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Roy Shkedi
69-10 108th Street
Forest Hills, NY 11375

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06/02/2023

EXAMINER

CORSARO, NICK

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PAPER

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

The time period for reply, if any, is set in the attached communication.



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ARNOLD & PORTER KAYE SCHOLER, LLP
601 MASSACHUSETTS, AVE. NW
WASHINGTON, DC 20001-3743

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

REEXAMINATION CONTROL NO. 90/019,209 .

PATENT UNDER REEXAMINATION 8594698 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,209	Patent Under Reexamination 8594698	
	Examiner NICK CORSARO	Art Unit 3992	AIA (FITF) Status No
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address-- The request for <i>ex parte</i> reexamination filed <u>05/12/2023</u> has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached. Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____ 1. ☒ The request for <i>ex parte</i> reexamination is GRANTED. RESPONSE TIMES ARE SET AS FOLLOWS: For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c). For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). NO EXTENSION OF THIS TIME PERIOD IS PERMITTED. If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.			
/NICK CORSARO/ Primary Examiner, Art Unit 3992			
cc:Requester (if third party requester)			

U.S. Patent and Trademark Office
PTOL-471G (Rev. 01-13)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20230602

**ORDER GRANTING REQUEST FOR
EX PARTE REEXAMINATION**

I. Introduction

This action is an order granting *Ex Parte* reexamination of U.S. Pat. No. 8,594,698 (“**698 Patent**”) to Shkedi, titled "SIGNAL COMPARISON-BASED LOCATION DETERMINING METHOD". The 698 Patent is based upon U.S. Application No. 13/448,309, filed Apr. 16, 2012.

A substantial new question of patentability (SNQ) affecting claims 1 - 32 of the 698 Patent is raised by the prior art cited in a request for Ex Parte reexamination filed May 12, 2023 (“**Request**”).

II. Priority

A) Priority

U.S. Pat. No. 8,594,698 is based upon U.S. application 13/448,309, which is a continuation of application Ser. No. 12/720,362, filed Mar. 9, 2010, now U.S. Pat. No. 8,170,583, which is a continuation of application Ser. No. 11/533,238, filed on Sep. 19, 2006, now U.S. Pat. No. 7,706,811

B) Effective Filing Date

Based upon the above priority the Examiner finds that the 698 Patent has an effective filing date of Sep. 19, 2006.

C) Term

Based upon review of the 698 Patent and the above priority the Examiner finds that the term of the 698 Patent has not expired.

5 D) AIA Provisions

Because the 698 Patent has an effective filing date before March 13, 2013 the present proceeding is being examined under the pre-AIA first to invent provisions.

III. Papers Filed

10 The Request included, among other things, a declaration from Bruce McNair ("**May 2023 McNair Declaration**"), and an information disclosure statement identifying, among other documents, the prior art asserted as raising the SNQ ("**May 2023 IDS**").

IV. Consideration of Papers

15 All of the above identified papers, including the May 2023 McNair Declaration, and the May 2023 IDS have been reviewed, considered, and placed of record in the file.

V. Patents and Publication Cited in the Request

A) Cited References

- 20 **1. de Clerq:** Pub. No. US 2005/0094610 to de Clerq et al., published May 5, 2005, filed Nov. 1, 2004.
- 2. Sheynblat:** Pub. No. US 2006/0089153 to Sheynblat, published Apr. 27, 2006, filed Nov. 30, 2004.

3. **Copley:** Pub. No. US 2005/0068169 to Copley et al., published Mar. 31, 2005,
filed Oct. 15, 2004.

5 4. **Perez-Breva:** Pub. No. US 2005/0037776 to Perez-Breva et al., published Feb.
17, 2005, filed Aug. 23, 2004.

B) Evaluation of References

1. de Clerq, Copley, Perez-Breva: These references are all U.S. Patent Application
10 publications with publication date more than a year before the effective filing date of the 698
Patent. Accordingly, these references qualify as prior art under 35 U.S.C. § 102(b).

2. Sheynblat: This reference is a U.S. Patent Application publication with file date
before the effective filing date of the 698 Patent. Accordingly, these references qualify as prior
art under 35 U.S.C. § 102(e).

15

VI. Concurrent Proceedings

Based upon Examiner's review of the 698 Patent itself, the prosecution history, and the
file wrapper, the Examiner finds that there are no concurrent Ex Parte reexaminations,
supplemental reexaminations, reissues, or IPR proceedings involving the 698 Patent.

20

VII. Litigation

Based upon the Examiner's review of the prosecution history, the file record including the Request, with associated submissions, and a litigation search conducted by the USPTO, the Examiner finds that the 698 Patent is in litigation. (*Request p. 49*).

5

VIII. Prosecution History

A) Original Prosecution of the Base Application

1. Introduction.

The 698 Patent is based upon U.S. Application No. 13/448,309 ("**309 Application**" or
10 "**base application**"). When the base application issued, independent claims 1, 57 and 58 of the May 2013 Claims were numbered as patented claims 1, 23, and 24 of the 698 Patent.

2. Discussion of Original Prosecution.

- a) On April 16, 2012 the base application was filed with 46 claims. After a preliminary amendment claims 1 - 7, 12 15 - 16, 18 - 19, 21 - 23, 28, 30 -32, and 45 were
15 pending. Claims 1, 30, and 45 were the independent claims.
- b) On May 24, 2012 the examiner issued a non-final office action ("**May 2012 Non-Final Action**"). Claims 1 - 3, 5 - 7, 12, 15 - 16, 18 - 19, 21 - 23, 28, 30 - 32, and 45 were rejected based upon separate double patenting rejections, applying U.S. 7,706,811 and U.S. 8,170,583. Claims 1 - 3, 5 - 7, 12, 15 - 16, 18 - 19, 21 - 23, 28, 30 - 32, and 45 were rejected
20 under § 103 by Phatak (U.S. 2008/0039114) in view of Farmer (U.S. 2010/0156706). Claim 4 was rejected under § 103 by Phatak (U.S. 2008/0039114) in view of Farmer (U.S. 2010/0156706) and further in view of Bar-On et al. (US 2005/0159174).

c) On July 02, 2012 the Applicant submitted a response ("**July 2012 Response**") including claim amendments. Applicant cancelled claims 12, 18 -19, 21, 30 -32, and 45. Applicant added new claims 47 - 66 that included new independent claims 57 and 58. Accordingly, claims 1 - 7, 15 - 16, 22 - 23, 28, 47 - 66 were pending with claims 1 and 57 as the independent claims. The Amendments to claim 1 are representative and reprinted below.

1 (Currently Amended) A ~~signal comparison based~~ location determining method, operable by a first portable RF communications device ~~in conjunction with at least two fixed location service area antenna stations capable of RF communication with the device wherein the stations are substantially continuously operating~~, the method comprising the steps-of:

10 (a) the first portable RF communications device monitoring its location by (i) receiving communications signals from a first plurality of ~~local~~ fixed-location service-area antenna stations capable of RF communication with the first portable RF communications device wherein the antenna stations are substantially continuously operating, (ii) identifying at least one ID within at least one of the received communications signals, and (iii) measuring a signal characteristic associated with ~~[[the]]~~ a received communications signal ~~[[s]]~~ from each of the first plurality of antenna stations; and

15 (b) the first portable RF communications device determining if ~~[[the]]~~ a first monitored location, ~~monitored in accordance with part (a)~~, is within proximity of ~~[[to]]~~ a location chosen by a user of the first portable RF communications device, ~~as a result of [[by]] electronically comparing (i) the at least one ID at a fingerprint of the first monitored location with the at least one ID at a fingerprint of the chosen location chosen by the user; wherein the fingerprint of a given location is a group of figures identifying the location which include at least one figure which is an ID within a communication signal received at the given location and (ii) at least one number figure which is based on [[a]] the characteristic of each of [[a]] the first plurality of antenna stations signal received, at the first monitored location with at least one number based on signal characteristics of each of the first plurality of antenna stations at the location chosen by the user.~~

20 [[i]] the at least one ID at a fingerprint of the chosen location chosen by the user; wherein the fingerprint of a given location is a group of figures identifying the location which include at least one figure which is an ID within a communication signal received at the given location and (ii) at least one number figure which is based on [[a]] the characteristic of each of [[a]] the first plurality of antenna stations signal received, at the first monitored location with at least one number based on signal characteristics of each of the first plurality of antenna stations at the location chosen by the user.

25 .

In the July 2012 Remarks, Applicant generally argued that the claim had been amended to be similar to the parent application. For example, Applicant stated "*in the parent application . . . certain amendments would have put the claims into a form similar to Claim 1 here.*" "*Claim 1 as now amended is that variation.*" (July 2012 Remarks, p. 8). The Applicant generally identified the changes to claim 1 as adding "*signal characteristics*" and stated "*Signal Characteristics is intended to be distinct from ID,*" and "*the word number is used instead of the word figure.*" (Id.). Applicant noted, that prior art applied in the last office action was determining location of the mobile device by "*matching the signal strength to expected or*

calculated signal strength," "looking up locally unique base station identifiers," or by "triangulation," (July 2012 Remarks, pp. 9 - 10). Applicant asserted:

5 None of the references cited in this application (or in the parent applications) disclose comparing numbers calculated from (or equal to) signal strength (or other signal characteristics) from nearby antenna stations to corresponding numbers from antenna stations near a specific location to determine **whether or not** the device **is at the specific location**, as claimed.

- July 2012 Remarks, p. 10

10 **d)** On September 28, 2012 the Examiner issued a final rejection. The double patenting rejections were maintained. Claims 1 - 3, 5-7, 15 - 16, 22 -23, 28, and 47 -66 were rejected under § 102 by *Huomo* (U.S. 2004/0203863). Claim 4 was rejected under § 103 by *Huomo* (U.S. 2004/0203863) in view of *Bar-On et al.* (US 2005/0159174).

15 **e)** On January 28, 2013 the Applicant submitted a response after final ("**Jan. 2013 AF Response**") with the claims unamended and argued the 102 rejection. Applicant basically stated that based upon the structure of the claim the *Huomo* did not teach comparing both of "the number based upon signal characteristic" and the "at least one ID," because the number in *Huomo* is the signal ID number and not a number based upon the signal characteristic (Jan 2013 AF Response, p. 2).

 Additionally, a terminal disclaimer was submitted.

20 **f)** On February 14, 2013 the Examiner issued an Advisory Action. The examiner basically stated that the arguments concerning the rejections did not place the application in condition for allowance.

25 **g)** On February 26, 2013 the Applicant responded ("**Feb 2013 Response**"). The Feb 2013 Response included an RCE. Applicant stated that claim had been amended to clarify that "*the number based upon at least one signal characteristic is at least one number, other than the identification number.*" (Feb 2013 Remark, p. 8). Claim 1 was amended as follows:

1 (Currently Amended) A location determining method, operable by a first portable RF communications device, the method comprising the steps of:

(a) the first portable RF communications device monitoring its location by (i) receiving communications signals from a first plurality of fixed-location service-area antenna stations capable of RF communication with the first portable RF communications device wherein the antenna stations are substantially continuously operating, (ii) identifying at least one ID within at least one of the received communications signals, and (iii) measuring a signal characteristic associated with a received communications signal from each of the first plurality of antenna stations; and

(b) the first portable RF communications device determining if a first monitored location, monitored in accordance with part(a), is within proximity of a location chosen by a user of the first portable RF communications device, as a result of electronically comparing (i) the at least one ID at the first monitored location with the at least one ID at the location chosen by the user; and (ii) at least one number, other than identification number, based on the characteristic of each of the first plurality of antenna stations, at the first monitored location with at least one number, other than identification number, based on signal characteristics of each of the first plurality of antenna stations at the location chosen by the user.

h) On March 28, 2013 the Examiner issued a non final action. The double patenting rejections were dropped. Claims 1 - 3, 5-7, 15 - 16, 22 -23, 28, and 47 -66 were rejected under § 103 by Huomo (U.S. 2004/0203863) in view of Farmer (U.S. 7,706,975). Claim 4 was rejected under § 103 by Huomo (U.S. 2004/0203863) in view of in view of Farmer (U.S. 7,706,975) and further in view of Bar-On et al. (US 2005/0159174).

i) On May 06, 2013 the Office received and Applicant response ("**May 2013 Response**"). Applicant amended claim 1 as shown below.

1 (Currently Amended) A location determining method, operable by a first portable RF communications device, the method comprising the steps of:

(a) the first portable RF communications device monitoring its location by (i) receiving communications signals from a first plurality of fixed-location service-area antenna stations capable of RF communication with the first portable RF communications device wherein the antenna stations are substantially continuously operating, (ii) identifying at least one ID within at least one of the received communications signals, and (iii) measuring a varying signal characteristic other than ID, which signal characteristic is associated with a received communications signal from each of the first plurality of antenna stations; and

(b) the first portable RF communications device determining if a first monitored location, monitored in accordance with part(a), is within proximity of a location chosen by a user of the first portable RF communications device, as a result of electronically comparing (i) the at least one ID at the first monitored location with the at least one ID at the location chosen by the user; and (ii) at least one number, other than identification number, based on the varying signal characteristic of the communications signals from each of the first plurality of antenna stations, at the first monitored location with at least one number, other than identification number, based on corresponding varying signal characteristics of the communications signals from each of the first plurality of antenna stations at the location chosen by the user.

In the May 2013 Remarks, the Applicant argued:

In general, the amendments clarify that the “signal characteristics” being referenced are of a “varying” or “differing” nature. (See more specific language discussed below and in the claim amendments above.) . . .

During the interview, the Examiner agreed that a carrier frequency is a fixed signal characteristic, and thus, because he agreed that Farmer did not disclose use of any “varying” or “differing” signal characteristic, Farmer could not be used in combination with Uomo to obviate the amended claims. However, the Examiner said that he needed to review Uomo again and specifically consider ¶[0045] of Uomo.

- May 2013 Remarks, pp. 9 - 10.

j) On July 26, 2013 the Examiner issued a notice of allowance (“**July 2013 Notice of Allowance**”). In the July 2013 Notice of Allowance the Examiner made an examiner amendment to claim 58 making it substantially similar to claim 1. The examiner indicated the claims were allowable. The examiner's statement of reason for allowance over the prior art basically restated all the limitations of claim 1. See July 2013 Notice of Allowance pp. 2 - 4.

3. Conclusion of Original Prosecution

The examiner in the original prosecution supplied reasons for allowance. In the May 2013 Allowance, the reasons for allowance basically restated the entire claim 1. However, as noted above, the allowance came after the Applicant amended claim 1 in the May 06, 2013 Response. In the May 2013 Remarks, Applicant basically argued that Uomo (U.S. 2004/0203863) in view of Farmer (U.S. 7,706,975) did teach determining if the device location is in proximity of a user location based upon at least one radio station ID and a number associated with the “signal characteristics.” However, Applicant argued that Uomo in view of Farmer did not teach the “signal characteristics” are of a “varying” or “differing” signal characteristics, as required by claim 1 and the other claims.

Accordingly, the Examiner herein finds that the claims in the original prosecution were allowed because the prior art of record did not teach determining if the device is in proximity of a user specified location by comparing the radio station ID and:

- 5 comparing . . . at least one number, based on the varying signal characteristic of the communications signals from each of the first plurality of antenna stations, at the first monitored location with at least one number, based on corresponding varying signal characteristics of the communications signals from each of the first plurality of antenna stations at the location chosen by the user.

Accordingly, a review of the prosecution history does give an indication what elements of
10 the claims were not taught by the prior art of record.

IX. Requirements for an SNQ

For “a substantial new question of patentability” to be present, it is only necessary that:

(A) the prior art patents and/or printed publications raise a substantial question of
15 patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

(B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a
20 pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim.

If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request.

Additionally, it is not necessary that a "prima facie" case of unpatentability exist as to the
25 claim in order for “a substantial new question of patentability” to be present as to the claim.

Thus, “a substantial new question of patentability” as to a patent claim could be present even if

the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications.

- MPEP § 2242

5 **X. Technical Feature Evaluated for SNQ**

As noted above, during prosecution of the original application there was some indication of what features of the claims were deemed as allowable over the prior art.

For evaluation of substantial new question concerning patentability (SNQ), the Examiner herein finds that the technical feature of the claims, and reprinted below, is the technical feature
10 for which the claims were issued:

Technical Feature:

*“comparing ... at least one number, based on the varying signal characteristic of the communications signals from each of the first plurality of antenna stations, at the first monitored location with at least one number, based on corresponding varying signal characteristics of the communications signals from each of the first plurality
15 of antenna stations at the location chosen by the user...”* as in independent claim 1 of the 698 Patent, and similarly language in independent claims 23, and 24.

Accordingly if a requester provides a reference or a combination of references suggesting the technical feature recited below making the claims of the 698 Patent allowable over the prior art the reference or combination of references would raise a substantial new question of
20 patentability.

XI. Issues Asserted as Raising an SNQ

The Request, with support of the May 2023 McNair Declaration, referencing the Exhibit AA - Claim Chart, alleges that de Clerq, Perez-Breva, Sheynblat, Copley raise a substantial new

questions of patentability (SNQ's) of claims 1 - 32 of the 698 Patent. To comply with 37 CFR 1.510 the Requester provided the issues listed below.

However, the Examiner notes that the Request p. 41 alludes to 8 issues. But, the Request itself only provides a detailed explanation of Issue 1 below. For the remaining issues, the

5 Request p. 41 references the Exhibit AA - Claim Chart. The Examiner has reviewed the Claim Chart and finds that the claim chart does not explain 8 separate issues as stated in the Request. Rather, Exhibit AA - Claim Chart presents all the prior art simultaneously in § 103 fashion. As such, the expressly presented issues in the Claim Chart amount to Issue 2 and Issue 3 below.

Accordingly, the following three issues will be addressed in this proceeding.

10 1) Issue 1: Claims 1-6, 8 - 10, 13 - 20, and 22 - 32 under 35 U.S.C. § 102 based upon de Clerq (Pub. No. US 2005/0094610). Request pp. 41 - 48.

 2) Issue 2: Claims 1- 11 and 13 - 32 under 35 U.S.C. § 103 based upon de Clerq (Pub. No. US 2005/0094610) in view of Sheynblat (Pub. No. US 2006/0089153) and Copley (Pub. No. US 2005/0068169). See Claim Chart pp. 3 - 40 and pp. 42 - 122.¹

15 3) Issue 3: Claim 12 under 35 U.S.C. § 103 based upon de Clerq (Pub. No. US 2005/0094610) in view of Sheynblat (Pub. No. US 2006/0089153), Copley (Pub. No. US 2005/0068169) and Perez-Breva (Pub. No. US 2005/0037776). See Claim Chart pp. 40 - 41.

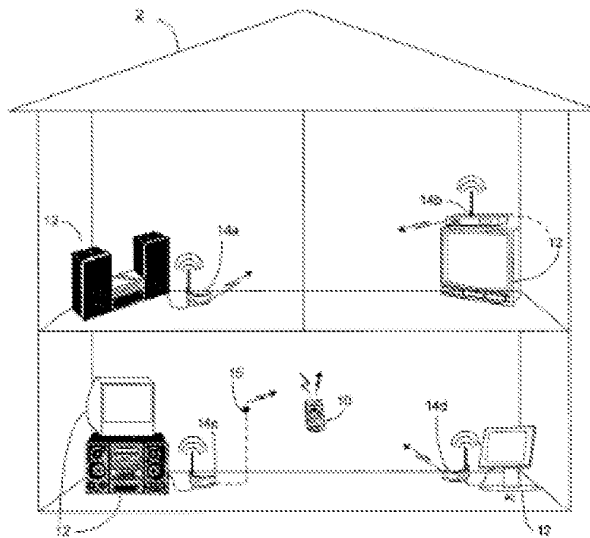
XII. Evaluation of SNQ

20 A) **de Clerq alone or in combination with Sheynblat, and Copley, as in issues 1 and 2 above.**

¹ These page numbers are the IFW page numbers. Requester did not number the pages of the claimchart.

The request asserts that a substantial new question of patentability as to the claims of the 698 Patent is raised by de Clerq (Pub. No. US 2005/0094610) alone or in combination with Sheynblat (Pub. No. US 2006/0089153), and Copley (Pub. No. US 2005/0068169). (Request, pp. 41 - 48 and Claim Chart). The Examiner agrees.

5 As discussed in the Request, de Clerq is teaching a method in system 2, Figure 1 below. In the method and system, the mobile device 10 determines its location by receiving signals from transmitting stations 14a-c (See de Clerq, Abstract, Par [0022] [0024] [0041]). In those sections de Clerq Par [0041] discusses device 10 can be a mobile phone. de Clerq Par [0022] [0024] states that the device 10 is determining its own location by having stations 14a-c send an
10 RF signal that is subsequently received by the mobile unit 10.).).



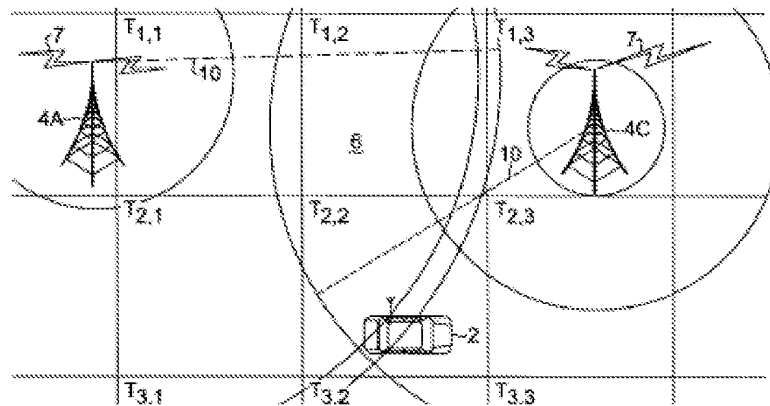
- de Clerq, Pub. No. US 2005/0094610, Figure 1

Because, de Clerq is teaching a mobile phone finding its own location by receiving signals from the stations 14a-c, the Examiner concludes that de Clerq is teaching "A location-
15 determining method, operable by a first portable RF communications device," as in claim 1 lines 1 of the 698 Patent.

Further de Clerq discusses that the devices 14a-c send an RF signal including their station ID to device 10. Device 10 matches the ID's with a location definitions representing the environment (de Clerq at Par [0027] is discussing device 10 receiving station ID's and matching those to a location definition.). de Clerq states that the environment definition is set by the user
5 (See de Clerq Par [0035], stating that environment definition is set via the home computer.). Because de Clerq teaches receiving the signal ID's and matching them to a data base of ID's at location set by the user, the Examiner finds that de Clerq is also teaching that the "*location determination method*," includes "*identifying at least one ID within at least one of the received communications signals . . . comparing the at least one ID at the first monitored location with at*
10 *least one ID at the location chosen by the user,*" as in claim 1 of the 698 Patent.

de Clerq discusses that mobile device 10 also checks signal strength values. Using the signal strength values, the mobile refines the location by matching the strength values to stored strength values representing locations in the region. The stored values called fingerprint data available to device 10, as shown in Figure 5 below (de Clerq Par [0030] [0036] [0037]).

15 Sheynblat (Pub. No. US 2006/0089153) is teaching a system, Figure 1 below, where a mobile device 2, uses RF finger printing to augment or refine location estimates based upon receiving base station ID's (See Sheynblat at Par [0004] [0017] [0023] [0025] [0030], discussing that a ruff estimate of location is found by ID of bases stations 4A and 4C. At Par [0030] Sheynblat discusses that RF fingerprinting entails further refining the location of mobile 2 by
20 matching RF signal strengths to an RF signal strength fingerprint database downloaded to the mobile.).



- Sheynblat, Pub. No. US 2006/0089153, Figure 1.

Because Sheynblat discusses a similar system to de Clerq, where Sheynblat is matching station ID's and using RF fingerprinting measuring a signal strength, the Examiner finds that

5 Sheynblat shows "*measuring a varying signal characteristic other than ID,*" and "*at least one number*" as in claim 1 of the 698 Patent.

Because, as noted above, de Clerq teaches a mobile device such as a cellular phone finding its location by receiving and matching transmitting station ID's. And, de Clerq teaches enhancing that location by matching the receiving signal strength using RF fingerprinting, data

10 entered by the user. And because Sheynblat states that the finger printing entails matching those measure values to values stored in a data base the Examiner finds the combination of de Clerq and Sheynblat reasonably is teach "*comparing . . . at least one number based on the varying signal characteristic of the communications signals from each of the first plurality of antenna stations at the first monitored location with at least one number based on corresponding varying*

15 *signal characteristics of the communications signals from each of the first plurality of antenna stations,*" as in claim 1 of the 698 Patent.

For that reason, the Examiner concludes that de Clerq in view of Sheynblat appears to teach the Technical Feature, identified above and repeated below, for which the claims of the 698 Patent were allowed.

Technical Feature:

5 “comparing . . . at least one number, based on the varying signal characteristic of the communications signals from each of the first plurality of antenna stations, at the first monitored location with at least one number, based on corresponding varying signal characteristics of the communications signals from each of the first plurality of antenna stations at the location chosen by the user.”

10 Because, de Clerq in view of Sheynblat appears to teach the above Technical Feature in context of "A location-determining method, operable by a first portable RF communications device," the Examiner finds that a reasonable examiner would find the teachings important in determining the patentability of the 698 Patent.

15 Therefore, the Examiner agrees with the Requester that De Clerq and Sheynblat raises a substantial new question of patentability for claims 1 - 32, because De Clerq and Sheynblat teaches the Technical Feature above in context of portable RF communication device location method.

The Examiner has reviewed Copley (Pub. No. US 2005/0068169), and finds that Copley is also directed to mobile device location determination (Copley, Abstract).

20 Because de Clerq in view of Sheynblat raises an SNQ, and Copley is also directed to the same topic as de Clerq and Sheynblat, the Examiner finds that a reasonable examiner would find the teachings of de Clerq and Sheynblat in combination with Copley, important in determining the patentability of the 698 Patent. For that reason the combination of de Clerq, Sheynblat and Copley would also raise an SNQ.

Therefore, the Examiner agrees with the Requester that the combination of de Clerq, Sheynblat and Copley, raises a substantial new question of patentability for claims 1 - 32, because the combination would teach the Technical Feature recited above in context of a method for portable device location determination.

5 The teachings of de Clerq, with Sheynblat and Copley were not cumulative to any written discussion of the requested claims on the record and were not previously addressed during a prior examination, and are not the subject of a final holding of invalidity by Federal Courts.

Accordingly, the Examiner finds de Clerq in combination with Sheynblat alone or in combination with Copley raises a substantial new question of patentability of the 698 Patent.

10

B) de Clerq alone in combination with Sheynblat, and Copley, and Perez-Breva, as in issue 3 above.

The request asserts that a substantial new question of patentability as to the claim 12 of the 698 Patent is raised by de Clerq (Pub. No. US 2005/0094610) in view of Sheynblat (Pub. No. 15 US 2006/0089153), Copley (Pub. No. US 2005/0068169) and Perez-Breva (Pub. No. US 2005/0037776). See Claim Chart pp. 40 - 41. The Examiner agrees.

As discussed in the Request, and above de Clerq, Sheynblat and Copley in combination are teaching enhancing location estimates by comparing signal strengths to a signal strength data base, aka, RF fingerprinting (See discussion above.). The Examiner finds that Perez-Breva is 20 also teaching RF fingerprinting similar to de Clerq, Sheynblat and Copley, where Perez-Brava also teaches capturing multiple snapshots of a single signal RSSI value overtime and comparing them (Perez-Breva Par [0055]). Perez-Breva also states that phase information could be used (Par [0030]).).

Because the teachings of de Clerq, Sheynblat, and Copley reasonably teach the Technical Feature for which the claims of the 698 Patent were allowed, requiring, inter alia, comparing a number representing a varying signal characteristic, where de Clerq, Sheynblat, and Copley reasonably teach RSSI that is a varying signal characteristic. And because Perez-Brava teaches a similar technique where the characteristic could be the phase of the signal, as in claim 12 of the 698 Patent, the Examiner finds that a reasonable Examiner would also consider the combination of de Clerq, Sheynblat and Copley, with Perez-Brava important in deciding whether or not the claims of the 698 Patent are patentable.

Therefore, the Examiner agrees with the Requester that de Clerq, Sheynblat and Copley, with Perez-Brava raises a substantial new question of patentability for claims 1 - 32, because de Clerq, Sheynblat and Copley, with Perez-Brava would teach the Technical Feature recited above for which the claims of the 698 Patent were allowed even if modified by claim 12.

The teachings of de Clerq, Sheynblat and Copley, with Perez-Brava were not cumulative to any written discussion of the requested claims on the record and were not previously addressed during a prior examination, and are not the subject of a final holding of invalidity by Federal Courts.

Accordingly, the Examiner finds de Clerq, Sheynblat and Copley, with Perez-Brava raises a substantial new question of patentability of the 698 Patent.

XIII. 35 U.S.C. § 325 (d)

A review of the post grant history of the 698 Patent indicates that the patent was not the subject of any prior post grant proceedings before the Office. For that reasons, the Examiner

finds that there is not a possibility of substantial overlap between this proceeding and prior post grant proceedings that may have applied the combinations of prior art cited above.

Accordingly, a discretionary denial of reexamination pursuant to 35 USC 325(d) is not implicated and reexamination is Ordered based on the determination that cited prior art raises an
5 SNQ for the reasons set forth above.

XIV. Notices Regarding Patent Owners Correspondence Address

Effective May 16, 2007, 37 C.F.R. § 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an Ex Parte
10 reexamination or an Inter Partes reexamination is designated as the correspondence address of the patent.

Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007) (Final Rule).

The correspondence address for any pending reexamination proceeding not having the
15 same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

20 Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly

encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

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XV. Conclusion and Correspondence Information

Claims 1 - 32 will be reexamined.

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

Patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '055 Patent throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286. The third-party requester is similarly apprised of the ability to disclose such proceedings.

All correspondence relating to this Ex Parte reexamination proceeding should be directed:

20 By U.S. Mail: Mail Stop Ex Parte Reexamination Central Reexamination Unit
Commissioner for Patents United States Patent & Trademark Office P.O. Box 1450 Alexandria,
VA 22313-1450. By FAX to: (571) 273-9900, Central Reexamination Unit.

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

5 /NICK CORSARO/
Primary Examiner, Art Unit 3992

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Conferees:

25 /CHARLES R CRAVER/
Reexamination Specialist, Art Unit 3992

/ANDREW J. FISCHER/
Supervisory Patent Reexamination Specialist, Art Unit 3992