one of a current radio position and a position error of said mobile device determined from the wireless communications network, said wireless communications network being different from said GPS.

EXAMINER'S COMMENT

This Office Action addresses U.S. Application No. 15/376,627, which is a continuation of reissue Application No. 14/031,992, which issued as U.S. Patent No. RE46237, which is a reissue of U.S. Application No. 11/661,707, which issued as U.S. Patent No. 8,022,870.

The status of the claims is as follows:

Claims 37, 41-43, 47-49, 53 and 54 are allowed.

All of the issues noted in the final Office action mailed April 1, 2020 have been overcome.

Applicant has provided proper support and explanations in the disclosure for each of the new claim limitations.

Applicant has filed a terminal disclaimer which has been accepted and has overcome the double patenting rejection.

The claims have been amended in a manner that overcomes the rejections based on claim interpretation.

The drawings have been corrected. A cleaner copy of the drawings is attached to this office action.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

All of the outstanding objections have been overcome by the amendment filed June 30, 2020 and the examiner's amendments herein.

With regard to the prior art, none of the references made of record are deemed to teach or suggest, either alone or in combination, each and all of the features of the present claims.

As stated in the Final Office action mailed April 1, 2020:

"The previous rejections of the claims as being unpatentable under 35 U.S.C. §103, based on prior art, are withdrawn due to the remarks submitted with the amendment of December 30, 2019. Applicant's arguments regarding the Pande, U.S. Patent No. 6,703,971, reference are deemed convincing."

Briefly stated, Pande does not explicitly teach the use of a position determined from the wireless communications network, wherein the wireless communications network is different from the GPS. In the Pande system, all positions are derived from the GPS.

Pande states, "wireless location technology of the present invention uses GPS technology". Pande also refers to "wireless communication services" and "Wireless aided GPS".

These teachings in Pande refer to a GPS-only solution which would have been well known to one having ordinary skill in the art of wireless location technologies. In

the GPS technology, location of a mobile device is aided by GPS information - received by a base station (part of the wireless network) - and communicated by the base station to the mobile device over the wireless network. This GPS information contains frequency settings and positions of the GPS satellites currently in view. This technique, well known to those skilled in the art, is used to speed up the mobile devices acquisition of GPS signals, and is deployed in almost all current smartphones. The GPS information sent by the base station does not contain any information on the position of the mobile device as determined by the wireless network.

Pande makes clear that the information sent by base station to the mobile device contains only information on the GPS system, i.e., information used to aid the mobile device acquiring a GPS location. As stated above, the teachings in Pande do not include the use of a position determined from the wireless communications network and thus would not teach the invention as now claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. James Peikari whose telephone number is (571) 272-4185. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski, SPE Art Unit 3992, can be reached at (571) 272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. James Peikari/
Primary Examiner
Art Unit 3992

Conferees:

/C.M.T/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art
Unit 3992

<i>Search Notes</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
G01S 19/34	8/9/2017	mcg
G01S 19/34; G01S 19/42	09/23/2019	BJP

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
342	357.74	09/23/2019	BJP

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
See attached EAST Search History	8/9/2017	mcg
WEST Search Enclosed / inventor name search	09/23/2019	BJP
G01S 19/34; G01S 19/42 - limited by text search	09/23/2019	BJP
342/357.74 - limited by text search	09/23/2019	BJP
Interference search by text search of claim language	09/23/2019	BJP
Google update search performed	03/25/2020	BJP
Google update search performed	07/14/2020	BJP

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<i>Search Notes</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
342	357.74	09/23/2019	BJP

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Issue Classification 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CPC						
Symbol					Type	Version
G01S	/	19	/	34	F	2013-01-01
G01S	/	19	/	42	A	2013-01-01

CPC Combination Sets						
Symbol				Type	Set	Ranking
	/		/			

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	9	
/B. James Peikari/	14 July 2020	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	37	6

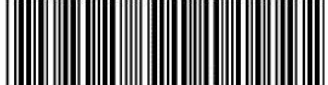
Issue Classification 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

INTERNATIONAL CLASSIFICATION			
CLAIMED			
G01S		19	34
NON-CLAIMED			

US ORIGINAL CLASSIFICATION	
CLASS	SUBCLASS
342	357.74

CROSS REFERENCES(S)						
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)					

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	9	
/B. James Peikari/	14 July 2020	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	37	6

Issue Classification 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

☐ Claims renumbered in the same order as presented by applicant
 ☐ CPA
 ☒ T.D.
 ☐ R.1.47

CLAIMS															
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
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	2		11		20		29		38	41	47				
	3		12		21		30		39	42	48				
	4		13		22		31		40	43	49				
	5		14		23		32	38	41		50				
	6		15		24		33	39	42		51				
	7		16		25		34	40	43		52				
	8		17		26		35		44	44	53				
	9		18		27		36		45	45	54				

NONE (Assistant Examiner) (Date)		Total Claims Allowed: 9	
/B. James Peikari/ (Primary Examiner) (Date)		O.G. Print Claim(s) 37	O.G. Print Figure 6

<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS									
☒ Claims renumbered in the same order as presented by applicant ☐ CPA ☒ T.D. ☐ R.1.47									
CLAIM		DATE							
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	41	✓	✓	=					
	42	✓	✓	=					

<i>Index of Claims</i> 	Application/Control No. 15/376,627	Applicant(s)/Patent Under Reexamination Malaney, Robert Anderson
	Examiner BEHZAD PEIKARI	Art Unit 3992

CLAIM		DATE							
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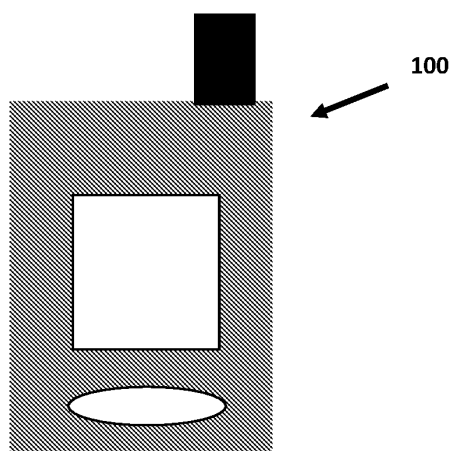


FIG. 1 (Amended)

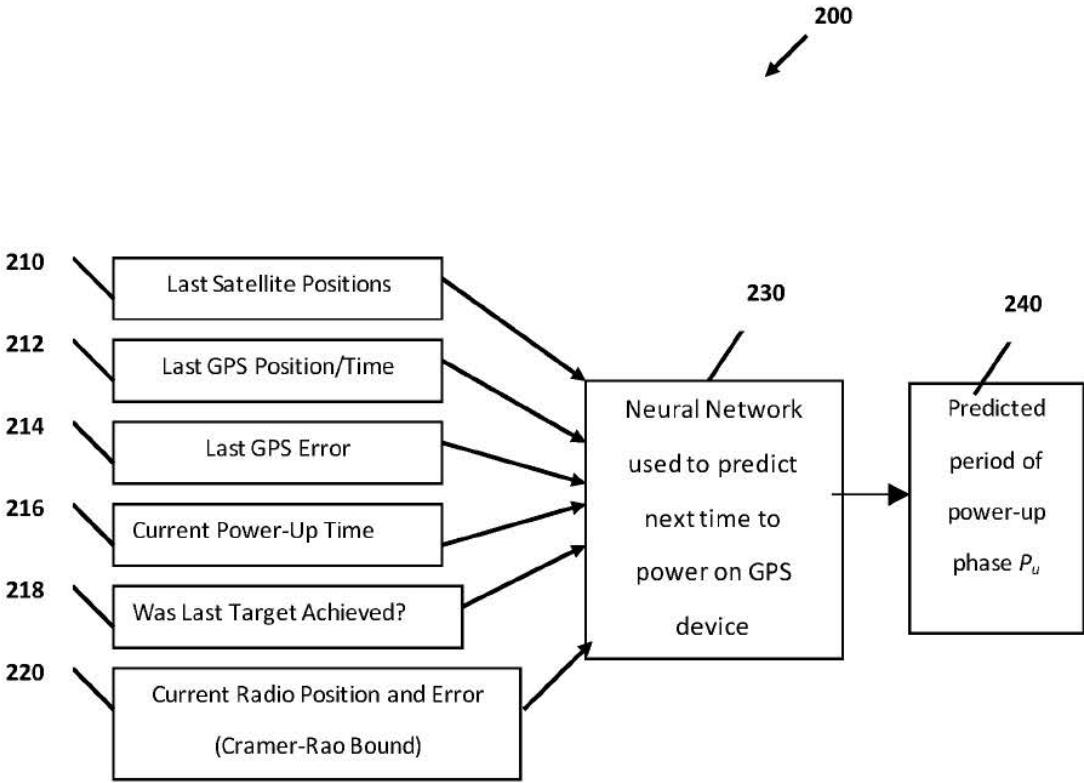


FIG. 2 (Amended)

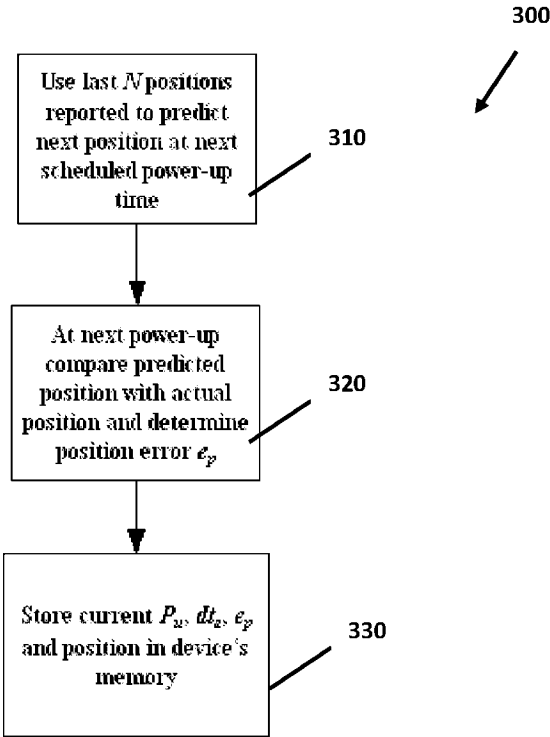


FIG. 3 (Amended)

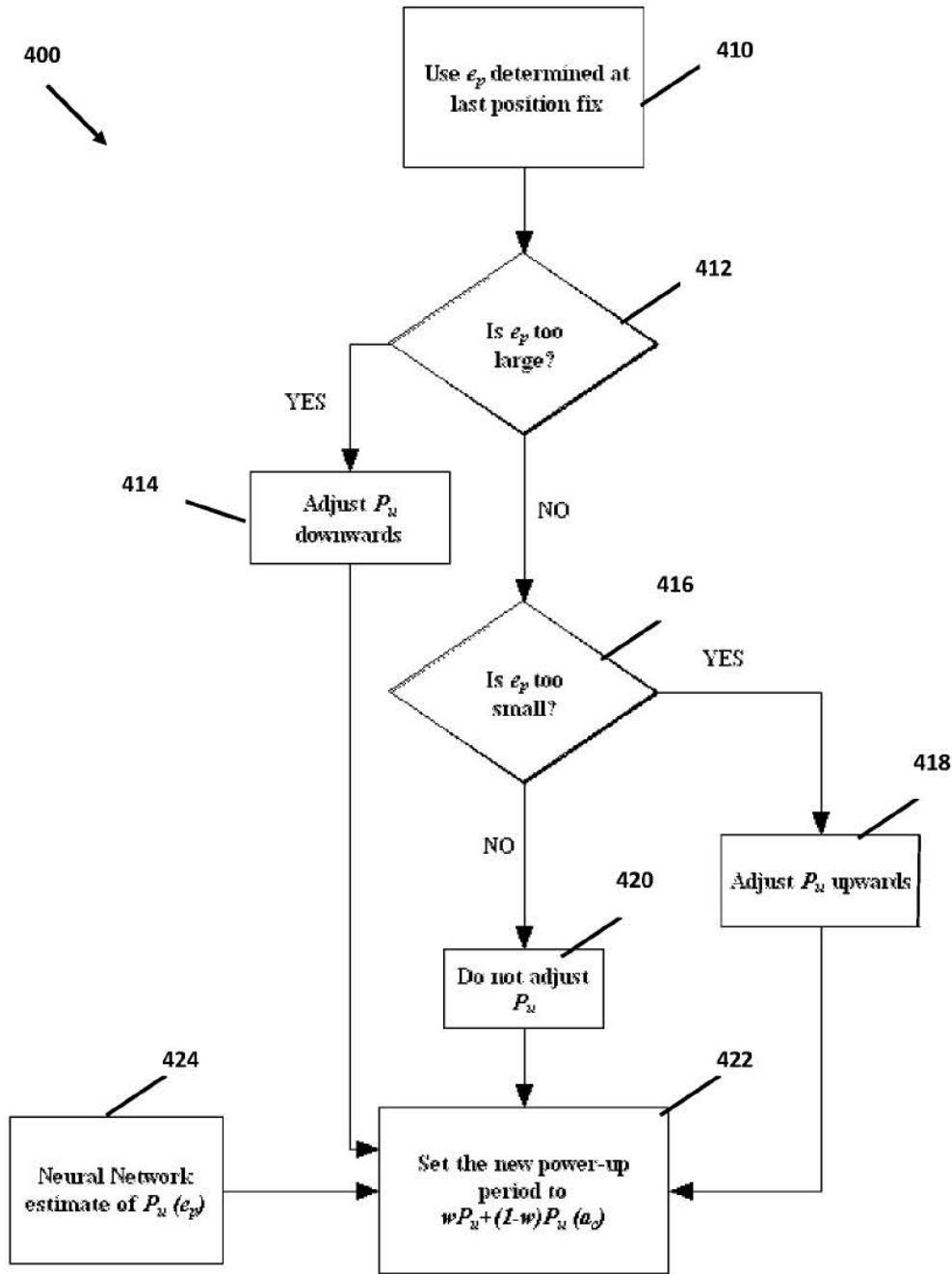


FIG. 4 (Amended)

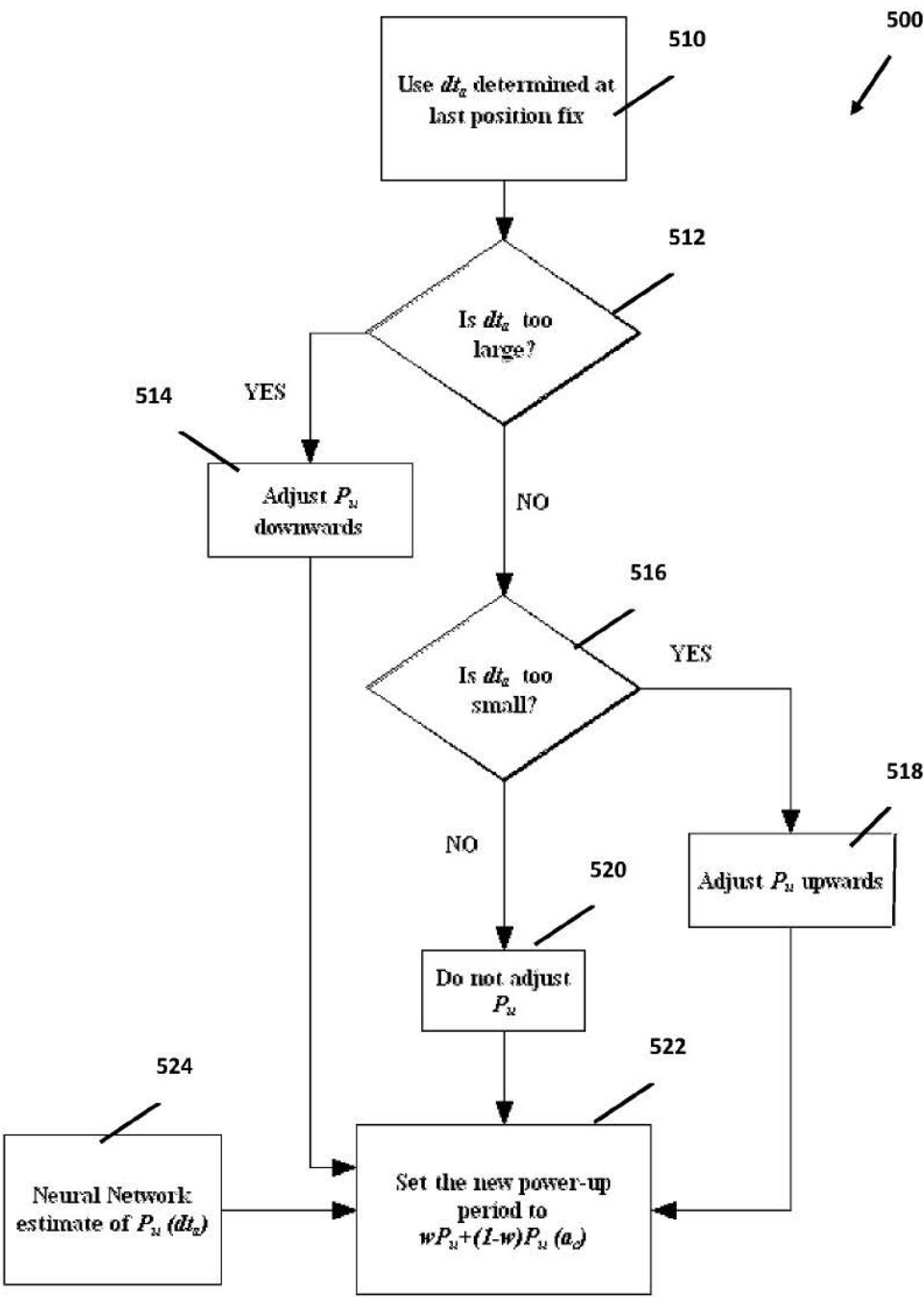


FIG. 5 (Amended)

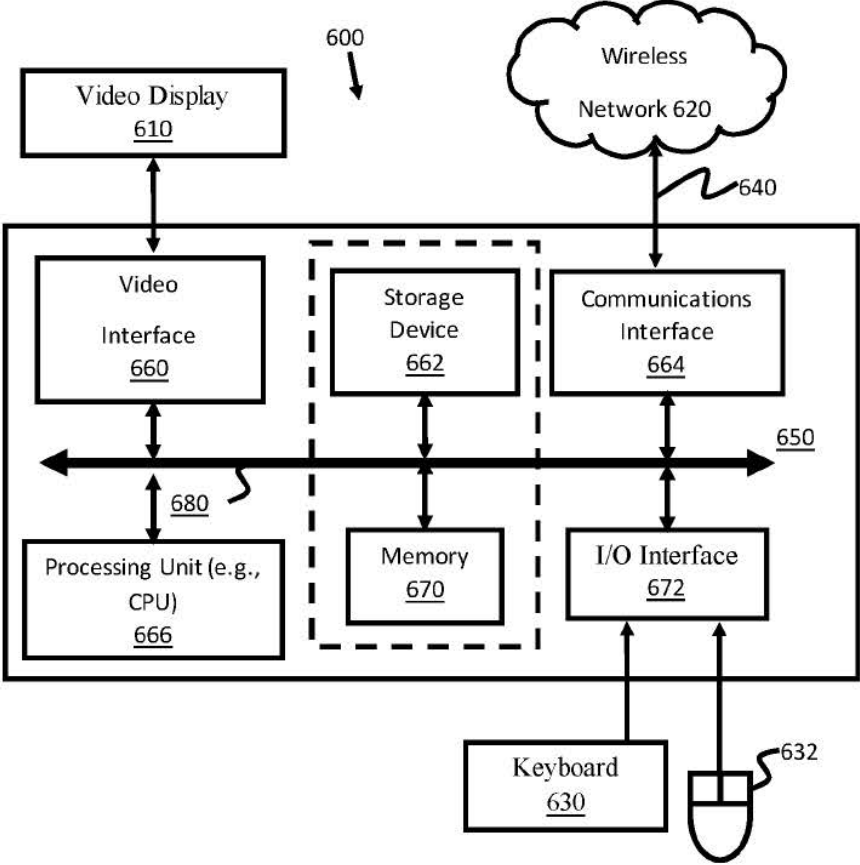


FIG. 6 (Amended)



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United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

BIB DATA SHEET

CONFIRMATION NO. 2064

SERIAL NUMBER 15/376,627	FILING or 371(c) DATE 12/12/2016 RULE	CLASS 342	GROUP ART UNIT 3992	ATTORNEY DOCKET NO.		
APPLICANTS INVENTORS Robert Anderson Malaney, East Lindfield, AUSTRALIA; ** CONTINUING DATA ***** This application is a REI of 14/031,992 09/19/2013 PAT RE46237 which is a REI of 11/661,707 02/11/2008 PAT 8022870 which is a 371 of PCT/AU2005/001351 08/31/2005 ** FOREIGN APPLICATIONS ***** AUSTRALIA 2004905024 09/02/2004 ** IF REQUIRED, FOREIGN FILING LICENSE GRANTED *** SMALL ENTITY ** 12/21/2016						
Foreign Priority claimed ☒ Yes ☐ No 35 USC 119(a-d) conditions met ☒ Yes ☐ No Verified and Acknowledged <u>/B. James Peikari/</u> Examiner's Signature		☐ Met after Allowance Initials	STATE OR COUNTRY AUSTRALIA	SHEETS DRAWINGS 6	TOTAL CLAIMS 18	INDEPENDENT CLAIMS 3
ADDRESS Robert Malaney 16 Carlyle Rd East Lindfield, NSW, 2070 AUSTRALIA						
TITLE REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES						
FILING FEE RECEIVED 1590	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:			☐ All Fees ☐ 1.16 Fees (Filing) ☐ 1.17 Fees (Processing Ext. of time) ☐ 1.18 Fees (Issue) ☐ Other _____ ☐ Credit		

UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Terminal Disclaimer Review Form

Application No.

15/376,627

Art Unit:

3992

Examiner:

Peikari

Original Patent Number of
Patent to be Reissued is: 8022870

The Maintenance fee status is:

- ☒ up to date.
☐ not up to date.
(Consult with SPRS)

Is there a terminal disclaimer filed and accepted during the prosecution of (i) the current reissue application, (ii) the underlying patent, and/or (iii) reexamination proceeding(s) of the underlying patent?

- ☐ NO
☒ YES (Complete the rest of the form)

This reissue patent is subject to Terminal Disclaimer(s) that was/were:

- ☒ filed and accepted (DISQ or DISQ.E.FILE) during the prosecution of the current reissue application.
(Enter terminal disclaimer(s) filing date(s) below).

1. 06/30/2020

2. _____

3. _____

The underlying patent of the current reissue application is subject to Terminal Disclaimer(s) that was/were:

- ☐ accepted (DISQ or DISQ.E.FILE) and of record in the prosecution of the underlying patent and/or reexamination proceeding(s) of the underlying patent. (Enter application/control no(s) and terminal disclaimer(s) filing date(s) below).

1. _____

2. _____

3. _____

(Examiner's note: Assign Doc Code "REIS.REVFORM" to this form.)

U.S. Patent and Trademark Office

Last revised: 12/2016



United States Patent and Trademark Office

Office of the Chief Financial Officer

Document Code:WFEE

User :C44696

Sale Accounting Date:07/28/2020

Sale Item Reference Number
15376627

Effective Date
07/28/2020

Document Number	Fee Code	Fee Code Description	Amount Paid	Payment Method
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Recipient Information

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ISSUE FEE 15/376,627



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From: Robert Malaney, Phone #61294161983 Tue Jul 28 08:34 2020

3 of 3

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via EFS-Web.

By mail, send to: Mail Stop ISSUE FEE
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Alexandria, Virginia 22313-1450

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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

132350 2590 07/15/2020
Robert Malaney
16 Carlyle Rd
East Lindfield, NSW, 2070
AUSTRALIA



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Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via EFS-Web or by facsimile to (571) 273-2885, on the date below.

(Type or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15-376,627	12/12/2016	Robert Anderson Malaney		2064

TITLE OF INVENTION: REDUCED POWER USE IN MOBILE GPS-BASED TECHNOLOGIES

APPL. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$500	\$0.00	\$0.00	\$500	10/15/2020

EXAMINER	ART UNIT	CLASS-SUBCLASS
PEIKARI, BEHZAD	3992	342-357130

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.563).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB 133) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB 47, Rev. 03-09 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) The names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recording, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

ROBERT ANDERSON MALANEY

EAST LINDFIELD, NSW
AUSTRALIAPlease check the appropriate assignee category or categories (will not be printed on the patent): ☒ Individual ☐ Corporation or other private group entity ☐ Government4a. Fees submitted: ☐ Issue Fee ☐ Publication Fee (if required) ☐ Advance Order - # of Copies _____

4b. Method of Payment: (Please first reuplay any previously paid fee shown above)

- ☐ Electronic Payment via EFS-Web ☐ Enclosed check ☒ Non-electronic payment by credit card (Attach form PTO-2033)
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. Change in Entry Status (from status indicated above)

- ☐ Applicant certifying micro entity status. See 37 CFR 1.29
☐ Applicant asserting small entity status. See 37 CFR 1.27
☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB 15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature Robert A MalaneyDate 07/28/2020Typed or printed name ROBERT A MALANEY

Registration No. _____

PTOL-85 Part B (05-18) Approved for use through 01/31/2020

Page 2 of 3
OMB 0651-0033

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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/376,627	09/15/2020	RE48206		2064

132250 7590 08/26/2020
Robert Malaney
16 Carlyle Rd
East Lindfield, NSW, 2070
AUSTRALIA

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Robert Anderson Malaney, East Lindfield, AUSTRALIA;

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage and facilitate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit SelectUSA.gov.

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

EPAS ID: PAT6378956

SUBMISSION TYPE:	NEW ASSIGNMENT	
NATURE OF CONVEYANCE:	ASSIGNMENT	
SEQUENCE:	1	
CONVEYING PARTY DATA		
	Name	Execution Date
	ROBERT A MALANEY	10/31/2020
RECEIVING PARTY DATA		
Name:	NARISTE NETWORKS PTY LTD	
Street Address:	16 CARLYLE RD	
City:	EAST LINDFIELD	
State/Country:	AUSTRALIA	
Postal Code:	2070	
PROPERTY NUMBERS Total: 1		
Property Type	Number	
Patent Number:	RE48206	
CORRESPONDENCE DATA		
Fax Number:		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>		
Email:	robert@nariste.com	
Correspondent Name:	ROBERT ANDERSON MALANEY	
Address Line 1:	16 CARLYLE RD	
Address Line 4:	EAST LINDFIELD, AUSTRALIA 2070	
NAME OF SUBMITTER:	ROBERT A. MALANEY	
SIGNATURE:	/Robert A. Malaney/	
DATE SIGNED:	10/31/2020	
	This document serves as an Oath/Declaration (37 CFR 1.63).	
Total Attachments: 2		
source=deed RM to Narsite 2020#page1.tif		
source=deed RM to Narsite 2020#page2.tif		

DEED

DEED made 31 October 2020.

BETWEEN: ROBERT ANDERSON MALANEY of 16 Carlyle Road, Lindfield, New South Wales (the "Assignor")

AND: NARISTE NETWORKS PTY LIMITED (ACN 117 199 363) of 16 Carlyle Road, Lindfield, New South Wales (the "Assignee")

RECITALS:

- A. By patent application US 15/376,627 ("the application") the Assignor has applied for and received a patent in the United States of America for an invention entitled "Reduced Power Use in Mobile GPS-Based Technologies," US RE48,206 ("the invention").
- B. The Assignor has agreed to assign to the Assignee all his right, title and interest in and to the application and the invention, including the right to apply for and obtain patents in any country for the invention.

THIS DEED WITNESSES AS FOLLOWS:

1. In consideration of the payment of the sum of \$10.00 by the Assignee to the Assignor, the Assignor hereby assigns to the Assignee all his right, title and interest in and to the application and the invention, including the right to apply for and obtain patents in any country for the invention. The Assignor also assigns the same right, title and interest to the Assignee to the related patents US 8,022,870 and US RE46,327.
2. The Assignor agrees, at the expense of the Assignee, to do all such further acts and execute all such further documents as may be necessary to transfer to the Assignee the application and any patent that may be granted as a result of the application and invention.
3. For the avoidance of doubt, it is agreed that all fees, costs and expenses incurred by the Assignor (whether before or after the date of this Deed) in connection with enabling the Assignee to be registered as the sole owner of any patent that may be granted as a result of the application, are to be borne and paid by the Assignee or (as the case may be) reimbursed to the Assignor by the Assignee, at the request of the Assignor.

EXECUTED AS A DEED

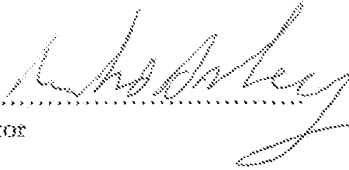
Signed, sealed and delivered by
ROBERT ANDERSON MALANEY
in the presence of

Witness: *AFRANCIS PIERRE*

Robert Anderson Malaney
Robert Anderson Malaney

Title: *NW 30 #228344*

The Common Seal of
NARISTE NETWORKS PTY LIMITED
(ACN 117 199 363)
was affixed in accordance with
its Constitution


.....
Director

