# Litigation Search Report CRU 3999

## Reexamination Control No. 90/015,287

| | | | |
|---|---|---|---|
| **To:** | WASSUM | **From:** | SALDANA |
| **Location:** | CRU | **Location:** | CRU |
| **Art Unit:** | 3992 | **Phone:** | 571-272-7740 |
| **Date:** | 12 December 2024 | **E-mail:** | MANUEL.SALDANA@USPTO.GOV |

## Search Notes

(CLOSED) 2:23cv94, The Phelan Group, Llc V. Kia Corporation Et Al
(CLOSED) 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

1. Performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
2. Performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
3. Performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
4. Performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
5. Performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

LexisNexis

**User Name:** Manuel Saldana
**Date and Time:** Thursday, December 12, 2024 9:52:00 AM EST
**Job Number:** 240685757

## Document (1)

1. 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

**Client/Matter:** -None-
**Search Terms:** number(2:23CV93)
**Search Type:** Natural Language
**Narrowed by:**

| Content Type | Narrowed by |
| --- | --- |
| Dockets | Case Status: Open,Unknown,Closed |

# 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

US District Court Docket

United States District Court, Texas Eastern

(Marshall)

**This case was retrieved on** 11/14/2024

## Header

**Case Number:** ***2:23cv93***
**Date Filed:** 03/07/2023
**Assigned To:** District Judge Rodney Gilstrap
**Referred To:** Magistrate Judge Roy S. Payne
**Nature of Suit:** Patent (830)
**Cause:** Patent Infringement
**Lead Docket:** None
**Other Docket:** None
**Jurisdiction:** Federal Question

**Class Code:** Closed
**Closed:** 11/21/2023
**Statute:** 35:271
**Jury Demand:** Both
**Demand Amount:** $0
**NOS Description:** Patent

## Participants

### Litigants

The Phelan Group, LLC
**Plaintiff**

### Attorneys

Adam G Price
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2632 Fax: 512-727-6691
Email:Aprice@dinovoprice.Com

Michael D. French
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2618 Fax: 512-727-6691
Email:Mfrench@dinovoprice.Com

Nicole E Glauser
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2638 Fax: 512-727-6691
Email:Nglauser@krameralberti.Com

Andrew Gerald DiNovo
ATTORNEY TO BE NOTICED



Manuel Saldana

| Litigants | Attorneys |
| --- | --- |
| | DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2631 Fax: 512-727-6691<br>Email:Adinovo@dinovoprice.Com |
| Toyota Motor Corporation<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor North America, Inc. | Fadi N Kiblawi |

| Litigants | Attorneys |
|---|---|
| **Defendant** | ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor Engineering & Manufacturing North America, Inc.<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com |

| Litigants | Attorneys |
| --- | --- |
| | John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor Sales, U.S.A., Inc.<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA |

| Litigants | Attorneys |
|---|---|
| | 202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Kia Corporation<br>Consolidated from 2:23-cv-94 \|<br>**Consol Defendant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071 |

| Litigants | Attorneys |
|---|---|
| | USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>Consolidated from 2:23-cv-94 \|<br>**Consol Defendant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407 |

| Litigants | Attorneys |
|---|---|
| | Email:Ryagura@omm.Com |
| Kia Corporation<br>Consolidated from 2:23-cv-94 \|<br>**Counter Claimant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>Consolidated from 2:23-cv-94 \|<br>**Counter Claimant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com |

| Litigants | Attorneys |
|---|---|
| | Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com |
| | Paige Hardy<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com |
| | Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| The Phelan Group, LLC<br>**Counter Defendant** | Adam G Price<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2632 Fax: 512-727-6691<br>Email:Aprice@dinovoprice.Com |
| | Michael D. French<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2618 Fax: 512-727-6691<br>Email:Mfrench@dinovoprice.Com |
| | Nicole E Glauser<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2638 Fax: 512-727-6691<br>Email:Nglauser@krameralberti.Com |
| | Andrew Gerald DiNovo<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2631 Fax: 512-727-6691 |

## Litigants

## Attorneys

Email:Adinovo@dinovoprice.Com

## Proceedings

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 1 | 03/07/2023 | COMPLAINT against All Defendants ( Filing fee $ 402 receipt number ATXEDC-9388646.), filed by Phelan Group, LLC. (Attachments: # 1 Civil Cover Sheet, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6)(DiNovo, Andrew) (Entered: 03/07/2023) | |
| 2 | 03/07/2023 | DEMAND for Trial by Jury by Phelan Group, LLC. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 3 | 03/07/2023 | Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 4 | 03/07/2023 | NOTICE of Attorney Appearance by Nicole E Glauser on behalf of Phelan Group, LLC (Glauser, Nicole) (Entered: 03/07/2023) | |
| 5 | 03/07/2023 | NOTICE of Attorney Appearance by Adam G Price on behalf of Phelan Group, LLC (Price, Adam) (Entered: 03/07/2023) | |
| | 03/07/2023 | Case assigned to District Judge Rodney Gilstrap and Magistrate Judge Roy S. Payne. (ch, ) (Entered: 03/07/2023) | |
| | 03/07/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (ch, ) (Entered: 03/07/2023) | |
| 6 | 03/07/2023 | CORPORATE DISCLOSURE STATEMENT filed by Phelan Group, LLC (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 7 | 03/07/2023 | SUMMONS Issued as to Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Summons(es), # 2 Summons(es), # 3 Summons(es))(ch, ) (Entered: 03/07/2023) | |
| 8 | 03/09/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Sales, U.S.A., Inc. served on 3/9/2023, answer due 3/30/2023. (DiNovo, Andrew) (Entered: 03/09/2023) | |
| 9 | 03/10/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Engineering & Manufacturing North America, Inc. served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/10/2023) | |
| 10 | 03/10/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor North America, Inc. served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/10/2023) | |
| 11 | 03/15/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Corporation served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/15/2023) | |
| 12 | 03/30/2023 | MOTION for Extension of Time to File Answer re 1 Complaint, by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Michael) (Entered: 03/30/2023) | |
| 13 | 03/31/2023 | ORDER granting 12 MOTION for Extension of Time to File | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Answer re 1 Complaint, . Signed by Magistrate Judge Roy S. Payne on 3/31/2023. (nkl, ) (Entered: 03/31/2023) | |
| 14 | 04/17/2023 | CONSOLIDATION ORDER - The above-captioned cases are hereby ORDERED to be CONSOLIDATED for all pretrial issues with the LEAD CASE, Case No. 2:23-cv-00093. All parties are instructed to file any future filings in the LEAD CASE. Signed by District Judge Rodney Gilstrap on 4/17/2023. (ch, ) (Entered: 04/18/2023) | |
| 15 | 04/19/2023 | ORDER - Scheduling/Case Management Conference set for 5/30/2023 01:30 PM before District Judge Rodney Gilstrap. Signed by Magistrate Judge Roy S. Payne on 4/19/2023. (ch, ) (Entered: 04/19/2023) | |
| 16 | 04/26/2023 | NOTICE of Attorney Appearance by Cason Garrett Cole on behalf of Kia America, Inc., Kia Corporation (Cole, Cason) (Entered: 04/26/2023) | |
| 17 | 04/27/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Paige Hardy, I on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9471658. (Hardy, Paige) (Entered: 04/27/2023) | |
| 18 | 05/02/2023 | Unopposed MOTION for Extension of Time to File Answer re 1 Complaint, and Waiver of Foreign Service Requirement by Kia America, Inc., Kia Corporation. (Attachments: # 1 Text of Proposed Order)(Yagura, Ryan) (Entered: 05/02/2023) | |
| 19 | 05/04/2023 | NOTICE of Attorney Appearance by John Frank Rabena on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc. (Rabena, John) (Entered: 05/04/2023) | |
| 20 | 05/04/2023 | ORDER granting 18 Motion for Extension of Time to Answer re 18 Unopposed MOTION for Extension of Time to File Answer re 1 Complaint, and Waiver of Foreign Service Requirement. Signed by Magistrate Judge Roy S. Payne on 5/4/2023. (ch, ) (Entered: 05/04/2023) | |
| | 05/04/2023 | Answer Due Deadline Updated for Kia America, Inc. to 6/14/2023; Kia Corporation to 6/14/2023. (ch, ) (Entered: 05/04/2023) | |
| 21 | 05/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Yoshinari Kishimoto on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9492507. (Kishimoto, Yoshinari) (Entered: 05/10/2023) | |
| 22 | 05/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Tyler Del Rosario on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9492561. (Del Rosario, Tyler) (Additional attachment(s) added on 5/10/2023: # 1 Sealed Attachment) (nkl, ). (Entered: 05/10/2023) | |
| 23 | 05/11/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by William H Mandir on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9495106. (Mandir, William) (Entered: 05/11/2023) | |
| 24 | 05/12/2023 | Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions) by The Phelan Group, LLC. (Attachments: # 1 Text of Proposed Order)(DiNovo, Andrew) (Entered: 05/12/2023) | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 25 | 05/15/2023 | NOTICE of Attorney Appearance by Michael D. French on behalf of The Phelan Group, LLC (French, Michael) (Entered: 05/15/2023) | |
| 26 | 05/15/2023 | ORDER granting 24 Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions). Signed by Magistrate Judge Roy S. Payne on 5/15/2023. (ch, ) (Entered: 05/16/2023) | |
| 27 | 05/16/2023 | AMENDED ORDER re 24 Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions). Signed by Magistrate Judge Roy S. Payne on 5/16/2023. (ch, ) (Entered: 05/16/2023) | |
| 28 | 05/25/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Fadi N Kiblawi on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9517691. (Kiblawi, Fadi) (Entered: 05/25/2023) | |
| | 05/30/2023 | Minute Entry for proceedings held before District Judge Rodney Gilstrap: Scheduling Conference/Case Management Conference held on 5/30/2023. Counsel for the parties appeared. Court asked whether they consented to trial before the U.S. Magistrate Judge. Court then gave counsel Claim Construction and Jury Selection/Trial dates. (Court Reporter Shawn McRoberts) (aeb) (Entered: 06/01/2023) | |
| 29 | 06/05/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Kia America, Inc., Kia Corporation (Yagura, Ryan) (Entered: 06/05/2023) | |
| 30 | 06/13/2023 | Joint MOTION for Entry of Agreed Proposed DCO by The Phelan Group, LLC. (Attachments: # 1 Exhibit A - Agreed Proposed DCO)(DiNovo, Andrew) (Entered: 06/13/2023) | |
| 31 | 06/13/2023 | Joint MOTION for Entry of Agreed Proposed Discovery Order by The Phelan Group, LLC. (Attachments: # 1 Exhibit A - Agreed Proposed DO)(DiNovo, Andrew) (Entered: 06/13/2023) | |
| 32 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Engineering & Manufacturing North America, Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 33 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Corporation (Smith, Michael) (Entered: 06/14/2023) | |
| 34 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Sales, U.S.A., Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 35 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor North America, Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 36 | 06/14/2023 | DOCKET CONTROL ORDER- Markman Hearing set for 6/27/2024 09:00 AM before Magistrate Judge Roy S. Payne., Jury Selection set for 12/9/2024 09:00AM before District Judge Rodney Gilstrap., Pretrial Conference set for 11/5/2024 01:30 PM before Magistrate Judge Roy S. Payne.). Signed by Magistrate Judge Roy S. Payne on 06/14/2023. (klc, ) (Entered: 06/14/2023) | |
| 37 | 06/14/2023 | DISCOVERY ORDER re 31 Motion for Entry of Agreed Proposed Discovery Order. Signed by Magistrate Judge Roy S. Payne on 6/14/2023. (nkl, ) (Entered: 06/14/2023) | |
| 38 | 06/14/2023 | Kia Corporation and Kia America, Inc.'s ANSWER to 1 Complaint, Affirmative Defense, and, COUNTERCLAIM against The Phelan Group, LLC by Kia Corporation, Kia America, Inc..(Yagura, Ryan) (Entered: 06/14/2023) | |
| 39 | 06/14/2023 | ANSWER to 1 Complaint, by Toyota Motor Corporation, Toyota | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc..(Smith, Michael) (Entered: 06/14/2023) | |
| | 06/15/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 06/15/2023) | |
| | 06/15/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 06/15/2023) | |
| 40 | 06/16/2023 | Joint MOTION to Amend/Correct - Joint Motion to Amend the Docket Control Order to Provide Additional Time to File the Protective Order and to Serve Initial Disclosures by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 06/16/2023) | |
| 41 | 06/19/2023 | NOTICE by The Phelan Group, LLC Plaintiff's Notice of Compliance (DiNovo, Andrew) (Entered: 06/19/2023) | |
| 42 | 06/20/2023 | ORDER granting 40 Joint MOTION to Amend/Correct - Joint Motion to Amend the Docket Control Order to Provide Additional Time to File the Protective Order and to Serve Initial Disclosures. Signed by Magistrate Judge Roy S. Payne on 6/20/2023. (ch, ) (Entered: 06/20/2023) | |
| 43 | 06/26/2023 | Joint MOTION for Protective Order by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 44 | 06/26/2023 | NOTICE of Discovery Disclosure by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc. (Initial and Additional Disclosures) (Smith, Michael) (Entered: 06/26/2023) | |
| 45 | 06/26/2023 | Joint MOTION to Amend/Correct 36 Order,, Set Deadlines/Hearings, by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 46 | 06/26/2023 | Joint MOTION Focusing Patent Claims and Prior Art to Reduce Costs by Kia America, Inc., Kia Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 47 | 06/26/2023 | NOTICE by Kia America, Inc., Kia Corporation - Notice of Compliance Regarding Initial Disclosures (Yagura, Ryan) (Entered: 06/26/2023) | |
| 48 | 06/28/2023 | PROTECTIVE ORDER granting 43 Joint Motion for Protective | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Order. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 49 | 06/28/2023 | SECOND AMENDED DOCKET CONTROL ORDER granting 45 Joint MOTION to Amend/Correct 36 Order,, Set Deadlines/Hearings. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 50 | 06/28/2023 | ORDER FOCUSING PATENT CLAIMS AND PRIOR ART TO REDUCE COSTS granting 46 Joint MOTION Focusing Patent Claims and Prior Art to Reduce Costs. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 51 | 07/05/2023 | ANSWER to 38 Answer to Complaint, Counterclaim by The Phelan Group, LLC.(DiNovo, Andrew) (Entered: 07/05/2023) | |
| 52 | 07/27/2023 | Joint MOTION to Amend/Correct Joint Motion for Entry of Agreed Proposed Amended Docket Control Order by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 07/27/2023) | |
| 53 | 07/28/2023 | THIRD AMENDED DOCKET CONTROL ORDER granting 52 Joint MOTION to Amend/Correct Joint Motion for Entry of Agreed Proposed Amended Docket Control Order. Signed by Magistrate Judge Roy S. Payne on 7/28/2023. (ch, ) (Entered: 07/28/2023) | |
| 54 | 08/18/2023 | Joint MOTION to Stay All Deadlines and Notice of Settlement in Principle by The Phelan Group, LLC. (Attachments: # 1 Proposed Order Staying Case Deadlines)(DiNovo, Andrew) (Entered: 08/18/2023) | |
| 55 | 08/23/2023 | ORDER granting 54 Motion to Stay All Deadlines and Notice of Settlement in Principle. Signed by Magistrate Judge Roy S. Payne on 8/22/2023. (nkl, ) (Entered: 08/23/2023) | |
| 56 | 08/31/2023 | Agreed MOTION for Entry of Fourth Amended Scheduling Order by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 08/31/2023) | |
| 57 | 09/09/2023 | JOINT MOTION to Stay All Deadlines and Notice of Settlement by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 09/09/2023) | |
| 58 | 09/11/2023 | ORDER granting 57 Motion to Stay all Deadlines and Notice of Settlement. Signed by Magistrate Judge Roy S. Payne on 9/10/2023. (nkl, ) (Entered: 09/11/2023) | |
| 59 | 09/20/2023 | JOINT MOTION to Continue the Stay of All Deadlines Pending Settlement by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 09/20/2023) | |
| 60 | 09/23/2023 | ORDER granting 59 JOINT MOTION to Continue the Stay of All Deadlines Pending Settlement. ORDERED that all pending deadlines in Case No. 2:23-cv-00094-JRG-RSP are stayed for thirty (30) days from the date of this Order. Signed by Magistrate Judge Roy S. Payne on 9/23/2023. (ch, ) (Entered: 09/25/2023) | |
| 61 | 10/11/2023 | JOINT MOTION to Stay of All Deadlines Pending Settlement by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 10/11/2023) | |
| 62 | 10/13/2023 | ORDER granting 61 JOINT MOTION to Stay of All Deadlines Pending Settlement. Signed by Magistrate Judge Roy S. Payne on 10/13/2023. (ch, ) (Entered: 10/16/2023) | |
| 63 | 10/23/2023 | JOINT MOTION to Continue Stay Pending Settlement by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(DiNovo, | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Andrew) (Entered: 10/23/2023) | |
| 64 | 10/24/2023 | ORDER granting 63 JOINT MOTION to Continue Stay Pending Settlement. Signed by Magistrate Judge Roy S. Payne on 10/24/2023. (ch, ) (Entered: 10/24/2023) | |
| 65 | 11/06/2023 | STIPULATION of Dismissal with Prejudice by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(DiNovo, Andrew) (Entered: 11/06/2023) | |
| 66 | 11/14/2023 | STIPULATION of Dismissal by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(Glauser, Nicole) (Entered: 11/14/2023) | |
| 67 | 11/21/2023 | ORDER. The Court ACCEPTS AND ACKNOWLEDGES that all claims and causes of action asserted between Plaintiff The Phelan Group and Defendant Toyota in lead case 2:23-cv-0093 are DISMISSED WITH PREJUDICE. Each party is to bear its own costs, expenses, and attorneys' fees. All pending requests for relief not explicitly granted herein are DENIED AS MOOT. The Clerk of Court is directed to CLOSE cases 2:23-cv-00093 and 2:23-cv-00094 as no parties or claims remain. Signed by District Judge Rodney Gilstrap on 11/21/2023. (slo) (Entered: 11/22/2023) | |

## Patents

| Number | Title | Issued | Class | Subclass |
|---|---|---|---|---|
| 8,417,415 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/09/2013 | 701 | 29.2 |
| 8,958,929 | Vehicle control apparatus | 02/17/2015 | 701 | 2 |
| 9,045,101 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/02/2015 | 1 | 1 |
| 9,440,660 | Method for remote communication with and through a vehicle | 09/13/2016 | 1 | 1 |
| 9,493,149 | Driver authentication system and method for monitoring and controlling vehicle usage | 11/15/2016 | 1 | 1 |
| 9,908,508 | Driver authentication system and method for monitoring and controlling vehicle usage | 03/06/2018 | 1 | 1 |
| 10,259,465 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,259,470 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,414,275 | Instrument cluster arrangements for vehicles | 09/17/2019 | 1 | 1 |
| 10,493,957 | Operational mode change based on vehicle occupancy for an autonomous vehicle | 12/03/2019 | 1 | 1 |
| 10,860,025 | Modeling graph of interactions between agents | 12/08/2020 | 1 | 1 |
| 11,352,020 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/07/2022 | 1 | 1 |

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**Job Number:** 240685561

## Document (1)

1. 2:23cv94, The Phelan Group, Llc, V. Kia Corporation Et Al

**Client/Matter:** -None-
**Search Terms:** number(2:23CV94)
**Search Type:** Natural Language
**Narrowed by:**

| Content Type | Narrowed by |
| --- | --- |
| Dockets | Case Status: Open,Unknown,Closed |

# 2:23cv94, The Phelan Group, Llc V. Kia Corporation Et Al

US District Court Docket

United States District Court, Texas Eastern

(Marshall)

**This case was retrieved on** 11/14/2024

## Header

**Case Number:** ***2:23cv94***
**Date Filed:** 03/07/2023
**Assigned To:** District Judge Rodney Gilstrap
**Referred To:** Magistrate Judge Roy S. Payne
**Nature of Suit:** Patent (830)
**Cause:** Patent Infringement
**Lead Docket:** None
**Other Docket:** None
**Jurisdiction:** Federal Question

**Class Code:** Closed
**Closed:** 11/21/2023
**Statute:** 35:271
**Jury Demand:** Plaintiff
**Demand Amount:** $0
**NOS Description:** Patent

## Participants

### Litigants

The Phelan Group, LLC
**Plaintiff**

Kia Corporation
**Defendant**

### Attorneys

Adam G Price
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2632 Fax: 512-727-6691
Email:Aprice@dinovoprice.Com

Nicole E Glauser
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2638 Fax: 512-727-6691
Email:Nglauser@krameralberti.Com

Andrew Gerald DiNovo
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2631 Fax: 512-727-6691
Email:Adinovo@dinovoprice.Com

Cason Garrett Cole
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP



Manuel Saldana

| Litigants | Attorneys |
| --- | --- |
| | Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>**Defendant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor |

## Litigants

## Attorneys

Los Angeles, CA 90071
USA
213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com

Paige Hardy
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP
400 South Hope Street 18th Floor
Los Angeles, CA 90071
USA
213-430-6000 Email:Phardy@omm.Com

Ryan K Yagura
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP - LA
400 South Hope Street 18th Floor
Los Angeles, CA 90071
USA
213/430-6189 Fax: 213-430-6407
Email:Ryagura@omm.Com

## Proceedings

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 1 | 03/07/2023 | COMPLAINT against All Defendants ( Filing fee $ 402 receipt number ATXEDC-9388902.), filed by Phelan Group, LLC. (Attachments: # 1 Civil Cover Sheet, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6)(DiNovo, Andrew) (Entered: 03/07/2023) | |
| 2 | 03/07/2023 | DEMAND for Trial by Jury by Phelan Group, LLC. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 3 | 03/07/2023 | Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 4 | 03/07/2023 | NOTICE of Attorney Appearance by Nicole E Glauser on behalf of Phelan Group, LLC (Glauser, Nicole) (Entered: 03/07/2023) | |
| 5 | 03/07/2023 | NOTICE of Attorney Appearance by Adam G Price on behalf of Phelan Group, LLC (Price, Adam) (Entered: 03/07/2023) | |
| 6 | 03/07/2023 | CORPORATE DISCLOSURE STATEMENT filed by Phelan Group, LLC (DiNovo, Andrew) (Entered: 03/07/2023) | |
| | 03/07/2023 | Case Assigned to District Judge Rodney Gilstrap and Magistrate Judge Roy S. Payne. (nkl, ) (Entered: 03/07/2023) | |
| | 03/07/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 03/07/2023) | |
| 7 | 03/07/2023 | SUMMONS Issued as to Kia America, Inc. c/o CT Corporation System, Kia Corporation c/o Texas Secretary of State. (Attachments: # 1 Summons(es))(nkl, ) (Entered: 03/07/2023) | |
| 8 | 03/13/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Kia Corporation served on 3/10/2023, answer due 3/31/2023. | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | (DiNovo, Andrew) (Entered: 03/13/2023) | |
| 9 | 03/13/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Kia America, Inc. served on 3/9/2023, answer due 3/30/2023. (DiNovo, Andrew) (Entered: 03/13/2023) | |
| 10 | 03/30/2023 | NOTICE of Attorney Appearance by Ryan K Yagura on behalf of Kia America, Inc., Kia Corporation (Yagura, Ryan) (Entered: 03/30/2023) | |
| 11 | 03/30/2023 | Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Kia Corporation.( Yagura, Ryan) (Entered: 03/30/2023) | |
| 12 | 03/30/2023 | Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Kia America, Inc..( Yagura, Ryan) (Entered: 03/30/2023) | |
| | 03/30/2023 | Defendant's Unopposed FIRST Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Kia Corporation to 5/15/2023. 45 Days Granted for Deadline Extension.( ch, ) (Entered: 03/30/2023) | |
| | 03/30/2023 | Defendant's Unopposed FIRST Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Kia America, Inc. to 5/14/2023. 45 Days Granted for Deadline Extension.( ch, ) (Entered: 03/30/2023) | |
| 13 | 04/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Clarence Rowland on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9444625. (Rowland, Clarence) (Entered: 04/10/2023) | |
| 14 | 04/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Nicholas J Whilt on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9444641. (Whilt, Nicholas) (Entered: 04/10/2023) | |
| 15 | 04/17/2023 | CONSOLIDATION ORDER - The above-captioned cases are hereby ORDERED to be CONSOLIDATED for all pretrial issues with the LEAD CASE, Case No. 2:23-cv-00093. All parties are instructed to file any future filings in the LEAD CASE. Signed by District Judge Rodney Gilstrap on 4/17/2023. (ch, ) (Entered: 04/18/2023) | |
| 16 | 04/26/2023 | ***FILED IN ERROR***NOTICE of Attorney Appearance by Cason Garrett Cole on behalf of Kia America, Inc., Kia Corporation (Cole, Cason) Modified on 4/26/2023 (ch, ). (Entered: 04/26/2023) | |
| | 04/26/2023 | ***FILED IN ERROR. NEED TO FILE IN THE LEAD CASE. Document # 16, Notice of Appearance. PLEASE IGNORE.*** (ch, ) (Entered: 04/26/2023) | |
| 17 | 09/23/2023 | ORDER - ORDERED that all pending deadlines in Case No. 2:23-cv-00094-JRG-RSP arestayed for thirty (30) days from the date of this Order. Signed by Magistrate Judge Roy S. Payne on 9/23/2023. (ch, ) (Entered: 09/25/2023) | |
| 18 | 11/21/2023 | ORDER. All claims and causes of action asserted by Plaintiff The Phelan Group against Defendants Kia in member case 2:23-cv-00094-JRG-RSP are DISMISSED WITH PREJUDICE. All claims and causes of action asserted by Defendant Kia against Plaintiff The Phelan Group are DISMISSED WITHOUT PREJUDICE. Each party is to bear its own costs, expenses, and attorneys fees. All pending requests for relief not explicitly granted herein are DENIED AS MOOT. The Clerk of Court is directed to CLOSE cases 2:23-cv-00093 and 2:23 cv-00094 as no parties or claims remain. Signed by District Judge Rodney Gilstrap on 11/221/2023. (slo, ) (Entered: 11/22/2023) | |

| Number | Title | Issued | Class | Subclass |
|---|---|---|---|---|
| 9,045,101 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/02/2015 | 1 | 1 |
| 9,493,149 | Driver authentication system and method for monitoring and controlling vehicle usage | 11/15/2016 | 1 | 1 |
| 9,908,508 | Driver authentication system and method for monitoring and controlling vehicle usage | 03/06/2018 | 1 | 1 |
| 10,259,465 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,259,470 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 11,352,020 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/07/2022 | 1 | 1 |

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# FAX COVER SHEET

| | |
|---|---|
| TO | Commissioner for Patents |
| COMPANY | USPTO |
| FAX NUMBER | 15712739900 |
| FROM | Adam Price |
| DATE | 2024-11-25 21:06:03 GMT |
| RE | Appeal Brief (Appl No. 90/015,287) |

## COVER MESSAGE

Attached please find a courtesy copy of Patent Owner's Appeal Brief and Claims Appendix.



PAGE 1/47 * RCVD AT 11/25/2024 4:07:31 PM [Eastern Standard Time] * SVR:W-PTOFAX-DTS-E1/28 * DNIS:2739900 * CSID:15127276691 * ANI:3055038807 * DURATION (mm-ss):24-16

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| *Ex Parte* Reexamination of<br>U.S. Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

## PATENT OWNER'S APPEAL BRIEF IN *EX PARTE* REEXAMINATION

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant Patent Owner presents this Appeal Brief in the *ex parte* reexamination of U.S. Patent No. 10,259,470 ("'470 Patent"). This brief is filed under 37 C.F.R. §41.37(a) in furtherance of the Notice of Appeal filed for this reexamination on September 23, 2024, regarding the decision of the Examiner of Group 3992 set forth in the Final Office Action dated May 23, 2024 ("Final Office Action") and the Advisory Action dated August 20, 2024 ("Advisory Action"). The First Office Action in this case was issued on February 15, 2024 ("First Office Action").



PAGE 2/47 * RCVD AT 11/25/2024 4:07:31 PM [Eastern Standard Time] * SVR:W-PTOFAX-DTS-E1/28 * DNIS:2739900 * CSID:15127276691 * ANI:3055038807 * DURATION (mm-ss):24-16

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## I. REAL PARTY IN INTEREST

The real party in interest is The Phelan Group, LLC, the assignee of record of the '470 Patent, as indicated by an assignment recorded on September 12, 2018, at reel/frame 046851/0608.

## II. RELATED APPEALS, INTERFERENCES AND TRIALS

The '470 Patent is related to the following matters:

1. *The Phelan Group, LLC v. Mercedes-Benz Group AG*, 2:23-cv-607-JRG (EDTX).

2. *The Phelan Group, LLC v. State Farm Mutual Automobile Insurance Co.*, 2:23-cv-611-JRG (EDTX).

3. *The Phelan Group, LLC v. Honda Motor Co., Ltd*, 2:23-cv-606-JRG (EDTX).

## III. STATUS OF THE CLAIMS

The '470 Patent was issued on April 16, 2019 with twenty (20) claims. A request for *ex parte* reexamination, filed August 31, 2023, requested reexamination of claims 1 and 4 of the '470 Patent. The request was granted on October 17, 2023, resulting in the reexamination of claims 1 and 4, both of which currently stand twice and finally rejected.

Pursuant to 37 C.F.R. § 41.37(c)(1)(iii), the following summary is a concise explanation of the subject matter defined in each of the rejected claims 1 and 4 and



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refers to the drawings and specification in the '470 Patent as issued. This particular explanation is for assistance of the Board, by way of example, and is not intended to limit or interpret the claims in any way. Further, for each feature of the claims, there may be additional supportive disclosure in the specification beyond what is cited below.

## IV. STATUS OF THE AMENDMENTS

Applicant has not filed any amendment in this *ex parte* reexamination.

## V. SUMMARY OF THE CLAIMED SUBJECT MATTER

1. A vehicle control system (1:31-35; 6:8-12; FIG. 5), comprising:

a wireless identification and data logging module (7:9-14; FIG.5);

a master control unit (7:29-32; 7:58-62; FIG. 5) in a vehicle for wirelessly authenticating at least one occupant via said wireless driver identification and data logging module (12:37-42; FIG. 5) and associating an operating profile with said at least one occupant (2:37-50; 7:5-8; FIG. 5);

a module for receiving at least location and speed information in association with movement of said motor vehicle (12:37-59);

a data logging device that records vehicle operation data associated with a use of said vehicle (7:46-57; FIG. 5), the vehicle operation data comprising at least said location and speed information received from said module (12:43-48; FIG. 5);

and a slave control unit (6:8-11; 10:48-61; 11:8-22; FIG. 5) in said motor vehicle and in communication with said master control unit (10:48-61; 11:8-22; FIG.



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5),

wherein said slave control unit receives commands from said master control unit and generate an alarm signal (11:45-58; 12:47-55; FIG. 5);

wherein said master control unit provides operation governance of said vehicle (3:4-7; 12:15-18) within an operating profile (2:37-50; 7:5-8; FIG. 5).

4. The vehicle control system of claim 1 (1:31-35; 6:8-12; FIG. 5) wherein said wireless identification and data logging module (7:9-14; FIG.5) comprises at least one of:

a WIFI enabled device; an RFID enabled device; a Bluetooth enabled device; a cellular telephone; and a smartphone (7:9-25).

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." *Id.* at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile that matches requirements of the high-risk driver." *Id.* at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit



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> receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

*Id.* at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are control units, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:

> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.
>
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.



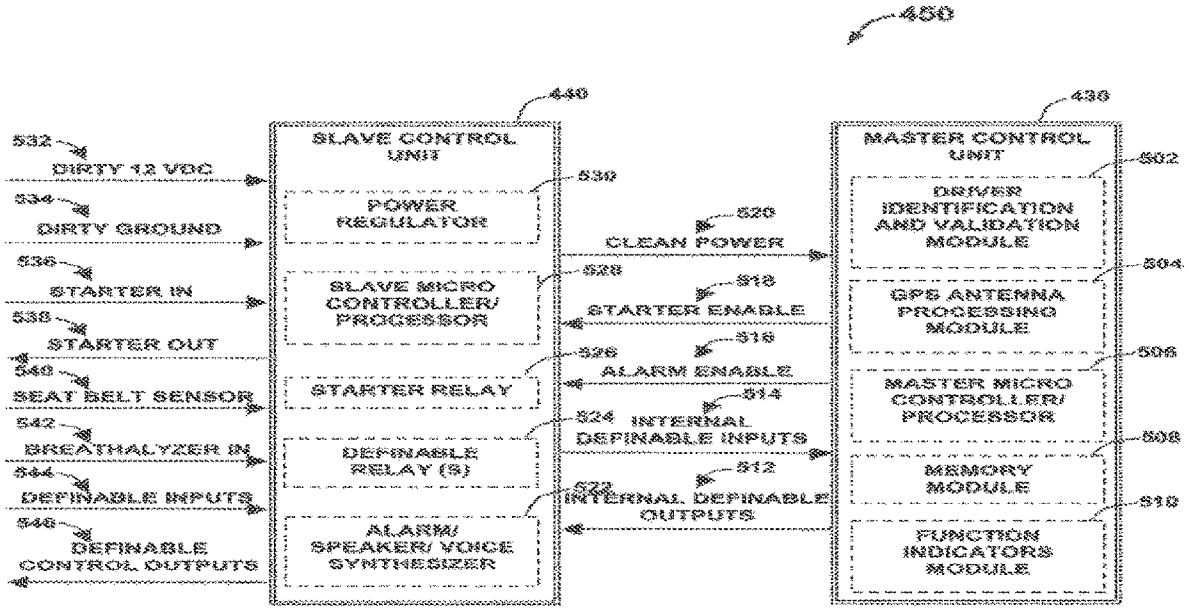
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As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.




*Id.* at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." *Id.* at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an



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> actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

## VI. SUMMARY OF THE ARGUMENT

As set forth below, while the Examiner has given this case careful consideration, an error recurs in the analysis. With respect to master control unit and slave control unit, the Examiner appears to collapse both elements into a single communication between them. *See* Advisory Action at 5 ("the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit"). In doing so, there is no construction of "master control unit" or "slave control unit," which are terms that have been construed by this tribunal previously, consistently with the construction advanced by Appellant. Dictionaries cited by the Examiner ignore the "control unit" designation for each of those two elements in the claims, resulting in the deviation between the two positions. Of course, claim elements should not be read so as to render key claim terms superfluous.



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A similar problem arises in connection with the claimed "a wireless identification and data logging module (7:9-14; FIG.5)." The Examiner assert that "The Office initially notes that the claimed wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But the data logging device itself is claimed as a wireless device, so that is not the case; a POSITA would understand identification and data logging communications to be communicated wirelessly.

Cherouny discloses an exclusively wired communication that is especially adapted to prevent tampering. Cherouny explicitly requires that "all the various electronic modules" are wired together, including with a specialized wiring harness, so that if any component is removed, presumably including whatever component would be alleged to be the claimed component is removed, the system is alerted to that problem. Thus, Cherouny is directed to a different problem, and specifically teaches away from wireless communications for data logging.

Claim 1 of the '470 Patent also requires that speed and location information are received "***in association with a movement of said vehicle***." Cherouny discloses that speed information is determined not from "movement of said vehicle," but rather clock cycles associated with wheel sensors.

Examiner also improperly relies on the same structure (car monitor 170 of Cherouny) to teach two separate claim elements—the data logging device and the



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identification and data logging module recited in claim 1 of the '470 Patent. It is with these foundational elements in mind that we respectfully submit the following arguments for consideration.

## VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicant appeals the rejections of claims 1 and 4 of the '470 Patent.

Ground 1: Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter.

Ground 2: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman.

Ground 3: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik.

Ground 4: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

## VIII. ARGUMENT

### A. GROUND 1 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF HARTER)

#### 1. NO MOTIVATION TO COMBINE CHEROUNY WITH HARTER EXISTS.

The combination of Cherouny and Harter is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*,



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964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).

The Examiner correctly notes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 18. On the contrary, Cherouny teaches secure wired communication with dummy wires to prevent tampering.

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is



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> broken for even a moment the event is recorded and documented.

Cherouny at ¶33. Therefore, it would not have been "obvious to try" modifying Cherouny with Harter's disclosure of a wireless device because that is taught against by Cherouny itself.

In the Advisory Action at page 3, the Examiner acknowledges that the claimed wireless communication includes wirelessly authenticating the driver of the vehicle. More specifically, the claim requires: "a master control unit in a vehicle for wirelessly authenticating at least one occupant." The Examiner then states that "the wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But that characterization misses two elements: the previously claimed "wireless identification and data logging module" and the "master control unit" itself, which is engaging in wireless communication with it per the claim. Thus, the Examiner's efforts to distill the claimed wireless functionality to a single communication is incorrect; each of those components must communicate wirelessly per the express claim language. The Examiner makes a similarly incorrect slight of hand by defining "master control unit" and a "slave control unit" by the claimed communication between them, instead of evaluating the meaning of the terms to a POSITA. *See* Advisory Action at 5. As set forth above, the "data logging module" is explicitly wired in a very particular way in Cherouny.

As set forth below, the Examiner largely ignores the "master control unit" and



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"slave control unit" other than as to a single communication. But Cherouny's CPU is wired. As set forth in the specification:

> ***The CPU module is wired to the under the hood box and a connection to that wiring in the back of the dash mounting holder.*** The holder guides the CPU modules into the connector as the CPU module is inserted into the holder. The programmable unit is contained in a module which controls the speed of the vehicle and the memory function of the module itself. The unit is essentially a hand-held computer that is an integrated, low-voltage, Single chip implementation of a high-performance 32 bit, X-scale compatible microprocessor with the extra logic needed for PC/AT compatible PCs. It has a AMD386 or more advanced chip CPU core with a memory control unit, ISA bus controller and peripheral control logic.

Cherouny at ¶17.

Thus, a person of ordinary skill would not be motivated to combine Harter or any other reference relating to wireless communication with Cherouny, which is directed to preventing interception, cessation or modification of data with a specific wired connection within the vehicle, and which teaches fully away from wireless communications because of its different objectives. *Id.* at ¶33.

### 2. CHEROUNY DOES NOT DISCLOSE A MASTER CONTROL UNIT AS PROPERLY CONSTRUED.

Cherouny does not disclose the "master control unit" of claim 1 as properly construed. Examiner alleged in the Final Office Action that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's



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> data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).

May 23, 2024 Final Office Action at 16-17.

The Examiner argued that "there does not appear to be an allegation that Cherouny does not disclose the claimed master control unit, only that it is implemented differently." *Id.* at 9. That assertion is incorrect. Bilateral communication is required between a master control unit and a slave control unit. That is claimed and stated clearly in the prosecution history. Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Prosecution History-related patent to the '470 Patent).

The '470 Patent's master control unit is designed to identify a driver profile in which the vehicle operates and for controlling various vehicle system components and has all the necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny. For example, the master control unit 430 of the '470 Patent includes a driver identification and validation module 502, a GPS antenna processing module 504, a master micro controller/processor 506, a memory module 508 and a function indicators module 510. '470 Patent at FIG. 6.

The communications interfaces of the master control unit 430 depicted in the specification include outputs such as starter enable 518, alarm enable 516, and internal definable outputs 512. The inputs include clean power 520 and other



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internal definable inputs 514. *Id.* at 10:48-11:52; FIG. 6.

The master control unit is to be understood in a specific systemic context, namely its relationship to the "slave control unit" claimed in claim 1 and discussed in "Limitation 1(e)" below. The master control unit and slave control unit "communicate," as set forth in claim 1. *See also* IEEE 100 Authoritative Dictionary, "master": "a device that initiates communications requests to gather data or perform controls." As stated in prosecution, "the master and slave control units claimed work in parallel and ***thus require bidirectional communication***." Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Patent Prosecution History) (emphasis added).

Cherouny, in contrast, discloses a microprocessor that performs calculations and processes data based on inputs. These inputs include inputs from an automobile speed sensor 108, a key fob reader 109, and power conditioning 110. Cherouny at [0073], FIG. 20A. The microprocessor in turn provides simple instructions to peripheral components to execute functions such an audible noise generator 121, which Examiner identifies as a "slave control unit." *Id.* at [0077], [0078], FIG. 20A.

As set forth in more detail in connection with Section 1(e) ("slave control unit"), a control unit is a term of skill in the art. Likewise, a "master" and "slave" relationship is well understood, and the intrinsic record is clear that bidirectional communication is required. These terms are understood in the context of the



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specification, which supports a construction of "master control unit" that requires bidirectional communication. There is no communication received from the noise generator in Cherouny.

In the Advisory Action, Examiner asserted that "the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit" and that "the reception of commands by the slave control unit constitutes the claimed 'communication.'" Advisory Action at 5. First, Examiner effectively ignores the claimed control units, and instead looks only to the presence of a communication. Respectfully, the terms "master control unit" and "slave control unit" must be understood as a POSITA would, as a control unit having a processor or microcontroller, having bidirectional communication and controlling components in their own right.

Moreover, as to the characterization of the communications themselves, Patent Owner respectfully disagrees. The claim language expressly states: "a slave control unit…which communicates with said master control unit wherein said slave control unit receives commands from said master control unit." '470 Patent at 14:19-22. In other words, the language requires the slave to be able to send signals to communicate with the master ***and*** receive commands/signals from the master control unit. This understanding is borne out consistently in the intrinsic record, including



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the figures and prosecution history.

Examiner also argued in the Advisory Action that during original prosecution, that Examiner "found the arguments not persuasive and maintained the rejection" with respect to the "bilateral communication" argument that Patent Owner made in the U.S. Patent No. 8,417,415 prosecution history. Advisory Action at 6. While it is true that the Examiner found the argument Applicant made differentiating the claim language and the cited prior art (Gratz) unpersuasive, he did not imply or state that the claim language did not require bi-directional communication as Applicant asserted.

Examiner further cited two references purporting to support his position that bi-directional communication is not inherent in a master-slave relationship. Advisory Action at 7. In doing so, he completely ignores the phrase "control unit" appended to each of "master" and "slave," which is improper and results in error. A control unit is a well understood term, and that understanding is corroborated by the prosecution history.

Even so, one of the selected references cited by the Examiner discloses that the slave responds/communicates with the master device. The cited PC Magazine references notes, "one device acts as the controller (the master) and initiates the commands, and the other devices (the slaves) ***respond*** accordingly. (emphasis added). Regardless, the Patent Owner's argument is not that bi-directional



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communication is inherent in all master-slave relationships, but rather that in view of the intrinsic record (prosecution history/specification and drawings) as previously discussed, bi-directional communication is required for claim 1 of the '470 Patent.

The Examiner acknowledged "that in Fig. 6 of the '470 patent, there are two signals illustrated that are from the slave control unit to the master control unit; clean power 520 and internal definable inputs 514." Advisory Action at 7. The Examiner alleged, however, that "the '470 patent includes no disclosure as to the nature of these signals, and there is no disclosed nor claimed use of these signals." *Id.* at 8. This is both irrelevant and inaccurate. The presence of the arrows showing commands from the slave control unit to the master control along with the arrows showing commands from the master control unit to the slave control unit in FIG. 6 clearly depict the bi-directional flow Patent Owner argues is required in the '470 Patent regardless of whether the nature of the signals is detailed. Moreover, the '470 Patent does discuss these signals, stating "the master control unit 430 and the slave control unit 440 can be communicated via various communication signal lines such as clean power signal 520, an alarm enable signal 516, internal definable input signal 514 and an internal definable output signal 512." '470 Patent at 11:16-22.

### 3. CHEROUNY DOES NOT DISCLOSE RECEIVING LOCATION AND SPEED INFORMATION IN ASSOCIATION WITH A MOVEMENT OF A VEHICLE.

Cherouny does not disclose receiving location and speed information "*in*



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***association with a movement of a vehicle***" as required by claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor 108, [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1).

May 23, 2024 Final Office Action at 17.

Examiner alleged that "[t]he limitation also merely recites the receipt of speed information and location information" and "[t]here is no limitation regarding the mechanism for deriving said information." May 23, 2024 Final Office Action at 11. Patent Owner disagrees. This limitation of the '470 Patent requires that speed and location information are received "***in association with a movement of said vehicle***." Cherouny discloses that speed information is determined ***not*** from "movement of said vehicle," but rather clock cycles associated with wheel sensors. Cherouny never uses vehicle movement to determine speed. On the contrary, Cherouny states:

> ***The instant device counts clock cycles between rising edges as well as any other part***, such as the falling edges or even voltage levels, of the square wave coming from an additional wheel sensor similar to the antilock ABS sensors on one of the wheels. This digital computer ***version of speed detection is unique when used with the other features of the device.***



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Cherouny at [0011], [0015] (emphasis added).

Hence, Cherouny's methodology for estimating speed—clock cycles and wheel rotation—does not teach or suggest this claim limitation. Cherouny's sole mention of GPS is so that the system can be made aware of school zones. *Id.* at [0010], [0020]. Cherouny never teaches or suggests using GPS to determine speed and location based on vehicle movement.

Examiner admitted in the Advisory Action that "Cherouny's mechanism for measuring vehicle speed involves the counting of pulses generated by speed sensors integrated with the antilock brake device or other sensor on the wheel, generating a square wave as the wheel rotates," but refused to concede that is not the equivalent of receiving speed information in association with a movement of said vehicle. Advisory Action at 11. Cherouny's described mechanism for measuring vehicle speed is associated with movement of ***components*** of the vehicle (clock cycles and wheel rotation) and not associated with movement of the vehicle itself.

### 4. CHEROUNY DOES NOT DISCLOSE A SEPARATE DATA LOGGING DEVICE AND IDENTIFICATION AND DATA LOGGING MODULE.

Cherouny does not disclose a separate "data logging device" and "identification and data logging module" as recited in claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle**



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> **operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], [0080]-[0081]).

May 23, 2024 Final Office Action at 17.

Examiner argued that "[c]laiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as Cherouny's disclosed car monitor 170) does not impart patentability when all of the claimed functionality is carried out be the disclosed combined hardware/software component." May 23, 2024 Final Office Action at 12. However, Examiner failed to address the United States Patent and Trademark Office and Federal Circuit decisions related to this issue discussed in Patent Owner's April 15, 2024 Response to the Non-Final Office Action.

In particular, the PTAB has determined that it would be "problematic" to rely on one component of a prior art reference as teaching two separate components of a claim. In *Hopkins*, the PTAB held that the prior art disclosure of an accelerometer with an output signal could not be applied as teaching both a "deceleration signal" and an "inclination signal" as claimed. *Hopkins Manufacturing Corp. v. Cequent Performance Products, Inc.* (IPR 2015-00613, Paper 9, August 7, 2015).



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According to *Becton*, "[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention." *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010). Where a claim provides for two separate elements (*e.g.*, a "second portion" and a "return portion"), these two elements "logically cannot be one and the same." *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996).

Therefore, it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching the two separate claim elements (a data logging device and an identification and data logging module) of claim 1 of the '470 Patent. This is particularly true when the specification highlights the reason why having a data logging device separate from the identification and data logging module is beneficial. The '470 Patent states, "the system 450 can provide an owner alarm signal 460 that remotely alerts the authorized vehicle owner 470 regarding violation of the programmed operating profile 435." '470 Patent at 8:20-24. This arrangement allows for a system in which the identification and data logging module can be located in the vehicle for identifying the operator, and the data logging device can be remote from the vehicle to alert others not occupying the vehicle of the operating conditions.



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Examiner alleged in the Advisory Action that "Patent Owner's own specification discloses that the data logging device and the identification and data logging module/device could be embodied in a single component." Advisory Action at 13. However, the cited column 7, lines 33-35 and 46-47 of the '470 Patent, actually discloses two separate components—a driver authentication and data logging module 425 and a data logging device 452. FIG. 5 of the '470 Patent described in the cited passages also confirms that the '470 Patent has two separate components (a driver identification and data logging module and a data logging device).

Examiner also cited U.S. Patent No. 9,045,101 to which the '470 patent claims priority, and alleged that it "explicitly discloses a single 'driver identification and data logging device,' whereby the master control unit receives a unique identification code from the data logging device to authenticate a high-risk driver…, and whereby the driver logging device also records vehicle operation data associated with use of the motor vehicle by said at least one driver, including location and speed information." Advisory Action at 14. However, the claims of the '101 Patent only recite a single device, a data logging device, and FIG. 5 of the '101 Patent (reproduced below) has a completely different FIG. 5 from the '470 Patent, depicting only a driver identification and data logging device 425.



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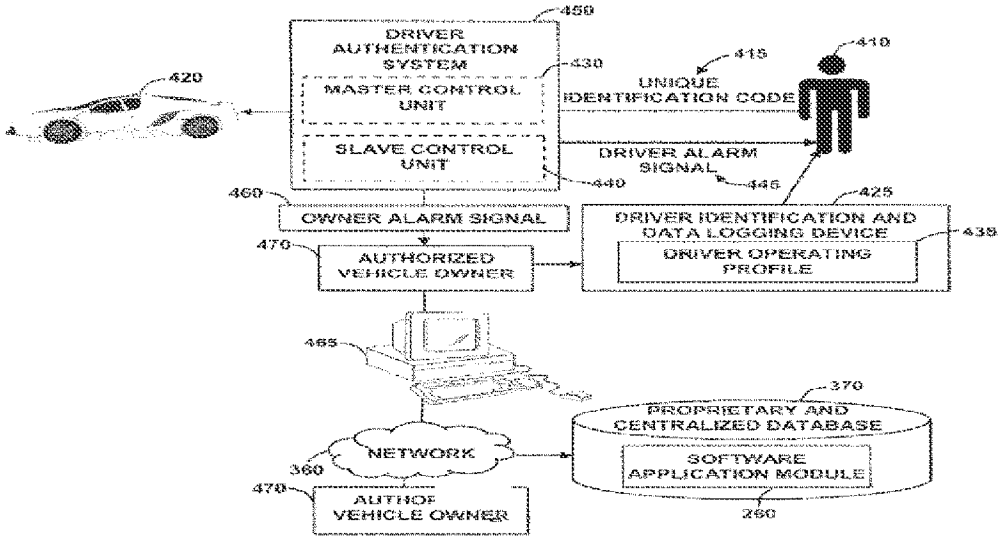



FIG. 5

In contrast, the '470 Patent (reproduced below) depicts two separate components—a data logging device 452 and a driver identification and data logging module 425.



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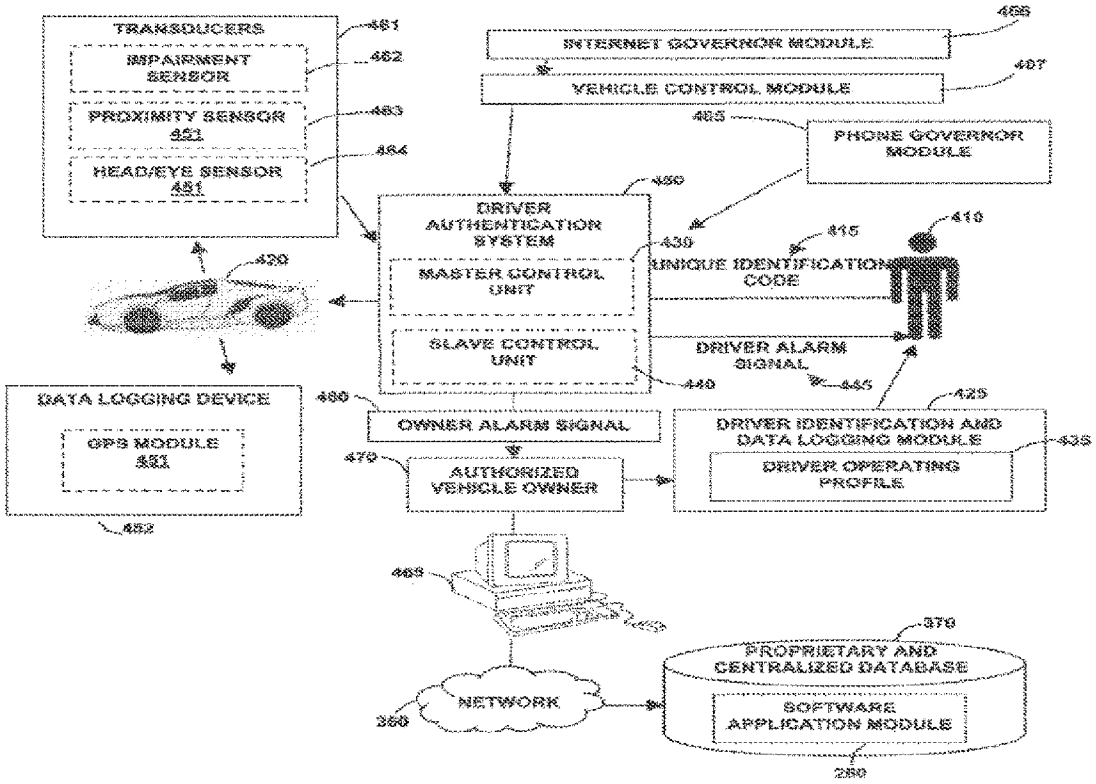



FIG. 5

Because the claim elements are listed separately in the '470 Patent for the data logging device and driver identification and data logging module, the clear implication is that those elements are distinct components which is reinforced by the specification and FIG. 5 of the '470 Patent. *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010) ("[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention."; *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996) ("[w]here a claim provides for two separate



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elements (*e.g.*, a 'second portion' and a 'return portion'), these two elements logically cannot be one and the same.").

### 5. CHEROUNY DOES NOT DISCLOSE A SLAVE CONTROL UNIT WHEN THAT PHRASE IS PROPERLY CONSTRUED.

Cherouny does not disclose the "slave control unit" of claim 1 when that phrase is properly construed under any standard. A slave control unit is by definition ***a control unit*** that a POSITA would understand has certain characteristics. The Examiner has read this term out of the patent claim altogether, which is contrary to governing caselaw of the PTAB applying the BRI standard for this term.

Examiner alleged in the Final Office Action that Cherouny discloses:

> e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module 120 and audible noise generator 121, [0077]-[0078] and Figs. 20A &20B; see also disclosure that functions of the driver monitor include engine slowdown 181 and audible noise alarms 182, [0082] and Figs. 21A &21B; see also disclosure of the possible audio alarms, [0021]-[0024] and [0031]).

May 23, 2024 Final Office Action at 17-18.

The Examiner also made the following claim:

> The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and



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> nothing in the claims with respect to communication from the slave control unit to the master control unit.

May 23, 2024 Final Office Action at 13. This is incorrect and contrary to established law.

A slave control unit is a type of control unit. That should be apparent based on the plain and ordinary meaning of the claims and the intrinsic record. The Examiner reading out the phrase "control unit" from "slave control unit" constitutes plain error. Patent claims should be construed to avoid rendering claim terms superfluous. *Digital-Vending Services International, LLC v. University of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). For example, when a claim refers to "steel baffles," this "strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Phillips v. AWG Corp*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). That truism applies under any claim construction standard.

A control unit incorporates a controller. These take the form of a processor or microcontroller. *IControl Networks, Inc. v. Zonoff Inc.*, No. CV 14-1199-GMS, 2016 WL 1437892, at *1 (D. Del. Apr. 11, 2016) (construing "control unit" to require a programmable processor); *Glaston Corp. v. Salem Fabrication Techs. Grp.*, No. 1:21-CV-942, 2024 WL 1673273, at *17 (M.D.N.C. Apr. 18, 2024) (successfully arguing that "control units or controllers" are well-recognized structural units in patent law that a POSA would understand); *Capella Photonics, Inc. v. Fujitsu Network Commc'ns, Inc.*, No. 2:20-CV-00076-JRG, 2021 WL 465430, at *22 (E.D.



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Tex. Feb. 9, 2021) (a "control unit" refers to known structure, "namely a controller" such as a computer processor).

For this reason, and ***applying the BRI standard***, the PTAB has held that a controller ***must*** include ***a processor*** and ***be programmable***.

> The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[ ]." 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

*One World Techs., Inc. v. Chamberlain Grp., Inc.*, No. IPR2017-00073, 2018 WL 1960893, at *3–4 (P.T.A.B. Apr. 24, 2018).

The PTAB further observed that "broadest reasonable interpretation ... is an interpretation that corresponds with what and how the inventor describes his invention in the specification."

> Our interpretation "'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.' A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster." *Microsoft Corp. v. Proxyconn*, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citations omitted), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).



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> In the Decision on Institution, based on the parties' arguments, see Pet. 13–32; Paper 6, 5–16, and record at the time, we preliminarily interpreted the following limitations of claim 1:
> ***"controller": a microprocessor, processor, or other programmable logic*** that controls the operation of the barrier movement operator.

*Id.*

In view of the proper construction of "slave control unit," the Examiner's identification of a soundmaker as a "slave control unit" is in error. Properly construed, it is not a slave control unit. It has no processor and is not programmable.

A POSITA would, in view of the teachings of the specification and claims, understand a "slave control unit" in the context of its required communication with a "master control unit." Both contain processors and are programmable, as set forth in the intrinsic record and discussed below.



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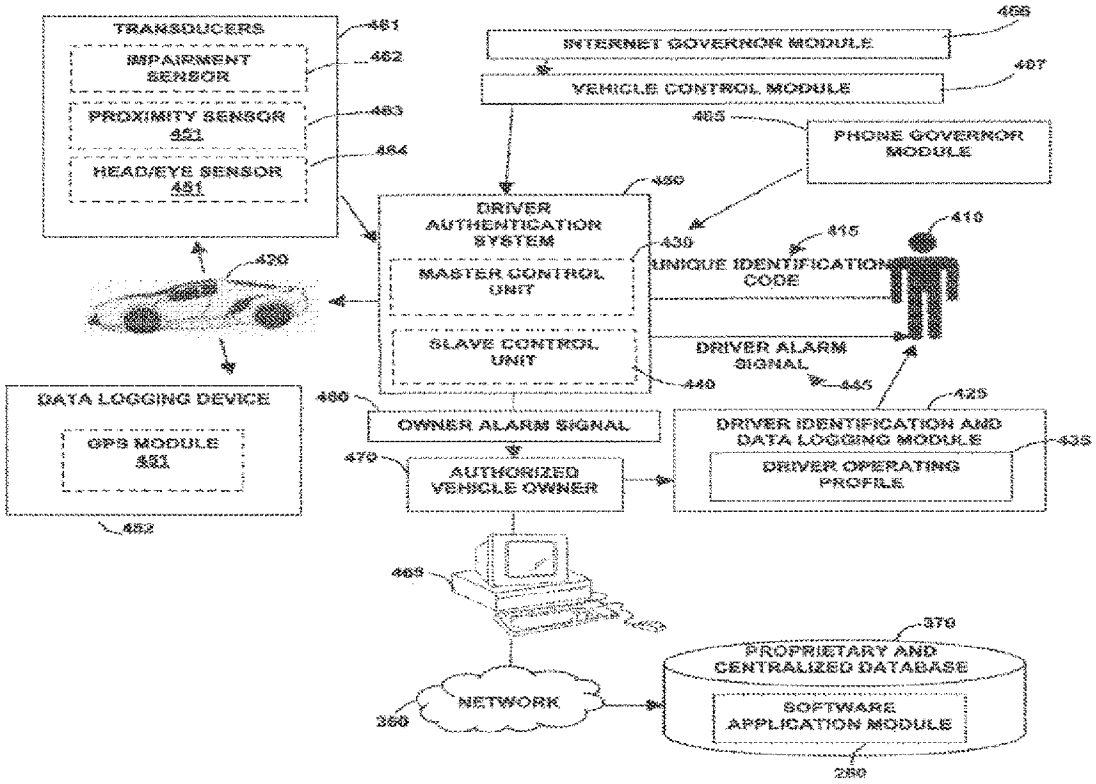



FIG. 5

The "slave control unit" 440 itself has a microprocessor and can be programmed.

> The system 450 generally includes a master control unit 430 and a slave control unit 440 that can be accessed and programmed via the software application module 260 stored in the proprietary and centralized database 370.

'470 Patent at 6:8-12; *accord* 8:9-24. The slave control unit processes inputs from sensors:

> The slave control unit **440** can process the data collected from the sensors and determine if the data indicates a condition that requires a warning. For example, the



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> sensors may indicate that the vehicle is speeding, veering off the road, approaching an obstruction in the road, too close to another vehicle, that the vehicle driver is distracted, sleepy, or not paying attention, that the vehicle driver is impaired etc. If one of these conditions is identified, the slave control unit **440** signals the master control unit **430** and the master control unit issues a driver alarm signal **445** as described above. In the case where the impairment sensor **462** provides a signal to the slave control unit **440** indicating that the driver's impairment is above a prescribed limit, the slave control unit can prevent the vehicle from starting.

'470 Patent at 8:43-56; 10:48-61.

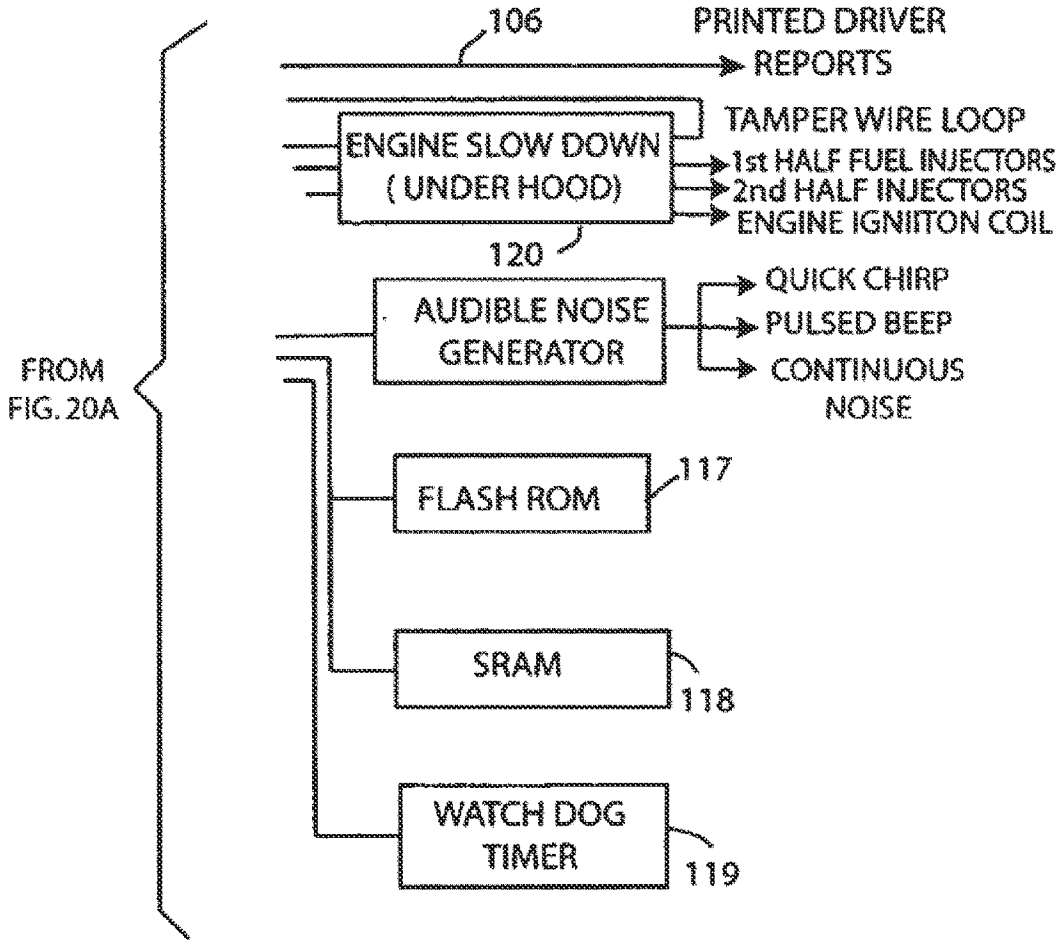
The Examiner contended that the microprocessor 101 is the "master control unit" and argued that engine slow down module 120 and audible noise generator 121 together form the "slave control unit." Rather than being a "unit," as claimed, the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another.



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FIG. 20B




Cherouny at Fig. 20B. There is no teaching of any programmability of audible noise generator, no communication of any kind to the engine slow down, and no function other than making a noise based on an input signal. *Id.* at [0078].

The Examiner did not contend that engine slow down module 120 generates an alarm signal as required by the claim language. The only disclosure remaining is audible noise generator 121, which as indicated by the name, is a simple noise



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generator:

> [0078] An audible noise generator **121** is also connected to the microprocessor for provision of various warning noises such as a quick chirp, a pulsed beep and a continuous noise. These provide warnings of increasing severity to the driver of the vehicle.

*Id.* at [0078]. This does not meet the requirements of the slave control unit when it is properly construed as discussed *supra*.

In the Advisory Action, with respect to the proper claim construction for the "slave control unit" limitation, the Examiner accused the Patent Owner of "reading limitations from the specification into the claims" while simultaneously remarking that "claim construction decisions are based upon the circumstances of each specific case, ***including the disclosure*** and claim language used." Advisory Action at 16-17 (emphasis added). Patent Owner presented portions of the specification/disclosure to support its position that the proper construction of "slave control unit" for the '470 Patent requires a processor and programmability. This is not reading limitations into the claims, but rather it is consistent with how the United States Patent and Trademark Office makes claim construction decisions.

Examiner also argued that the "slave control unit" could perform the claimed functionality through a programmable processor or some other means that does not require programmability. Advisory Action 17-18. However, the Examiner ignored the teachings of the '470 Patent previously discussed which expressly require the



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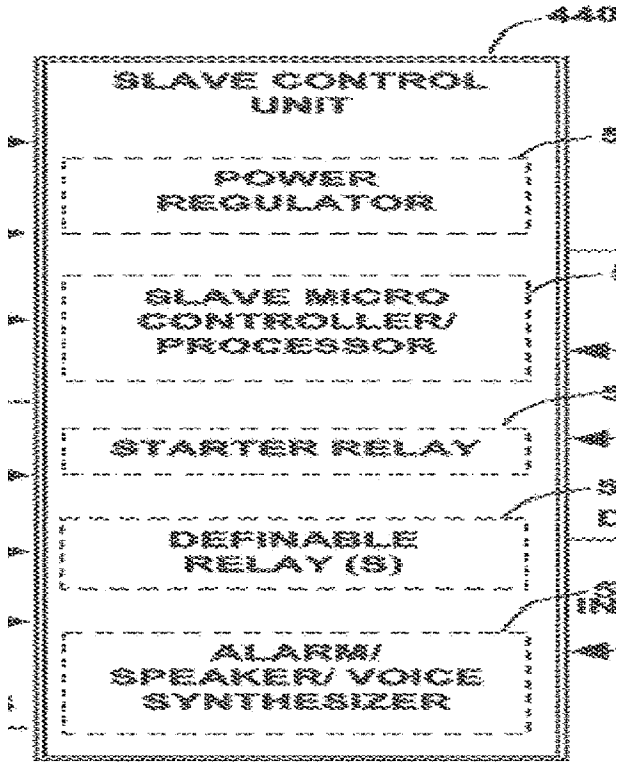
slave control unit to have a processor and be programmable.

Examiner further argued in the Advisory Action that the combination of the slow down module 120 and audible noise generator 121 which are not in communication with one another still constitutes a "unit" by equating them to the disclosure in the '470 Patent for a slave control unit. Advisory Action at 18. He asserted that in the '470 Patent, the slave control unit "is also illustrated as a collection of separate components, having no depiction or disclosure of communication between them." Advisory Action at 18. This is inaccurate. The slave control unit of the '470 Patent shown in FIG. 6 clearly illustrates a single slave control unit 440 with a power regulator, slave micro controller/processor, starter relay, definable relay and alarm/speaker/voice synthesizer as shown below.



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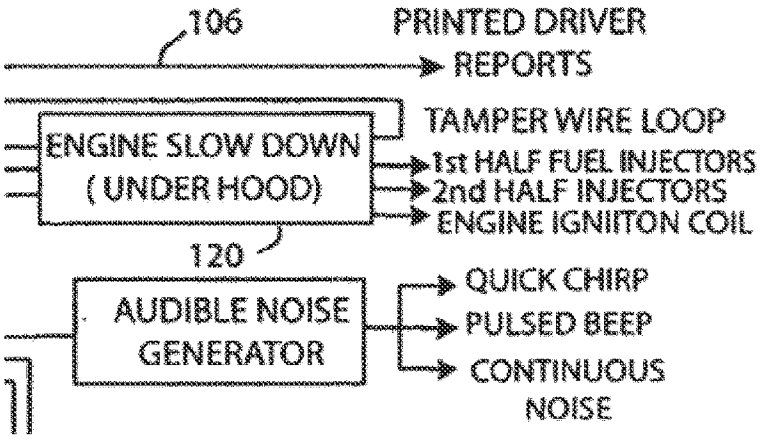

This is in sharp contrast to the separate engine slow down module 120 and audible noise generator 121 that do not communicate with one another and are clearly not part of a singular unit as shown in FIG. 20B of Cherouny reproduced below.



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FIG. 20B




### 6. CLAIM 4 IS ALSO ALLOWABLE.

Claim 4 is allowable for the same reasons previously discussed. Because it is a dependent claim, and thereby incorporates all of the limitations of independent claim 1 from which it depends, the disclosure lacking in Cherouny related to the independent claim limitations discussed herein prevent the combination of Cherouny and Harter from rendering dependent claim 4 obvious.

## B. GROUND 2 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF SHUMAN)

Ground 2 is predicated on a combination of Cherouny and Shuman. As a preliminary matter, the combination of these references is improper. The Examiner conceded that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 27. Indeed,



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Examiner cited neither Cherouny nor Shuman as disclosing a wireless communication system. The Examiner asserted without evidence, however, that a skilled artisan would have been generally motivated to modify Chorouny with Shuman to fabricate a wireless communication system in the manner claimed. *Id.* at 27.

That is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017); *see also DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009).

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present



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> device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.

Cherouny at ¶33.

Similarly, the profile information is kept inaccessible to the driver and is hardwired in a specific manner.

> The instant device utilizes input selector codes. The data is not coded going through the infrared link. It is literal data describing the numerous profiles of all the drivers under all the different driving conditions. The profile is set up in the instant device and inaccessible to the driver.

*Id.* at ¶30.

In short, there is no evidence in the record that an artisan would have been motivated to combine Cherouny and Shuman in the manner claimed, particularly when Cherouny teaches against such an implementation.

The arguments in Ground 1 also apply to this rejection.

### C. GROUND 3 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF PETRIK)

Ground 3 is based on Cherouny in view of Petrik. Here again, Examiner cited neither Cherouny nor Petrik as disclosing a wireless communication system, relying



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only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 33. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Petrik in the manner claimed, particularly when Cherouny teaches against wireless communication for data logging. Cherouny is focused on preventing modification, cessation or interception of logged data using a specialized wiring harness that communicates with a hardwired logging system in the vehicle.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. ***In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.***

Cherouny at ¶33 (emphasis added). Thus, each of the modules is connected through wiring, including a decoy wire that detects tampering. Therefore, it would not have been "obvious to try" modifying Cherouny with Petrik's disclosure of a wireless device because that is taught against by Cherouny itself.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.



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Petrik teaches an individual driver logbook for each driver in the form of a smart card. "Drivers are issued with their logbook smart cards with their fingerprint template recorded in the card." Petrik at ¶22. "At the start of the journey the driver inserts his smart card into the unit's smart card reader/writer and places his finger on the fingerprint reader to confirm his identity. This automatically logs him in as the current driver and enables engine ignition." *Id.* at ¶23. The unique smart card approach of Petrik could not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33. It is inappropriate to use the template provided by the inventor to render the inventor's contribution obvious. *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor")).

The arguments in Ground 1 also apply to this rejection.

### D. GROUND 4 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF BOUCHARD)

Ground 4 is based on Cherouny in view of Bouchard. Here again, Examiner cited neither Cherouny nor Bouchard as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 39. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been



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motivated to combine Cherouny and Bouchard in the manner claimed, particularly when Cherouny teaches against wireless communication.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." *Id.* at 35.

Here again, a review of Bouchard demonstrates that the two approaches of Cherouny and Bouchard are fundamentally inconsistent, and an artisan would not be motivated to combine one with the other. Bouchard is a vehicular *radar* system. Directly contrary to Cherouny, it also teaches a removable storage device.

> A removable, externally readable, non-volatile solid-state memory event recording apparatus (ERA)5 is coupled to the system processor 107. The ERA records the output of each of the sensors and information about targets detected by the radar system.

Bouchard, 8:43-48. The removable memory approach of Bouchard could likewise not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33.

The arguments in Ground 1 also apply to this rejection.

## IX. CONCLUSION

For at least the foregoing reasons, Appellant submits that claims 1 and 4 of the '470 Patent are patentable over the cited art, and respectfully requests that the rejections be reversed.



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Appellant believes no fee is due with this Brief.

Date: November 21, 2024

Respectfully submitted,

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, TX 78731
Telephone: (512) 539-2625
Facsimile: (512) 727-6691



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## CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November 2024, a true and correct copy of the foregoing PATENT OWNER'S APPEAL BRIEF IN REEXAMINATION was served pursuant to 37 C.F.R. § 1.550(f) via Priority Mail Express® (9470130109355003820752) upon the following counsel of record for third-party requesters:

Unified Patents, LLC
4445 Willard Ave.
Suite 600
Chevy Chase, MD 20815

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, Texas 78731



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## X. CLAIMS APPENDIX

1. (Original) A vehicle control system, comprising:

a wireless identification and data logging module;

a master control unit in a vehicle for wirelessly authenticating at least one occupant via said wireless driver identification and data logging module and associating an operating profile with said at least one occupant;

a module for receiving at least location and speed information in association with movement of said motor vehicle;

a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said location and speed information received from said module;

and a slave control unit in said motor vehicle and in communication with said master control unit,



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wherein said slave control unit receives commands from said master control unit and generate an alarm signal;

wherein said master control unit provides operation governance of said vehicle within an operating profile.

4. (Original) The vehicle control system of claim 1 wherein said wireless identification and data logging module comprises at least one of:

a WIFI enabled device; an RFID enabled device; a Bluetooth enabled device; a cellular telephone; and a smartphone.



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# FAX COVER SHEET

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| TO | Commissioner for Patents |
| COMPANY | USPTO |
| FAX NUMBER | 15712739900 |
| FROM | Adam Price |
| DATE | 2024-11-25 21:06:03 GMT |
| RE | Appeal Brief (Appl No. 90/015,287) |

## COVER MESSAGE

Attached please find a courtesy copy of Patent Owner's Appeal Brief and Claims Appendix.



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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| *Ex Parte* Reexamination of<br>U.S. Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

## PATENT OWNER'S APPEAL BRIEF IN *EX PARTE* REEXAMINATION

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant Patent Owner presents this Appeal Brief in the *ex parte* reexamination of U.S. Patent No. 10,259,470 ("'470 Patent"). This brief is filed under 37 C.F.R. §41.37(a) in furtherance of the Notice of Appeal filed for this reexamination on September 23, 2024, regarding the decision of the Examiner of Group 3992 set forth in the Final Office Action dated May 23, 2024 ("Final Office Action") and the Advisory Action dated August 20, 2024 ("Advisory Action"). The First Office Action in this case was issued on February 15, 2024 ("First Office Action").



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## I. REAL PARTY IN INTEREST

The real party in interest is The Phelan Group, LLC, the assignee of record of the '470 Patent, as indicated by an assignment recorded on September 12, 2018, at reel/frame 046851/0608.

## II. RELATED APPEALS, INTERFERENCES AND TRIALS

The '470 Patent is related to the following matters:

1. *The Phelan Group, LLC v. Mercedes-Benz Group AG*, 2:23-cv-607-JRG (EDTX).

2. *The Phelan Group, LLC v. State Farm Mutual Automobile Insurance Co.*, 2:23-cv-611-JRG (EDTX).

3. *The Phelan Group, LLC v. Honda Motor Co., Ltd*, 2:23-cv-606-JRG (EDTX).

## III. STATUS OF THE CLAIMS

The '470 Patent was issued on April 16, 2019 with twenty (20) claims. A request for *ex parte* reexamination, filed August 31, 2023, requested reexamination of claims 1 and 4 of the '470 Patent. The request was granted on October 17, 2023, resulting in the reexamination of claims 1 and 4, both of which currently stand twice and finally rejected.

Pursuant to 37 C.F.R. § 41.37(c)(1)(iii), the following summary is a concise explanation of the subject matter defined in each of the rejected claims 1 and 4 and



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refers to the drawings and specification in the '470 Patent as issued. This particular explanation is for assistance of the Board, by way of example, and is not intended to limit or interpret the claims in any way. Further, for each feature of the claims, there may be additional supportive disclosure in the specification beyond what is cited below.

## IV. STATUS OF THE AMENDMENTS

Applicant has not filed any amendment in this *ex parte* reexamination.

## V. SUMMARY OF THE CLAIMED SUBJECT MATTER

1. A vehicle control system (1:31-35; 6:8-12; FIG. 5), comprising:

a wireless identification and data logging module (7:9-14; FIG.5);

a master control unit (7:29-32; 7:58-62; FIG. 5) in a vehicle for wirelessly authenticating at least one occupant via said wireless driver identification and data logging module (12:37-42; FIG. 5) and associating an operating profile with said at least one occupant (2:37-50; 7:5-8; FIG. 5);

a module for receiving at least location and speed information in association with movement of said motor vehicle (12:37-59);

a data logging device that records vehicle operation data associated with a use of said vehicle (7:46-57; FIG. 5), the vehicle operation data comprising at least said location and speed information received from said module (12:43-48; FIG. 5);

and a slave control unit (6:8-11; 10:48-61; 11:8-22; FIG. 5) in said motor vehicle and in communication with said master control unit (10:48-61; 11:8-22; FIG.



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5),

wherein said slave control unit receives commands from said master control unit and generate an alarm signal (11:45-58; 12:47-55; FIG. 5);

wherein said master control unit provides operation governance of said vehicle (3:4-7; 12:15-18) within an operating profile (2:37-50; 7:5-8; FIG. 5).

4. The vehicle control system of claim 1 (1:31-35; 6:8-12; FIG. 5) wherein said wireless identification and data logging module (7:9-14; FIG.5) comprises at least one of:

a WIFI enabled device; an RFID enabled device; a Bluetooth enabled device; a cellular telephone; and a smartphone (7:9-25).

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." *Id.* at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile that matches requirements of the high-risk driver." *Id.* at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit



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> receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

*Id.* at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are control units, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:

> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.
>
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.



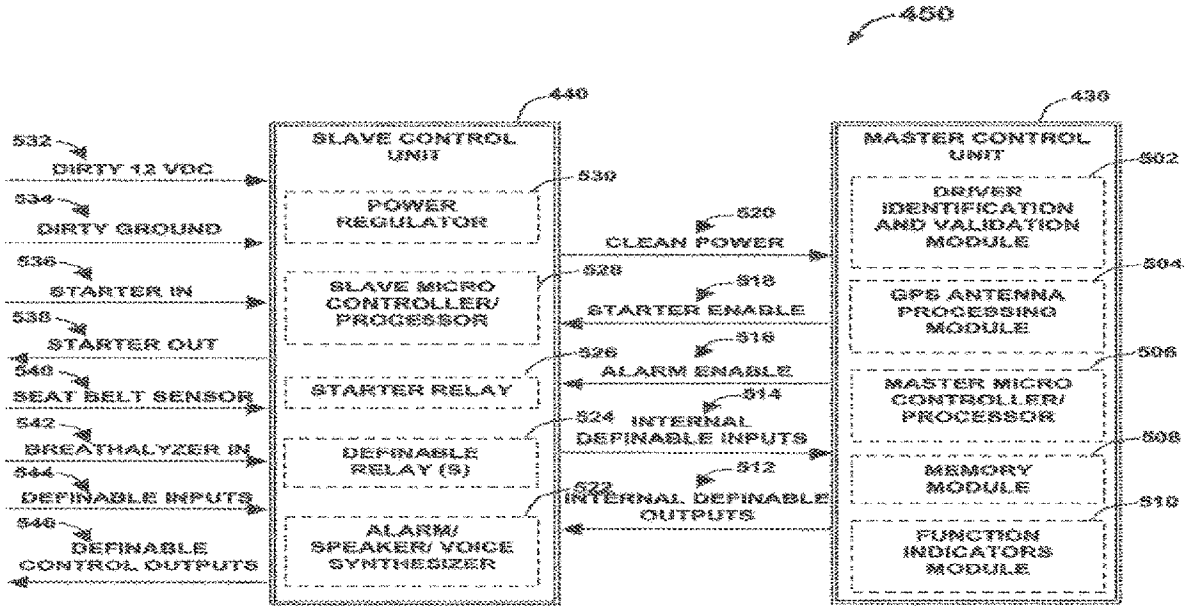
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As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.




*Id.* at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." *Id.* at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an



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> actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

## VI. SUMMARY OF THE ARGUMENT

As set forth below, while the Examiner has given this case careful consideration, an error recurs in the analysis. With respect to master control unit and slave control unit, the Examiner appears to collapse both elements into a single communication between them. *See* Advisory Action at 5 ("the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit"). In doing so, there is no construction of "master control unit" or "slave control unit," which are terms that have been construed by this tribunal previously, consistently with the construction advanced by Appellant. Dictionaries cited by the Examiner ignore the "control unit" designation for each of those two elements in the claims, resulting in the deviation between the two positions. Of course, claim elements should not be read so as to render key claim terms superfluous.



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A similar problem arises in connection with the claimed "a wireless identification and data logging module (7:9-14; FIG.5)." The Examiner assert that "The Office initially notes that the claimed wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But the data logging device itself is claimed as a wireless device, so that is not the case; a POSITA would understand identification and data logging communications to be communicated wirelessly.

Cherouny discloses an exclusively wired communication that is especially adapted to prevent tampering. Cherouny explicitly requires that "all the various electronic modules" are wired together, including with a specialized wiring harness, so that if any component is removed, presumably including whatever component would be alleged to be the claimed component is removed, the system is alerted to that problem. Thus, Cherouny is directed to a different problem, and specifically teaches away from wireless communications for data logging.

Claim 1 of the '470 Patent also requires that speed and location information are received "***in association with a movement of said vehicle***." Cherouny discloses that speed information is determined not from "movement of said vehicle," but rather clock cycles associated with wheel sensors.

Examiner also improperly relies on the same structure (car monitor 170 of Cherouny) to teach two separate claim elements—the data logging device and the



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identification and data logging module recited in claim 1 of the '470 Patent. It is with these foundational elements in mind that we respectfully submit the following arguments for consideration.

## VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicant appeals the rejections of claims 1 and 4 of the '470 Patent.

Ground 1: Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter.

Ground 2: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman.

Ground 3: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik.

Ground 4: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

## VIII. ARGUMENT

### A. GROUND 1 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF HARTER)

#### 1. NO MOTIVATION TO COMBINE CHEROUNY WITH HARTER EXISTS.

The combination of Cherouny and Harter is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*,



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964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).

The Examiner correctly notes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 18. On the contrary, Cherouny teaches secure wired communication with dummy wires to prevent tampering.

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is



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> broken for even a moment the event is recorded and documented.

Cherouny at ¶33. Therefore, it would not have been "obvious to try" modifying Cherouny with Harter's disclosure of a wireless device because that is taught against by Cherouny itself.

In the Advisory Action at page 3, the Examiner acknowledges that the claimed wireless communication includes wirelessly authenticating the driver of the vehicle. More specifically, the claim requires: "a master control unit in a vehicle for wirelessly authenticating at least one occupant." The Examiner then states that "the wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But that characterization misses two elements: the previously claimed "wireless identification and data logging module" and the "master control unit" itself, which is engaging in wireless communication with it per the claim. Thus, the Examiner's efforts to distill the claimed wireless functionality to a single communication is incorrect; each of those components must communicate wirelessly per the express claim language. The Examiner makes a similarly incorrect slight of hand by defining "master control unit" and a "slave control unit" by the claimed communication between them, instead of evaluating the meaning of the terms to a POSITA. *See* Advisory Action at 5. As set forth above, the "data logging module" is explicitly wired in a very particular way in Cherouny.

As set forth below, the Examiner largely ignores the "master control unit" and



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"slave control unit" other than as to a single communication. But Cherouny's CPU is wired. As set forth in the specification:

> ***The CPU module is wired to the under the hood box and a connection to that wiring in the back of the dash mounting holder.*** The holder guides the CPU modules into the connector as the CPU module is inserted into the holder. The programmable unit is contained in a module which controls the speed of the vehicle and the memory function of the module itself. The unit is essentially a hand-held computer that is an integrated, low-voltage, Single chip implementation of a high-performance 32 bit, X-scale compatible microprocessor with the extra logic needed for PC/AT compatible PCs. It has a AMD386 or more advanced chip CPU core with a memory control unit, ISA bus controller and peripheral control logic.

Cherouny at ¶17.

Thus, a person of ordinary skill would not be motivated to combine Harter or any other reference relating to wireless communication with Cherouny, which is directed to preventing interception, cessation or modification of data with a specific wired connection within the vehicle, and which teaches fully away from wireless communications because of its different objectives. *Id.* at ¶33.

### 2. CHEROUNY DOES NOT DISCLOSE A MASTER CONTROL UNIT AS PROPERLY CONSTRUED.

Cherouny does not disclose the "master control unit" of claim 1 as properly construed. Examiner alleged in the Final Office Action that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's



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> data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).

May 23, 2024 Final Office Action at 16-17.

The Examiner argued that "there does not appear to be an allegation that Cherouny does not disclose the claimed master control unit, only that it is implemented differently." *Id.* at 9. That assertion is incorrect. Bilateral communication is required between a master control unit and a slave control unit. That is claimed and stated clearly in the prosecution history. Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Prosecution History-related patent to the '470 Patent).

The '470 Patent's master control unit is designed to identify a driver profile in which the vehicle operates and for controlling various vehicle system components and has all the necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny. For example, the master control unit 430 of the '470 Patent includes a driver identification and validation module 502, a GPS antenna processing module 504, a master micro controller/processor 506, a memory module 508 and a function indicators module 510. '470 Patent at FIG. 6.

The communications interfaces of the master control unit 430 depicted in the specification include outputs such as starter enable 518, alarm enable 516, and internal definable outputs 512. The inputs include clean power 520 and other



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internal definable inputs 514. *Id.* at 10:48-11:52; FIG. 6.

The master control unit is to be understood in a specific systemic context, namely its relationship to the "slave control unit" claimed in claim 1 and discussed in "Limitation 1(e)" below. The master control unit and slave control unit "communicate," as set forth in claim 1. *See also* IEEE 100 Authoritative Dictionary, "master": "a device that initiates communications requests to gather data or perform controls." As stated in prosecution, "the master and slave control units claimed work in parallel and ***thus require bidirectional communication***." Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Patent Prosecution History) (emphasis added).

Cherouny, in contrast, discloses a microprocessor that performs calculations and processes data based on inputs. These inputs include inputs from an automobile speed sensor 108, a key fob reader 109, and power conditioning 110. Cherouny at [0073], FIG. 20A. The microprocessor in turn provides simple instructions to peripheral components to execute functions such an audible noise generator 121, which Examiner identifies as a "slave control unit." *Id.* at [0077], [0078], FIG. 20A.

As set forth in more detail in connection with Section 1(e) ("slave control unit"), a control unit is a term of skill in the art. Likewise, a "master" and "slave" relationship is well understood, and the intrinsic record is clear that bidirectional communication is required. These terms are understood in the context of the



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specification, which supports a construction of "master control unit" that requires bidirectional communication. There is no communication received from the noise generator in Cherouny.

In the Advisory Action, Examiner asserted that "the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit" and that "the reception of commands by the slave control unit constitutes the claimed 'communication.'" Advisory Action at 5. First, Examiner effectively ignores the claimed control units, and instead looks only to the presence of a communication. Respectfully, the terms "master control unit" and "slave control unit" must be understood as a POSITA would, as a control unit having a processor or microcontroller, having bidirectional communication and controlling components in their own right.

Moreover, as to the characterization of the communications themselves, Patent Owner respectfully disagrees. The claim language expressly states: "a slave control unit…which communicates with said master control unit wherein said slave control unit receives commands from said master control unit." '470 Patent at 14:19-22. In other words, the language requires the slave to be able to send signals to communicate with the master ***and*** receive commands/signals from the master control unit. This understanding is borne out consistently in the intrinsic record, including



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the figures and prosecution history.

Examiner also argued in the Advisory Action that during original prosecution, that Examiner "found the arguments not persuasive and maintained the rejection" with respect to the "bilateral communication" argument that Patent Owner made in the U.S. Patent No. 8,417,415 prosecution history. Advisory Action at 6. While it is true that the Examiner found the argument Applicant made differentiating the claim language and the cited prior art (Gratz) unpersuasive, he did not imply or state that the claim language did not require bi-directional communication as Applicant asserted.

Examiner further cited two references purporting to support his position that bi-directional communication is not inherent in a master-slave relationship. Advisory Action at 7. In doing so, he completely ignores the phrase "control unit" appended to each of "master" and "slave," which is improper and results in error. A control unit is a well understood term, and that understanding is corroborated by the prosecution history.

Even so, one of the selected references cited by the Examiner discloses that the slave responds/communicates with the master device. The cited PC Magazine references notes, "one device acts as the controller (the master) and initiates the commands, and the other devices (the slaves) ***respond*** accordingly. (emphasis added). Regardless, the Patent Owner's argument is not that bi-directional



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communication is inherent in all master-slave relationships, but rather that in view of the intrinsic record (prosecution history/specification and drawings) as previously discussed, bi-directional communication is required for claim 1 of the '470 Patent.

The Examiner acknowledged "that in Fig. 6 of the '470 patent, there are two signals illustrated that are from the slave control unit to the master control unit; clean power 520 and internal definable inputs 514." Advisory Action at 7. The Examiner alleged, however, that "the '470 patent includes no disclosure as to the nature of these signals, and there is no disclosed nor claimed use of these signals." *Id.* at 8. This is both irrelevant and inaccurate. The presence of the arrows showing commands from the slave control unit to the master control along with the arrows showing commands from the master control unit to the slave control unit in FIG. 6 clearly depict the bi-directional flow Patent Owner argues is required in the '470 Patent regardless of whether the nature of the signals is detailed. Moreover, the '470 Patent does discuss these signals, stating "the master control unit 430 and the slave control unit 440 can be communicated via various communication signal lines such as clean power signal 520, an alarm enable signal 516, internal definable input signal 514 and an internal definable output signal 512." '470 Patent at 11:16-22.

### 3. CHEROUNY DOES NOT DISCLOSE RECEIVING LOCATION AND SPEED INFORMATION IN ASSOCIATION WITH A MOVEMENT OF A VEHICLE.

Cherouny does not disclose receiving location and speed information "*in*



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***association with a movement of a vehicle***" as required by claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor 108, [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1).

May 23, 2024 Final Office Action at 17.

Examiner alleged that "[t]he limitation also merely recites the receipt of speed information and location information" and "[t]here is no limitation regarding the mechanism for deriving said information." May 23, 2024 Final Office Action at 11. Patent Owner disagrees. This limitation of the '470 Patent requires that speed and location information are received "***in association with a movement of said vehicle***." Cherouny discloses that speed information is determined ***not*** from "movement of said vehicle," but rather clock cycles associated with wheel sensors. Cherouny never uses vehicle movement to determine speed. On the contrary, Cherouny states:

> ***The instant device counts clock cycles between rising edges as well as any other part***, such as the falling edges or even voltage levels, of the square wave coming from an additional wheel sensor similar to the antilock ABS sensors on one of the wheels. This digital computer ***version of speed detection is unique when used with the other features of the device.***



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Cherouny at [0011], [0015] (emphasis added).

Hence, Cherouny's methodology for estimating speed—clock cycles and wheel rotation—does not teach or suggest this claim limitation. Cherouny's sole mention of GPS is so that the system can be made aware of school zones. *Id.* at [0010], [0020]. Cherouny never teaches or suggests using GPS to determine speed and location based on vehicle movement.

Examiner admitted in the Advisory Action that "Cherouny's mechanism for measuring vehicle speed involves the counting of pulses generated by speed sensors integrated with the antilock brake device or other sensor on the wheel, generating a square wave as the wheel rotates," but refused to concede that is not the equivalent of receiving speed information in association with a movement of said vehicle. Advisory Action at 11. Cherouny's described mechanism for measuring vehicle speed is associated with movement of ***components*** of the vehicle (clock cycles and wheel rotation) and not associated with movement of the vehicle itself.

### 4. CHEROUNY DOES NOT DISCLOSE A SEPARATE DATA LOGGING DEVICE AND IDENTIFICATION AND DATA LOGGING MODULE.

Cherouny does not disclose a separate "data logging device" and "identification and data logging module" as recited in claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle**



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> **operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], [0080]-[0081]).

May 23, 2024 Final Office Action at 17.

Examiner argued that "[c]laiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as Cherouny's disclosed car monitor 170) does not impart patentability when all of the claimed functionality is carried out be the disclosed combined hardware/software component." May 23, 2024 Final Office Action at 12. However, Examiner failed to address the United States Patent and Trademark Office and Federal Circuit decisions related to this issue discussed in Patent Owner's April 15, 2024 Response to the Non-Final Office Action.

In particular, the PTAB has determined that it would be "problematic" to rely on one component of a prior art reference as teaching two separate components of a claim. In *Hopkins*, the PTAB held that the prior art disclosure of an accelerometer with an output signal could not be applied as teaching both a "deceleration signal" and an "inclination signal" as claimed. *Hopkins Manufacturing Corp. v. Cequent Performance Products, Inc.* (IPR 2015-00613, Paper 9, August 7, 2015).



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According to *Becton*, "[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention." *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010). Where a claim provides for two separate elements (*e.g.*, a "second portion" and a "return portion"), these two elements "logically cannot be one and the same." *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996).

Therefore, it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching the two separate claim elements (a data logging device and an identification and data logging module) of claim 1 of the '470 Patent. This is particularly true when the specification highlights the reason why having a data logging device separate from the identification and data logging module is beneficial. The '470 Patent states, "the system 450 can provide an owner alarm signal 460 that remotely alerts the authorized vehicle owner 470 regarding violation of the programmed operating profile 435." '470 Patent at 8:20-24. This arrangement allows for a system in which the identification and data logging module can be located in the vehicle for identifying the operator, and the data logging device can be remote from the vehicle to alert others not occupying the vehicle of the operating conditions.



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Examiner alleged in the Advisory Action that "Patent Owner's own specification discloses that the data logging device and the identification and data logging module/device could be embodied in a single component." Advisory Action at 13. However, the cited column 7, lines 33-35 and 46-47 of the '470 Patent, actually discloses two separate components—a driver authentication and data logging module 425 and a data logging device 452. FIG. 5 of the '470 Patent described in the cited passages also confirms that the '470 Patent has two separate components (a driver identification and data logging module and a data logging device).

Examiner also cited U.S. Patent No. 9,045,101 to which the '470 patent claims priority, and alleged that it "explicitly discloses a single 'driver identification and data logging device,' whereby the master control unit receives a unique identification code from the data logging device to authenticate a high-risk driver…, and whereby the driver logging device also records vehicle operation data associated with use of the motor vehicle by said at least one driver, including location and speed information." Advisory Action at 14. However, the claims of the '101 Patent only recite a single device, a data logging device, and FIG. 5 of the '101 Patent (reproduced below) has a completely different FIG. 5 from the '470 Patent, depicting only a driver identification and data logging device 425.



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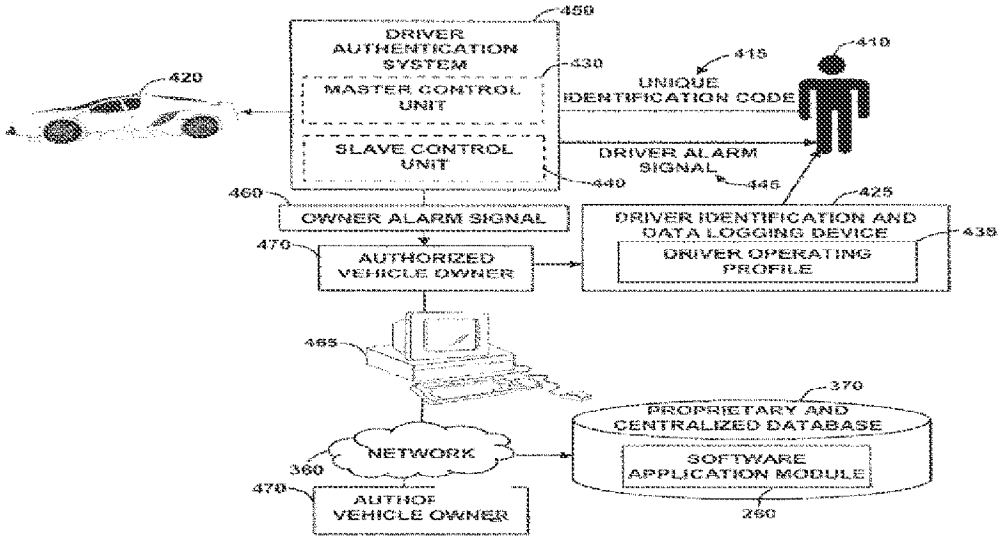



FIG. 5

In contrast, the '470 Patent (reproduced below) depicts two separate components—a data logging device 452 and a driver identification and data logging module 425.



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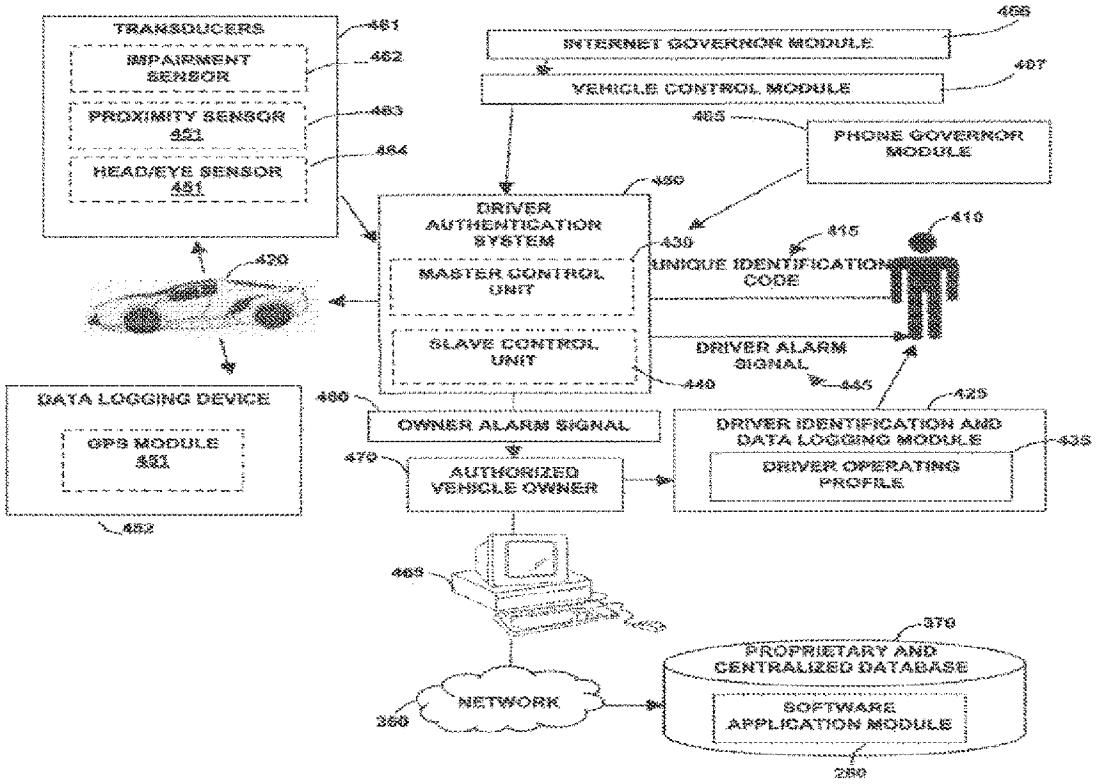



FIG. 5

Because the claim elements are listed separately in the '470 Patent for the data logging device and driver identification and data logging module, the clear implication is that those elements are distinct components which is reinforced by the specification and FIG. 5 of the '470 Patent. *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010) ("[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention."; *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996) ("[w]here a claim provides for two separate



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elements (*e.g.*, a 'second portion' and a 'return portion'), these two elements logically cannot be one and the same.").

### 5. CHEROUNY DOES NOT DISCLOSE A SLAVE CONTROL UNIT WHEN THAT PHRASE IS PROPERLY CONSTRUED.

Cherouny does not disclose the "slave control unit" of claim 1 when that phrase is properly construed under any standard. A slave control unit is by definition ***a control unit*** that a POSITA would understand has certain characteristics. The Examiner has read this term out of the patent claim altogether, which is contrary to governing caselaw of the PTAB applying the BRI standard for this term.

Examiner alleged in the Final Office Action that Cherouny discloses:

> e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module 120 and audible noise generator 121, [0077]-[0078] and Figs. 20A &20B; see also disclosure that functions of the driver monitor include engine slowdown 181 and audible noise alarms 182, [0082] and Figs. 21A &21B; see also disclosure of the possible audio alarms, [0021]-[0024] and [0031]).

May 23, 2024 Final Office Action at 17-18.

The Examiner also made the following claim:

> The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and



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> nothing in the claims with respect to communication from the slave control unit to the master control unit.

May 23, 2024 Final Office Action at 13. This is incorrect and contrary to established law.

A slave control unit is a type of control unit. That should be apparent based on the plain and ordinary meaning of the claims and the intrinsic record. The Examiner reading out the phrase "control unit" from "slave control unit" constitutes plain error. Patent claims should be construed to avoid rendering claim terms superfluous. *Digital-Vending Services International, LLC v. University of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). For example, when a claim refers to "steel baffles," this "strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Phillips v. AWG Corp*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). That truism applies under any claim construction standard.

A control unit incorporates a controller. These take the form of a processor or microcontroller. *IControl Networks, Inc. v. Zonoff Inc.*, No. CV 14-1199-GMS, 2016 WL 1437892, at *1 (D. Del. Apr. 11, 2016) (construing "control unit" to require a programmable processor); *Glaston Corp. v. Salem Fabrication Techs. Grp.*, No. 1:21-CV-942, 2024 WL 1673273, at *17 (M.D.N.C. Apr. 18, 2024) (successfully arguing that "control units or controllers" are well-recognized structural units in patent law that a POSA would understand); *Capella Photonics, Inc. v. Fujitsu Network Commc'ns, Inc.*, No. 2:20-CV-00076-JRG, 2021 WL 465430, at *22 (E.D.



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Tex. Feb. 9, 2021) (a "control unit" refers to known structure, "namely a controller" such as a computer processor).

For this reason, and ***applying the BRI standard***, the PTAB has held that a controller ***must*** include ***a processor*** and ***be programmable***.

> The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[ ]." 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

*One World Techs., Inc. v. Chamberlain Grp., Inc.*, No. IPR2017-00073, 2018 WL 1960893, at *3–4 (P.T.A.B. Apr. 24, 2018).

The PTAB further observed that "broadest reasonable interpretation ... is an interpretation that corresponds with what and how the inventor describes his invention in the specification."

> Our interpretation "'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.' A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster." *Microsoft Corp. v. Proxyconn*, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citations omitted), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).



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> In the Decision on Institution, based on the parties' arguments, see Pet. 13–32; Paper 6, 5–16, and record at the time, we preliminarily interpreted the following limitations of claim 1:
> ***"controller": a microprocessor, processor, or other programmable logic*** that controls the operation of the barrier movement operator.

*Id.*

In view of the proper construction of "slave control unit," the Examiner's identification of a soundmaker as a "slave control unit" is in error. Properly construed, it is not a slave control unit. It has no processor and is not programmable.

A POSITA would, in view of the teachings of the specification and claims, understand a "slave control unit" in the context of its required communication with a "master control unit." Both contain processors and are programmable, as set forth in the intrinsic record and discussed below.



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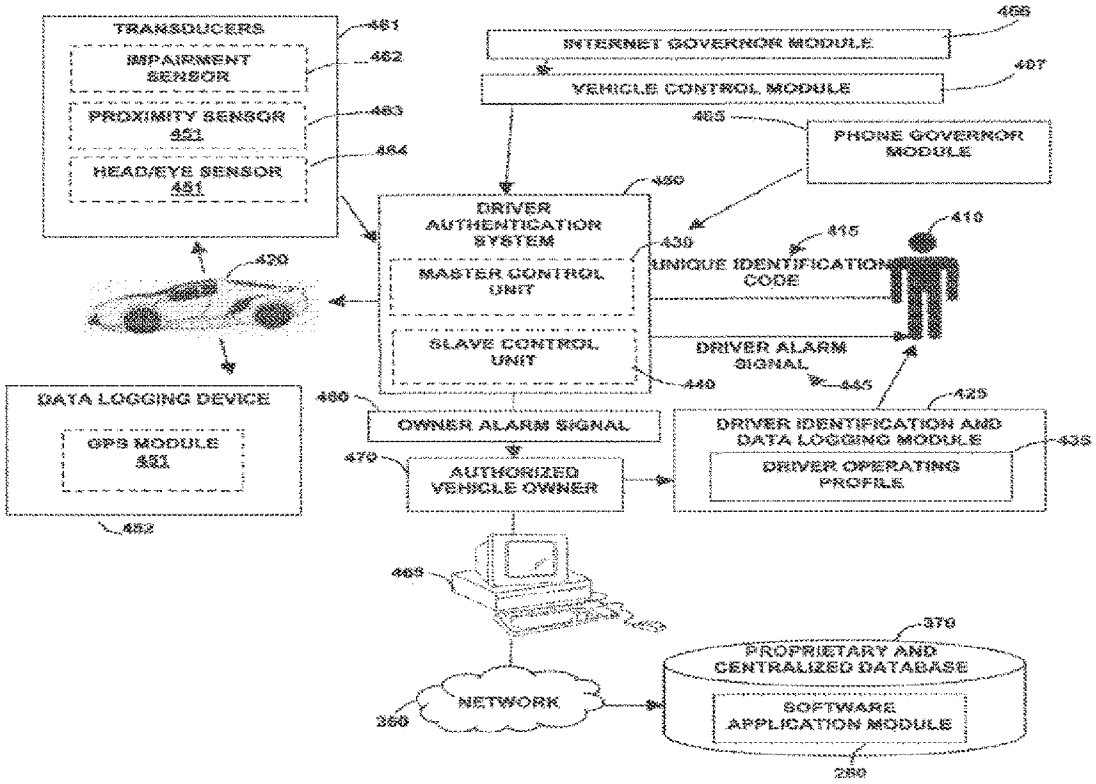



FIG. 5

The "slave control unit" 440 itself has a microprocessor and can be programmed.

> The system 450 generally includes a master control unit 430 and a slave control unit 440 that can be accessed and programmed via the software application module 260 stored in the proprietary and centralized database 370.

'470 Patent at 6:8-12; *accord* 8:9-24. The slave control unit processes inputs from sensors:

> The slave control unit **440** can process the data collected from the sensors and determine if the data indicates a condition that requires a warning. For example, the



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> sensors may indicate that the vehicle is speeding, veering off the road, approaching an obstruction in the road, too close to another vehicle, that the vehicle driver is distracted, sleepy, or not paying attention, that the vehicle driver is impaired etc. If one of these conditions is identified, the slave control unit **440** signals the master control unit **430** and the master control unit issues a driver alarm signal **445** as described above. In the case where the impairment sensor **462** provides a signal to the slave control unit **440** indicating that the driver's impairment is above a prescribed limit, the slave control unit can prevent the vehicle from starting.

'470 Patent at 8:43-56; 10:48-61.

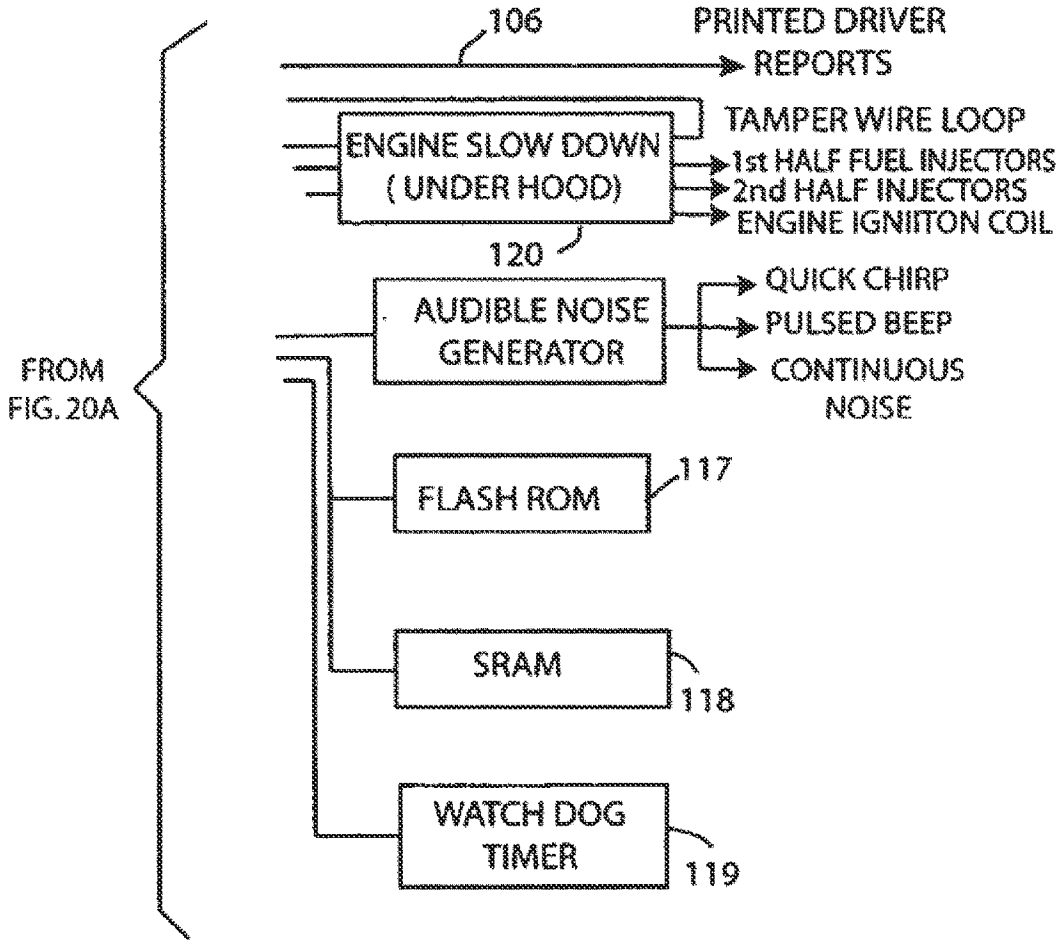
The Examiner contended that the microprocessor 101 is the "master control unit" and argued that engine slow down module 120 and audible noise generator 121 together form the "slave control unit." Rather than being a "unit," as claimed, the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another.



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FIG. 20B




Cherouny at Fig. 20B. There is no teaching of any programmability of audible noise generator, no communication of any kind to the engine slow down, and no function other than making a noise based on an input signal. *Id.* at [0078].

The Examiner did not contend that engine slow down module 120 generates an alarm signal as required by the claim language. The only disclosure remaining is audible noise generator 121, which as indicated by the name, is a simple noise



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generator:

> [0078] An audible noise generator **121** is also connected to the microprocessor for provision of various warning noises such as a quick chirp, a pulsed beep and a continuous noise. These provide warnings of increasing severity to the driver of the vehicle.

*Id.* at [0078]. This does not meet the requirements of the slave control unit when it is properly construed as discussed *supra*.

In the Advisory Action, with respect to the proper claim construction for the "slave control unit" limitation, the Examiner accused the Patent Owner of "reading limitations from the specification into the claims" while simultaneously remarking that "claim construction decisions are based upon the circumstances of each specific case, ***including the disclosure*** and claim language used." Advisory Action at 16-17 (emphasis added). Patent Owner presented portions of the specification/disclosure to support its position that the proper construction of "slave control unit" for the '470 Patent requires a processor and programmability. This is not reading limitations into the claims, but rather it is consistent with how the United States Patent and Trademark Office makes claim construction decisions.

Examiner also argued that the "slave control unit" could perform the claimed functionality through a programmable processor or some other means that does not require programmability. Advisory Action 17-18. However, the Examiner ignored the teachings of the '470 Patent previously discussed which expressly require the



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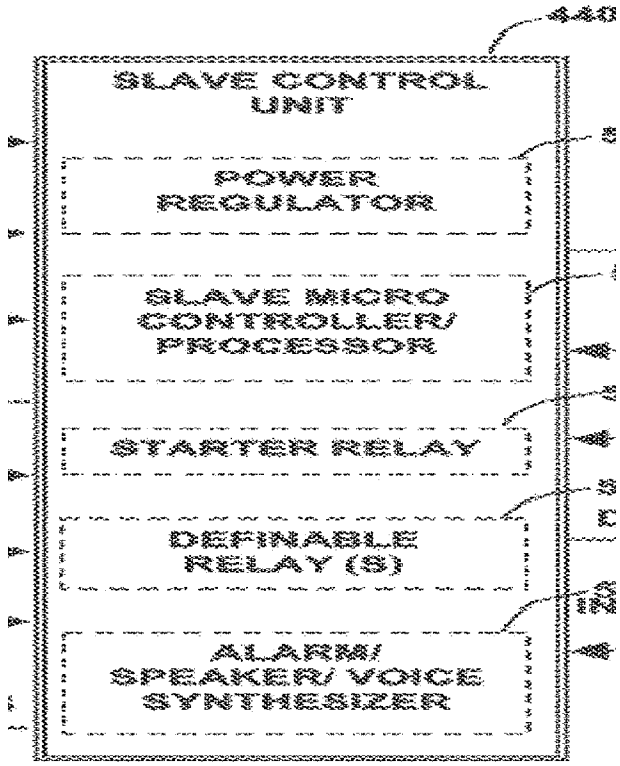
slave control unit to have a processor and be programmable.

Examiner further argued in the Advisory Action that the combination of the slow down module 120 and audible noise generator 121 which are not in communication with one another still constitutes a "unit" by equating them to the disclosure in the '470 Patent for a slave control unit. Advisory Action at 18. He asserted that in the '470 Patent, the slave control unit "is also illustrated as a collection of separate components, having no depiction or disclosure of communication between them." Advisory Action at 18. This is inaccurate. The slave control unit of the '470 Patent shown in FIG. 6 clearly illustrates a single slave control unit 440 with a power regulator, slave micro controller/processor, starter relay, definable relay and alarm/speaker/voice synthesizer as shown below.



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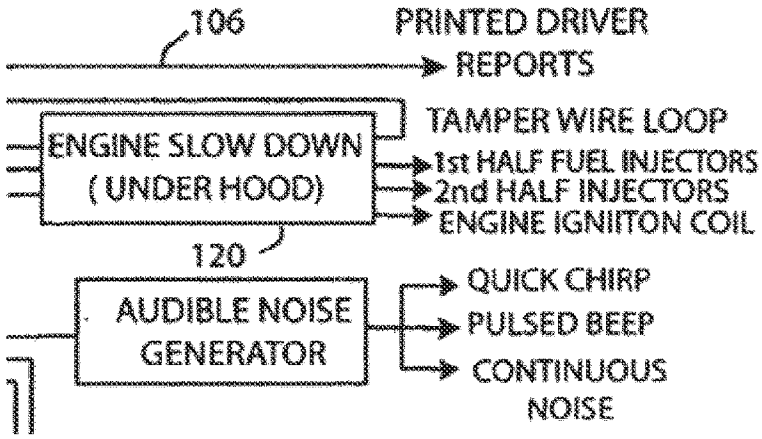

This is in sharp contrast to the separate engine slow down module 120 and audible noise generator 121 that do not communicate with one another and are clearly not part of a singular unit as shown in FIG. 20B of Cherouny reproduced below.



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FIG. 20B




### 6. CLAIM 4 IS ALSO ALLOWABLE.

Claim 4 is allowable for the same reasons previously discussed. Because it is a dependent claim, and thereby incorporates all of the limitations of independent claim 1 from which it depends, the disclosure lacking in Cherouny related to the independent claim limitations discussed herein prevent the combination of Cherouny and Harter from rendering dependent claim 4 obvious.

## B. GROUND 2 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF SHUMAN)

Ground 2 is predicated on a combination of Cherouny and Shuman. As a preliminary matter, the combination of these references is improper. The Examiner conceded that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 27. Indeed,



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Examiner cited neither Cherouny nor Shuman as disclosing a wireless communication system. The Examiner asserted without evidence, however, that a skilled artisan would have been generally motivated to modify Chorouny with Shuman to fabricate a wireless communication system in the manner claimed. *Id.* at 27.

That is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017); *see also DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009).

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present



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> device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.

Cherouny at ¶33.

Similarly, the profile information is kept inaccessible to the driver and is hardwired in a specific manner.

> The instant device utilizes input selector codes. The data is not coded going through the infrared link. It is literal data describing the numerous profiles of all the drivers under all the different driving conditions. The profile is set up in the instant device and inaccessible to the driver.

*Id.* at ¶30.

In short, there is no evidence in the record that an artisan would have been motivated to combine Cherouny and Shuman in the manner claimed, particularly when Cherouny teaches against such an implementation.

The arguments in Ground 1 also apply to this rejection.

### C. GROUND 3 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF PETRIK)

Ground 3 is based on Cherouny in view of Petrik. Here again, Examiner cited neither Cherouny nor Petrik as disclosing a wireless communication system, relying



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only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 33. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Petrik in the manner claimed, particularly when Cherouny teaches against wireless communication for data logging. Cherouny is focused on preventing modification, cessation or interception of logged data using a specialized wiring harness that communicates with a hardwired logging system in the vehicle.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. ***In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.***

Cherouny at ¶33 (emphasis added). Thus, each of the modules is connected through wiring, including a decoy wire that detects tampering. Therefore, it would not have been "obvious to try" modifying Cherouny with Petrik's disclosure of a wireless device because that is taught against by Cherouny itself.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.



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Petrik teaches an individual driver logbook for each driver in the form of a smart card. "Drivers are issued with their logbook smart cards with their fingerprint template recorded in the card." Petrik at ¶22. "At the start of the journey the driver inserts his smart card into the unit's smart card reader/writer and places his finger on the fingerprint reader to confirm his identity. This automatically logs him in as the current driver and enables engine ignition." *Id.* at ¶23. The unique smart card approach of Petrik could not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33. It is inappropriate to use the template provided by the inventor to render the inventor's contribution obvious. *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor")).

The arguments in Ground 1 also apply to this rejection.

### D. GROUND 4 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF BOUCHARD)

Ground 4 is based on Cherouny in view of Bouchard. Here again, Examiner cited neither Cherouny nor Bouchard as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 39. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been



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motivated to combine Cherouny and Bouchard in the manner claimed, particularly when Cherouny teaches against wireless communication.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." *Id.* at 35.

Here again, a review of Bouchard demonstrates that the two approaches of Cherouny and Bouchard are fundamentally inconsistent, and an artisan would not be motivated to combine one with the other. Bouchard is a vehicular *radar* system. Directly contrary to Cherouny, it also teaches a removable storage device.

> A removable, externally readable, non-volatile solid-state memory event recording apparatus (ERA)5 is coupled to the system processor 107. The ERA records the output of each of the sensors and information about targets detected by the radar system.

Bouchard, 8:43-48. The removable memory approach of Bouchard could likewise not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33.

The arguments in Ground 1 also apply to this rejection.

## IX. CONCLUSION

For at least the foregoing reasons, Appellant submits that claims 1 and 4 of the '470 Patent are patentable over the cited art, and respectfully requests that the rejections be reversed.



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Appellant believes no fee is due with this Brief.

Date: November 21, 2024

Respectfully submitted,

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, TX 78731
Telephone: (512) 539-2625
Facsimile: (512) 727-6691



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## CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November 2024, a true and correct copy of the foregoing PATENT OWNER'S APPEAL BRIEF IN REEXAMINATION was served pursuant to 37 C.F.R. § 1.550(f) via Priority Mail Express® (9470130109355003820752) upon the following counsel of record for third-party requesters:

Unified Patents, LLC
4445 Willard Ave.
Suite 600
Chevy Chase, MD 20815

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, Texas 78731



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| *Ex Parte* Reexamination of<br>U.S. Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

**PATENT OWNER'S APPEAL BRIEF IN *EX PARTE* REEXAMINATION**

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant Patent Owner presents this Appeal Brief in the *ex parte* reexamination of U.S. Patent No. 10,259,470 ("'470 Patent"). This brief is filed under 37 C.F.R. §41.37(a) in furtherance of the Notice of Appeal filed for this reexamination on September 23, 2024, regarding the decision of the Examiner of Group 3992 set forth in the Final Office Action dated May 23, 2024 ("Final Office Action") and the Advisory Action dated August 20, 2024 ("Advisory Action"). The First Office Action in this case was issued on February 15, 2024 ("First Office Action").

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## I. REAL PARTY IN INTEREST

The real party in interest is The Phelan Group, LLC, the assignee of record of the '470 Patent, as indicated by an assignment recorded on September 12, 2018, at reel/frame 046851/0608.

## II. RELATED APPEALS, INTERFERENCES AND TRIALS

The '470 Patent is related to the following matters:

1. *The Phelan Group, LLC v. Mercedes-Benz Group A*G, 2:23-cv-607-JRG (EDTX).

2. *The Phelan Group, LLC v. State Farm Mutual Automobile Insurance Co.*, 2:23-cv-611-JRG (EDTX).

3. *The Phelan Group, LLC v. Honda Motor Co., Ltd*, 2:23-cv-606-JRG (EDTX).

## III. STATUS OF THE CLAIMS

The '470 Patent was issued on April 16, 2019 with twenty (20) claims. A request for *ex parte* reexamination, filed August 31, 2023, requested reexamination of claims 1 and 4 of the '470 Patent. The request was granted on October 17, 2023, resulting in the reexamination of claims 1 and 4, both of which currently stand twice and finally rejected.

Pursuant to 37 C.F.R. § 41.37(c)(1)(iii), the following summary is a concise explanation of the subject matter defined in each of the rejected claims 1 and 4 and



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refers to the drawings and specification in the '470 Patent as issued. This particular explanation is for assistance of the Board, by way of example, and is not intended to limit or interpret the claims in any way. Further, for each feature of the claims, there may be additional supportive disclosure in the specification beyond what is cited below.

## IV. STATUS OF THE AMENDMENTS

Applicant has not filed any amendment in this *ex parte* reexamination.

## V. SUMMARY OF THE CLAIMED SUBJECT MATTER

1. A vehicle control system (1:31-35; 6:8-12; FIG. 5), comprising:

a wireless identification and data logging module (7:9-14; FIG.5);

a master control unit (7:29-32; 7:58-62; FIG. 5) in a vehicle for wirelessly authenticating at least one occupant via said wireless driver identification and data logging module (12:37-42; FIG. 5) and associating an operating profile with said at least one occupant (2:37-50; 7:5-8; FIG. 5);

a module for receiving at least location and speed information in association with movement of said motor vehicle (12:37-59);

a data logging device that records vehicle operation data associated with a use of said vehicle (7:46-57; FIG. 5), the vehicle operation data comprising at least said location and speed information received from said module (12:43-48; FIG. 5);

and a slave control unit (6:8-11; 10:48-61; 11:8-22; FIG. 5) in said motor vehicle and in communication with said master control unit (10:48-61; 11:8-22; FIG.



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5),

wherein said slave control unit receives commands from said master control unit and generate an alarm signal (11:45-58; 12:47-55; FIG. 5);

wherein said master control unit provides operation governance of said vehicle (3:4-7; 12:15-18) within an operating profile (2:37-50; 7:5-8; FIG. 5).

4. The vehicle control system of claim 1 (1:31-35; 6:8-12; FIG. 5) wherein said wireless identification and data logging module (7:9-14; FIG.5) comprises at least one of:

a WIFI enabled device; an RFID enabled device; a Bluetooth enabled device; a cellular telephone; and a smartphone (7:9-25).

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." *Id.* at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile that matches requirements of the high-risk driver." *Id.* at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit



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> receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

*Id.* at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are control units, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:

> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.
>
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.

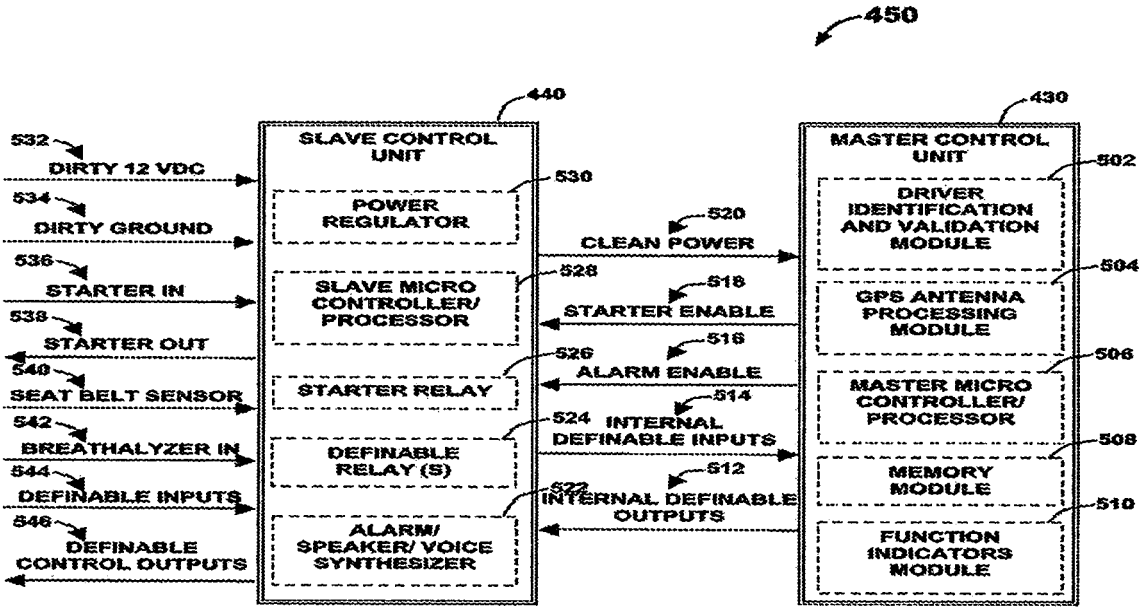


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As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.




*Id.* at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." *Id.* at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an



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actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

## VI. SUMMARY OF THE ARGUMENT

As set forth below, while the Examiner has given this case careful consideration, an error recurs in the analysis. With respect to master control unit and slave control unit, the Examiner appears to collapse both elements into a single communication between them. *See* Advisory Action at 5 ("the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit"). In doing so, there is no construction of "master control unit" or "slave control unit," which are terms that have been construed by this tribunal previously, consistently with the construction advanced by Appellant. Dictionaries cited by the Examiner ignore the "control unit" designation for each of those two elements in the claims, resulting in the deviation between the two positions. Of course, claim elements should not be read so as to render key claim terms superfluous.



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A similar problem arises in connection with the claimed "a wireless identification and data logging module (7:9-14; FIG.5)." The Examiner assert that "The Office initially notes that the claimed wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But the data logging device itself is claimed as a wireless device, so that is not the case; a POSITA would understand identification and data logging communications to be communicated wirelessly.

Cherouny discloses an exclusively wired communication that is especially adapted to prevent tampering. Cherouny explicitly requires that "all the various electronic modules" are wired together, including with a specialized wiring harness, so that if any component is removed, presumably including whatever component would be alleged to be the claimed component is removed, the system is alerted to that problem. Thus, Cherouny is directed to a different problem, and specifically teaches away from wireless communications for data logging.

Claim 1 of the '470 Patent also requires that speed and location information are received "***in association with a movement of said vehicle.***" Cherouny discloses that speed information is determined not from "movement of said vehicle," but rather clock cycles associated with wheel sensors.

Examiner also improperly relies on the same structure (car monitor 170 of Cherouny) to teach two separate claim elements—the data logging device and the



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identification and data logging module recited in claim 1 of the '470 Patent. It is with these foundational elements in mind that we respectfully submit the following arguments for consideration.

## VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicant appeals the rejections of claims 1 and 4 of the '470 Patent.

Ground 1: Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter.

Ground 2: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman.

Ground 3: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik.

Ground 4: Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

## VIII. ARGUMENT

### A. GROUND 1 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF HARTER)

#### 1. NO MOTIVATION TO COMBINE CHEROUNY WITH HARTER EXISTS.

The combination of Cherouny and Harter is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*,



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964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).

The Examiner correctly notes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 18. On the contrary, Cherouny teaches secure wired communication with dummy wires to prevent tampering.

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is



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> broken for even a moment the event is recorded and documented.

Cherouny at ¶33. Therefore, it would not have been "obvious to try" modifying Cherouny with Harter's disclosure of a wireless device because that is taught against by Cherouny itself.

In the Advisory Action at page 3, the Examiner acknowledges that the claimed wireless communication includes wirelessly authenticating the driver of the vehicle. More specifically, the claim requires: "a master control unit in a vehicle for wirelessly authenticating at least one occupant." The Examiner then states that "the wireless communication is limited to wirelessly authenticating the driver of the vehicle." Advisory Action at 3. But that characterization misses two elements: the previously claimed "wireless identification and data logging module" and the "master control unit" itself, which is engaging in wireless communication with it per the claim. Thus, the Examiner's efforts to distill the claimed wireless functionality to a single communication is incorrect; each of those components must communicate wirelessly per the express claim language. The Examiner makes a similarly incorrect slight of hand by defining "master control unit" and a "slave control unit" by the claimed communication between them, instead of evaluating the meaning of the terms to a POSITA. *See* Advisory Action at 5. As set forth above, the "data logging module" is explicitly wired in a very particular way in Cherouny.

As set forth below, the Examiner largely ignores the "master control unit" and



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"slave control unit" other than as to a single communication. But Cherouny's CPU is wired. As set forth in the specification:

> ***The CPU module is wired to the under the hood box and a connection to that wiring in the back of the dash mounting holder.*** The holder guides the CPU modules into the connector as the CPU module is inserted into the holder. The programmable unit is contained in a module which controls the speed of the vehicle and the memory function of the module itself. The unit is essentially a hand-held computer that is an integrated, low-voltage, Single chip implementation of a high-performance 32 bit, X-scale compatible microprocessor with the extra logic needed for PC/AT compatible PCs. It has a AMD386 or more advanced chip CPU core with a memory control unit, ISA bus controller and peripheral control logic.

Cherouny at ¶17.

Thus, a person of ordinary skill would not be motivated to combine Harter or any other reference relating to wireless communication with Cherouny, which is directed to preventing interception, cessation or modification of data with a specific wired connection within the vehicle, and which teaches fully away from wireless communications because of its different objectives. *Id.* at ¶33.

### 2. CHEROUNY DOES NOT DISCLOSE A MASTER CONTROL UNIT AS PROPERLY CONSTRUED.

Cherouny does not disclose the "master control unit" of claim 1 as properly construed. Examiner alleged in the Final Office Action that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's



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> data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).

May 23, 2024 Final Office Action at 16-17.

The Examiner argued that "there does not appear to be an allegation that Cherouny does not disclose the claimed master control unit, only that it is implemented differently." *Id.* at 9. That assertion is incorrect. Bilateral communication is required between a master control unit and a slave control unit. That is claimed and stated clearly in the prosecution history. Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Prosecution History-related patent to the '470 Patent).

The '470 Patent's master control unit is designed to identify a driver profile in which the vehicle operates and for controlling various vehicle system components and has all the necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny. For example, the master control unit 430 of the '470 Patent includes a driver identification and validation module 502, a GPS antenna processing module 504, a master micro controller/processor 506, a memory module 508 and a function indicators module 510. '470 Patent at FIG. 6.

The communications interfaces of the master control unit 430 depicted in the specification include outputs such as starter enable 518, alarm enable 516, and internal definable outputs 512. The inputs include clean power 520 and other



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internal definable inputs 514. *Id.* at 10:48-11:52; FIG. 6.

The master control unit is to be understood in a specific systemic context, namely its relationship to the "slave control unit" claimed in claim 1 and discussed in "Limitation 1(e)" below. The master control unit and slave control unit "communicate," as set forth in claim 1. *See also* IEEE 100 Authoritative Dictionary, "master": "a device that initiates communications requests to gather data or perform controls." As stated in prosecution, "the master and slave control units claimed work in parallel and ***thus require bidirectional communication***." Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 (U.S. Patent No. 8,417,415 Patent Prosecution History) (emphasis added).

Cherouny, in contrast, discloses a microprocessor that performs calculations and processes data based on inputs. These inputs include inputs from an automobile speed sensor 108, a key fob reader 109, and power conditioning 110. Cherouny at [0073], FIG. 20A. The microprocessor in turn provides simple instructions to peripheral components to execute functions such an audible noise generator 121, which Examiner identifies as a "slave control unit." *Id.* at [0077], [0078], FIG. 20A.

As set forth in more detail in connection with Section 1(e) ("slave control unit"), a control unit is a term of skill in the art. Likewise, a "master" and "slave" relationship is well understood, and the intrinsic record is clear that bidirectional communication is required. These terms are understood in the context of the



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specification, which supports a construction of "master control unit" that requires bidirectional communication. There is no communication received from the noise generator in Cherouny.

In the Advisory Action, Examiner asserted that "the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit" and that "the reception of commands by the slave control unit constitutes the claimed 'communication.'" Advisory Action at 5. First, Examiner effectively ignores the claimed control units, and instead looks only to the presence of a communication. Respectfully, the terms "master control unit" and "slave control unit" must be understood as a POSITA would, as a control unit having a processor or microcontroller, having bidirectional communication and controlling components in their own right.

Moreover, as to the characterization of the communications themselves, Patent Owner respectfully disagrees. The claim language expressly states: "a slave control unit...which communicates with said master control unit wherein said slave control unit receives commands from said master control unit." '470 Patent at 14:19-22. In other words, the language requires the slave to be able to send signals to communicate with the master ***and*** receive commands/signals from the master control unit. This understanding is borne out consistently in the intrinsic record, including



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the figures and prosecution history.

Examiner also argued in the Advisory Action that during original prosecution, that Examiner "found the arguments not persuasive and maintained the rejection" with respect to the "bilateral communication" argument that Patent Owner made in the U.S. Patent No. 8,417,415 prosecution history. Advisory Action at 6. While it is true that the Examiner found the argument Applicant made differentiating the claim language and the cited prior art (Gratz) unpersuasive, he did not imply or state that the claim language did not require bi-directional communication as Applicant asserted.

Examiner further cited two references purporting to support his position that bi-directional communication is not inherent in a master-slave relationship. Advisory Action at 7. In doing so, he completely ignores the phrase "control unit" appended to each of "master" and "slave," which is improper and results in error. A control unit is a well understood term, and that understanding is corroborated by the prosecution history.

Even so, one of the selected references cited by the Examiner discloses that the slave responds/communicates with the master device. The cited PC Magazine references notes, "one device acts as the controller (the master) and initiates the commands, and the other devices (the slaves) ***respond*** accordingly. (emphasis added). Regardless, the Patent Owner's argument is not that bi-directional



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communication is inherent in all master-slave relationships, but rather that in view of the intrinsic record (prosecution history/specification and drawings) as previously discussed, bi-directional communication is required for claim 1 of the '470 Patent.

The Examiner acknowledged "that in Fig. 6 of the '470 patent, there are two signals illustrated that are from the slave control unit to the master control unit; clean power 520 and internal definable inputs 514." Advisory Action at 7. The Examiner alleged, however, that "the '470 patent includes no disclosure as to the nature of these signals, and there is no disclosed nor claimed use of these signals." *Id.* at 8. This is both irrelevant and inaccurate. The presence of the arrows showing commands from the slave control unit to the master control along with the arrows showing commands from the master control unit to the slave control unit in FIG. 6 clearly depict the bi-directional flow Patent Owner argues is required in the '470 Patent regardless of whether the nature of the signals is detailed. Moreover, the '470 Patent does discuss these signals, stating "the master control unit 430 and the slave control unit 440 can be communicated via various communication signal lines such as clean power signal 520, an alarm enable signal 516, internal definable input signal 514 and an internal definable output signal 512." '470 Patent at 11:16-22.

### 3. CHEROUNY DOES NOT DISCLOSE RECEIVING LOCATION AND SPEED INFORMATION IN ASSOCIATION WITH A MOVEMENT OF A VEHICLE.

Cherouny does not disclose receiving location and speed information "***in***



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***association with a movement of a vehicle***" as required by claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor 108, [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1).

May 23, 2024 Final Office Action at 17.

Examiner alleged that "[t]he limitation also merely recites the receipt of speed information and location information" and "[t]here is no limitation regarding the mechanism for deriving said information." May 23, 2024 Final Office Action at 11. Patent Owner disagrees. This limitation of the '470 Patent requires that speed and location information are received "***in association with a movement of said vehicle***." Cherouny discloses that speed information is determined ***not*** from "movement of said vehicle," but rather clock cycles associated with wheel sensors. Cherouny never uses vehicle movement to determine speed. On the contrary, Cherouny states:

> ***The instant device counts clock cycles between rising edges as well as any other part***, such as the falling edges or even voltage levels, of the square wave coming from an additional wheel sensor similar to the antilock ABS sensors on one of the wheels. This digital computer ***version of speed detection is unique when used with the other features of the device.***

Cherouny at [0011], [0015] (emphasis added).

Hence, Cherouny's methodology for estimating speed—clock cycles and wheel rotation—does not teach or suggest this claim limitation. Cherouny's sole mention of GPS is so that the system can be made aware of school zones. *Id.* at [0010], [0020]. Cherouny never teaches or suggests using GPS to determine speed and location based on vehicle movement.

Examiner admitted in the Advisory Action that "Cherouny's mechanism for measuring vehicle speed involves the counting of pulses generated by speed sensors integrated with the antilock brake device or other sensor on the wheel, generating a square wave as the wheel rotates," but refused to concede that is not the equivalent of receiving speed information in association with a movement of said vehicle. Advisory Action at 11. Cherouny's described mechanism for measuring vehicle speed is associated with movement of ***components*** of the vehicle (clock cycles and wheel rotation) and not associated with movement of the vehicle itself.

### 4. CHEROUNY DOES NOT DISCLOSE A SEPARATE DATA LOGGING DEVICE AND IDENTIFICATION AND DATA LOGGING MODULE.

Cherouny does not disclose a separate "data logging device" and "identification and data logging module" as recited in claim 1.

Examiner asserted in the Final Office Action that Cherouny discloses:

> d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle**



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> **operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], [0080]-[0081]).

May 23, 2024 Final Office Action at 17.

Examiner argued that "[c]laiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as Cherouny's disclosed car monitor 170) does not impart patentability when all of the claimed functionality is carried out be the disclosed combined hardware/software component." May 23, 2024 Final Office Action at 12. However, Examiner failed to address the United States Patent and Trademark Office and Federal Circuit decisions related to this issue discussed in Patent Owner's April 15, 2024 Response to the Non-Final Office Action.

In particular, the PTAB has determined that it would be "problematic" to rely on one component of a prior art reference as teaching two separate components of a claim. In *Hopkins*, the PTAB held that the prior art disclosure of an accelerometer with an output signal could not be applied as teaching both a "deceleration signal" and an "inclination signal" as claimed. H*opkins Manufacturing Corp. v. Cequent Performance Products, Inc.* (IPR 2015-00613, Paper 9, August 7, 2015).



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According to *Becton*, "[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention." *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010). Where a claim provides for two separate elements (*e.g.*, a "second portion" and a "return portion"), these two elements "logically cannot be one and the same." *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996).

Therefore, it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching the two separate claim elements (a data logging device and an identification and data logging module) of claim 1 of the '470 Patent. This is particularly true when the specification highlights the reason why having a data logging device separate from the identification and data logging module is beneficial. The '470 Patent states, "the system 450 can provide an owner alarm signal 460 that remotely alerts the authorized vehicle owner 470 regarding violation of the programmed operating profile 435." '470 Patent at 8:20-24. This arrangement allows for a system in which the identification and data logging module can be located in the vehicle for identifying the operator, and the data logging device can be remote from the vehicle to alert others not occupying the vehicle of the operating conditions.



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Examiner alleged in the Advisory Action that "Patent Owner's own specification discloses that the data logging device and the identification and data logging module/device could be embodied in a single component." Advisory Action at 13. However, the cited column 7, lines 33-35 and 46-47 of the '470 Patent, actually discloses two separate components—a driver authentication and data logging module 425 and a data logging device 452. FIG. 5 of the '470 Patent described in the cited passages also confirms that the '470 Patent has two separate components (a driver identification and data logging module and a data logging device).

Examiner also cited U.S. Patent No. 9,045,101 to which the '470 patent claims priority, and alleged that it "explicitly discloses a single 'driver identification and data logging device,' whereby the master control unit receives a unique identification code from the data logging device to authenticate a high-risk driver..., and whereby the driver logging device also records vehicle operation data associated with use of the motor vehicle by said at least one driver, including location and speed information." Advisory Action at 14. However, the claims of the '101 Patent only recite a single device, a data logging device, and FIG. 5 of the '101 Patent (reproduced below) has a completely different FIG. 5 from the '470 Patent, depicting only a driver identification and data logging device 425.



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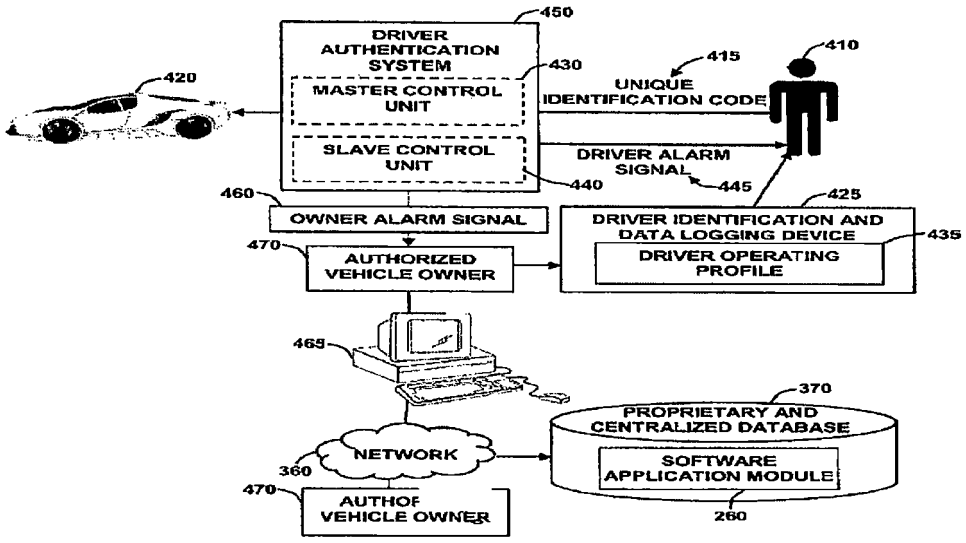



FIG. 5

In contrast, the '470 Patent (reproduced below) depicts two separate components—a data logging device 452 and a driver identification and data logging module 425.



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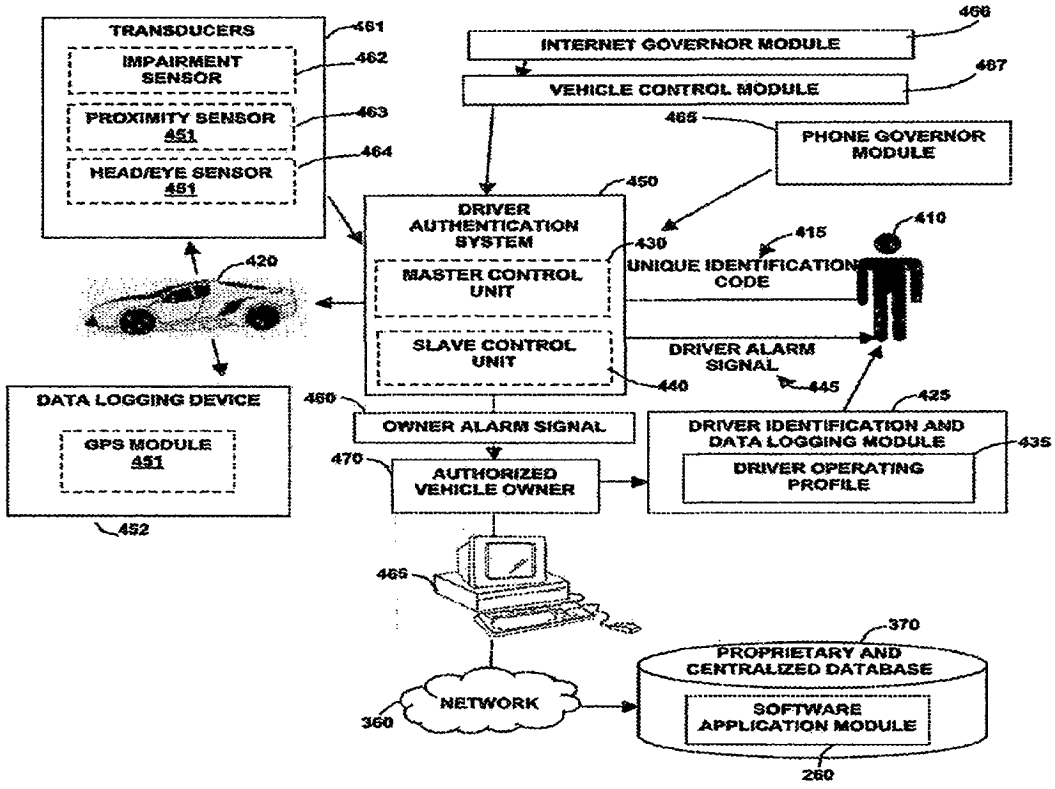



FIG. 5

Because the claim elements are listed separately in the '470 Patent for the data logging device and driver identification and data logging module, the clear implication is that those elements are distinct components which is reinforced by the specification and FIG. 5 of the '470 Patent. *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010) ("[w]here a claim lists elements separately, 'the clear implication of the claim language is that those elements are distinct component[s]' of the [claimed] invention."; *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996) ("[w]here a claim provides for two separate



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elements (*e.g.*, a 'second portion' and a 'return portion'), these two elements logically cannot be one and the same.").

### 5. CHEROUNY DOES NOT DISCLOSE A SLAVE CONTROL UNIT WHEN THAT PHRASE IS PROPERLY CONSTRUED.

Cherouny does not disclose the "slave control unit" of claim 1 when that phrase is properly construed under any standard. A slave control unit is by definition ***a control unit*** that a POSITA would understand has certain characteristics. The Examiner has read this term out of the patent claim altogether, which is contrary to governing caselaw of the PTAB applying the BRI standard for this term.

Examiner alleged in the Final Office Action that Cherouny discloses:

> e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module 120 and audible noise generator 121, [0077]-[0078] and Figs. 20A &20B; see also disclosure that functions of the driver monitor include engine slowdown 181 and audible noise alarms 182, [0082] and Figs. 21A &21B; see also disclosure of the possible audio alarms, [0021]-[0024] and [0031]).

May 23, 2024 Final Office Action at 17-18.

The Examiner also made the following claim:

> The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and



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> nothing in the claims with respect to communication from the slave control unit to the master control unit.

May 23, 2024 Final Office Action at 13. This is incorrect and contrary to established law.

A slave control unit is a type of control unit. That should be apparent based on the plain and ordinary meaning of the claims and the intrinsic record. The Examiner reading out the phrase "control unit" from "slave control unit" constitutes plain error. Patent claims should be construed to avoid rendering claim terms superfluous. *Digital-Vending Services International, LLC v. University of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). For example, when a claim refers to "steel baffles," this "strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Phillips v, AWG Corp*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). That truism applies under any claim construction standard.

A control unit incorporates a controller. These take the form of a processor or microcontroller. *IControl Networks, Inc. v. Zonoff Inc.*, No. CV 14-1199-GMS, 2016 WL 1437892, at *1 (D. Del. Apr. 11, 2016) (construing "control unit" to require a programmable processor); *Glaston Corp. v. Salem Fabrication Techs. Grp.*, No. 1:21-CV-942, 2024 WL 1673273, at *17 (M.D.N.C. Apr. 18, 2024) (successfully arguing that "control units or controllers" are well-recognized structural units in patent law that a POSA would understand); *Capella Photonics, Inc. v. Fujitsu Network Commc'ns, Inc.*, No. 2:20-CV-00076-JRG, 2021 WL 465430, at *22 (E.D.



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Tex. Feb. 9, 2021) (a "control unit" refers to known structure, "namely a controller" such as a computer processor).

For this reason, and ***applying the BRI standard***, the PTAB has held that a controller ***must*** include ***a processor*** and ***be programmable***.

> The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[ ]." 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

*One World Techs., Inc. v. Chamberlain Grp., Inc.*, No. IPR2017-00073, 2018 WL 1960893, at *3–4 (P.T.A.B. Apr. 24, 2018).

The PTAB further observed that "broadest reasonable interpretation ... is an interpretation that corresponds with what and how the inventor describes his invention in the specification."

> Our interpretation "'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.' A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster." *Microsoft Corp. v. Proxyconn*, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citations omitted), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).



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> In the Decision on Institution, based on the parties' arguments, see Pet. 13–32; Paper 6, 5–16, and record at the time, we preliminarily interpreted the following limitations of claim 1:
> ***"controller": a microprocessor, processor, or other programmable logic*** that controls the operation of the barrier movement operator.

*Id.*

In view of the proper construction of "slave control unit," the Examiner's identification of a soundmaker as a "slave control unit" is in error. Properly construed, it is not a slave control unit. It has no processor and is not programmable.

A POSITA would, in view of the teachings of the specification and claims, understand a "slave control unit" in the context of its required communication with a "master control unit." Both contain processors and are programmable, as set forth in the intrinsic record and discussed below.



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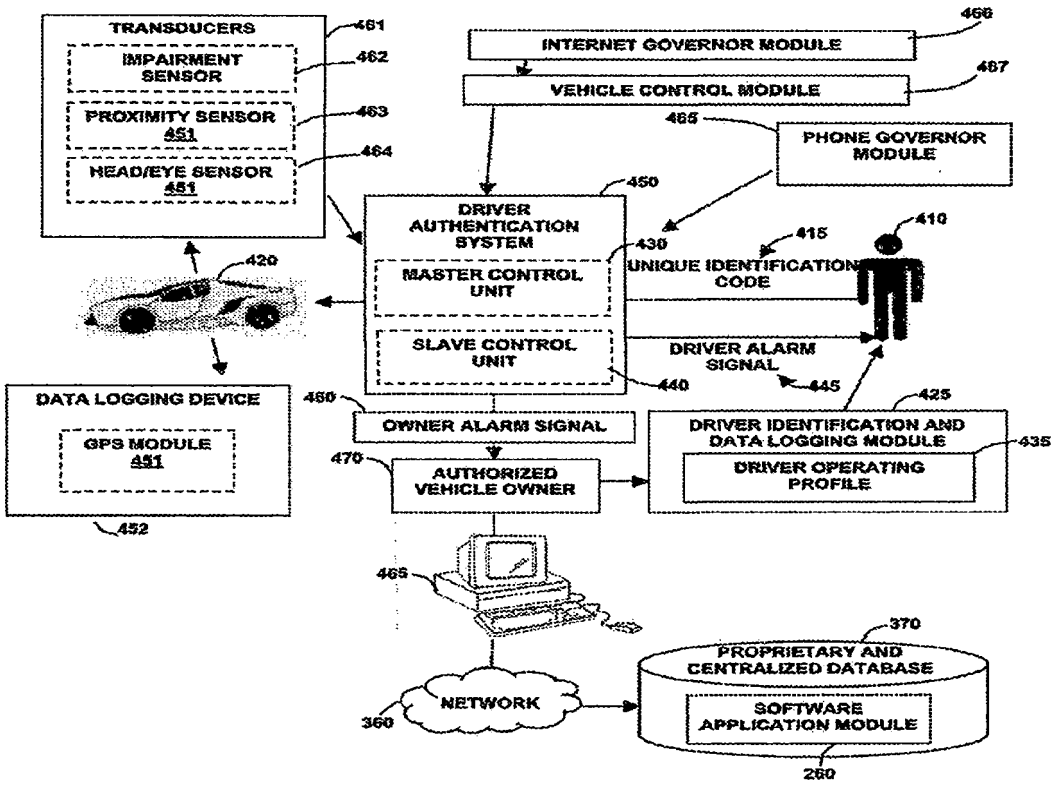



FIG. 5

The "slave control unit" 440 itself has a microprocessor and can be programmed.

> The system 450 generally includes a master control unit 430 and a slave control unit 440 that can be accessed and programmed via the software application module 260 stored in the proprietary and centralized database 370.

'470 Patent at 6:8-12; *accord* 8:9-24. The slave control unit processes inputs from sensors:

> The slave control unit **440** can process the data collected from the sensors and determine if the data indicates a condition that requires a warning. For example, the



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> sensors may indicate that the vehicle is speeding, veering off the road, approaching an obstruction in the road, too close to another vehicle, that the vehicle driver is distracted, sleepy, or not paying attention, that the vehicle driver is impaired etc. If one of these conditions is identified, the slave control unit **440** signals the master control unit **430** and the master control unit issues a driver alarm signal **445** as described above. In the case where the impairment sensor **462** provides a signal to the slave control unit **440** indicating that the driver's impairment is above a prescribed limit, the slave control unit can prevent the vehicle from starting.

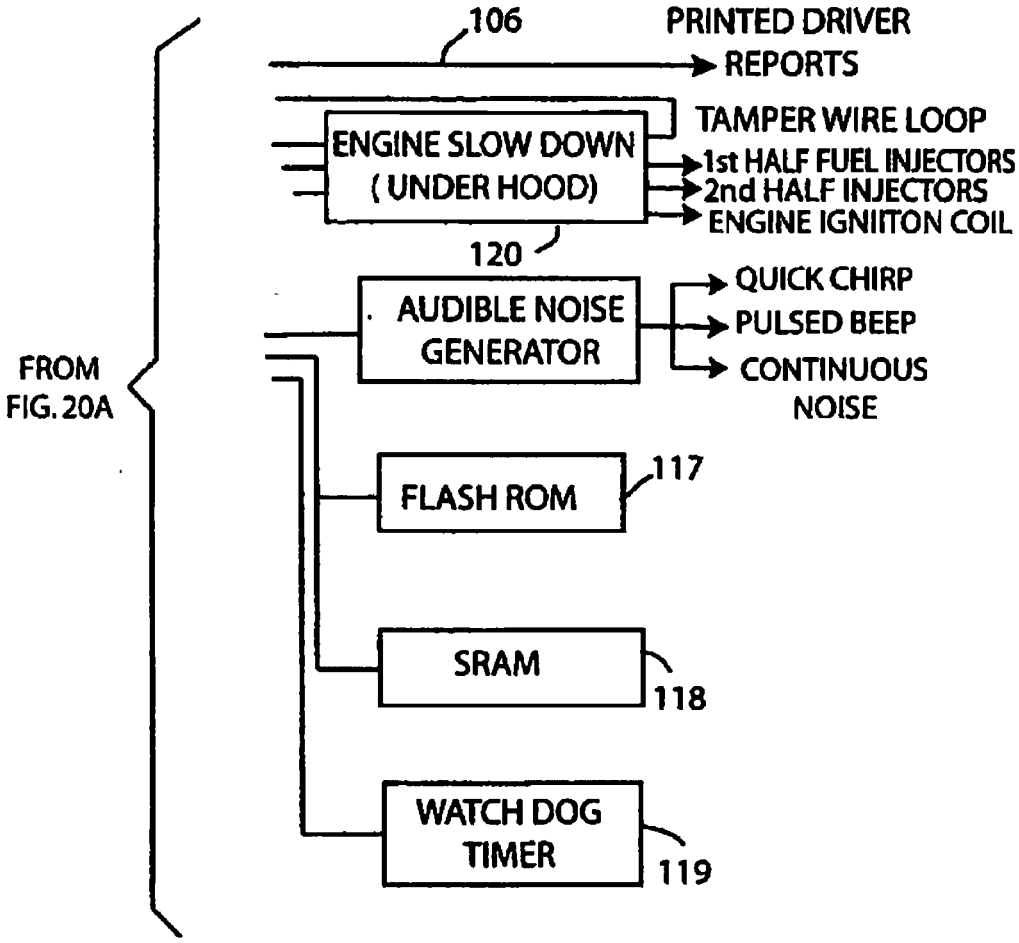
'470 Patent at 8:43-56; 10:48-61.

The Examiner contended that the microprocessor 101 is the "master control unit" and argued that engine slow down module 120 and audible noise generator 121 together form the "slave control unit." Rather than being a "unit," as claimed, the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another.



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FIG. 20B




Cherouny at Fig. 20B. There is no teaching of any programmability of audible noise generator, no communication of any kind to the engine slow down, and no function other than making a noise based on an input signal. *Id.* at [0078].

The Examiner did not contend that engine slow down module 120 generates an alarm signal as required by the claim language. The only disclosure remaining is audible noise generator 121, which as indicated by the name, is a simple noise



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generator:

> **[0078]** An audible noise generator **121** is also connected to the microprocessor for provision of various warning noises such as a quick chirp, a pulsed beep and a continuous noise. These provide warnings of increasing severity to the driver of the vehicle.

*Id.* at [0078]. This does not meet the requirements of the slave control unit when it is properly construed as discussed *supra*.

In the Advisory Action, with respect to the proper claim construction for the "slave control unit" limitation, the Examiner accused the Patent Owner of "reading limitations from the specification into the claims" while simultaneously remarking that "claim construction decisions are based upon the circumstances of each specific case, ***including the disclosure*** and claim language used." Advisory Action at 16-17 (emphasis added). Patent Owner presented portions of the specification/disclosure to support its position that the proper construction of "slave control unit" for the '470 Patent requires a processor and programmability. This is not reading limitations into the claims, but rather it is consistent with how the United States Patent and Trademark Office makes claim construction decisions.

Examiner also argued that the "slave control unit" could perform the claimed functionality through a programmable processor or some other means that does not require programmability. Advisory Action 17-18. However, the Examiner ignored the teachings of the '470 Patent previously discussed which expressly require the



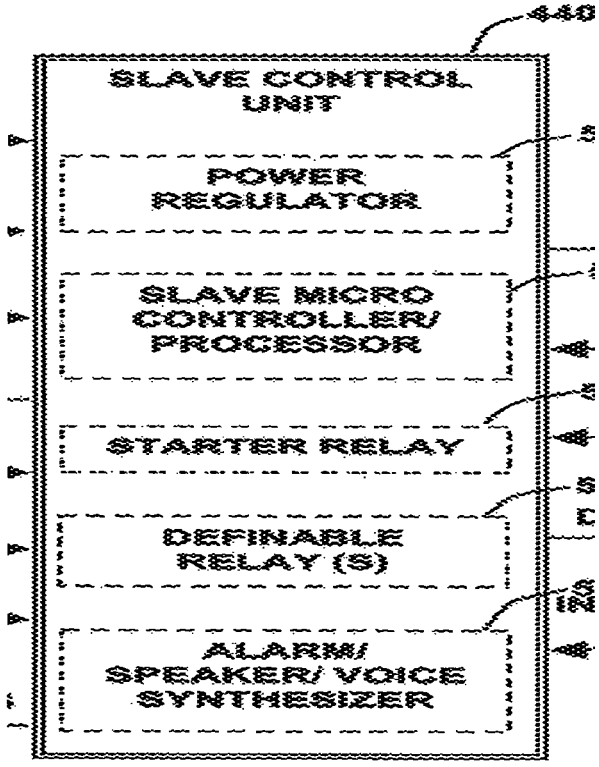
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slave control unit to have a processor and be programmable.

Examiner further argued in the Advisory Action that the combination of the slow down module 120 and audible noise generator 121 which are not in communication with one another still constitutes a "unit" by equating them to the disclosure in the '470 Patent for a slave control unit. Advisory Action at 18. He asserted that in the '470 Patent, the slave control unit "is also illustrated as a collection of separate components, having no depiction or disclosure of communication between them." Advisory Action at 18. This is inaccurate. The slave control unit of the '470 Patent shown in FIG. 6 clearly illustrates a single slave control unit 440 with a power regulator, slave micro controller/processor, starter relay, definable relay and alarm/speaker/voice synthesizer as shown below.



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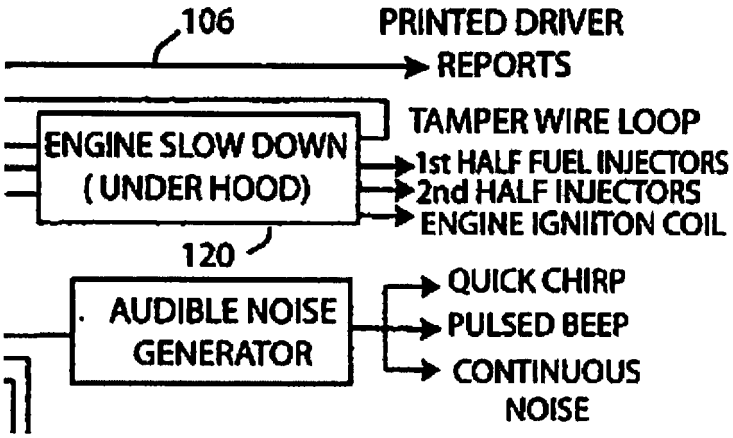



This is in sharp contrast to the separate engine slow down module 120 and audible noise generator 121 that do not communicate with one another and are clearly not part of a singular unit as shown in FIG. 20B of Cherouny reproduced below.



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FIG. 20B




**6. CLAIM 4 IS ALSO ALLOWABLE.**

Claim 4 is allowable for the same reasons previously discussed. Because it is a dependent claim, and thereby incorporates all of the limitations of independent claim 1 from which it depends, the disclosure lacking in Cherouny related to the independent claim limitations discussed herein prevent the combination of Cherouny and Harter from rendering dependent claim 4 obvious.

**B. GROUND 2 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF SHUMAN)**

Ground 2 is predicated on a combination of Cherouny and Shuman. As a preliminary matter, the combination of these references is improper. The Examiner conceded that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 27. Indeed,



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Examiner cited neither Cherouny nor Shuman as disclosing a wireless communication system. The Examiner asserted without evidence, however, that a skilled artisan would have been generally motivated to modify Chorouny with Shuman to fabricate a wireless communication system in the manner claimed. *Id.* at 27.

That is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.,* 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017); *see also DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.,* 567 F.3d 1314, 1327 (Fed. Cir. 2009).

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present



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> device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.

Cherouny at ¶33.

Similarly, the profile information is kept inaccessible to the driver and is hardwired in a specific manner.

> The instant device utilizes input selector codes. The data is not coded going through the infrared link. It is literal data describing the numerous profiles of all the drivers under all the different driving conditions. The profile is set up in the instant device and inaccessible to the driver.

*Id.* at ¶30.

In short, there is no evidence in the record that an artisan would have been motivated to combine Cherouny and Shuman in the manner claimed, particularly when Cherouny teaches against such an implementation.

The arguments in Ground 1 also apply to this rejection.

### C. GROUND 3 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF PETRIK)

Ground 3 is based on Cherouny in view of Petrik. Here again, Examiner cited neither Cherouny nor Petrik as disclosing a wireless communication system, relying



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only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 33. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Petrik in the manner claimed, particularly when Cherouny teaches against wireless communication for data logging. Cherouny is focused on preventing modification, cessation or interception of logged data using a specialized wiring harness that communicates with a hardwired logging system in the vehicle.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. ***In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.***

Cherouny at ¶33 (emphasis added). Thus, each of the modules is connected through wiring, including a decoy wire that detects tampering. Therefore, it would not have been "obvious to try" modifying Cherouny with Petrik's disclosure of a wireless device because that is taught against by Cherouny itself.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.



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Petrik teaches an individual driver logbook for each driver in the form of a smart card. "Drivers are issued with their logbook smart cards with their fingerprint template recorded in the card." Petrik at ¶22. "At the start of the journey the driver inserts his smart card into the unit's smart card reader/writer and places his finger on the fingerprint reader to confirm his identity. This automatically logs him in as the current driver and enables engine ignition." *Id.* at ¶23. The unique smart card approach of Petrik could not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33. It is inappropriate to use the template provided by the inventor to render the inventor's contribution obvious. *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor")).

The arguments in Ground 1 also apply to this rejection.

### D. GROUND 4 UNDER 35 U.S.C. § 103 (CHEROUNY IN VIEW OF BOUCHARD)

Ground 4 is based on Cherouny in view of Bouchard. Here again, Examiner cited neither Cherouny nor Bouchard as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 39. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been



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motivated to combine Cherouny and Bouchard in the manner claimed, particularly when Cherouny teaches against wireless communication.

The Examiner also acknowledged that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." *Id.* at 35.

Here again, a review of Bouchard demonstrates that the two approaches of Cherouny and Bouchard are fundamentally inconsistent, and an artisan would not be motivated to combine one with the other. Bouchard is a vehicular *radar* system. Directly contrary to Cherouny, it also teaches a removable storage device.

> A removable, externally readable, non-volatile solid-state memory event recording apparatus (ERA)5 is coupled to the system processor 107. The ERA records the output of each of the sensors and information about targets detected by the radar system.

Bouchard, 8:43-48. The removable memory approach of Bouchard could likewise not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33.

The arguments in Ground 1 also apply to this rejection.

## IX. CONCLUSION

For at least the foregoing reasons, Appellant submits that claims 1 and 4 of the '470 Patent are patentable over the cited art, and respectfully requests that the rejections be reversed.



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Appellant believes no fee is due with this Brief.

Date: November 21, 2024

Respectfully submitted,

/s/ *Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, TX 78731
Telephone: (512) 539-2625
Facsimile: (512) 727-6691



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Page 157 of 1244

## CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November 2024, a true and correct copy of the foregoing PATENT OWNER'S APPEAL BRIEF IN REEXAMINATION was served pursuant to 37 C.F.R. § 1.550(f) via Priority Mail Express® (9470130109355003820752) upon the following counsel of record for third-party requesters:

Unified Patents, LLC
4445 Willard Ave.
Suite 600
Chevy Chase, MD 20815

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, Texas 78731



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LHDTSV-8

## X. CLAIMS APPENDIX

1. (Original) A vehicle control system, comprising:

a wireless identification and data logging module;

a master control unit in a vehicle for wirelessly authenticating at least one occupant via said wireless driver identification and data logging module and associating an operating profile with said at least one occupant;

a module for receiving at least location and speed information in association with movement of said motor vehicle;

a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said location and speed information received from said module;

and a slave control unit in said motor vehicle and in communication with said master control unit,

wherein said slave control unit receives commands from said master control unit and generate an alarm signal;

wherein said master control unit provides operation governance of said vehicle within an operating profile.

4. (Original) The vehicle control system of claim 1 wherein said wireless identification and data logging module comprises at least one of:

a WIFI enabled device; an RFID enabled device; a Bluetooth enabled device; a cellular telephone; and a smartphone.

OPAP LHDT SW-5
SEP 30 2024
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Reexam

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Signature /Gregory S. Donahue/

Typed or printed name Gregory S. Donahue

| | |
|---|---|
| First Named Inventor: Phelan, Michael | |
| Application Number: 90/015,287 | Filed: 08/31/2023 |
| For: | |
| Art Unit: 3992 | Examiner: Wassum, Luke S. |

Applicant hereby **appeals** to the Patent Trial and Appeal Board from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) $ 840.00

☐ Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 60%, and the resulting fee is: $ _____

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I am the

☐ applicant

☑ attorney or agent of record
Registration number 47,531

☐ attorney or agent acting under 37 CFR 1.34
Registration number _____

Signature /Gregory S. Donahue/

Typed or printed name Gregory S. Donahue

Telephone Number 512-539-2625

Date 9/23/2024

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5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;

6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;

7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;

8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));

9) the Office of Personnel Management (OPM) for personnel research purposes; and

10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

# FAX COVER SHEET

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| TO | Commissioner for Patents |
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| FROM | Shannon Mason |
| DATE | 2024-09-23 20:44:52 GMT |
| RE | Notice of Appeal (Appl No. 90/015,287) |

## COVER MESSAGE

Please find attached Patent Owner's Notice of Appeal to be filed in Application No 90/015,287. The credit card payment form for the filing fee will be faxed under separate cover.



PAGE 1/3 * RCVD AT 9/23/2024 4:45:22 PM [Eastern Daylight Time] * SVR:W-PTOFAX-DTS-E1/42 * DNIS:2739900 * CSID:15127145447 * ANI:5034367160 * DURATION (mm-ss):04-45

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Signature: /Gregory S. Donahue/

Typed or printed name: Gregory S. Donahue

First Named Inventor: Phelan, Michael

| Application Number | Filed |
|---|---|
| 90/015,287 | 08/31/2023 |

For:

| Art Unit | Examiner |
|---|---|
| 3992 | Wassum, Luke S. |

Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) $ 840.00

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I am the

☐ applicant

☑ attorney or agent of record. Registration number 47,631

☐ attorney or agent acting under 37 CFR 1.34. Registration number _____

Signature: /Gregory S. Donahue/

Typed or printed name: Gregory S. Donahue

Telephone Number: 512-539-2825

Date: 9/23/2024

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/015,287 | 08/31/2023 | 10259470 | PHE101 | 7777 |

64064 7590 08/20/2024

Ortiz & Lopez, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

| EXAMINER | |
|---|---|
| WASSUM, LUKE S | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3992 | |

| MAIL DATE | DELIVERY MODE |
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| 08/20/2024 | PAPER |

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

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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/015,287* .

PATENT UNDER REEXAMINATION *10259470* .

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)).

| **Ex Parte Reexamination Advisory Action** *Before the Filing of an Appeal Brief* | **Control No.** 90/015,287 | **Patent Under Reexamination** 10259470 | |
|---|---|---|---|
| | **Examiner** Luke S Wassum | **Art Unit** 3992 | **AIA (FITF) Status** Yes |

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

THE PROPOSED RESPONSE FILED 23 July 2024 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 23 May 2024.

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 4 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 _____ 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 37 CFR 1.116 and 41.33(a)).
4. ☐ 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 and 4
   Claim(s) not subject to reexamination: 2-3 and 5-20

AFFIDAVIT OR OTHER EVIDENCE

7. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____ .
8. ☐ 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).
9. ☐ 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).
10. ☐ 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

11. ☑ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached detailed response .
12. ☐ Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____ .
13. ☐ Other: _____ .

| | | |
|---|---|---|
| | | /LUKE S WASSUM/<br>Primary Examiner, Art Unit 3992 |

cc: Requester (if third party requester)

## *Ex Parte* Reexamination

## Advisory Action

A request for Ex Parte Reexamination of claims 1 and 4 of U.S. Patent Number 10,259,470 ("the '470 patent") was filed on 31 August 2023 ("the Request"). The '470 patent was issued to **Michael Phelan** on 16 April 2019, from application 15/336,110 ("the '110 application"), filed 27 October 2016.

The Office mailed a Decision granting reexamination of claims 1 and 4 on 17 October 2023.

Claims 1 and 4 are subject to reexamination.

## Patent Owner's Response

Patent Owner filed an after-final response ("Response") on 23 July 2024. The response included remarks only.

Claims 1 and 4 remain subject to reexamination.

## Response to Arguments

Patent Owner's response included several arguments. They are addressed in turn below.



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Motivation

Patent Owner argues that a POSITA would not have been motivated to incorporate the wireless user authentication disclosed by **Harter** into the vehicle control system disclosed by **Cherouny**, because **Cherouny** teaches away from the use of wireless communications (Response, pages 8-10).

This argument is not persuasive.

Specifically, Patent Owner argues that **Cherouny** discloses the use of decoy wiring in the wiring harness to defeat user tampering with the vehicle control device, and that such a disclosure teaches away from the use of wireless communication (Response, pages 8-10).

The Office initially notes that the claimed wireless communication is limited to wirelessly authenticating the driver of the vehicle. **Cherouny** discloses that driver authentication is accomplished through the insertion of a key fob into the control device (see ¶¶ [0017]-[0018]). The disclosure of the use of decoy wiring in the wiring harness would have no bearing on a POSITA's motivation to implement driver authentication wirelessly, since the interface being replaced would be the interface between the key fob and the optoelectronic components in the key fob reader necessary for reading the



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unique number of the inserted key fob (¶ [0017]), which would not require a change in the interface between system components via the wiring harness.

Even were the claims to require a wireless interface between system components generally, **Cherouny** makes no assertion of teaching away from such an implementation, and in fact does not discuss wireless communication between the system components at all. Instead, **Cherouny's** system uses the decoy wiring to prevent a user from "hot wiring around [the vehicle control system]." ¶ [0033]. The Office points out that incorporating wireless communication between system components would arguably serve the purpose of defeating potential user tampering even more effectively, by removing the wired connections entirely.

This would serve as motivation for a POSITA to incorporate wireless communication into the vehicle control system disclosed by **Cherouny**.

Limitation 1(b): master control unit

Patent Owner argues that **Cherouny** does not disclose the claimed master control unit, because "[b]ilateral communication is required between a master control unit and a slave control unit", and further because the claimed master control unit "has all the



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necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny" (Response, pages 10-12).

This argument is not persuasive.

Specifically, Patent Owner argues that bilateral communication is required because (1) it is in the claim, because (2) it is stated in the prosecution history, and because (3) a "master" and "slave" relationship requires bidirectional communication.

Regarding (1) the claim language, only the following limitation defines communication between the master and slave control units:

> "a slave control unit…which communicates with said master control unit wherein said slave control unit receives commands from said master control unit"

As can be seen, the only claimed communication between the respective control units is the transmission of commands from the master control unit to the slave control unit. The Office notes that the reception of commands by the slave control unit constitutes the claimed 'communication'. Such communication is taught by **Cherouny** at least through the control lines spanning Figs. 20A and 20B, between microprocessor **101** and engine slow down unit **120**/audible noise generator **121**.



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Regarding (2) statements during prosecution, Patent Owner made the following arguments in a response filed 6 February 2012, in application 12/496,509:

> the master and slave control units claimed work in parallel and thus require bi-directional communication. The Applicant respectfully asserts the reference fails to disclose this type of relationship between modules.

The Office notes that claim 1 fails to include any limitations requiring communication from the slave control unit to the master control unit, nor do they include any limitation calling for their operation in 'parallel'. Instead, the only claimed interaction between the master and slave control units is the limitation that the master control unit transmits commands to the slave control unit to generate an alarm signal.

The Office also notes that in the subsequent final Office action mailed 7 March 2012, the examiner found the arguments not persuasive, and maintained the rejection.

With respect to Patent Owner's third argument, this argument seems to be that bi-directional communication is inherent between a master and slave due to the very nature of the master/slave relationship.

This is not the case, however.

For instance, the IONOS Digital Guide discloses that, with respect to a master/slave model,



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## How does the master/slave model work?

In the master/slave model, communication is one-sided. The master can contact the slave, but it is not possible for the slave to communicate with the master. Therefore, resources are always controlled unidirectionally.

PC Magazine discloses that master-slave means

(1) An electronic interaction in which one device acts as the controller (the master) and initiates the commands, and the other devices (the slaves) respond accordingly. See master-slave communications.

and master-slave communications means

Communications in which one side (the "master") initiates and controls the transmission. The "slave" at the other end of the line responds to commands from the master. In this configuration, polling is widely used to activate the data transfers. See master-slave.

These examples are provided not to show that communication in a master-slave system *must* be only in one direction, but to show that the master-slave model does not inherently *require* bi-directional communication, as is argued by Patent Owner.

Additionally, and as noted above, bi-directional communication is not claimed. It is the Office's position that merely labeling control units as a *master* control unit and a *slave* control unit does not impart the requirement of bi-directional communication between the two.

The Office does acknowledge that in Fig. 6 of the '470 patent, there are two signals illustrated that are from the slave control unit to the master control unit; clean



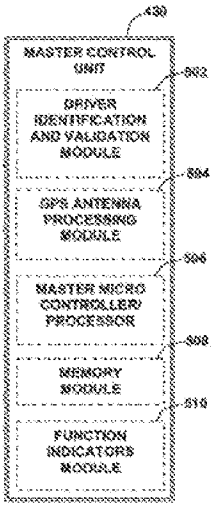
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power **520** and internal definable inputs **514**. However, the '470 patent includes no disclosure as to the nature of these signals, and there is no disclosed nor claimed use of these signals.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Patent Owner's argument that the claimed master control unit is a singular device, vs. **Cherouny's** 'componentized' implementation, the Office does not find this argument persuasive.

For instance, it is noted that the disclosed master control unit is comprised of several components/modules:






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The '470 patent explicitly discloses that each of these 'modules' may by implemented in hardware or software:

> Note that as utilized herein, the term "module" may refer to a physical hardware component and/or to a software module.

Col. 6, lines 11-13.

In addition, it is noted that the claimed functionality of the master control unit is limited to 'authenticating at least one occupant via said driver identification and logging module [a separate component], and associating an operating profile with said at least one occupant'.

The '470 patent discloses, at col. 7, lines 33-45, that driver authentication and data logging module or device **425** provides a unique identification code to the master control unit **430** so that the master control unit can authenticate the driver and associate an operating profile with the driver.

In the same way, **Cherouny** discloses the use of a key fob reader that reads a unique number from the key fob that identifies the driver, and relays that information to microprocessor **101** to authenticate the driver and to associate an operating profile with the driver (see ¶¶ [0017]-[0020] and [0073]).



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The systems in both cases accept driver identification information from an external device and use said information to authenticate the driver and associate the driver with an operating profile.

Limitation 1(c): module for receiving location and speed information

Patent Owner argues that **Cherouny** does not disclose the claimed reception of location and speed information in association with a movement of said vehicle (Response, pages 12-14).

More specifically, Patent Owner argues that **Cherouny** discloses speed information determined from clock cycles associated with wheel rotation, which fails to disclose speed information "in association with a movement of said vehicle…Cherouny never uses vehicle movement to determine speed."

This argument is not persuasive.

The Office initially notes that the limitation at issue is a module that receives location and speed information. Since the claim merely requires a module that receives information, the *source* of said information is not a limiting feature. The module would work identically regardless of the source of said speed and location information.



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Additionally, the Office notes that the claim requires that the speed information is *associated with* a movement of said vehicle, not that the speed information is *determined by* movement of the vehicle (although both are disclosed by **Cherouny**).

**Cherouny** discloses a car monitor **170** that "includes the function of *measuring car speed* **171**" (emphasis added) (¶ [0081]). Indeed, it is disclosed that "[i]t is another object of this invention to provide a programmable electronic device for motor vehicles which also *records the driving speed* over a given period of time" (emphasis added) (¶ [0036]).

The measurement of car speed is accomplished through the use of "automobile speed sensors **108** which *sense the actual speed* of the automobile when in use." (emphasis added) (¶ [0073]). It is well known that the definition of speed is the rate of change of position of an object, measured as the ratio of distance to the time in which the distance was covered. The very concept of speed is inherently associated with a movement, and so **Cherouny's** disclosure of the measure of a vehicle speed is inherently associated with a movement of said vehicle.

It is true that **Cherouny's** mechanism for measuring vehicle speed involves the counting of pulses generated by speed sensors integrated with the antilock brake device or other sensor on the wheel, generating a square wave as the wheel rotates (¶ [0030]). However, the rotation of wheels on a vehicle is also "associated with a movement of the



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vehicle", as claimed, since the movement of the vehicle is reflected by the rotation of the wheels.

To summarize, it is not clear how one could possibly receive/generate/calculate vehicle speed information, where the vehicle speed information is not 'associated with' a movement of the vehicle.

In the same way, vehicle location information is inherently 'associated with' a movement of the vehicle, since any movement of the vehicle would result in a change in the vehicle's location. Thus, **Cherouny's** disclosure of the receipt of vehicle location information from a GPS satellite system (see ¶ [0020]) anticipates the claimed receipt of location information associated with movement of the vehicle.

Limitation 1(d): a data logging device

Patent Owner argues that the rejection of record is improper because it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching two separate claim elements (a data logging device and an identification and data logging module) (Remarks, pages 14-16).

This argument is not persuasive.



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Specifically, Patent Owner argues that the PTAB, in *Hopkins Manufacturing Corporation et al. v. Cequent Performance Products, Inc.* (IPR2015-00613), determined that it would be 'problematic' to rely on one component of a prior art reference as teaching two separate claim components.

As noted in Patent Owner's arguments, the PTAB decision determined that a single prior art *signal* could not be applied to teach two distinctly claimed *signals*. This was based upon an analysis of the claims and specification that concluded that the two claimed signals must be "separate and distinct" from each other (Decision Denying Institution, 7 August 2015, at 7-10).

In this case, however, the claimed elements are a device (i.e., hardware) and a module/device (i.e., hardware or software), as opposed to signals. As discussed in the last Office action, absent some teaching to the contrary, an ordinary artisan would understand that multiple hardware and software modules could be implemented as a single component, and vice versa. Implementation as separate components as opposed to a combined single component does not impart patentability.

In fact, Patent Owner's own specification discloses that the data logging device and the identification and data logging module/device could be embodied in a single component (i.e., a smartphone with GPS capability), at col. 7, lines 33-35 and 46-57:



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> In one embodiment, the driver authentication and data logging module or device **425** can be a smart phone with one or more of WIFI, RFID, Bluetooth, and GPS capabilities.
>
> A data logging device **452** can be used to record vehicle operation data associated with the operation of the vehicle. Included may be a GPS module **451** which can be used to monitor the vehicles speed, location, and acceleration/deceleration data.
>
> In another embodiment, the data logging device **452** and GPS module **451** may be provided as functionalities associated with the driver identification and data logging module when that module is embodied as a mobile device equipped with at least GPS capabilities (i.e. a Smartphone with GPS capability).

Indeed, Patent Owner's own antecedent U.S. Patent 9,045,101, to which the '470 patent claims priority, explicitly discloses a single "driver identification and data logging device", whereby the master control unit receives a unique identification code from the data logging device to authenticate a high-risk driver (see col. 2, lines 28-32), and whereby the driver logging device also records vehicle operation data associated with use of the motor vehicle by said at least one driver, including location and speed information (see claim 11, col. 10, lines 42-45).

In view of these facts, the Office concludes that there is nothing in Patent Owner's claims or disclosure that precludes the use of a single combined component that carries out the functions of both the data logging device and the identification and logging module/device.



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Limitation 1(e): slave control unit

Patent Owner argues that the prior art fails to disclose the claimed slave control unit, because (1) the examiner has read out the phrase "control unit" from "slave control unit", because (2) the slave control unit must include a processor and be programmable, and because (3) the combination of **Cherouny's** engine slow down module 120 and audible generator 121 together do not teach a "unit", as claimed.

These arguments are not persuasive.

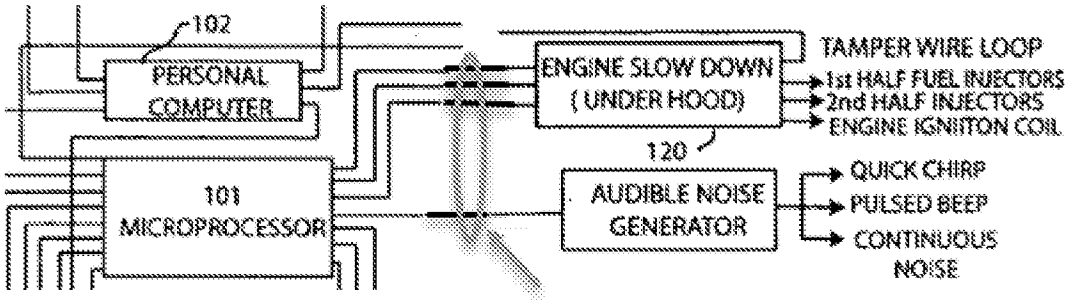
With respect to item (1), it is noted that with respect to the claimed slave *control unit*, the components of **Cherouny** that are mapped to this claim limitation both perform control functions, and as such, the examiner has not 'read out' the term 'control unit' from the claimed slave control unit.

For instance, the engine slow down module **120** controls the operation of the engine's fuel injectors and the engine's ignition coil, in order to ensure that the vehicle is operated within prescribed parameters (see ¶¶ [0025]-[0027], [0029], and [0077]). Similarly, audible noise generator **121** controls the output of various audible signals which alert the driver that the vehicle is being operated outside of the prescribed parameters (see ¶¶ [0021]-[0024], [0031], and [0078]).



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These disclosed components read on the claimed slave control unit, in that they exercise control over operation of the vehicle, and provide the claimed functionality of communication with the master control unit (see illustrated connections between microprocessor **101** [the claimed master control unit] and engine slow down module **120** and audible noise generator **121** [collectively the claimed slave control unit]):




**Cherouny**, Figs 20A & 20B (annotated).

The components also provide the claimed functionality of receiving commands from the master control unit (see connections illustrated above) and generating an alarm signal (see disclosure that the audible noise generator provides various warning noises such as a quick chirp, a pulsed beep, and a continuous noise, ¶¶ [0021]-[0024] and [0078]).

With respect to item (2), the Office again notes that Patent Owner is reading limitations from the specification into the claims. Use of the term 'control unit' does not


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inherently require the presence of a processor, nor does it inherently require programmability.

Patent Owner has cited a number of court and PTAB decisions to support their position. However, the Office notes that claim construction decisions are based upon the specific circumstances of each specific case, including the disclosure and claim language used. Unlike more generic terms, such as "personal computer" or "cellular phone", use of the term "control unit" does not inherently impart a specific structure, nor inherently require a processor or programming. The term "control unit", by itself, merely relates to a unit (i.e., a device or module) that exercises some type of 'control' over some element or component of a system.

In this case, the claimed slave control unit receives commands from the master control unit, in order to carry out the claimed function of 'generate an alarm signal', as well as allowing the master control unit to 'provide operational governance of said vehicle within said operating profile'. This would involve receiving signals from the master control unit, and translating those signals into outputs that perform the claimed control functions.

This 'translation' *could* of course be accomplished through a programmable processor. Alternately, the control units could utilize circuitry (programmable or otherwise) that translates specific inputs (the claimed commands) to specific outputs



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that carry out the claimed control functions. The specific outputs in this case would be one of a number of audio outputs (the claimed 'generate an alarm signal'), or signals to regulate the operation of the vehicle through manipulation of the fuel injectors or starter relay (the claimed 'operational governance').

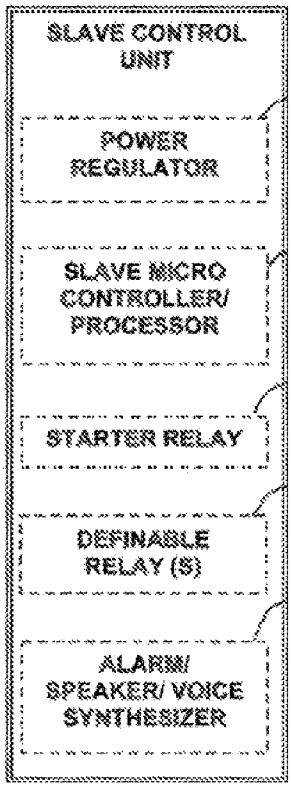
The instant claims fail to limit the slave control unit to a specific implementation, and the Office declines to read limitations for a specific implementation of the slave control unit from the specification into the claims.

Regarding item (3), Patent Owner argues that "the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another."

The Office notes, however, that the '470 patent discloses a slave control unit that is also illustrated as a collection of separate components, having no depiction or disclosure of communication between them:



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**Cherouny's** use of multiple components that collectively make up the claimed slave control unit is analogous to that disclosed in the '470 patent, as illustrated in Fig. 6 above.

Patent Owner concludes by presenting several arguments with respect to features allegedly not taught by engine slow down module **120** and audible noise generator **121** individually. These arguments are not persuasive, and have been addressed above.

Patent Owner also argues that with respect to claim 4, as well as Grounds 2-4, these rejections are also improper based on the previously presented arguments.


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Specifically, with respect to Ground 2, Patent Owner repeats their arguments that **Cherouny** teaches away from the use of wireless communications. This argument has been addressed above.

With respect to Ground 3, Patent Owner argues that the data logging of **Petrik** could not be combined with the vehicle control system of **Cherouny**, because **Cherouny** discloses the storage of speed information in a secure location, hardwired to the vehicle.

This, however, is not the case. **Cherouny** discloses only that data is logged, but does not include details on the mechanism for doing so. **Petrik** is relied upon to disclose one such mechanism for data logging, and for its explicit disclosure of the logging of *location* information.

With respect to Ground 4, Patent Owner makes an analogous argument, that the data logging of **Bouchard** could not be combined with the vehicle control system of **Cherouny**, because **Cherouny** discloses the storage of speed information in a secure location, hardwired to the vehicle.

The Office respectfully disagrees, for the reasons discussed immediately above.

The rejections of record are maintained.



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**Conclusion**

Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving U.S. Patent No. 10,259,470 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Patent Owner is reminded that any proposed amendment to the specification and/or claims in the reexamination proceeding must comply with the provisions of 37 C.F.R. § 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. § 1.52(a) and (b), and must include any fees required by 37 C.F.R. § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper amendments in reexamination proceedings.

Any document filed by Patent Owner must be served on the third party requester (or requesters in a merged proceeding) in the reexamination proceeding in the manner provided by 37 C.F.R. § 1.248. See 37 C.F.R. § 1.550(f) and MPEP § 2266.03.

**All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

| | |
|---|---|
| By Patent Center: | Patent Center (patentcenter.uspto.gov) has 100% of the functionality of EFS-Web, Public and Private PAIR, and is available to all users for electronic filing and management of patent applications. For more information, please visit the Patent Center information page at uspto.gov/patents/apply/patent-center. |
| By Mail to: | Mail Stop *Ex Parte* Reexam<br>Central Reexamination Unit<br>Commissioner for Patents<br>United States Patent & Trademark Office<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| By hand: | Customer Service Window<br>Knox Building<br>501 Dulany Street<br>Alexandria, VA 22314 |

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

/LUKE S WASSUM/
Primary Examiner, Art Unit 3992

Conferees:

/ANGELA M LIE/
Primary Examiner, Art Unit 3992

/Michael Fuelling/
Supervisory Patent Examiner, AU 3992

lsw
8 August 2024

| *Notice of References Cited* | Application/Control No. 90/015,287 | Applicant(s)/Patent Under Reexamination 10259470 | |
|---|---|---|---|
| | Examiner Luke S Wassum | Art Unit 3992 | Page of |

**U.S. PATENT DOCUMENTS**

| * | | Document Number Country Code-Number-Kind Code | Date YYYY-MM-DD | Name | CPC Classification | US Classification |
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**FOREIGN PATENT DOCUMENTS**

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**NON-PATENT DOCUMENTS**

| * | | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
| | U | Definition of master-slave, PC Magazine, https://www.pcmag.com/encyclopedia/term/master-slave, downloaded 1 August 2024. ( Year: 2024) |
| | V | Definition of master-slave communications, PC Magazine, https://www.pcmag.com/encyclopedia/term/master-slave-communications, downloaded 1 August 2024. (Year: 2024) |
| | W | "What is the master/slave model?", IONOS Digital Guide, https://www.ionos.com/digitalguide/server/know-how/master/slave-model/, 22 June 2023. (Year: 2023) |
| | X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in YYYY-MM-DD format are publication dates. Classifications may be US or foreign.

| Reexamination | Application/Control No. | Applicant(s)/Patent Under Reexamination |
|---|---|---|
| | 90/015,287 | 10259470 |
| | Certificate Date | Certificate Number |

| Requester Correspondence Address: ☐ Patent Owner ☑ Third Party |
|---|
| UNIFIED PATENTS<br>4445 WILLARD AVENUE<br>SUITE 600<br>CHEVY CHASE, MD 20815 |

| LITIGATION REVIEW ☑ | lsw (examiner initials) | 03 May 2024 (date) |
|---|---|---|
| Case Name | | Director Initials |
| The Phelan Group LLC v. Kia Corporation et al. 2:23cv94 (closed) | | |
| Phelan Group LLC v. Toyota Motor Corporation et al. 2:23cv93 (closed) | | |

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| TYPE OF PROCEEDING | NUMBER |
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OK for entry.

8 August 2024

/lsw/



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|---|---|
| Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Fax: (571) 273-9900

Dear Sir/Madam:

**RESPONSE TO MAY 23, 2024 FINAL OFFICE ACTION**

Responsive to the Final Office Action dated May 23, 2024, the Patent Owner presents the following in complete response pursuant to 37 C.F.R. § 1.550. Attached to this Response are the following:

**Amendments to the Claims** are unnecessary given the remarks. No claim amendments are made herein as discussed on page 2 of this paper.

**Remarks** begin on page 3 of this paper.



PAGE 2/32 * RCVD AT 7/23/2024 6:07:57 PM [Eastern Daylight Time] * SVR:W-PTOFAX-DTS-E1/19 * DNIS:2739900 * CSID:15127276691 * ANI:3055037548 * DURATION (mm-ss):18-56

## CLAIM AMENDMENTS

Based on the remarks below, no claim amendments are necessary to put this application in condition for allowance and issuance of a reexamination certificate for United States Patent No. 10,259,470 ("'470 Patent").





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## REMARKS

Applicant submits that challenged claims 1 and 4 of the '470 Patent along with all unchallenged claims of the '470 Patent are allowable.

## STATUS OF THE CLAIMS

Claims 1 and 4 of the '470 Patent were rejected in the May 23, 2024 Final Office Action. Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

## BACKGROUND OF THE '470 PATENT

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." '470 Patent at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile



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that matches requirements of the high-risk driver." '470 Patent at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

'470 Patent at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are ***control units***, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. Moreover, both are ***units***, not combinations of devices created with the claims in mind to meet the control units' limitations.

A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:



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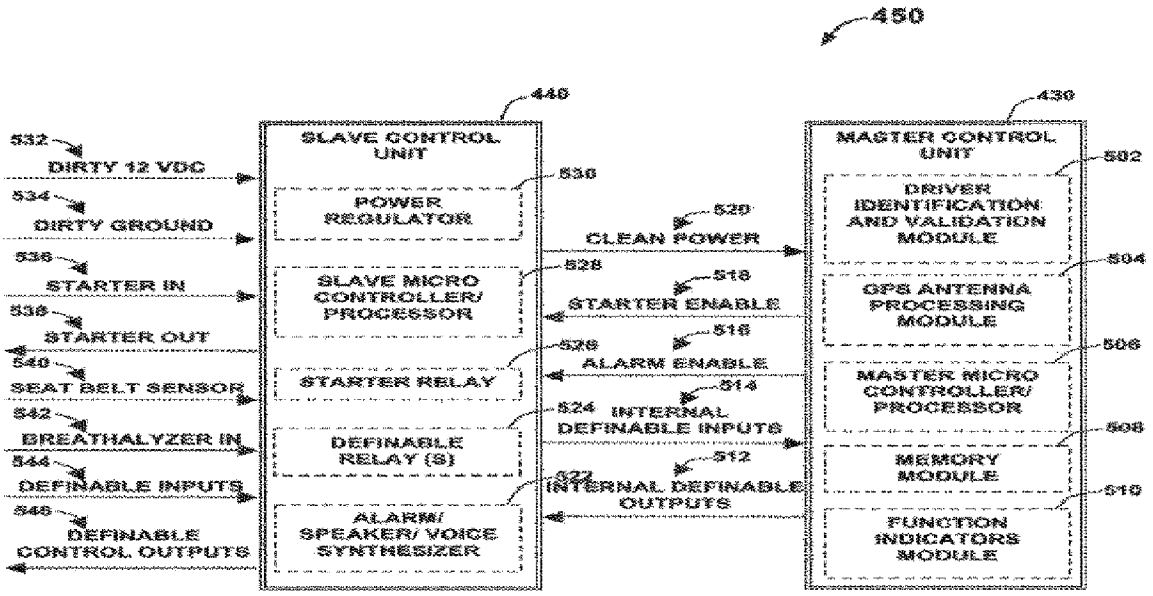
> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.
>
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.

As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.




'470 Patent at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." '470 Patent at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices***





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> ***in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

## CLAIM CONSTRUCTION

The Examiner observes that the Patent Owner did not act as his own lexicographer, and that no claim terms are subject to 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. §112, sixth paragraph. May 23, 2024 Final Office Action at 5-6. Consequently, the Examiner did not construe any claim term in the subject claims. Patent Owner respectfully disagrees with that approach. However, acting as a lexicographer is not the only instance in which claim construction is critically important to a validity analysis.

The law is well settled that claim construction is required to ascertain validity under 35 U.S.C. §102 and §103 and infringement, regardless of whether or not the broadest reasonable interpretation standard is applicable, as it is here. *In re Yamamoto*. 740 F.2d 1569, 1571 (Fed. Cir. 1984).



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First, under any reasonable interpretation, the master control unit and the slave control unit must have a master and slave relationship as specified in the claims—those words are part of the subject claim terms, and have a technical meaning to a person of ordinary skill in the art. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1. That is borne out in the specification, and consistent with it, the claims and the figures. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1.

Secondly, the master control unit and slave control unit must in fact be control units. Here again, those terms are set forth verbatim in the claim language, and have a meaning to a person of ordinary skill in the art. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1. Controlling case law also mandates that conclusion, as explained below. These control units must control the claimed features.

## CLAIM REJECTIONS

### Ground 1 Under 35 U.S.C. § 103 (Cherouny in View of Harter)

The combination of Cherouny and Harter is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence





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presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).

The Examiner correctly notes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 18. On the contrary, Cherouny teaches secure wired communication with dummy wires to prevent tampering.

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is





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> broken for even a moment the event is recorded and documented.

Cherouny at ¶33. Therefore, it would not have been "obvious to try" modifying Cherouny with Harter's disclosure of a wireless device because that is taught against by Cherouny itself.

Limitation 1(b)

Cherouny does not disclose a "master control unit" as properly construed. Examiner alleges that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).

May 23, 2024 Final Office Action at 16-17.

The Examiner argues that "there does not appear to be an allegation that Cherouny does not disclose the claimed master control unit, only that it is implemented differently." May 23, 2024 Final Office Action at 9. That assertion is incorrect. Bilateral communication is required between a master control unit and a slave control unit. That is claimed and stated clearly in the prosecution history.



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Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 ('415 Patent Prosecution History-related patent to the '470 Patent) (emphasis added).

The '470 Patent's master control unit is designed to identify a driver profile in which the vehicle operates and for controlling various vehicle system components and has all the necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny. For example, the master control unit 430 of the '470 Patent includes a driver identification and validation module 502, a GPS antenna processing module 504, a master micro controller/processor 506, a memory module 508 and a function indicators module 510. '470 Patent at FIG. 6.

The communications interfaces of the master control unit 430 depicted in the specification include outputs such as starter enable 518, alarm enable 516, and internal definable outputs 512. The inputs include clean power 520 and other internal definable inputs 514. '470 Patent at 10:48-11:52; FIG. 6.

The master control unit is to be understood in a specific systemic context, namely its relationship to the "slave control unit" claimed in claim 1 and discussed in "Limitation 1(e)" below. The master control unit and slave control unit "communicate," as set forth in claim 1. *See also* IEEE 100 Authoritative Dictionary, "master": "a device that initiates communications requests to gather data or perform



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controls." As stated in prosecution, "the master and slave control units claimed work in parallel and ***thus require bidirectional communication***." Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 ('415 Patent Prosecution History) (emphasis added).

Cherouny, in contrast, discloses a microprocessor that performs calculations and processes data based on inputs. These inputs include inputs from an automobile speed sensor 108, a key fob reader 109, and power conditioning 110. Cherouny at [0073], FIG. 20A. The microprocessor in turn provides simple instructions to peripheral components to execute functions such an audible noise generator 121, which Examiner identifies as a "slave control unit." *Cf.* Cherouny at [0077], [0078], FIG. 20A.

As set forth in more detail in connection with Section 1(e) ("slave control unit"), a control unit is a term of skill in the art. Likewise, a "master" and "slave" relationship is well understood, and the intrinsic record is clear that bidirectional communication is required. These terms are understood in the context of the specification, which supports a construction of "master control unit" that requires bidirectional communication. There is no communication received from the noise generator in Cherouny.

Limitation 1(c)





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Cherouny does not disclose receiving location and speed information "***in association with a movement of a vehicle***."

Examiner asserts that Cherouny discloses:

> c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor 108, [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1).

May 23, 2024 Final Office Action at 17.

Examiner alleges that "[t]he limitation also merely recites the receipt of speed information and location information" and "[t]here is no limitation regarding the mechanism for deriving said information." May 23, 2024 Final Office Action at 11. Patent Owner disagrees. This limitation of the '470 Patent requires that speed and location information are received "***in association with a movement of said vehicle***." Patent Owner respectfully notes that Examiner has not addressed this portion of the limitation. Cherouny discloses that speed information is determined ***not*** from "movement of said vehicle," but rather clock cycles associated with wheel sensors. Cherouny never uses vehicle movement to determine speed. On the contrary, Cherouny states:



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> ***The instant device counts clock cycles between rising edges as well as any other part***, such as the falling edges or even voltage levels, of the square wave coming from an additional wheel sensor similar to the antilock ABS sensors on one of the wheels. This digital computer ***version of speed detection is unique when used with the other features of the device.***

Cherouny at [0011], [0015] (emphasis added).

Hence, Cherouny's methodology for estimating speed—clock cycles and wheel rotation—does not teach or suggest this claim limitation. Cherouny's sole mention of GPS is so that the system can be made aware of school zones. Cherouny at [0010], [0020]. Cherouny never teaches or suggests using GPS to determine speed and location based on vehicle movement.

Limitation 1(d)

Cherouny does not disclose a separate "data logging device" and "identification and data logging module."

Examiner asserts:

> d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], [0080]-[0081]).





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May 23, 2024 Final Office Action at 17.

Examiner argues that "[c]laiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as Cherouny's disclosed car monitor 170) does not impart patentability when all of the claimed functionality is carried out be the disclosed combined hardware/software component." May 23, 2024 Final Office Action at 12. However, Examiner fails to address the United States Patent and Trademark Office and Federal Circuit decisions related to this issue discussed in Patent Owner's April 15, 2024 Response to the Non-Final Office Action and included again below for Examiner's convenience.

In particular, the PTAB has determined that it would be "problematic" to rely on one component of a prior art reference as teaching two separate components of a claim. In *Hopkins*, the PTAB held that the prior art disclosure of an accelerometer with an output signal could not be applied as teaching both a "deceleration signal" and an "inclination signal" as claimed. H*opkins Manufacturing Corp. v. Cequent Performance Products, Inc.* (IPR 2015-00613, Paper 9, August 7, 2015).

As previously argued but unaddressed, according to *Becton*, "[w]here a claim lists elements separately, 'the clear implication of the claim language is that those





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elements are distinct component[s]' of the [claimed] invention." *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010). Where a claim provides for two separate elements (*e.g.*, a "second portion" and a "return portion"), these two elements "logically cannot be one and the same." *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996).

Therefore, it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching the two separate claim elements (a data logging device and an identification and data logging module) of claim 1 of the '470 Patent, without at a minimum identifying how they are distinctly present.

Limitation 1(e)

Cherouny does not disclose a "slave control unit" when that phrase is properly construed under any standard. A slave control unit is by definition ***a control unit*** that a POSITA would understand has certain characteristics. The Examiner has read this term out of the patent claim altogether, which is contrary to governing caselaw of the PTAB applying the BRI standard for this term.

Examiner alleges that Cherouny discloses:

> e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module 120 and audible





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> noise generator 121, [0077]-[0078] and Figs. 20A &20B; see also disclosure that functions of the driver monitor include engine slowdown 181 and audible noise alarms 182, [0082] and Figs. 21A &21B; see also disclosure of the possible audio alarms, [0021]-[0024] and [0031]).

May 23, 2024 Final Office Action at 17-18.

The Examiner also makes the following claim:

> The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and nothing in the claims with respect to communication from the slave control unit to the master control unit.

May 23, 2024 Final Office Action at 13. This is incorrect and contrary to established law.

A slave control unit is a type of control unit. That should be apparent based on the plain and ordinary meaning of the claims and the intrinsic record. The Examiner reading out the phrase "control unit" from "slave control unit" constitutes plain error. Patent claims should be construed to avoid rendering claim terms superfluous. *Digital-Vending Services International, LLC v. University of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). For example, when a claim refers to "steel baffles," this "strongly implies that the term 'baffles' does not inherently mean





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objects made of steel." *Phillips v. AWG Corp*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). That truism applies under any claim construction standard.

A control unit incorporates a controller. These take the form of a processor or microcontroller. *IControl Networks, Inc. v. Zonoff Inc.*, No. CV 14-1199-GMS, 2016 WL 1437892, at *1 (D. Del. Apr. 11, 2016) (construing "control unit" to require a programmable processor); *Glaston Corp. v. Salem Fabrication Techs. Grp.*, No. 1:21-CV-942, 2024 WL 1673273, at *17 (M.D.N.C. Apr. 18, 2024) (successfully arguing that "control units or controllers" are well-recognized structural units in patent law that a POSA would understand); *Capella Photonics, Inc. v. Fujitsu Network Commc'ns, Inc.*, No. 2:20-CV-00076-JRG, 2021 WL 465430, at *22 (E.D. Tex. Feb. 9, 2021) (a "control unit" refers to known structure, "namely a controller" such as a computer processor).

For this reason, and ***applying the BRI standard***, the PTAB has held that a controller ***must*** include ***a processor*** and ***be programmable***.

> The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[ ]." 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description

> contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

*One World Techs., Inc. v. Chamberlain Grp., Inc.*, No. IPR2017-00073, 2018 WL 1960893, at *3–4 (P.T.A.B. Apr. 24, 2018).

The PTAB further observed that "broadest reasonable interpretation ... is an interpretation that corresponds with what and how the inventor describes his invention in the specification."

> Our interpretation "'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.' A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster." *Microsoft Corp. v. Proxyconn*, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citations omitted), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).
> In the Decision on Institution, based on the parties' arguments, see Pet. 13–32; Paper 6, 5–16, and record at the time, we preliminarily interpreted the following limitations of claim 1:
> ***"controller": a microprocessor, processor, or other programmable logic*** that controls the operation of the barrier movement operator.

*Id.*

In view of the proper construction of "slave control unit," the Examiner's identification of a soundmaker as a "slave control unit" is in error. Properly construed, it is not a slave control unit. It has no processor and is not programmable.





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While Phelan pointed out that these terms required construction, neither the request nor the Examiner provide a construction of the terms "master control unit" or "slave control unit." A POSITA would, in view of the teachings of the specification and claims, understand a "slave control unit" in the context of its required communication with a "master control unit." Both contain processors and are programmable, as set forth in the intrinsic record and discussed below.

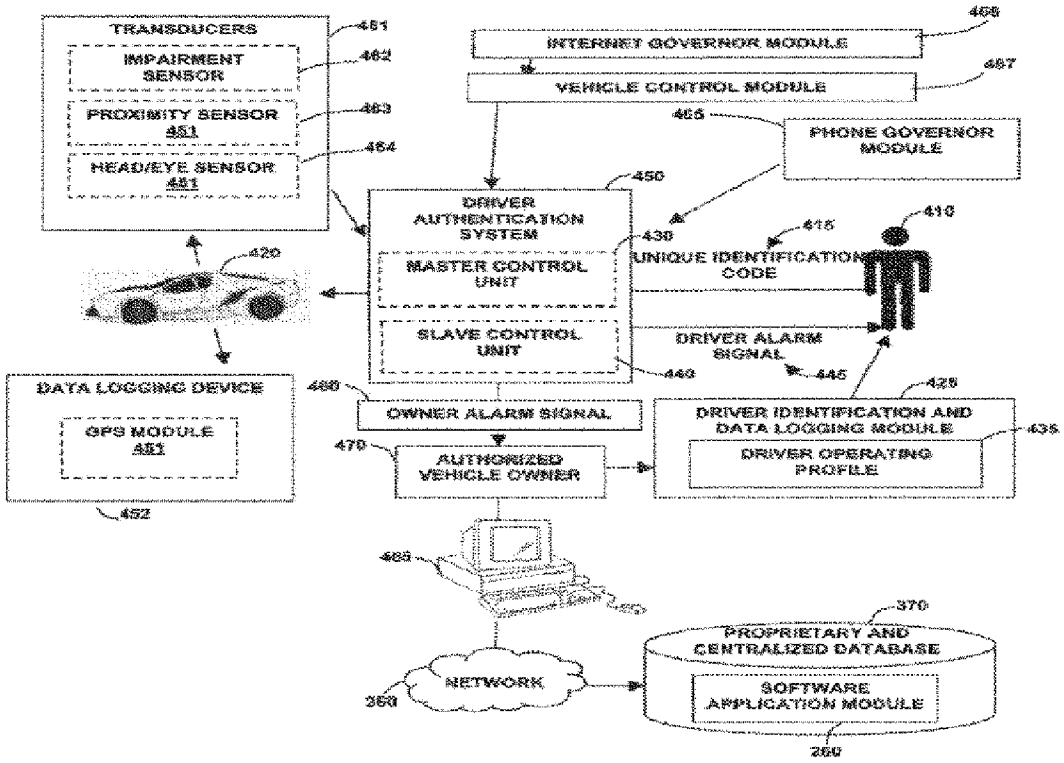



FIG. 5





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The "slave control unit" 440 itself has a microprocessor and can be programmed.

> The system 450 generally includes a master control unit 430 and a slave control unit 440 that can be accessed and programmed via the software application module 260 stored in the proprietary and centralized database 370.

'470 Patent at 6:8-12; *accord* 8:9-24. The slave control unit processes inputs from sensors:

> The slave control unit **440** can process the data collected from the sensors and determine if the data indicates a condition that requires a warning. For example, the sensors may indicate that the vehicle is speeding, veering off the road, approaching an obstruction in the road, too close to another vehicle, that the vehicle driver is distracted, sleepy, or not paying attention, that the vehicle driver is impaired etc. If one of these conditions is identified, the slave control unit **440** signals the master control unit **430** and the master control unit issues a driver alarm signal **445** as described above. In the case where the impairment sensor **462** provides a signal to the slave control unit **440** indicating that the driver's impairment is above a prescribed limit, the slave control unit can prevent the vehicle from starting.

'470 Patent at 8:43-56; 10:48-61.

The Examiner contends that the microprocessor 101 is the "master control unit" and appears to argue that engine slow down module 120 and audible noise generator 121 together form the "slave control unit." Rather than being a "unit," as

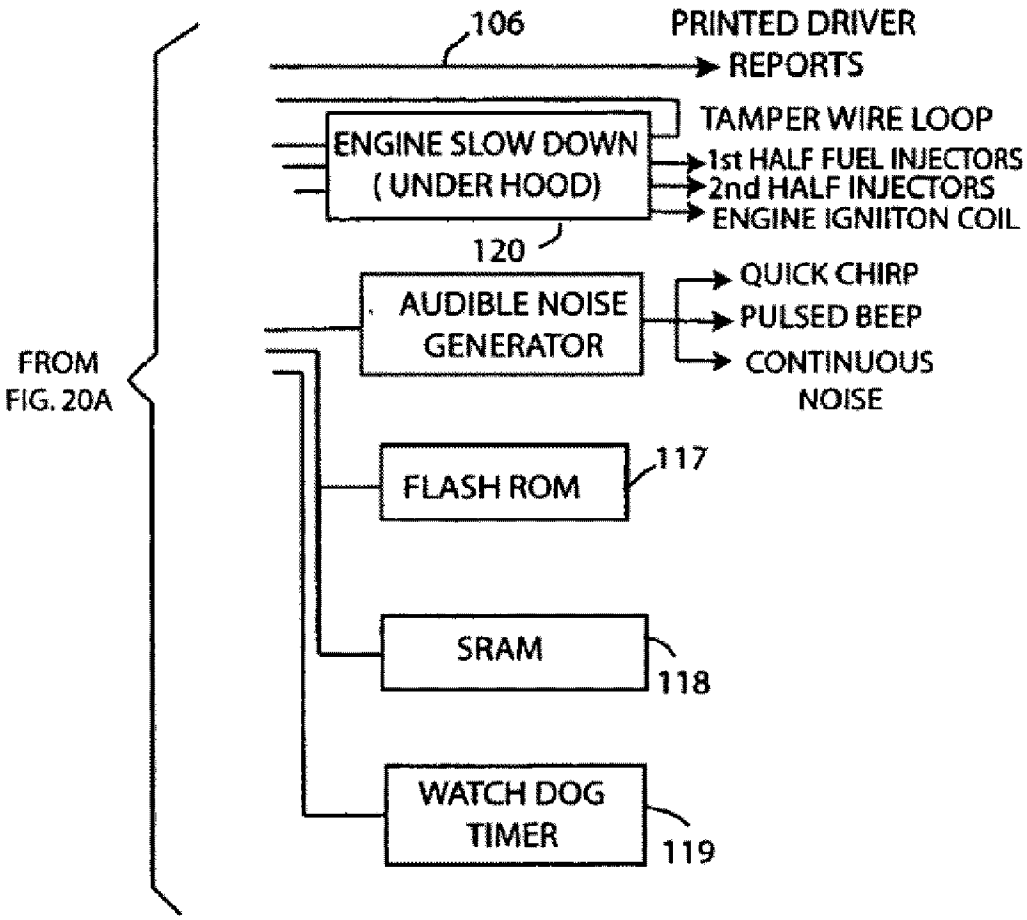


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claimed, the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another.

FIG. 20B








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Cherouny at Fig. 20B. There is no teaching of any programmability of audible noise generator, no communication of any kind to the engine slow down, and no function other than making a noise based on an input signal. Cherouny at [0078].

The Examiner does not appear to contend that engine slow down module 120 generates an alarm signal as required by the claim language. The only disclosure remaining is audible noise generator 121, which as indicated by the name, is a simple noise generator:

> **[0078]** An audible noise generator **121** is also connected to the microprocessor for provision of various warning noises such as a quick chirp, a pulsed beep and a continuous noise. These provide warnings of increasing severity to the driver of the vehicle.

Cherouny at 6 [0078]. This does not meet the requirements of the slave control unit when it is properly construed as discussed *supra*.

Claim 4

Claim 4 is allowable for the same reasons previously discussed. Because it is a dependent claim, and thereby incorporates all of the limitations of independent claim 1 from which it depends, the disclosure lacking in Cherouny related to the independent claim limitations discussed herein prevent the combination of Cherouny and Harter from rendering dependent claim 4 obvious.

**Ground 2 Under 35 U.S.C. § 103 (Cherouny in View of Shuman)**

Ground 2 is predicated on a combination of Cherouny and Shuman. As a preliminary matter, the combination of these references is improper. The Examiner concedes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 27. Indeed, Examiner cites neither Cherouny nor Shuman as disclosing a wireless communication system. The Examiner asserts without evidence, however, that a skilled artisan would have been generally motivated to modify Chorouny with Shuman to fabricate a wireless communication system in the manner claimed. May 23, 2024 Final Office Action at 27.

That is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).





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More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.

Cherouny at ¶33.

Similarly, the profile information is kept inaccessible to the driver and is hardwired in a specific manner.

> The instant device utilizes input selector codes. The data is not coded going through the infrared link. It is literal data describing the numerous profiles of all the drivers under all the different driving conditions. The profile is set up in the instant device and inaccessible to the driver.

Cherouny at ¶30.



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In short, there is no evidence in the record that an artisan would have been motivated to combine Cherouny and Shuman in the manner claimed, particularly when Cherouny teaches against such an implementation.

The arguments in Ground 1 also apply to this rejection.

**Ground 3 Under 35 U.S.C. § 103 (Cherouny in View of Petrik)**

Ground 3 is based on Cherouny in view of Petrik. Here again, Examiner cites neither Cherouny nor Petrik as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 33. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Petrik in the manner claimed, particularly when Cherouny teaches against wireless communication.

The Examiner also acknowledges that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.

Petrik teaches an individual driver logbook for each driver in the form of a smart card. "Drivers are issued with their logbook smart cards with their fingerprint template recorded in the card." Petrik at ¶22. "At the start of the journey the driver inserts his smart card into the unit's smart card reader/writer and places his finger





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on the fingerprint reader to confirm his identity. This automatically logs him in as the current driver and enables engine ignition." *Id.* At ¶23. The unique smart card approach of Petrik could not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33. It is inappropriate to use the template provided by the inventor to render the inventor's contribution obvious. *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor")).

The arguments in Ground 1 also apply to this rejection.

**Ground 4 Under 35 U.S.C. § 103 (Cherouny in View of Bouchard)**

Ground 4 is based on Cherouny in view of Bouchard. Here again, Examiner cites neither Cherouny nor Bouchard as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 39. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Bouchard in the manner claimed, particularly when Cherouny teaches against wireless communication.





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The Examiner also acknowledges that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.

Here again, a review of Bouchard demonstrates that the two approaches of Cherouny and Bouchard are fundamentally inconsistent, and an artisan would not be motivated to combine one with the other. Bouchard is a vehicular *radar* system. Directly contrary to Cherouny, it also teaches a removable storage device.

> A removable, externally readable, non-volatile solid-state memory event recording apparatus (ERA)5 is coupled to the system processor 107. The ERA records the output of each of the sensors and information about targets detected by the radar system.

Bouchard, 8:43-48. The removable memory approach of Bourchard could likewise not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33.

The arguments in Ground 1 also apply to this rejection.

## CONCLUSION

In light of the foregoing remarks, the Patent Owner respectfully requests the Office to withdraw the pending rejection to claims 1 and 4 of the '470 Patent. If any outstanding issues remain, the undersigned would welcome an Applicant interview with the Office to expedite the resolution of this application.





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Date: July 23, 2024

Respectfully submitted,

/s/ *Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, TX 78731
Telephone: (512) 539-2625
Facsimile: (512) 539-2627



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# FAX COVER SHEET

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| TO | Mail Stop "Ex Parte Reexam" Central Reexamination Unit |
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| FAX NUMBER | 15712739900 |
| FROM | Adam Price |
| DATE | 2024-07-23 22:07:07 GMT |
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COVER MESSAGE

Attachedplease find Patent Owner's Response to May 23, 2024 Final Office Action including the certificate of transmission.



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Fax: (571) 273-9900

Dear Sir/Madam:

**RESPONSE TO MAY 23, 2024 FINAL OFFICE ACTION**

Responsive to the Final Office Action dated May 23, 2024, the Patent Owner presents the following in complete response pursuant to 37 C.F.R. § 1.550. Attached to this Response are the following:

**Amendments to the Claims** are unnecessary given the remarks. No claim amendments are made herein as discussed on page 2 of this paper.

**Remarks** begin on page 3 of this paper.



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## CLAIM AMENDMENTS

Based on the remarks below, no claim amendments are necessary to put this application in condition for allowance and issuance of a reexamination certificate for United States Patent No. 10,259,470 ("'470 Patent").



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## REMARKS

Applicant submits that challenged claims 1 and 4 of the '470 Patent along with all unchallenged claims of the '470 Patent are allowable.

## STATUS OF THE CLAIMS

Claims 1 and 4 of the '470 Patent were rejected in the May 23, 2024 Final Office Action. Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

## BACKGROUND OF THE '470 PATENT

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." '470 Patent at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile



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that matches requirements of the high-risk driver." '470 Patent at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

'470 Patent at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are ***control units***, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. Moreover, both are ***units***, not combinations of devices created with the claims in mind to meet the control units' limitations.

A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:



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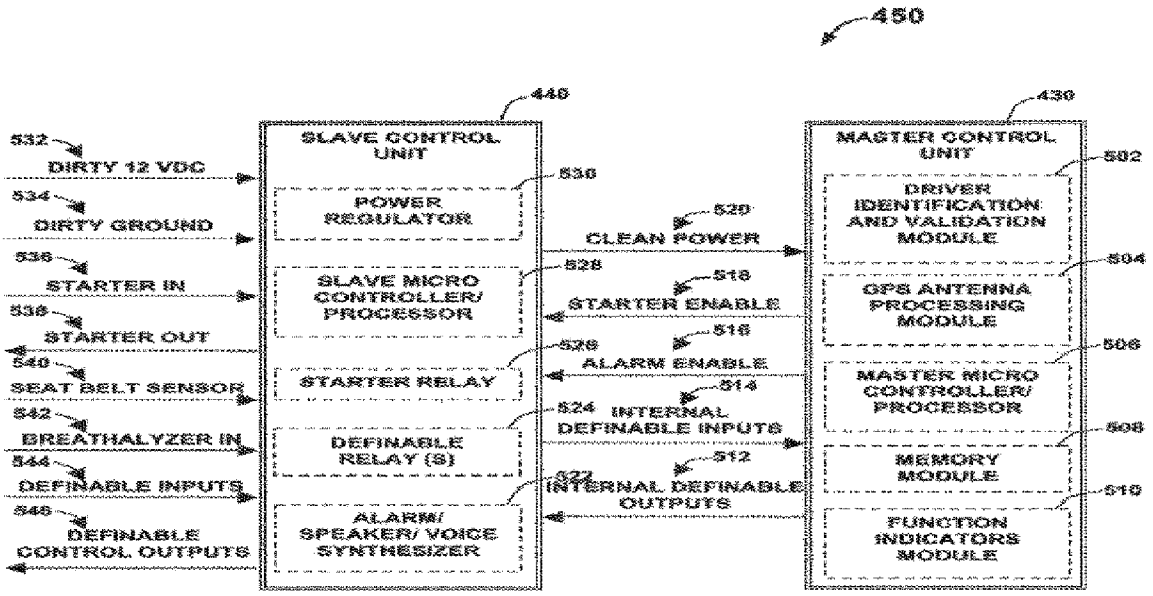
> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.
>
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.

As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.




'470 Patent at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." '470 Patent at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices***





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> ***in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

## CLAIM CONSTRUCTION

The Examiner observes that the Patent Owner did not act as his own lexicographer, and that no claim terms are subject to 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. §112, sixth paragraph. May 23, 2024 Final Office Action at 5-6. Consequently, the Examiner did not construe any claim term in the subject claims. Patent Owner respectfully disagrees with that approach. However, acting as a lexicographer is not the only instance in which claim construction is critically important to a validity analysis.

The law is well settled that claim construction is required to ascertain validity under 35 U.S.C. §102 and §103 and infringement, regardless of whether or not the broadest reasonable interpretation standard is applicable, as it is here. *In re Yamamoto*. 740 F.2d 1569, 1571 (Fed. Cir. 1984).



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First, under any reasonable interpretation, the master control unit and the slave control unit must have a master and slave relationship as specified in the claims—those words are part of the subject claim terms, and have a technical meaning to a person of ordinary skill in the art. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1. That is borne out in the specification, and consistent with it, the claims and the figures. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1.

Secondly, the master control unit and slave control unit must in fact be control units. Here again, those terms are set forth verbatim in the claim language, and have a meaning to a person of ordinary skill in the art. '470 Patent at 2:41-53; 6:8-13; 10:48-61; FIG. 6; Claim 1. Controlling case law also mandates that conclusion, as explained below. These control units must control the claimed features.

## CLAIM REJECTIONS

### Ground 1 Under 35 U.S.C. § 103 (Cherouny in View of Harter)

The combination of Cherouny and Harter is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence





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presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).

The Examiner correctly notes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 18. On the contrary, Cherouny teaches secure wired communication with dummy wires to prevent tampering.

More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is





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> broken for even a moment the event is recorded and documented.

Cherouny at ¶33. Therefore, it would not have been "obvious to try" modifying Cherouny with Harter's disclosure of a wireless device because that is taught against by Cherouny itself.

Limitation 1(b)

Cherouny does not disclose a "master control unit" as properly construed. Examiner alleges that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).

May 23, 2024 Final Office Action at 16-17.

The Examiner argues that "there does not appear to be an allegation that Cherouny does not disclose the claimed master control unit, only that it is implemented differently." May 23, 2024 Final Office Action at 9. That assertion is incorrect. Bilateral communication is required between a master control unit and a slave control unit. That is claimed and stated clearly in the prosecution history.



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Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 ('415 Patent Prosecution History-related patent to the '470 Patent) (emphasis added).

The '470 Patent's master control unit is designed to identify a driver profile in which the vehicle operates and for controlling various vehicle system components and has all the necessary features on-board a singular device versus the highly "componentized" approach taught by Cherouny. For example, the master control unit 430 of the '470 Patent includes a driver identification and validation module 502, a GPS antenna processing module 504, a master micro controller/processor 506, a memory module 508 and a function indicators module 510. '470 Patent at FIG. 6.

The communications interfaces of the master control unit 430 depicted in the specification include outputs such as starter enable 518, alarm enable 516, and internal definable outputs 512. The inputs include clean power 520 and other internal definable inputs 514. '470 Patent at 10:48-11:52; FIG. 6.

The master control unit is to be understood in a specific systemic context, namely its relationship to the "slave control unit" claimed in claim 1 and discussed in "Limitation 1(e)" below. The master control unit and slave control unit "communicate," as set forth in claim 1. *See also* IEEE 100 Authoritative Dictionary, "master": "a device that initiates communications requests to gather data or perform



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controls." As stated in prosecution, "the master and slave control units claimed work in parallel and ***thus require bidirectional communication***." Amendment, Reply and Request for Reconsideration dated February 6, 2012 at 10 ('415 Patent Prosecution History) (emphasis added).

Cherouny, in contrast, discloses a microprocessor that performs calculations and processes data based on inputs. These inputs include inputs from an automobile speed sensor 108, a key fob reader 109, and power conditioning 110. Cherouny at [0073], FIG. 20A. The microprocessor in turn provides simple instructions to peripheral components to execute functions such an audible noise generator 121, which Examiner identifies as a "slave control unit." *Cf.* Cherouny at [0077], [0078], FIG. 20A.

As set forth in more detail in connection with Section 1(e) ("slave control unit"), a control unit is a term of skill in the art. Likewise, a "master" and "slave" relationship is well understood, and the intrinsic record is clear that bidirectional communication is required. These terms are understood in the context of the specification, which supports a construction of "master control unit" that requires bidirectional communication. There is no communication received from the noise generator in Cherouny.

Limitation 1(c)





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Cherouny does not disclose receiving location and speed information "***in association with a movement of a vehicle***."

Examiner asserts that Cherouny discloses:

> c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor 108, [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1).

May 23, 2024 Final Office Action at 17.

Examiner alleges that "[t]he limitation also merely recites the receipt of speed information and location information" and "[t]here is no limitation regarding the mechanism for deriving said information." May 23, 2024 Final Office Action at 11. Patent Owner disagrees. This limitation of the '470 Patent requires that speed and location information are received "***in association with a movement of said vehicle***." Patent Owner respectfully notes that Examiner has not addressed this portion of the limitation. Cherouny discloses that speed information is determined ***not*** from "movement of said vehicle," but rather clock cycles associated with wheel sensors. Cherouny never uses vehicle movement to determine speed. On the contrary, Cherouny states:



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> ***The instant device counts clock cycles between rising edges as well as any other part***, such as the falling edges or even voltage levels, of the square wave coming from an additional wheel sensor similar to the antilock ABS sensors on one of the wheels. This digital computer ***version of speed detection is unique when used with the other features of the device.***

Cherouny at [0011], [0015] (emphasis added).

Hence, Cherouny's methodology for estimating speed—clock cycles and wheel rotation—does not teach or suggest this claim limitation. Cherouny's sole mention of GPS is so that the system can be made aware of school zones. Cherouny at [0010], [0020]. Cherouny never teaches or suggests using GPS to determine speed and location based on vehicle movement.

Limitation 1(d)

Cherouny does not disclose a separate "data logging device" and "identification and data logging module."

Examiner asserts:

> d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], [0080]-[0081]).





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May 23, 2024 Final Office Action at 17.

Examiner argues that "[c]laiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as Cherouny's disclosed car monitor 170) does not impart patentability when all of the claimed functionality is carried out be the disclosed combined hardware/software component." May 23, 2024 Final Office Action at 12. However, Examiner fails to address the United States Patent and Trademark Office and Federal Circuit decisions related to this issue discussed in Patent Owner's April 15, 2024 Response to the Non-Final Office Action and included again below for Examiner's convenience.

In particular, the PTAB has determined that it would be "problematic" to rely on one component of a prior art reference as teaching two separate components of a claim. In *Hopkins*, the PTAB held that the prior art disclosure of an accelerometer with an output signal could not be applied as teaching both a "deceleration signal" and an "inclination signal" as claimed. H*opkins Manufacturing Corp. v. Cequent Performance Products, Inc.* (IPR 2015-00613, Paper 9, August 7, 2015).

As previously argued but unaddressed, according to *Becton*, "[w]here a claim lists elements separately, 'the clear implication of the claim language is that those





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elements are distinct component[s]' of the [claimed] invention." *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010). Where a claim provides for two separate elements (*e.g.*, a "second portion" and a "return portion"), these two elements "logically cannot be one and the same." *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1298 (Fed. Cir. 1996).

Therefore, it is improper to rely on the same structure (car monitor 170) of a prior art reference as teaching the two separate claim elements (a data logging device and an identification and data logging module) of claim 1 of the '470 Patent, without at a minimum identifying how they are distinctly present.

Limitation 1(e)

Cherouny does not disclose a "slave control unit" when that phrase is properly construed under any standard. A slave control unit is by definition ***a control unit*** that a POSITA would understand has certain characteristics. The Examiner has read this term out of the patent claim altogether, which is contrary to governing caselaw of the PTAB applying the BRI standard for this term.

Examiner alleges that Cherouny discloses:

> e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module 120 and audible





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> noise generator 121, [0077]-[0078] and Figs. 20A &20B; see also disclosure that functions of the driver monitor include engine slowdown 181 and audible noise alarms 182, [0082] and Figs. 21A &21B; see also disclosure of the possible audio alarms, [0021]-[0024] and [0031]).

May 23, 2024 Final Office Action at 17-18.

The Examiner also makes the following claim:

> The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and nothing in the claims with respect to communication from the slave control unit to the master control unit.

May 23, 2024 Final Office Action at 13. This is incorrect and contrary to established law.

A slave control unit is a type of control unit. That should be apparent based on the plain and ordinary meaning of the claims and the intrinsic record. The Examiner reading out the phrase "control unit" from "slave control unit" constitutes plain error. Patent claims should be construed to avoid rendering claim terms superfluous. *Digital-Vending Services International, LLC v. University of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012). For example, when a claim refers to "steel baffles," this "strongly implies that the term 'baffles' does not inherently mean





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objects made of steel." *Phillips v. AWG Corp*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). That truism applies under any claim construction standard.

A control unit incorporates a controller. These take the form of a processor or microcontroller. *IControl Networks, Inc. v. Zonoff Inc.*, No. CV 14-1199-GMS, 2016 WL 1437892, at *1 (D. Del. Apr. 11, 2016) (construing "control unit" to require a programmable processor); *Glaston Corp. v. Salem Fabrication Techs. Grp.*, No. 1:21-CV-942, 2024 WL 1673273, at *17 (M.D.N.C. Apr. 18, 2024) (successfully arguing that "control units or controllers" are well-recognized structural units in patent law that a POSA would understand); *Capella Photonics, Inc. v. Fujitsu Network Commc'ns, Inc.*, No. 2:20-CV-00076-JRG, 2021 WL 465430, at *22 (E.D. Tex. Feb. 9, 2021) (a "control unit" refers to known structure, "namely a controller" such as a computer processor).

For this reason, and ***applying the BRI standard***, the PTAB has held that a controller ***must*** include ***a processor*** and ***be programmable***.

> The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[ ]." 37 C.F.R. § 42.100(b). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description

> contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see In re Smith Int'l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

*One World Techs., Inc. v. Chamberlain Grp., Inc.*, No. IPR2017-00073, 2018 WL 1960893, at *3–4 (P.T.A.B. Apr. 24, 2018).

The PTAB further observed that "broadest reasonable interpretation ... is an interpretation that corresponds with what and how the inventor describes his invention in the specification."

> Our interpretation "'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.' A construction that is 'unreasonably broad' and which does not 'reasonably reflect the plain language and disclosure' will not pass muster." *Microsoft Corp. v. Proxyconn*, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (citations omitted), overruled on other grounds by *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).
> In the Decision on Institution, based on the parties' arguments, see Pet. 13–32; Paper 6, 5–16, and record at the time, we preliminarily interpreted the following limitations of claim 1:
> ***"controller": a microprocessor, processor, or other programmable logic*** that controls the operation of the barrier movement operator.

*Id.*

In view of the proper construction of "slave control unit," the Examiner's identification of a soundmaker as a "slave control unit" is in error. Properly construed, it is not a slave control unit. It has no processor and is not programmable.





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While Phelan pointed out that these terms required construction, neither the request nor the Examiner provide a construction of the terms "master control unit" or "slave control unit." A POSITA would, in view of the teachings of the specification and claims, understand a "slave control unit" in the context of its required communication with a "master control unit." Both contain processors and are programmable, as set forth in the intrinsic record and discussed below.

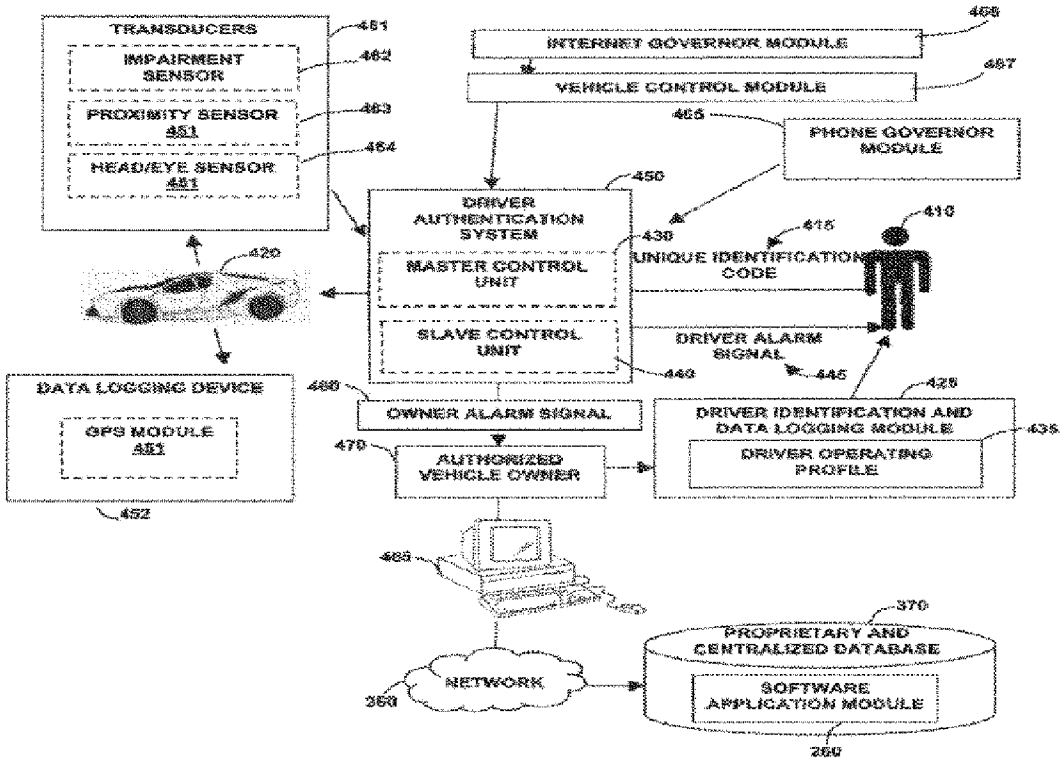



FIG. 5





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The "slave control unit" 440 itself has a microprocessor and can be programmed.

> The system 450 generally includes a master control unit 430 and a slave control unit 440 that can be accessed and programmed via the software application module 260 stored in the proprietary and centralized database 370.

'470 Patent at 6:8-12; *accord* 8:9-24. The slave control unit processes inputs from sensors:

> The slave control unit **440** can process the data collected from the sensors and determine if the data indicates a condition that requires a warning. For example, the sensors may indicate that the vehicle is speeding, veering off the road, approaching an obstruction in the road, too close to another vehicle, that the vehicle driver is distracted, sleepy, or not paying attention, that the vehicle driver is impaired etc. If one of these conditions is identified, the slave control unit **440** signals the master control unit **430** and the master control unit issues a driver alarm signal **445** as described above. In the case where the impairment sensor **462** provides a signal to the slave control unit **440** indicating that the driver's impairment is above a prescribed limit, the slave control unit can prevent the vehicle from starting.

'470 Patent at 8:43-56; 10:48-61.

The Examiner contends that the microprocessor 101 is the "master control unit" and appears to argue that engine slow down module 120 and audible noise generator 121 together form the "slave control unit." Rather than being a "unit," as

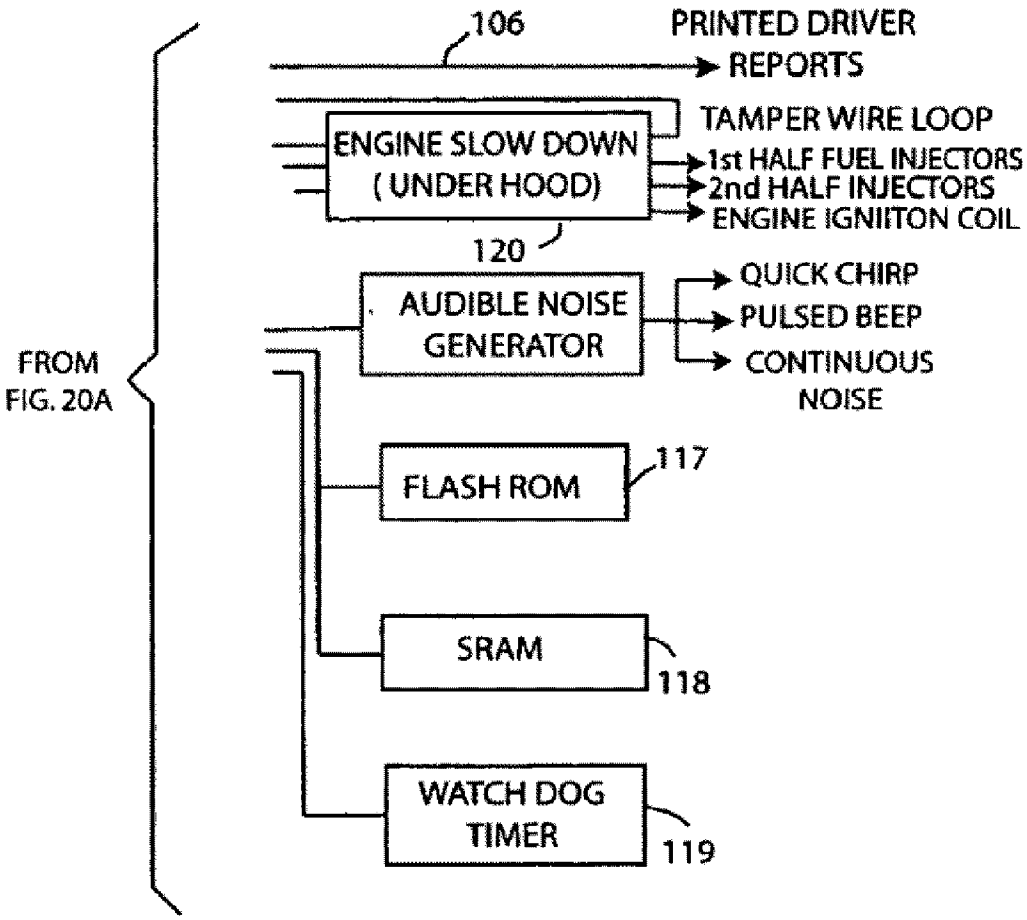


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claimed, the slow down module 120 and audible noise generator 121 are not even depicted as being in communication with one another.

FIG. 20B








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Cherouny at Fig. 20B. There is no teaching of any programmability of audible noise generator, no communication of any kind to the engine slow down, and no function other than making a noise based on an input signal. Cherouny at [0078].

The Examiner does not appear to contend that engine slow down module 120 generates an alarm signal as required by the claim language. The only disclosure remaining is audible noise generator 121, which as indicated by the name, is a simple noise generator:

> **[0078]** An audible noise generator **121** is also connected to the microprocessor for provision of various warning noises such as a quick chirp, a pulsed beep and a continuous noise. These provide warnings of increasing severity to the driver of the vehicle.

Cherouny at 6 [0078]. This does not meet the requirements of the slave control unit when it is properly construed as discussed *supra*.

Claim 4

Claim 4 is allowable for the same reasons previously discussed. Because it is a dependent claim, and thereby incorporates all of the limitations of independent claim 1 from which it depends, the disclosure lacking in Cherouny related to the independent claim limitations discussed herein prevent the combination of Cherouny and Harter from rendering dependent claim 4 obvious.

**Ground 2 Under 35 U.S.C. § 103 (Cherouny in View of Shuman)**





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Ground 2 is predicated on a combination of Cherouny and Shuman. As a preliminary matter, the combination of these references is improper. The Examiner concedes that "Cherouny does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means." May 23, 2024 Final Office Action at 27. Indeed, Examiner cites neither Cherouny nor Shuman as disclosing a wireless communication system. The Examiner asserts without evidence, however, that a skilled artisan would have been generally motivated to modify Chorouny with Shuman to fabricate a wireless communication system in the manner claimed. May 23, 2024 Final Office Action at 27.

That is improper in the absence of evidence that an artisan would be motivated, rather than discouraged, from combining in the manner claimed. *See Tris Pharma, Inc. v. Actavis Lab'ys FL, Inc.*, 2022 WL 2525318, at *5 (Fed. Cir. July 7, 2022); *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1067 (Fed. Cir. 2020) (affirming a district court's finding of no motivation to combine where the district court "properly weighed the evidence presented and concluded as a matter of fact that a [skilled artisan] would be dissuaded from selecting or combining the components as claimed"); *see also Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1379 (Fed. Cir. 2017).





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More specifically, Cherouny teaches against wireless communication between the alleged data logging module and identification module. Moreover, it teaches away from a simple *wired* configuration, and teaches a very specific implementation, for security purposes.

> In the prior art devices, there was no way to make a record to guide decisions about future programming. The present device allows for a driver to pass a controlled number of occurrences but at some point that ability will be curtailed. If the driver has a bad record the ability to "pass" will be limited or denied. In addition, it would be easy to by-pass the prior art system by hot wiring around it. In the instant invention, the wiring harness has decoy wiring that forms a loop through all the various electronic modules. If the looped wire that threads through all of the modules is broken for even a moment the event is recorded and documented.

Cherouny at ¶33.

Similarly, the profile information is kept inaccessible to the driver and is hardwired in a specific manner.

> The instant device utilizes input selector codes. The data is not coded going through the infrared link. It is literal data describing the numerous profiles of all the drivers under all the different driving conditions. The profile is set up in the instant device and inaccessible to the driver.

Cherouny at ¶30.



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In short, there is no evidence in the record that an artisan would have been motivated to combine Cherouny and Shuman in the manner claimed, particularly when Cherouny teaches against such an implementation.

The arguments in Ground 1 also apply to this rejection.

**Ground 3 Under 35 U.S.C. § 103 (Cherouny in View of Petrik)**

Ground 3 is based on Cherouny in view of Petrik. Here again, Examiner cites neither Cherouny nor Petrik as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 33. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Petrik in the manner claimed, particularly when Cherouny teaches against wireless communication.

The Examiner also acknowledges that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.

Petrik teaches an individual driver logbook for each driver in the form of a smart card. "Drivers are issued with their logbook smart cards with their fingerprint template recorded in the card." Petrik at ¶22. "At the start of the journey the driver inserts his smart card into the unit's smart card reader/writer and places his finger





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on the fingerprint reader to confirm his identity. This automatically logs him in as the current driver and enables engine ignition." *Id.* At ¶23. The unique smart card approach of Petrik could not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33. It is inappropriate to use the template provided by the inventor to render the inventor's contribution obvious. *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor")).

The arguments in Ground 1 also apply to this rejection.

**Ground 4 Under 35 U.S.C. § 103 (Cherouny in View of Bouchard)**

Ground 4 is based on Cherouny in view of Bouchard. Here again, Examiner cites neither Cherouny nor Bouchard as disclosing a wireless communication system, relying only on a general statement that a POSITA would know how to implement a system wirelessly. May 23, 2024 Final Office Action at 39. For the same reasons discussed in Grounds 1 and 2, a POSITA would not have been motivated to combine Cherouny and Bouchard in the manner claimed, particularly when Cherouny teaches against wireless communication.





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The Examiner also acknowledges that "Cherouny does not explicitly teach a vehicle control system wherein the data logging device records location information." May 23, 2024 Final Office Action at 35.

Here again, a review of Bouchard demonstrates that the two approaches of Cherouny and Bouchard are fundamentally inconsistent, and an artisan would not be motivated to combine one with the other. Bouchard is a vehicular *radar* system. Directly contrary to Cherouny, it also teaches a removable storage device.

> A removable, externally readable, non-volatile solid-state memory event recording apparatus (ERA)5 is coupled to the system processor 107. The ERA records the output of each of the sensors and information about targets detected by the radar system.

Bouchard, 8:43-48. The removable memory approach of Bourchard could likewise not be combined with Cherouny, which teaches storing calculated speed information in a secure location, hardwired in the vehicle. Cherouny at ¶33.

The arguments in Ground 1 also apply to this rejection.

## CONCLUSION

In light of the foregoing remarks, the Patent Owner respectfully requests the Office to withdraw the pending rejection to claims 1 and 4 of the '470 Patent. If any outstanding issues remain, the undersigned would welcome an Applicant interview with the Office to expedite the resolution of this application.





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Date: July 23, 2024

Respectfully submitted,

/s/ *Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, TX 78731
Telephone: (512) 539-2625
Facsimile: (512) 539-2627



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## CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of July 2024, a true and correct copy of the foregoing RESPONSE TO MAY 23, 2024 FINAL OFFICE ACTION was served pursuant to 37 C.F.R. § 1.550(f) via Priority Mail (9405503699300702133265) upon the following counsel of record for third-party requesters:

Unified Patents, LLC
4445 Willard Ave.
Suite 600
Chevy Chase, MD 20815

*/s/ Gregory S. Donahue*
Gregory S. Donahue
Reg. No. 47,531
DiNovo Price LLP
7000 North MoPac Expressway
Suite 350
Austin, Texas 78731



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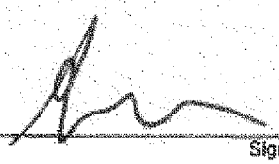
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Patent Owner's Response to Final Office Action dated July 23, 2024 in Reexam 90/015,287

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Ortiz & Lopez, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

| EXAMINER | |
|---|---|
| WASSUM, LUKE S | |

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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/015,287* .

PATENT UNDER REEXAMINATION *10259470* .

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)).

## *Ex Parte* Reexamination

A request for Ex Parte Reexamination of claims 1 and 4 of U.S. Patent Number 10,259,470 ("the '470 patent") was filed on 31 August 2023 ("the Request"). The '470 patent was issued to **Michael Phelan** on 16 April 2019, from application 15/336,110 ("the '110 application"), filed 27 October 2016.

The Office mailed a Decision granting reexamination of claims 1 and 4 on 17 October 2023.

Claims 1 and 4 are subject to reexamination.

## Related Proceedings

After review of the '470 patent and its prosecution history, the examiner has located two instances of currently ongoing litigation (see Litigation Review sheet). The examiner has failed to locate any previous reexaminations (*ex parte* or *inter partes*), supplemental examinations, or other post issuance proceedings before the Office.

## Priority

The '470 patent is a continuation of application number 14/464,188, filed 20 August 2014, now U.S. Patent 9,493,149 ("the parent patent"), which is a continuation-in-part of application number 13/858,930, filed 8 April 2013, now U.S. Patent 9,045,101



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("the grandparent patent"), which is a continuation of application number 12/496,509, filed 1 July 2009, now U.S. Patent 8,417,415. The '470 patent also claims priority under 35 U.S.C. § 119(e) to U.S. Provisional Application 61/077,568, filed 2 July 2008.

With respect to the priority date to which the '470 patent is entitled, the Office notes that claim 1 includes the limitation of 'a wireless identification and data logging module'. After review of the disclosure of the grandparent patent, the Office concludes that this limitation of claim 1 is not supported therein.

For instance, the grandparent patent includes only a disclosure of a driver identification and data logging device, while the '470 patent claims a *wireless* driver identification and data logging *module*. Implementation of this feature as wireless or as a module is not supported by the grandparent patent, which can be seen (for example) by comparing analogous portions of the specifications of the respective disclosures:

> The data logging device **425** can be connected to the remote computer **465** and the operating profile **435** can be stored. Once the required information is copied into the data logging device **425**, the device **425** can be disconnected from the remote computer **465** and can be placed on a driver key ring (not shown). The master control unit **430** can authenticate the driver **410** utilizing a unique identification code **415** provided by the driver identification and data logging device **425**.

Grandparent patent, col. 6, lines 52-60.



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The Office notes that the above disclosure regarding disconnecting the data logging device from the remote computer and placing it on the driver's key ring (i.e., a *device* embodiment) was omitted from the specification of the '470 patent, as can be seen below.

> The driver authentication and data logging module or device **425** can be connected to the remote computer **465** wirelessly or otherwise, and the operating profile **435** can be stored. The master control unit **430** can authenticate the driver **410** utilizing a unique identification code **415** provided by the driver identification and data logging module **425**.

'470 patent, col. 7, lines 26-32.

As highlighted above, disclosure of an embodiment of the data logging device as a *module*, present in the specification of the '470 patent, was absent in the specification of the grandparent patent, as was the *wireless* embodiment.

In summary, the Office has reviewed the disclosure of the grandparent patent and found no support for a data logging *module*, nor a *wireless* data logging module, therein.

Since the above identified features of claim 1 are not supported by the grandparent patent, the earliest priority date of the '470 patent is 20 August 2014, the application date of the parent patent.



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Because the effective filing date of the '110 application is presumed to be on or after March 16, 2013, the AIA First Inventor to File ("AIA-FITF") provisions will apply.

In the event the determination of the status of the '110 application as subject to AIA 35 U.S.C. §§ 102 and 103 (or as subject to pre-AIA 35 U.S.C. §§ 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

**Claim Construction**

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)).

The examiner has reviewed of the original specification and prosecution history and found no instance of lexicographic definitions, either express or implied, that are inconsistent with the ordinary and customary meaning of the respective terms. Therefore, for the purposes of claim interpretation, the examiner concludes that there



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are no claim terms for which Patent Owner is acting as their own lexicographer. See MPEP § 2111.01(IV).

Additionally, upon review of the claims subject to reexamination, the examiner finds no instances where the claim terms include language which would invoke the provisions of 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. §112, sixth paragraph.

**The Claimed Invention**

The '470 patent is titled "Driver Authentication System and Method for Monitoring and Controlling Vehicle Usage." The '470 patent discloses a "driver authentication and safety system and method for monitoring and controlling vehicle usage by high-risk drivers.", Abstract. The '470 patent does so through the use of "operating profiles" that "can be loaded to a driver identification and data logging module in conjunction with a remote computer.", *Id.* Furthermore, the system includes components such as a "master control unit" that receives an identification code to authenticate the high-risk driver to "operate the vehicle within the desired operating profile.", *Id.* Finally, a "slave control unit" is disclosed that "receives commands from the master control unit" and can "generate[] a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver.", *Id.*



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The '470 patent acknowledges that "[w]ith more young drivers getting licenses each year, there has been an unfortunate increase in accidents along with the ensuing damage, debilitating injuries and sometimes death" attributable to "generally poor driving habits.", col. 1, lines 39-48. The '470 patent further acknowledges other categories of "high-risk driver[s]," including "teen driver, fleet or rental drivers, habitual reckless drivers, aged drivers, drunk drivers, drowsily (sic) drivers, distracted drivers etc." that could benefit from the '470 patent's invention, col. 2, lines 31-50. As mentioned, the '470 patent is designed to improve driver safety through the use of an alarm signal generated by a slave control unit when the driver violates a preprogrammed operating profile unique to the driver. This alarm could continue until the driver corrects the operating condition (e.g., speed, location) and brings the vehicle within the desired operating profile (e.g., if the driver is going too fast, slowing the vehicle to be within the operating profile range), col. 2, line 51 through col. 3, line 3. The system further "can include a GPS (Global Positioning System) module to determine and measure parameters such as, time of day, speed and location data associated with the vehicle.", *Id*.

The '470 patent describes a software system and general process through which an authorized user (e.g., a parent) can establish an operating profile for the at-risk driver, col. 4, lines 3-67 and col. 2, lines 54-55. The profile may include, for example,



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"maximum allowable vehicle speed, user infraction limits … vehicle locations," and so on, col. 6, line 46 through col. 7, line 2. Relevant to challenged claim 1, the system further discloses a "data logging device" that "can be used to record vehicle operation data associated with operation of the vehicle," which may include the vehicle's speed and location, col. 7, lines 46-57. Finally, a "master control unit" and "slave control unit" are in communication with one another, and, may generate an alarm signal or take control of the vehicle (e.g., to "lower/limit speed") when the driver operates outside of the established operating profile, col. 7, line 58 through col. 9, line 37.

**Prior Art Cited in the Request**

The following references were cited by the third party Requester in the Request for *Ex Parte* Reexamination:

U.S. Patent Application Publication 2006/0052909 to Peter H. Cherouny ("**Cherouny**")

U.S. Patent Application Publication 2008/0188217 to Thomas C. Harter et al. ("**Harter**")

U.S. Patent 6,577,937 to Valerie Shuman et al. ("**Shuman**")

U.S. Patent Application Publication 2007/0168125 to Stephen Petrik ("**Petrik**")

U.S. Patent 5,465,079 to Paul J. Bouchard et al. ("**Bouchard**")



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None of these references were cited or discussed on the record during the original prosecution of the '110 application.

**Patent Owner's Response**

Patent Owner filed a response ("Response") on 15 April 2024. The response included remarks only.

Claims 1 and 4 remain subject to reexamination.

**Response to Arguments**

Patent Owner's response included several arguments. They are addressed in turn below.

Limitation 1(b): master control unit

Patent Owner makes several distinctions (Response, pages 10-12) between the disclosed master control unit and that taught in the prior art. However, there does not appear to be an allegation that **Cherouny** does not disclose the claimed master control unit, only that it is implemented differently.



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The Office notes that as discussed in the rejection of record, **Cherouny** discloses a microprocessor (i.e., the claimed master control unit) that authenticates at least one vehicle occupant in order to associate an operating profile with the occupant. See disclosure that the microprocessor is connected to a key fob that checks the identity of the driver to insure (sic) that the user's data table (i.e., the claimed operating profile) is used, ¶ [0073]. This disclosure meets the claimed limitation of the master control unit.

Limitation 1(c): module for receiving location and speed information

Patent Owner argues that **Cherouny** fails to disclose "speed information determined from movement of said vehicle" (because it uses a wheel sensor), and that **Cherouny's** disclosure of GPS is made only with respect to school zones, and not for speed determinations based on vehicle movement (Response, pages 12-13).

This argument is not persuasive.

The Office initially notes that the limitation at issue is a module that receives location and speed information. Since the claim merely requires a module that receives information, the *source* of said information is not a limiting feature. The module would work identically regardless of the source of said speed and location information.

Although the claims are interpreted in light of the specification, limitations from



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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The limitation also merely recites the receipt of speed information and location information. There is no limitation regarding the mechanism for deriving said information. **Cherouny** discloses "speed sensors **108** which sense the actual speed of the automobile when in use" (¶ [0073]), which clearly meets the requirement for receipt of speed information. Also disclosed is the fact that the system "receives the location of the vehicle from the GPS satellite system" (¶ [0020]), which clearly meets the requirement for receipt of location information.

Limitation 1(d): a data logging device

Patent Owner argues that the rejection of record is improper because it apparently maps **Cherouny's** disclosed car monitor **170** to both the claimed identification/data logging module and also the claimed data logging device (Remarks, pages 13-15).

This argument is not persuasive.



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The Office notes that one of the argued components is a 'module' (i.e., software) and the other is a 'device' (i.e., hardware). Although there is no claimed functionality associated with the identification and data logging module, it is presumed to identify the driver of a vehicle and to process data associated with the vehicle, such as speed data. The functionality associated with the claimed data logging device is to record the vehicle operation data, such as speed data.

Since the data logging device records vehicle operation data, and the identification/data logging module processes such vehicle operation data (e.g., speed), it would make sense that the module processing said data would reside within a device that records such data (as is the case with the car monitor disclosed by **Cherouny**).

**Cherouny** discloses that the car monitor **170** performs the functions of measuring car speed **171** and identifying the driver via a key fob reader **174**, the functions of the claimed identification and data logging module. **Cherouny** also discloses that the car monitor provides data logs, the functionality of the claimed data logging device.

Claiming the hardware and software components separately (such as the current claim 1) as opposed to a single component combining hardware and software (such as **Cherouny's** disclosed car monitor **170**) does not impart patentability when all of the claimed functionality is carried out by the disclosed combined hardware/software component.



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Limitation 1(e): slave control unit

Patent Owner argues that the prior art fails to disclose the claimed slave control unit, because it does not teach communication with a 'master control unit', and because the disclosed slave processing unit includes a programmable processor (Remarks, pages 15-19). Patent Owner also argues that the prior art fails to disclose any programmability of the audio noise generator, communication to the master control unit, communication to the engine slow down, and no function other than making a noise based on an input signal.

These arguments are not persuasive.

The Office initially notes that Patent Owner is reading limitations from the specification into the claims. For instance, there is nothing in the claims with respect to programmability of the claimed 'slave control unit', and nothing in the claims with respect to communication *from* the slave control unit *to* the master control unit.

Instead, claim 1, as currently written, requires only that the slave control unit receives commands from the master control unit and generates an alarm signal. **Cherouny's** disclosed audible noise generator reads on this claim limitation, receiving



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signals from microprocessor **101** (the claimed master control unit) in order to generate audible signals (see ¶ [0078] and Figs. 20A & 20B).

Also required is that the master control unit provides operational governance of said vehicle within said operational profile. **Cherouny's** disclosed engine slow down module **120** receives signals from microprocessor **101** (the claimed master control unit) in order to govern the operation of the vehicle within the operational profile, as claimed (see ¶¶ [0020], [0025]-[0027], [0031], [0038], and [0077]).

Patent Owner also argues that with respect to claim 4, as well as Grounds 2-4, these rejections are also improper based on the previously presented arguments.

These arguments are not persuasive, for the reasons discussed above.

The rejections of record are therefore maintained.

**Summary of Grounds of Rejection**

Ground 1: Claims 1 and 4 are obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Harter**.

Ground 2: Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Shuman**.



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Ground 3: Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Petrik**.

Ground 4: Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Bouchard**.

**Relevant Statutes**

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



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## Claim Rejections

**Ground 1: Cherouny and Harter**

Claims 1 and 4 are obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Harter**.

Claim 1

With respect to claim 1, **Cherouny** teaches **a vehicle control system** (see disclosure of an improved electronic programmable speed limiter for drivers of vehicles, Abstract), comprising:

a) **an identification** (see disclosure of a key fob that identifies to the mobile computer who was or is about to operate the vehicle, ¶ [0018]) **and data logging module** (see disclosure of car monitor **170**, which measures car speed, and provides data logs of time and severity of infraction, ¶ [0081]);

b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor **101** which connects to key fob reader **109** to check the identity of the user of the automobile to ensure the instant user's data table is used, ¶ [0073]; see also



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disclosure that a moderator can preprogram operational parameters [i.e., an operating profile] for an individual driver in its system, ¶¶ [0018] and [0020]);

c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor **108**, ¶ [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, ¶ [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1);

d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, ¶ [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], ¶¶ [0080]-[0081]);

e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands**



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**from said master control unit and generate an alarm signal** (see disclosure of engine slow down module **120** and audible noise generator **121**, ¶¶ [0077]-[0078] and Figs. 20A & 20B; see also disclosure that functions of the driver monitor include engine slowdown **181** and audible noise alarms **182**, ¶[0082] and Figs. 21A & 21B; see also disclosure of the possible audio alarms, ¶¶ [0021]-[0024] and [0031]); and

f) **wherein said master control unit provides operation governance of said vehicle within said operating profile** (see disclosure of a system for regulating the driving performance of a given individual whereby operation of the engine of a vehicle is automatically curtailed when received exceeds preset or personalized limits of the individual driver, claim 1; see also disclosure that a moderator can regulate operation of the engine in response to the car going faster than the speed limit, ¶¶ [0020], [0025]-[0027], [0031], [0038], and [0077]).

**Cherouny** does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means.



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It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the claimed identification and data logging module as a module that communicates wirelessly, since wireless short-range communications were common at the time of the invention, including the use of wireless fobs for use in authentication of a driver of a vehicle. Implementing wireless communication would have involved a modification that was well within the skill of an ordinary artisan at the time of the invention, and would have had the benefit of enabling communication between vehicle components without the need for a physical connection, thus increasing ease of use.

Furthermore, to the extent that one could argue that **Cherouny** fails to disclose all aspects of the logging of data regarding the operation of the vehicle through the use of a wireless device, **Harter** teaches these features.

For instance, **Harter** discloses a portable device **120** that receives identifying information from the driver (¶ [0007] and Fig. 4), and communicates such data to a base unit **116** via a wireless link **122** (¶ [0033]). See also illustration that the portable device, in this case a smart phone **400**, is used for logging data, as displayed on status screen **900** in Figs. 10-13.



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Using **Harter's** teaching of using a smart phone to assist in identifying and monitoring drivers would have been the simple substitution of one known technique (i.e., **Harter's** use of a wireless smart phone device together with software to identify and log data related to a specific driver of a vehicle) for another (**Cherouny's** technique of using a key fob together with software to identify and log data related to a driver of a vehicle) to obtain predictable results - i.e., a system (**Cherouny's**) using a wireless mobile device (in view of **Harter's** teachings) to assist with wirelessly identifying a driver and logging data related to their trip within the vehicle. See **Cherouny**, ¶¶ [0018]-[0020], [0031], [0035], [0081]; see also **Harter**, ¶¶ [0007]-[0008], [0032]-[0033], [0042], [0045]-[0046], [0053].

Implementing **Harter's** teaching of using a wireless mobile device (i.e., smart phone) would have been an improvement over **Cherouny's** existing system using a key fob and various software modules, and a POSITA would have recognized at the time of the '470 patent that a smart phone, like **Harter's**, would increase the vehicle control system's ability to identify and log data associated with a trip, given the known capabilities of a smart phone at the time (which would have included various additional technologies, such as Bluetooth or GPS) as compared to the key fob used in **Cherouny**.

For example, **Cherouny's** disclosure is based on applications dating back to June 2001, a time when many drivers would not have regularly carried a smartphone or used



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it as an identification device. But before the time of the '470 patent, techniques using smartphones together with vehicles were known and common (as evidenced by **Harter**), and would have been well known to a POSITA at the time reading **Cherouny**. Accordingly, this provides further motivation for a POSITA to modify **Cherouny** with the teachings of **Harter** to bring it up to date with modern techniques and knowledge at the time. *Id*.

Additionally, combining **Harter's** teachings for implementing a wireless mobile device in a system that identifies and logs data related to drivers of vehicles would have merely combined prior art elements (**Harter's** disclosure of a smart phone for identifying and logging data related to a driver of a vehicle and **Cherouny's** system for a similar purpose of monitoring drivers) according to known methods (i.e., that it was known to use various wired and/or wireless devices, such as **Harter's** "cable or wireless link" (¶ [0033]), to assist with monitoring and identifying drivers of vehicles) to yield predictable results—i.e., a system that is able to use a wireless mobile device to identify and log data related to a driver's trip within the vehicle. See **Cherouny**, ¶¶ [0018]-[0020], [0031], [0035], [0081]; see also **Harter**, ¶¶ [0007]- [0008], [0032]-[0033], [0042], [0045]-[0046], [0053].



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**Cherouny** does not explicitly teach a vehicle control system wherein the data logging device records location information.

**Harter**, however, discloses a vehicle control system wherein **the data logging device records location information** (see disclosure that the system logs performance of a driver operating a vehicle, Abstract and ¶ [0007]; see also disclosure that the system logs operating parameters, including speed, ¶ [0032]; see also disclosure that the logged information also includes locations that the driver has traveled during the trip, ¶ [0054] and illustrated in Fig. 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data logging module that logs location information, because a POSITA would have recognized that **Harter's** explicit disclosure of a data logging device as shown above would have added desirable functionality to **Cherouny** and once again furthered its goal of improving the safety of at-risk drivers, e.g., by allowing a moderator to review driving records of the monitored and at-risk driver. As discussed above, a POSITA would have had a reasonable expectation of success in implementing these teachings from **Harter** into **Cherouny** given **Cherouny** already



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discloses the use of speed and location information and the recording of said speed data over a period of time.

Claim 4

With respect to claim 4, **Cherouny** and **Harter** teach the vehicle control system of claim 1 wherein said wireless identification and data logging module comprises at least one of: **a WIFI enabled device**; an RFID enabled device; **a Bluetooth enabled device**; **a cellular telephone**; and **a smartphone** (see disclosure that the portable device comprises at least one of a computer, a personal-digital-assistant ("PDA"), and a smart phone, claim 2; see also disclosure that the portable device is wirelessly coupled to the base unit via at least one of a personal area network connection and a cellular connection, claim 3 and ¶ [0033]; see also disclosure that base unit **116** and portable device **120** communicate through wireless link **122**, which can include Bluetooth, ¶[0033] and Fig. 1; see also disclosure of portable devices **120** in the form of a smart phone **400** that connects wirelessly via Bluetooth or other wireless connections, ¶ [0042]).



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It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a specific type of wireless communication types such as claimed, for the same reasons discussed above with respect claim 1 regarding motivation for the incorporation of wireless communications generally.

**Ground 2: Cherouny and Shuman**

Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Shuman**.

Claim 1

With respect to claim 1, **Cherouny** teaches **a vehicle control system** (see disclosure of an improved electronic programmable speed limiter for drivers of vehicles, Abstract), comprising:

a) **an identification** (see disclosure of a key fob that identifies to the mobile computer who was or is about to operate the vehicle, ¶ [0018]) **and data logging module** (see disclosure of car monitor **170**, which measures car speed, and provides data logs of time and severity of infraction, ¶ [0081]);

b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an**



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**operating profile with said at least one occupant** (see microprocessor **101** which connects to key fob reader **109** to check the identity of the user of the automobile to ensure the instant user's data table is used, ¶ [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile] for an individual driver in its system, ¶¶ [0018] and [0020]);

c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor **108**, ¶ [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, ¶ [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1);

d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, ¶ [0036]; see also disclosure that the system shows a daily driving record, and measures



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car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], ¶¶ [0080]-[0081]);

e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module **120** and audible noise generator **121**, ¶¶ [0077]-[0078] and Figs. 20A & 20B; see also disclosure that functions of the driver monitor include engine slowdown **181** and audible noise alarms **182**, ¶[0082] and Figs. 21A & 21B; see also disclosure of the possible audio alarms, ¶¶ [0021]-[0024] and [0031]); and

f) **wherein said master control unit provides operation governance of said vehicle within said operating profile** (see disclosure of a system for regulating the driving performance of a given individual whereby operation of the engine of a vehicle is automatically curtailed when received exceeds preset or personalized limits of the individual driver, claim 1; see also disclosure that a moderator can regulate operation of the engine in response to the car going faster than the speed limit, ¶¶ [0020], [0025]-[0027], [0031], [0038], and [0077]).



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**Cherouny** does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the claimed identification and data logging module as a module that communicates wirelessly, since wireless short-range communications were common at the time of the invention, including the use of wireless fobs for use in authentication of a driver of a vehicle. Implementing wireless communication would have involved a modification that was well within the skill of an ordinary artisan at the time of the invention, and would have had the benefit of enabling communication between vehicle components without the need for a physical connection, thus increasing ease of use.

To the extent that one could argue that **Cherouny** lacks implementation details with respect to the logging of data regarding the operation of the vehicle, **Shuman** teaches such details.

For instance, **Shuman** discloses a drive recorder **225** that obtains and logs information relating to all aspects of the vehicle and vehicle environment, including



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current information streams from all sensors, all subsystem software, all vehicle hardware, the communications manager, the vehicle-user device manager, and the driver and user interface devices. The driver recorder **225** continuously stores a history of the vehicle and vehicle environment in a non-volatile secure data storage device, col. 30, line 59 through col. 31, line 12.

A POSITA would have found it obvious to use the teachings from **Shuman** (i.e., the use of driver profiles and recording vehicle location and speed in the vehicle units' memory) because this would have represented a simple modification to **Cherouny's** system, which already describes "record[ing] the driver speed over a given period of time." **Cherouny**, ¶ [0035]. Accordingly, to the extent **Cherouny** was lacking any implementation details on how or where to record information about operation of the vehicle, **Shuman** provides explicit details of the same (e.g., that its "driver recorder **225** continuously stores a history of the vehicle and vehicle environment in a non-volatile secure data storage device," and that this "data storage device may be in the vehicle or may be located remotely," **Shuman**, col. 30, line 59 through col. 31, line 12), and a POSITA would have been aware of these techniques in view of **Shuman's** explicit disclosure of them. A POSITA would have had a reasonable expectation of success in implementing **Shuman's** teachings, particularly given **Cherouny's** disclosure that with



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its invention "the memory capability of the speed governor allows for a permanent record of the drivers possible violations." **Cherouny**, ¶ [0009].

**Cherouny** does not explicitly teach a vehicle control system wherein the data logging device records location information.

**Shuman**, however, discloses a vehicle control system wherein **the data logging device records location information** (see disclosure that a vehicle positioning program uses data from the vehicle sensors **202** and **204** and the geographic database **220** to determine the position, speed, and heading of the vehicle, col. 9, lines 52-57; see also disclosure that the drive recorder maintains records of the statuses of all vehicle systems, Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data logging module that logs location information, because a POSITA would have seen it as beneficial and obvious to include capabilities of monitoring and receiving speed and location information into **Cherouny's** system based on these explicit teachings in **Shuman**. **Cherouny's** system already includes the



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components necessary to obtain this information (e.g., through its automobile speed sensor **108** and GPS **114**), and to the extent it is not explicit, **Shuman** provides the implementation details as to how this information would be received by the processor of the system. See **Cherouny**, claim 1, ¶¶ [0020], [0035], [0040]; **Shuman**, Abstract, col. 9, lines 52-57. A POSITA would have recognized that monitoring speed and location (e.g., in view of **Shuman's** explicit teachings) would further **Cherouny's** stated goal of improving safety of at-risk drivers. A POSITA would have had a reasonable expectation of success of implementing **Shuman's** teachings in view of **Cherouny** disclosing transmission of "location and speed data" and that **Cherouny's** system already includes the components for doing so. *Id*.

**Ground 3: Cherouny and Petrik**

Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Petrik**.

Claim 1

With respect to claim 1, **Cherouny** teaches **a vehicle control system** (see disclosure of an improved electronic programmable speed limiter for drivers of vehicles, Abstract), comprising:



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a) **an identification** (see disclosure of a key fob that identifies to the mobile computer who was or is about to operate the vehicle, ¶ [0018]) **and data logging module** (see disclosure of car monitor **170**, which measures car speed, and provides data logs of time and severity of infraction, ¶ [0081]);

b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor **101** which connects to key fob reader **109** to check the identity of the user of the automobile to ensure the instant user's data table is used, ¶ [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile] for an individual driver in its system, ¶¶ [0018] and [0020]);

c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor **108**, ¶ [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, ¶ [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1);



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d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, ¶ [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], ¶¶ [0080]-[0081]);

e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module **120** and audible noise generator **121**, ¶¶ [0077]-[0078] and Figs. 20A & 20B; see also disclosure that functions of the driver monitor include engine slowdown **181** and audible noise alarms **182**, ¶[0082] and Figs. 21A & 21B; see also disclosure of the possible audio alarms, ¶¶ [0021]-[0024] and [0031]); and

f) **wherein said master control unit provides operation governance of said vehicle within said operating profile** (see disclosure of a system for regulating the driving performance of a given individual whereby operation of the engine of a vehicle is automatically curtailed when received



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exceeds preset or personalized limits of the individual driver, claim 1; see also disclosure that a moderator can regulate operation of the engine in response to the car going faster than the speed limit, ¶¶ [0020], [0025]-[0027], [0031], [0038], and [0077]).

**Cherouny** does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the claimed identification and data logging module as a module that communicates wirelessly, since wireless short-range communications were common at the time of the invention, including the use of wireless fobs for use in authentication of a driver of a vehicle. Implementing wireless communication would have involved a modification that was well within the skill of an ordinary artisan at the time of the invention, and would have had the benefit of enabling communication between vehicle components without the need for a physical connection, thus increasing ease of use.



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To the extent that one could argue that **Cherouny** lacks implementation details with respect to the logging of data regarding the operation of the vehicle, **Petrik** teaches such details.

For instance, **Petrik** discloses a system for automatically logging operational parameters such as vehicle location and vehicle speeds, and recording these on a secure smart card as well as in the vehicle units' memory, ¶¶ [0009] and [0025].

A POSITA would have found it obvious to use the teachings from **Petrik** (i.e., recording vehicle location and speed in the vehicle units' memory) because this would have represented a simple modification to **Cherouny's** system, which already describes "record[ing] the driver speed over a given period of time." ¶ [0035]. Accordingly, to the extent **Cherouny** was lacking any implementation details on how or where to record information about operation of the vehicle, **Petrik** provides explicit details of the same (e.g., "automatically and irrefutably logging … operational parameters … and recording these on a secure smart card as well as in the vehicle units' memory," ¶ [0009]) and a POSITA would have been aware of these techniques in view of **Petrik's** explicit disclosure of them. A POSITA would have had a reasonable expectation of success in implementing **Petrik's** teachings, particularly given **Cherouny's** disclosure that with its invention "the memory capability of the speed governor allows for a permanent record of the drivers possible violations." ¶ [0009].



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**Cherouny** does not explicitly teach a vehicle control system wherein the data logging device records location information.

**Petrik**, however, discloses a vehicle control system wherein **the data logging device records location information** (see disclosure of a system for automatically logging operational parameters such as vehicle location and vehicle speeds, and recording these on a secure smart card as well as in the vehicle units' memory, ¶¶ [0009] and [0025]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data logging module that logs location information, because a POSITA would have seen it as beneficial and obvious to include capabilities of monitoring and receiving speed and location information into **Cherouny's** system based on these explicit teachings in **Petrik**. **Cherouny's** system already includes the components necessary to obtain this information (e.g., through its automobile speed sensor **108** and GPS **114**), and to the extent it is not explicit, **Petrik** provides the implementation details as to how this information would be received by the processor



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of the system. See **Cherouny**, claim 1, ¶¶ [0020], [0035], [0040]; **Petrik**, ¶¶ [0009], [0025]. A POSITA would have recognized that monitoring speed and location (e.g., in view of **Petrik's** explicit teachings) would further **Cherouny's** stated goal of improving safety of at-risk drivers. A POSITA would have had a reasonable expectation of success of implementing **Petrik's** teachings in view of **Cherouny** disclosing transmission of "location and speed data" and that **Cherouny's** system already includes the components for doing so. *Id*.

**Ground 4: Cherouny and Bouchard**

Claim 1 is obvious under 35 U.S.C. § 103 over **Cherouny** in view of **Bouchard**.

Claim 1

With respect to claim 1, **Cherouny** teaches **a vehicle control system** (see disclosure of an improved electronic programmable speed limiter for drivers of vehicles, Abstract), comprising:

a) **an identification** (see disclosure of a key fob that identifies to the mobile computer who was or is about to operate the vehicle, ¶ [0018]) **and data**



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**logging module** (see disclosure of car monitor **170**, which measures car speed, and provides data logs of time and severity of infraction, ¶ [0081]);

b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor **101** which connects to key fob reader **109** to check the identity of the user of the automobile to ensure the instant user's data table is used, ¶ [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile] for an individual driver in its system, ¶¶ [0018] and [0020]);

c) **a module for receiving at least location and speed information in association with a movement of said vehicle** (see disclosure of speed sensor **108**, ¶ [0073]; see also disclosure of a global positioning receiver linked to the CPU that receives the location of the vehicle from the GPS satellite system, ¶ [0020]; see also disclosure of a wireless transmitting means associated with the moderator to send signals representing location and speed data of the vehicle at any given time to a central server, claim 1);

d) **a data logging device that records vehicle operation data associated with a use of said vehicle, the vehicle operation data comprising at least said**



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**speed information received from said module*** (see disclosure that the system records the driving speed over a given period of time, ¶ [0036]; see also disclosure that the system shows a daily driving record, and measures car speed and provides data logs of time and severity of infraction [i.e., car speed that is over the defined speed limits], ¶¶ [0080]-[0081]);

e) **a slave control unit in said vehicle and which communicates with said master control unit, wherein said slave control unit receives commands from said master control unit and generate an alarm signal** (see disclosure of engine slow down module **120** and audible noise generator **121**, ¶¶ [0077]-[0078] and Figs. 20A & 20B; see also disclosure that functions of the driver monitor include engine slowdown **181** and audible noise alarms **182**, ¶[0082] and Figs. 21A & 21B; see also disclosure of the possible audio alarms, ¶¶ [0021]-[0024] and [0031]); and

f) **wherein said master control unit provides operation governance of said vehicle within said operating profile** (see disclosure of a system for regulating the driving performance of a given individual whereby operation of the engine of a vehicle is automatically curtailed when received exceeds preset or personalized limits of the individual driver, claim 1; see also disclosure that a moderator can regulate operation of the engine in



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response to the car going faster than the speed limit, ¶¶ [0020], [0025]-[0027], [0031], [0038], and [0077]).

**Cherouny** does not explicitly teach a vehicle control system wherein the various system modules, including the identification and data logging module, communicate via wireless means.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the claimed identification and data logging module as a module that communicates wirelessly, since wireless short-range communications were common at the time of the invention, including the use of wireless fobs for use in authentication of a driver of a vehicle. Implementing wireless communication would have involved a modification that was well within the skill of an ordinary artisan at the time of the invention, and would have had the benefit of enabling communication between vehicle components without the need for a physical connection, thus increasing ease of use.



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To the extent that one could argue that **Cherouny** lacks implementation details with respect to the logging of data regarding the operation of the vehicle, **Bouchard** teaches such details.

For instance, **Bouchard** discloses an event recording apparatus coupled to a collision warning apparatus for recording the collected relevant data and recording a driver profile, claim 1. The driver's performance is evaluated in real-time by utilizing information gathered by a radar system and other sensors, and the information that has been recorded during past trips and a present trip, col. 4, line 60 through col. 5, line 1, and col. 26, lines 48-58.

Each driver maintains a removable event recording apparatus (ERA) that is personalized to that particular driver. Each ERA stores information that identifies the driver, and a record of that driver's driving history and performance, col. 6, lines 4-8. Data gathered from vehicle sensors ***4a*** include vehicle speed (momentary and average), and geographical positioning information, col. 9, lines 21-50.

A POSITA would have found it obvious to use the teachings from **Bouchard** (i.e., recording operational event information, a record of driving history) because this would have represented a simple modification to **Cherouny's** system, which already describes "record[ing] the driver speed over a given period of time." ¶ [0035]. Accordingly, to the extent **Cherouny** was lacking any implementation details on how or



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where to record information about operation of the vehicle, **Bouchard** provides explicit details of the same (e.g., "recording the collected relevant data and recording a driver profile" claim 1), and a POSITA would have been aware of these techniques in view of **Bouchard's** explicit disclosure of them. A POSITA would have had a reasonable expectation of success in implementing **Bouchard's** teachings, particularly given **Cherouny's** disclosure that with its invention "the memory capability of the speed governor allows for a permanent record of the drivers possible violations." ¶ [0009].

**Cherouny** does not explicitly teach a vehicle control system wherein the data logging device records location information.

**Bouchard**, however, discloses a vehicle control system wherein **the data logging device records location information** (see disclosure of a removable event recording apparatus (ERA) that is personalized to that particular driver. Each ERA stores information that identifies the driver, and a record of that driver's driving history and performance, col. 6, lines 4-8. Data gathered from vehicle sensors **4*a*** include vehicle speed (momentary and average), and geographical positioning information, col. 9, lines 21-50).



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It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data logging module that logs location information, because a POSITA would have seen it as beneficial and obvious to include capabilities of monitoring and receiving speed and location information into **Cherouny's** system based on these explicit teachings in **Bouchard**. **Cherouny's** system already includes the components necessary to obtain this information (e.g., through its automobile speed sensor **108** and GPS **114**), and to the extent it is not explicit, **Bouchard** provides the implementation details as to how this information would be received by the processor of the system. See **Cherouny**, claim 1, ¶¶ [0020], [0035], [0040]; **Bouchard**, col. 9, lines 21-50. A POSITA would have recognized that monitoring speed and location (e.g., in view of **Bouchard's** explicit teachings) would further **Cherouny's** stated goal of improving safety of at-risk drivers. A POSITA would have had a reasonable expectation of success of implementing **Bouchard's** teachings in view of **Cherouny** disclosing transmission of "location and speed data" and that **Cherouny's** system already includes the components for doing so. *Id*.



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## Conclusion

**THIS ACTION IS MADE FINAL.**

A shortened statutory period for response to this action is set to expire TWO (2) MONTHS from the mailing date of this action.

**Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings.** The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

**Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c).** A request for extension of time must specify the requested period of extension and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). Any request for an extension in a third party requested ex parte reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request will not effect any extension of time. A request for an extension of time in a third party requested ex parte reexamination will be granted only for sufficient cause, and for a reasonable time specified. Any request for extension in a patent owner requested ex parte reexamination (including reexamination ordered under 35 U.S.C. 257) for up to two months from the time period set in the Office action must be filed no



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later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested ex parte reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months will not effect the extension. The time for taking action in a patent owner requested ex parte reexamination will not be extended for more than two months from the time period set in the Office action in the absence of sufficient cause or for more than a reasonable time.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional two months. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving U.S. Patent No. 10,259,470 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.



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The Patent Owner is reminded that any proposed amendment to the specification and/or claims in the reexamination proceeding must comply with the provisions of 37 C.F.R. § 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. § 1.52(a) and (b), and must include any fees required by 37 C.F.R. § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper amendments in reexamination proceedings.

Any document filed by the Patent Owner must be served on the third party requester (or requesters in a merged proceeding) in the reexamination proceeding in the manner provided by 37 C.F.R. § 1.248. See 37 C.F.R. § 1.550(f) and MPEP § 2266.03.

**All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

| | |
|---|---|
| By Patent Center: | Patent Center (patentcenter.uspto.gov) has 100% of the functionality of EFS-Web, Public and Private PAIR, and is available to all users for electronic filing and management of patent applications. For more information, please visit the Patent Center information page at uspto.gov/patents/apply/patent-center. |
| By Mail to: | Mail Stop *Ex Parte* Reexam<br>Central Reexamination Unit<br>Commissioner for Patents<br>United States Patent & Trademark Office<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| By hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |



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Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

/LUKE S WASSUM/
Primary Examiner, Art Unit 3992

Conferees:

/ANGELA M LIE/
Primary Examiner, Art Unit 3992

/Michael Fuelling/
Supervisory Patent Examiner, AU 3992

lsw
17 May 2024

| *Office Action in Ex Parte Reexamination* | **Control No.** 90/015,287 | **Patent Under Reexamination** 10259470 | |
|---|---|---|---|
| | **Examiner** Luke S Wassum | **Art Unit** 3992 | **AIA (FITF) Status** Yes |

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

a. ☑ Responsive to the communication(s) filed on 15 April 2024.
   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

b. ☑ This action is made FINAL.

c. ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☑ Claims 1 and 4 are subject to reexamination.

1b. ☑ Claims 2-3 and 5-20 are not subject to reexamination.

2. ☐ Claims _____ have been canceled in the present reexamination proceeding.

3. ☐ Claims _____ are patentable and/or confirmed.

4. ☑ Claims 1 and 4 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ The drawings, filed on _____ are acceptable.

7. ☐ The proposed drawing correction, filed on _____ has been (7a) ☐ approved (7b) ☐ 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

   1 ☐ been received.

   2 ☐ not been received.

   3 ☐ been filed in Application No. _____.

   4 ☐ been filed in reexamination Control No. _____.

   5 ☐ been received by the International Bureau in PCT application No. _____.

   * See the attached detailed Office action for a list of the certified copies not received.

9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

10. ☐ Other: _____

cc: Requester (if third party requester)

| Reexamination | Application/Control No. | Applicant(s)/Patent Under Reexamination |
|---|---|---|
| | 90/015,287 | 10259470 |
| | Certificate Date | Certificate Number |

| Requester Correspondence Address: ☐ Patent Owner ☑ Third Party |
|---|
| UNIFIED PATENTS<br>4445 WILLARD AVENUE<br>SUITE 600<br>CHEVY CHASE, MD 20815 |

| LITIGATION REVIEW ☑ | lsw (examiner initials) | 03 May 2024 (date) |
|---|---|---|
| Case Name | | Director Initials |
| The Phelan Group LLC v. Kia Corporation et al. 2:23cv94 (closed) | | |
| Phelan Group LLC v. Toyota Motor Corporation et al. 2:23cv93 (closed) | | |

| COPENDING OFFICE PROCEEDINGS | |
|---|---|
| TYPE OF PROCEEDING | NUMBER |
| | |

| | |
|---|---|
| | |

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/015,287 | 08/31/2023 | 10259470 | PHE101 | 7777 |

64064 7590 05/15/2024

Ortiz & Lopez, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

| EXAMINER |
|---|
| WASSUM, LUKE S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3992 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/15/2024 | 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.

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

May 15, 2024

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

UNIFIED PATENTS, LLC
4445 WILLARD AVE.
SUITE 600
CHEVY CHASE, MD 20815

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90015287
PATENT NO. : 10259470
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484

For Patent Owner

UNIFIED PATENTS, LLC
4445 Willard Ave.
Suite 600
Chevy Chase, MD 20815

For 3rd Party Requester

*Ex Parte* Reexamination Proceeding: 90/015,287
Filed: August 31, 2023
For: U.S. Patent No. 10,259,470

**DECISION *SUA SPONTE* VACTING NOTICE OF INTENT TO ISSUE *EX PARTE* REXAMINATION CERTIFICATE**

The purpose of this communication is to inform the parties to this proceeding that the Notice of Intent to Issue *ex parte* Reexamination Certificate (NIRC) mailed May 14, 2024 is hereby vacated for the following reason:

A review of the record for this *ex parte* reexamination proceeding indicates that prior to the expiration of the shortened statutory period for response set forth in the February 15, 2024 non-final Office action, Patent Owner submitted a proper response to the non-final action on April 15, 2024, which although was timely filed, was not matched by the Office with file wrapper. Thus, Patent Owner's response was not considered by the Examiner and the NIRC mailed May 14, 2024 was prematurely issued.

Accordingly, the NIRC that was prematurely mailed on May 14, 2024, is hereby vacated and expunged from the record by being designated "closed" and "not public" in the Information File Wrapper (IFW). The NIRC will form no part of the record and will not be available to the public. This decision will be made of record in the reexamination file. The proceeding is being returned to the Examiner for consideration of April 15, 2024 response to the non-final Office action.

Any inquiry concerning this communication should be directed to Stephen Stein, Managing Quality Assurance Specialist of the Central Reexamination Unit, at telephone (571) 272-1544.

*/Stephen Stein/*
Stephen Stein
Managing Quality Assurance Specialist
Central Reexamination Unit

# Litigation Search Report CRU 3999

## Reexamination Control No. 90/015,287

| | | | |
|---|---|---|---|
| **To:** | WASSUM | **From:** | SALDANA |
| **Location:** | REM04C71 | **Location:** | REM04C71 |
| **Art Unit:** | 3992 | **Phone:** | 571-272-7740 |
| **Date:** | 03 May 2024 | **E-mail:** | MANUEL.SALDANA@USPTO.GOV |

## Search Notes

(CLOSED) 2:23cv94, The Phelan Group, Llc V. Kia Corporation Et Al

(CLOSED) 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

1. Performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
2. Performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
3. Performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
4. Performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
5. Performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

LexisNexis

**User Name:** Manuel Saldana
**Date and Time:** Friday, May 3, 2024 12:07:00PM EDT
**Job Number:** 223462754

## Document (1)

1. 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

**Client/Matter:** -None-
**Search Terms:** number(2:23CV93)
**Search Type:** Natural Language
**Narrowed by:**

| Content Type | Narrowed by |
| --- | --- |
| Dockets | Case Status: Open,Unknown,Closed |

# 2:23cv93, Phelan Group, Llc V. Toyota Motor Corporation Et Al

US District Court Docket

United States District Court, Texas Eastern

(Marshall)

**This case was retrieved on** 03/12/2024

## Header

**Case Number:** ***2:23cv93***
**Date Filed:** 03/07/2023
**Assigned To:** District Judge Rodney Gilstrap
**Referred To:** Magistrate Judge Roy S. Payne
**Nature of Suit:** Patent (830)
**Cause:** Patent Infringement
**Lead Docket:** None
**Other Docket:** None
**Jurisdiction:** Federal Question

**Class Code:** Closed
**Closed:** 11/21/2023
**Statute:** 35:271
**Jury Demand:** Both
**Demand Amount:** $0
**NOS Description:** Patent

## Participants

### Litigants

The Phelan Group, LLC
**Plaintiff**

### Attorneys

Adam G Price
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2632 Fax: 512-727-6691
Email:Aprice@dinovoprice.Com

Michael D. French
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2618 Fax: 512-727-6691
Email:Mfrench@dinovoprice.Com

Nicole E Glauser
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2638 Fax: 512-727-6691
Email:Nglauser@dinovoprice.Com

Andrew Gerald DiNovo
ATTORNEY TO BE NOTICED



Manuel Saldana

| Litigants | Attorneys |
|---|---|
| | DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2631 Fax: 512-727-6691<br>Email:Adinovo@dinovoprice.Com |
| Toyota Motor Corporation<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor North America, Inc. | Fadi N Kiblawi |



Mercedes EX1012
Page 310 of 1244

| Litigants | Attorneys |
|---|---|
| **Defendant** | ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor Engineering & Manufacturing North America, Inc.<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com |

| Litigants | Attorneys |
|---|---|
| | John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Jrabena@sughrue.Com<br><br>Michael Charles Smith<br>ATTORNEY TO BE NOTICED<br>Scheef & Stone, LLP - Marshall<br>P O Box 1556<br>Marshall, TX 75671-1556<br>USA<br>903-938-8900 Email:Michael.Smith@solidcounsel.Com<br><br>Tyler Del Rosario<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Tdelrosario@sughrue.Com<br><br>William H Mandir<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202-293-7060 Fax: 202-293-7860<br>Email:Wmandir@sughrue.Com<br><br>Yoshinari Kishimoto<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202/293-7060 Fax: 202/293-7860<br>Email:Ykishimoto@sughrue.Com |
| Toyota Motor Sales, U.S.A., Inc.<br>**Defendant** | Fadi N Kiblawi<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion, PLLC - DC<br>2000 Pennsylvania Avenue Nw<br>Washington, DC 20006<br>USA<br>202.293.7060 Fax: 202.293.7860<br>Email:Fkiblawi@sughrue.Com<br><br>John Frank Rabena<br>ATTORNEY TO BE NOTICED<br>Sughrue Mion PLLC - DC<br>2100 Pennsylvania Ave Nw Suite 800<br>Washington, DC 20037<br>USA |



Mercedes EX1012
Page 312 of 1244

## Litigants

## Attorneys

202-293-7060 Fax: 202-293-7860
Email:Jrabena@sughrue.Com

Michael Charles Smith
ATTORNEY TO BE NOTICED
Scheef & Stone, LLP - Marshall
P O Box 1556
Marshall, TX 75671-1556
USA
903-938-8900 Email:Michael.Smith@solidcounsel.Com

Tyler Del Rosario
ATTORNEY TO BE NOTICED
Sughrue Mion, PLLC - DC
2000 Pennsylvania Avenue Nw
Washington, DC 20006
USA
202-293-7060 Fax: 202-293-7860
Email:Tdelrosario@sughrue.Com

William H Mandir
ATTORNEY TO BE NOTICED
Sughrue Mion, PLLC - DC
2000 Pennsylvania Avenue Nw
Washington, DC 20006
USA
202-293-7060 Fax: 202-293-7860
Email:Wmandir@sughrue.Com

Yoshinari Kishimoto
ATTORNEY TO BE NOTICED
Sughrue Mion, PLLC - DC
2000 Pennsylvania Avenue Nw
Washington, DC 20006
USA
202/293-7060 Fax: 202/293-7860
Email:Ykishimoto@sughrue.Com

Kia Corporation
Consolidated from 2:23-cv-94 |
**Consol Defendant**

Cason Garrett Cole
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP
Tx 2501 N. Harwood St. 17th Floor
Dallas, TX 75201
USA
972-360-1916 Email:Ccole@omm.Com

Clarence Rowland
PRO HAC VICE;ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP - LA
400 South Hope Street 18th Floor
Los Angeles, CA 90071
USA
213.430.6000 Fax: 213.430.6407
Email:Crowland@omm.Com

Nicholas J Whilt
PRO HAC VICE;ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP - LA
400 South Hope Street 18th Floor
Los Angeles, CA 90071

| Litigants | Attorneys |
|---|---|
| | USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy , I<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>Consolidated from 2:23-cv-94 \|<br>**Consol Defendant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy , I<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>PRO HAC VICE;ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407 |



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| Litigants | Attorneys |
|---|---|
| Kia Corporation<br>Consolidated from 2:23-cv-94 \|<br>**Counter Claimant** | Email:Ryagura@omm.Com<br>Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy , I<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>Consolidated from 2:23-cv-94 \|<br>**Counter Claimant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com |

| Litigants | Attorneys |
|---|---|
| | Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com |
| | Paige Hardy , I<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com |
| | Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| The Phelan Group, LLC<br>**Counter Defendant** | Adam G Price<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2632 Fax: 512-727-6691<br>Email:Aprice@dinovoprice.Com |
| | Michael D. French<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2618 Fax: 512-727-6691<br>Email:Mfrench@dinovoprice.Com |
| | Nicole E Glauser<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2638 Fax: 512-727-6691<br>Email:Nglauser@dinovoprice.Com |
| | Andrew Gerald DiNovo<br>ATTORNEY TO BE NOTICED<br>DiNovo Price LLP<br>7000 N. Mopac Expressway Suite 350<br>Austin, TX 78731<br>USA<br>512-539-2631 Fax: 512-727-6691 |

## Litigants

## Attorneys

Email:Adinovo@dinovoprice.Com

## Proceedings

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 1 | 03/07/2023 | COMPLAINT against All Defendants ( Filing fee $ 402 receipt number ATXEDC-9388646.), filed by Phelan Group, LLC. (Attachments: # 1 Civil Cover Sheet, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6)(DiNovo, Andrew) (Entered: 03/07/2023) | |
| 2 | 03/07/2023 | DEMAND for Trial by Jury by Phelan Group, LLC. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 3 | 03/07/2023 | Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 4 | 03/07/2023 | NOTICE of Attorney Appearance by Nicole E Glauser on behalf of Phelan Group, LLC (Glauser, Nicole) (Entered: 03/07/2023) | |
| 5 | 03/07/2023 | NOTICE of Attorney Appearance by Adam G Price on behalf of Phelan Group, LLC (Price, Adam) (Entered: 03/07/2023) | |
| | 03/07/2023 | Case assigned to District Judge Rodney Gilstrap and Magistrate Judge Roy S. Payne. (ch, ) (Entered: 03/07/2023) | |
| | 03/07/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (ch, ) (Entered: 03/07/2023) | |
| 6 | 03/07/2023 | CORPORATE DISCLOSURE STATEMENT filed by Phelan Group, LLC (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 7 | 03/07/2023 | SUMMONS Issued as to Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Summons(es), # 2 Summons(es), # 3 Summons(es))(ch, ) (Entered: 03/07/2023) | |
| 8 | 03/09/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Sales, U.S.A., Inc. served on 3/9/2023, answer due 3/30/2023. (DiNovo, Andrew) (Entered: 03/09/2023) | |
| 9 | 03/10/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Engineering & Manufacturing North America, Inc. served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/10/2023) | |
| 10 | 03/10/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor North America, Inc. served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/10/2023) | |
| 11 | 03/15/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Toyota Motor Corporation served on 3/10/2023, answer due 3/31/2023. (DiNovo, Andrew) (Entered: 03/15/2023) | |
| 12 | 03/30/2023 | MOTION for Extension of Time to File Answer re 1 Complaint, by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Michael) (Entered: 03/30/2023) | |
| 13 | 03/31/2023 | ORDER granting 12 MOTION for Extension of Time to File | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Answer re 1 Complaint, . Signed by Magistrate Judge Roy S. Payne on 3/31/2023. (nkl, ) (Entered: 03/31/2023) | |
| 14 | 04/17/2023 | CONSOLIDATION ORDER - The above-captioned cases are hereby ORDERED to be CONSOLIDATED for all pretrial issues with the LEAD CASE, Case No. 2:23-cv-00093. All parties are instructed to file any future filings in the LEAD CASE. Signed by District Judge Rodney Gilstrap on 4/17/2023. (ch, ) (Entered: 04/18/2023) | |
| 15 | 04/19/2023 | ORDER - Scheduling/Case Management Conference set for 5/30/2023 01:30 PM before District Judge Rodney Gilstrap. Signed by Magistrate Judge Roy S. Payne on 4/19/2023. (ch, ) (Entered: 04/19/2023) | |
| 16 | 04/26/2023 | NOTICE of Attorney Appearance by Cason Garrett Cole on behalf of Kia America, Inc., Kia Corporation (Cole, Cason) (Entered: 04/26/2023) | |
| 17 | 04/27/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Paige Hardy, I on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9471658. (Hardy, Paige) (Entered: 04/27/2023) | |
| 18 | 05/02/2023 | Unopposed MOTION for Extension of Time to File Answer re 1 Complaint, and Waiver of Foreign Service Requirement by Kia America, Inc., Kia Corporation. (Attachments: # 1 Text of Proposed Order)(Yagura, Ryan) (Entered: 05/02/2023) | |
| 19 | 05/04/2023 | NOTICE of Attorney Appearance by John Frank Rabena on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc. (Rabena, John) (Entered: 05/04/2023) | |
| 20 | 05/04/2023 | ORDER granting 18 Motion for Extension of Time to Answer re 18 Unopposed MOTION for Extension of Time to File Answer re 1 Complaint, and Waiver of Foreign Service Requirement. Signed by Magistrate Judge Roy S. Payne on 5/4/2023. (ch, ) (Entered: 05/04/2023) | |
| | 05/04/2023 | Answer Due Deadline Updated for Kia America, Inc. to 6/14/2023; Kia Corporation to 6/14/2023. (ch, ) (Entered: 05/04/2023) | |
| 21 | 05/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Yoshinari Kishimoto on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9492507. (Kishimoto, Yoshinari) (Entered: 05/10/2023) | |
| 22 | 05/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Tyler Del Rosario on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9492561. (Del Rosario, Tyler) (Additional attachment(s) added on 5/10/2023: # 1 Sealed Attachment) (nkl, ). (Entered: 05/10/2023) | |
| 23 | 05/11/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by William H Mandir on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9495106. (Mandir, William) (Entered: 05/11/2023) | |
| 24 | 05/12/2023 | Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions) by The Phelan Group, LLC. (Attachments: # 1 Text of Proposed Order)(DiNovo, Andrew) (Entered: 05/12/2023) | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 25 | 05/15/2023 | NOTICE of Attorney Appearance by Michael D. French on behalf of The Phelan Group, LLC (French, Michael) (Entered: 05/15/2023) | |
| 26 | 05/15/2023 | ORDER granting 24 Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions). Signed by Magistrate Judge Roy S. Payne on 5/15/2023. (ch, ) (Entered: 05/16/2023) | |
| 27 | 05/16/2023 | AMENDED ORDER re 24 Joint MOTION for Extension of Time for Plaintiff to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions). Signed by Magistrate Judge Roy S. Payne on 5/16/2023. (ch, ) (Entered: 05/16/2023) | |
| 28 | 05/25/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Fadi N Kiblawi on behalf of Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. Filing fee $ 100, receipt number ATXEDC-9517691. (Kiblawi, Fadi) (Entered: 05/25/2023) | |
| | 05/30/2023 | Minute Entry for proceedings held before District Judge Rodney Gilstrap: Scheduling Conference/Case Management Conference held on 5/30/2023. Counsel for the parties appeared. Court asked whether they consented to trial before the U.S. Magistrate Judge. Court then gave counsel Claim Construction and Jury Selection/Trial dates. (Court Reporter Shawn McRoberts) (aeb) (Entered: 06/01/2023) | |
| 29 | 06/05/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Kia America, Inc., Kia Corporation (Yagura, Ryan) (Entered: 06/05/2023) | |
| 30 | 06/13/2023 | Joint MOTION for Entry of Agreed Proposed DCO by The Phelan Group, LLC. (Attachments: # 1 Exhibit A - Agreed Proposed DCO)(DiNovo, Andrew) (Entered: 06/13/2023) | |
| 31 | 06/13/2023 | Joint MOTION for Entry of Agreed Proposed Discovery Order by The Phelan Group, LLC. (Attachments: # 1 Exhibit A - Agreed Proposed DO)(DiNovo, Andrew) (Entered: 06/13/2023) | |
| 32 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Engineering & Manufacturing North America, Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 33 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Corporation (Smith, Michael) (Entered: 06/14/2023) | |
| 34 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor Sales, U.S.A., Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 35 | 06/14/2023 | Fed. R. Civ. P. 7.1(a)(1) Disclosure Statement filed by Toyota Motor North America, Inc. (Smith, Michael) (Entered: 06/14/2023) | |
| 36 | 06/14/2023 | DOCKET CONTROL ORDER- Markman Hearing set for 6/27/2024 09:00 AM before Magistrate Judge Roy S. Payne., Jury Selection set for 12/9/2024 09:00AM before District Judge Rodney Gilstrap., Pretrial Conference set for 11/5/2024 01:30 PM before Magistrate Judge Roy S. Payne.). Signed by Magistrate Judge Roy S. Payne on 06/14/2023. (klc, ) (Entered: 06/14/2023) | |
| 37 | 06/14/2023 | DISCOVERY ORDER re 31 Motion for Entry of Agreed Proposed Discovery Order. Signed by Magistrate Judge Roy S. Payne on 6/14/2023. (nkl, ) (Entered: 06/14/2023) | |
| 38 | 06/14/2023 | Kia Corporation and Kia America, Inc.'s ANSWER to 1 Complaint, Affirmative Defense, and, COUNTERCLAIM against The Phelan Group, LLC by Kia Corporation, Kia America, Inc..(Yagura, Ryan) (Entered: 06/14/2023) | |
| 39 | 06/14/2023 | ANSWER to 1 Complaint, by Toyota Motor Corporation, Toyota | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc..(Smith, Michael) (Entered: 06/14/2023) | |
| | 06/15/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 06/15/2023) | |
| | 06/15/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 06/15/2023) | |
| 40 | 06/16/2023 | Joint MOTION to Amend/Correct - Joint Motion to Amend the Docket Control Order to Provide Additional Time to File the Protective Order and to Serve Initial Disclosures by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 06/16/2023) | |
| 41 | 06/19/2023 | NOTICE by The Phelan Group, LLC Plaintiff's Notice of Compliance (DiNovo, Andrew) (Entered: 06/19/2023) | |
| 42 | 06/20/2023 | ORDER granting 40 Joint MOTION to Amend/Correct - Joint Motion to Amend the Docket Control Order to Provide Additional Time to File the Protective Order and to Serve Initial Disclosures. Signed by Magistrate Judge Roy S. Payne on 6/20/2023. (ch, ) (Entered: 06/20/2023) | |
| 43 | 06/26/2023 | Joint MOTION for Protective Order by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 44 | 06/26/2023 | NOTICE of Discovery Disclosure by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc. (Initial and Additional Disclosures) (Smith, Michael) (Entered: 06/26/2023) | |
| 45 | 06/26/2023 | Joint MOTION to Amend/Correct 36 Order,, Set Deadlines/Hearings, by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 46 | 06/26/2023 | Joint MOTION Focusing Patent Claims and Prior Art to Reduce Costs by Kia America, Inc., Kia Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 06/26/2023) | |
| 47 | 06/26/2023 | NOTICE by Kia America, Inc., Kia Corporation - Notice of Compliance Regarding Initial Disclosures (Yagura, Ryan) (Entered: 06/26/2023) | |
| 48 | 06/28/2023 | PROTECTIVE ORDER granting 43 Joint Motion for Protective | |

| # | Date | Proceeding Text | Source |
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| | | Order. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 49 | 06/28/2023 | SECOND AMENDED DOCKET CONTROL ORDER granting 45 Joint MOTION to Amend/Correct 36 Order,, Set Deadlines/Hearings. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 50 | 06/28/2023 | ORDER FOCUSING PATENT CLAIMS AND PRIOR ART TO REDUCE COSTS granting 46 Joint MOTION Focusing Patent Claims and Prior Art to Reduce Costs. Signed by Magistrate Judge Roy S. Payne on 6/28/2023. (ch, ) (Entered: 06/29/2023) | |
| 51 | 07/05/2023 | ANSWER to 38 Answer to Complaint, Counterclaim by The Phelan Group, LLC.(DiNovo, Andrew) (Entered: 07/05/2023) | |
| 52 | 07/27/2023 | Joint MOTION to Amend/Correct Joint Motion for Entry of Agreed Proposed Amended Docket Control Order by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 07/27/2023) | |
| 53 | 07/28/2023 | THIRD AMENDED DOCKET CONTROL ORDER granting 52 Joint MOTION to Amend/Correct Joint Motion for Entry of Agreed Proposed Amended Docket Control Order. Signed by Magistrate Judge Roy S. Payne on 7/28/2023. (ch, ) (Entered: 07/28/2023) | |
| 54 | 08/18/2023 | Joint MOTION to Stay All Deadlines and Notice of Settlement in Principle by The Phelan Group, LLC. (Attachments: # 1 Proposed Order Staying Case Deadlines)(DiNovo, Andrew) (Entered: 08/18/2023) | |
| 55 | 08/23/2023 | ORDER granting 54 Motion to Stay All Deadlines and Notice of Settlement in Principle. Signed by Magistrate Judge Roy S. Payne on 8/22/2023. (nkl, ) (Entered: 08/23/2023) | |
| 56 | 08/31/2023 | Agreed MOTION for Entry of Fourth Amended Scheduling Order by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 08/31/2023) | |
| 57 | 09/09/2023 | JOINT MOTION to Stay All Deadlines and Notice of Settlement by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 09/09/2023) | |
| 58 | 09/11/2023 | ORDER granting 57 Motion to Stay all Deadlines and Notice of Settlement. Signed by Magistrate Judge Roy S. Payne on 9/10/2023. (nkl, ) (Entered: 09/11/2023) | |
| 59 | 09/20/2023 | JOINT MOTION to Continue the Stay of All Deadlines Pending Settlement by Kia America, Inc., Kia Corporation. (Attachments: # 1 Proposed Order)(Yagura, Ryan) (Entered: 09/20/2023) | |
| 60 | 09/23/2023 | ORDER granting 59 JOINT MOTION to Continue the Stay of All Deadlines Pending Settlement. ORDERED that all pending deadlines in Case No. 2:23-cv-00094-JRG-RSP are stayed for thirty (30) days from the date of this Order. Signed by Magistrate Judge Roy S. Payne on 9/23/2023. (ch, ) (Entered: 09/25/2023) | |
| 61 | 10/11/2023 | JOINT MOTION to Stay of All Deadlines Pending Settlement by Toyota Motor Corporation, Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor North America, Inc., Toyota Motor Sales, U.S.A., Inc.. (Attachments: # 1 Proposed Order)(Smith, Michael) (Entered: 10/11/2023) | |
| 62 | 10/13/2023 | ORDER granting 61 JOINT MOTION to Stay of All Deadlines Pending Settlement. Signed by Magistrate Judge Roy S. Payne on 10/13/2023. (ch, ) (Entered: 10/16/2023) | |
| 63 | 10/23/2023 | JOINT MOTION to Continue Stay Pending Settlement by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(DiNovo, | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | Andrew) (Entered: 10/23/2023) | |
| 64 | 10/24/2023 | ORDER granting 63 JOINT MOTION to Continue Stay Pending Settlement. Signed by Magistrate Judge Roy S. Payne on 10/24/2023. (ch, ) (Entered: 10/24/2023) | |
| 65 | 11/06/2023 | STIPULATION of Dismissal with Prejudice by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(DiNovo, Andrew) (Entered: 11/06/2023) | |
| 66 | 11/14/2023 | STIPULATION of Dismissal by The Phelan Group, LLC. (Attachments: # 1 Proposed Order)(Glauser, Nicole) (Entered: 11/14/2023) | |
| 67 | 11/21/2023 | ORDER. The Court ACCEPTS AND ACKNOWLEDGES that all claims and causes of action asserted between Plaintiff The Phelan Group and Defendant Toyota in lead case 2:23-cv-0093 are DISMISSED WITH PREJUDICE. Each party is to bear its own costs, expenses, and attorneys' fees. All pending requests for relief not explicitly granted herein are DENIED AS MOOT. The Clerk of Court is directed to CLOSE cases 2:23-cv-00093 and 2:23-cv-00094 as no parties or claims remain. Signed by District Judge Rodney Gilstrap on 11/21/2023. (slo) (Entered: 11/22/2023) | |

## Patents

| Number | Title | Issued | Class | Subclass |
|---|---|---|---|---|
| 8,417,415 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/09/2013 | 701 | 29.2 |
| 8,958,929 | Vehicle control apparatus | 02/17/2015 | 701 | 2 |
| 9,045,101 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/02/2015 | 1 | 1 |
| 9,440,660 | Method for remote communication with and through a vehicle | 09/13/2016 | 1 | 1 |
| 9,493,149 | Driver authentication system and method for monitoring and controlling vehicle usage | 11/15/2016 | 1 | 1 |
| 9,908,508 | Driver authentication system and method for monitoring and controlling vehicle usage | 03/06/2018 | 1 | 1 |
| 10,259,465 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,259,470 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,414,275 | Instrument cluster arrangements for vehicles | 09/17/2019 | 1 | 1 |
| 10,493,957 | Operational mode change based on vehicle occupancy for an autonomous vehicle | 12/03/2019 | 1 | 1 |
| 10,860,025 | Modeling graph of interactions between agents | 12/08/2020 | 1 | 1 |
| 11,352,020 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/07/2022 | 1 | 1 |

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**IN THE UNITED STATES DISTRICT COURT**
**FOR THE EASTERN DISTRICT OF TEXAS**
**MARSHALL DIVISION**

THE PHELAN GROUP, LLC,

*Plaintiff*,

v.

TOYOTA MOTOR CORPORATION, ET AL.,

*Defendants*.

Case No. 2:23-cv-0093-JRG-RSP (Lead case)

Case No. 2:23-cv-0094-JRG-RSP (Member case)

**Jury Trial Requested**

THE PHELAN GROUP, LLC,

*Plaintiff*,

v.

KIA CORPORATION and KIA AMERICA, INC.

*Defendants*.

**KIA CORPORATION AND KIA AMERICA, INC.'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS TO THE PHELAN GROUP, LLC'S COMPLAINT FOR PATENT INFRINGEMENT**

Defendants Kia Corporation ("Kia Corp.") and Kia America, Inc. ("Kia America") (collectively, "Kia"), by and through the undersigned attorneys, for their Answer, Affirmative Defenses, and Counterclaims to Plaintiff The Phelan Group, LLC's ("Phelan") Original Complaint filed on March 7, 2023 ("Complaint"), admit and deny as follows. Except as hereinafter specifically admitted, qualified, or affirmatively alleged, Kia denies each and every allegation, matter, or thing contained in the Complaint and states in response to each of the numbered paragraphs of said Complaint as follows:

## I. NATURE OF THE ACTION

1. Kia admits that Phelan's Complaint purports to make claims under the patent laws of the United States, Title 35 of the United States Code. Kia specifically denies that it has committed or is committing any act of patent infringement. Except as expressly admitted, Kia denies each and every allegation in Paragraph 1.

2. Kia denies each and every allegation in Paragraph 2, and specifically denies that it has committed or is committing any act of patent infringement.

3. Kia admits that Phelan's Complaint purports to seek past and future damages and prejudgment and post-judgment interest. Kia specifically denies that it has committed or is committing any act of patent infringement. Except as expressly admitted, Kia denies each and every allegation in Paragraph 3.

## II. PARTIES

4. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 4, and on that basis denies them.

5. Kia admits that Kia Corp. is a corporation organized under the laws of the Republic of Korea. Kia admits that Kia Corp.'s principal place of business is at 12 Heolleung-ro, Seocho-gu, Seoul, 06797, Republic of Korea. Except as expressly admitted, Kia denies each and every allegation in Paragraph 5.

6. Kia denies each and every allegation in Paragraph 6.

7. Kia admits that Kia America is incorporated under the laws of California, and has a place of business at 5810 Tennyson Parkway, Plano, Texas 75024. Kia admits that Kia America may be served through its registered agent CT Corporation System, 1999 Bryan St., Ste. 900, Dallas, TX 75201. Kia admits that Kia America is registered to do business in the State of

Texas and has been since at least May 26, 1994. Except as expressly admitted, Kia denies each and every allegation in Paragraph 7.

8. Kia admits that Kia America is a wholly-owned subsidiary of Kia Corp. Except as expressly admitted, Kia denies each and every allegation in Paragraph 8.

9. Kia denies each and every allegation in Paragraph 9, and specifically denies that it has committed or is committing any act of patent infringement.

## III. JURISDICTION AND VENUE

10. To the extent a response is required, Kia admits that Phelan's complaint purports to make claims arising under the patent laws of the United States, Title 35 of the United States Code. Kia admits, for purposes of this action only, that this Court has subject matter jurisdiction over Phelan's claims made pursuant to 28 U.S.C. §§ 1331 and 1338(a). Except as expressly admitted, Kia denies each and every allegation in Paragraph 10, and specifically denies that it has committed or is committing any act of patent infringement.

11. Kia admits, for purposes of this action only, that this Court has specific personal jurisdiction over Kia Corp. Except as expressly admitted, Kia denies each and every allegation in Paragraph 11, and specifically denies that it has committed or is committing any act of patent infringement.

12. Kia admits, for purposes of this action only, that this Court has specific personal jurisdiction over Kia America. Except as expressly admitted, Kia denies each and every allegation in Paragraph 12, and specifically denies that it has committed or is committing any act of patent infringement.

13. Kia admits, for purposes of this action only, that this Court has specific personal jurisdiction over Kia. Except as expressly admitted, Kia denies each and every allegation in

Paragraph 13, and specifically denies that it has committed or is committing any act of patent infringement.

14. Kia America, Inc. admits that it distributes, offers for sale, sells, and advertises certain vehicles and components and affiliated services thereof in the State of Texas and the Eastern District of Texas. Except as expressly admitted, Kia denies each and every allegation in Paragraph 14, and specifically denies that it has committed or is committing any act of patent infringement.

15. Kia denies each and every allegation in Paragraph 15, and specifically denies that it has committed or is committing any act of patent infringement.

16. Kia America, Inc. admits that it transacts business in the State of Texas and in the Eastern District of Texas. Except as expressly admitted, Kia denies each and every allegation in Paragraph 16.

17. Kia denies each and every allegation in Paragraph 17, and specifically denies that it has committed or is committing any act of patent infringement.

18. Kia denies each and every allegation in Paragraph 18, and specifically denies that it has committed or is committing any act of patent infringement.

19. Kia admits, for purposes of this action only, that venue is proper in the Eastern District of Texas under 28 U.S.C. § 1400(b), although Kia expressly reserves the right to contest whether the Eastern District of Texas is a convenient forum under, among others, the doctrine of *forum non conveniens* and 28 U.S.C. § 1404. Except as expressly admitted, Kia denies each and every allegation set forth in Paragraph 19, and specifically denies that it has committed or is committing any act of patent infringement.

## IV. BACKGROUND

PATENTS-IN-SUIT

20. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 20, and on that basis denies them.

21. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 21, and on that basis denies them.

22. Kia admits that what purports to be a copy of U.S. Patent No. 9,405,101 ("the '101 Patent") was attached to the Complaint as Exhibit 1. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 22, and on that basis denies them.

23. Kia admits that what purports to be a copy of U.S. Patent No. 9,493,149 ("the '149 Patent") was attached to the Complaint as Exhibit 2. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 23, and on that basis denies them.

24. Kia admits that what purports to be a copy of U.S. Patent No. 9,908,508 ("the '508 Patent") was attached to the Complaint as Exhibit 3. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 24, and on that basis denies them.

25. Kia admits that what purports to be a copy of U.S. Patent No. 10,259,465 ("the '465 Patent") was attached to the Complaint as Exhibit 4. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 25, and on that basis denies them.

26. Kia admits that what purports to be a copy of U.S. Patent No. 10,259,470 ("the '470 Patent") was attached to the Complaint as Exhibit 5. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 26, and on that basis denies them.

27. Kia admits that what purports to be a copy of U.S. Patent No. 11,352,020 ("the '020 Patent") was attached to the Complaint as Exhibit 6. Except as expressly admitted, Kia is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 27, and on that basis denies them.

28. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 28, and on that basis denies them.

DEFENDANTS' ACTS

29. Kia admits that it makes, uses, sells, offers for sale, distributes, and/or imports vehicles and components of vehicles. Kia admits that some of its vehicles include or are compatible with functionality called Kia Drive Wise and Kia Connect (formerly UVO), including at least some trims of the 2023 Kia Niro. Except as expressly admitted, Kia denies each and every allegation of Paragraph 29, and specifically denies that it has committed or is committing any act of patent infringement.

30. Kia denies each and every allegation in Paragraph 30, and specifically denies that it has committed or is committing any act of patent infringement.

31. Kia admits that 2023 Kia Niro trims that include or are compatible with Kia Drive Wise and Kia Connect include various technologies related to accident protection and collisions, and may collect information related to the vehicle. Except as expressly admitted, Kia denies

each and every allegation of Paragraph 31, and specifically denies that it has committed or is committing any act of patent infringement.

32. Kia denies each and every allegation of Paragraph 32, and specifically denies that it has committed or is committing any act of patent infringement.

33. Kia denies each and every allegation in Paragraph 33.

34. Kia admits that the Digital Key 2 Touch technology, which is included in or compatible with some 2023 Kia Niro trims, allows a user to unlock, lock, or start some Kia vehicles. Except as expressly admitted, Kia denies each and every allegation of Paragraph 34.

35. Kia denies each and every allegation in Paragraph 35.

36. Kia denies each and every allegation in Paragraph 36.

37. Kia denies each and every allegation in Paragraph 37.

38. Kia admits that Kia Drive Wise technology can, in some trims and in some vehicles, include various advanced driver assistance systems (ADAS) such as Auto Emergency Braking Technology (Forward Collision Warning & Forward Collision-Avoidance Assist), Blind-Spot Collision-Avoidance Assist & Blind-Spot Collision Warning, Rear Cross-Traffic Warning and Avoidance Technology (Rear Cross-Traffic Collision-Avoidance Assist), Smart Cruise Control w/Stop & Go, Parking Collision-Avoidance Assist-Reverse, Pre-Collison System with Pedestrian Detection, Dynamic Radar Cruise Control or Full-Speed Range Dynamic Radar Cruise Control, Lane Departure Alert with Steering Assist, Road Sign Assist, and/or Lane Keeping Assist. Except as expressly admitted, Kia denies each and every allegation of Paragraph 38.

39. Kia admits that the Auto Emergency Braking Technology w/ Pedestrian, Cyclist & Junction Turning Technology (Forward Collision Warning & Forward Collision-Avoidance

Assist) technology can "detect potential collisions and apply the brakes." Kia admits that the Blind-Spot Collision-Avoidance Assist & Blind-Spot Collision Warning can detect "objects in your blind spot, giving the driver visual and/or audible signals to help warn of detected objects outside the driver's field of view" and "[i]f the system determines that the driver is trying to change lanes while an object is detected, it will help maintain the previous course by helping the vehicle return to its lane." Kia admits that Rear Cross-Traffic Warning and Avoidance Technology (Rear Cross-Traffic Collision-Avoidance Assist) can "warn you if it detects vehicle cross traffic" and "[i]f detected and necessary, the system will also automatically apply the brakes…." Kia admits that Smart Cruise Control w/ Stop & Go can "maintain a predetermined following distance from the detected vehicle in front, adjusting driving speed as needed and can bring the vehicle to a complete stop and start again within 3 seconds of stopping." Kia admits that Parking Collision-Avoidance Assist-Reverse can "[w]hen reversing, if the system detects certain objects behind the vehicle, it will issue audible and visual warnings" and "[i]f the system detects an object getting extremely close, the vehicle will apply brakes automatically, potentially avoiding a collision." Except as expressly admitted, Kia denies each and every allegation of Paragraph 39.

40. Kia admits that, as discussed in the privacy policy cited by Plaintiff, Kia sometimes may collect information from vehicles equipped with or compatible with Kia Drive Wise and Kia Connect, including speed and location information. Except as expressly admitted, Kia specifically denies each and every allegation in Paragraph 40, and specifically denies that it has committed or is committing any act of patent infringement.

41. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 41, and on that basis denies them. Kia specifically denies that it has

committed or is committing any act of patent infringement. Kia denies each and every remaining allegation of Paragraph 41.

42. Kia admits that in some circumstances, Kia may enter into agreements with its customers that preclude the unauthorized reproduction, distribution, and modification of its software.

43. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 43, and on that basis denies them.

44. To the extent a response is required, Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 44, and on that basis denies them.

## V. COUNTS OF ALLEGED PATENT INFRINGEMENT

### COUNT ONE
### ALLEGED INFRINGEMENT OF U.S. PATENT NO. 9,045,101

45. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 44 as if specifically set forth herein.

46. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 46, and on that basis denies them.

47. Kia denies each and every allegation in Paragraph 47, and specifically denies that it has committed or is committing any act of patent infringement.

48. Kia America, Inc. admits it was made aware of the '101 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 48, and specifically denies that it has committed or is committing any act of patent infringement.

49. Kia denies each and every allegation in Paragraph 49, and specifically denies that it has committed or is committing any act of patent infringement.

50. Kia denies each and every allegation in Paragraph 50, and specifically denies that it has committed or is committing any act of patent infringement.

51. Kia denies each and every allegation in Paragraph 51, and specifically denies that it has committed or is committing any act of patent infringement.

52. Kia denies each and every allegation in Paragraph 52, and specifically denies that it has committed or is committing any act of patent infringement.

53. Kia denies each and every allegation in Paragraph 53, and specifically denies that it has committed or is committing any act of patent infringement.

COUNT TWO
ALLEGED INFRINGEMENT OF U.S. PATENT NO. 9,493,149

54. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 53 as if specifically set forth herein.

55. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 55, and on that basis denies them.

56. Kia denies each and every allegation in Paragraph 56, and specifically denies that it has committed or is committing any act of patent infringement.

57. Kia America, Inc. admits it was made aware of the '149 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 57, and specifically denies that it has committed or is committing any act of patent infringement.

58. Kia denies each and every allegation in Paragraph 58, and specifically denies that it has committed or is committing any act of patent infringement.

59. Kia denies each and every allegation in Paragraph 59, and specifically denies that it has committed or is committing any act of patent infringement.

60. Kia denies each and every allegation in Paragraph 60, and specifically denies that it has committed or is committing any act of patent infringement.

61. Kia denies each and every allegation in Paragraph 61, and specifically denies that it has committed or is committing any act of patent infringement.

62. Kia denies each and every allegation in Paragraph 62, and specifically denies that it has committed or is committing any act of patent infringement.

COUNT THREE
ALLEGED INFRINGEMENT OF U.S. PATENT NO. 9,908,508

63. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 62 as if specifically set forth herein.

64. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 64, and on that basis denies them.

65. Kia denies each and every allegation in Paragraph 65, and specifically denies that it has committed or is committing any act of patent infringement.

66. Kia America, Inc. admits it was made aware of the '508 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 66, and specifically denies that it has committed or is committing any act of patent infringement.

67. Kia denies each and every allegation in Paragraph 67, and specifically denies that it has committed or is committing any act of patent infringement.

68. Kia denies each and every allegation in Paragraph 68, and specifically denies that it has committed or is committing any act of patent infringement.

69. Kia denies each and every allegation in Paragraph 69, and specifically denies that it has committed or is committing any act of patent infringement.

70. Kia denies each and every allegation in Paragraph 70, and specifically denies that it has committed or is committing any act of patent infringement.

71. Kia denies each and every allegation in Paragraph 71, and specifically denies that it has committed or is committing any act of patent infringement.

COUNT FOUR
ALLEGED INFRINGEMENT OF U.S. PATENT NO. 10,259,465

72. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 71 as if specifically set forth herein.

73. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 73, and on that basis denies them.

74. Kia denies each and every allegation in Paragraph 74, and specifically denies that it has committed or is committing any act of patent infringement.

75. Kia America, Inc. admits it was made aware of the '465 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 75, and specifically denies that it has committed or is committing any act of patent infringement.

76. Kia denies each and every allegation in Paragraph 76, and specifically denies that it has committed or is committing any act of patent infringement.

77. Kia denies each and every allegation in Paragraph 77, and specifically denies that it has committed or is committing any act of patent infringement.

78. Kia denies each and every allegation in Paragraph 78, and specifically denies that it has committed or is committing any act of patent infringement.

79. Kia denies each and every allegation in Paragraph 79, and specifically denies that it has committed or is committing any act of patent infringement.

80. Kia denies each and every allegation in Paragraph 80, and specifically denies that it has committed or is committing any act of patent infringement.

COUNT FIVE
ALLEGED INFRINGEMENT OF U.S. PATENT NO. 10,259,470

81. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 80 as if specifically set forth herein.

82. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 82, and on that basis denies them.

83. Kia denies each and every allegation in Paragraph 83, and specifically denies that it has committed or is committing any act of patent infringement.

84. Kia America, Inc. admits it was made aware of the '470 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 84, and specifically denies that it has committed or is committing any act of patent infringement.

85. Kia denies each and every allegation in Paragraph 85, and specifically denies that it has committed or is committing any act of patent infringement.

86. Kia denies each and every allegation in Paragraph 86, and specifically denies that it has committed or is committing any act of patent infringement.

87. Kia denies each and every allegation in Paragraph 87, and specifically denies that it has committed or is committing any act of patent infringement.

88. Kia denies each and every allegation in Paragraph 88, and specifically denies that it has committed or is committing any act of patent infringement.

89. Kia denies each and every allegation in Paragraph 89, and specifically denies that it has committed or is committing any act of patent infringement.

COUNT SIX
ALLEGED INFRINGEMENT OF U.S. PATENT NO. 11,352,020

90. Kia incorporates by reference its responses to Phelan's allegations in Paragraphs 1 through 89 as if specifically set forth herein.

91. Kia is without information sufficient to form a belief as to the truth of the allegations of Paragraph 91, and on that basis denies them.

92. Kia denies each and every allegation in Paragraph 92, and specifically denies that it has committed or is committing any act of patent infringement.

93. Kia America, Inc. admits it was made aware of the '020 Patent by the date the Complaint was served on Kia America, Inc. Kia denies each and every remaining allegation of Paragraph 93, and specifically denies that it has committed or is committing any act of patent infringement.

94. Kia denies each and every allegation in Paragraph 94, and specifically denies that it has committed or is committing any act of patent infringement.

95. Kia denies each and every allegation in Paragraph 95, and specifically denies that it has committed or is committing any act of patent infringement.

96. Kia denies each and every allegation in Paragraph 96, and specifically denies that it has committed or is committing any act of patent infringement.

97. Kia denies each and every allegation in Paragraph 97, and specifically denies that it has committed or is committing any act of patent infringement.

98. Kia denies each and every allegation in Paragraph 98, and specifically denies that it has committed or is committing any act of patent infringement.

**IV. JURY DEMAND**

99. To the extent a response is required, Kia admits that Phelan's Complaint contains a request for a jury trial.

## VII. PRAYER FOR RELIEF

100. To the extent a response is required, Kia denies that Phelan is entitled to any of its requested relief. Kia specifically denies that it, directly or indirectly, literally or under the doctrine of equivalents, has infringed or is infringing U.S. Patent Nos. 9.045,101, 9,493,149, 9,908,508, 10,259,465, 10,259,470, and 11,352,020 willfully or otherwise; specifically denies that Phelan is entitled to any award of damages; specifically denies that Phelan is entitled to attorneys' fees; and specifically denies that Phelan is entitled to costs, prejudgment or post-judgment interest, treble damages, or any other relief in this action.

## GENERAL DENIAL

101. To the extent that any allegations of the Complaint are not specifically admitted, Kia hereby denies them.

## AFFIRMATIVE DEFENSES

102. Without admitting or acknowledging that Kia bears the burden of proof as to any of them and reserving the right to amend its answer as additional information becomes available, Kia pleads the following defenses:

## FIRST DEFENSE

103. Kia has not engaged in any acts that would constitute direct or indirect infringement of any valid claim of the '101, '149, '508, '465, '470, or '020 Patents, either literally or under the doctrine of equivalents, willfully or otherwise.

**SECOND DEFENSE**

104. The '101, '149, '508, '465, '470, and '020 Patents are invalid for failure to satisfy the conditions of patentability set forth in 35 U.S.C. §§ 101 *et seq.*, including at least sections 101, 102, 103, and 112.

**THIRD DEFENSE**

105. Phelan is barred or limited from recovery in whole or in part by the doctrine of prosecution history estoppel.

**FOURTH DEFENSE**

106. Phelan is barred or limited from recovery in whole or in part by the doctrines of estoppel, waiver, acquiescence, patent misuse, and/or unclean hands.

**FIFTH DEFENSE**

107. Phelan's right to seek damages is limited by statute because it may not recover money damages for any alleged infringement committed more than six years prior to the filing of its Complaint under of 35 U.S.C. § 286.

**SIXTH DEFENSE**

108. Phelan's claims for relief are limited to the extent that any allegedly infringing products or components thereof are supplied, directly or indirectly, to Kia or are imported, sold by, offered for sale by, made by, or made for, any entity or entities having express or implied licenses to one or more of the '101, '149, '508, '465, '470, and '020 Patents, and/or under the doctrines of exhaustion, first sale, or full compensation.

**SEVENTH DEFENSE**

109. To the extent that Phelan's claims are directed to acts occurring outside the United States, those claims for relief are barred or limited by the doctrine of territoriality by 35 U.S.C. § 271 et seq., including but not limited to § 271(a) and (c).

**EIGHTH DEFENSE**

110. Phelan is not entitled to recover attorneys' fees associated with this action under 35 U.S.C. § 285 or costs associated with this action under 35 U.S.C. § 288.

**NINTH DEFENSE**

111. Phelan has failed to state a claim upon which relief can be granted.

**TENTH DEFENSE**

112. Phelan is barred in whole or in part from recovering damages by a failure by the owner and/or licensee of the Patents-in-Suit to mark relevant products as required by 35 U.S.C. § 287.

**ELEVENTH DEFENSE**

113. To the extent that Phelan lacks all substantive rights to bring suit and to exclude others from practicing the claims of one or more of the '101, '149, '508, '465, '470, and '020 Patents, Plaintiff's claims are barred by a lack of standing.

**TWELFTH DEFENSE**

114. All of the asserted Phelan patents are unenforceable because of inequitable conduct. Under, at least, Title 37 of the Code of Federal Regulations ("CFR") § 1.56, the Manual for Patent Examination Procedure ("MPEP") § 2000.01, et seq., and generally principles of equity, a patentee and each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith before the United States Patent and Trademark

Office ("PTO"), which requires him or her to disclose to the PTO all information that is material to the patentability of the application under examination. Breach of this duty of candor, good faith and honesty with intent to deceive the PTO constitutes inequitable conduct so as to render the affected patents unenforceable.

115. At all times between the filing of the provisional application to which all of the Patents-in-Suit claim priority and the respective issue dates of the Patents-in-Suit, Phelan (including specific as-yet unidentified persons responsible for the prosecution of those patents, herein included in the definition of "Phelan") and the prosecuting attorneys owed a duty of candor to the Patent Office that required each one of them to notify the Patent Office of all prior art references material to the patentability of the then-pending patent applications.

116. During prosecution of the Patents-in-Suit, the named inventor, Phelan, failed to disclose known highly material prior art that would have prevented at least one of the independent claims of the asserted patents from being allowed by the U.S. Patent Office.

117. Phelan's failure to disclose the highly material prior art was done with the specific intent of deceiving the PTO. Phelan's conduct violated the duty of candor, good faith and honesty owed by patent applicants.

118. The known highly material prior art includes at least the New Mexico State University Annual Report for "2005-2006: Highlights of the Year College of Engineering," the February 4, 2007 article from the Albuquerque Business First entitled "Remote device will help parents and monitor teenage drivers," the March 26, 2006 article from the Albuquerque Business First entitled "PaceIgnitions' device puts computer brakes on teens," the March 11, 2007 entitled Symposium presenters realize many paths to their goals," and the 2006 PaceIgnitions website describing "The Governor" system as a smart ignition system.

119. These references describe features relevant to the Patents-in-Suit, including allowing customization of the vehicle's speed maximum speed performance to correspond to each of driver's needs.

120. The references teach that each of the car's drivers will have a unique PIN code and a corresponding maximum allowable speed that can be programmed.

121. The references also teach an Electronic Control Unit as well as an Engine Control Module that is controlled by the Electronic Control Unit to the maximum allowable speed of operation of the particular driver.

122. Each of these prior art publications also disclose shutting-off the vehicle's radio if a driver violates his or her profile. *See, e.g.*, "Remote device will help parents and monitor teenage drivers" at 1–2 ("If it's past curfew, a teenager won't even be able to start the car. The device will also record all teen driving habits for parents to review on home computers. If a teen drives too fast, fails to use seatbelts or drives beyond a specified area the device will sound an alarm, dome lights will flash and the radio will turn off until the behavior ceases.").

123. These prior art references were known to Phelan and render at least one independent claim of each of the asserted patents unpatentable, like, for example, Claim 1 of the '101 Patent, which claims a unit that is configured to "generate at least one of an alarm signal if said at least one driver violates said operating profile unique to said at least one driver thereby providing feedback about said vehicle usage and govern mechanical operations of said vehicle remotely thereby maintaining occupant safety."

124. It is abundantly clear that Phelan knew about these references and the material contained within them at least during the prosecution of each of the Patents-in-Suit; Phelan was quoted in the New Mexico State University report, and PaceIgnitions was a New Mexico

corporation that listed Phelan as its registered agent. Additionally, the "Remote device will help parents and monitor teenage drivers" and "PaceIgnitions' device puts computer brakes on teens" articles contain substantial interview material with Phelan.

125. Phelan and/or others involved in the prosecution of the Patents-in-Suit knew or reasonably should have known about the above-mentioned undisclosed information and that it would have been material to the PTO in deciding whether to allow the claims. The failure to disclose the information was therefore made with the intent to deceive the USPTO and is a violation of the duty of disclosure under 37 C.F.R. § 1.56.

126. The publications referenced in paragraph 118 were all filed or published more than one year before the filing of the Patents-in-Suit.

127. Because the patents and publications referenced in paragraph 118 disclose many of the central features claimed by the Patents-in-Suit, they would have been material to the PTO in deciding whether to allow Phelan's then-pending claims. But for Phelan's failure to satisfy the duty of disclosure by omitting these highly material prior art references, at least one independent claim of each of the asserted patents would have not issued.

128. Phelan intentionally withheld these prior art references from the Examiner in order to obtain issuance of at least one independent claim of each of the asserted patents.

129. Accordingly, the Patents-in-Suit are unenforceable for inequitable conduct due to the intentional failure to disclose, with an intent to deceive, any of the references listed in paragraph 115 to the PTO.

130. Kia's investigation is ongoing. Kia reserves the right to seek leave to amend their Answer to include additional facts or bases of inequitable conduct as they become known.

**THIRTEENTH DEFENSE**

131. All of the asserted patents in Phelan's Complaint are unenforceable because of infectious unenforceability. Phelan committed inequitable conduct in connection with its U.S. Patent No. 8,417,415 (the "'415 Patent"), on which all of the asserted patents claim a domestic priority benefit. Phelan committed inequitable conduct with respect to the '415 Patent by intentionally failing to disclose highly material prior art known to Phelan, and that would have prevented the '415 Patent from being allowed by the U.S. Patent Office.

132. At all times between the filing of the provisional application underlying the '415 Patent and the respective issue dates of the Patents-in-Suit, Phelan (including specific as-yet unidentified persons responsible for the prosecution of those patents, herein included in the definition of "Phelan") and the prosecuting attorneys owed a duty of candor to the Patent Office that required each one of them to notify the Patent Office of all prior art references material to the patentability of the then-pending patent applications.

133. The known highly material prior art includes at least the New Mexico State University Annual Report for "2005-2006: Highlights of the Year College of Engineering," the February 4, 2007 article from the Albuquerque Business First entitled "Remote device will help parents and monitor teenage drivers," and the March 26, 2006 article from the Albuquerque Business First entitled "PaceIgnitions' device puts computer brakes on teens."

134. Each of these prior art publications were known to Phelan and disclose shutting-off the vehicle's radio if a driver violates his or her profile. As previously discussed, it is clear that Phelan knew about the references, and the relevant material within them, because of his role, either 1) being quoted in the material or 2) being the registered agent of the corporation that published the material.

135. During prosecution of the application for the '415 Patent, Phelan filed an Amendment on August 3, 2012, that amended the claims to include the feature of shutting-off the vehicle's radio if the driver's profile is violated. Phelan made this amendment to the claims in order to obtain issuance of the '415 Patent.

136. The Examiner believed that no prior art of record uncovered during the prosecution of the '415 Patent taught the claimed feature of shutting of the vehicle's radio in response to a profile violation, and therefore, in an Office Action dated October 3, 2012, the Examiner allowed those claims including the feature of shutting-off the vehicle's radio in response to a profile violation. But, the Examiner continued to reject any claim that did not include this claimed radio shut-off feature.

137. On December 10, 2012, Phelan canceled those rejected claims; that is, those claims that did not include the radio shut-off feature in order to obtain allowance of the '415 Patent. But for Phelan's failure to meet its duty to disclose these known and highly material prior art references to the Examiner during the prosecution of the application for '415 Patent, the '415 Patent would not have been granted.

138. Phelan intentionally misled the Examiner into allowing the application for the '415 Patent by withholding known prior art that Phelan knew would have prevented the U.S. Patent Office from issuing the '415 Patent. Since each of the asserted patents claims benefit to the '415 Patent, and since Phelan committed inequitable conduct during prosecution of the '415 Patent, the '415 Patent as well as all of the asserted patents are unenforceable.

139. The inequitable conduct that occurred during prosecution of the '415 Patent has an immediate and necessary relation to the enforcement of the Patents-in-Suit.

140. For example, the '415 Patent claims are directed to the same subject matter as the Patents-in-Suit. The '415 Patent is a continuation of provisional application 61/077,568; all of the Patents-in-Suit claim priority to this provisional application and incorporate it by reference. There is significant overlap between the '415 Patent and the Patents-in-Suit. For example, the '415 Patent and the asserted '101 Patent contain an identical specification. Each of the patents relies on the same disclosed subject matter for written description support for its claims.

141. The inequitable conduct Phelan undertook relates to the asserted claims of the Patents-in-Suit. Phelan intentionally failed to disclose the publications referenced in paragraph 118, which disclose, among other things, a system capable of monitoring a high-risk driver and generating alarms in response to the driver's violation of a profile. *See, e.g.*, "Remote device will help parents and monitor teenage drivers" at 1–2 ("If it's past curfew, a teenager won't even be able to start the car. The device will also record all teen driving habits for parents to review on home computers. If a teen drives too fast, fails to use seatbelts or drives beyond a specified area the device will sound an alarm, dome lights will flash and the radio will turn off until the behavior ceases."). This material relates to the asserted claims of the Patents-in-Suit. *See, e.g.*, '101 Patent at Claim 1 ("...generate at least one of an alarm signal if said at least one driver violates said operating profile unique to said at least one driver thereby providing feedback about said vehicle usage and govern mechanical operations of said vehicle remotely thereby maintaining occupant safety"); '101 Patent at Claim 8 ("The driver authentication and monitoring system of claim 1, wherein said at least one operating parameter comprises at least one of: a maximum allowable vehicle speed; an allowable vehicle location; allowable hours of operation; and seatbelt usage.").

142. Because of the inequitable conduct committed by Mr. Phelan, the named inventor of the Patents-in-Suit as well as the '415 Patent, and/or other individuals involved in the prosecution of the Patents-in-Suit, the Patents-in-Suit, which are directed to the same subject matter that Phelan sought to capture through the '415 Patent, are also unenforceable under the theory of infectious unenforceability.

143. Kia's investigation is ongoing. Kia reserves the right to seek leave to amend their Answer to include additional facts or bases of inequitable conduct as they become known.

**RESERVATION OF ADDITIONAL DEFENSES**

144. Kia reserves the right to assert additional defenses that may be developed through discovery in this action.

**COUNTERCLAIMS FOR DECLARATORY JUDGMENT**

145. Without admitting any of the allegations of the Complaint other than those expressly admitted herein, and without prejudice to either Kia Corp.'s or Kia America's right to plead additional counterclaims as additional information becomes available, Counterclaim-Plaintiff Kia alleges as follows against Counterclaim-Defendant Phelan:

**BACKGROUND**

146. According to the allegations set forth in its Complaint, Phelan claims to be the assignee and owner of the '101, '149, '508, '465, '470 and '020 Patents. *See* Dkt. No. 1 at ¶¶ 20, 22–28. These patents are referred to collectively as the "Patents-in-Suit."

147. Phelan has accused Kia of infringing the Patents-in-Suit. Kia denies that any of its products infringe any valid or enforceable claim in any of the Patents-in-Suit.

148. An actual case and controversy exists between Kia and Phelan concerning the alleged infringement of one or more claims of the Patents-in-Suit, and that controversy is ripe for adjudication by this Court.

**THE PARTIES**

149. Counterclaim-Plaintiff Kia Corporation is a business entity organized under the laws of the Republic of Korea with a principal place of business at 12 Heolleung-ro, Seocho-gu, Seoul, 06797, Republic of Korea.

150. Counterclaim-Plaintiff Kia America, Inc. is a corporation organized under the laws of the state of California with its principal place of business at 111 Peters Canyon Road, Irvine, California 92606.

151. On information and belief, Counterclaim-Defendant Phelan alleges it is a limited liability company duly formed under the laws of the State of New Mexico. *See* Dkt. No. 1 at ¶ 4.

**JURISDICTION AND VENUE**

152. This is an action for declaratory judgment under 28 U.S.C. §§ 2201 and 2202. This Court has subject matter jurisdiction over these Counterclaims under 28 U.S.C. §§ 1331 and 1338(a). These Counterclaims arise under the patent laws of the United States.

153. This Court has personal jurisdiction over Phelan, at least because by initiating this lawsuit, Phelan has submitted to the jurisdiction of this District.

154. Venue for these Counterclaims is proper in this District under 28 U.S.C. §§ 1391 and 1400.

**COUNTERCLAIM 1**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '101 PATENT)**

155. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

156. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '101 Patent, as Phelan contends, or does not do so, as Kia contends.

157. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

158. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '101 Patent either directly or indirectly, literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

159. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '101 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

160. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 2**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '149 PATENT)**

161. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

162. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '149 Patent, as Phelan contends, or does not do so, as Kia contends.

163. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

164. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '149 Patent either directly,

literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

165. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '149 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

166. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 3**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '508 PATENT)**

167. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

168. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '508 Patent, as Phelan contends, or does not do so, as Kia contends.

169. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

170. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '508 Patent either directly or indirectly, literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

171. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '508 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

172. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 4**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '465 PATENT)**

173. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

174. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '465 Patent, as Phelan contends, or does not do so, as Kia contends.

175. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

176. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '465 Patent either directly or indirectly, literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

177. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '465 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

178. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 5**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '470 PATENT)**

179. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

180. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '470 Patent, as Phelan contends, or does not do so, as Kia contends.

181. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

182. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '470 Patent either directly or indirectly, literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

183. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '470 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

184. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 6**
**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '020 PATENT)**

185. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

186. An actual controversy exists between Kia and Phelan as to whether Kia infringes the '020 Patent, as Phelan contends, or does not do so, as Kia contends.

187. Kia has been damaged by Phelan's filing of a lawsuit against Kia based on a patent that Kia does not infringe.

188. By this Counterclaim, Kia seeks a declaration that it has not infringed and does not infringe any valid and enforceable claim of the '020 Patent either directly,

literally or under the doctrine of equivalents, or willfully, and is entitled to a declaration to that effect.

189. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '020 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

190. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 7**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '101 PATENT)**

191. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

192. An actual controversy exists between Kia and Phelan as to whether the '101 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of patentability of the Patent Laws of the United States, Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

193. By this Counterclaim, Kia seeks a declaration that the claims of the '101 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '101 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

194. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 8**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '149 PATENT)**

195. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

196. An actual controversy exists between Kia and Phelan as to whether the '149 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of patentability of the Patent Laws of the United States, Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

197. By this Counterclaim, Kia seeks a declaration that the claims of the '149 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '149 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

198. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 9**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '508 PATENT)**

199. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

200. An actual controversy exists between Kia and Phelan as to whether the '508 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of patentability of the Patent Laws of the United States, Title 35 of the United States Code,

including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

201. By this Counterclaim, Kia seeks a declaration that the claims of the '508 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '508 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

202. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 10**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '465 PATENT)**

203. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

204. An actual controversy exists between Kia and Phelan as to whether the '465 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of patentability of the Patent Laws of the United States, Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

205. By this Counterclaim, Kia seeks a declaration that the claims of the '465 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '465 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

206. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 11**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '470 PATENT)**

207. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

208. An actual controversy exists between Kia and Phelan as to whether the '470 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of patentability of the Patent Laws of the United States, Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

209. By this Counterclaim, Kia seeks a declaration that the claims of the '470 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '470 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

210. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**COUNTERCLAIM 12**
**(DECLARATORY JUDGMENT OF INVALIDITY OF THE '020 PATENT)**

211. Kia incorporates by reference the admissions, denials, and allegations set forth in the preceding paragraphs of this Answer as if fully set forth herein.

212. An actual controversy exists between Kia and Phelan as to whether the '020 Patent is valid, as Phelan contends, or is invalid for failure to comply with the requirements of

patentability of the Patent Laws of the United States, Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282, as Kia contends.

213. By this Counterclaim, Kia seeks a declaration that the claims of the '020 Patent are invalid. A judicial declaration is necessary and appropriate at this time such that Kia may ascertain its rights and duties with respect to the '020 Patent and with respect to any past, present, or future manufacture, use, importation, distribution, sale, or offer for sale of its products.

214. This is an exceptional case entitling Kia to an award of its attorney's fees incurred in connection with this action pursuant to 35 U.S.C. § 285.

**KIA'S DEMAND FOR JURY TRIAL**

215. Kia hereby demands a jury trial on all issues so triable.

**KIA'S PRAYER FOR RELIEF**

WHEREFORE, Kia prays for judgment as follows:

A. For dismissal of Phelan's Complaint with prejudice, and that Phelan shall take nothing against Kia by the Complaint;

B. For a judgment and declaration that the Patents-in-Suit, and each and every claim thereof, are not infringed by Kia;

C. For a judgment and declaration that the Patents-in-Suit, and each and every claim thereof, are invalid;

D. For a judgment, pursuant to 35 U.S.C. § 285, that Phelan's conduct renders this case exceptional and that Kia be awarded its attorneys' fees and costs;

E. For Kia's costs of suit incurred herein; and

F. For such other and further relief as the Court deems just and proper.

Dated: June 14, 2023

Respectfully submitted,

/s/ *Ryan Yagura*

Ryan K. Yagura (Tex. Bar No. 24075933)
ryagura@omm.com
Nicholas J. Whilt (*Pro Hac Vice*)
nwhilt@omm.com
Clarence A. Rowland (*Pro Hac Vice*)
crowland@omm.com
Paige Hardy (*Pro Hac Vice*)
phardy@omm.com
Cason Garrett Cole (Tex. Bar No. 24109741)
ccole@omm.com
**O'MELVENY & MYERS LLP**
400 S. Hope Street
Los Angeles, CA 90071
Telephone: 213-430-6000
Facsimile: 213-430-6407

Cason Garrett Cole (Tex. Bar No. 24109741)
ccole@omm.com
**O'MELVENY & MYERS LLP**
2501 No. Harwood St. Ste 1700
Dallas, TX 75201
Telephone: 972-360-1900
Facsimile: 213-430-6407

***Attorneys for Defendants Kia Corporation and Kia America, Inc.***

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on June 14, 2023. Any other counsel of record will be served by facsimile transmission, e-mail and/or first class mail.

/s/ *Ryan Yagura*

LexisNexis

**User Name:** Manuel Saldana
**Date and Time:** Friday, May 3, 2024 12:06:00PM EDT
**Job Number:** 223462594

## Document (1)

1. 2:23cv94, The Phelan Group, Llc, V. Kia Corporation Et Al

**Client/Matter:** -None-
**Search Terms:** number(2:23CV94)
**Search Type:** Natural Language
**Narrowed by:**

| Content Type | Narrowed by |
| --- | --- |
| Dockets | Case Status: Open,Unknown,Closed |

# 2:23cv94, The Phelan Group, Llc V. Kia Corporation Et Al

US District Court Docket

United States District Court, Texas Eastern

(Marshall)

**This case was retrieved on** 03/12/2024

## Header

**Case Number:** ***2:23cv94***
**Date Filed:** 03/07/2023
**Assigned To:** District Judge Rodney Gilstrap
**Referred To:** Magistrate Judge Roy S. Payne
**Nature of Suit:** Patent (830)
**Cause:** Patent Infringement
**Lead Docket:** None
**Other Docket:** None
**Jurisdiction:** Federal Question

**Class Code:** Closed
**Closed:** 11/21/2023
**Statute:** 35:271
**Jury Demand:** Plaintiff
**Demand Amount:** $0
**NOS Description:** Patent

## Participants

### Litigants

The Phelan Group, LLC
**Plaintiff**

Kia Corporation
**Defendant**

### Attorneys

Adam G Price
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2632 Fax: 512-727-6691
Email:Aprice@dinovoprice.Com

Nicole E Glauser
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2638 Fax: 512-727-6691
Email:Nglauser@dinovoprice.Com

Andrew Gerald DiNovo
ATTORNEY TO BE NOTICED
DiNovo Price LLP
7000 N. Mopac Expressway Suite 350
Austin, TX 78731
USA
512-539-2631 Fax: 512-727-6691
Email:Adinovo@dinovoprice.Com

Cason Garrett Cole
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP

| Litigants | Attorneys |
|---|---|
| | Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com<br><br>Paige Hardy , I<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213-430-6000 Email:Phardy@omm.Com<br><br>Ryan K Yagura<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213/430-6189 Fax: 213-430-6407<br>Email:Ryagura@omm.Com |
| Kia America, Inc.<br>**Defendant** | Cason Garrett Cole<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP<br>Tx 2501 N. Harwood St. 17th Floor<br>Dallas, TX 75201<br>USA<br>972-360-1916 Email:Ccole@omm.Com<br><br>Clarence Rowland<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor<br>Los Angeles, CA 90071<br>USA<br>213.430.6000 Fax: 213.430.6407<br>Email:Crowland@omm.Com<br><br>Nicholas J Whilt<br>ATTORNEY TO BE NOTICED<br>O'Melveny & Myers LLP - LA<br>400 South Hope Street 18th Floor |



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## Litigants

## Attorneys

Los Angeles, CA 90071
USA
213-430-6000 Fax: 213-430-6407 Email:Nwhilt@omm.Com

Paige Hardy , I
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP
400 South Hope Street 18th Floor
Los Angeles, CA 90071
USA
213-430-6000 Email:Phardy@omm.Com

Ryan K Yagura
ATTORNEY TO BE NOTICED
O'Melveny & Myers LLP - LA
400 South Hope Street 18th Floor
Los Angeles, CA 90071
USA
213/430-6189 Fax: 213-430-6407
Email:Ryagura@omm.Com

## Proceedings

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| 1 | 03/07/2023 | COMPLAINT against All Defendants ( Filing fee $ 402 receipt number ATXEDC-9388902.), filed by Phelan Group, LLC. (Attachments: # 1 Civil Cover Sheet, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6)(DiNovo, Andrew) (Entered: 03/07/2023) | |
| 2 | 03/07/2023 | DEMAND for Trial by Jury by Phelan Group, LLC. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 3 | 03/07/2023 | Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (DiNovo, Andrew) (Entered: 03/07/2023) | |
| 4 | 03/07/2023 | NOTICE of Attorney Appearance by Nicole E Glauser on behalf of Phelan Group, LLC (Glauser, Nicole) (Entered: 03/07/2023) | |
| 5 | 03/07/2023 | NOTICE of Attorney Appearance by Adam G Price on behalf of Phelan Group, LLC (Price, Adam) (Entered: 03/07/2023) | |
| 6 | 03/07/2023 | CORPORATE DISCLOSURE STATEMENT filed by Phelan Group, LLC (DiNovo, Andrew) (Entered: 03/07/2023) | |
| | 03/07/2023 | Case Assigned to District Judge Rodney Gilstrap and Magistrate Judge Roy S. Payne. (nkl, ) (Entered: 03/07/2023) | |
| | 03/07/2023 | In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (nkl, ) (Entered: 03/07/2023) | |
| 7 | 03/07/2023 | SUMMONS Issued as to Kia America, Inc. c/o CT Corporation System, Kia Corporation c/o Texas Secretary of State. (Attachments: # 1 Summons(es))(nkl, ) (Entered: 03/07/2023) | |
| 8 | 03/13/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Kia Corporation served on 3/10/2023, answer due 3/31/2023. | |

| # | Date | Proceeding Text | Source |
|---|---|---|---|
| | | (DiNovo, Andrew) (Entered: 03/13/2023) | |
| 9 | 03/13/2023 | SUMMONS Returned Executed by The Phelan Group, LLC. Kia America, Inc. served on 3/9/2023, answer due 3/30/2023. (DiNovo, Andrew) (Entered: 03/13/2023) | |
| 10 | 03/30/2023 | NOTICE of Attorney Appearance by Ryan K Yagura on behalf of Kia America, Inc., Kia Corporation (Yagura, Ryan) (Entered: 03/30/2023) | |
| 11 | 03/30/2023 | Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Kia Corporation.( Yagura, Ryan) (Entered: 03/30/2023) | |
| 12 | 03/30/2023 | Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Kia America, Inc..( Yagura, Ryan) (Entered: 03/30/2023) | |
| | 03/30/2023 | Defendant's Unopposed FIRST Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Kia Corporation to 5/15/2023. 45 Days Granted for Deadline Extension.( ch, ) (Entered: 03/30/2023) | |
| | 03/30/2023 | Defendant's Unopposed FIRST Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Kia America, Inc. to 5/14/2023. 45 Days Granted for Deadline Extension.( ch, ) (Entered: 03/30/2023) | |
| 13 | 04/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Clarence Rowland on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9444625. (Rowland, Clarence) (Entered: 04/10/2023) | |
| 14 | 04/10/2023 | NOTICE of Attorney Appearance - Pro Hac Vice by Nicholas J Whilt on behalf of Kia America, Inc., Kia Corporation. Filing fee $ 100, receipt number ATXEDC-9444641. (Whilt, Nicholas) (Entered: 04/10/2023) | |
| 15 | 04/17/2023 | CONSOLIDATION ORDER - The above-captioned cases are hereby ORDERED to be CONSOLIDATED for all pretrial issues with the LEAD CASE, Case No. 2:23-cv-00093. All parties are instructed to file any future filings in the LEAD CASE. Signed by District Judge Rodney Gilstrap on 4/17/2023. (ch, ) (Entered: 04/18/2023) | |
| 16 | 04/26/2023 | ***FILED IN ERROR***NOTICE of Attorney Appearance by Cason Garrett Cole on behalf of Kia America, Inc., Kia Corporation (Cole, Cason) Modified on 4/26/2023 (ch, ). (Entered: 04/26/2023) | |
| | 04/26/2023 | ***FILED IN ERROR. NEED TO FILE IN THE LEAD CASE. Document # 16, Notice of Appearance. PLEASE IGNORE.*** (ch, ) (Entered: 04/26/2023) | |
| 17 | 09/23/2023 | ORDER - ORDERED that all pending deadlines in Case No. 2:23-cv-00094-JRG-RSP arestayed for thirty (30) days from the date of this Order. Signed by Magistrate Judge Roy S. Payne on 9/23/2023. (ch, ) (Entered: 09/25/2023) | |
| 18 | 11/21/2023 | ORDER. All claims and causes of action asserted by Plaintiff The Phelan Group against Defendants Kia in member case 2:23-cv-00094-JRG-RSP are DISMISSED WITH PREJUDICE. All claims and causes of action asserted by Defendant Kia against Plaintiff The Phelan Group are DISMISSED WITHOUT PREJUDICE. Each party is to bear its own costs, expenses, and attorneys fees. All pending requests for relief not explicitly granted herein are DENIED AS MOOT. The Clerk of Court is directed to CLOSE cases 2:23-cv-00093 and 2:23 cv-00094 as no parties or claims remain. Signed by District Judge Rodney Gilstrap on 11/221/2023. (slo, ) (Entered: 11/22/2023) | |

| Number | Title | Issued | Class | Subclass |
|---|---|---|---|---|
| 9,045,101 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/02/2015 | 1 | 1 |
| 9,493,149 | Driver authentication system and method for monitoring and controlling vehicle usage | 11/15/2016 | 1 | 1 |
| 9,908,508 | Driver authentication system and method for monitoring and controlling vehicle usage | 03/06/2018 | 1 | 1 |
| 10,259,465 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 10,259,470 | Driver authentication system and method for monitoring and controlling vehicle usage | 04/16/2019 | 1 | 1 |
| 11,352,020 | Driver authentication system and method for monitoring and controlling vehicle usage | 06/07/2022 | 1 | 1 |

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OPAP LHDT SV-5
APR 18 2024
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PTO/AIA/81B (07-13)
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| | |
|---|---|
| Control Number(s) | 90/015,287 |
| Filing Date(s) | 8/31/2023 |
| First Named Inventor | Phelan |
| Title | Driver Authentication System and Method For Monitoring And Controlling Vehicle Usage |
| Patent Number | 10,259,470 |
| Examiner Name | Luke Wassum |
| Attorney Docket No(s) | PHE101 |

**I. Power of Attorney.** This form may be used to change the Power of Attorney in a reexamination or supplemental examination proceeding (or multiple proceedings where merged). This form may also be used to change the Power of Attorney in the patent file; in such a case, a copy of this form will be placed in both the patent file and the reexamination or supplemental examination proceeding.

A. Revocation of Previous Power of Attorney. I hereby revoke all previous patent owner powers of attorney, if any, given:

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| Practitioner(s) Name | Registration Number |
|---|---|
| Gregory S. Donahue | 47,531 |
| | |
| | |
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**OR**
■ Patent owner.
*Statement under 37 CFR 3.73(c) (Form PTO/AIA/96) submitted herewith or filed on* _____.

| | | | |
|---|---|---|---|
| Signature of Inventor or Patent Owner | | Date | 4/12/2024 |
| Name | Michael Phelan | Telephone | 505.660.0527 |
| Title and Company | MEMBER, THE PHELAN GROUP, LLC | | |

NOTE: Signatures of all the inventors or patent owners of the entire interest or their representative(s) are required. If more than one signature is required, submit multiple forms, check the box below, and identify the total number of forms submitted in the blank below.

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Priority Mail Express No.: 9405503699300679602863

Date: April 15, 2024

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| Patent No.: 10,259,470 | |
| Application No.: 90/015,287 | |
| Filed: 08/31/2023 | Art Unit: 3992 |
| Inventor: Phelan | |
| Title: DRIVER AUTHENTICATION SYSTEM AND METHOD FOR MONITORING AND CONTROLLING VEHICLE USAGE | Examiner: Wassum, Luke S. |

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Dear Sir/Madam:

**RESPONSE TO FEBRUARY 15, 2024 NON-FINAL OFFICE ACTION**

Responsive to the Non-Final Office Action dated February 15, 2024, the Patent Owner presents the following in complete response pursuant to 37 C.F.R. § 1.550. Attached to this Response are the following:

**Amendments to the Claims** are unnecessary given the remarks. No claim amendments are made herein as discussed on page 3 of this paper.

**Remarks** begin on page 4 of this paper.



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## CLAIM AMENDMENTS

Based on the remarks below, no claim amendments are necessary to put this application in condition for allowance and issuance of a reexamination certificate for United States Patent No. 10,259,470 ("'470 Patent").



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## REMARKS

Applicant submits that challenged claims 1 and 4 of the '470 Patent along with all unchallenged claims of the '470 Patent are allowable.

## STATUS OF THE CLAIMS

Claims 1 and 4 of the '470 Patent were rejected in the February 15, 2024 Non-Final Office Action. Claims 1 and 4 were rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Harter. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Shuman. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Petrik. Claim 1 was rejected under 35 U.S.C. § 103 as being rendered obvious by Cherouny in view of Bouchard.

### Background of the '470 Patent

The '470 Patent is "generally related to techniques for use in ensuring motor vehicle operation safety." '470 Patent at 1:32-33. More specifically, it relates "to systems and methods for monitoring and controlling vehicle usage by high-risk drivers." '470 Patent at 1:33-35. "A proprietary and centralized database comprising a software application can be accessed by an authorized user via a network utilizing a remote computer in order to configure a desired operating profile





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that matches requirements of the high-risk driver." '470 Patent at 2:37-41. The '470 Patent explains:

> The operating profile can be loaded to a driver identification and data logging module in conjunction with the remote computer. A master control unit can receive a unique identification code from the data logging device to authenticate the high-risk driver and to operate the vehicle within the desired operating profile. A slave control unit receives commands from the master control unit and generates a real time alarm signal if the driver violates the preprogrammed operating profile unique to the driver. The alarm signal generated by the slave control unit can remain until the driver corrects the operating condition and brings the vehicle within the desired operating profile.

'470 Patent at 2:41-53.

Central to the teachings of the '470 Patent, and claim 1 in particular, are the claimed relationship between two control units, namely the "master control unit" and the "slave control unit." Both are control units, meaning that they have certain characteristics known to a person of skill in the art, including the ability to communicate, process data and control features of the claimed system. A "controller" in the context of a computerized system such as the "vehicle control system" of claim 1 is defined in the IEEE Dictionary as follows:

> (2) A device or group of devices that serves to govern, in some predetermined manner, the electric power delivered to the apparatus to which it is connected.



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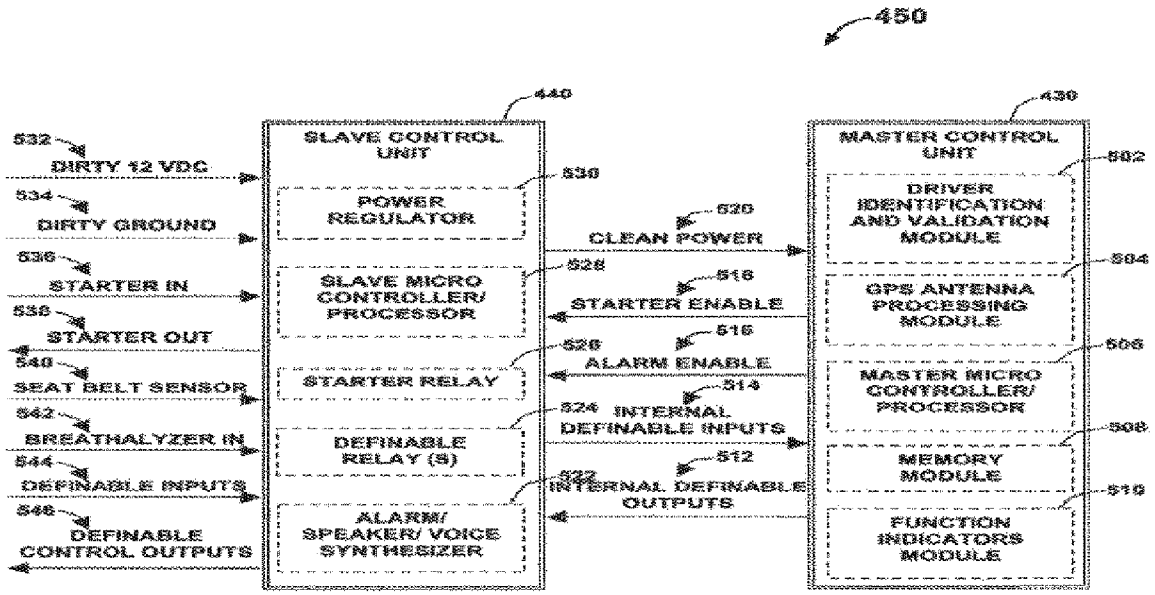
> (3) (packing machinery) A device or group of devices that serves to control in some predetermined manner the apparatus to which it is connected.
>
> (4) The component of a system that functions as the system controller. A controller typically sends program messages to and receives response messages from devices.

*IEEE 100: The Authoritative Dictionary of IEEE Standards Terms*, edited by Kim Breitfelder and Don Messina, Seventh Ed., Standards Information Network IEEE Press, December 2000, p. 234.

As explained in the specification of the '470 Patent:

> The system **450** generally includes a master control unit **430** and a slave control unit **440** that can be accessed and programmed via the software application module **260** stored in the proprietary and centralized database.

'470 Patent at 6:8-13.








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'470 Patent at Fig. 6. "When the driver enters the vehicle, the device **425** can automatically, or at the user's request, connect to the master control unit **465**." '470 Patent at 7:37-39.

As a programmable controller, the slave control unit's output can take varied and complex forms, including remote communication relating to vehicle operation by an interested party such as a fleet manager or other owner.

> The master control unit **430** can enable vehicle operation within the programmed operating profile **435**. If the driver **410** violates the preprogrammed operating profile **435** the master control unit **430** can communicate with the slave control unit **440** and generate a real time driver alarm signal **445**. The alarm signal **445** can result in an actual audible alarm, or it can be used to control/govern operational aspects of the vehicle. ***For example, the real time driver alarm signal 445 can be used to communicate conditions to the driver, limit/disable radio functionality, limit/disable mobile cellular devices in the vehicle, limit/disable internet applications provided in the vehicle, limit/disable GPS related applications provided by the vehicle, limit/disable the drivers cellular telephone or other such devices in the vehicle, govern mechanical operations (e.g., lower/limit speed), remotely contact vehicle owners/fleet managers, and other electrical or mechanical functions, while maintaining driver and occupant safety.***

*Id.* at 10:48-61 (emphasis added).

**Priority of the '470 Patent**

Examiner asserts that the grandparent patent ("'101 Patent") to the '470 Patent does not support the limitation of claim 1 of the '470 Patent related to "a wireless identification and data logging module." February 15, 2024 Non-Final Office

Action at 3. Patent Owner hereby reserves its rights related to the priority date determination and believes that the '470 Patent is entitled to priority through the '101 Patent and potentially even beyond. Nevertheless, this priority date issue is not relevant to the arguments made herein as the arguments presented do not rely on whether the pre-AIA or AIA provisions apply to this re-examination.

**Background of Cherouny**

Cherouny is entitled "Electronic Programmable Speed Limiter." It discloses an "electronic programmable speed limiter for drivers of vehicles which can be preprogrammed and controlled from a remote location via a radio link to update driver performance and adjust the controls on the speed limiter." Cherouny at Abstract. Cherouny focuses on speed monitoring and does not address other safety controls.

**Background of Harter**

Harter involves a "system for logging performance of a driver operating a vehicle that has a vehicle information system from which [at] least one vehicle operating parameter may be obtained." Harter at Abstract. "The vehicle operating parameter collected through the vehicle information system and operator information collected from a portable device are wirelessly communicated to a remote host through a network such as the Internet." Harter at Abstract. Harter's



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invention aims to evaluate and enhance driver performance over time rather than enforcing immediate compliance with driving profiles or authentication of driver identity.

**Background of Shuman**

Shuman discloses a computing architecture for a vehicle. Shuman states:

> The computing architecture includes a data network comprised of a plurality of interconnected processors, a first group of sensors responsive to environmental conditions around the vehicle, a second group of sensors responsive to the vehicle's hardware systems, and a map database containing data that represent geographic features in the geographic area around the vehicle. A vehicle-environment modeling program, executed on the data network, uses the outputs from the first and second groups of sensors and the map database to provide and continuously update a data model that represents the vehicle, past, present, and future environmental conditions around the vehicle, and geographic features, including structures, objects and obstacles around the vehicle. Vehicle operations programming applications, executed on the data network, use the data model to determine desired vehicle operation in the context of the vehicle's past, present, and future environment.

Shuman at 2:11-29

**Background of Petrik**

Petrik is entitled "GPS Monitoring Biometric Smartcard, Intelligent Speed Management." It discusses a "method and system, which, provides GPS based





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vehicle monitoring, management and cruise control, incorporating intelligent speed adaptation, recording driver and vehicle operating parameters." Petrik at [0001].

**Background of Bouchard**

Bouchard discloses a "method and apparatus for evaluating a driver's performance under actual real-time conditions and for using such evaluation to determine the driver's ability to safely operate a vehicle." Bouchard at Abstract. "[C]onditions monitored are used to make a determination as to whether the driver is performing in conformity with normal driving standards and the driver's own past performance." Bouchard at 5:21-24.

## CLAIM REJECTIONS

### Ground 1 Under 35 U.S.C. § 103 (Cherouny in View of Harter)

Limitation 1(b)

Examiner alleges that Cherouny discloses:

> b) **a master control unit in a vehicle for authenticating at least one occupant via said driver identification and logging module and associating an operating profile with said at least one occupant** (see microprocessor 101 which connects to key fob reader 109 to check the identity of the user of the automobile to ensure the instant user's data table is used, [0073]; see also disclosure that a moderator can preprogram operational parameters [i.e., an operating profile for an individual driver in its system, [0018] and [0020]).





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