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.
11/944,828	11/26/2007	Christopher L. Oesterling	GP-304065-OST-ALS	6231

60770 7590 08/01/2014
General Motors Corporation
c/o REISING ETHINGTON P.C.
P.O. BOX 4390
TROY, MI 48099-4390

EXAMINER
WEISENFELD, ARYAN E

ART UNIT	PAPER NUMBER
3689	

MAIL DATE	DELIVERY MODE
08/01/2014	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.

Office Action Summary	Application No. 11/944,828	Applicant(s) OESTERLING ET AL.	
	Examiner ARYAN WEISENFELD	Art Unit 3689	AIA (First Inventor to File) Status No

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

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 2/20/2013.

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

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance 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.

Disposition of Claims*

5)☒ Claim(s) 1-8 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☐ Claim(s) _____ is/are rejected.

8)☒ Claim(s) 1-8 is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☒ The drawing(s) filed on 11/26/2007 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

DETAILED ACTION

Reopening Prosecution

1) In view of the appeal brief filed on February 20, 2013, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CRF 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount of previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JANICE MOONEYHAM/

Supervisory Patent Examiner, Art Unit 3689

Response to Amendment

2) New 35 U.S.C. 101 Rejection has been provided.

3) New 35 U.S.C. 103(a) Rejections have been provided.

4) New 35 U.S.C. 112, 2nd paragraph rejections have been provided.

5) Double Patenting Rejections have been provided.

Notice to Applicant

6) In the amendment dated 5/16/ the following has occurred: Claim 8 has been amended; No claims have been canceled; No claims have been added.

7) Claims 1-8 are pending.

8) The present case has been inherited from a previous Examiner.

9) The present application is being examined under the pre-AIA first to invent provisions.

Priority

10) The present application is a continuation of application 11/024103, filed on 12/28/2004, which is a continuation of PCT/US2004/024241, filed on 7/28/2004, which claims priority from provisional application 60/509606, filed on 10/8/2003.

Double Patenting

11) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12) Claims 1 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of claims 2, 8, and 9 of application 11/024013 (hereinafter '103), of which the present application is a continuation, in view of "Telematics – A viewpoint," Business Briefing: Global Automotive Manufacturing & Technology, published 2002, hereinafter "Telematics."

13) This is a <u>provisional</u> obviousness-type double patenting rejection.

Specifically, **Claim 1** of the present application claims the following:

producing an initial design of a vehicle having an integrated telematics unit (equivalent to points A and C of claim 2 of '103, points A and C of Claim 8 of '103, and points A and C of claim 9 of '103);

building a first plurality of vehicles according to the initial design, wherein the building step is carried out by a vehicle manufacturer and wherein at least some of the first plurality of vehicles each include the integrated telematics unit installed by the vehicle manufacturer as a part of building the vehicles according to the initial design (equivalent to points B and C of claim 2 of '103, points B and C of claim 8 of '103 and points B and C of claim 9 of '103);

operating vehicles from the first plurality of vehicles in a captured test fleet (equivalent to points H and I of claim 2 of '103, point E of claim 8 of '103 and point E of claim 9 of '103);

sending data from vehicles in the captured test fleet to the vehicle manufacturer via the telematics unit (equivalent to points H and I of claim 2 of '103, and points G of claims 8 and 9 of '103);

creating a revised design by revising the initial design in response to at least some of the data received by the vehicle manufacturer (equivalent to point J of claim 2 of '103, and point H of claims 8 and 9 of '103);

building a second plurality of vehicles according to the revised design, wherein at least some of the second plurality of vehicles each include one of the integrated telematics units (equivalent to point K of claim 1 of '103, and point H of claims 8 and 9 of '103).

However, '103 does not disclose selling some or all of the second plurality of vehicles to customers.

However, Telematics does teach:

selling some or all of the second plurality of vehicles to customers (Page 74, paragraph [0002] teaches that a telematics unit will aid in the process of selling the car).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of '103 to subsequently sell the production vehicles because it would aid in the selling of the car, as taught by Telematics, and it would be beneficial to sell the plurality of cars to make a profit.

Additionally, it would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the selling of the production vehicles because, as taught by Telematics since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

14) **Regarding claim 6**, Claim 6 discloses the following (all parenthetical references to claims are to application '103):

designing a vehicle including a vehicle system (equivalent to points A of claims 2, 8, and 9 of '103);

building a plurality of pilot vehicles of the designed vehicle such that at least some of the pilot vehicles include both the vehicle system and an integrated telematics unit (equivalent to points B and C of claims 2, 8, and 9 of '103);

creating a captured test fleet that includes the pilot vehicles (equivalent to point E of claim 2, point D of claims 8 and 9);

operating the captured test fleet (equivalent to I of claim 2, E of claims 9 and 10);

monitoring performance of the vehicle system within the pilot vehicles (equivalent to H of claim 2, subpoint i of claims 8 and 9);

storing data within a controller in the pilot vehicles in response to the monitoring (H of claim 2, ii of claims 8 and 9);

automatically triggering within the telematics unit a telematics connection from the pilot vehicles to a service center (E – specifically the request – of claim 2, and iii of claims 8 and 9);

communicating the data to the service center (I of claim 2, iv of claims 8 and 9);

storing the data in the service center (H of claim 2, v of claims 8 and 9);

providing the data for at least some of the pilot vehicles to at least one person capable of influencing design of the monitored vehicle system (J and K of claim 2, G of claims 8 and 9);

modifying the design of the monitored vehicle system in response to the data (K of claim 2, H of claims 8 and 9);

producing production vehicles that include the vehicle system built according to the modified design (K of claim 2, H of claims 8 and 9).

However, '103 does not teach selling at least some of the production vehicles.

However, Telematics does teach:

selling at least some of the production vehicles (Page 74, paragraph [0002] teaches that a telematics unit will aid in the process of selling the car).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of '103 to subsequently sell the production vehicles because it would be beneficial to include in the second set of revised vehicles the telematics unit because it would aid in the selling of the car, as taught by Telematics, and it would be beneficial to sell the plurality of cars to make a profit.

Additionally, it would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the selling of the production vehicles because, as taught by Telematics since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

15) Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of application 11/024013 (hereinafter '103), of which the present application is a continuation, in view of Fiechter et al. (US 2003/0114965 A1), hereinafter "Fiechter."

16) This is a provisional obviousness-type double patenting rejection.

Specifically, claim 8 recites:

a captured test fleet comprising a plurality of vehicles having integrated telematics units installed in vehicles (A and C of claim 8 of '103);

a service center having the service center having a second database that stores performance data associated with vehicles in the captured test fleet (i, ii, and v of claim 8 of '103);

wherein said service center communicates with said vehicles via the integrated telematics units wherein each of the vehicles collect and store the performance data at the vehicle and then subsequently send the performance data to the service center and the performance data is used by a vehicle manufacturer for revising vehicle design and applying those revisions to producing vehicles ((E, G, H of claim 2, i-v, and the wherein clause after point H of claim 9).

Specifically, claim 8 of '103 does not teach:

each vehicle having an identifier that associates the vehicle with the captured test fleet;

a database of vehicles that includes at least some of the vehicles in the captured test fleet and that includes the identifiers for some or all of the vehicles in the database; and

such that requests for performance data are sent from said service center to vehicles in the captured test fleet using identifiers contained in said first database.

However, Fiechter does teach:

each vehicle having an identifier that associates the vehicle with the captured test fleet (Page 3, paragraph [0036] teaches that the condition monitoring system of the present invention frequently acquires and archives aggregated data from many vehicles, one of which includes a VIN number for the particular vehicles. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition);

a database of vehicles that includes at least some of the vehicles in the captured test fleet and that includes the identifiers for some or all of the vehicles in the database (Page 3, paragraph [0036] teaches that the condition monitoring system of the present invention frequently acquires and archives aggregated data from many vehicles, one of which includes a VIN number for the particular vehicles. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition); and

such that requests for performance data are sent from said service center to vehicles in the captured test fleet using identifiers contained in said first database (As above, because the system acquires and archives data, such as the VIN, and other data such as load collectives and data-traces and other diagnostics, the data must first be requested, otherwise no data could be

acquired. Furthermore, the purpose of Fiechter is to monitor conditions of vehicles – i.e. the condition data is requested. Page 3, paragraphs [0036] – [0038] teach condition monitoring that enables continuous observation of the status of each vehicle. The only vehicles that are monitored are those discussed in paragraph [0036], that have a particular VIN. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition. The system monitors the condition of the vehicle, which means that the system transmits a data retrieval request to request condition information about the particular vehicle).

It would have been obvious to one of ordinary skill in the art to include in claim 8 of '103, the above-mentioned limitations, as taught by Fietcher, since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

17) A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the claims that are directed to the same invention so they are no longer

coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 8 is rejected on the ground of statutory double patenting as being unpatentable over each of claims 2 and 9 of application 11/024013 (hereinafter '103), of which the present application is a continuation.

Specifically, claim 8 recites:

a captured test fleet comprising a plurality of vehicles having integrated telematics units installed in vehicles, each vehicle having an identifier that associates (A and E of claim 2 of '103, A, C, and the wherein clause after point H of claim 9);

a service center having a first database of vehicles that includes at least some of the vehicles in the captured test fleet and that includes the identifiers for some or all of the vehicles in the first database, the service center having a second database that stores performance data associated with vehicles in the captured test fleet (E, G, H of claim 2, i, ii, v, and the wherein clause after point H of claim 9);

wherein said service center communicates with said vehicles via the integrated telematics units, such that requests for performance data are sent from said service center to vehicles in the captured test fleet using identifiers in said first database, and wherein each of the vehicles collect and store the requested performance data at the vehicle and then subsequently send the requested performance data to the service center in response to the request and the requested performance data is used by a vehicle manufacturer for revising vehicle design and applying those revisions to producing vehicles ((E, G, H of claim 2, i-v, and the wherein clause after point H of claim 9).

Claim Rejections - 35 USC § 101

18) 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19) Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claim as a whole, considering all claim elements, both individually and in combination do not amount to significantly more than an abstract idea. The claims are directed towards the abstract idea of vehicle design and manufacture, including an iterative development process to refine vehicle design parameters, which is simply a fundamental economic and business practice. The additional elements or combination of elements in the claims other than the abstract idea per se amounts to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well understood, routine, and conventional activities previously known to the automotive industry. Viewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. Therefore, the claims are rejected under 35 U.S.C 101 as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

20) The following is a quotation of 35 U.S.C. 112(b):

> (b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21) Claim 4 is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. Specifically, the Examiner is unsure what the service center is in claim 4, because claim 4 depends on claim 1, and no service center is recited in claim 1. As such, there is lack of antecedent basis for "the" service center.

Claim Rejections - 35 USC § 103

22) The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23) **Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glen Courtright, Case Study of the Applicability of Applying Telematics Enabled Collaboration Technology to Advanced Powertrain Development, Support for Presentation Date found in PTO-892 "Final Program," dated January 19-24, 2003, hereinafter "Courtright," in view of "Telematics – A viewpoint," Business Briefing: Global Automotive Manufacturing & Technology, published 2002, hereinafter "Telematics."**

24) **Regarding claim 1**, Courtright discloses a method of producing and selling vehicles, comprising the steps of:

producing an initial design of a vehicle having an integrated telematics unit (Page 2, Col. 1, last paragraph, and Col. 2, first paragraph disclose that the Science Applications International Corporation has **designed, developed, and implemented** a collaborative engineering enterprise that is comprised of a central data repository, web-based analysis tools, secure data distribution to vehicle developers in North American and Asia, and a **complete telematics-based instrumentation system** for state of the art vehicle development program. SAIC engineers have designed and installed vehicle instrumentation systems in the vehicles to remotely monitor and analyze powertrain and instrumentation performance. The collaboration technology provides early insight into the engineering process, which can translate into a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. ***The collected data are critical to the fine-tuning of the powertrain***. Stated differently, the initial design of a vehicle is simply the vehicle (or, plurality of vehicles) that have the installed vehicle instrumentation systems in the vehicle to monitor data of the powertrain. The subsequently designed vehicles are the vehicles that include the "fine-tuned" powertrain based on the collected data from the telematics-based instrumentation of the initial set of vehicles);

building a first plurality of vehicles according to the initial design, wherein the building step is carried out by a vehicle manufacturer and wherein at least some of the first plurality of vehicles each include the integrated telematics unit as a part of building the vehicles according to the initial design (As discussed above, Page 2, Col. 1, last paragraph, and Col. 2, first paragraph disclose that SAIC engineers have designed and installed vehicle instrumentation systems in the vehicles to remotely monitor and analyze powertrain and instrumentation performance. The collaboration technology provides early insight into the engineering process, which can translate

into a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. ***The collected data are critical to the fine-tuning of the powertrain***. Stated differently, the initial design of a vehicle is simply the vehicle (or, plurality of vehicles – i.e. a first plurality of vehicles) that have the installed vehicle instrumentation systems in the vehicle to monitor data of the powertrain. The subsequently designed vehicles (i.e. a second plurality of vehicles) are the vehicles that include the "fine-tuned" powertrain based on the collected data from the telematics-based instrumentation of the initial set of vehicles. Furthermore, for the plurality of vehicles to exist, they must first have been built. Page 2, Col. 2, Paragraph one states that the OEM and key suppliers jointly use the data to make revisions to the vehicle and provide **feedback** to their parts suppliers. This means that key suppliers (i.e. manufacturers) are responsible for building the first plurality of vehicles (using suppliers to provide parts) and the second plurality of vehicles (i.e. the revised vehicles) because they "make revisions to vehicle design");

operating vehicles from the first plurality of vehicles in a captured test fleet (Page 2, Col. 2, second paragraph discloses that at the time of publishing, SAIC has completed one year of vehicle testing with the telematics system. Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The collected data are continually stored to disk while the driver and passenger are able to view vehicle and instrumentation status on an in vehicle computer. Further, Page 5, Col. 1, second paragraph discloses that the vehicles used in the operations testing are labeled a "fleet");

sending data from vehicles in the captured test fleet to the vehicle manufacturer via the telematics unit (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The data is sent to test engineers and managers to quickly diagnose vehicle problems and adjust vehicle testing. Page 2, Col. 2, Paragraph one teaches that the collected data are sent to key vehicle suppliers (i.e. manufacturers));

creating a revised design by revising the initial design in response to at least some of the data received by the vehicle manufacturer (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** and to provide accurate feedback to their parts suppliers on subsystem performance);

building a second plurality of vehicles according to a revised design (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** (i.e. build a second plurality of vehicles which are distinct from the first because the second plurality of vehicles include the revisions) and to provide accurate feedback to their parts suppliers on subsystem performance);

In sum, Courtright teaches a method and system for building an initial test set of vehicles which includes an integrated telematics unit, running diagnostic tests using the telematics unit, and reporting said data to various key suppliers and test engineers to make revisions on the initial design of the vehicle. The **only** differences between Courtright and the claimed invention are that Courtright: 1) does not teach that the telematics unit is specifically installed by the vehicle manufacturer, rather, as discussed on Page 2, paragraph [0001], it is installed by the SAIC engineers; 2) that the second plurality of vehicles includes the telematics unit; and 3) that some of the second plurality of vehicles are sold.

Specifically, Courtright does not teach (note that only the italicized portions are what Courtright does not teach):

the integrated telematics unit *installed by the vehicle manufacturer*;

wherein at least some of the second plurality of vehicles each include one of the integrated telematics units; and

selling some or all of the second plurality of vehicles to customers.

While Courtright discloses the limitation of installing the first plurality of vehicles with the integrated telematics unit, Courtright does not disclose that the integrated telematics unit is *installed by the vehicle manufacturer.*

However, the Examiner asserts that the data identifying the entity that installs the integrated telematics unit is simply a label for an entity and adds little, if anything, to the claimed acts or steps and thus does not serve to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through labels (i.e., the specific entity that installs the integrated telematics unit) which does not explicitly alter or impact the steps of the method does not patentably distinguish the claimed invention from the prior art in terms of

patentability. Whether the telematics unit is installed by the engineers, as taught by Courtright, or vehicle manufacturers, as claimed, the functional steps of the method --namely building of the vehicle and installation of the integrated telematics unit, is performed in the exact same way. The claimed vehicle manufacturer represents descriptive information in that changing the claimed limitation to another value not claimed does not alter the outcome of the claimed method.

Even though the particular person or entity installing the integrated telematics unit is descriptive labeling, to expedite prosecution, the Examiner uses Courtright to teach the feature of a vehicle manufacturer installing automotive parts. As above, Courtright, Page 2, Col. 2, Paragraph one already teaches that it is well-known in the vehicle manufacturing arts to install vehicle parts by vehicle manufacturers. The aforementioned section teaches that the OEM and key suppliers jointly use the data to **make revisions to vehicle design, such as improving the powertrain**, and to provide accurate feedback to their parts suppliers on subsystem performance. This shows that vehicle manufacturers and parts suppliers install vehicle parts.

Therefore, it would be prima facie obvious to substitute the claimed nonfunctional descriptive vehicle manufacturer with a different nonfunctional descriptive item and obtain the same outcome.

However, Courtright still does not teach:

wherein at least some of the second plurality of vehicles each include one of the integrated telematics units; and

selling some or all of the second plurality of vehicles to customers.

However, Telematics does teach:

wherein at least some of the second plurality of vehicles each include one of the integrated telematics units (Page 74, paragraph [0002] and [0003] teach that a telematics unit

will aid in the process of selling the car and that a consumer will come to expect that a telematics unit will be a standard feature of any car); and

selling some or all of the second plurality of vehicles to customers (Page 74, paragraph [0002] teaches that a telematics unit will aid in the process of selling the car).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Courtright to include a telematics unit in the second plurality of vehicles and then to subsequently sell those vehicles because, as stated on Page 2, Col. 2, paragraph one of Courtright, the objective of the method is to design a system for state of the art vehicle development programs. The purpose of developing vehicles is to ultimately sell them, and, as discussed on Page 74, paragraph [0002] of Telematics, having a telematics unit will aid in the selling of a car. It would be beneficial to include in the second set of revised vehicles the telematics unit because it would aid in the selling of the car, as taught by Telematics, and it would be beneficial to sell the plurality of cars to make a profit.

Additionally, it would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the actual telematics unit in the revised second plurality of vehicles and sell those vehicles because, as taught by Telematics since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25) **Regarding claim 2**, the combination of Courtright and Telematics make obvious the method of claim 1. The combination further teaches carrying out the following steps:

monitoring at least some of the vehicles by collecting data at those vehicles and transmitting it to the vehicle manufacturer via the integrated telematics unit (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The data is sent to test engineers and managers to quickly diagnose vehicle problems and adjust vehicle testing. Page 2, Col. 2, Paragraph one teaches that the collected data are sent to key vehicle suppliers (i.e. manufacturers));

identifying a vehicle improvement to be made (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** and to provide accurate feedback to their parts suppliers on subsystem performance);

designing the vehicle improvement (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** and to provide accurate feedback to their parts suppliers on subsystem performance); and

improving at least some of the vehicles with the vehicle improvement (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make**

revisions to vehicle design and to provide accurate feedback to their parts suppliers on subsystem performance).

However, the combination of references does not explicitly teach that these steps are performed for the sold vehicles after the selling step. Courtright, though, does make this step obvious.

Courtright, as discussed at length above, teaches, on Page 2, Col. 2, paragraph one that the telematics based instrumentation is used for a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. The collected data are critical to the fine-tuning of the power train and used to make revisions to the initial design. From this, it would have been obvious to a person having ordinary skill in the art at the time of the invention to include the integrated telematics unit in the revised set of vehicles and **perform the testing and monitoring steps in the *same way* as for the captured test fleet,** because it is obvious that the "fine-tuning" process will take several rounds. It is unreasonable to expect a perfect car to be made after one set of revisions.

Therefore, it would be obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Courtright invention to include the integrated telematics unit in the revised set of vehicles and **perform the testing and monitoring steps in the *same way* as for the captured test fleet** because several rounds of testing will be necessary to produce the best "state of the art" vehicle. It is unreasonable and near impossible to expect a perfect car to be built based on only one round of testing.

By employing the same monitoring and improving steps for the sold cars as was employed for the captured test fleet, an engineer can better achieve the objective of Courtright, stated on Page 2, Col. 2, paragraph one, of "state of the art vehicle development."

26) **Regarding claim 3**, the combination of Courtright and Telematics make obvious the method of claim 1. Courtright further teaches wherein, for each of at least some of the first plurality of vehicles, the sending step further comprises the steps of:

monitoring performance of a vehicle system within the vehicle (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. Page 7, Section 3.5, paragraph two states that some of the performances that are monitored include powertrain temperatures, manifold pressures, and electrical loads);

storing performance data for the vehicle system (Page 3, Background Section, Col. 1 teaches that the data are stored on disk and sent to the automotive design team);

establishing a wireless telematics connection between the vehicle and a service center (Page 2, Abstract, Paragraph one teaches that SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using real-time **wireless** data acquisition. The data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers);

communicating the performance data to the service center (Page 2, Abstract, Paragraph one teaches that SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using real-time **wireless** data acquisition. The data was transmitted to and

hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers);

storing the received performance data at the service center (Page 5, Col. 1, paragraph one states that the collected data are continually stored to disk. More pertinently, Page 4, Col. 2, Data Center teaches that the data collection center hosts up to 2.2 terabytes of vehicle instrumentation data in a relational database).

27) **Regarding claim 4**, the combination of Courtright and Telematics make obvious the method of claim 1. Courtright further teaches wherein the service center comprises a call center for the vehicle manufacturer (Page 5, Fig. 2 teaches that the database server and SAIC Data Center includes a Call Agent workstation. As above, Page 2, Abstract, Paragraph one teaches that the data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers (i.e. manufacturers)).

28) **Regarding claim 6**, Courtright discloses a method of producing and selling a vehicle, comprising the steps of:

designing a vehicle including a vehicle system (Page 2, Col. 1, last paragraph, and Col. 2, first paragraph disclose that the Science Applications International Corporation has **designed, developed, and implemented** a collaborative engineering enterprise that is comprised of a central data repository, web-based analysis tools, secure data distribution to vehicle developers in North American and Asia, and a **complete telematics-based instrumentation system** for state of the art vehicle development program. SAIC engineers have designed and installed vehicle instrumentation systems in the vehicles to remotely monitor and analyze powertrain and

instrumentation performance. The collaboration technology provides early insight into the engineering process, which can translate into a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. ***The collected data are critical to the fine-tuning of the powertrain***. Stated differently, the initial design of a vehicle is simply the vehicle (or, plurality of vehicles) that have the installed vehicle instrumentation systems in the vehicle to monitor data of the powertrain. The subsequently designed vehicles are the vehicles that include the "fine-tuned" powertrain based on the collected data from the telematics-based instrumentation of the initial set of vehicles. The vehicle system is simply the rest of the vehicle that is not the integrated telematics unit, such as, the powertrain);

building a plurality of pilot vehicles of the designed vehicle such that at least some of the pilot vehicles include both the vehicle system and an integrated telematics unit (As discussed above, Page 2, Col. 1, last paragraph, and Col. 2, first paragraph disclose that SAIC engineers have designed and installed vehicle instrumentation systems in the vehicles to remotely monitor and analyze powertrain and instrumentation performance. The collaboration technology provides early insight into the engineering process, which can translate into a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. ***The collected data are critical to the fine-tuning of the powertrain***. Stated differently, the initial design of a vehicle is simply the vehicle (or, plurality of vehicles – i.e. a pilot plurality of vehicles) that have the installed vehicle instrumentation systems in the vehicle to monitor data of the powertrain. The subsequently designed vehicles (i.e. a second plurality of vehicles) are the vehicles that include the "fine-tuned" powertrain based on the collected data from the telematics-based instrumentation of the initial set of

vehicles. Furthermore, for the plurality of vehicles to exist, they must first have been built. Page 2, Col. 2, Paragraph one states that the OEM and key suppliers jointly use the data to make revisions to the vehicle and provide **feedback** to their parts suppliers. This means that key suppliers (i.e. manufacturers) are responsible for building the pilot plurality of vehicles (using suppliers to provide parts) and the second plurality of vehicles (i.e. the revised vehicles) because they "make revisions to vehicle design");

creating a captured test fleet that includes the pilot vehicles (Further, Page 5, Col. 1, second paragraph discloses that the vehicles used in the operations testing are labeled a "fleet");

operating the captured test fleet (Page 2, Col. 2, second paragraph discloses that at the time of publishing, SAIC has completed one year of vehicle testing with the telematics system. Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The collected data are continually stored to disk while the driver and passenger are able to view vehicle and instrumentation status on an in vehicle computer. Further, Page 5, Col. 1, second paragraph discloses that the vehicles used in the operations testing are labeled a "fleet"); and,

for each pilot vehicle of the captured test fleet:

monitoring performance of the vehicle system within the pilot vehicles (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning

system data. The data is sent to test engineers and managers to quickly diagnose vehicle problems and adjust vehicle testing. Page 2, Col. 2, Paragraph one teaches that the collected data are sent to key vehicle suppliers (i.e. manufacturers));

storing data within a controller in the pilot vehicles in response to the monitoring (Page 4, Section 3.1 states that the in-vehicle system incorporates 15 GB of Data Storage);

automatically triggering within the telematics unit a telematics connection from the pilot vehicles to a service center (Page 2, Abstract, Paragraph one teaches that SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using **real-time wireless** data acquisition. The data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers);

communicating the data to the service center (Page 2, Abstract, Paragraph one teaches that SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using **real-time wireless** data acquisition. The data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers);

storing the data in the service center (Page 5, Col. 1, paragraph one states that the collected data are continually stored to disk. More pertinently, Page 4, Col. 2, Data Center teaches that the data collection center hosts up to 2.2 terabytes of vehicle instrumentation data in a relational database);

providing the data for at least some of the pilot vehicles to at least one person capable of influencing design of the monitored vehicle system (Page 2, Abstract, Paragraph one teaches that

SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using real-time **wireless** data acquisition. The data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers (i.e. to at least one person capable of influencing design of the monitored vehicle system));

modifying the design of the monitored vehicle system in response to the data (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** and to provide accurate feedback to their parts suppliers on subsystem performance);

producing production vehicles that include the vehicle system built according to the modified design (Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** (i.e. producing a modified plurality of vehicles which are distinct from the pilot because the second plurality of vehicles include the revisions) and to provide accurate feedback to their parts suppliers on subsystem performance).

In sum, Courtright teaches a method and system for building an initial test set of vehicles which includes an integrated telematics unit, running diagnostic tests using the telematics unit, and reporting said data to various key suppliers and test engineers to make revisions on the initial

design of the vehicle. The **only** differences between Courtright and the claimed invention are that Courtright does not teach selling at least some of the production vehicles.

Specifically, Courtright does not teach (note that only the italicized portions are what Courtright does not teach):

selling at least some of the production vehicles

However, Telematics does teach:

selling at least some of the production vehicles (Page 74, paragraph [0002] teaches that a telematics unit will aid in the process of selling the car).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Courtright to subsequently sell the production vehicles because, as stated on Page 2, Col. 2, paragraph one of Courtright, the objective of the method is to design a system for state of the art vehicle development programs. The purpose of developing vehicles is to ultimately sell them, and, as discussed on Page 74, paragraph [0002] of Telematics, having a telematics unit will aid in the selling of a car. It would be beneficial to include in the second set of revised vehicles the telematics unit because it would aid in the selling of the car, as taught by Telematics, and it would be beneficial to sell the plurality of cars to make a profit.

Additionally, it would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the selling of the production vehicles because, as taught by Telematics since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function

as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

29) **Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glen Courtright, Case Study of the Applicability of Applying Telematics Enabled Collaboration Technology to Advanced Powertrain Development, Support for Presentation Date found in PTO-892 "Final Program," dated January 19-24, 2003, hereinafter "Courtright," in view of "Telematics – A viewpoint," Business Briefing: Global Automotive Manufacturing & Technology, published 2002, hereinafter "Telematics," in view of Fiechter et al. (US 2003/0114965 A1), hereinafter "Fiechter."**

30) **Regarding claim 5**, the combination of Courtright and Telematics make obvious the method of claim 1. Courtright further teaches wherein the sending step further comprises the steps of:

collecting the data at the vehicle (Page 2, Col. 2, second paragraph discloses that at the time of publishing, SAIC has completed one year of vehicle testing with the telematics system. Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The collected data are continually stored to disk while the driver and passenger are able to view vehicle and instrumentation status on an in vehicle computer); and

transmitting the collected data to the vehicle manufacturer (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-

mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The data is sent to test engineers and managers to quickly diagnose vehicle problems and adjust vehicle testing. Page 2, Col. 2, Paragraph one teaches that the collected data are sent to key vehicle suppliers (i.e. manufacturers)).

However, Courtright does not teach:

providing a database including a list of vehicles, each associated with a captured test fleet identifier;

receiving a request for data;

determining which vehicles listed in the database have a captured test fleet identifier that corresponds to the request; and

transmitting a data retrieval request to the vehicles having the corresponding test fleet identifier.

However, Fiechter does teach:

providing a database including a list of vehicles, each associated with a captured test fleet identifier (Page 3, paragraph [0036] teaches that the condition monitoring system of the present invention frequently acquires and archives aggregated data from many vehicles, one of which includes a VIN number for the particular vehicles. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition);

receiving a request for data (As above, because the system acquires and archives data, such as the VIN, and other data such as load collectives and data-traces and other diagnostics, the

data must first be requested, otherwise no data could be acquired. Furthermore, the purpose of Fiechter is to monitor conditions of vehicles – i.e. the condition data is requested);

determining which vehicles listed in the database have a captured test fleet identifier that corresponds to the request (Page 3, paragraphs [0036] – [0038] teach condition monitoring that enables continuous observation of the status of each vehicle. The only vehicles that are monitored are those discussed in paragraph [0036], that have a particular VIN. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition); and

transmitting a data retrieval request to the vehicles having the corresponding test fleet identifier (Again, as above Page 3, paragraphs [0036] – [0038] teach a system for monitoring and archiving condition data of a particular set of vehicles. The system monitors the condition of the vehicle, which means that the system transmits a data retrieval request to request condition information about the particular vehicle).

It would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the above-mentioned limitations, as taught by Fietcher, since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

31) **Regarding claim 7**, the combination of Courtright and Telematics make obvious the method of claim 6. However, neither reference teaches:

wherein automatically triggering within the telematics units telematics connection from the pilot vehicle to a service center further comprises the steps of receiving an upload trigger from the service center via the telematics unit, and determining occurrence of the upload trigger.

However, Feitcher does teach:

wherein automatically triggering within the telematics units telematics connection from the pilot vehicle to a service center further comprises the steps of receiving an upload trigger from the service center via the telematics unit, and determining occurrence of the upload trigger (Page 2, paragraph [0030] and Page 8, paragraph [0100] teach an off-board system receiving information from the telematics platform based on a trigger or request of an off-board component. Further, for the telematics platform to know to send the data via the request or trigger, the telematics unit must determine the occurrence of the trigger).

It would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the receiving a trigger and determining occurrence of the upload trigger, as taught by Fietcher, since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

32) **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glen Courtright, Case Study of the Applicability of Applying Telematics Enabled Collaboration Technology to Advanced Powertrain Development, Support for Presentation Date found in PTO-892 "Final Program," dated January 19-24, 2003, hereinafter "Courtright," in view of Fiechter et al. (US 2003/0114965 A1), hereinafter "Fiechter."**

33) **Regarding claim 8**, Courtright discloses a system for vehicle design and manufacturing, comprising:

a captured test fleet comprising a plurality of vehicles having integrated telematics units installed in vehicles (Page 5, Col. 1, second paragraph discloses that the vehicles used in the operations testing are labeled a "fleet." Page 2, Col. 1, last paragraph, and Col. 2, first paragraph disclose that the Science Applications International Corporation has **designed, developed, and implemented** a collaborative engineering enterprise that is comprised of a central data repository, web-based analysis tools, secure data distribution to vehicle developers in North American and Asia, and a **complete telematics-based instrumentation system** for state of the art vehicle development program. SAIC engineers have designed and installed vehicle instrumentation systems in the vehicles to remotely monitor and analyze powertrain and instrumentation performance. The collaboration technology provides early insight into the engineering process, which can translate into a better understanding of how to effect positive change, avoid unnecessary cost increases, and reduce the impact of schedule delays. ***The collected data are critical to the fine-tuning of the powertrain***. Stated differently, the initial design of a vehicle is simply the vehicle (or, plurality of vehicles) that have the installed vehicle instrumentation systems in the vehicle to monitor data of the powertrain. The subsequently designed vehicles are the vehicles that include the "fine-tuned" powertrain based on the collected data from the telematics-based instrumentation of the initial set of vehicles. The vehicle system is simply the rest of the vehicle that is not the integrated telematics unit, such as, the powertrain);

a service center having a first database and a second database that stores performance data associated with vehicles in the captured test fleet (Page 2, Col. 2, second paragraph

discloses that at the time of publishing, SAIC has completed one year of vehicle testing with the telematics system. Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The collected data are continually stored to disk while the driver and passenger are able to view vehicle and instrumentation status on an in vehicle computer. Further, Page 5, Col. 1, second paragraph discloses that the vehicles used in the operations testing are labeled a "fleet." Further, Fig. 2 discloses a plurality of databases in the form of a plurality of computers and servers);

wherein said service center communicates with said vehicles via the integrated telematics units (Page 2, Abstract, Paragraph one teaches that SAIC instrumented a fleet of advanced vehicles to collect vehicle powertrain functionality data using **real-time wireless** data acquisition. The data was transmitted to and hosted on SAIC's wireless data center and readily accessible over a secure link between SAIC, the vehicle test engineers, and key vehicle component suppliers); and

wherein each of the vehicles collect and store the performance data at the vehicle and the subsequently send the performance data to the service center <u>and the requested performance data is used by a vehicle manufacturer for revising vehicle design and applying those revisions to producing vehicles</u> (As discussed above, Page 5, Col. 1, paragraph one then teaches that test operations are conducted and during test operations instrumentation system is collecting vehicle performance data from the CAN, electrical-mechanical sensors, Battery Control Unit, thermocouples, and global positioning system data. The data is sent to test engineers and

managers to quickly diagnose vehicle problems and adjust vehicle testing. Page 2, Col. 2, Paragraph one teaches that the collected data are sent to key vehicle suppliers (i.e. manufacturers). Page 2, Col. 2, Paragraph one teaches that the collected data are critical to the fine-tuning of the powertrain. Information learned from the information is shared between the OEM and key vehicle suppliers (i.e. manufacturers). The OEM and key suppliers jointly use the data to **make revisions to vehicle design** (i.e. producing a modified plurality of vehicles which are distinct from the pilot because the second plurality of vehicles include the revisions) and to provide accurate feedback to their parts suppliers on subsystem performance. Further, Page 4, section 3.1 teaches that the in-vehicle telematics unit stores data in a 15 GB Storage).

In sum, Courtright teaches a method and system for building an initial test set of vehicles which includes an integrated telematics unit, running diagnostic tests using the telematics unit, and reporting said data to various key suppliers and test engineers to make revisions on the initial design of the vehicle. The **only** differences between Courtright and the claimed invention are that Courtright does not teach each vehicle having an identifier, a database including the identifiers, and that the service center requests data.

Specifically, Courtright does not teach (note that only the italicized portions are what Courtright does not teach):

each vehicle having an identifier that associates the vehicle with the captured test fleet;

a database of vehicles that includes at least some of the vehicles in the captured test fleet and that includes the identifiers for some or all of the vehicles in the database; and

such that requests for performance data are sent from said service center to vehicles in the captured test fleet using identifiers contained in said first database.

However, Fiechter does teach:

each vehicle having an identifier that associates the vehicle with the captured test fleet (Page 3, paragraph [0036] teaches that the condition monitoring system of the present invention frequently acquires and archives aggregated data from many vehicles, one of which includes a VIN number for the particular vehicles. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition);

a database of vehicles that includes at least some of the vehicles in the captured test fleet and that includes the identifiers for some or all of the vehicles in the database (Page 3, paragraph [0036] teaches that the condition monitoring system of the present invention frequently acquires and archives aggregated data from many vehicles, one of which includes a VIN number for the particular vehicles. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition); and

such that requests for performance data are sent from said service center to vehicles in the captured test fleet using identifiers contained in said first database (As above, because the system acquires and archives data, such as the VIN, and other data such as load collectives and data-traces and other diagnostics, the data must first be requested, otherwise no data could be acquired. Furthermore, the purpose of Fiechter is to monitor conditions of vehicles – i.e. the condition data is requested. Page 3, paragraphs [0036] – [0038] teach condition monitoring that enables continuous observation of the status of each vehicle. The only vehicles that are monitored are those discussed in paragraph [0036], that have a particular VIN. These are in a captured test fleet because these are a set of vehicles (i.e. a fleet) that are being monitored continuously for condition. The system monitors the condition of the vehicle, which means that

the system transmits a data retrieval request to request condition information about the particular vehicle).

It would have been obvious to one of ordinary skill in the art to include in the telematics vehicle development system of Courtright the above-mentioned limitations, as taught by Fietcher, since the claimed invention is merely a combination of old elements, and in the combination each element taught would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicants' arguments filed in the Appeal Brief of 2/20/2013 have been fully considered, but are deemed moot in light of the new grounds for rejection. It should be noted that Applicants do not argue the Double Patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Conference Final Program for The 2003 International Symposium on Collaborative Technologies and Systems CTS 2003 is being included in the PTO-892 form to provide evidence, on Page 11, that Courtright was presented on January 24, 2003. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARYAN WEISENFELD whose telephone number is (571)272-6602. The examiner can normally be reached on Monday-Friday 8 AM - 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. W./
Examiner, Art Unit 3689

/GERARDO ARAQUE JR/
Primary Examiner, Art Unit 3689