



US006064970C1

(12) **EX PARTE REEXAMINATION CERTIFICATE** (8789th)
United States Patent
McMillan et al.

(10) **Number:** **US 6,064,970 C1**

(45) **Certificate Issued:** ***Jan. 10, 2012**

(54) **MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE**

(75) Inventors: **Robert John McMillan**, Tampa, FL (US); **Alexander Dean Craig**, Moreland Hills, OH (US); **John Patrick Heinen**, Tampa, FL (US)

(73) Assignee: **Progressive Casualty Insurance Company**, Mayfield Village, OH (US)

Reexamination Request:
No. 90/011,252, Sep. 22, 2010

Reexamination Certificate for:
Patent No.: **6,064,970**
Issued: **May 16, 2000**
Appl. No.: **09/135,034**
Filed: **Aug. 17, 1998**

(*) Notice: This patent is subject to a terminal disclaimer.

Related U.S. Application Data

(63) Continuation of application No. 08/592,958, filed on Jan. 29, 1996, now Pat. No. 5,797,134.

(51) **Int. Cl.**
G06Q 40/00 (2006.01)

(52) **U.S. Cl.** 705/4; 340/439; 340/870.01; 360/5; 702/1; 705/400

(58) **Field of Classification Search** None
See application file for complete search history.

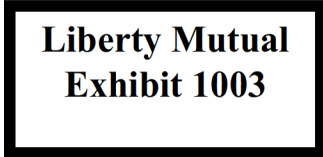
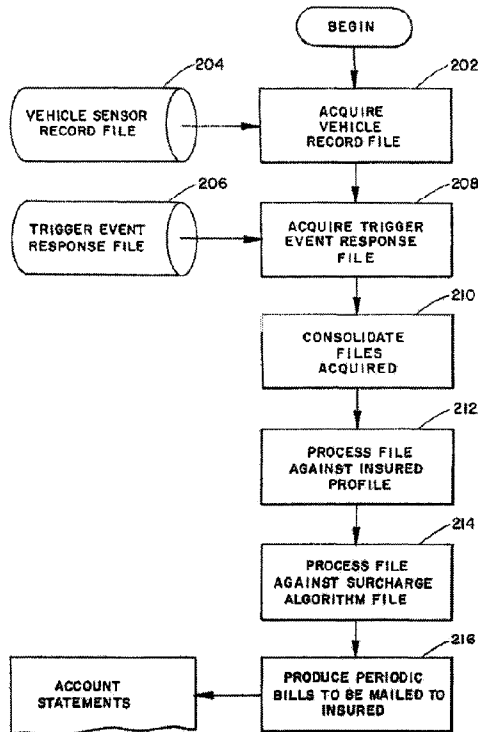
(56) **References Cited**

To view the complete listing of prior art documents cited during the proceeding for Reexamination Control Number 90/011,252, please refer to the USPTO's public Patent Application Information Retrieval (PAIR) system under the Display References tab.

Primary Examiner—Karin Reichle

(57) **ABSTRACT**

A method and system of determining a cost of automobile insurance based upon monitoring, recording and communicating data representative of operator and vehicle driving characteristics. The cost is adjustable retrospectively and can be prospectively set by relating the driving characteristics to predetermined safety standards. The method comprises steps of monitoring a plurality of raw data elements representative of an operating state of the vehicle or an action of the operator. Selected ones of the raw data elements are recorded when the ones are determined to have an identified relationship to safety standards. The selected ones are consolidated for processing against an insurer profile and for identifying a surcharge or discount to be applied to a base cost of automobile insurance. A final cost is produced from the base costs and the surcharges or discounts.



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EX PARTE
REEXAMINATION CERTIFICATE
ISSUED UNDER 35 U.S.C. 307

THE PATENT IS HEREBY AMENDED AS
INDICATED BELOW.

Matter enclosed in heavy brackets [] appeared in the patent, but has been deleted and is no longer a part of the patent; matter printed in italics indicates additions made to the patent.

AS A RESULT OF REEXAMINATION, IT HAS BEEN DETERMINED THAT:

Claim 2 is cancelled.

Claims 1, and 3-6 are determined to be patentable as amended.

Claims 7-15, dependent on an amended claim, are determined to be patentable.

New claims 16-18 are added and determined to be patentable.

1. A method of generating a database comprising data elements representative of operator or vehicle driving characteristics, the method comprising:

generating actuarial classes of insurance, which group operators or vehicles having a similar risk characteristic, from actual monitored driving characteristics during a selected time period as represented by recorded data elements representative of an operating state of the vehicles or an action of the operators; and

monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of [the] an operator during a latter selected time period; and,

recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the latter selected time period, said ones including, a time and location of vehicle operation and a corresponding log of vehicle speed for the time and location.

3. The [database] method as defined in claim [2] wherein the data elements comprise raw data elements, derived data elements and calculated data elements.

4. A method of insuring a vehicle operator for a selected period based upon operator driving characteristics during the period, comprising, steps of:

generating an initial operator profile;

generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicle operator's driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator;

monitoring [operator] the vehicle operator's driving characteristics during the selected period; and deciding a total cost of vehicle insurance for the selected period based upon the [operating] vehicle operator's driving characteristics monitored in that selected period and the base cost of insurance.

5. A method of determining a cost of vehicle insurance for a selected period based upon monitoring, recording and

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communicating data representative of operator and vehicle driving characteristics during said period, whereby the cost is adjustable by relating the driving characteristics to predetermined safety standards *that are related to a safe operation of a vehicle*, the method comprising:

determining an initial insured profile *for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator of the vehicle* and determining a base cost of the vehicle insurance based on said initial insured profile *wherein the initial insured profile comprises coverage information, including limits and deductibles;*

monitoring a plurality of the data elements representative of [an] the operating state of [a] the vehicle or [an] the action of the operator of the vehicle during the selected period;

recording selected ones of the plurality of data elements when said ones are determined to have a preselected relationship to the safety standards;

consolidating said selected ones for identifying a surcharge or discount to be applied to the base cost; and,

producing a final cost of vehicle insurance for the selected period from the base cost and the surcharge or discount.

6. A method of monitoring a human operator controlled power source driven vehicle, the method comprising:

extracting one or more data elements *by a computer programmed to monitor sensor data* from at least one sensor wherein the one or more elements are *actual driving characteristics* of at least one operating state of the and [the] at least one [human's] human operator's actions during a data collection period;

analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements; and,

correlating the group data values to preset values in a second memory and generating an output data value based on the correlation wherein the output data value is used to compute an insurance rating for the vehicle [FOR the data collection period] *for the data collection period that is based on an actuarial class of insurance which groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic and which also represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor.*

16. The method of claim 5, wherein the surcharge or discount comprises a discount, and wherein producing the final cost of vehicle insurance comprises applying the discount to the base cost of vehicle insurance.

17. The method of claim 5, wherein the surcharge or discount comprises a surcharge, and wherein producing the final cost of vehicle insurance comprises applying the surcharge to the base cost of vehicle insurance.

18. A method of monitoring a human operator controlled power source driven vehicle, the method comprising:

extracting one or more data elements *by an on-board computer from at least one sensor wherein the one or more elements are actual driving characteristics of at least one operating state of the vehicle and at least one human operator's actions during a data collection period;*

analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements;

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correlating the group data values to preset values related to safety standards in a second memory and generating an output data value based on the correlation; and computing an insurance rating based upon the output data value for the vehicle for the data collection period, in which the insurance rating is also based on an actuarial class of insurance wherein said actuarial class of insurance groups other human operator controlled power source driven vehicles having a similar operator

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or vehicle risk characteristic as well as represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor, and setting prospective insurance premiums based on the actuarial class of insurance.

* * * * *

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/James A. Collins/

James A. Collins, Reg. No. 43,557

November 16, 2011

Date of Signature & Date of Transmission

EX PARTE REEXAM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CENTRAL REEXAMINATION UNIT

Ex parte Reexamination of U.S. Patent :
6,064,970 :
Robert J. McMillan, et al. : Confirmation No. 4116
Control No. 90/011,252 : Examiner: Karin M. Reichle
Filing Date: August 17, 1998 : Group Art Unit: 3992
For: MOTOR VEHICLE MONITORING SYSTEM FOR : Attorney Docket No. 12741-32
DETERMINING A COST OF INSURANCE :

MAIL STOP *EX PARTE* REEXAM
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INTERVIEW SUMMARY

On November 4, 2011 a telephone interview was held with Examiner Reichle, Supervisor Ferris, and Examiner Cabrera and Patent Owner's representatives Raymond Ling, Joseph Hanasz, and James Collins.

Knowledge of insurance practices and insurance policies and potential amendments to the claims outlined in the Brief Outline for Interview (submitted for discussion purposes) were

discussed. Also, the term “insurance actuarial class” was discussed with respect to claims 1, 6, and 70.

On November 8, 2011, the interview was reconvened. The Patent Owner adopted the amendments proposed by the examiners during that call. Patent Owner’s representatives appreciate the examiners’ consideration.

BRINKS HOFER GILSON & LIONE
312-321-4200

Respectfully submitted,

/James A. Collins/
James A. Collins
Registration No. 43,557
Attorney for Patentee

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: November 16, 2011 Name: James A. Collins Signature: /James A. Collins/

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& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ex parte Reexamination of U.S. Patent 6,064,970

Robert J. McMillan, et al.

Patent Filing Date: August 17, 1998

Reexamination Filing Date: September 22, 2010

Control No.: 90/011,252

For: MOTOR VEHICLE MONITORING SYSTEM FOR
DETERMINING A COST OF INSURANCE

Examiner: Karin M. Reichle

Group Art Unit: 3992

Conf. No.: 4116

Attorney Docket No.: 12741/32

CERTIFICATE OF SERVICE

Mail Stop Ex Parte Reexam
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that a true copy of the foregoing **INTERVIEW SUMMARY**, was served this November 16, 2011 by First Class United States Mail, postage prepaid, on:

J. Steven Baughman
Ropes & Gray LLP
Prudential Tower
800 Boylston Street
Boston, MA 02199-3600

Respectfully submitted,

November 16, 2011

Date

/James A. Collins/

James A. Collins (Reg. No. 43,557)

BRINKS
HOFER
GILSON
& LIONE

BRINKS HOFER GILSON & LIONE
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

Electronic Acknowledgement Receipt

| | |
|---|---|
| EFS ID: | 11423509 |
| Application Number: | 90011252 |
| International Application Number: | |
| Confirmation Number: | 4116 |
| Title of Invention: | MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE |
| First Named Inventor/Applicant Name: | 6,064,970 |
| Customer Number: | 10999 |
| Filer: | James A. Collins/Maggie Pieczonka |
| Filer Authorized By: | James A. Collins |
| Attorney Docket Number: | 12741-32 |
| Receipt Date: | 16-NOV-2011 |
| Filing Date: | 22-SEP-2010 |
| Time Stamp: | 17:16:29 |
| Application Type: | Reexam (Patent Owner) |

Payment information:

| | |
|------------------------|----|
| Submitted with Payment | no |
|------------------------|----|

File Listing:

| Document Number | Document Description | File Name | File Size(Bytes)/ Message Digest | Multi Part /.zip | Pages (if appl.) |
|-----------------|--------------------------------------|--------------------|---|------------------|------------------|
| 1 | Reexam Miscellaneous Incoming Letter | transforintsum.PDF | 41913 <small>e916d9c6c89c4d0c10012f23aa0e674d82cc 2e71</small> | no | 1 |

Warnings:

Information:

| | | | | | |
|---|--|-------------------|--|--------|---|
| 2 | Applicant summary of interview with examiner | intsummary.PDF | 51274 2b50e50f10908ba9e4e6c4e5f7b9fe0859c0920 | no | 2 |
| Warnings: | | | | | |
| Information: | | | | | |
| 3 | Reexam Certificate of Service | certofservice.PDF | 31897 d4e70d659e2b3e81502ea524802563697fd062f | no | 1 |
| Warnings: | | | | | |
| Information: | | | | | |
| Total Files Size (in bytes): | | | | 125084 | |
| <p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p> | | | | | |

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Date: November 16, 2011 Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re-Examination of: Robert J. McMillan et al.
 Re-Examination Appl. No.: 90/011,252
 Filing Date: September 22, 2010
 U.S. Patent No.: 6,064,970
 For: **MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE**
 Attorney Docket No.: 12741/32

Examiner: Karin M. Reichle
 Group Art Unit: 3992
 Conf. No.: 4116

TRANSMITTAL

Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

Sir:

Attached is/are:

Transmittal; Interview Summary; and Certificate of Service.

Fee calculation:

- No additional fee is required.
- Small Entity.
- An extension fee in an amount of \$_____ for a _____ month extension of time under 37 CFR § 1.136(a).
- A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(____) .
- An additional filing fee has been calculated as shown below:

| | | | | | Small Entity | | Not a Small Entity | | |
|---|----------------------------------|-------|---------------------------------|---------------|--------------|-----------|--------------------|----------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | OR | Rate | Add'l Fee |
| Total | | Minus | | | x \$26= | | | x \$52= | |
| Indep. | | Minus | | | x 110= | | | x \$220= | |
| First Presentation of Multiple Dep. Claim | | | | | + \$195= | | | + \$390= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

- Please charge Deposit Account No. 23-1925 in the amount of \$_____ for _____.
- Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

November 16, 2011
 Date

/James A. Collins/
 James A. Collins (Reg. No. 43,557)



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address : COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

| | | | |
|---------------------------------|--------------------|---|---------------------|
| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
| 90/011,252 | 22 September, 2010 | 6,064,970 | 12741-32 |

| | | |
|--|----------------|----------|
| Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 | EXAMINER | |
| | KARIN REICHLER | |
| | ART UNIT | PAPER |
| | 3992 | 20111115 |

DATE MAILED: **MAILED**

NOV 15 2011

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

Commissioner for Patents

See attached communication

encl: 2-11-2011 PTO-1449

/Karin M. Reichle/
Primary Examiner, Art Unit 3992



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ROPES & GRAY LLP

PATENT DOCKETING 39/41

ONE INTERNATIONAL PLACE

BOSTON, MA 02110-2624

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,252.

PATENT NO. 6,064,970.

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)).

Communication

IDS Submissions

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

Accordingly, the IDS submissions have been considered by the Examiner only with the scope required by MPEP 2256.

Correspondence

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
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

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Art Unit: 3992

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

Other useful telephone numbers:

Reexamination Practice (571) 272-7703

Reexamination Facsimile Transmission No. (571) 273-9900

/Karin M. Reichle/
Examiner, CRU
Art Unit 3992

Receipt date: 02/11/2011

90011252 - GAU: 3992

| | | |
|--|---|--------------------------|
| FORM PTO-1449 | SERIAL NO. 90/011,252 | CASE NO. 12741-32 |
| LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT | FILING DATE September 22, 2010 | GROUP ART UNIT 3992 |
| | (use several sheets if necessary) APPLICANT(S): Robert John McMillan et al. | |
| | | CONFIRMATION NO. 4116 |

REFERENCE DESIGNATION U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | NAME | CLASS/SUBCLASS | FILING DATE |
|------------------|---|--------------|------------|--------------------|-------------|
| | C1 | US 4,581,708 | 04/08/1986 | Van Ostrand et al. | |
| | C2 | US 4,593,357 | 06/03/1986 | Van Ostrand et al. | |
| | C3 | US 4,945,759 | 08/07/1990 | Krofchalk et al. | |
| | C4 | US 5,074,144 | 12/24/1991 | Krofchalk et al. | |
| | C5 | US 5,862,500 | 01/19/1999 | Goodwin | |

FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | COUNTRY | CLASS/SUBCLASS | TRANSLATION YES OR NO |
|------------------|---|------|---------|----------------|-----------------------|
| | | | | | |
| | | | | | |
| | | | | | |

OTHER ART - NON PATENT LITERATURE DOCUMENTS

| EXAMINER INITIAL | <small>(Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.</small> | | | | |
|------------------|---|--|--|--|--|
| | C6 | Butler, T., "Insurance by the Mile," Letter to the Editor, The Washington Post, January 17, 1991, 2 pages. | | | |
| | C7 | Capon, R., "insure by the Mile," Letter to the Editor, The Washington Post, December 27, 1990, 2 pages. | | | |
| | C8 | Narten, T., "File Server," Encyclopedia of Computer Science, Ed. Anthony Ralston and Edwin D. Reilly, 3rd. Ed., New York: Van Nostrand Reinhold, copyright 1993, pp.554-555. | | | |
| | C9 | "Vehicle Alert and Notification System," IBM Technical Disclosure Bulletin, Vol. 38, No. 8, August 1995, pp. 209-211. | | | |

| | | | |
|----------|-----------------|-----------------|------------|
| EXAMINER | /Karin Reichle/ | DATE CONSIDERED | 11/15/2011 |
|----------|-----------------|-----------------|------------|

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /KR/



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
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 90/011,252 | 09/22/2010 | 6,064,970 | 12741-32 | 4116 |
| 10999 | 7590 | 11/10/2011 | EXAMINER | |
| Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 | | | ART UNIT | PAPER NUMBER |

DATE MAILED: 11/10/2011

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,252.

PATENT NO. 6,064,970.

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)).

| | | |
|---|--------------------|-----------------------------------|
| Notice of Intent to Issue Ex Parte Reexamination Certificate | Control No. | Patent Under Reexamination |
| | 90/011,252 | 6,064,970 |
| | Examiner | Art Unit |
| | KARIN REICHLE | 3992 |

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

1. Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
- (a) Patent owner's communication(s) filed: _____.
- (b) Patent owner's late response filed: _____.
- (c) Patent owner's failure to file an appropriate response to the Office action mailed: _____.
- (d) Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
- (e) Other: Interviews of 11/4/11 & 11/8/11.
- Status of *Ex Parte* Reexamination:
- (f) Change in the Specification: Yes No
- (g) Change in the Drawing(s): Yes No
- (h) Status of the Claim(s):
- (1) Patent claim(s) confirmed: _____.
- (2) Patent claim(s) amended (including dependent on amended claim(s)): 1 and 3-15
- (3) Patent claim(s) canceled: 2.
- (4) Newly presented claim(s) patentable: 70,76 and 77.
- (5) Newly presented canceled claims: 16-69, 71-75 and 78-80.
- (6) Patent claim(s) previously currently disclaimed: _____
- (7) Patent claim(s) not subject to reexamination: _____.
2. Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
3. Note attached NOTICE OF REFERENCES CITED (PTO-892).
4. Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
5. The drawing correction request filed on _____ is: approved disapproved.
6. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
 been received.
 not been received.
 been filed in Application No. _____.
 been filed in reexamination Control No. _____.
 been received by the International Bureau in PCT Application No. _____.
- * Certified copies not received: _____.
7. Note attached Examiner's Amendment.
8. Note attached Interview Summary (PTO-474).
9. Other: _____.

Karin M. Reichle
Primary Examiner
Art Unit: 3992

cc: Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-469 (Rev. 05-10)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20111108

NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION

CERTIFICATE

Examiner's Amendment

An examiner's amendment to the record appears below. The changes made by this examiner's amendment will be reflected in the reexamination certificate to issue in due course.

1. (amended) A method of generating a database comprising data elements representative of operator or vehicle driving characteristics, the method comprising:

generating actuarial classes of insurance, which group operators or vehicles having a similar risk characteristic, from actual monitored driving characteristics during a selected time period as represented by recorded data elements representative of an operating state of the vehicles or an action of the operators; and

monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of [the] an operator during a latter selected time period; and,

recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the latter selected time period, said ones including, a time and location of vehicle operation and a corresponding log of vehicle speed for the time and location.

2. (cancelled).

3. (amended) The [database] method as defined in claim 1 [2] wherein the data elements comprise raw data elements, derived data elements and calculated data elements.

4. (amended) A method of insuring a vehicle operator for a selected period based upon operator driving characteristics during the period, comprising, steps of:

generating an initial operator profile;

generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicle operator's driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator;

monitoring the vehicle operator's driving characteristics during the selected period; and

deciding a total cost of vehicle insurance for the selected period based upon the [operating] vehicle operator's driving characteristics monitored in that selected period and the base cost of insurance.

5. (amended) A method of determining a cost of vehicle insurance for a selected period based upon monitoring, recording and communicating data representative of operator and vehicle driving characteristics during said period, whereby the cost is adjustable by relating the driving characteristics to predetermined safety standards that are related to a safe operation of a vehicle, the method comprising:

determining an initial insured profile for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator

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of the vehicle and determining a base cost of the vehicle insurance based on said initial insured profile wherein the initial insured profile comprises coverage information, including limits and deductibles;

monitoring a plurality of the data elements representative of [an] the operating state of [a] the vehicle or [an] the action of the operator of the vehicle during the selected period;

recording selected ones of the plurality of data elements when said ones are determined to have a preselected relationship to the safety standards;

consolidating said selected ones for identifying a surcharge or discount to be applied to the base cost; and,

producing a final cost of vehicle insurance for the selected period from the base cost and the surcharge or discount.

6. (amended) A method of monitoring a human operator controlled power source driven vehicle, the method comprising:

extracting one or more data elements by a computer programmed to monitor sensor data from at least one sensor wherein the one or more elements are actual driving characteristics of at least one operating state of the vehicle and [the] at least one human[']s operator's actions during a data collection period;

analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements; and,

correlating the group data values to preset values in a second memory and generating an output data value based on the correlation wherein the output data value is used to compute an

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insurance rating for the vehicle for the data collection period that is based on an actuarial class of insurance which groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic and which also represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor [FOR the data collection period].

7. (original) The method according to claim 6, further including the steps of:

determining if the one or more data elements indicate one or more predetermined triggering events, where if the determination is positive, correlating the one or more data elements to one or more types of triggering events stored in a third memory; and,

storing and transmitting a signal corresponding to the determined triggering event to a receiving system.

8. (original) The method according to claim 6, further including the steps of:

determining if the one or more data elements indicate one or more predetermined triggering events, where if the determination is positive, correlating the one or more data elements to one or more types of triggering events stored in a third memory; and,

storing or transmitting a signal corresponding to the determined triggering event to a receiving system.

9. (original) The method as defined in claim 6 wherein the output data value is additionally used

for computing an insurance rating for the vehicle for a future data collection period.

10. (original) The method according to claim 6, further comprising the steps of:

using safety or other actuarial standard values as the preset values; and,

generating an adjusted insurance cost as the output data value.

11. (original) The method according to claim 10, further comprising the steps of:

using location and time as the one or more data elements which are compared to the safety or other actuarial standard values to generate the adjusted insurance cost.

12. (original) The method according to claim 11 wherein:

the adjusted insurance cost can be for a prospective or retrospective basis.

13. (original) The method according to claim 6, further comprising the steps of:

using safety or other actuarial standard values as the preset values; and,

generating an adjusted underwriting cost as the output data value.

14. (original) The method according to claim 13, further comprising the steps of:

using location and time as the one or more data elements which are compared to the safety or other actuarial standard values to generate the adjusted underwriting cost.

15. (original) The method according to claim 14 wherein:

the adjusted underwriting cost can be for a prospective or retrospective basis.

16.-69. (cancelled).

70. (new) A method of monitoring a human operator controlled power source driven vehicle, the method comprising:

extracting one or more data elements by an on-board computer from at least one sensor wherein the one or more elements are actual driving characteristics of at least one operating state of the vehicle and at least one human operator's actions during a data collection period;

analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements;

correlating the group data values to preset values related to safety standards in a second memory and generating an output data value based on the correlation; and

computing an insurance rating based upon the output data value for the vehicle for the data collection period, in which the insurance rating is also based on an actuarial class of insurance wherein said actuarial class of insurance groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic as well as represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor, and setting prospective insurance premiums based on the actuarial class of insurance.

71. - 75. (cancelled).

76. (new) The method of claim 5, wherein the surcharge or discount comprises a discount, and wherein producing the final cost of vehicle insurance comprises applying the discount to the base cost of vehicle insurance.

77. (new) The method of claim 5, wherein the surcharge or discount comprises a surcharge, and wherein producing the final cost of vehicle insurance comprises applying the surcharge to the base cost of vehicle insurance.

78. - 80. (cancelled).

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Reasons for Patentability/ConfirmationClaim 1:

This claim now requires a method of generating a database comprising data elements representative of operator or vehicle driving characteristics, the method comprising: generating actuarial classes of insurance, which group operators or vehicles having a similar risk characteristic, from actual monitored driving characteristics during a selected time period as represented by recorded data elements representative of an operating state of the vehicles or an action of the operators; and monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of an operator during a latter selected time period; and, recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the latter selected time period, said ones including, a time and location of vehicle operation and a corresponding log of vehicle speed for the time and location.

As set forth MPEP 2258, I., G, "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). See also *Phillips v. AWH Corp.*, 415 F.3d 1303, 1330-1331 (Fed. Cir. 2005) (en banc), i.e. "We have also held that extrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field."

See page 26 of the September 26, 2001 response, second full paragraph, e.g. "Support ... can be found at least in the following passages: col. 5, lines 28-46; col. 1, lines 28-30 and lines 53-56; col. 3, [sic] 45-50; col. 5, [sic] 7-11 and 28-32 and original claim 17 from parent patent application serial number: 08/592,958, now U.S. Pat. No. 5,797,134." as well as the 11/1/11 document entitled "SECOND DECLARATION UNDER RULE 1.132 OF BETH VECCHIOLI", esp. paragraph 9, and thereby paragraphs 37-39 of Beth Vecchioli's first 4-6-11 declaration, *paragraph 10*, i.e. "In the context of the '970 patent, I understood the term **'insurance actuarial class,'** which is **equivalent to the term 'actuarial class,'** to refer to a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. This understanding was explained in my April 6, 2011 declaration." (emphasis added), *paragraph 11*, i.e. "In the context of the '970 disclosure, one can think of the term actuarial class in two parts. The first part, 'a grouping of individuals or vehicles having similar risk characteristics,' reflects my conclusion that the Applicants had not sought to vary the ordinary and customary meaning of the term as used in the claims, nor deviate from the ordinary and customary meaning of the term. To avoid improperly reading limitations into the claim, my understanding reflects the ordinary and customary meaning that one of skill in the art would reach when reading the term in context of the entire patent." (emphasis added), *paragraph 12*, i.e. "One of skill in the art would also understand the second part 'based on, in whole or in part, the actual monitored characteristics of the vehicle or driver' refers to *the innovation behind the actuarial classes disclosed in the patent.* In my view, *the innovation comes from the use of actual driving data to generate the actuarial classes, the use of actual driving data to assign a specific vehicle/operator to an actuarial class,*

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or the use of actual driving data to compute an insurance rating based on an actuarial class that represents the actual driving data” (emphasis added), *paragraph 14*, i.e. “The term ‘new’ described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would, in my opinion, indicate that **the actuarial classes** are more precise because (1) **they are formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers**, and (2) *are assigned based on the demonstrated behavior of the newly monitored driver/vehicle.*” (emphasis added) and *paragraph 24*, i.e. “... As explained above, **the actual data used to determine the vehicle record files must be different from the data used to derive the claimed actuarial classes.**” (emphasis added), *paragraph 26*, i.e. “...the language ‘which group operators or vehicles having similar risk characteristics’ ...By including a definition in the claim, the definition sets a limit on how broadly one may construe the term “actuarial class” under a reasonable interpretation...limiting language that establishes an actuarial class to be groups of operators or vehicles having a similar risk characteristic.” and *paragraph 27*, i.e. “In my previous declaration, I explained that an insurance actuarial class is a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. My understanding of the term ‘actuarial class’ is equivalent to the term ‘insurance actuarial class’ and ‘actuarial class of insurance’ as these terms are used interchangeably in the insurance industry.” Note also *paragraphs 1-8* of such document with regard to the expertise of Beth Vecchioli in the pertinent field of insurance.

Claim 1 as amended is therefore now interpreted to require generating “actuarial classes of insurance” (note again *paragraphs 9-12 and 27* of the second declaration, i.e. groupings of

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individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver), which group operators or vehicles having a similar risk characteristic, from actual monitored driving characteristics during a selected time period as represented by recorded data elements representative of an operating state of the vehicles or an action of the operators; (note again the second declaration at *paragraph 26* as well as *paragraph 12*, i.e. “One of skill in the art would also understand the second part ‘based on, in whole or in part, the actual monitored characteristics of the vehicle or driver’ refers to *the innovation behind the actuarial classes disclosed in the patent*. In my view, *the innovation comes from the use of actual driving data to generate the actuarial classes,...*” (emphasis added), and *paragraph 14*, i.e. “The term ‘new’ described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would, in my opinion, indicate that **the actuarial classes** are more precise because (1) **they are formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers,...**” (emphasis added)). Claim 1 is also interpreted to require and monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of an operator during a latter selected time period and recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the latter selected time period, said ones including, a time and location of vehicle operation and a corresponding log of vehicle speed for the time and location (note again the second declaration at *paragraph 12*, i.e. “One of skill in the art would also understand the second part ‘based on, in whole or in part, the actual monitored characteristics of the vehicle or driver’ refers to *the innovation behind the actuarial classes disclosed in the patent*. In my view, *the*

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innovation comes from ... the use of actual driving data to assign a specific vehicle/operator to an actuarial class, or the use of actual driving data to compute an insurance rating based on an actuarial class that represents the actual driving data" (emphasis added), *paragraph 14*, i.e.

"The term 'new' described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would, in my opinion, indicate that **the actuarial classes** are more precise because ... *are assigned based on the demonstrated behavior of the newly monitored driver/vehicle.*" (emphasis added) and *paragraph 24*, i.e. "As explained above, **the actual data used to determine the vehicle record files must be different from the data used to derive the claimed actuarial classes.**" (emphasis added)).

Turning to Bouchard '079 with regard to claim 1. Note the cited portions of the second declaration discussed supra as well as *paragraphs 21- 25*, especially *paragraph 24* "...the 'customized' or 'personalized' ERA described in the Bouchard system is not equivalent to the claimed 'actuarial class' recited in the pending claims. As explained above, **the actual data used to determine the vehicle record files must be different from the data used to derive the claimed actuarial classes.**" (emphasis added). While Bouchard '079 teaches monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of an operator during a selected time period and recording selected ones of the plurality of data elements into a database when said ones are determined to be appropriate for recording relative to determining driver fitness during the selected time period and using the data elements as well as personal or other standards to classify the driver's fitness to a class, see '079 at, e.g., col. 5, lines 20-25, col. 6, lines 16-23, the paragraph bridging cols. 9-10, col. 29, line 65-col. 31, line 43, col. 32, lines 39-47 and claims 1 and 7, it does not teach generating "actuarial classes of

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insurance" (note again paragraphs 9-12 and 27 of the second declaration, i.e. groupings of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver), which group operators or vehicles having a similar risk characteristic, from actual monitored driving characteristics during a selected time period as represented by recorded data elements representative of an operating state of the vehicles or an action of the operators (i.e. "actuarial classes" formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers) and monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of an operator during a latter selected time period (i.e. demonstrated behavior of the newly monitored driver/vehicle) and recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the latter selected time period (i.e. does not teach the actual data of demonstrated behavior of the newly monitored driver/vehicle used to generate the database and determine insurance costs for such monitored operator/vehicle for the latter selected period which actual data is different from the actual data of behaviors of other vehicles/drivers used to derive the claimed "actuarial classes"). Kosaka '868 and Black Magic also do not provide such teachings, see, e.g., English translation of '868 page 6 or 426, col. 1, last full paragraph.

Therefore, the prior art does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 of claim 1.

Claim 3:

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For at least the reasons discussed with regard to claim 1, the prior art also does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 with regard to claim 3 which depends therefrom.

Claims 4 and 5:

Claim 4 now requires a method of insuring a vehicle operator for a selected period based upon operator driving characteristics during the period, comprising, steps of: generating an initial operator profile; generating an *insured* profile for the vehicle operator prior to any monitoring of any of the vehicle operator's driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator; monitoring the vehicle operator's driving characteristics during the selected period; and deciding a total cost of vehicle insurance for the selected period based upon the vehicle operator's driving characteristics monitored in that selected period and the base cost of insurance. Claim 5 now requires a method of determining a cost of vehicle insurance for a selected period based upon monitoring, recording and communicating data representative of operator and vehicle driving characteristics during said period, whereby the cost is adjustable by relating the driving characteristics to predetermined safety standards that are related to a safe operation of a vehicle, the method comprising: determining an *initial insured* profile for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator of the vehicle and determining a base cost of the vehicle insurance based on said *initial insured* profile wherein the *initial insured* profile comprises coverage information,

including limits and deductibles; monitoring a plurality of the data elements representative of the operating state of the vehicle or the action of the operator of the vehicle during the selected period; recording selected ones of the plurality of data elements when said ones are determined to have a preselected relationship to the safety standards; consolidating said selected ones for identifying a surcharge or discount to be applied to the base cost; and, producing a final cost of vehicle insurance for the selected period from the base cost and the surcharge or discount.

See page 26 of the September 26, 2001 response, first full paragraph, e.g. "Support...may be found in the '970 Patent at col. 10, lines 30-49 and col. 3, line 67-col. 4, line 10" as well as MPEP 2258 supra.

Turning to Kosaka JP '868 with regard to these claims. While Kosaka '868 teaches a monetary amount file/stored initially paid insurance premium and/or "the insurance agreement", see March 7, 2011 Office Action, '868 does not clearly and explicitly teach generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicle operator's driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator and deciding a total cost of vehicle insurance for the selected period based upon the vehicle operator's driving characteristics monitored in that selected period and the base cost of insurance nor determining an initial insured profile for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator of the vehicle and determining a base cost of the vehicle insurance based on said initial insured profile wherein the initial insured profile comprises coverage information, including limits and deductibles and producing a final cost of vehicle insurance for

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the selected period from the base cost and a surcharge or discount, respectively, in combination with the other methodology set forth in claims 4 and 5. The prior art to Bouchard '079 and Black Magic also do not teach such insured profile determination/generation and vehicle insurance base cost determination based thereon.

Therefore, the prior art does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 of claims 4 and 5.

Claims 76-77:

For at least the reasons discussed with regard to claim 5, the prior art also does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 with regard to each of claims 76-77 which depend therefrom.

Claims 6 and 70:

Claim 6 now requires a method of monitoring a human operator controlled power source driven vehicle, the method comprising: extracting one or more data elements by a computer programmed to monitor sensor data from at least one sensor wherein the one or more elements are actual driving characteristics of at least one operating state of the vehicle and at least one human operator's actions during a data collection period; analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements; and, correlating the group data values to preset values in a second memory and generating an output data value based on the correlation wherein the output data value is used to compute an insurance rating for the vehicle for the data collection period that is based

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on an actuarial class of insurance which groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic and which also represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor. Claim 70 similarly requires a method of monitoring a human operator controlled power source driven vehicle, the method comprising: extracting one or more data elements by an on-board computer from at least one sensor wherein the one or more elements are actual driving characteristics of at least one operating state of the vehicle and at least one human operator's actions during a data collection period; analyzing, grouping, and storing the one or more data elements as group data values in a first memory related to a predetermined group of elements; correlating the group data values to preset values related to safety standards in a second memory and generating an output data value based on the correlation; and computing an insurance rating based upon the output data value for the vehicle for the data collection period, in which the insurance rating is also based on an actuarial class of insurance wherein said actuarial class of insurance groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic as well as represents the actual driving characteristics of the vehicle monitored and recorded from the at least one sensor, and setting prospective insurance premiums based on the actuarial class of insurance.

See the discussion of claim 1 supra (attention is esp. reinvited to *paragraph 10*, i.e. "In the context of the '970 patent, I understood the term 'insurance actuarial class,' which is equivalent to the term 'actuarial class,' to refer to a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. This understanding was explained in my April 6, 2011 declaration."

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(emphasis added), *paragraph 11*, i.e. “In the context of the '970 disclosure, one can think of the term actuarial class in two parts. The first part, ‘a grouping of individuals or vehicles having similar risk characteristics,’ reflects my conclusion that the Applicants had not sought to vary the ordinary and customary meaning of the term as used in the claims, nor deviate from the ordinary and customary meaning of the term. To avoid improperly reading limitations into the claim, my understanding reflects the ordinary and customary meaning that one of skill in the art would reach when reading the term in context of the entire patent.” (emphasis added), *paragraph 12*, i.e. “One of skill in the art would also understand the second part ‘based on, in whole or in part, the actual monitored characteristics of the vehicle or driver’ refers to *the innovation behind the actuarial classes disclosed in the patent*. In my view, *the innovation comes from the use of actual driving data to generate the actuarial classes, the use of actual driving data to assign a specific vehicle/operator to an actuarial class, or the use of actual driving data to compute an insurance rating based on an actuarial class that represents the actual driving data*” (emphasis added), *paragraph 14*, i.e. “The term ‘new’ described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would, in my opinion, indicate that the actuarial classes are more precise because (1) they are formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers, and (2) are assigned based on the demonstrated behavior of the *newly monitored driver/vehicle*.” (emphasis added), *paragraph 24*, i.e. “... As explained above, the actual data used to determine the vehicle record files must be different from the data used to derive the claimed actuarial classes.” (emphasis added), *paragraph 26*, i.e. “...the language ‘which group operators or vehicles having similar risk’ ...By including a definition in the claim, the definition sets a limit on how broadly one may construe

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the term "actuarial class" under a reasonable interpretation...limiting language that establishes an actuarial class to be groups of operators or vehicles having a similar risk characteristic." and *paragraph 27*, i.e. "In my previous declaration, I explained that an insurance actuarial class is a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. My understanding of the term 'actuarial class' is equivalent to the term 'insurance actuarial class' and 'actuarial class of insurance' as these terms are used interchangeably in the insurance industry.") as well as the discussion of the prior art to Bouchard '079, Kosaka '868 and Black Magic.

Therefore while Bouchard '079 teaches monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of an operator during a selected time period and recording selected ones of the plurality of data elements into a memory when said ones are determined to be appropriate for recording relative to determining driver fitness during the selected time period and using such data elements as well as personal or other standards to classify the driver's fitness to one of four classes, see '079 at, e.g. col. 5, lines 20-25, col.6, lines 16-23, the paragraph bridging cols. 9-10, col. 29, line 65-col. 31, line 43, 39-47 and claims 1 and 7, it does not teach generating an output data value based on the correlation wherein the output data value is used to compute an insurance rating for the vehicle for the data collection period that is based on "an actuarial class of insurance" (note again *paragraphs 9-12 and 27* of the second declaration, i.e. groupings of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver), which groups other human operator controlled power source driven vehicles having a similar operator or vehicle risk characteristic and which also represents the actual driving characteristics of the

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vehicle monitored and recorded from the at least one sensor (i.e. does not teach "actuarial classes" formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers which classes also represent demonstrated behavior of the newly monitored driver/vehicle, see again *paragraphs 12,14 and 24* of the second declaration discussed supra. Kosaka '868 and Black Magic again do not provide such teachings, see, e.g., English translation of '868 page 6 or 426, col. 1, last full paragraph.

Accordingly the prior art does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 of claims 6 and 70.

Claims 7-15:

For at least the reasons discussed with regard to claim 6, the prior art also does not provide the teachings to sustain a rejection under 35 USC 102 nor 35 USC 103 with regard to each of claims 7-15 which depend therefrom.

Other Matters

IDS Submissions

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

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Accordingly, the IDS submission have been considered by the Examiner only with the scope required by MPEP 2256.

Correspondence

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
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

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

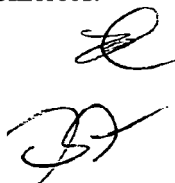
Other useful telephone numbers:

Reexamination Practice (571) 272-7703

Reexamination Facsimile Transmission No. (571) 273-9900

/Karin M. Reichle/
Examiner, CRU
Art Unit 3992

Conferees:



| | | |
|---|----------------------------------|--|
| Ex Parte Reexamination Interview Summary | Control No. 90/011,252 | Patent Under Reexamination 6,064,970 |
| | Examiner KARIN REICHLE | Art Unit 3992 |

All participants (USPTO personnel, patent owner, patent owner's representative):

- | | |
|--|--------------------------|
| (1) <u>KARIN REICHLE, Fred Ferris, Zoila Cabrera</u> | (3) <u>Raymond Ling</u> |
| (2) <u>James Collins</u> | (4) <u>Joseph Hanasz</u> |

Date of Interview: 11/4/11 & 11/8/11

Type: a) Telephonic b) Video Conference
c) Personal (copy given to: 1) patent owner 2) patent owner's representative)

Exhibit shown or demonstration conducted: d) Yes e) No.
If Yes, brief description: Second declaration of Beth Vecchiola

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: 1-80.

Identification of prior art discussed: Bouchard '079.

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNER'S STATEMENT CAN NOT BE WAIVED. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

/Karin M. Reichle/
Primary Examiner, Art Unit 3992

cc: Requester (if third party requester)

Continuation of Description of the general nature of what was agreed to if an agreement was reached, or any other comments: The issues and amendments set forth in the 11-1-11 submission entitled "BRIEF OUTLINE FOR INTERVIEW" and "SECOND DECLARATION UNDER RULE 1.132 OF BETH VECCHIOLA" were discussed. The interpretation of the term "actuarial insurance class", paragraphs 10-20 of the declaration, was especially discussed with regard to claims 1, 6 and 70. In order to allow the Examiners to consider the claims in light of such discussion and, if necessary, draft claim language it was agreed to reconvene on 11/8/11. On 11/8/11 an Examiner's amendment, see accompanying Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC), was proposed and authorized. See also reasons for patentability/confirmation accompanying NIRC.

Receipt date: 11/08/2011

| | | |
|--|---|--------------------------|
| FORM PTO-1449 | SERIAL NO. 90/011,252 | CASE NO. 12741-32 |
| LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT <small>(use several sheets if necessary)</small> | FILING DATE September 22, 2010 | GROUP ART UNIT 3992 |
| | APPLICANT(S): Robert John McMillan et al. | |
| | | CONFIRMATION NO. 4116 |

REFERENCE DESIGNATION U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | NAME | CLASS/ SUBCLASS | FILING DATE |
|---------------------|--|------|------|--------------------|----------------|
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FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | COUNTRY | CLASS/ SUBCLASS | TRANSLATION YES OR NO |
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OTHER ART – NON PATENT LITERATURE DOCUMENTS

| EXAMINER INITIAL | <small>(Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.</small> | |
|---------------------|---|--|
| E1 | "1988 Automobile Insurance Shoppers' Guide," Florida Department of Insurance, 1988, 20 pages. | |
| E2 | "1992 Ohio Shoppers' Guide to Auto Insurance," The Ohio Department of Insurance, 1992, 24 pages. | |
| E3 | "1995 Consumers Guide on Automobile Insurance (Downstate)," New York State Insurance Department, 1995, 66 pages. | |
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|-----------------------------|-------------------------------|
| EXAMINER /Karin Reichle/ | DATE CONSIDERED 11/09/2011 |
|-----------------------------|-------------------------------|

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /KR/

| | | |
|--|--|---|
| Issue Classification  | Application/Control No. 90/011,252 | Applicant(s)/Patent under Reexamination 6,064,970 |
| | Examiner KARIN REICHLER | Art Unit 3992 |

| ISSUE CLASSIFICATION | | | | | | | | | | |
|----------------------|-----------------------------------|----------|--|--|------------------------------|--|---|-------------|--|---|
| ORIGINAL | | | | | INTERNATIONAL CLASSIFICATION | | | | | |
| CLASS | | SUBCLASS | | | CLAIMED | | | NON-CLAIMED | | |
| 705 | | 4 | | | G 0 5 47 / 60 | | | | | |
| CROSS REFERENCES | | | | | G 0 6 9 40 / 00 | | | | | |
| CLASS | SUBCLASS (ONE SUBCLASS PER BLOCK) | | | | | | | | | |
| 340 | 439 | 870.01 | | | | | / | | | / |
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| (Assistant Examiner) (Date) <i>K. Reichle</i> 11/10/11 (Legal Instruments Examiner) (Date) | /Karin Reichle/ 11/9/11 (Primary Examiner) (Date) | Total Claims Allowed: 17 |
| | | O.G. Print Claim(s) 1 |
| | | O.G. Print Fig. 2 |

| <input type="checkbox"/> Claims renumbered in the same order as presented by applicant | | <input type="checkbox"/> CPA | | <input type="checkbox"/> T.D. | | <input type="checkbox"/> R.1.47 | |
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| Final | Original | Final | Original | Final | Original | Final | Original |
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BIB DATA SHEET

CONFIRMATION NO. 4116

| | | | | | |
|--|--|-------------------------|---|--|--------------------------------|
| SERIAL NUMBER 90/011,252 | FILING or 371(c) DATE 09/22/2010 | CLASS 705 | GROUP ART UNIT 3992 | ATTORNEY DOCKET NO. 12741-32 | |
| APPLICANTS 6,064,970, Residence Not Provided; PROGRESSIVE CASUALTY INSURANCE COMPANY (OWNER), MAYFIELD VILLAGE, OH; ROPES & GRAY LLP (3RD.PTY.REQ.), BOSTON, MA; ROPES & GRAY LLP, BOSTON, MA | | | | | |
| ** CONTINUING DATA ***** This application is a REX of 09/135,034 08/17/1998 PAT 6,064,970 which is a CON of 08/592,958 01/29/1996 PAT 5,797,134 | | | | | |
| ** FOREIGN APPLICATIONS ***** ** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** | | | | | |
| Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No 35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No Verified and Acknowledged <u>/KARIN M REICHL/</u> <small>Examiner's Signature</small> | <input type="checkbox"/> Met after Allowance Initials _____ | STATE OR COUNTRY | SHEETS DRAWINGS | TOTAL CLAIMS 15 | INDEPENDENT CLAIMS 5 |
| ADDRESS Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 UNITED STATES | | | | | |
| TITLE MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE | | | | | |
| FILING FEE RECEIVED 2520 | FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following: | | <input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit | | |

| | | |
|---|-------------------------|---|
| Reexamination  | Application/Control No. | Applicant(s)/Patent Under Reexamination |
| | 90/011,252 | 6,064,970 |
| | Certificate Date | Certificate Number |
| | | C1 |

| | | | |
|---|--------------------------------|---------------------------------------|---|
| Requester | Correspondence Address: | <input type="checkbox"/> Patent Owner | <input checked="" type="checkbox"/> Third Party |
| <p>ROPES & GRAY LLP PATENT DOCKETING 39/41 ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624</p> | | | |

| | | |
|---|----------------------------|--------------------------------|
| LITIGATION REVIEW <input checked="" type="checkbox"/> | KMR (examiner initials) | 11/8/11 (date) |
| Case Name | | Director Initials |
| Closed (Stayed): Progressive Casualty Ins. Co. v. Safeco Ins. Co. of Ill., et al., 1:10-cv-01370 (N. D. Ohio) CLOSED | | <i>[Handwritten Signature]</i> |
| Open: Progressive Casualty Ins. Co. v. Allstate Ins. Co. of Ill., et. al., 1:11-cv-00082 (N. D. Ohio) OPEN | | <i>[Handwritten Signature]</i> |
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| COPENDING OFFICE PROCEEDINGS | |
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| TYPE OF PROCEEDING | NUMBER |
| 1. NONE | |
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| FORM PTO-1449 | SERIAL NO. 90/011,252 | CASE NO. 12741-32 |
| LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT | FILING DATE September 22, 2010 | GROUP ART UNIT 3992 |
| (use several sheets if necessary) | APPLICANT(S): Robert John McMillan et al. | CONFIRMATION NO. 4116 |

REFERENCE DESIGNATION U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | NAME | CLASS/SUBCLASS | FILING DATE |
|------------------|---|------|------|----------------|-------------|
| | | | | | |

FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | COUNTRY | CLASS/SUBCLASS | TRANSLATION YES OR NO |
|------------------|---|------|---------|----------------|-----------------------|
| | | | | | |

OTHER ART – NON PATENT LITERATURE DOCUMENTS

| EXAMINER INITIAL | <small>(Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.</small> | |
|------------------|---|--|
| E1 | "1988 Automobile Insurance Shoppers' Guide," Florida Department of Insurance, 1988, 20 pages. | |
| E2 | "1992 Ohio Shoppers' Guide to Auto Insurance," The Ohio Department of Insurance, 1992, 24 pages. | |
| E3 | "1995 Consumers Guide on Automobile Insurance (Downstate)," New York State Insurance Department, 1995, 66 pages. | |
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| EXAMINER | DATE CONSIDERED |
|----------|-----------------|

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: November 8, 2011 Name: James A. Collins Signature: /James A. Collins/

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& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Ex Parte Robert John McMillan et al.
Reexam of:

Reexam Appln. 90/011,252
No.:

Filed: September 22, 2010

For: MOTOR VEHICLE MONITORING SYSTEM
FOR DETERMINING A COST OF INSURANCE

Attorney Docket No.: 12741-32

Examiner: Karin M. Reichle

Art Unit: 3992

Conf. No.: 4116

CERTIFICATE OF SERVICE

Mail Stop Ex Parte Reexam
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that a true copy of the foregoing **FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT** was served this November 8, 2011 by First Class United States Mail, postage prepaid, on:

J. Steven Baughman
Ropes & Gray LLP
Prudential Tower
800 Boylston Street
Boston, MA 02199

Respectfully submitted,

November 8, 2011

Date

/James A. Collins/

James A. Collins (Reg. No. 43,557)

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HOFER
GILSON
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BRINKS HOFER GILSON & LIONE
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

Electronic Acknowledgement Receipt

| | |
|---|---|
| EFS ID: | 11360217 |
| Application Number: | 90011252 |
| International Application Number: | |
| Confirmation Number: | 4116 |
| Title of Invention: | MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE |
| First Named Inventor/Applicant Name: | 6,064,970 |
| Customer Number: | 10999 |
| Filer: | James A. Collins/Masoud Naseri |
| Filer Authorized By: | James A. Collins |
| Attorney Docket Number: | 12741-32 |
| Receipt Date: | 08-NOV-2011 |
| Filing Date: | 22-SEP-2010 |
| Time Stamp: | 15:21:52 |
| Application Type: | Reexam (Patent Owner) |

Payment information:

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File Listing:

| Document Number | Document Description | File Name | File Size(Bytes)/ Message Digest | Multi Part /.zip | Pages (if appl.) |
|-----------------|----------------------|---------------------------|--|------------------|------------------|
| 1 | | 12741-32_4th_Supp_IDS.pdf | 142287 e83397aee1f649aa11076f9536b44d6531c bd7b0 | yes | 5 |

| Multipart Description/PDF files in .zip description | | | |
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| Document Description | Start | End | |
| Miscellaneous Incoming Letter | 1 | 1 | |
| Transmittal Letter | 2 | 3 | |
| Information Disclosure Statement (IDS) Form (SB08) | 4 | 4 | |
| Reexam Certificate of Service | 5 | 5 | |

Warnings:

Information:

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|---|-----------------------|--|--|----|----|
| 2 | Non Patent Literature | 1988_automobile_insurance_shoppers_guide.PDF | 4415471 ed560e883bd94a68f5bfa2d3ebcd02197ab7d8b | no | 20 |
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Warnings:

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| 3 | Non Patent Literature | 1992_ohio_shoppers_guide_to_auto_insurance.PDF | 2658316 3ad68ace52deadfeab10fa43a48d3db280f551e | no | 24 |
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| 4 | Non Patent Literature | 1995_consumers_guide_on_automobile_insurance.PDF | 3166864 34745afdadcb9f7dd53b406729569db5cd052a2d | no | 66 |
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: November 8, 2011 Name: James A. Collins Signature: /James A. Collins/

**BRINKS
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GILSON
& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Ex Parte Robert John McMillan et al.
 Reexam of:
 Reexam Appln. 90/011,252
 No.:
 Filed: September 22, 2010
 For: MOTOR VEHICLE MONITORING SYSTEM
 FOR DETERMINING A COST OF INSURANCE
 Attorney Docket No.: 12741-32

Examiner: Karin M. Reichle
 Art Unit: 3992
 Conf. No.: 4116

TRANSMITTAL

Mail Stop Ex Parte Reexam
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

Sir:

Attached is/are:

- Transmittal (1 pg); Fourth Supplemental Information Disclosure Statement (2 pgs); Form PTO 1449 (1 pg); copies of Three Non Patent Literature References (E1-E3); and Certificate of Service (1 pg).

Fee calculation:

- No additional fee is required.
- Small Entity.
- An extension fee in an amount of \$_____ for a ____- month extension of time under 37 CFR § 1.136(a).
- A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(p).
- An additional filing fee has been calculated as shown below:

| | | | | | Small Entity | | Not a Small Entity | | |
|---|----------------------------------|-------|---------------------------------|---------------|--------------|-----------|--------------------|----------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | OR | Rate | Add'l Fee |
| Total | | Minus | | | x \$26= | | | x \$52= | |
| Indep. | | Minus | | | x 110= | | | x \$220= | |
| First Presentation of Multiple Dep. Claim | | | | | | | | | |
| | | | | | +\$195= | | | +\$390= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

- Please charge Deposit Account No. 23-1925 in the amount of \$_____ for _____.
- Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

November 8, 2011
 Date

/James A. Collins/
 James A. Collins (Reg. No. 43,557)

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HOFER
GILSON
& LIONE**

BRINKS HOFER GILSON & LIONE
 NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

I hereby certify that this correspondence is being Electronically Transmitted on the date noted below to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
November 8, 2011

Date of Deposit
James A. Collins

Name of applicant, assignee or
Registered Representative
/James A. Collins/

Signature
November 8, 2011
Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Ex Parte Robert John McMillan et al.
Reexamination
of:

Reexamination 90/011,252
Appln. No.:

Filed: September 22, 2010

For: MOTOR VEHICLE
MONITORING SYSTEM FOR
DETERMINING A COST OF
INSURANCE

Attorney Docket No: 12741-32

Examiner: Karin M. Reichle

Art Unit: 3992

Confirmation No.: 4116

FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Ex Parte Reexam
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

In accordance with the duty of disclosure under 37 CFR §1.555, Patent Owner submits the references that were received yesterday (November 7, 2011) afternoon.

The references are listed on the enclosed Form PTO-1449, copies of which are being submitted with this filing. Patent Owner respectfully requests the Examiner's consideration of the submitted references and entry thereof into the record of this reexamination.

BRINKS
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This Information Disclosure Statement supplements any references already considered by the Office in this reexamination or during the prosecution of U.S. Patent No. 6,064,970. By submitting this Statement, Patent Owner is attempting to fully comply with the duty of candor and good faith mandated by 37 CFR §1.555, and the requirements of 37 CFR §1.98. This Statement is not intended to constitute an admission that any of the enclosed references, or other information referred to therein, constitutes "prior art" or is otherwise "material to patentability," as that phrase is defined in 37 CFR §1.555(b). Patent Owner reserves the right to file supplemental IDS(s) if additional references are found.

Patent Owner also respectfully requests the Office to review the claims and the prosecution history, including any Office Actions issued by the U.S. Patent and Trademark Office and any responses filed by Patent Owner, for Serial No. 08/592,958 (now U.S. Pat. No. 5,797,134), Serial No. 09/571,650 (now U.S. Pat. No. 6,868,386), Serial No. 10/764,076, Serial No. 11/868,827, and Serial No. 12/132,487.

Patent Owner has calculated no fee due upon filing this Information Disclosure Statement. However, the Director is authorized to charge any fee deficiency associated with the filing of this Information Disclosure Statement to a deposit account, as authorized in the accompanying Transmittal.

Respectfully submitted,

November 8, 2011

 Date

/James A. Collins/

 James A. Collins
 (Reg. No. 43,557)



I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR § 1.8.

EX PARTE REEXAM

/James A. Collins/

James A. Collins, Reg. No. 43,557

November 1, 2011

Date of Signature & Date of Transmission

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CENTRAL REEXAMINATION UNIT

| | | |
|---|---|------------------------------|
| <i>Ex parte</i> Reexamination of | : | |
| U.S. Patent No. 6,064,970 | : | |
| Robert J. McMillan, et al. | : | Confirmation No. 4116 |
| Control No. 90/011,252 | : | Examiner: Karin M. Reichle |
| Filing Date: August 17, 1998 | : | Group Art Unit: 3992 |
| For: MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE | : | Attorney Docket No. 12741-32 |

BRIEF OUTLINE FOR INTERVIEW

Dear Examiner:

- I. Introduction
 - a. The pending claims relate to systems and methods for generating actuarial classes, computing insurance ratings, and determining insurance costs.
 - b. The independent claims describe different features of a new actuarial assessment process. For example, in claim 1, actuarial classes of insurance are generated from actual driving characteristics. Claim 6 uses an actuarial class which represents actual driving characteristics to compute an insurance rating for a monitored vehicle.
 - c. The claimed actuarial classes described in claim 1 and 6 group operators or vehicles having a similar risk characteristic.
 - d. The current Advisory Action indicates that the claim language “which group operators or vehicles having a similar risk characteristic” is (1) redundant, (2) not required, and/or (3) inconsistent with other portions of the record. Each of these three concerns is addressed below with respect to the language of claim 6.

II. Claim 6

- a. First, the Advisory Action states that the claim language “which groups operators or vehicles having a similar risk characteristic” is redundant with the other claim language. *See* Advisory Action at page 4.
 - i. The Non-final Office Action mailed on March 7, 2011 defines an “actuarial class” “as being a combination/group/groupings related to loss/risk/safety which are determined from classifications/characteristics representative of motor vehicle operational characteristics and driver behavior for which data is gathered.” *See* Non-final OA at pages 188-189. The current Advisory Action provided a different construction of “actuarial class” as being “specific to the driver and/or vehicle for each period due to the generation/derivation from actual data for that period.”
 - ii. In view of the multiple different constructions, Patent Owner has amended the claims to clarify and define that an “actuarial class” in the context of the claims is something “which groups operators or vehicles having a similar risk characteristic.” Thus, Patent Owner does not believe the proposed amendment is redundant.
- b. Second, the Advisory Action indicates that the claim language “which groups operators or vehicles having a similar risk characteristic” does not require the actuarial classes to actually include a group of operators and/or vehicles. *See* Advisory Action at page 4.
 - i. The Advisory Action focuses on the language “that would be placed.” However, that language is only found in the remarks section of Patent Owner’s last response. It is not recited in the proposed claims.
 - ii. The cited language from the remarks section of Patent Owner’s last response could be written as follows to clarify the Patent Owner’s position: the specification teaches that an actuarial class is a grouping of vehicles/drivers (col. 1, lines 28-30), where a specific vehicle/driver is placed into that group based on having a similar risk characteristic as the other vehicles/drivers that have already been placed into that group.
 - iii. Furthermore, even under the Advisory Action’s interpretation on this issue, Patent Owner does not believe that the cited reference teaches or suggests the claimed subject matter. The Advisory Action cites to Bouchard at col. 29, lines 18-24 for the claimed actuarial class. *See* Advisory Action at page 4. The cited portion of Bouchard discloses a RAM card that stores driver preferences. When the RAM card is plugged into a vehicle, the vehicle’s control system can use the preference information stored on the RAM card to customize or personalize the operational characteristics of the vehicle. This customization of a vehicle to a specific driver’s preferences does not compute an insurance rating for the vehicle based on an actuarial class of insurance which represents actual driving characteristics (in fact, Bouchard does not disclose any insurance-related details), and does not have the capability to group operators or vehicles having a similar

risk characteristic. (See Second Declaration of Beth Vecchioli, ¶21-¶25). If an actuarial class includes more than one driver or vehicle, then would that difference, if recited in the claim, distinguish the claim over the Bouchard reference?

iv. To advance prosecution, would the following amendment eliminate this concern?

1. “correlating the group data values to preset values in a second memory and generating an output data value based on the correlation wherein the output data value is used to compute an insurance rating for the vehicle that is based on an actuarial class of insurance, [which groups] comprising a group of operators or vehicles having a similar risk characteristic and which represents actual driving characteristics of the vehicle monitored and recorded from the at least one sensor, for the data collection period”

c. Third, the Advisory Action indicates that the claim language “which groups operators or vehicles having a similar risk characteristic” is inconsistent with portions of the record. Specifically, the Advisory Action finds that some portions of the record suggest that the actuarial classes are “specific to the driver and/or vehicle for each period due to the generation/derivation from actual data for that period.”

i. Preliminary Questions

1. If it is shown that not all embodiments of the original disclosure limit the term “actuarial class” to be “specific to the driver and/or vehicle for each period due to the generation/derivation from actual data for that period,” then would you agree that there is original disclosure support for an actuarial class that includes more than one driver and/or vehicle? (See Second Declaration of Beth Vecchioli, ¶10-¶18)
2. In view of the current Advisory Action’s interpretation of actuarial class (“specific to the driver and/or vehicle for each period due to the generation/derivation from actual data for that period”) and the prior interpretation provided in the March 7, 2011 Non-final Office Action at pages 188-89 (“a combination/group/groupings related to loss/risk/safety which are determined from classifications/characteristics representative of motor vehicle operational characteristics and driver behavior for which data is gathered”), is there an “express definition” of the term actuarial class provided in the specification? If there is no expressly stated definition, then should the construction given to the term “actuarial class” ignore the interpretive guidance given to the term by its ordinary usage?
3. Do you agree that absent an expressed definition in the specification of the term “actuarial class,” the fact that one party can point to portions of the written description in support of their opinion does not make the other parties’ interpretation unreasonable when the other party can point to the written description, usages, understandings of persons skilled in the art and definitions to support their interpretation?

4. Are the citations and evidence provided by Beth Vecchioli and the prosecution record in this reexamination proceeding persuasive? What additional evidence would strengthen the support and opinion illustrating how those skilled in the art understand the use of the term?
- ii. The Advisory Action refers to the actuarial classes described at column 4, lines 27-57 of the specification to support its position. How does this specification passage preclude the Patent Owner's clarifying amendment for actuarial classes? (See Second Declaration of Beth Vecchioli, ¶14-¶17)
1. The term "new" described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would indicate that the actuarial classes are more precise because (1) they are formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers, and (2) are assigned based on the demonstrated behavior of the newly monitored driver/vehicle. (See Second Declaration of Beth Vecchioli, ¶14)
 2. The new actuarial classes described in the specification are based on monitored driving data that groups vehicles/drivers sharing similar characteristics. The "total driving time in minutes" of each driver of an insured vehicle at col. 4, lines 33-34 that is monitored, for example, will be assigned to a total drive time class. A person skilled in the art would understand how usage based classes are formed according to the analysis of the same type of data monitored from other drivers/vehicles that share similar characteristics. *See* col. 5, lines 7-11. The "total driving time" is divided into groups known as actuarial classes based on other drivers'/vehicles' previously monitored data. Thus, if an insured vehicle is driven a certain number of minutes, it will be assigned to a total drive time class, developed from previously monitored drivers/vehicles, based on the newly monitored behavior demonstrated by the driver/vehicle. (See Second Declaration of Beth Vecchioli, ¶16)
 3. Another actuarial class described in the specification is based on the location of where a vehicle is parked at night at col. 4, line 48-49. Vehicles may be parked in a garage, in a driveway, or on the street as explained in the specification. Through navigation signals obtained from a GPS (global positioning system) antenna or other locating system, a vehicle may be assigned to a location class based on the actual data monitored from the driver/vehicle. Thus, if a locating system in a vehicle indicates that a vehicle is parked on a street, the vehicle will be assigned to an actuarial class based on the driver's own monitored data. The location classes are formed from vehicle provided data previously monitored from other drivers/vehicles. (See Second Declaration of Beth Vecchioli, ¶17)
- iii. The Advisory Action refers to original claims 17 and 20 to support its position. How do these claims preclude the Patent Owner's clarifying amendment for actuarial classes?

1. In original claims 17 and 20 of U.S. Application 08/592,958, the processing of selected data with selected actuarial classes determines a cost of insurance. If the selected data were the same data used to generate the actuarial classes, the claimed association/consolidation would be an association/consolidation of the data to itself. One can think of the data used to generate the actuarial classes as being the same type of data generated from multiple vehicles/drivers, but not necessarily the same data from a single vehicle/driver because the association/consolidation of the data produces a cost of insurance in original claim 17/20 of U.S. Application 08/592,958.
 2. (See Second Declaration of Beth Vecchioli, ¶19)
- iv. The Advisory Action refers to the 9-26-97 Interview Summary record from the '958 parent application to support its position. How does this Interview Summary preclude the Patent Owner's clarifying amendment for actuarial classes?
1. The cited interview summary states "[i]t was agreed that [in] Claim 17, the data element to be used to determine the actuarial classes are of [the] same type as the raw selected data used to generate a vehicle record file." This language makes clear that the data used to determine the actuarial classes in original claim 17 is of the same type as the data in the vehicle record file, not necessarily the same exact data as the data in the vehicle record file.
- v. The Advisory Action refers to the remarks on page 2 of the 1/12/98 proposed amendment from the '958 parent application to support its position. How do these remarks preclude the Patent Owner's clarifying amendment for actuarial classes?
1. It is unclear what portion of this document is used by the Advisory Action, but it is believed the Advisory Action has targeted the passage stating: "Applicants teach continuous monitoring and also adjustment for generating a fine tuned operator profile and associated insurance (usage) rate that can be tailored and personalized to the operator for a more accurate and fair result."
 2. This passage does not suggest a "fine tuned" or "tailored and personalized" actuarial class system for a specific vehicle/driver, as implied by the Advisory Action. Rather, this passage concerns the collection of actual driving data into a "fine tuned" operator profile and determining an insurance rate that can be "tailored and personalized" according to the monitored data. Therefore, this passage does not address the contested term "actuarial class."
- vi. The Advisory Action refers to the remarks on pages 5-6 of the 7-19-99 response from the '034 application to support its position. How do these remarks preclude the Patent Owner's clarifying amendment for actuarial classes?
1. It is unclear what portion of this document is used by the Advisory Action, but it is believed the Advisory Action has targeted the passage stating: "[a]s noted by the Examiner in the

parent application, the prior art ‘fails to disclose a method of generating an actuarial class system for determining vehicle costs for adjusting premiums for an insurance period of time based on data derived from motor vehicle operations characteristics and driver behavior during said insurance period of time...’”

2. This passage mentions generating an actuarial class system, but does not explain how (or on what data) the actuarial classes are generated. The portion of the passage that recites “based on data derived from motor vehicle operations characteristics and driver behavior during said insurance period of time” is linked with “adjusting premiums for an insurance period of time,” not the generation of the actuarial class system.
- vii. The Advisory Action refers to claims 10 and 13 to support its position. The actuarial standard values of claims 10 and 13 are described as being “preset values.” How do these claims support the Advisory Action’s position?
- viii. The advisory action states that “the proposed explicit claim language does not preclude such grouping/rating primarily based on such conventional data gathering especially with respect to ‘operators or vehicles having a similar risk characteristic’.”
1. This statement does not take into account the claim language that recites “generating actuarial classes of insurance ... from actual driving characteristics as represented by the recorded data elements” (for claim 1) and “compute an insurance rating for the vehicle that is based on an actuarial class of insurance... which represents actual driving characteristics of the vehicle monitored and recorded from the at least one sensor” (for claim 6). Thus, in claim 1, the claimed actuarial classes of insurance are required to be generated from actual driving characteristics. In claim 6, the actuarial class used to compute the rate represents actual monitored driving characteristics.

III. Claims 4 and 5

- a. Patent Owner appreciates the Examiner’s indication in the Advisory Action that the prior art rejection of claims 4 and 5 would be withdrawn in response to presentation of specific claim language. Patent Owner would like to confirm that the language presented below would meet the Examiner’s approval. Claim 5 is believed to match exactly as instructed in the Advisory Action. Claim 4 differs from the Advisory Action’s suggestions in a few minor ways to correct typographical issues, ensure antecedent basis, and remain consistent with the patented language. The marked-up language is shown with respect to the patented versions of the claims.

4. (amended) A method of insuring a vehicle operator for a selected period based upon operator driving characteristics during the period, comprising, steps of:

generating an initial operator profile;

generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicle operator’s

driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator;

monitoring the vehicle operator's driving characteristics during the selected period; and

deciding a total cost of vehicle insurance for the selected period based upon the [operating] vehicle operator's driving characteristics monitored in that selected period and the base cost of insurance.

5. (amended) A method of determining a cost of vehicle insurance for a selected period based upon monitoring, recording and communicating data representative of operator and vehicle driving characteristics during said period, whereby the cost is adjustable by relating the driving characteristics to predetermined safety standards that are related to a safe operation of a vehicle, the method comprising:

determining an initial insured profile for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator of the vehicle and determining a base cost of the vehicle insurance based on said initial insured profile wherein the initial insured profile comprises coverage information, including limits and deductibles;

monitoring a plurality of the data elements representative of [an] the operating state of [a] the vehicle or [an] the action of the operator of the vehicle during the selected period;

recording selected ones of the plurality of data elements when said ones are determined to have a preselected relationship to the safety standards;

consolidating said selected ones for identifying a surcharge or discount to be applied to the base cost; and,

producing a final cost of vehicle insurance for the selected period from the base cost and the surcharge or discount.

IV. Would the following alternative versions of claims 1 and 70 overcome the pending rejections?

1. A method of generating a database comprising data elements representative of a vehicle operator or vehicle driving characteristics, the method comprising:

generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicle operator's driving characteristics wherein the insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the vehicle operator;

monitoring a plurality of the data elements representative of an operating state of a vehicle or an action of the operator during a selected time period; [and,]

recording selected ones of the plurality of data elements into the database when said ones are determined to be appropriate for recording relative to determining a cost of insurance for the vehicle during the selected time period, said ones including, a time and location of vehicle operation and a corresponding log of vehicle speed for the time and location; and

producing a total cost of vehicle insurance, comprising a retrospective adjustment of an insurance premium or a prospective setting of an insurance premium, based upon the vehicle operator's driving characteristics

monitored in that selected period and the base cost of insurance.

70. A method of monitoring a human controlled power source driven vehicle, the method comprising:
generating an insured profile for a vehicle operator prior to any extracting of any of the vehicle operator's
driving characteristics wherein the insured profile comprises coverage information, including limits and
deductibles, for determining a base cost of vehicle insurance for the vehicle operator;
extracting one or more data elements by an on-board computer from at least one sensor wherein the one
or more elements are of at least one operating state of the vehicle and the at least one human's actions during a
data collection period;
analyzing, grouping, and storing the one or more data elements as group data values in a first memory
related to a predetermined group of elements;
correlating the group data values to preset values related to safety standards in a second memory and
generating an output data value based on the correlation; and
computing an insurance rating based upon the output data value for the vehicle for the data collection
period to produce a total cost of vehicle insurance, comprising a retrospective adjustment of an insurance
premium or a prospective setting of an insurance premium, based upon driving characteristics of the vehicle
operator extracted during the data collection period and the base cost of insurance.

Respectfully submitted,

Date: November 1, 2011

/James A. Collins/
James A. Collins
Registration No. 43,557
Attorney of Record
Brinks Hofer Gilson & Lione
455 N. Cityfront Plaza Drive, Suite 3600
Chicago, IL 60601
(312) 321-4200 (telephone)
(312) 321-4299 (facsimile)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CENTRAL REEXAMINATION UNIT

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|---|---|------------------------------|
| <i>Ex parte</i> Reexamination U.S. Patent 6,064,970 | : | |
| | : | |
| Robert J. McMillan, et al. | : | Confirmation No. 4116 |
| | : | |
| Control No. 90/011,252 | : | Examiner: Karin M. Reichle |
| | : | |
| Filing Date: August 17, 1998 | : | Group Art Unit: 3992 |
| | : | |
| For: MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE | : | Attorney Docket No. 12741-32 |

SECOND DECLARATION UNDER RULE 1.132 OF BETH VECCHIOLI

I, Beth Vecchioli, declare as follows:

1. I have worked in the insurance industry for more than 18 years.
2. From 1993 to 1996, I was employed as a Financial Administrator for the Bureau of Self-Insurance of the Department of Insurance in the State of Florida. In that position, I was involved with the regulation of workers compensation self-insurance trust funds and individually self-insured employers. My duties included the review and audit of various actuarial and financial reports relating to self-insureds' loss experience, as well as experience rating and statistical reports and the actuarial classes identified therein. I also became accustomed to the terminology relating to the development and determination of insurance rates and ratings.
3. From 1996 to 1999, I worked as a Financial Administrator for the Bureau of Property & Casualty Insurer Solvency of the Department of Insurance in the State of Florida. In that position, I managed the regulation of all property and casualty insurers, including automobile insurers, licensed in the State of Florida. My responsibilities included the review and audit of insurers' solvency. As part of the review and audit process, I evaluated individual insurer's rating structures and their impact on the insurer's solvency. I was also responsible for the licensing of new property and casualty insurers in the State of Florida, which process included the review of those insurers' business plans, as well as the rates and products they intended to offer. In this position, I became knowledgeable of the terminology used in the field of automobile insurance, including the terminology relating to automobile insurance rates and rating plans.
4. From 2000-2001, I held the position of Bureau Chief for the Bureau of Property & Casualty Forms and Rates of the Department of Insurance in the State of Florida. As Bureau Chief, I was responsible for managing and approving rate filings for property and casualty insurers in the State of Florida, including automobile insurers. That process involved actuarial review of rate filings and rating manuals to confirm compliance with statutory requirements, including the evaluation of rate adequacy, excessiveness, and non-discriminatory application. Those rate filings comprised various aspects of an insurer's rating programs, such as, for example, particular base rates charged to individual insureds, actuarial classes of insureds, profiling of insureds, and surcharges or discounts offered by the insurer. As Bureau Chief, I was also responsible for managing and approving policy forms and

endorsements. That process included the review of insurance contracts to confirm compliance with statutorily mandated provisions and requirements.

5. From 2001-2003, I held the position of Deputy Director for the Office of Insurance Regulation in the State of Florida. As Deputy Director, I managed the regulation of the solvency and licensing of property and casualty insurers, life and health insurers, and specialty insurers licensed in the State of Florida. In this position, my responsibilities focused on the regulation of financially troubled insurers. That process included the audit and review of insurers' operations and their rate adequacy, including a number of Florida-based automobile insurers.

6. Currently, I am a Senior Government Consultant with the Carlton Fields law firm. I am not an attorney. However, I am a member of the firm's Insurance Practice Group and the Government Law and Consulting Practice Group, specializing in insurance regulatory and financial services matters. As a Senior Government Consultant, I advise clients regarding insurance products, plans, and offerings. I also review, evaluate, and assist insurers in developing rate filings, including specific base rates, rating manuals, underwriting guidelines, classifications, discounts and surcharges, and other rating factors. Furthermore, I assist automobile insurance companies with the submission and approval of rate filings and insurance contracts in the States of Florida, Georgia, and South Carolina.

7. Neither I nor the Carlton Fields law firm has worked in this capacity for the Progressive Group of Insurance Companies. In this matter, I am being compensated at my normal hourly rate. My compensation does not depend on the outcome of this reexamination proceeding.

8. I received a B.S., with honors, in Business Administration, with a major in Finance, from the University of Florida.

9. I previously presented a declaration in this reexamination proceeding in support of the Patent Owner's response filed April 6, 2011. I present the following declaration in support of the Patent Owner's response to the October 13, 2011 Advisory Office Action. The declaration is intended to provide information and opinions concerning the issues raised in the pending Advisory Office Action.

10. As was addressed in the pending Advisory Action, claims 1, 6, and 70 focus on systems that include an actuarial class or actuarial classes. In the context of the '970 patent, I understood the term "insurance actuarial class," which is equivalent to the term "actuarial class," to refer to a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. This understanding was explained in my April 6, 2011 declaration.

11. In the context of the '970 disclosure, one can think of the term actuarial class in two parts. The first part, "a grouping of individuals or vehicles having similar risk characteristics," reflects my conclusion that the Applicants had not sought to vary the ordinary and customary meaning of the term as used in the claims, nor deviate from the ordinary and customary meaning of the term. To avoid improperly reading limitations into the claim, my understanding reflects the ordinary and customary meaning that one of skill in the art would reach when reading the term in context of the entire patent.

12. One of skill in the art would also understand the second part "based on, in whole or in part, the actual monitored characteristics of the vehicle or driver" refers to the innovation behind the actuarial classes disclosed in the patent. In my view, the innovation comes from the use of actual driving data to generate the actuarial classes, the use of actual driving data to assign a specific vehicle/operator to an actuarial class, or the use of actual driving data to compute an Insurance rating based on an actuarial class that represents the actual driving data.

13. Previously, actuarial classes were based on data gathered from past realized losses and applicant interviews. The use of actual driving data makes the actuarial classes new and more precise; but the application's use of the term "new", in my opinion, does not establish that the '970 disclosure contains a specialized definition limiting the term actuarial class to a specific driver or vehicle or limiting an actuarial class to a specific time period.

14. The term "new" described at col. 4, lines 53-56, in the context of the disclosure, as understood by a person skilled in the art would, in my opinion, indicate that the actuarial classes are more precise because (1) they are formed from (e.g., divided according to) the monitored behaviors of other vehicles/drivers, and (2) are assigned based on the demonstrated behavior of the newly monitored driver/vehicle.

15. The specification makes many references to actuarial classifications related to rating variables. A driver's age, for instance, is a rating variable that may be segmented into many different groups or many different actuarial classes that group operators/drivers that share similar risk characteristics. Any individual operator or driver may only be assigned to a single age class. A 45 year old driver, for example, would not be classified in the 38-39 year old actuarial class, but instead would be assigned to a class that has a range that includes 45 year old drivers, as explained at col. 2, lines 13-20. In traditional rating systems, the assignment and the segmentation are based on application interviews and past realized losses, as explained at col. 2, lines 38-44.

16. The new actuarial classes described in the specification are based on monitored driving data that groups vehicles/drivers sharing similar characteristics. The "total driving time in minutes" of each driver of an insured vehicle at col. 4, lines 33-34 that is monitored, for example, will be assigned to a total drive time class. A person skilled in the art, in my view, understands how usage based classes are formed according to the analysis of the same type of data monitored from other drivers/vehicles that share similar characteristics. See col. 5, lines 7-11. The "total driving time" is divided into groups known as actuarial classes based on other drivers'/vehicles' previously monitored data. Thus, if an insured vehicle is driven a certain number of minutes, it will be assigned to a total drive time class, developed from previously monitored drivers/vehicles, based on the newly monitored behavior demonstrated by the driver/vehicle.

17. Another actuarial class described in the specification is based on the location of where a vehicle is parked at night at col. 4, line 48-49. Vehicles may be parked in a garage, in a driveway, or on the street at night as explained in the specification. Through navigation signals obtained from a GPS (global positioning system) antenna or other locating system, a vehicle may be assigned to a location class based on the actual data monitored from the driver/vehicle. Thus, if a locating system in a vehicle indicates that a vehicle is parked on a street, the vehicle will be assigned to an actuarial class based on the driver's own monitored data. The location classes are formed from vehicle provided data previously monitored from other drivers/vehicles.

18. The actuarial classes disclosed in the specification are described as groupings of vehicles/drivers having similar characteristics at col. 1, lines 28 et seq. The term's meaning is consistent with other statements in the specification, for example the statements at col. 3, lines 45-50 indicate that a driver or vehicle is placed *into* an actuarial class based on actual driving data. The specification suggests that the monitored driving data used to determine surcharges and discounts are not necessarily the same data used to determine actuarial classes, at col. 5, lines 7-11. However, the prosecution history establishes that they are of a same type at U.S. Application 08/592,958, September 26, 1997 Interview Summary.

19. The original disclosure also teaches that the claimed actuarial classes cannot be limited to either a specific driver or vehicle monitored for a specific time period. In original claim 17/20 of U.S. Application 08/592,958, the processing of selected data with selected actuarial classes determines a cost of insurance. If the selected data were the same data used to generate the actuarial classes, the claimed association/consolidation would be an

association/consolidation of the data to itself. One can think of the data used to generate the actuarial classes as being the same type of data generated from multiple vehicles/drivers, but not necessarily the same data from a single vehicle/driver because the association/consolidation of the data produces a cost of insurance in original claim 17/20 of U.S. Application 08/592,958.

20. Neither the specification of the '970 patent nor prosecution record disclose that the claimed actuarial classes are based on the same driver or vehicle, but monitored earlier in time. Instead, the meaning is established in the context of the specification that explains the actuarial classes are groupings of vehicles/drivers at col. 1, lines 28-30 and June 14, 2011 Final Office Action at pg. 5.

21. Turning now to the Bouchard reference on which the Advisory Action relies, it does not disclose generating an actuarial class of insurance, which groups operators or vehicles having a similar risk characteristic. Bouchard's teachings are in a sense very different from the teachings of the proposed claims, in that Bouchard's event recording apparatus (ERA) records selectable vehicle performance and operational status, that as the Advisory Action points out, are customized and personalized to the vehicle and driver's preferences. (October 13, 2011, Advisory Action at pg. 4 and the '079 patent at col. 29, lines 18-24). This is analogous to a driver rating her or himself that does not necessarily reflect their risk as compared to others.

22. Bouchard employs a self-assessment system in which information that is recorded also determines a baseline standard of performance. The driver's own information that is recorded determines the performance standard in which a driver's abilities are measured against. The assessments shown in Figures 18 and 19 are designed on the assumption that drivers are interested in confirming their own perception of their driving performance, instead of learning how their driving risk measures up against others.

23. One skilled in the art would not use the customized or operational characteristics that is personalized to a specific driver's preferences that is described in the Bouchard system as an actuarial class (the '079 patent at col. 29, lines 18-24). In fact, because each driver of a fleet vehicle or bus can use this aspect of the system to upload into the vehicle the driver's own preferences, the driver (rather than the insurer) would decide which preferences might be used to determine an insurance rating or a cost of insurance. This means, that Bouchard is not suited to generate insurance ratings or reduce insurance rating errors that are common to conventional insurance cost systems because Bouchard would allow the insured to choose the parameters and set the thresholds that may determine the data that is collected from the vehicle (e.g., vehicle record files) and the data it would be measured against.

24. Even if one were to ignore the meaning of the term "actuarial class" that one of ordinary skill would reach when the term is read in the context of the specification of the '970 patent, which I would not, the "customized" or "personalized" ERA described in the Bouchard system is not equivalent to the claimed "actuarial class" recited in the pending claims. As explained above, the actual data used to determine the vehicle record files *must be different* from the data used to derive the claimed actuarial classes.

25. In contrast, Bouchard uses data that reflects a driver's present performance to determine a baseline performance standard. The system is designed to confirm or justify the accuracy of a driver's own perspective of fitness, rather than providing a reliable, meaningful, and predicative assessment of risk through a comparison to others. In short, Bouchard's disclosure is of a system not designed for, or compatible with, a system that determines an insurance rating or an insurance cost, based on the claimed actuarial class.

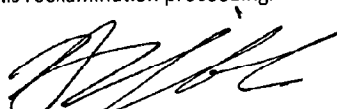
26. Turning now to a separate issue, the Advisory Action identifies the language "which group operators or vehicles having similar risk characteristics" to be redundant and optional. (October 10, 2011, Advisory Action at

pg. 4) I believe it is not. By including a definition in the claim, the definition sets a limit on how broadly one may construe the term "actuarial class" under a reasonable interpretation. In my view, it would be unreasonable to ignore the limiting language that establishes an actuarial class to be groups of operators or vehicles having a similar risk characteristic.

27. In my previous declaration, I explained that an insurance actuarial class is a grouping of individuals or vehicles having similar risk characteristics based on, in whole or in part, the actual monitored characteristics of the vehicle or driver. My understanding of the term "actuarial class" is equivalent to the term "insurance actuarial class" and "actuarial class of insurance" as these terms are used interchangeably in the insurance industry.

28. 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 such willful false statements or the like may jeopardize the validity the patent and any claims issuing from this reexamination proceeding.

Date: November 1, 2011



Beth Vecchioli

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: November 1, 2011 Name: James A. Collins Signature: /James A. Collins/

BRINKS
HOFER
GILSON
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ex parte Reexamination of U.S. Patent 6,064,970

Robert J. McMillan, et al.

Patent Filing Date: August 17, 1998

Reexamination Filing Date: September 22, 2010

Control No.: 90/011,252

For: MOTOR VEHICLE MONITORING SYSTEM FOR
DETERMINING A COST OF INSURANCE

Examiner: Karin M. Reichle

Group Art Unit: 3992

Conf. No.: 4116

Attorney Docket No.: 12741/32

CERTIFICATE OF SERVICE

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Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that a true copy of the foregoing **BRIEF OUTLINE FOR INTERVIEW** and **SECOND DECLARATION UNDER RULE 1.132 OF BETH VECCHIOLI**, was served this November 1, 2011 by First Class United States Mail, postage prepaid, on:

J. Steven Baughman
Ropes & Gray LLP
Prudential Tower
800 Boylston Street
Boston, MA 02199-3600

Respectfully submitted,

November 1, 2011
Date

/James A. Collins/
James A. Collins (Reg. No. 43,557)

BRINKS
HOFER
GILSON
& LIONE

BRINKS HOFER GILSON & LIONE
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

Electronic Acknowledgement Receipt

| | |
|---|---|
| EFS ID: | 11315384 |
| Application Number: | 90011252 |
| International Application Number: | |
| Confirmation Number: | 4116 |
| Title of Invention: | MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE |
| First Named Inventor/Applicant Name: | 6,064,970 |
| Customer Number: | 10999 |
| Filer: | James A. Collins/Tina Sieczkowski |
| Filer Authorized By: | James A. Collins |
| Attorney Docket Number: | 12741-32 |
| Receipt Date: | 01-NOV-2011 |
| Filing Date: | 22-SEP-2010 |
| Time Stamp: | 20:46:17 |
| Application Type: | Reexam (Patent Owner) |

Payment information:

| | |
|------------------------|----|
| Submitted with Payment | no |
|------------------------|----|

File Listing:

| Document Number | Document Description | File Name | File Size(Bytes)/ Message Digest | Multi Part /.zip | Pages (if appl.) |
|-----------------|--------------------------------------|-------------------------------------|--|------------------|------------------|
| 1 | Reexam Miscellaneous Incoming Letter | transforoutlineandseconddec. PDF | 42867 <small>aa314e8a3409d81e1f925a3f1f054d078cb5bfb3</small> | no | 1 |

Warnings:

Information:

| | | | | | |
|---|---|---------------------------------|---|----|---|
| 2 | Letter Requesting Interview with Examiner | briefoutlineforintr2.PDF | 455938 | no | 8 |
| | | | 38c003c873f98562bc665d809f5292b2d8d4b34a | | |
| Warnings: | | | | | |
| Information: | | | | | |
| 3 | Letter Requesting Interview with Examiner | seconddec.PDF | 286978 | no | 5 |
| | | | 486a263b891ac855a4accf3027783033ed8f3155c | | |
| Warnings: | | | | | |
| Information: | | | | | |
| 4 | Reexam Certificate of Service | certofservforbriefoutanddec.PDF | 33096 | no | 1 |
| | | | 321918c890f4c7a7dccc399d78dc7a6a1cc9720d | | |
| Warnings: | | | | | |
| Information: | | | | | |
| Total Files Size (in bytes): | | | 818879 | | |
| <p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p> | | | | | |

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: November 1, 2011 Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/

**BRINKS
HOFER
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& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re-Examination of: Robert J. McMillan et al.

Re-Examination Appl. No.: 90/011,252

Filing Date: September 22, 2010

U.S. Patent No.: 6,064,970

For: MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE

Attorney Docket No.: 12741/32

Examiner: Karin M. Reichle

Group Art Unit: 3992

Conf. No.: 4116

TRANSMITTAL

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

- Transmittal; Brief Outline for Interview; Second Declaration Under Rule 1.132 of Beth Vecchioli; and Certificate of Service.

Fee calculation:

- No additional fee is required.
- Small Entity.
- An extension fee in an amount of \$_____ for a ____ - month extension of time under 37 CFR § 1.136(a).
- A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(____) .
- An additional filing fee has been calculated as shown below:

| | | Small Entity | | | Not a Small Entity | | | | |
|---|----------------------------------|--------------|---------------------------------|---------------|--------------------|-----------|----|----------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | OR | Rate | Add'l Fee |
| Total | | Minus | | | x \$26= | | | x \$52= | |
| Indep. | | Minus | | | x 110= | | | x \$220= | |
| First Presentation of Multiple Dep. Claim | | | | | +\$195= | | | +\$390= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

- Please charge Deposit Account No. 23-1925 in the amount of \$_____ for _____.
- Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

November 1, 2011
Date

/James A. Collins/
James A. Collins (Reg. No. 43,557)

Considered KMR
11/8/11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CENTRAL REEXAMINATION UNIT

| | | |
|---|---|------------------------------|
| <i>Ex parte</i> Reexamination U.S. Patent 6,064,970 | : | |
| | : | |
| Robert J. McMillan, et al. | : | Confirmation No. 4116 |
| | : | |
| Control No. 90/011,252 | : | Examiner: Karin M. Reichle |
| | : | |
| Filing Date: August 17, 1998 | : | Group Art Unit: 3992 |
| | : | |
| For: MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE | : | Attorney Docket No. 12741-32 |

SECOND DECLARATION UNDER RULE 1.132 OF BETH VECCHIOLI

I, Beth Vecchioli, declare as follows:

1. I have worked in the insurance industry for more than 18 years.
2. From 1993 to 1996, I was employed as a Financial Administrator for the Bureau of Self-Insurance of the Department of Insurance in the State of Florida. In that position, I was involved with the regulation of workers compensation self-insurance trust funds and individually self-insured employers. My duties included the review and audit of various actuarial and financial reports relating to self-insureds' loss experience, as well as experience rating and statistical reports and the actuarial classes identified therein. I also became accustomed to the terminology relating to the development and determination of insurance rates and ratings.
3. From 1996 to 1999, I worked as a Financial Administrator for the Bureau of Property & Casualty Insurer Solvency of the Department of Insurance in the State of Florida. In that position, I managed the regulation of all property and casualty insurers, including automobile insurers, licensed in the State of Florida. My responsibilities included the review and audit of insurers' solvency. As part of the review and audit process, I evaluated individual insurer's rating structures and their impact on the insurer's solvency. I was also responsible for the licensing of new property and casualty insurers in the State of Florida, which process included the review of those insurers' business plans, as well as the rates and products they intended to offer. In this position, I became knowledgeable of the terminology used in the field of automobile insurance, including the terminology relating to automobile insurance rates and rating plans.
4. From 2000-2001, I held the position of Bureau Chief for the Bureau of Property & Casualty Forms and Rates of the Department of Insurance in the State of Florida. As Bureau Chief, I was responsible for managing and approving rate filings for property and casualty insurers in the State of Florida, including automobile insurers. That process involved actuarial review of rate filings and rating manuals to confirm compliance with statutory requirements, including the evaluation of rate adequacy, excessiveness, and non-discriminatory application. Those rate filings comprised various aspects of an insurer's rating programs, such as, for example, particular base rates charged to individual insureds, actuarial classes of insureds, profiling of insureds, and surcharges or discounts offered by the insurer. As Bureau Chief, I was also responsible for managing and approving policy forms and



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. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 90/011,252 | 09/22/2010 | 6,064,970 | 12741-32 | 4116 |

10999 7590 10/28/2011

Progressive Casualty/BHGL
P.O. Box 10395
Chicago, IL 60610

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/28/2011

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

Date: **MAILED**

OCT 28 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011252
PATENT NO. : 6064970
ART UNIT : 3993

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)).

**Decision on Petition for Extension
of Time in Reexamination**

Control No.:90/011,252

1. THIS IS A DECISION ON THE PETITION FILED 10/24/2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on 08/08/2011, which sets a two (2) month period for filing a response thereto, be extended by one (1) month.
 - A. Petition fee per 37 CFR §1.17(g):
 - i. Petition includes authorization to debit a deposit account.
 - ii. Petition includes authorization to charge a credit card account.
 - iii. Other: _____.
 - B. Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. Petition was timely filed.
 - D. Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. Granted or Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
 Other/comment: _____.
 - B. Dismissed because:
 - i. Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. The petition is moot.
 - vi. Other/comment: See Attached Comments.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 or Sudhanshu C. Pathak at 571-272-5509 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/ for Mark Reinhart
[Signature]

SPE, CRU 3992
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. While the petition speaks to the considerations maintaining an open dialog between the examiner and the Patent Owner, reduce the number of claims and further the "special dispatch" consideration, these are not persuasive considerations.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Furthermore, Pursuant to MPEP § 2265 (in-part) "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary circumstances are involved; e.g., death or incapacitation of the patent owner.

Therefore, based on the reasoning provided above the Petition is dismissed.

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8
I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:
Date: October 24, 2011 Name: James A. Collins Signature: /James A. Collins/

**BRINKS
HOFER
GILSON
& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Ex Parte Robert John McMillan et al.
Reexam of:
Reexam Appln. 90/011,252
No.:
Filed: September 22, 2010
For: MOTOR VEHICLE MONITORING SYSTEM
FOR DETERMINING A COST OF INSURANCE
Attorney Docket No.: 12741-32

Examiner: Karin M. Reichle
Art Unit: 3992
Conf. No.: 4116

CERTIFICATE OF SERVICE

Mail Stop Ex Parte Reexam
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that true copies of the foregoing Petition Under 37 CFR § 1.550(c) for Extension of Time, Petition Under 1.182/1.183 for Suspension of Rules to Waive Due Date of Appeal Brief, Petition Under 1.182/1.183 to Reopen Prosecution were served this October 24, 2011 by First Class United States Mail, postage prepaid, on:

J. Steven Baughman
Ropes & Gray LLP
One International Place
Boston, MA 02110

Respectfully submitted,

October 24, 2011
Date

/James A. Collins/
James A. Collins (Reg. No. 43,557)

**BRINKS
HOFER
GILSON
& LIONE**

BRINKS HOFER GILSON & LIONE
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR § 1.8.

EX PARTE REEXAM

/James A. Collins/

James A. Collins, Reg. No. 43,557

October 24, 2011

Date of Signature & Date of Transmission

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CENTRAL REEXAMINATION UNIT

| | | |
|---|---|------------------------------|
| <i>Ex parte</i> Reexamination of | : | |
| U.S. Patent 6,064,970 | : | |
| Robert J. McMillan, et al. | : | Confirmation No. 4116 |
| Control No. 90/011,252 | : | Examiner: Karin M. Reichle |
| Filing Date: August 17, 1998 | : | Group Art Unit: 3992 |
| For: Motor Vehicle Monitoring System for Determining a Cost of Insurance | : | Attorney Docket No. 12741-32 |

**Petition Under 37 CFR § 1.550(c) for Extension of Time,
Petition Under 1.182/1.183 for Suspension of Rules to Waive Due Date of Appeal Brief,
Petition Under 1.182/1.183 to Reopen Prosecution.**

Attn: Central Reexamination Unit
Commission for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Patent Owner seeks relief by this request for a one month extension of time to address the Examiner's rejections raised in the Advisory Action dated October 13, 2011, but issued on

Reexamination Control No. 90/011,252
U.S. Patent 6,064,970

Atty. Dkt. No. 12741-32
Page 1 of 7

October 18, 2011. Specifically, Patent Owner respectfully requests that the Patent Office either (1) extend the appeal brief deadline set forth in 37 CFR § 41.37(a) for one month (under 37 CFR § 1.550); (2) waive the appeal brief deadline (under 37 CFR § 1.182/1.183) for one month; or (3) reopen prosecution (under 37 CFR § 1.182/1.183) to address the few remaining issues pending in this reexamination proceeding. Patent Owner has been diligently amending claims, cancelling broad and narrow claims, and conducting interviews with the Patent Office in a *bona fide* effort to respond to the few remaining issues raised by the Examiner in her Advisory Action.

It is believed that if any of the three requests presented above is granted, it will

- (1) Further “special dispatch” by maintaining the open dialog between the Examiner and Patent Owner that resolved many questions about the patentability of the pending claims;
- (2) Reduce the number of claims covered by the issuance of a reexamination certificate or may be subject to an appeal, if that is still necessary;
- (3) Further “special dispatch” by allowing for the submission of evidence directed only to the issues raised by the Advisory Action and in support of evidence already in the record that that will aid the Examiner in resolving the few remaining issues; and
- (4) Shorten the pendency of this reexamination proceeding.

The on-going discussions, cancellation of claims, submission of evidence (if needed), and amendment to the claims will resolve the few pending issues associated with the current Advisory Action, provide the Examiner with sufficient time to consider such discussions/evidence, and will advance prosecution to the issuance of a reexamination certificate or at the very least, better define the issues for appeal, if that is still necessary.

BACKGROUND FACTS

1. On May 16, 2000, U.S. Patent No. 6,064,970 issues to McMillan *et al.*
2. On September 22, 2010, the *Ex Parte* Reexam Request is filed with the Patent Office.
3. On January 26, 2011, Patent Owner waives Patent Owner Statement.
4. On March 7, 2011, a Non-final Office Action issues (220 pages).
5. On March 25, 2011, Patent Owner submits Interview agenda which addresses the issues raised in the Non-final Office Action.
6. On March 30, 2011, first personal interview conducted.
7. On April 6, 2011, first Patent Owner Response filed that includes declaration evidence and factual support, which addressed the issues raised in the March 7, 2011 first Office Action.
8. On June 14, 2011, Final Office Action issues (201 pages) that further incorporates the first Office Action (220 pages).
9. On June 21, 2011, first petition under 37 CFR § 1.550 was filed requesting a one month extension of time to respond to the Final Office Action that is collectively 421 pages long.
10. On June 29, 2011, the first petition under 37 CFR § 1.550 is granted.
11. On July 12, 2011, Patent Owner submits first Outline for Interview which proposes claim amendments and addresses the issues raised in the Final Office Action.
12. On July 18, 2011, second personal interview conducted in which the prior art and the proposed amendments outlined in Patent Owner's July 12, 2011 submission is discussed. Supervisor Harrison encourages participants to sustain an open dialog and indicates that prosecution may be extended if *bona fide* efforts continue to advance prosecution.
13. On August 12, 2011, a first Response to the final Office Action filed cancelling or amending the pending independent claims, amending many dependent claims, and cancelling 37 claims (or 46% of the pending claims under reexamination).
14. On August 26, 2011, first Advisory Action issues.
15. On September 8, 2001, Patent Owner submits Second Outline for Interview which proposes various alternative claim amendments, identifies original disclosure support for the amendments, and addresses the issues raised in the first Advisory Action.

16. On September 13, 2011, first telephone interview conducted in which the prior art and proposed amendments outlined in Patent Owner's September 8, 2011 submission is discussed. The explanations and amendments address the issues raised in the August 26, 2011 first Advisory Action. A tentative agreement is reached on two of the five pending independent claims. A final decision on the claims including the patentability of the remaining three independent claims was reserved for later consideration of Patent Owner's second Response to the Final Office Action.
17. On September 14, 2011 a Notice of Appeal is filed for the sole purpose of preserving Patent Owner's appeal rights.
18. On September 26, second Response to the Final Office Action filed cancelling 37 claims amending all of the pending independent claims to address issues raised in the August 26, 2011 first Advisory Action and the agreements reached in the September 13, 2011 first telephone interview.
19. On October 18, 2011¹ a second Advisory Action Issues in which the Examiner proposes additional amendments to independent claims 4 and 5 and indicates that if similar amendments were made to the remaining independent claims, the amendments would necessitate the withdrawal of the prior art rejections. The necessary amendments to independent claims 1, 6, and 80 are not explicitly expressed.
20. On October 21, 2011 Patent Owner requests an interview to resolve the remaining issues addressed in the Advisory Action.
21. On October 24, 2011 Examiner Reichle is working diligently to resolve scheduling issues with her Examiner conferees. PTO scheduling conflicts have delayed the meeting until at least November 2nd or 3rd. This leaves only six business days to prepare the appeal brief and for the Examiner to consider and enter (if persuasive) proposed claim amendments.

The issues remaining relate to minor phrasing issues, the language needed to adopt the Examiner's suggestions, and whether there is original disclosure support for one claim limitation.

SPECIFIC FACTS

Patent Owner is diligently advancing prosecution since the first petition under 37 CFR § 1.550 was granted. In spite of all of the issues raised in the 421-page Final Office Action, Patent Owner and the Examiner have reduced the issues to 7 pages, primarily directed to the issue of

¹ Although the Advisory Action indicates a mailing date of October 13, 2011, the Office Action was not available on Private Pair or Public Pair until the afternoon of October 18, 2011.

whether there is original disclosure support for one claim limitation. The Background Facts establish that Patent Owner responded to nearly every action (except the Final Office Action) in two weeks or less, resulting in the confirmation of two claims and the likely confirmation of the remaining claims if prosecution is extended.

While significant progress has been made, the resources needed to continue to advance prosecution must now be re-directed to preparing the appeal brief and necessary petitions (e.g., petitions to waive page length must be filed 10 calendar days prior to the date it is due) unless the requested relief is granted. The pending 421-page Final Office Action will require a significant amount of time to prepare the appeal brief and consult with the personnel assisting in this reexamination. Instead of working with the Examiner to resolve the few questions of patentability that remain with respect to the *proposed claims*, Patent Owner's counsel will need to expend considerable time to contest the Examiner's findings and conclusions with respect to the *original un-amended claims*. Not only would this be a misallocation of resources, it is unnecessary given the few issues that remain. And, if Patent Owner is successful before the Board in whole or in part, Patent Owner is left with the election of reopening prosecution or requesting a re-docketed appeal. Rather than advancing prosecution and reducing the pendency of this reexamination proceeding, dismissal of this petition will complicate and retard the handling of this proceeding and prevent a resolution with "special dispatch".

The Background Facts above show *bona fide* efforts to advance prosecution toward issuance of a reexamination certificate, or at least better define the issues for appeal, if necessary. After each interview and Advisory Action, Patent Owner actively sought to adopt the Examiner's suggestions and address the Examiner's concern about support. Broad and narrow claims were

cancelled. Many amendments were proposed. Interviews were scheduled and responses were filed expeditiously. And new claims were *never* submitted. In spite of this diligence by both Patent Owner and the Examiner, advisory decisions issue about four weeks after interviews are held (See Background Facts as to the timing between an interview and an advisory action). In view of the record and limited issues remaining, Patent Owner believes the equities call for granting the requested extension. This would provide sufficient time to advance prosecution that will lead to issuance of a reexamination certificate without the expense or latency of an *ex parte* appeal and possibility of a remand that will likely reopen and return prosecution to its current state at the expense of the statutory mandate of “special dispatch”.

It should be noted that if additional evidence is needed to aid the Examiner in resolving the few remaining patentability issues, further define the claims over the cited art, further “special dispatch” by resolving issues, or further advance prosecution, it will be submitted subject the Examiner’s discretion. In view of the above, and Supervisor Harrison’s early encouragement and sage advice (Background Fact No. 12), Patent Owner respectfully requests that this request for an extension be granted.

CONCLUSION

Based on the explanations above, the Patent Owner respectfully requests that the Patent Office extend Appellant’s Brief deadline set forth in 37 CFR § 41.37(a) for one month (under 37 CFR § 1.550). Alternatively, the Patent Owner respectfully requests waiver of the appeal brief deadline (under 37 CFR § 1.1.82/1.183) for one month, or the grant of the Patent Owner’s

request to reopen prosecution (under 37 CFR § 1.182/1.183) to address the few remaining issues pending in this reexamination proceeding. A copy of this submission is being served on the Third Party Requester pursuant to 37 CFR § 1.550(f) as indicated on the attached certificate of service. The petition fee under 37 CFR § 1.17(g) is being submitted herewith. The Commissioner is hereby authorized to charge any fee deficiencies, or credit any overpayments, to Deposit Account No. 23-125 under Request 12741-32.

Respectfully submitted,

Date: October 24, 2011

/James A. Collins/
James A. Collins
Registration No. 43,557
Attorney of Record
Brinks Hofer Gilson & Lione
455 N. Cityfront Plaza Drive, Suite 3600
Chicago, IL 60601
(312) 321-4200 (telephone)
(312) 321-4299 (facsimile)

CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: October 24, 2011 Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|--|
| <p><i>Ex parte</i> Reexamination of U.S. Patent 6,064,970</p> <p>Robert J. McMillan, et al.</p> <p>Control No. 90/011,252</p> <p>Filing Date: August 17, 1998</p> <p>For: Motor Vehicle Monitoring System for Determining a Cost of Insurance</p> | <p>Confirmation No. 4116</p> <p>Examiner: Karin M. Reichle</p> <p>Group Art Unit: 3992</p> <p>Attorney Docket No. 12741-32</p> |
|---|--|

TRANSMITTAL

Mail Stop Ex Parte Reexam
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

- Transmittal Cover Letter (1p.); Certificate of Service (1p.); Petition Under 37 CFR § 1.550(c) for Extension of Time, Petition Under 1.182/1.183 for Suspension of Rules to Waive Due Date of Appeal Brief, Petition Under 1.182/1.183 to Reopen Prosecution.

Fee calculation:

- No additional fee is required.
- Small Entity.
- An extension fee in an amount of \$_____ for a _____-month extension of time under 37 CFR § 1.136(a).
- A petition or processing fee in an amount of \$400 under 37 CFR § 1.17(f).
- An additional filing fee has been calculated as shown below:

| | | | | | Small Entity | | Not a Small Entity | | |
|---|----------------------------------|-------|-----------------------------|---------------|--------------|-----------|--------------------|----------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid | Present Extra | Rate | Add'l Fee | OR | Rate | Add'l Fee |
| Total | | Minus | | | x \$30= | | | x \$60= | |
| Indep. | | Minus | | | x 125= | | | x \$250= | |
| First Presentation of Multiple Dep. Claim | | | | | + \$225= | | | + \$450= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

- Please charge Deposit Account No. 23-1925 in the amount of \$400 for Petition Fee.
- Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

October 24, 2011
Date

/James A. Collins/
James A. Collins (Reg. No. 43,557)

BRINKS HOFER GILSON & LIONE
NBC Tower – Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

Electronic Patent Application Fee Transmittal

| | | | | | |
|---|---|-----------------|---------------|-----------------------------|--|
| Application Number: | 90011252 | | | | |
| Filing Date: | 22-Sep-2010 | | | | |
| Title of Invention: | MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE | | | | |
| First Named Inventor/Applicant Name: | 6,064,970 | | | | |
| Filer: | James A. Collins | | | | |
| Attorney Docket Number: | 12741-32 | | | | |
| Filed as Large Entity | | | | | |
| ex parte reexam Filing Fees | | | | | |
| Description | Fee Code | Quantity | Amount | Sub-Total in USD(\$) | |
| Basic Filing: | | | | | |
| Pages: | | | | | |
| Claims: | | | | | |
| Miscellaneous-Filing: | | | | | |
| Petition: | | | | | |
| Petition fee- 37 CFR 1.17(f) (Group I) | 1462 | 1 | 400 | 400 | |
| Patent-Appeals-and-Interference: | | | | | |
| Post-Allowance-and-Post-Issuance: | | | | | |
| Extension-of-Time: | | | | | |

| Description | Fee Code | Quantity | Amount | Sub-Total in USD(\$) |
|--------------------------|----------|----------|--------|----------------------|
| Miscellaneous: | | | | |
| Total in USD (\$) | | | | 400 |

Electronic Acknowledgement Receipt

| | |
|---|---|
| EFS ID: | 11254488 |
| Application Number: | 90011252 |
| International Application Number: | |
| Confirmation Number: | 4116 |
| Title of Invention: | MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE |
| First Named Inventor/Applicant Name: | 6,064,970 |
| Customer Number: | 10999 |
| Filer: | James A. Collins/Nkosi Harvey |
| Filer Authorized By: | James A. Collins |
| Attorney Docket Number: | 12741-32 |
| Receipt Date: | 24-OCT-2011 |
| Filing Date: | 22-SEP-2010 |
| Time Stamp: | 19:00:58 |
| Application Type: | Reexam (Patent Owner) |

Payment information:

| | |
|--|-----------------|
| Submitted with Payment | yes |
| Payment Type | Deposit Account |
| Payment was successfully received in RAM | \$400 |
| RAM confirmation Number | 7023 |
| Deposit Account | 231925 |
| Authorized User | |

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)
 Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)
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File Listing:

| Document Number | Document Description | File Name | File Size(Bytes)/ Message Digest | Multi Part /.zip | Pages (if appl.) |
|-------------------------------------|--|--|---|------------------|------------------|
| 1 | Reexam Miscellaneous Incoming Letter | 2011-10-24_12741-32-CertificateofServicePetition.pdf | 16016 2ade9f92d5285c0b023a00a28b2d37606b98e584 | no | 1 |
| Warnings: | | | | | |
| Information: | | | | | |
| 2 | Reexam Request to Lift Suspension of Prosecution | 12741-32_1stRequestforSuspensionofRules.pdf | 61391 4ed3ffad8129eb3cb7f55408960b86fab2a77fa | no | 7 |
| Warnings: | | | | | |
| Information: | | | | | |
| 3 | Reexam Miscellaneous Incoming Letter | 11-10-24-12741-32TransmittalLetter-Petition.pdf | 22466 af32d58d891f84ad39576d70dbc677462cfa11 | no | 1 |
| Warnings: | | | | | |
| Information: | | | | | |
| 4 | Fee Worksheet (SB06) | fee-info.pdf | 29994 5fd426accbd0200402b8e725cf9f87c62df6908b | no | 2 |
| Warnings: | | | | | |
| Information: | | | | | |
| Total Files Size (in bytes): | | | 129867 | | |

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 90/011,252 | 09/22/2010 | 6,064,970 | 12741-32 | 4116 |
| 10999 | 7590 | 10/13/2011 | EXAMINER | |
| Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 | | | ART UNIT | PAPER NUMBER |

DATE MAILED: 10/13/2011

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



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ROPES & GRAY LLP

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BOSTON, MA 02110-2624

MAILED

OCT 13 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,252.

PATENT NO. 6,064,970.

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)).



UNITED STATES DEPARTMENT OF COMMERCE
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| | | | |
|---|--------------------|---|----------------------------|
| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
| 90/011,252 | 22 September, 2010 | 6,064,970 | 12741-32 |

| | | |
|--|-----------------|--------------|
| Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 | EXAMINER | |
| | KARIN REICHLER | |
| | ART UNIT | PAPER |
| | 3992 | 20111005 |

DATE MAILED:

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

Commissioner for Patents

| | |
|----------------------------|---|
| See attached communication | |
| | |
| | /Karin M. Reichle/ Primary Examiner, Art Unit 3992 |

**Ex Parte Reexamination
Advisory Action
Before the Filing of an Appeal Brief**

| | |
|----------------------------|---|
| Control No. 90/011,252 | Patent Under Reexamination 6,064,970 |
| Examiner KARIN REICHLER | Art Unit 3992 |

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

THE PROPOSED RESPONSE FILED 26 September 2011 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 6-14-11.

1. Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.

THE PERIOD FOR RESPONSE IS EXTENDED TO RUN _____ MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION. Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. An Appeal Brief is due two months from the date of the Notice of Appeal filed on 14 September 2011 to avoid dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e).

AMENDMENTS

3. The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet* (See 37 CFR 1.116 and 41.33(a)).

4. Patent owner's proposed response filed _____ has overcome the following rejection(s): _____
5. The proposed new or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. For purposes of appeal, the proposed amendment(s) a) will not be entered, or b) will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) patentable and/or confirmed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-80
Claim(s) not subject to reexamination: _____

AFFIDAVIT OR OTHER EVIDENCE

7. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
8. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
9. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

10. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
11. Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____.
12. Other: _____.

| | |
|---|---|
| /Karin M. Reichle/ Primary Examiner, Art Unit 3992 |  |
|---|---|

cc: Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-467 (Rev. 08-06)

Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief

Part of Paper No. 20111005

Continuation of 3.(d) NOTE: See attached explanation.

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Continuation of 3.(d) NOTE: The prior art rejections of claims 4 and 5, and thereby claims 76-77 which depend therefrom, would be withdrawn if rewritten as follows (i.e. to conform with col. 4, lines 5-10, and col. 10, lines 36-39 of '970 as well as the prosecution history of '958, Paper No. 6, page 6, lines 3-5 and 7-9) and submitted in a separate timely filed amendment without any other amendments. In claim 4 as filed 9-26-11, lines 4-6: the language should be --generating an insured profile for the vehicle operator prior to any monitoring of any of the vehicles operator's driving characteristics wherein the initial insured profile comprises coverage information, including limits and deductibles, for determining a base cost of vehicle insurance for the of the vehicle operator;-- and lines 8-9 should be rewritten: --producing a total cost of insurance for the selected period based upon the vehicle driver's driving characteristics monitored in that selected period and the base cost of insurance.--. In claim 5 as filed 9-26-11, lines 5-9: the language should be --determining an initial insured profile for the operator of the vehicle prior to any monitoring of any data elements representative of an operating state of the vehicle or an action of the operator of the vehicle and determining a base cost of the vehicle insurance based on said initial insured profile wherein the initial insured profile comprises coverage information, including limits and deductibles; monitoring a plurality of the data elements representative of the operating state of the vehicle or the action of the operator of the vehicle during the selected period--. Claims 1, 6 and 70 if amended to include the limitations of claim 4 and 5 would also necessitate the withdrawal of the prior art rejections thereof. See discussion of claims 1, 6 and 70 infra.

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The proposed amendments to the claims raise new issues, e.g. the independent claims 1, 6 and 70, raise issues with regard to support and/or clarity and/or, to the extent such are supported and/or understood, do not patentably distinguish over the prior art.

For example:

Claim 1: Claim 1 includes the proposed amendment "generating actuarial classes of insurance, which group operators or vehicles having a similar risk characteristic, from actual driving characteristics as represented by the recorded data elements" after the monitoring and recording steps. While col. 5, lines 28-40 of '970 set forth "It is yet another object of the present invention to generate actuarial classes and operator profiles relative thereto based upon actual driving characteristics of the vehicle and driver, as represented by the monitored and recorded data elements for providing a more knowledgeable, enhanced insurance rating precision. The subject new insurance rating system retrospectively adjusts and prospectively sets premiums based on data derived from motor vehicle operational characteristics and driver behavior through the generation of new actuarial classes determined from such characteristics and behavior, which classes heretofore have been unknown in the insurance industry." (emphasis added), Patent Owner further argues at pages 12-14 of the 9-26-11 response, relying on portions of the Background of the Invention section, e.g. col. 1, lines 28-30, and the previously submitted Vecchioli and McMillan declarations, e.g. the ordinary meaning of such term in the art/insurance industry term of art, that the term "actuarial class" is defined as "a grouping of vehicles/drivers where a specific vehicle/driver is placed into that group based on having a similar risk characteristic as the other vehicles/drivers that would be placed into that group" (emphasis

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added) and thereby supports the additional proposed claim language “which group operators or vehicles having a similar risk characteristic” (emphasis added). First, assuming arguendo that such is the definition of the term “actuarial class”, then such claim language “which group operators or vehicles having a similar risk characteristic” is redundant with regard to the preceding claim language “actuarial classes of insurance”. Second, assuming arguendo that such is the definition, see the claim language “which group” and the definition, discussed supra, i.e. “that would be placed”. Such claim language does not clearly require the classes actually include/form a group of operators and/or vehicles as contrasted to merely having the capability of doing so. Therefore, such would also not appear to distinguish over the prior art to Bouchard, see, e.g., col. 29, lines 18-24, i.e. at the very least, the profile/standard/class generated has the capability of being based on the use of multiple vehicles, e.g. any one of a fleet of vehicles. Finally, it is the Examiner’s position that “new actuarial classes” of the ‘970 Patent are “new” because the concept/definition of “actuarial class” is “new”, i.e. specific to the driver and/or vehicle for each period due to the generation/derivation from actual data for that period, i.e. an “actuarial class(es)” is(are) a specific driver and/or vehicle risk(s)/characteristic(s) for each specific period, e.g. “Driver: Total driving time in minutes by each driver of the insured vehicle”, “Vehicle: Location vehicle is parked at night (in garage, in driveway, on street)” rather than a group of drivers/vehicles. See the portions of ‘970 Patent relied upon for support by Patent Owner (see, e.g., pages 12-14 and 26-27 of the 9-26-11 response) as well as original claims 17 and 20 of the ‘958 parent application, the ‘958 parent application prosecution history (e.g. the 9-26-97 Interview Summary record), the remarks on page 2 of the 1/12/98 proposed amendment, the ‘034 application prosecution history (e.g. the remarks on pages 5-6 of the 7-19-99 response),

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and other portions of the '970 Patent (e.g. col. 4, lines 30-34 (“Examples of possible actuarial classes developed from vehicle provided data include: Driver: Total driving time in minutes by each driver of the insured vehicle” (Note such a “class” would only include each driver of the insured vehicle)), claims 10 and 13 (i.e. preset values used to generate output data value are “actuarial standard values”)). Therefore, and contrary to Patent Owner’s remarks, the invention (i.e. “The subject new insurance rating system retrospectively adjusts and prospectively sets premiums based on data derived from motor vehicle operational characteristics and driver behavior through the generation of new actuarial classes determined from such characteristics and behavior, **which classes heretofore have been unknown in the insurance industry.**” (emphasis added)), is not “actuarial classes” which are “new” because “they are not based solely on past realized losses (like the conventional classes based solely on data gathered from past applicant interviews or existing public records that are not verifiable)” (emphasis added), but also on actual driving characteristics, i.e. “actuarial classes” as with the known term of art but based at least in part on actual data. Note especially the proposed explicit claim language does not preclude such grouping/rating primarily based on such conventional data gathering especially with respect to “operators or vehicles having a similar risk characteristic”. See also discussion infra with regard to claims 6 and 70.

Claim 6: See the discussion of claim 1 supra. Additionally, e.g., the language of this claim only requires that that “an actuarial class of insurance” “**represent[s]** actual driving characteristics of the vehicle monitored and recorded from the at least one sensor, [FOR] for the data collection period.” Such claim language “represents” does not require generation of the class from such

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characteristics as disclosed, i.e. supported, by the '970 Patent. Note claim 41. Also, note the prosecution history, e.g. original claims 17 and 20 of the '958 parent application, e.g. extracting, screening, aggregating and recording of raw data in a vehicle record file, setting of actuarial classes derived from aggregating those raw data elements, consolidation of such classes with vehicle record for determining a cost for the vehicle in correspondence with one of the classes, claim 6 of the '970 Patent, e.g. extracting, analyzing, grouping and storing of data elements/group data values in a first memory, correlation of such elements/data values in first memory with preset values in second memory to generate correlation based output data value used to compute insurance rating based on an actuarial class, claims 10 and 13, e.g. preset values include "other actuarial standard values" and Figure 5 of the '970 Patent, e.g. vehicle record file 204, consolidate files 210, process file 212, 214, e.g. are the preset values and set generated actuarial classes as disclosed/supported one and the same? See discussion of dependent claims *infra*.

Claim 70: First, the last section of this claim also includes the language "based on an actuarial class of insurance...represents actual driving characteristics of the vehicle monitored and recorded from the at least one sensor", but not the language "which groups operators or vehicles" as do claims 1 and 6. Yet Patent Owner, see footnote on page 12 of the 9-26-11 response, appears to argue a different interpretation of the same claim language "an actuarial class of insurance". See also discussion of claims 1 and 6 *supra* with regard to the claim language which is similar.

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Dependent claims:

For example: With regard to claim 41, is the “the actuarial class of insurance associated with the vehicle” in this claim and “an actuarial class of insurance” which is the basis for an insurance rating for the vehicle of claim 6 one and the same? With regard to claim 62, with respect to “the actuarial class of insurance” see discussion of claim 41. Also is this claim requiring the generation of a cost based on data elements and the actuarial class at a minimum, i.e. note the cost generation does not require use of the generated output value, as well as the generation of an output value, i.e. how many values at a minimum are required to be determined/computed/generated and based on what at a minimum?