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| 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

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| EXAMINER |
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RIMELL, SAMUEL G

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| ART UNIT | PAPER NUMBER |
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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.



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(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)).

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

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(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

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