



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/013,303 07/21/2014 7,397,363 B2 3482

7590 07/29/2015
RAYMOND A. JOAO, ESQ.
122 BELLEVUE PLACE
YONKERS, NY 10703

EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

07/29/2015

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.



**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Kenyon & Kenyon LLP  
One Broadway  
New York, New York 10004

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

REEXAMINATION CONTROL NO. 90/013,303.

PATENT NO. 7,397,363 B2 E.

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)).

<b>Notice of Intent to Issue Ex Parte Reexamination Certificate</b>	<b>Control No.</b> 90/013,303	<b>Patent Under Reexamination</b> 7,397,363 B2 E	
	<b>Examiner</b> SAMUEL RIMELL	<b>Art Unit</b> 3992	<b>AIA (First Inventor to File) Status</b> No

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

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
  - (a)  Patent owner's communication(s) filed: 01 June 2015.
  - (b)  Patent owner's failure to file an appropriate timely response to the Office action mailed: \_\_\_\_\_.
  - (c)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (d)  The decision on appeal by the  Board of Patent Appeals and Interferences  Court dated \_\_\_\_\_
  - (e)  Other: Reasons for Patentability (Attached).
2. The Reexamination Certificate will indicate the following:
  - (a) Change in the Specification:  Yes  No
  - (b) Change in the Drawing(s):  Yes  No
  - (c) Status of the Claim(s):
    - (1) Patent claim(s) confirmed: 21.
    - (2) Patent claim(s) amended (including dependent on amended claim(s)): \_\_\_\_\_
    - (3) Patent claim(s) canceled: \_\_\_\_\_.
    - (4) Newly presented claim(s) patentable: \_\_\_\_\_.
    - (5) Newly presented canceled claims: \_\_\_\_\_.
    - (6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_
    - (7) Patent claim(s) not subject to reexamination: \_\_\_\_\_.
3.  A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
4.  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."
5.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
6.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
8.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some\* c)  None of the certified copies have
    - been received.
    - not been received.
    - been filed in Application No. \_\_\_\_\_.
    - been filed in reexamination Control No. \_\_\_\_\_.
    - been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.
9.  Note attached Examiner's Amendment.
10.  Note attached Interview Summary (PTO-474).
11.  Other: \_\_\_\_\_.

**All correspondence** relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/Sam Rimell/  
Primary Examiner  
Art Unit: 3992

cc: Requester (if third party requester)

### **Reasons for Patentability**

Claim 21 is the single claim subject to reexamination in this proceeding.

(a) Office Action of March 31, 2015: Claim 21 was rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Spaur et al (U.S. Patent 5,732,074) in view of Kniffen et al (U.S. Patent 6,072,402). Upon further analysis of Patent Owner's arguments of June 1, 2015, and reconsideration of the facts and evidence, it has been found that this rejection would result in a system unsatisfactory for its intended purpose, and thus would not have been obvious. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In particular, the prior art combination would result in a system where the third device (see office action at p. 3) would lack a mechanism to receive or control the direction of signals to the appropriate devices on the vehicle. The proposed combination would thus produce a device which is essentially non-operational, and thus unsatisfactory for its intended purpose. Accordingly, this rejection is hereby vacated.

(b) Spaur et al + Kniffen et al + Add a duplicate phone to device #3: Examiners considered the question of whether it would have been obvious to further modify the combination of Spaur et al and Kniffen et al to place a duplicate cellphone at the third device. However, upon making this analysis, it was found that the proposed combination would still be non-operational. In particular, a second cell phone added to the third device (office action at p.3) would be capable of receiving signals, but have no capacity to determine where the received signals are supposed to be directed. The proposed combination would thus produce a device which remains non-operational, and thus unsatisfactory for its intended purpose.

Art Unit: 3992

(c) Spaur et al + Kniffen et al + Add a duplicate phone to device #3 + Add a controller to Device #3: Examiners considered the question of whether it would have been obvious to further modify the combination of Spaur et al and Kniffen et al to place a duplicate cellphone at the third device, as well as a controller to direct signals to the appropriate devices. However, this would result in multiple equipment redundancies that are not suggested by either Spaur et al or Kniffen et al. The combination would also not otherwise provide definable advantages or improvement so as to suggest obviousness to the person of ordinary skill in the art. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). See also *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick*, 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006) *In re Maloney*, 411 F.2d 1321, 1323, 162 USPQ 98, 100 (CCPA 1969). *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-421, 82 USPQ2d 1385, 1395-97 (2007).

(d) Other Relevant Prior Art: Examiners have also considered the prior art reference to Ramono (US Patent 5,070,320). Claim 21 recites:

“..wherein the first processing device determines whether an action or an operation associated with information contained in the second signal, to at least one of activate, deactivate, disable re-enable, and control an operation of, the at least one of a vehicle system, a vehicle equipment system, a vehicle component, a vehicle device, a vehicle equipment, and a vehicle appliance, is an authorized or an allowed action or an authorized or an allowed operation,..”

Ramono recites a mobile security device 18 used by authorized personnel, but not a processing device where “the first processing device determines whether an action or an

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.