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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/013,252 05/22/2014 5,954,781 9999

7590 06/27/2014
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EXAMINER

ENGLAND, DAVID E

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

06/27/2014

PAPER

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

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/013,252.

PATENT NO. 5,954,781.

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)).

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

### **DECISION GRANTING EX PARTE REEXAMINATION**

A Request for *ex parte* reexamination affecting claims 1, 2, 4, 5, 7, 8, 10, 12, 13, 15 and 17 – 32 of United States Patent Number 5,954,781 (hereafter “the ‘781 Patent”) has been submitted on 05/22/2014.

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

### **Prosecution History**

The ‘781 Patent was issued on September 21 1999 from U.S. Application Serial No. 08/813,270, hereinafter “the ‘270 Application”, filed on March 10, 1997.

The prosecution history of the ‘781 Patent includes:

The '270 application was filed on March 10, 1997 with 32 claims, of which application claims 1, 14, 18, and 27 were the only independent claims. Among these independent claims, application claim 1 included a fuel overinjection circuit, application claim 14 included a fuel overinjection circuit, an upshift notification circuit, and a downshift notification circuit,

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application claim 18 included a vehicle proximity alarm, and application claim 27 included a fuel overinjection circuit and a vehicle proximity alarm.

In the only Office Action, dated August 6, 1998, application claims 1, 2 and 4 to 6 were rejected as obvious in view of U.S. Patent No. 4,901,701 to Chasteen (copy attached as Exhibit 3), application claim 3 was rejected as obvious in view of the combination of Chasteen and U.S. Patent No. 4,631,515 to Blee et al. (copy attached as Exhibit 4), and application claims 7, 18 to 24, 27, and 28 were rejected as obvious in view of the combination of Chasteen and U.S. Patent No. 5,708,584 to Doi et al. (copy attached as Exhibit 5).

In the Office Action, the Examiner stated that application claims 8 to 13, 25, 26, and 29 to 32 included allowable subject matter. Specifically, the Examiner stated that application claims 8, 25, and 29 included allowable subject matter on the basis that "the prior art fails to disclose an upshift notification circuit coupled to the processor subsystem, the upshift notification circuit issuing a notification that the engine of the vehicle is being operated at an excessive engine speed and the processor determines when to activate the upshift notification circuit." Similarly, the Examiner stated that application claims 11, 26, and 31 included allowable subject matter on the basis that "the prior art fails to disclose a downshift notification circuit coupled to the processor subsystem, the downshift notification circuit issuing a notification that the engine of the vehicle is being operated at an insufficient engine speed and the processor determines when to activate the downshift notification circuit." In addition, application claims 14 - 17, which included both an upshift notification circuit and a downshift notification circuit, were allowed on the basis that:

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the prior art fails to disclose an upshift notification circuit coupled to the processor subsystem, the upshift notification circuit issuing a notification that the engine of the vehicle is being operated at an excessive engine speed and the processor determines when to activate the upshift notification circuit and a downshift notification circuit coupled to the processor subsystem, the downshift notification circuit issuing a notification that the engine of the vehicle is being operated at an insufficient engine speed and the processor determines when to activate the downshift notification circuit.

In response to this Office Action, the applicant submitted an Amendment on February 8, 1999 with numerous amendments, see the response to Office Action and the Request pages 6 – 13 for further explanation. The '270 Application was subsequently allowed, see Notice of Allowance dated 04/21/1999 or the Request pages 13 and 14 for further details. The Examiner stated in their reasons for allowance that:

*The prior art fails to disclose an apparatus for optimizing operation of a vehicle and comprising an upshift notification circuit coupled to the processor subsystem, the upshift notification circuit issuing a notification that the engine of the vehicle is being operated at an excessive speed and the processor determines when to activate the upshift notification circuit, and a downshift notification circuit coupled to the processor subsystem, the downshift notification circuit issuing*

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