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EXAMINER

CARLSON, JEFFREY D

ART UNIT

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

REEXAMINATION CONTROL NO. 90/019,456 .

PATENT UNDER REEXAMINATION 11738659 .

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)).

/JDC/

|                                                              |                                      |                                               |                                |
|--------------------------------------------------------------|--------------------------------------|-----------------------------------------------|--------------------------------|
| <b>Order Granting Request For<br/>Ex Parte Reexamination</b> | <b>Control No.</b><br>90/019,456     | <b>Patent Under Reexamination</b><br>11738659 |                                |
|                                                              | <b>Examiner</b><br>JEFFREY D CARLSON | <b>Art Unit</b><br>3992                       | <b>AIA (FITF) Status</b><br>No |

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

The request for *ex parte* reexamination filed 03/25/2024 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 *ex parte* 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.

/JEFFREY D CARLSON/  
Primary Examiner, Art Unit 3992

cc:Requester ( if third party requester )

## **DECISION ON REQUEST FOR *EX PARTE* REEXAMINATION**

Third-party requester Unified Patents, LLC submitted a request for *ex parte* reexamination with a filing date of 3/25/2024, requesting reexamination of claims 1–21 of US Patent 11,738,659 (“the patent”). At least one substantial new question of patentability affecting claims 1–21 of the patent in effect at the time is raised by the request. Accordingly, claims 1–21 will be reexamined.

### ***Publications Asserted as Raising Substantial New Question(s) of Patentability***

The asserted substantial new question(s) of patentability (SNQs) are based on the following publications, each of which qualify as prior art against the patent<sup>1</sup>.

- US 2013/0099892 (“Tucker”)
- US 2008/0275604 (“Perry”)
- US 2008/0150683 (“Mikan”)
- US 2012/0254948 (“Kleve”)
- US 8,977,408 (“Cazanas”)

### ***Analysis of Substantial New Questions of Patentability (SNQs)***

#### **SUMMARY OF REQUESTED US PATENT 11,738,659**

US Patent 11,738,659 is titled “Vehicles And Cloud Systems For Sharing E-Keys To Access And Use Vehicles” and is summarized as follows:

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<sup>1</sup> Perry, Mikan, and Kleve were each filed prior to the patent’s earliest possible priority benefit date (4/22/2011, via provisional 61/478,436). Tucker and Cazanas were each filed after this 4/22/2011 date. The disclosure of this provisional application however appears to lack support for several limitations claimed in US Patent 11,738,659 requested for reexamination. These include for example an “eKey”, “coded data”, “unlocking” or “starting” of the vehicle and “privilege settings”.

“A vehicle configured to communicate with a server of a cloud system to enable access to use the vehicle via one or more electronic keys is provided. The vehicle includes electronics and a subsystem of the vehicle for enabling unlocking of the vehicle. The subsystem is interfaced with the electronics and a subsystem of the vehicle for enabling starting of the vehicle for use of the vehicle. The vehicle further includes communications circuitry that is interfaced with electronics of the vehicle. The communications circuitry is programmable to communicate with the server of the cloud system and communicate with a mobile device. The communications circuitry of the vehicle is configured to receive a request from the mobile device for unlocking of the vehicle. The request from the mobile device includes coded data obtained by the mobile device from the server to enable sending the request to the vehicle. The coded data is associated with privileges for use of the vehicle. The privileges are defined for the coded data, and the vehicle is configured to receive information from the server to authenticate the request by the mobile device. And, if the request is authentic, the mobile device is provided with data to enable an electronic key to use the vehicle, and the electronics of the vehicle instructs the subsystem of the vehicle to enable unlocking of the vehicle and enable starting of the vehicle for use of the vehicle via the electronic key consistent with the privileges of the coded data” (at Abstract).

Patented claim 1 is representative and is reproduced below:

1. A sub-system of a vehicle, the vehicle having an on-board computer interfaced with the sub-system for processing instructions to enable use of an electronic key (eKey), the sub-system comprising:

memory associated with the on-board computer of the vehicle having program instructions for instructing unlocking and starting of the vehicle; and

communications circuitry of the vehicle interfaced with the on-board computer of the vehicle and the sub-system, the communications circuitry is configured to process program instructions to enable communication with a server, the communications circuitry includes wireless communication circuitry for enabling local connection with a mobile device, the mobile device is configured to use the eKey for said unlocking and said starting the vehicle;

**wherein the wireless communications circuitry of the vehicle is configured to receive coded data from the mobile device when using the eKey, the coded**

**data enables functions of said eKey for said unlocking and use of the vehicle, the coded data is associated to the eKey for use by the mobile device, and the coded data includes privilege settings associated with the eKey for limiting types of use of the vehicle when using the eKey with the vehicle;**

wherein use of the vehicle using the eKey is tracked to identify and log actions taken using the vehicle while the eKey is used.

### ORIGINAL PROSECUTION HISTORY

Application 17/461,959 filed 8/30/2021 presented claims 1–14<sup>2</sup>. A preliminary amendment filed 7/25/2022 amended claims 1, 4, 8 and 13, canceled claims 7 and 10–12 and added claims 15–24<sup>3</sup>. Claims 1–6, 8, 9, and 13–24 were pending.

An office action mailed 8/25/2022:

- Rejected claims 1–6, 8, 9 and 13–24 on the ground of nonstatutory double patenting over claims of US Patents 9,189,900, 9,663,067, 10,407,026, 10,442,399 and 11,104,245.
- Rejected claims 1–6, 9, 16–18 and 21–24 under 35 U.S.C. 102(b) as being anticipated by US 2011/0112969 (Zaid).
- Rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Zaid and US 2011/0060480 (Mottla).
- Rejected claims 13–15 under 35 U.S.C. 103(a) as being unpatentable over Zaid and US 2009/0062971 (Rottig).
- Rejected claims 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over Zaid.

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<sup>2</sup> Claim 1 was the independent claim.

<sup>3</sup> Claim 18 was another independent claim.

A response filed 1/6/2023:

- Amended claims 1, 15 and 18 and added claim 25<sup>4</sup>. Claims 1–6, 8, 9, and 13–25 were pending.

An office action mailed 2/7/2023:

- Rejected claims 1–6, 8, 9, and 13–25 on the ground of nonstatutory double patenting over claims of the same five previous US patents.
- Rejected claims 1–6, 9 and 16–25 under 35 U.S.C. 103(a) as being unpatentable over Zaid and US 2005/0203752 (Shinada).
- Rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Zaid, Shinada and Mottla.
- Rejected claims 13–15 under 35 U.S.C. 103(a) as being unpatentable over Zaid, Shinada and Rottig.

A response filed 5/9/2023:

- Amended claims 1, 3, 4, 6, 8, 9 and 18–25, canceled claims 2, 16 and 17 and added claims 26–28. Claims 1, 3–6, 8, 9, 13–15 and 18–28 were pending.
- Requested a Terminal Disclaimer for US Patents 9,189,900, 9,663,067, 10,407,026, 10,442,399 and 11,104,245.
- Received approval for the electronically-requested Terminal Disclaimer.

A Notice of Allowance mailed 6/26/2023:

- Allowed claims 1, 3–6, 8, 9, 13–15 and 18–28.
- Provided the following reasons for allowance:  
“The distinguishing elements of the claim "**wherein the wireless**

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<sup>4</sup> Claim 25 was another independent claim.

**communications circuitry of the vehicle is configured to receive coded data from the mobile device when using the eKey, the coded data enables functions of said eKey for said unlocking and use of the vehicle, the coded data is associated to the eKey for use by the mobile device, and the coded data includes privilege settings associated with the eKey for limiting types of use of the vehicle when using the eKey with the vehicle" as recited in claims 1 and similarly presented in 18 and 25 are allowable subject matter".**

US Patent 11,738,659 issued 8/29/2023 with claims 1–21. Prosecuted claims 1, 18 and 25 printed as independent claims 1, 11 and 18 respectively.

#### POST-GRANT HISTORY AT THE PTAB

No other reexamination requests or PTAB trial petitions have been identified by the examiner or requestor.

#### PROPOSED SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Requester proposes the following SNQs:

| SNQ   | Claims        | Basis                           |
|-------|---------------|---------------------------------|
| SNQ 1 | 1, 2 and 5–10 | § 103 – Tucker and Perry        |
| SNQ 2 | 1–3 and 5–7   | § 103 – Tucker and Mikan        |
| SNQ 3 | 4             | § 103 – Tucker, Mikan and Kleve |
| SNQ 4 | 8–10          | § 103 – Tucker, Mikan and Perry |
| SNQ 5 | 11–21         | § 103 – Tucker and Cazan        |

None of Mikan, Kleve, Perry, or Cazan were cited or discussed on the record in the original prosecution. Tucker was cited by applicant but its substance

was not discussed on the record by applicant or examiner.

On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a): "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, each of the proposed SNQs 1–5 are based on Tucker in view of additional reference(s) not previously cited or discussed. Further, because Tucker was not discussed on the record, it is not clear the degree to which Tucker was previously considered. The request has additionally provided insight into the teachings of Tucker which appear to have escaped review in the original prosecution. See below.

The proposed question(s) of patentability in this reexamination request based upon these combinations were not: (A) decided in a final holding of invalidity by a federal court in a decision on the merits involving the claim, after all appeals; (B) decided in an earlier concluded examination or review of the patent by the Office; or (C) raised to or by the Office in a pending reexamination or supplemental examination of the patent.

SNQ 1 – Tucker and Perry

Tucker is titled “ACCESSING A VEHICLE USING PORTABLE DEVICES” and teaches:

“A primary portable device can access a vehicle by transmitting an activation message including a vehicle access credential to the vehicle. The primary portable device can additionally enable a secondary portable device to access the vehicle by transmitting the vehicle access credential to the secondary portable device. The connections between the primary portable device, secondary portable device, and vehicle can be based on a short-range wireless protocol, such as Bluetooth or Bluetooth LE” (Tucker Abstract).

“primary portable device 102 can receive a vehicle access credential from vehicle 106” (Tucker ¶ 0071).

“a vehicle access credential can be any value, data, or information suitable for determining whether a device is authorized to activate a vehicle. For example, a vehicle access credential can be or include one or more access tokens, access keys, access codes, access information, cryptographic keys, data signed using cryptographic keys, and/or the like” (Tucker ¶ 0024).

“vehicle-related operation can be any operation supported by a vehicle. For example, a vehicle-related operation can be an operation to unlock a vehicle's doors, unlock a vehicle's storage compartment, start a vehicle's engine, activate a vehicle's audio . . .” (Tucker ¶ 0025).

“each vehicle access key can be associated with a different access level. Each access level can, in turn, be associated with a particular set of vehicle-related operations and/or set of usage parameters. For example, a first vehicle access key can be associated with an owner access level. As a result, a portable device that transmits an activation message including the first vehicle access key can activate the vehicle such that any supported vehicle-related operation can be accessed. By contrast, a second vehicle access key can be associated with a restricted or guest access level. As such, a portable device that transmits an activation message including the second vehicle access key can activate the vehicle such that only a limited number of vehicle-related operations can be accessed” (Tucker ¶ 0125).

“primary portable device 102 can transmit a set of usage parameters to secondary

portable device 104. The usage parameters can, in some embodiments, limit the manner in which vehicle 106 can be operated when the vehicle is activated using secondary portable device 104. For example . . . only a door unlock operation is accessible . . . limit the time period during which vehicle's 106 operations are accessible . . . limited such that vehicle 106 is not permitted to exceed a speed of 45 mph” (Tucker¶ 0092).

“The vehicle access credential can include the access credential that primary portable device 102 previously obtained from vehicle 106 and may also incorporate other information, such as the usage parameters” (Tucker¶ 0098).

Tucker thus teaches instructions for wirelessly sending access keys/codes to a vehicle from different mobile devices in order to access, unlock and/or start the vehicle. The transmission of access keys/codes includes transmission of usage parameters that define and limit the types of vehicle usage. These usage parameters represent the claimed privilege settings that were part of the distinguishing elements in the original prosecution.

Because these teachings are relevant to the allowable features of independent claims 1, 11 and 18 of the patent, there is a substantial likelihood that a reasonable examiner would consider the teachings important in evaluating the patentability of claims 1–21.

The combination of Tucker with Perry likewise includes teachings important in evaluating the patentability of these claims, given the specific teachings of Tucker.

Tucker and Perry in combination therefore raise a substantial new question of patentability with respect to claims 1–21.

## SNQ 2 – Tucker and Mikan

As discussed above, Tucker teaches instructions for wirelessly sending access keys/codes to a vehicle from different mobile devices in order to access,

unlock and/or start the vehicle. The transmission of access keys/codes includes transmission of usage parameters that define and limit the types of vehicle usage. These usage parameters represent the claimed privilege settings that were part of the distinguishing elements in the original prosecution.

Because these teachings are relevant to the allowable features of independent claims 1, 11 and 18 of the patent, there is a substantial likelihood that a reasonable examiner would consider the teachings important in evaluating the patentability of claims 1–21.

The combination of Tucker with Mikan likewise includes teachings important in evaluating the patentability of these claims, given the specific teachings of Tucker.

Tucker and Mikan together therefore raise a substantial new question of patentability with respect to claims 1–21.

### SNQ 3 – Tucker, Mikan and Kleve

As discussed above, Tucker teaches instructions for wirelessly sending access keys/codes to a vehicle from different mobile devices in order to access, unlock and/or start the vehicle. The transmission of access keys/codes includes transmission of usage parameters that define and limit the types of vehicle usage. These usage parameters represent the claimed privilege settings that were part of the distinguishing elements in the original prosecution.

Because these teachings are relevant to the allowable features of independent claims 1, 11 and 18 of the patent, there is a substantial likelihood that a reasonable examiner would consider the teachings important in evaluating the patentability of claims 1–21.

The combination of Tucker with Mikan and Kleve likewise includes

teachings important in evaluating the patentability of these claims, given the specific teachings of Tucker.

Tucker, Mikan and Kleve together therefore raise a substantial new question of patentability with respect to claims 1–21.

#### SNQ 4 – Tucker, Mikan and Perry

As discussed above, Tucker teaches instructions for wirelessly sending access keys/codes to a vehicle from different mobile devices in order to access, unlock and/or start the vehicle. The transmission of access keys/codes includes transmission of usage parameters that define and limit the types of vehicle usage. These usage parameters represent the claimed privilege settings that were part of the distinguishing elements in the original prosecution.

Because these teachings are relevant to the allowable features of independent claims 1, 11 and 18 of the patent, there is a substantial likelihood that a reasonable examiner would consider the teachings important in evaluating the patentability of claims 1–21.

The combination of Tucker with Mikan and Perry likewise includes teachings important in evaluating the patentability of these claims, given the specific teachings of Tucker.

Tucker, Mikan and Perry together therefore raise a substantial new question of patentability with respect to claims 1–21.

#### SNQ 5 – Tucker and Cazanias

As discussed above, Tucker teaches instructions for wirelessly sending access keys/codes to a vehicle from different mobile devices in order to access, unlock and/or start the vehicle. The transmission of access keys/codes includes

transmission of usage parameters that define and limit the types of vehicle usage. These usage parameters represent the claimed privilege settings that were part of the distinguishing elements in the original prosecution.

Because these teachings are relevant to the allowable features of independent claims 1, 11 and 18 of the patent, there is a substantial likelihood that a reasonable examiner would consider the teachings important in evaluating the patentability of claims 1–21.

The combination of Tucker with Cazanias likewise includes teachings important in evaluating the patentability of these claims, given the specific teachings of Tucker.

Tucker and Cazanias together therefore raise a substantial new question of patentability with respect to claims 1–21.

### ***35 USC 325(d)***

A review of the post grant history for US Patent 11,738,659 indicates that there have been no other Office post grant challenges involving the patent (Reexamination Proceedings or Inter Partes Review, Post Grant Review, Covered Business Method trials). Accordingly, a determination of whether to exercise discretion to reject the request pursuant to 35 USC 325(d) is not applicable.

### ***Extensions of Time***

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 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).

### ***Submissions***

In order to ensure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

### ***Notification of Concurrent Proceedings***

The 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 patent requested for reexamination throughout the course of this reexamination proceeding. Likewise, if present, the third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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Any inquiry concerning this communication should be directed to **the Central Reexamination Unit** at telephone number **517-272-7705**.

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