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RAYMOND A. JOAO
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EXAMINER

NGUYEN, MINH T

| ART UNIT | PAPER NUMBER |
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09/17/2014

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. 90/013,301.

PATENT NO. 6549130.

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)).

DECISION GRANTING *EX PARTE* REEXAMINATION

Reexamination has been requested for claim 48 of the United States Patent Number
5 6,549,130 to Joao, entitled "CONTROL APPARATUS AND METHOD FOR VEHICLES AND/OR
FOR PREMISES" by a third party requester ("Requester").

A substantial new question of patentability affecting claim 48 of the United States Patent
Number 6,549,130 to Joao ("the '130 patent") is raised by the request for *ex parte* reexamination.

10 Claim 48 will be reexamined. Because the '130 patent has expired, (i) the "ordinary and
customary meaning" standard as set forth in MPEP 2258 applies to this reexamination
proceeding; (ii) no amendment may be proposed for entry in an expired patent as set forth in
MPEP 2250.

15 The Examiner Interview filed on August 19, 2014 indicated that the Patent owner did not
agree to waive its right to file a patent owner's statement under 35 USC 304 at this time.

Submitted Prior Art in the Request

20 The substantial new question of patentability consideration is based on the following
references:

1. U.S. Patent 5,070,320 to Ramono, filed June 12, 1989 and issued December 3,
1991 ("Ramono").
2. U.S. Patent 6,072,402 to Kniffin, filed January 9, 1992 and issued June 6, 2000
25 ("Kniffin").
3. U.S. Patent 5,113,427 to Ryoichi et al, filed August 24, 1990 and issued May 12,
1992 ("Ryoichi").
4. U.S. Patent 5,276,728 to Pagliaroli et al, filed November 6, 1991 and issued
January 4, 1994 ("Pagliaroli").
- 30 5. U.S. Patent 5,081,667 to Drori et al, filed March 20, 1990 and issued January 14,
1992 ("Drori").

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6. U.S. Patent 5,103,221 to Memmola, filed December 5, 1989 and issued April 7, 1992 ("Memmola").

Prosecution History

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The '130 patent is titled "Control Apparatus and Method for Vehicles and/or for Premises" and was issued on April 15, 2003, from U.S. Application Serial No. 09/277,935 ("the '935 application"), filed on March 29, 1999. According to the '130 patent, it is a continuation application of U.S. Patent Application Serial No. 08/683,828, filed July 18, 10 1996, issued as the '405 patent, which is a continuation-in-part of U.S. Patent Application Serial No. 08/622,749, filed on Mar. 27, 1996, abandoned, and a continuation-in-part of U.S. Patent Application Serial No. 08/587,628 ("the '628 application"), filed January 17, 1996, abandoned, which is a continuation of U.S. Patent Application Serial No. 08/489,238, filed June 12, 1995, issued as U.S. Patent No. 5,513,244, which is a continuation application of 15 U.S. Patent Application Serial No. 08/073,755 ("the '755 application"), filed June 8, 1993, abandoned.

Initially, the '935 application contained 20 claims, including independent claims 1, 13, and 19. Prior to receiving any Office Action, the Applicant filed three Preliminary Amendments. The first Preliminary Amendment, filed on May 3, 1999, canceled claims 1 to 20 and added new 20 claims 21 to 40, the second Preliminary Amendment, filed on June 16, 1999, added a "Related Application" section to the '935 Application, and the third Preliminary Amendment, filed on February 25, 2000, added new claims 41 to 53. Among the claims added by the Preliminary Amendments, claims 21, 31, 35, 37, 41, 50, and 51 were independent claims.

On December 4, 2000, the Examiner rejected claims 21, 23-26, 28-31, 33-43, 45-48, 25 and 50-53 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,028,537 to Suman et al., rejected claims 22 and 32 under 35 U.S.C. § 103(a) as obvious in view of Suman et al., rejected claims 27, 44, and 53 under 35 U.S.C. § 103(a) obvious in view of the combination of Suman et al. and U.S. Patent No. 5,541,585 to Duhame et al., and rejected claims 26 and 49 under 35 U.S.C. § 103(a) as obvious in view of the combination of Suman et al. and U.S. Patent 30 No. 5,081,667 to Drori et al..

In its response dated March 21, 2001, the Applicant presented arguments that Suman et al. is not prior art to the '935 application. Amendment, Mar. 21, 2001, at 4. The

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Examiner then issued another Office Action, on April 16, 2001, in which all of the claims were rejected for obviousness-type double patenting over claims 1 to 20 of the '405 patent. Office Action, Apr. 16, 2001. Applicant thereafter submitted a Terminal Disclaimer over the '405 patent. Terminal Disclaimer, Apr. 30, 2001.

5 After further amendments, a Notice of Allowance issued on June 4, 2001. Claims 21-53 were allowed. The Examiner provided the following reasons for allowance, identifying the chain of three control devices:

10 [T]here are no references teaching of a control apparatus for controlling of at least one activating, deactivating, enabling and disabling of at least one of a premises having at least one of system, subsystem, component, equipment and appliance. Wherein the first control device is responsive to a second signal and the second signal is at least generated by a a [sic] second control device which is located remote from the premises. And
15 further wherein the second control device is responsive to a third control signal which is generated by a third control device which is located at a location remote from the premises and remote from the second control device.

Notice of Allowance, Jun. 4, 2001, at 2.

20 Applicant filed additional amendments on July 25, 2001, and August 22, 2001, addressing grammatical errors and antecedent basis issues. On August 29, 2001, the Applicant filed Comments on Statement of Reasons for Allowance, listing each element of each independent claim, and asserting, without any supporting argument, that the prior art does not disclose or suggest those elements.

25 On October 26, 2001, the Applicant filed a petition to withdraw the application from issue, and submitted a Request for Continued Examination, with a preliminary amendment amending, canceling, and adding claims. In the preliminary amendment, Applicant stated that the term "automatically" means "without human intervention," the term "automatically received" means "received without human intervention." Amendment, Oct. 26, 2001, at 26. Applicant then
30 filed two more preliminary amendments, on December 3 and 18, 2001, canceling several claims, adding and then canceling other claims, and adding new claims 57 to 62.

Following an interview on January 15, 2002, the Examiner's summary of the interview stated that all independent claims are allowable over the prior art of record. Applicant filed two

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