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.
15/709,082	09/19/2017	Tod Farrell	67466/02033	4679

31013 7590 10/09/2020

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
GONZALEZ, AMANCIO	

ART UNIT	PAPER NUMBER
2642	

NOTIFICATION DATE	DELIVERY MODE
10/09/2020	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dtorniali@kramerlevin.com
klpatent@kramerlevin.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOD FARRELL and ALETHEA P. MCCASKEY

Appeal 2019-006192
Application 15/709,082
Technology Center 2600

Before JENNIFER S. BISK, JASON J. CHUNG, and
DAVID J. CUTITTA II, *Administrative Patent Judges.*

BISK, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[2] appeals from the Examiner's decision to reject claims 1–16. *See* Final Act. 1. We have

---

[1] Throughout this Decision we have considered the Specification filed September 19, 2017 ("Spec."), the Final Rejection mailed October 11, 2018 ("Final Act."), the Appeal Brief filed May 7, 2019 ("Appeal Br."), the Examiner's Answer mailed June 20, 2019 ("Ans."), and the Reply Brief filed August 16, 2019 ("Reply Br.").

[2] We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Sirius XM Connected Vehicle Services Inc. Appeal Br. 2.

jurisdiction under 35 U.S.C. § 6(b). A hearing was scheduled for August 27, 2020, but was subsequently waived by Patent Owner.

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to "providing driver usage information to a third-party through a telematics system and methods for providing such information." Spec. ¶ 3. Claim 1, reproduced below, is the only independent claim and is illustrative of the claimed subject matter:

> 1. A method for providing information to a third party about a driver of a vehicle having a telematics system and a vehicle identification number (VIN), the telematics system comprising a positioning module, a telematics unit, a mobile device of the driver having a unique identification (ID), and an integrated communication device of the vehicle, which comprises:
>
> automatically identifying the mobile device of the driver with at least one of the integrated communication device and the telematics unit;
>
> generating data from the positioning module as the driver operates the vehicle;
>
> transmitting the generated data, the VIN, and the ID of the mobile device of the driver outside the vehicle;
>
> generating a driving behavior report from the transmitted data, VIN, and ID; and
>
> utilizing the driving behavior report to determine an insurance premium to charge at least one of the driver and an owner of the vehicle.

Appeal Br. 14 (Claims App'x.).

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Berkobin	US 8,117,049 B2	Feb. 14, 2012
Przybylski	US 2012/0142367 A1	June 7, 2012
Steinberg	US 2014/0046701 A1	Feb. 13, 2014
Miao	US 9,888,080 B2	Feb. 6, 2018

REJECTIONS[3]

Claims 1–7 and 10–16 are rejected under 35 U.S.C. § 103 as being unpatentable over Berkobin, Miao, and Steinberg. Final Act. 3–9.

Claims 8 and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Berkobin, Miao, Steinberg, and Przybylski. Final Act. 9–10.

OPINION

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

[3] In the event of further prosecution, the Examiner may want to consider whether these claims recite patentable-eligible subject matter under 35 U.S.C. § 101. In particular, we note that the MPEP states that claims reciting "fundamental economic principles," such as calculating insurance policies, may be classified as abstract ideas under step 2A of the eligibility test. MPEP § 2106.04(a)(2) 9th Ed. Rev. 10.2019 (June 2020). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

We have considered all of Appellant's arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Claims 1–7 and 10–16

The Examiner rejects claims 1–7 and 10–16 as obvious over Berkobin, Miao, and Steinberg. Final Act. 3–9. In particular, the Examiner relies on Berkobin for many of the recited limitations of the challenged claims. *Id.* at 3–5. The Examiner, however, finds that Berkobin does not teach explicitly "automatically identifying the mobile device of the driver with at least one of the integrated communication device and the telematics unit" ("the automatically identifying limitation"). *Id.* at 5–6. The Examiner relies on both Miao and Steinberg for teaching or suggesting portions of the automatically identifying limitation. *Id.* at 6. First, the Examiner points to Miao as teaching "association between a mobile communications device and a telematics unit in a vehicle" by identifying the driver of the vehicle and looking up the identity of a mobile device known to be used by the driver. *Id.* at 6 (citing Miao, 13:41–51).

Second, the Examiner points to Steinberg as teaching gathering data monitoring a driver's performance from the driver's mobile device. Ans. 4 (citing Steinberg ¶¶ 27, 41). The Examiner also explains that Steinberg teaches "[v]erification of the vehicle associated with the mobile device could be achieved by linking the mobile device 50 with sub-systems of the vehicle using wired or wireless connections." *Id.* at 4–5 (quoting Steinberg ¶ 32). The Examiner also points out that Steinberg teaches automatically identifying a driver. Final Act. 6 (citing Steinberg ¶ 39).

The Examiner explains that it would have been obvious to a person of ordinary skill in the art to modify Berkobin in view of Miao and Steinberg to "provid[e] means for correlating the use of a mobile device with an individual while driving a vehicle" and "provid[e] means for making insurance more affordable." Final Act. 6–7 (citing Steinberg ¶ 8).

Appellant argues that "any teaching, suggestion, or incentive possibly derived from the cited art is only present with an impermissible hindsight judgment in view of the claimed invention." Appeal Br. 8. First, according to Appellant, "[b]ecause Steinberg does not identify *a mobile device*, it cannot be used to support the conclusion that the combination of Berkobin, Miao, and Steinberg suggest the features of claim 1 to one having ordinary skill in the art." *Id.* at 8–9; *see also* Reply Br. 3 ("[N]owhere does Steinberg suggest 'automatically identifying the **mobile device**."). This argument is not persuasive as Steinberg teaches gathering data from a driver's mobile device (Steinberg ¶ 27), and we find a person of ordinary skill in the art would have understood that in order to gather this data, Steinberg must, at some point, have identified the driver's mobile device. Moreover, Steinberg teaches verifying the mobile device using Bluetooth, which a person of ordinary skill in the art would have understood can be done automatically. Steinberg ¶ 32; Ans. 4–5. We do not agree with Appellant that this paragraph teaches only identifying the vehicle (*see* Reply Br. 3), but instead agree with the Examiner that a person of ordinary skill in the art would have understood the connection between the vehicle and the mobile device to also allow identifying the driver's mobile device. In addition, Appellant contends that Steinberg "**requires the driver to manually enter** the VIN

into their phone" (Appeal Br. 9 (citing Steinberg ¶ 32[4])), however, we agree with the Examiner (Ans. 5) that in paragraphs 31 and 32 Steinberg specifically teaches several methods for verifying a mobile device with a vehicle only a subset of which would require manual entry of a VIN. Ans. 5 (citing ¶¶ 31–32). Thus, we agree with the Examiner that Steinberg at least suggests automatically identifying the mobile device of the driver.

Second, Appellant contends that "Miao **determines identity *only manually***," and therefore neither Berkobin nor Miao show the automatic identification recited by the claims. Appeal Br. 10. This argument is not persuasive because, as discussed above, the Examiner relies on both Miao and Steinberg as teaching or suggesting the automatically identifying limitation. Moreover, as explained above, we agree that Steinberg teaches automatically identifying the driver's mobile device. We agree with the Examiner that the combination of Miao and Steinberg at least suggests the automatically identifying limitation.

Finally, Appellant argues "there is no reason, whether set forth specifically in Berkobin or inferred therefrom, as to why Berkobin would ever desire to correlate the use of the mobile device with an individual while driving the vehicle." Appeal Br. 10. The Examiner does not, however, point to Berkobin to show that a person of ordinary skill in the art would have combined the teachings of the references, but instead points to paragraph 8 of Steinberg (Final Act. 7), which states that insurance companies monitoring devices installed in vehicles to examine driving data, including speed and acceleration measurements, and linking insurance price

[4] We assume that reference to Steinberg ¶ 32 here is a typo and is meant to refer to Steinberg ¶ 31.

to that data to make it "more affordable, fair, and transparent to consumers" (Steinberg ¶ 8). We find that this disclosure, in combination with the knowledge that most drivers now have mobile devices including GPS data (as taught by Steinberg), provides a reasonable rationale for why a person of ordinary skill in the art would want to correlate the use of the driver's mobile device with that individual.

We, therefore, are not persuaded that the Examiner erred in rejecting claims 1–7 and 10–16 as obvious over the combined teachings of Berkobin, Miao, and Steinberg.

Claims 8 and 9

The Examiner rejects dependent claims 8 and 9 as obvious over Berkobin, Miao, Steinberg, and Przybylski. Final Act. 9–10. In particular, the Examiner turns to Przybylski to teach "wherein the integrated communication device of the vehicle comprises a Bluetooth device having a highest priority phone; and the mobile device of the driver is the highest priority phone and automatically pairs with the Bluetooth device when in communications range with the Bluetooth device." Final Act. 10 (citing Przybylski ¶ 27). According to the Examiner, a person of ordinary skill in the art would have used this teaching to modify the Berkobin/Miao/Steinberg system to "provid[e] a system that informs the vehicle operator that one or more devices have been found and requests which mobile device should be used." *Id.*

Appellant argues that "there is no suggestion, let alone express teaching, within any of Berkobin or Miao or Steinberg to change the description of the inventions therein by adding the feature described in paragraph 27 of Przybylski." Appeal Br. 12. The Examiner, however, relies

on Przybylski for the rationale to combine. Final Act. 10. We agree that Pryzbylski teaches the "presence of multiple mobile devices might occur because, for example, there are other occupants with mobile devices in the vehicle, or are other people nearby with mobile devices" so that it makes sense to determine which device belongs to the vehicle driver by giving it priority. Przybylski ¶ 27. We find this that this disclosure, in combination with the knowledge that most occupants of a car now have mobile devices, provides a reasonable rationale for why a person of ordinary skill in the art would want to modify the Berkobin/Miao/Steinberg system to use priorities for devices as described by Przybylski.

We, therefore, are not persuaded that the Examiner erred in rejecting claims 8 and 9 as obvious over the combined teachings of Berkobin, Miao, Steinberg, and Przybylski.

CONCLUSION

We affirm the Examiner's rejections.

DECISION SUMMARY

Claim(s)	**35 U.S.C. §**	**Basis/Reference(s)**	**Affirmed**	**Reversed**
1–7, 10–16	103	Berkobin, Miao, Steinberg	1–7, 10–16	
8, 9	103	Berkobin, Miao, Steinberg, Przybylski	8, 9	
Overall Outcome			1–16	

TIME PERIOD FOR 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