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Volpe Koenig 30 SOUTH 17TH STREET, 18TH FLOOR PHILADELPHIA, PA 19103			APPIAH, CHARLES NANA	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD B. HIMMELSTEIN

Appeal 2019-003256
Application 14/294,934
Technology Center 2600

Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and
JOHNNY A. KUMAR, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 2, 4, 6, 8–10, 12, 14, and 16. We have jurisdiction over the rejected claims under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Embodiments of Appellant’s invention relate to “a mobile communication system which allows mobile vehicles to communicate with neighboring vehicles and roadside communication networks.” Spec. ¶ 3.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, the real party in interest is Intellectual Ventures II LLC. *See* Appeal Br. 3.

Exemplary Claim

1. (Rejected) A mobile computing device of a vehicle comprising:

a transceiver configured to receive, over a cellular data connection, a request for authorization to share location information in a control instruction;

a processor configured to compare a security access code in the control instruction to detect a security level of a plurality of security levels to authorize sharing of the location information;

the processor configured to receive an input to accept the detected security level;

the transceiver configured to transmit the location information to be displaced on a real-time map on an audio-visual interface (AVI); and

a display configured to display the AVI with a record having identifying information of other vehicles and a function to communicate voice packets at the A VI using internet protocol (IP) over the cellular data connection.

Appeal Br. 27, Claims App.

Rejections

- A. Claims 1, 2, 4, 6, 8–10, 12, 14, and 16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
- B. Claims 1, 2, 4, 6, 8–10, 12, 14, and 16 are rejected on the grounds of nonstatutory double patenting, as being unpatentable over claim all claims of US 7,885,685.
- C. Claims 1, 4, 6, 8, 9, 12, 14, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Obradovich et al. (US

2003/0163251 A1; published Aug. 28, 2003 (hereinafter “Obradovich”)) Elliot (US 6,243,039 B1; issued June 5, 2001) and further in view of Zhang (US 2013/0052990 A1; published Feb. 28, 2013).

- D. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich and Elliot and Zhang and further in view of Heinonen (US 6,078,806; issued June 20, 2000 (hereinafter “Heinonen”)).

Cross Reference to Related Applications

This appeal is for current Application No. 14/294,934 (hereinafter the ‘934 child application):

This application is a **continuation of U.S. Patent Application Serial No. 14/053,237** filed October 14, 2013, **which is a continuation of U.S. Patent Application Serial No. 12/870,219 filed August 27, 2010**, [hereinafter the ‘219 parent application,] issued as U.S. Patent No. 8,565,734 on October 22, 2013, which is a continuation of U.S. Patent Application Serial No. 12/841,433 filed July 22, 2010, issued as U.S. Patent No. 7,885,685 on February 8, 2011, which is a continuation of U.S. Patent Application Serial No. 12/546,645 filed August 24, 2009, issued as U.S. Patent No. 7,783,304 on August 24, 2010, which is a continuation of U.S. Patent Application Serial No. 12/389,245 filed February 19, 2009, issued as U.S. Patent No. 7,599,715 on October 6, 2009, which is a continuation of U.S. Patent Application Serial No. 12/018,588 filed January 23, 2008, issued as U.S. Patent No. 7,536,189 on May 19, 2009, which is a continuation of U.S. Patent Application Serial No. 11/524,858 filed September 20, 2006, issued as U.S. Patent No. 7,450,955 on November 11, 2008, which is a continuation of U.S. Patent Application Serial No. 10/705,674 filed November 10, 2003, issued as U.S. Patent No. 7,123,926 on October 17, 2006, which

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was a continuation of U.S. Patent Application Serial No. 09/659,074 filed September 11, 2000, issued as U.S. Patent No. 6,647,270 on November 11, 2003, which claims the benefit of U.S. Provisional Application No. 60/153,424 filed September 10, 1999.

This application is related to U.S. Patent Application Serial No. 10/705,065 filed on November 10, 2003.

Spec. ¶¶ 1, 2. (emphasis added).

ANALYSIS

Rejection A under Non-Statutory Obviousness Type Double-Patenting (OTDP)

Appellant advances no arguments regarding claims 1, 2, 4, 6, 8–10, 12, 14, and 16 as rejected by the Examiner under non-statutory OTDP Rejection A. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we *pro forma* sustain the Examiner’s Rejection A of claims 1, 2, 4, 6, 8–10, 12, 14, and 16 on the ground of non-statutory OTDP.

Rejection B of Claims 1, 2, 4, 6, 8–10, 12, 14, and 16 under 35 U.S.C. § 112, first paragraph

The Examiner determines that the ’934 child application (i.e., original Specification) does not have sufficient written description support:

All independent claims including claim 1, contain limitations that require a network device to receive/send/share an authorization request to a mobile device to send/receive/share location information, [**hereinafter “location authorization limitations”**]; a processor configured to compare a security access code in the control instruction to detect a security level of a plurality of security levels to authorize

sharing of the location information; the processor configured to receive an input to accept the detected security level, [hereinafter “the security level limitation”].

Final Act. 8. (emphasis added).

To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991). Specifically, the specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art and show that the inventor actually invented the claimed invention. *Id.* at 1562–63; *Accord Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Ariad*, 598 F.3d at 1351. In particular, the written description requirement does not demand any particular form of disclosure “or that the specification recite the claimed invention *in haec verba*.” *Id.* at 1352.

Appellant has identified written description support for each element of claim 1 (and claim 9) in the U.S. Pre-Grant Publication 2014-0273946 of the present application.” (hereinafter “’946 Pub”) on pages 5 through 22 of the Appeal Brief.² In particular, the ’946 Pub describes:

Paragraph [0050] teaches that location of the vehicle is an example of stored information on a vehicle. Location information may be shared with others when, as explained in

² Upon a cursory review, the paragraph numbers in the ’946 Pub and the ’934 child application are exactly same.

paragraph [0071], the vehicletalk system receives a “packet [that] includes a control communication ... microprocessor compares the control instruction to the security level required (step 616)” and, as explained in paragraph [0038], access to a vehicle may be obtained based on the security instruction that may allow “0--access to all functions of the vehicle communication system 10 including the physical control of the vehicle and all of the information stored within the memory 41. 1--access only to the physical control of the vehicle. 2--access only to the information stored within the memory 41.. ..”

A person of ordinary skill in the art at the time of filing understands that paragraphs [0038], [0050], and [0071] together support with levels 0 or 2 giving others access to “information stored within the memory 41,” which may include location information as disclosed in paragraph [0050], if requested. Therefor, "a request for authorization to share location information in a control instruction" as claimed is fully supported.

.....

Paragraph [0039] states that the “security field 61 may also include a security code, which permits authentication of the entity sending the security instruction” and paragraph [0071] states that the vehicletalk system receives a “packet [that] includes a control communication ... microprocessor compares the control instruction to the security level required (step 616).” In the procedure given in figure 6 [of the Specification], a control instruction of packet control communication is performed if a security level is sufficient.

Reply Br. 4–6.

As noted above, the written description requirement does not demand “that the specification recite the claimed invention *in haec verba*.” *Ariad*, 598 F.3d at 1352. For the same reasons as advanced by Appellant, we find sufficient written description to demonstrate *possession* of the invention

claimed in paragraphs 38, 39, 50, 71, and Figure 6 of the '946 Pub ('934 child application).

Accordingly, we are constrained on this record to reverse the Examiner's Rejection B of claims 1, 2, 4, 6, 8-10, 12, 14, and 16, under pre-AIA 35 U.S.C. § 112, first paragraph (written description).

Rejections C and D under § 103(a) of Claims 1, 2, 4, 6, 8-10, 12, 14, and 16

The Examiner cited the Zhang reference for disclosing the location authorization limitations. Final Act. 10.

Appellant contends the obviousness rejections are improper because Zhang is not available as prior art. Appeal. Br. 26; Reply Br. 7. The dispositive issue presented by Appellant's argument is whether the Zhang's patent application publication (US 2013/0052990 A1, filed August 29, 2011) is available as prior art.

We note Appellant's application '934 child application on appeal has a filing date of June 3, 2014, but as noted above, it has an effective filing date of at least August 27, 2010, because it is a continuation of U.S. Patent Application Serial No. 14/053,237 filed October 14, 2013, which is further a continuation of U.S. Patent Application Serial No. 12/870,219, filed August 27, 2010 ('219 parent application),

In Table One below, we compare the description of the relevant paragraphs (¶¶ 38, 50, 71) of the '934 child application with corresponding subject matter in the '219 parent application that relate to the location authorization limitations.

TABLE ONE

‘934 child application	‘219 parent application
<p>[0038] Since the vehicle communication system 10 in accordance with the present invention permits control of a vehicle and overall control of the communication system 10 by law enforcement authorities via a “security instruction”, the system 10 has a plurality of security levels to ensure that unauthorized individuals will not use the system 10 for subversive purposes. Optionally, driver may override law enforcement. System may ask for permission for law enforcement to control vehicle. The security field 61 is defined as follows: 0--access to all functions of the vehicle communication system 10 including the physical control of the vehicle and all of the information stored within the memory 41. 1--access only to the physical control of the vehicle. 2--access only to the information stored within the memory 41. 3--access for transmitting and receiving communications. 4--access only to receiving communications.</p>	<p>[0034] Since the vehicle communication system 10 in accordance with the present invention permits control of a vehicle and overall control of the communication system 10 by law enforcement authorities via a “security instruction”, the system 10 has a plurality of security levels to ensure that unauthorized individuals will not use the system 10 for subversive purposes. Optionally, driver may override law enforcement. System may ask for permission for law enforcement to control vehicle. The security field 61 is defined as follows: 0--access to all functions of the vehicle communication system 10 including the physical control of the vehicle and all of the information stored within the memory 41. 1--access only to the physical control of the vehicle. 2--access only to the information stored within the memory 41. 3--access for transmitting and receiving communications. 4--access only to receiving communications.</p>
<p>[0050] The origination field 76 includes the location of the vehicle when the vehicle was turned on. The destination field 77 includes the destination of the vehicle. This, of</p>	<p>[0046] The origination field 76 includes the location of the vehicle when the vehicle was turned on. The destination field 77 includes the</p>

‘934 child application	‘219 parent application
<p>course, requires that the destination be input into the mobile unit 16, such as when a destination is input into a navigation system. It should be understood that the vehicletalk operator may override certain fields to ensure that this information is not obtained by other vehicletalk operators. For example, the origination 76 and destination fields 77, which may include personal information that the vehicletalk operator does not desire other vehicletalk operators to have access to, may include null data such that the sender's destination and origination will be listed as "not available" to the receiver. The vehicle operator configures their mobile unit 16 as desired to specify which fields should be transmitted with null data.</p>	<p>destination of the vehicle. This, of course, requires that the destination be input into the mobile unit 16, such as when a destination is input into a navigation system. It should be understood that the vehicletalk operator may override certain fields to ensure that this information is not obtained by other vehicletalk operators. For example, the origination 76 and destination fields 77, which may include personal information that the vehicletalk operator does not desire other vehicletalk operators to have access to, may include null data such that the senders destination and origination will be listed as "not available" to the receiver. The vehicle operator configures their mobile unit 16 as desired to specify which fields should be transmitted with null data.</p>
<p>[0071] If it has been determined that the packet includes a control communication, the communication is processed as such (step 614). The microprocessor compares the control instruction to the security level required (step 616). This includes reviewing the security field, including the optional security access code. If the security access code is proper (i.e. authorized), the security level is reviewed and the microprocessor makes a determination of whether the</p>	<p>[0067] If it has been determined that the packet includes a control communication, the communication is processed as such (step 614). The microprocessor compares the control instruction to the security level required (step 616). This includes reviewing the security field, including the optional security access code. If the security access code is proper (i.e. authorized), the security level is reviewed and the microprocessor makes a determination of whether the</p>

‘934 child application	‘219 parent application
<p>security level is sufficient (step 618). If so, the microprocessor performs the control instruction (step 620). If not, the microprocessor generates a transmission to the sender of the control instruction that they are not authorized to control the particular mobile unit (step 622). The microprocessor 40 also notifies the particular vehicletalk operator that a control attempt was made and was unsuccessful. This will alert the vehicletalk operator that someone may be utilizing the system for subversive purposes. Optionally, the system may require the vehicle talk operator to authorize their vehicle to accept a control instruction, prior to undertaking any control instructions. Once the processing of the packet is performed, the microprocessor goes to the next packet (step 624).</p>	<p>security level is sufficient (step 618). If so, the microprocessor performs the control instruction (step 620). If not, the microprocessor generates a transmission to the sender of the control instruction that they are not authorized to control the particular mobile unit (step 622). The microprocessor 40 also notifies the particular vehicletalk operator that a control attempt was made and was unsuccessful. This will alert the vehicletalk operator that someone may be utilizing the system for subversive purposes. Optionally, the system may require the vehicle talk operator to authorize their vehicle to accept a control instruction, prior to undertaking any control instructions. Once the processing of the packet is performed, the microprocessor goes to the next packet (step 624).</p>

Based upon our review, we find ¶¶ 38, 50, and 71 of the ‘934 child application correspond to ¶¶ 34, 46, and 67 in the ‘219 parent application. Accordingly, the claimed location authorization limitations are supported by the ‘219 parent application.

We note that the Examiner has not proffered any objective evidence to support any reason that Appellant might not be entitled to claim the benefit of their own ‘219 parent application.

We emphasize that we are a Board of review. Because the Examiner has not developed the record in this regard, we decline to do so here in the first instance. *See id.* “The review authorized by 35 U.S.C. § 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance.” *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

Based upon our review of the record, we find the Examiner has not provided sufficient evidence on appeal to show that Zhang is available as prior art. Therefore, on this record, the Board can only rely upon the ’219 parent application filing date, which is August 27, 2010, this date occurring **before** Zhang’s filing date of August 29, 2011.

Therefore, as further discussed above, we find the Examiner has not shown Zhang is available as prior art.

The Examiner must provide **prior art** references as evidence in the first instance to establish a prima facie case of obviousness. Without the Zhang being properly established as available prior art, the Examiner’s Rejections C and D under 35 U.S.C. § 103(a) fail due to insufficient evidence. Therefore, on this record, we are persuaded the Examiner erred by improperly relying upon Zhang as prior art.

Accordingly, we are constrained on this record to reverse the Examiner’s Rejections C and D under 35 U.S.C. § 103(a), of all claims on appeal, because each rejection improperly relies upon Zhang as prior art.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)Basis	Affirmed	Reversed
1, 2, 4, 6, 8-10, 12, 14, 16	112, first paragraph	Written description		1, 2, 4, 6, 8-10, 12, 14, 16
1, 2, 4, 6, 8-10, 12, 14, 16	N/A	Nonstatutory Double Patenting	1, 2, 4, 6, 8-10, 12, 14, 16	
1, 4, 6, 8, 9, 12, 14, 16	103	Obradovich, Elliot, Zhang		1, 4, 6, 8, 9, 12, 14, 16
2, 10	103	Obradovich, Elliot, Zhang, Heinonen		2, 10
Overall outcome			1,2, 4, 6, 8-10, 12, 14, 16	

FINALITY AND RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED