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) Assignce: 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 dis-

claimer.

### 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)

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

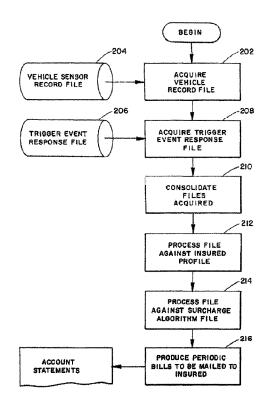
### (56) References Cited

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.



**Liberty Mutual Exhibit 1003** 

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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 acturial 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 55 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 aroups other, human operator controlled 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.

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.

/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

Group Art Unit: 3992

Filing Date: August 17, 1998

For: MOTOR VEHICLE MONITORING SYSTEM FOR :

DETERMINING A COST OF INSURANCE

Attorney Docket No. 12741-32

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

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

Atty. Dkt. No. 12741-32 Page 1 of 2 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

Reexamination Control No. 90/011,252 U.S. Patent 6,064,970 Atty. Dkt. No. 12741-32 Page 2 of 2

### CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

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Date: November 16, 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**

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)



Electronic Acl	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	no	1
·				e916d9c6c89c4d0cb0012f23aa0e674d82cc 2e71		·
Warnings:						
Information:						

2	2 Applicant summary of interview with examiner	intsummary.PDF	51274	no	2
2	examiner	mouninary. Di	2b50e50f10908ba9ef4e6c4e6f7b9fe0869c 0920	110	2
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3	Reexam Certificate of Service	certofservice.PDF	31897	no	1
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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.

#### BRINKS CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8 HOFER 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: GILSON Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/ &LIONE

Date: November 16, 2011

IN TH	IE UNITI	ED STATES PA	TENT AN	ID TRA	DEMARK	OF	FICE	
Re-Examination of: Ro	bert J. M	cMillan et al.						
Re-Examination Appl.	No.: 90/0	11,252						
Filing Date: September		Examir	er: Karin I	M. R	eichle			
U.S. Patent No.: 6,06	4,970			Group	Art Unit: 3	992		
		IITORING SYSTE FOF INSURANCI		Conf. N	lo.: 4116			
Attorney Docket No.:	12741/32							
		TRAN	ISMITT	AL				
Commissioner for Patents PO Box 1450 Alexandria, VA 22313-14								
Sir:								
Attached is/are:								
	ew Summa	ary; and Certificate	of Service.					
Fee calculation:								
No additional fee is	s required.							
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		nt of \$ for a _					37 CFR §	1.136(a).
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An additional filing	fee has be	een calculated as sh	nown below	<i>"</i> :				
				Sm	all Entity		Not a S	mall Entity
Claims Remainir After Amendme		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	OR	Rate	Add'l Fee
Total	Minus			x \$26=	:		x \$52=	
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First Presentation of Multiple	Dep. Claim			+\$195=			+ \$390=	
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		amount of \$	•					
The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.1 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including an								

16 extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. Respectfully submitted, /James A. Collins/ James A. Collins (Reg. No. 43,557) November 16, 2011 Date



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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
				EXAMINER
Progressive Casualty/l P.O. Box 10395	BHGL		К	ARIN REICHLE
Chicago, IL 60610			ART UNIT	PAPER
			3992	20111115
			·- <del></del>	

DATE MAILED:

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NOV 15 2011

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

**Commissioner for Patents** 

See attached communication		i.
		,
encl: 2-11-2011 PTO-1449		
Elici. 2-11-2VII F (7-1447	/Karin M. Reichle/	
•	Primary Examiner, Art Unit 3992	
PTO 000 (Pay 04 02)		<u></u>

PTO-90C (Rev.04-03)

### UNITED STATES PATENT AND TRADEMARK OFFICE



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ROPES & GRAY LLP

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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)).

Art Unit: 3992

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:

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United States Patent & Trademark Office

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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 Page 2

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.	CASE NO.
1		90/011,252	12741-32
LIST OF PATENTS AND PU	BLICATIONS FOR	FILING DATE	GROUP ART UNIT
APPLICANT'S INFORMATION DIS	CLOSURE STATEMENT	September 22, 2010	3992
(use several sheets if necessary) APF	PLICANT(S): Robert John M	IcMillan et al.	CONFIRMATION NO. 4116

REFERENCE DESIGNATION	U.S. PATENT DOCUMENTS

	DOCUMENT NUMBER Number-Kind Code (if known)	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		
	C2 C3 C4	NUMBER Number-Kind Code (If known)  C1 US 4,581,708  C2 US 4,593,357  C3 US 4,945,759  C4 US 5,074,144	NUMBER Number-Kind Code (if known)         DATE           C1         US 4,581,708         04/08/1986           C2         US 4,593,357         06/03/1986           C3         US 4,945,759         08/07/1990           C4         US 5,074,144         12/24/1991	NUMBER Number-Kind Code (if known)         DATE         NAME           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.	NUMBER Number-Kind Code (if known)         DATE         NAME         SUBCLASS           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.

### FOREIGN PATENT DOCUMENTS

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

EXAMINER INITIAL		OTHER ART – NON PATENT LITERATURE DOCUMENTS  nclude name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, ymposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.					
	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/



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APPLICATION NO.	F	TLING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/011,252	•	09/22/2010	6,064,970	12741-32	4116
10999	<b>7</b> 59 <b>0</b>	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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REEXAMINATION CONTROL NO. <u>90/011,252</u>.

PATENT NO. 6,064,970.

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		Control No.	Patent Under Reexamination				
	Notice of Intent to Issue	90/011,252	6,064,970				
	Ex Parte Reexamination Certificate	Examiner	Art Unit				
		KARIN REICHLE	3992				
	- The MAILING DATE of this communication appears o		rrespondence address -				
1. 🖾	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 3 a) All b) Some* c) None of the certiin been received. Inot been received. Inot been filed in Application No. Induction been filed in reexamination Control No. Induction been received by the International Bureau	fied copies have					
	* Certified copies not received:						
	Note attached Examiner's Amendment.						
	Note attached Interview Summary (PTO-474).						
9. 🔲	Other:						
	Karin M. Reichle Primary Examiner Art Unit: 3992						

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PTOL-469 (Rev. 05-10) Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20111108

Art Unit: 3992

# 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 <u>latter</u> 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).

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- 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

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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.

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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.

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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/Confirmation

# Claim 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."

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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, ' $\underline{a}$ 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,

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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 payed 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://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.

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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:

	Control No.	Patent Under Reexamination						
Ex Parte Reexamination Interview Summary	90/011,252	6,064,970						
SIN IDI B	Examiner -	Art Unit						
25% SA - +	KARIN REICHLE	3992						
All participants (USPTO personnel, patent owner, patent	owner's representative):							
(1) KARIN REICHLE, Fred Ferris, Zoila Cabrera	(3) Raymond Ling							
(2) James Collins	(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 own	er 2)∏ patent owner's re	epresentative)						
Exhibit shown or demonstration conducted: d)⊠ Yes If Yes, bnef description: <u>Second declaration of Beth V</u>	e)∏ No. <u>'ecchiola</u>	ei T						
Agreement with respect to the claims f) was reached Any other agreement(s) are set forth below under "Descr	. g) was not reached. iption of the general nature o	h)∏ N/A. of what was agreed to…"						
Claim(s) discussed: <u>1-80</u> .								
Identification of prior art discussed: Bouchard '079.								
Description of the general nature of what was agreed to i See Continuation Sheet.	f an agreement was reached	d, or any other comments:						
(A fuller description, if necessary, and a copy of the ame patentable, if available, must be attached. Also, where n patentable is available, a summary thereof must be attached.	o copy of the amendments t	r agreed would render the claims hat would render the claims						
STATEMENT OF THE SUBSTANCE OF THE INTERVIE LAST OFFICE ACTION HAS ALREADY BEEN FILED, T INTERVIEW DATE TO PROVIDE THE MANDATORY S (37 CFR 1.560(b)), THE REQUIREMENT FOR PATENT	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.

Page 000041

Receipt date: 11/08/2011

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FORM PTO-1449	SERIAL NO.	CASE NO.
	90/011,252	12741-32
LIST OF PATENTS AND PUBLICATIONS FOR	FILING DATE	GROUP ART UNIT
APPLICANT'S INFORMATION DISCLOSURE STATEMENT	September 22, 2010	- 3992
(use several sheets if necessary) APPLICANT(S): Robert John	CONFIRMATION NO.	
7.11 2.107.11 (O). 1(ODG): 001/11 (	vicivilian et al.	4116

REFERENCE	DESIG	NATION U.S.	PATENT DOCL	JMENTS	-	
EXAMINER INITIAL	-7.	DOCUMENT NUMBER Number-Kind Code (if known)	DATE	NAME	CLASS/ SUBCLASS	FILING DATE

#### FOREIGN PATENT DOCUMENTS DOCUMENT **EXAMINER** CLASS/ TRANSLATION YES OR NO NUMBER Number-Kind Code (if known) INITIAL DATE COUNTRY **SUBCLASS**

EXAMINER INITIAL	(includ	OTHER ART – NON PATENT LITERATURE DOCUMENTS (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.						
	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.						

EXAMINER	DATE CONSIDERED	44/00/0044
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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.

LL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /KR/

Issue	Classi	fication

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

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U.S. Patent and Trademark Office

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	Application/Control No.	Applicant(s)/Patent under Reexamination
	90/011,252	6,064,970
Γ	Examiner	Art Unit
	KARIN REICHLE	3992

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Class	Subclass	Date	Examiner				
NONE		11/8/11	KMR				
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SEARCH NOTES (INCLUDING SEARCH STRATEGY)			
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Review of Patented File Prosecution History	11/8/11	KMR	
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# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1850 Alexandria, Virginia 22313-1450 www.uspto.gov

# **BIB DATA SHEET**

# **CONFIRMATION NO. 4116**

SERIAL NUME	BER	FILING or 371(c) DATE		CLASS	GR	OUP ART	UNIT	ATTO	RNEY DOCKET
90/011,252	2	09/22/2010		705		3992			12741-32
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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 **********************************									
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ADDRESS									
P.O. Box 1 Chicago, II	Progressive Casualty/BHGL P.O. Box 10395 Chicago, IL 60610 UNITED STATES								
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Re	examinat	tion

Application/Control No.	Applicant(s)/Patent Under Reexamination
90/011,252	6,064,970
Certificate Date	Certificate Number
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COPENDING OFFICE PROCEEDINGS				
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1. NONE	<u>.</u>			
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U.S. Patent and Trademark Office

DOC. CODE RXFILJKT

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

REFERENCE DESIGNATION U.S. PATENT DOCUMENTS

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

# FOREIGN PATENT DOCUMENTS

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

EXAMINER INITIAL	(Include	OTHER ART – NON PATENT LITERATURE DOCUMENTS (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.				
	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.				

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/

BRINKS HOFER GILSON &LIONE

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Ex Parte Robert John McMillan et al.

Reexam Appln. 90/011,252

Reexam of:

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)

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

Electronic Acl	knowledgement 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.)
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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.

CERTIFICATE O	E EES	FILING	UNDER	37	CER	R1 R
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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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In re Ex Parte Reexam of:	e Robert	John	McMillan et al.						
Reexam App No.:	ln. 90/011	,252				Exam	iner	: Karir	n M. Reichle
Filed:	Septer	nber 2	2, 2010			Art U	nit:	3992	
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Commissioner for PO Box 1450	Mail Stop Ex Parte Reexam Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450								
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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,

Total

November 8, 2011
Date

Fee payment:

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



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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 HOFER GILSON &LIONE

Attorney Docket No. 12741-32

Appln. No. 90/011,252

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)

BRINKS HOFER GILSON &LIONE

EX PARTE REEXAM

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.

/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

Ex parte 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

Group Art Unit: 3992

Filing Date: August 17, 1998

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.

Page | 1

### 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 climinate 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 <u>not all</u> 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, \$\frac{114-\frac{1}17}{\text{}}}\)
  - 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, linc 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?
  - 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 <u>the</u> data elements representative of [an] <u>the</u> operating state of [a] <u>the</u> vehicle or [an] <u>the</u> action of the operator <u>of the vehicle</u> 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 <u>a vehicle</u> 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

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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

### **CENTRAL REEXAMINATION UNIT**

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

Robert J. McMillan, et al. : Confirmation No. 4116

Control No. 90/011,252 : Examiner: Karin M. Reichle

Group Art Unit: 3992

Filing Date: August 17, 1998

For: MOTOR VEHICLE MONITORING SYSTEM FOR : Attorney Docket No. 12741-32

DETERMINING A COST OF INSURANCE

#### 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.
- 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.
- 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 <u>same type</u> 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 <u>same type</u> of data generated from multiple vehicles/drivers, but not necessarily <u>the same data</u> 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 outs, 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.
- 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	01166
	· · · · · · · · · · · · · · · · · · ·	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

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 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)

GILSON &LIONE

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

Electronic Acl	knowledgement 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)

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1	Reexam Miscellaneous Incoming Letter PDF		42867 aa314e8a3409d81e1f925a3f1f054d078cb5 bf33	no	1	
Warnings:						
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2	Letter Requesting Interview with	esting Interview with briefoutlineforintr2.PDF		no	8
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Information	1				
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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 1, 2011 Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/

BRINKS HOFER GILSON &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:

Atta	ched	is/are:

$\bowtie$	Transmittal; Brief Outline for Interview; Second Declaration Under Rule 1.132 of Beth Vecchioli; and Certificat
	of Service.

Fee calculation:	
☐ Small Entity.	
An extension fee in an amount of \$ for a month extension of time under 37 C	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 Pres	sentation of Multiple De	p. Claim			+\$195=	·		+ \$390=	
					Total	\$		Total	\$

#### Fee payment:

Date

	☐ Please charge Deposit Account No. 23-1925 in the amount of \$	<u> </u>
	Payment by credit card in the amount of \$ (Form PTO-20	038 is attached).
$\boxtimes$	The Director is hereby authorized to charge payment of any ad and any patent application processing fees under 37 CFR § extension fee required to ensure that this paper is timely fi Account No. 23-1925.	1.17 associated with this paper (including any
	Respectful	ly submitted,
Nove	November 1, 2011 /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**

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

Robert J. McMillan, et al.

Confirmation No. 4116

Control No. 90/011,252

Examiner: Karin M. Reichle

Group Art Unit: 3992

Filing Date: August 17, 1998

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:

- I have worked in the insurance industry for more than 18 years.
- 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. It also became accustomed to the terminology relating to the development and determination of insurance rates and ratings.
- 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.
- 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 fillings 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

PPLICATION 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		EXAM	INER	
-	Casualty/BHGL				
P.O. Box 1039			I DELL'AUTO	PAPER NUMBER	
Chicago, IL	60610		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

**DCT 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)).

D	ecision on Petition for Extension	Control No.:90/011,252						
	of Time in Reexamination							
1.	THIS IS A DECISION ON THE PETITION FI	LED <u>10/24/2011</u> .						
2.	<ul> <li>THIS DECISION IS ISSUED PURSUANT TO:</li> <li>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.</li> <li>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.</li> <li>The petition is before the Central Reexamination Unit for consideration.</li> </ul>							
3.	FORMAL MATTERS Patent owner requests that the period for responding to the Office action mailed on <u>08/08/2011</u> , which sets a <u>two (2) month</u> period for filing a response thereto, be extended by <u>one (1) month</u> .							
	iii.	on to debit a deposit account. on to charge a credit card account. vided. (Not required in reexamination where patent owner is						
	<ul><li>C.  Petition was timely filed.</li><li>D.  Petition properly signed.</li></ul>							
4.	Other/comment:  B. Dismissed because:  i. Formal matters (See unched ii. Petitioner failed to provide a responsible for preparing a remained period.  iii. Petitioner failed to explain wadditional time is needed.							
<b>5</b> .	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.							
/Su	Sudhanshu C. Pathak/ for Mark Reinhart SPE, CRU 3992 [Signature] (Title)							

U.S. Patent and Trademark Office PTO-2293 (Rev. 09-2010)

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 /James A. Collins/

Date 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

EX PARTE REEXAM

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.

/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

Ex parte Reexamination of

U.S. Patent 6,064,970

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Robert J. McMillan, et al.

Confirmation No. 4116

Control No. 90/011,252

Ez

Examiner: Karin M. Reichle

:

Group Art Unit: 3992

Filing Date: August 17, 1998

:

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 § 1.1.82/1.183) 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.

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

Atty. Dkt. No. 12741-32

#### **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.

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

Atty. Dkt. No. 12741-32 Page 3 of 7

- 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, 2011<sup>1</sup> 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

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

Atty. Dkt. No. 12741-32 Page 4 of 7

<sup>&</sup>lt;sup>1</sup> 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

Reexamination Control No. 90/011,252

U.S. Patent 6,064,970

Atty. Dkt. No. 12741-32

Page 5 of 7

Page 000081

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 exparte

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

Reexamination Control No. 90/011,252

U.S. Patent 6,064,970

Atty. Dkt. No. 12741-32

Page 6 of 7

Page 000082

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)

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

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

Page 000083

	C	ERTIFICA	TE OF EES FILING LING	EB 37 CEB	81:	8				BRINK
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								HOFE		
Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:									GILSO	
Date: October 24, 2011 Name: James A. Collins, Reg. No. 43,557 Signature: /James A. Collins/									&LION	
	ı	N THE U	INITED STATES PA	TENT AN	D٦	TRADEM.	ARK OFFIC	E		·
	te Reexamination of atent 6,064,970									
Robert	J. McMillan, et al.				Cor	nfirmation	No. 4116			
Control	l No. 90/011,252			E	Ξxε	aminer: Ka	arin M. Reich	nle		
					Gro	oup Art Ur	nit: 3992			
Filing [	Date: August 17, 1998									
	otor Vehicle Monitoring of Insurance	System	for Determining a C	ost A	Atto	orney Doc	ket No. 127	41-32	2	
			TRA	NSMITTAL	L					
Commi PO Box	op Ex Parte Reexam issioner for Patents x 1450 dria, VA 22313-1450									
Sir:										
☑ Petition	ned is/are: Transmittal Cover Len Under 1.182/1.183 for n Prosecution.	etter (1p. Suspen	); Certificate of Servi sion of Rules to Wai	ce (1p.); P ve Due Da	eti te	tion Unde of Appeal	r 37 CFR § Brief, Petitio	1.550 on Ui	D(c) for Ex	tension of Tir 2/1.183 to
Fee ca	lculation:									
	No additional fee is red	uired.								
	Small Entity.									
An extension fee in an amount of \$ for amonth 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:										
						Sma	I Entity		Not a S	mall 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 Pr	resentation of Multiple [	Dep. Clai	m			+\$225=			+ \$450=	
						Total	\$		Total	\$

Fee p	ayment:
$\boxtimes$	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
 /James A. Collins/

 Date
 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:	<b>9</b> 0011252						
Filing Date:	22	-Sep-2010					
Title of Invention:		MOTOR VEHICLE MONITORING SYSTEM FOR DETERMINING A COST OF INSURANCE					
First Named Inventor/Applicant Name:	6,0	064,970					
Filer:	Jar	nes A. Collins					
Attorney Docket Number:	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:						
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:					
	Tot	al 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)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

#### 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	no	1
		Certificateorservicer ention.pur	2ade9f92d5285c0b023a00a28b2d37606b9 8e584		
Warnings:					
Information:					
2	Reexam Request to Lift Suspension of	12741-32_1stRequestforSuspe	61391	no	7
_	Prosecution nsionofRules.pdf		4ed3fffad8129eb3cb7f554d8960bb86fab2 a7rta		
Warnings:					
Information:					
3	Reexam Miscellaneous Incoming Letter	11-10-24-12741-32TransmittalL etter-Petition.pdf	22466	no	1
_			af32d58d891f84ad39576d70dbc677462cf4 ca11		
Warnings:					
Information:					
4	Fee Worksheet (SB06)	fee-info.pdf	29994	no	2
	, 60 // 6/10/1000 (0000)		5fd426ocdsd0200402b8c725cf0f87c62dfo 908b		
Warnings:					
Information:					
		Total Files Size (in bytes)	12	9867	

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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.

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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.

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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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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.	APPLICATION NO. FILING DATE FIRST NAME		ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,252 09/22/2010		6,064,970	12741-32	4116
10999	7590 10/13/20	ai i	EXAM	INER
Progressive (P.O. Box 103) Chicago, IL	-		ART UNIT	PAPER NUMBER
Cincago, IL	00010			

DATE MAILED: 10/13/2011

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 Patent and Trademark Office
P.O. 80x1450
Alexandria, VA 22313-1450

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ROPES & GRAY LLP

PATENT DOCKETING 39141

ONE INTERNATIONAL PLACE

BOSTON, MA 02110-2624

#### EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,252.

PATENT NO. <u>6,064,970</u>.

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)).

PTOL-465 (Rev.07-04)



## 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	
				EXAMINER	
Progressive Casualty/E P.O. Box 10395	BHGL		KARIN REICHLE		
Chicago, IL 60610			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
DTO 000 (Day 04 02)	

PTO-90C (Rev.04-03)

# Ex Parte Reexamination Advisory Action

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

Before the Filing of an Appeal Brief --The MAILING DATE of this communication appears on the cover sheet with the correspondence address--THE PROPOSED RESPONSE FILED <u>26 September 2011</u> FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED <u>6-14-11</u>. 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)). 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 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 <u>elements</u> 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" "<u>represent[s]</u> 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 <u>generation</u> of the class from such

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infra.

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

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?