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EXAMINER

LAROSE, COLIN M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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



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FEB 26 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001029
PATENT NO. : 6459806
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No..	Patent Under Reexamination	
	95/001,029	6459806	
	Examiner	Art Unit	
	COLIN M. LAROSE	3992	

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

Responsive to the communication(s) filed by:

Patent Owner on 29 June 2009
 Third Party(ies) on 27 July 2009

Patent owner may once file a submission under 37 CFR 1.951(a) within 2 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. PTO-1449

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-133 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims See Continuation Sheet are confirmed. [Unamended patent claims]
4. Claims 34-36 and 43-45 are patentable. [Amended or new claims]
5. Claims 1-3,6-8,14-19,21-24,28-33,37-42,46-48,82-84,88-94 and 98-100 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 - been received. not been received. been filed in Application/Control No _____
10. Other _____

Continuation of SUMMARY OF ACTION:

3. Claims 4,5,9-13,20,25-27,49-81,85-87,95-97 and 101-133 are confirmed. [Unamended patent claims].

ACTION CLOSING PROSECUTION

1. This action is in response to:
 - Patent Owner's amendments and remarks dated 6/29/09 ("POR"); and
 - Third Party Requester's remarks dated 7/27/09 ("TPR").

Expiration of U.S. Patent 6,459,806

2. The '806 patent has an earliest effective filing date of February 5, 1990, and therefore expired on February 5, 2010 (see MPEP § 2701). Pursuant to 37 CFR 1.530(j), no amendments (except claim cancellations) may be introduced for entry in an expired patent. Accordingly, the previous amendments to claims 30 and 40 proposed by Patent Owner are now withdrawn, and all further reexamination proceedings of the '806 patent shall be with respect to the unamended patent claims. [The treatment of the claims below is with respect to the unamended patent claims 30 and 40.]

Response to Arguments

IV. TOSHIBA and MOSLER

3. Issue IV.A—Whether Toshiba qualifies as a Printed Publication

On pp. 21-23 of POR, the Patent Owner refutes the availability of Toshiba as a printed publication and argues that, notwithstanding the date of 1985 on the document, there is no evidence in the record indicating that the document was sufficiently publicly accessible in order to qualify as prior art under § 102.

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35 U.S.C. §§ 310 and 311 denote that reexamination may be carried out only on the basis of "patents and printed publications." MPEP § 2128 sets forth guidelines for determining whether a document qualifies as a "printed publication":

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

The date of accessibility by the public can be shown through evidence of routine business practices for handling documents (MPEP § 2128.02):

Evidence showing routine business practices can be used to establish the date on which a publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), cert. denied, 988 U.S. 892 (1988) (Court held that evidence submitted by Intel regarding undated specification sheets showing how the company usually treated such specification sheets was enough to show that the sheets were accessible by the public before the critical date.); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) (Librarian's affidavit establishing normal time frame and practice for indexing, cataloging and shelving doctoral theses established that the thesis in question would have been accessible by the public before the critical date.).

The Patent Owner points out that the initial burden is on the Examiner to establish that a document qualifies as a printed publication (see POR, pp. 21-22).

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In response, the Third party submitted the following as evidence supporting the availability of the document as a "printed publication" (see TPR, pp. 9-10):

The CF-401 machine described in the Toshiba reference was also offered for sale by the Toshiba Corporation during the same period as the CF-400 and CF-420 currency discriminating machines. (Ex. 1, Magee Depo. of April 9, 2009 at p 10, ll. 4-12; p. 11, ll. 1-5; p. 14, ll. 4-25; p. 43, l. 8 to p. 44, l. 5 (discussing CF-400, CF-401, and CF-420); Ex. 2, Zambito Decl. dated July 27, 2009 at ¶¶ 5-11 (discussing CF-400, CF-401, and related manuals); Ex. 3, William Jones Decl. dated Oct. 1, 2002 at 3-4 (discussing CF-400); Ex. 4, Doug Mennie Decl. at 8 (discussing CF-420); *see also* Reexamination Control No. 95/001,029, Office Action mailed Mar. 27, 2009 (hereinafter "Office Action") at p. 5 (noting that the CF-401 machine is "substantially similar" to the CF-400 machine.). Thus, a person skilled in the art of currency discriminators would have

been aware of the CF-400, CF-401, and CF-420 machines and would have knowledge that the associated manuals (including the Toshiba reference) could be accessed and reviewed either with the corresponding machine, or by seeking them directly from Toshiba Corporation or its distributors.

The cited portions of the Magee deposition recite the following:

- 4 Q. Were you ever aware of the existence of
5 products called the CF-401?
6 A. Yes.
7 Q. How did you become aware of the CF-401
8 product?
9 A. I saw an ad in a magazine.
10 Q. Did you ever see one personally?
11 A. I may have seen one at a business show. I
12 don't recall.

p. 10, lines 4-12

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1 Q. How about the CF-420 product, did you ever
2 personally become aware of the existence of a CF-420
3 product?

4 A. I knew there was one offered, but I don't
5 know if I've ever seen one.

p. 11, lines 1-5

4 Q. You mentioned that you sold the CF-400; is
5 that correct?

6 A. Correct.

7 Q. Do you remember when you started selling the
8 CF-400?

9 A. I believe maybe 1984.

10 Q. And is your company located right here in
11 Hartford?

12 A. Middlefield, Connecticut.

13 Q. Middlefield. And is that where you sold the
14 CF-400 products from, your office here in Middlefield?

15 A. Correct.

16 Q. And who were some of the typical customers
17 that you sold the machines to?

18 A. As I recall, I believe we only sold them to
19 banks. I don't believe any armored carriers bought
20 any at that time, but it all would have been large
21 banks.

22 Q. Do you remember where the banks were
23 located?

24 A. Probably, but they probably changed their
25 name. They were all over the United States.

p. 14, lines 4-25

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- 8 Q. You mentioned you've never actually seen a
9 CF-420 product?
10 A. I don't believe I've ever seen them.
11 Q. Do you know whether Mosler was ever trying
12 to sell CF-420 products?
13 A. I think they were selling, trying to sell
14 them or sold it.
15 Q. What leads you to believe that they were
16 trying to sell the CF-420 product?
17 A. Because I heard it gave a lot of trouble.
18 Q. You heard that the product --
19 A. This was my decision, I decided not to take
20 this product on because of my relationship with
21 Mosler, so I never took it on. I never saw it, but I
22 know that Mosler took it on, and it gave a lot of
23 trouble, so I was very pleased.
24 Q. All right. In what respect did it give
25 Mosler trouble?

- 1 A. The 400 worked perfectly and this one was
2 awful.
3 Q. Really. Do you remember in what respect?
4 A. They had a lot of technical difficulty with
5 the product.

p. 43, line 8—p. 44, line 5

The above passages do not support a conclusion that the Toshiba document was publicly disseminated prior to the earliest effective date of the '806 Patent. In fact, the above passages make no mention of the Toshiba document.

The cited portions of the Zambito deposition recite the following:

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5. As indicated in the attached manuals, the CF-400 and CF-401 each provided a count mode in which a stack of mixed denomination were placed in the feeder and the machine determined the denomination of each of the bills in the stack. As also described in the manuals, the machine would send denominated bills first to stacker "A" (the upper stacker) until it was full, and then to stacker "B" (the lower stacker). The upper and lower stackers each had a capacity of 150 bills. Therefore, if the stack of mixed denominations had 100 bills (a common quantity), all of the denominated bills would be delivered to stacker "A" (the upper stacker). Rejected bills that could not be denominated were sent to the reject stacker.

5. During the mid- and late-1980s, the Toshiba CF-400 and CF-401 machines were also being sold in the United States by Mosler, Inc. ("Mosler"). During this same period, I personally operated the CF-400 and CF-401, and observed the machines in use, including several of the machines sold by Mosler. The models of the CF-400 and CF-401 sold by Magner and Mosler appeared to be identical.

6. Operating manuals were including with each of the CF-400 and CF-401 machines sold by Magner during the mid- and late-1980s. It was my experience seeing CF-400 and CF-401 machines sold by Mosler that Mosler also included operating manuals with each machine

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that it sold during this same period. As with other electronic devices, such as televisions, audiovisual equipment, and computers, it has been a standard industry practice to include an operating manual with each currency discriminating machine. During this period, I also provided customers additional copies of these manuals, for example, in the event that that the manual included with each machine was lost.

7. Exhibit I to this Declaration is a copy of a brochure for a CF-400 machine, which was publicly distributed and which I observed while I was selling CF-400 machines in the mid- to late-1980s.

8. Exhibit 2 to this Declaration is a copy of an operating manual for a CF-400 machine, titled *Mosler Toshiba CF-400 Series Customer Operating Instructions*, which I observed while I was selling CF-400 machines in the mid- to late-1980s.

9. Exhibit W to this Declaration is a true and correct copy of an operating manual for a CF-400 machine, titled *Specification on Toshiba Currency Fitness Sorter Model: CF-401*, which I observed while I was selling CF-400 machines in the mid- to late-1980s.

10. I first reviewed each of the Exhibits attached hereto in the mid- and late-1980s in connection with my experience selling these machines.

11. The Exhibits attached hereto were not considered or maintained as proprietary or otherwise confidential. On several occasions while visiting customers during the mid- and late-1980s, I reviewed the manuals and product literature distributed with CF-400 and CF-401 machines sold by Mosler, which was a competitor of Magner. Exhibits 2 and W are copies of product literature prepared and distributed by Mosler, which I reviewed during my experience selling CF-400 and CF-401 machines during the mid- and late 1980s.

The above passages suggest that Mr. Zambito, a dealer for the Magner corporation in the 1980's, may have come into contact with Mosler product manuals during his dealings with customers. More specifically, he states that he "observed [the Toshiba document] while [he] was selling CF-400 machines in the mid- to late-1980's. He also states that "[i]t was [his] experience seeing CF-400 and CF-401 machines sold by Mosler that Mosler also included operating manuals with each machine that it sold during this same period."

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Mr. Zambito was not an employee of the Mosler corporation and therefore, does not appear to have firsthand knowledge of Mosler's business practices. In addition, while he asserts that he "observed" the Toshiba document while selling machines in the 1980's, he does not specifically state who possessed the document, how many observations of the document he made, or how those in possession of the document came to acquire it.

The Zambito declaration establishes that the CF-400 and CF-401 models were sold in the 1980's by two different companies—Magner and Mosler—however, it does not establish with any degree of certainty whether the Toshiba document was freely distributed with the corresponding devices sold by either Mosler or Magner, or whether the Toshiba document was ever publicly disseminated, catalogued, or otherwise made available via routine business practices to those interested in the art of currency counting and denominating. In sum, there is insufficient evidence in the Zambito declaration to support a conclusion that the Toshiba document qualifies as a "printed publication" in accordance with 35 U.S.C. § 102.

The cited pages of the Jones and Mennie declarations are nearly identical and only appear to generally discuss the historical background and technical characteristics of the CF-420 and CF-400. Neither declaration mentions the Toshiba document.

Accordingly, the evidence relied upon by the Third Party is insufficient to establish the availability of the Toshiba document as a printed publication. Therefore, all of the previous rejections relying on Toshiba have been withdrawn.

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4. Issue IV.B—Whether Toshiba's Disclosure Enables the Claimed Invention

On pp. 23-26 of POR, the Patent Owner argues that Toshiba's disclosure does not enable the claimed invention. The Third Party refutes this argument on pp. 10-12 of TPR.

On this issue, the Third Party's arguments are persuasive. Based on Toshiba's disclosure, one skilled in the art at the time the invention was made would likely not be subject to undue experimentation in order to achieve the claimed invention. An analysis of the *Wands* factors (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) weighs in favor of Toshiba being an enabling prior art reference. See MPEP § 2164.01(a). In particular, the breadth and generality of the claims, the level of predictability in the electronic and currency-sorting arts, and the level of one of ordinary skill in the art at the time of the invention all support the conclusion that one skilled in the art could have made and used the claimed invention as disclosed by Toshiba without undue experimentation. As noted by the Third Party, each of the limitations alleged not to be enabled by Toshiba corresponds to a structure or process that was within the level of ordinary skill at the time of the invention. Toshiba's disclosure need not teach the specific details of how to implement each individual component or individual step that is well-known; disclosure of simply the combination of these well-known elements is sufficient to enable the claimed invention.

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5. Issue IV.C—Whether the § 102 Rejections Based on Toshiba are Proper

On pp. 26-27 of the POR, the Patent Owner asserts that the rejections in paragraphs 5 and 6 of the previous Office action are improper since (1) Toshiba does not qualify as a printed publication, (2) Toshiba's disclosure is not enabling with respect to the claims, and (3) Toshiba does not teach "one and only one output receptacle," as claimed. The Third Party refutes these arguments on pp. 12-13 of the TPR.

Since Toshiba was determined not to qualify as a printed publication, as explained above, Toshiba does not anticipate the claims under § 102(a) or (b). On the other hand, Toshiba's disclosure is enabling with respect to the claimed invention, as explained above, and Toshiba does appear to disclose an embodiment in which bills are delivered to "one and only one receptacle," as explained on p. 13 of the TPR.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

6. Issue IV.D.1—Whether the § 103 Rejections Based on Toshiba Alone are Proper

On pp. 27-38 of the POR, the Patent Owner asserts that the rejections in paragraphs 9 and 11 of the previous Office action are improper since (1) Toshiba does not qualify as a printed publication, (2) Toshiba's disclosure is not enabling with respect to the claims, (3) there are substantial differences between Toshiba and the claimed invention, and (4) the claimed invention is unobvious in light of secondary considerations. The Third Party refutes these arguments on pp. 13-18 of the TPR.

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Since Toshiba was determined not to qualify as a printed publication, as explained above, Toshiba does not obviate the claims under § 103. On the other hand, Toshiba's disclosure is enabling with respect to the claimed invention, as explained above, and Toshiba does appear to teach or render obvious limitations relating to delivering [successfully evaluated] bills to "one and only one output receptacle," high-speed processing, and denominating based on only the green side of bills, as explained on p. 13 of the TPR.

The secondary considerations in favor of non-obviousness presented by the Patent Owner and the contrary remarks by the Third Party have been considered, however, they are considered moot at this time since Toshiba has been determined not to qualify as a printed publication, and Toshiba does appear to teach or render obvious limitations relating to delivering [successfully evaluated] bills to "one and only one output receptacle," high-speed processing, and denominating based on only the green side of bills, as explained on pp. 13 and 19-21 of the TPR.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

7. Issue IV.D.2—Whether the § 103 Rejections Based on Toshiba in View of Mosler are

Proper

On pp. 38-49 of the POR, the Patent Owner asserts that the rejections in paragraphs 4, 7, 8, 10, 12-15, and 17 of the previous Office action are improper since (1) Toshiba does not qualify as a printed publication, (2) Toshiba's disclosure is not enabling with respect to the claims, (3) Mosler does not qualify as a printed publication, (4) Mosler's disclosure is not

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enabling with respect to the claims, (5) there are substantial differences between Toshiba in view of Mosler and the claimed invention, and (6) the claimed invention is unobvious in light of secondary considerations. The Third Party refutes these arguments on pp. 18-22 of the TPR.

Since Toshiba was determined not to qualify as a printed publication, as explained above, Toshiba does not obviate the claims under § 103. On the other hand, Toshiba's disclosure is enabling with respect to the claimed invention, as explained above.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

8. Whether Mosler Qualifies as a Printed Publication

On pp. 40-42 of POR, the Patent Owner refutes the availability of Mosler as a printed publication and argues that, notwithstanding the date of 1989 on the document, there is no evidence in the record indicating that the document was sufficiently publicly accessible in order to qualify as prior art under § 102.

In response, the Third Party submitted the following as evidence supporting the availability of the document as a "printed publication" (see TPR, p. 18):

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The Patent Owner first argues that Mosler is not a printed publication. (Resp. at 40-42.) Mosler is a parts catalog for the Mosler/Toshiba CF-400 product. (Request, Ex. U.) The catalog is dated 1989 and is marked with a price of \$70.00. (*Id.* at U0001.) At the time Mosler, Inc. sold the CF-400 products in the United States. (Ex. 1, Magec Depo. of April 9, 2009 at 18, line 17 to 19, line 18; *id.* at 22, line 18 to 23, line 4; *id.* at 25, line 1 to 26, line 11; Ex. 2, Zambito Decl. dated July 27, 2009 at ¶ 5 (same and noting access to manuals by a competitor).) The Mosler reference is not marked as confidential in any form. These facts clearly indicated that the Mosler reference was offered for sale to customers who bought parts for the CF-400 product. As such, the Mosler reference was available to persons who were interested in the relevant art and, accordingly, a “printed publication” under 35 U.S.C. § 102(b). *In re Klopfenstein*, 380 F.3d at 1348 (Fed. Cir. 2004) (noting that “[t]he statutory phrase ‘printed publication’ has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art”).

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The cited portions of the Magee deposition recite the following:

- 17 Q. In the mid-to-late eighties, was there
18 anyone else selling CF-400s in the U.S.?
19 A. Mosler Corporation.
20 Q. Do you remember where they were located?
21 A. Ohio, I believe.
22 Q. Was there any relationship between Mosler
23 Corporation and Magner?
24 A. No.
25 Q. Do you know if Mosler still exists?

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- 1 A. No. I know they don't.
2 Q. All right. Do you know if there was anyone
3 else in the U.S. selling the CF-400s at the time?
4 A. No, I don't believe there was.
5 Q. Is there anything that caused Magner to stop
6 selling the CF-400s?
7 A. Yes.
8 Q. What was that?
9 A. We felt that Mosler was undercutting our
10 price too drastically, and we decided we didn't want
11 to continue marketing the product any further.
12 Q. Was Mosler related to Toshiba at all?
13 A. No. They were an independent company buying
14 the product the same as Magner.
15 Q. Are you aware of anyone else other than
16 Mosler and Magner who were selling the CF-400 back in
17 the mid-to-late eighties?
18 A. No.

p. 18, line 17—p. 19, line 18

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18 Q. Do you know for how long prior to Magner
19 Mosler was selling the machine?
20 A. I would have to assume a couple of years,
21 but I have no basis for making that judgment.
22 Q. Do you have any recollection of the
23 quantities of these CF-400 machines that Magner sold
24 in the eighties?
25 A. I believe we sold just slightly less than

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1 100.
2 Q. And were all those sales to banks here in
3 the U.S.?
4 A. Yes.

p. 22, line 18—p. 23, line 4

The above passages merely establishes that Mosler, in addition to Magner, offered the CF-400 for sale during the 1980's. There is no mention of the Mosler document.

The cited portions of the Zambito declaration recite the following:

5. As indicated in the attached manuals, the CF-400 and CF-401 each provided a count mode in which a stack of mixed denomination were placed in the feeder and the machine determined the denomination of each of the bills in the stack. As also described in the manuals, the machine would send denominated bills first to stacker "A" (the upper stacker) until it was full, and then to stacker "B" (the lower stacker). The upper and lower stackers each had a capacity of 150 bills. Therefore, if the stack of mixed denominations had 100 bills (a common quantity), all of the denominated bills would be delivered to stacker "A" (the upper stacker). Rejected bills that could not be denominated were sent to the reject stacker.

5. During the mid- and late-1980s, the Toshiba CF-400 and CF-401 machines were also being sold in the United States by Mosler, Inc. ("Mosler"). During this same period, I personally operated the CF-400 and CF-401, and observed the machines in use, including several of the machines sold by Mosler. The models of the CF-400 and CF-401 sold by Magner and Mosler appeared to be identical.

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The above passage merely establishes that Mr. Zambito was aware that Mosler sold CF-400 and CF-401 machines during the 1980's. There is no mention of the Mosler document.

The evidence relied upon by the Third Party is insufficient to establish the availability of the Mosler document as a printed publication for essentially the same reasons as above for the Toshiba document. Therefore, all of the previous rejections relying on Mosler have been withdrawn.

9. Whether Mosler Enables the Claimed Invention

On this issue, the Third Party's arguments are persuasive. Based on Mosler's disclosure, one skilled in the art at the time the invention was made would likely not be subject to undue experimentation in order to achieve the claimed invention. An analysis of the *Wands* factors (In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) weighs in favor of Toshiba being an enabling prior art reference. See MPEP § 2164.01(a). In particular, the breadth and generality of the claims, the level of predictability in the electronic and currency-sorting arts, and the level of one of ordinary skill in the art at the time of the invention all support the conclusion that one skilled in the art could have made and used the claimed invention as disclosed by Toshiba without undue experimentation. As noted by the Third Party, each of the limitations alleged not to be enabled by Mosler corresponds to a structure or process that was within the level of ordinary skill at the time of the invention. Mosler's disclosure need not teach the specific details of how to implement each individual component or individual step that is

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well-known; disclosure of simply the combination of these well-known elements is sufficient to enable the claimed invention.

10. Issue IV.D.3—Whether the § 103 Rejections Based on Toshiba in View of Mosler and Emery '829 are Proper

On pp. 49-55 of the POR, the Patent Owner asserts that the rejections in paragraph 16 of the previous Office action are improper since (1) neither Toshiba nor Mosler qualifies as a printed publication, (2) Toshiba's and Mosler's disclosures are not enabling with respect to the claims, (3) there are substantial differences between Toshiba in view of Mosler and Emery '829, and the claimed invention, and (4) the claimed invention is unobvious in light of secondary considerations. The Third Party refutes these arguments on pp. 22-23 of the TPR.

Since Toshiba and Mosler were determined not to qualify as a printed publication, as explained above, Toshiba and Mosler do not obviate the claims under § 103. On the other hand, Toshiba's and Mosler's disclosures are enabling with respect to the claimed invention, as explained above. In addition, Emery '829 does appear to teach scanning "along a single segment" of each bill, as claimed in claims 130 and 131. In particular, Emery '829 teaches that the whole bill need not be scanned; a single area, i.e., a single segment of the bill, can be selected for scanning and correlation with a stored pattern—see Emery '829, column 6/1-4. Emery '829 is only relied upon for the teaching that a single segment of a bill can be used for scanning and correlation in order to identify the bill.

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The secondary considerations in favor of non-obviousness presented by the Patent Owner and the contrary remarks by the Third Party have been considered, however, they are considered moot at this time since Toshiba and Mosler have been determined not to qualify as a printed publications.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

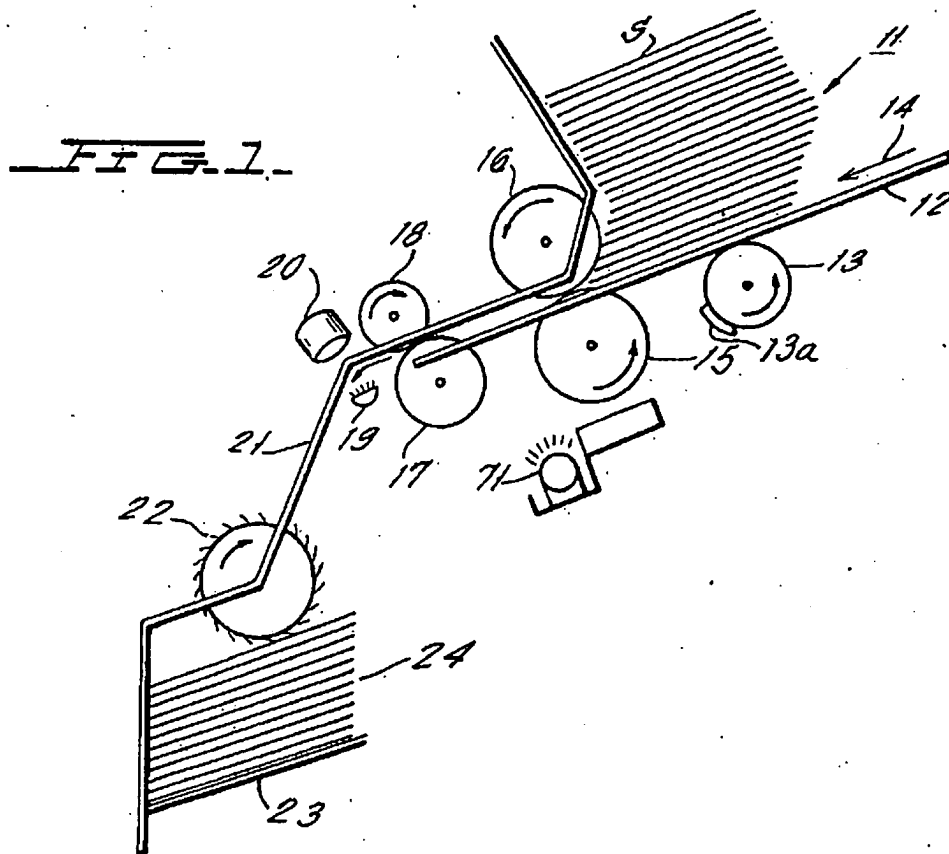
V. O'MALEY

11. Issues V.A—Whether the § 102 Rejections Based on O'Maley are Proper

On pp. 55-56 of the POR, the Patent Owner asserts that the rejections in paragraph 18 of the previous Office action are improper since O'Maley does not teach delivering bills to one and only one stacker wheel containing output receptacle. The Third Party refutes these arguments on pp. 23-24 of the TPR.

The Patent Owner asserts that the rollers 56 in figure 2 of O'Maley are "nip rollers" rather than "stacker wheels" and that these nip rollers do not perform a stacking function. Patent Owner's arguments are persuasive inasmuch as it appears that the rollers 56 are utilized to roll a bill pass the counters 58 rather than to actually stack the bills. In addition, O'Maley does not teach or suggest that the rollers 56 perform a stacking function. O'Maley's rollers 56 are similar to those of Jones (U.S. 4,114,804), shown as elements 17 and 18 below, as opposed to Jones' stacker mechanism 22:

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Accordingly, O'Maley does not appear to teach a "stacker wheel," and therefore, does not anticipate or render obvious the claims reciting a stacker wheel or a stacking mechanism having flexible blades.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

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12. Issue V.B.1—Whether the § 103 Rejections Based on O'Maley Alone are Proper

On pp. 57-59 of the POR, the Patent Owner asserts that the rejections in paragraph 20 of the previous Office action are improper since O'Maley does not teach (1) delivering bills to one and only one stacker wheel containing output receptacle (2) a "stacker wheel" or a stacking mechanism "having flexible blades," (3) delivering denominated bills of a plurality of denominations to one and only one output receptacle or single stack, (4) transporting the bills in the narrow dimension, and (5) the claimed invention is unobvious in light of secondary considerations. The Third Party refutes these arguments on pp. 24-26 of the TPR.

Patent Owner's arguments are persuasive, and the rejections in paragraph 20 are now withdrawn:

(1,2) As explained above for Issue V.A, O'Maley does not disclose or suggest a stacker wheel mechanism.

(3) In figure 1, O'Maley delivers denominated bills of a plurality of denomination to multiple corresponding output bins. In figure 2, O'Maley delivers denominated bills of a single denomination to a single output bin 54, and all other bills to a separate output bin 60. However, O'Maley does not appear to disclose or suggest denominated bills of a plurality of denominations being delivered to a single output bin, as claimed. Furthermore, there is no apparent reason or motivation to properly combine O'Maley's two embodiments without resorting to hindsight bias.

(4) O'Maley teaches transporting bills in the long dimension. O'Maley also teaches that other well-known transport mechanisms could be utilized and that the scanner elements can be positioned in a variety of manners, as pointed out by the Third Party, however, there is no indication that O'Maley intended the orientation of the transported bills could be changed. The

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cited passages seem to merely teach that the type of transport mechanism could be different than that disclosed by O'Maley, but there is no evidence or teaching in O'Maley alone showing that transportation in the narrow dimension was an obvious or well-known method of transporting bills.

(5) The secondary considerations in favor of non-obviousness presented by the Patent Owner and the contrary remarks by the Third Party have been considered, however, they are considered moot at this time since the § 103 based on O'Maley alone have been withdrawn for other reasons.

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) are moot since the rejections in question are now withdrawn.

13. Issue V.B.2—Whether the § 103 Rejections Based on O'Maley in view of Jones are Proper

On pp. 59-68 of the POR, the Patent Owner asserts that the rejections in paragraphs 21-22 of the previous Office action are improper since the combination of O'Maley and Jones does not teach (i) denominating multiple denominations in excess of 800 or 1000 bills per minute, (ii) delivering evaluated bills of multiple denominations to one and only one output receptacle (iii) delivering bills to one and only one stacker wheel containing output receptacle, (iv) a "stacker wheel" or a stacking mechanism "having flexible blades," (v) tracking the total value of denominated bills of multiple denominations, (vi) denominating based on only the green side of bills, (vii) transporting the bills in the narrow dimension, and (c) the claimed invention is

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unobvious in light of secondary considerations. The Third Party refutes these arguments on pp. 26-30 of the TPR.

(i) Patent Owner's arguments are persuasive on this issue. O'Maley does not disclose denominating bills at a rate in excess of 800 bills per minute, and Jones is directed to the task of bill counting rather than bill denomination. Therefore, the limitation of "in excess of 800 bills per minute" overcomes the previous rejections over O'Maley in view of Jones.

(ii-iv) Patent Owner's assertion that O'Maley does not disclose (ii) delivering evaluated bills of multiple denominations to one and only one output receptacle (iii) delivering bills to one and only one stacker wheel containing output receptacle, and (iv) a "stacker wheel" or a stacking mechanism "having flexible blades," is correct. However, it appears that the teachings of Jones would cure such deficiencies.

Figure 1 of O'Maley is a system that denominates multiple denominations of bills and then places each bill into a corresponding bin. Figure 1 of Jones illustrates a bill counting device that delivers each counted bill to a single output bin 24. While the convenience of having different denominations of bills in separate output bins according to figure 1 of O'Maley is readily apparent, so to is the desirability of having all of the denominated bills in a single stack according to figure 1 of Jones. That is, it is an arbitrary decision whether a user desires the bills to be automatically sorted according to denominations or simply remain in the same single stack as prior to processing. The type of bin used (O'Maley's sorted bin or Jones' single stack bin) has no bearing on the denominating of the bills—that is, whether O'Maley's output bin sorts or simply stacks the bills would have no effect on the actual denomination process that precedes the output process. Those skilled in the art would have found it obvious to modify O'Maley by Jones

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to stack bills in the same single stack in which the bills were received prior to denomination without undermining the operation of O'Maley's bill denomination system. In addition, Jones teaches the usual and customary way of stacking processed bills in a single output bin having a stacker wheel 22 having flexible blades (see column 3/6166). Jones shows that such a configuration of a single output bin in a bill processing device was conventional at the time the invention was made, and the decision whether to sort bills based on denomination (O'Maley) or simply stack processed bills into a single bin (Jones) is essentially an arbitrary design consideration that does not rely on the manner in which the bills are processed.

Therefore, the limitation of a single output bin with a stacker wheel having flexible blades is obviated by Jones' teachings.

(v) It is believed that O'Maley renders obvious the limitation of tracking the total value of denominated bills of multiple denominations. At column 4/21-24, O'Maley teaches that the number counted of each particular denomination is displayed. It would have been a trivial and obvious modification to those skilled in the art to additionally display the total value of the denominated bills. Official notice is taken of the fact that it would have been well within the realm of technical expertise of those skilled in the art to calculate and display the total value of a given stack of bills once the numbers of each type of bill are known, and the desirability for such information would have been readily apparent.

(vi) Examiner agrees with Requester's contention that denominating based on only the green side of bills is substantially equivalent to denominating based on only the black side of the bills. It seems that no unexpected results have been achieved by choosing the green side over the

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black side, and as noted on p. 29 of TPR, both sides convey similar information concerning the denomination of a bill.

(vii) It is believed that transporting the bills in the narrow dimension was an obvious modification to O'Maley in view of the teachings of Jones. In particular, O'Maley expressly teaches that "in general, many of the numerous types of well-known transport mechanisms well known in the art could be utilized" (column 3/60-63) in O'Maley's system. Jones teaches a conventional transport mechanism that transports bills with the narrow dimension parallel to the transport direction. Since O'Maley does not teach that the disclosed orientation of the transported bills is critical or otherwise required, those skilled in the art, based on the suggestion at column 3/60-63 in O'Maley, would have looked to other conventional means for transporting bills such as Jones and would have found it obvious to modify O'Maley to include a transport system that moves bills in the direction of the narrow dimension.

(c) The secondary considerations in favor of non-obviousness presented by the Patent Owner and the contrary remarks by the Third Party have been considered. Based on the evidence and facts presented, it is believed that the high-speed, compact bill denomination device invented by the Patent Owner was not obvious at the time the invention was made. The relatively high speed and compactness of such a device appear to be the critical separation points from other prior art devices. Accordingly, the claims that recite the high-speed properties of the device—viz., processing bills in excess of 800 or 1000 bills per minute—are considered unobvious. However, those claims that recite no limitation of the speed of processing and merely combine prior art elements in an obvious arrangement are considered obvious variants of the prior art.

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Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) have been considered, however, to the extent that the claim charts of the Request present a prima facie case of obviousness, it is not improper to incorporate such portions after careful review.

VI. DLR-J, DLR-X and DLR-H

14. Issue VI.A—Whether DLR-J, DLR-X, and DLR-H qualify as a Printed Publications

On pp. 68-71 of POR, the Patent Owner refutes the availability of DLR-J, DLR-X, and DLR-H as printed publications and argues that there is no evidence in the record indicating that these documents were sufficiently publicly accessible in order to qualify as prior art under § 102.

In response, the TPR asserts (pp. 30-32) that each of these documents does qualify as a printed publication:

DLR-H is a copy of Appendix 2 to the De La Rue 3100 Technical Manual. (Request, Ex. H, DLR-H.) DLR-J is a copy of a De La Rue US Dollar Sorter 3110 Mk II brochure. (Request, Ex. J, DLR-J.) DLR-X is a copy of the De La Rue 3100 Operator Instructions. (Request, Ex. X, DLR-X.) The manual, brochure, and operator instructions of DLR-H, DLR-J, and DLR-X should be deemed printed publication because each pertains to and accurately describes the De La Rue 3100 series machines which were sold abroad beginning in 1983 and in the United States beginning in 1987. (Request, Ex. Z, Lacey Decl. at ¶¶ 76, 93, 94; Ex. 6, Lacey Depo. of Nov. 10, 2006 at 137, lines 16 to 140, line 19); Ex. 7, Dolgins Depo. of Jan. 9, 2007 at 77, line 18 to 78, line 14 (noting sales from 1981 to 1987 of the De La Rue 3100 series machines in the United States for use with United States currency, and describing publication of the DLR-O reference); *id.* at 78, lines 14-25; *id.* at 79, line 18 to 79, line (recalling sales in about 1985 to banks in New York, Michigan, and Iowa).) Thus, a person skilled in the art of currency discriminators would have been aware of the De La Rue 3100 series machines and would have knowledge that the associated literature could be accessed and reviewed either with the corresponding machine, or by seeking it directly from De La Rue or its distributors. *In re Klopfenstein*, 380 F.3d at 1348 (Fed. Cir. 2004) (noting focus on accessibility by “the public interested in the art” and that there is no requirement for proof of distribution).

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With regard to the DLR-X manual, the Patent Owner argues that it can't be considered a publication because the particular copy provided with the Request was marked "PROVISIONAL" and includes blank pages, a missing section, and "chopped off" footers. (Resp. at 69.) First, the Patent Owner has pointed to no authority to suggest that documents marked "PROVISIONAL" or documents that are less than a perfect copy cannot be considered a printed publication. More importantly, Requester respectfully points out that this document is over 20 years old, and that it is not surprising that in the past 20 years certain pages have been lost or rearranged and that repeated copying has "chopped off" some of the footers.

The Patent Owner also argues that DLR-X can't be considered a printed publication because there is no evidence that it was actually disseminated. However, as noted above, there is simply no requirement that a document must have been actually disseminated to be considered a printed publication.

With regard to the DLR-H manual, the Patent Owner similarly argues that it can't be considered a printed publication because the copy provided with the Request contains handwriting, blank pages, schematics, different dates, out of order figures, and duplicate figures. (Resp. at 70.) Again, the Patent Owner has pointed to no authority to suggest that less than perfect copies cannot be considered a printed publication. This document is also over 20 years old, and it is similarly not surprising that over the past 20 years the document has acquired handwriting (none of which is relied on for the rejection).

The Patent Owner next submits its Exhibit 3 to suggest that DLR-H was confidential and not publicly available. (Resp. at 70.) Contrary to the Patent Owner's argument, its Exhibit 3 is not a copy of the complete manual of which DLR-H was a part. DLR-H is not found in Exhibit 3 nor even referenced in Exhibit 3. Rather, Exhibit 3 is simply another copy of Operating Instructions for the De La Rue 3100 series, which does not include DLR-H as an appendix and which does not even include a confidentiality designation as suggested by the Patent Owner. (Resp., Ex. 3.) The Patent Owner's "confidentiality" argument should therefore be rejected.

According to the above remarks, the Third Party cites the following passages of the Lacey Declaration, Lacey Deposition, and Dolgins Deposition in support of the claim that DLR-H, DLR-J, and DLR-X qualify as printed publications:

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76. Since 1987, the 3100 series machines that denominated U.S. currency, were sold and offered for sale in the U.S.

93. The De La Rue 3110 MK II machine, which was sold in the mid-late 1980s, combined the teachings of the "De La Rue 3100 Operator Instructions," the "3110 MK II & 3120 Software Configuration Procedure," the "De La Rue 3110 MK II Brochure," the "De La Rue 3100 Technical Manual, Appendix 2," and the "De La Rue 3110 MK2 Technical Manual." Based on my 20 years of experience at De La Rue dealing with these systems (see above), the various components depicted in these references were indeed designed to work together in the actual De La Rue 3110 Mk II machine, and one of ordinary skill in the art would understand the components described in these references to be compatible.

94. The De La Rue 3100 desktop machine was conceived and designed based on the success of De La Rue with the 3400 and 3500 large sorters and the two systems shared many similarities, including a similar currency denomination technique based on correlation. This is confirmed in the sentence contained within the document titled "At 8 P.M. Tonight", which is a promotional brochure for the 3100 and was created around the 1983 introduction date of the 3100 to the market. The sentence on the third page of the document reads, "Using the technology and understanding gained in developing the 3400 high speed sorting systems, De La Rue has built the 3100... a compact, currency fitness sorting machine..." confirming my knowledge and experience at De La Rue that the 3100 machine was based on the 3400 sorters and the two systems shared common technology.

Lacey Declaration, 1/10/2008, paragraphs 76, 93, and 94

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16 @@@> Q. Well, I notice -- I believe you testified
17 earlier that the 3100 series included -- I wrote down
18 the 3100. I don't know if there is a specific 3100
19 model?

20 A. There was a 3100, to the best of my
21 knowledge, yes.

22 Q. And a 3110, 3120, and then I think you
23 mentioned a 3110 Mk I and a 3110 Mk II?

24 A. I don't think there was one specifically
25 called Mk I, but it was implied it was a Mk I because

1 there was a Mk II.

2 Q. If you could look at Emery Exhibit 6,
3 could the 3100 denominate US bills?

4 A. The 3100 series machines could denominate
5 US currency, yes.

6 Q. If you put in mixed denominations of US
7 bills in the 3100, could it generate a report telling
8 you how many bills you had of each denomination?

9 A. Yes, you could get a similar sort of
10 report that we talked about for the 3000 series out of
11 the 3100 series pattern system.

12 Q. So it would generate a report with the
13 special codes on one side?

14 A. Yes.

15 Q. And a list on the other side of the
16 number of bills that are associated with each code?

17 A. Yes. I can't remember the detail so much
18 about that 3100 because it wasn't my major machine, but
19 I certainly know you could do that sort of thing.

20 Q. And when did De La Rue sell 3100 machines
21 that had the ability to generate this report regarding
22 the various denominations of US bills you just
23 mentioned?

24 A. It was sort of '83/84 sort of time
25 period, from memory.

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1 Q. Well, in your report -- maybe this
2 helps --
3 A. I'm just trying to think.
4 Q. I was looking at page 10, paragraph 76.
5 A. Okay. No, that is correct. It was when
6 work started on the detector, which was around '83/84.
7 Q. So work started on the detector in
8 '83/84?
9 A. In that sort of time period.
10 Q. What do you mean? What work started on
11 the detector?
12 A. That was when -- I think the guy's name
13 was Ralph Kimber, started the development work.
14 Q. What was his development work?
15 A. To develop a -- that one I do believe was
16 started for US currency specifically.
17 Q. So in -- maybe in '83/84 is when --
18 A. That sort of time period.
19 Q. So that is when Ralph Kimber started to
20 design a detector for the 3100 that could denominate US
21 bills; is that correct?
22 A. That sort of time period, yes.
23 Q. And that wasn't sold until 1987?
24 A. To the best of my recollection that is
25 the sort of time period, yes.

1 Q. How do you know that?
2 A. How do I know that?
3 Q. Yes?
4 A. Well, I know the machine was sold in the
5 States and I know it was that sort of time period just
6 from what else was going on in my career at that time.
7 Q. And do you know who it was sold to in the
8 United States?
9 A. Specifically, no. I do know that it is
10 there because I had seen a 3100 series machine in
11 operation in the US when I visited. I can't remember
12 the name of the bank, all I know is that at the time
13 I was visiting the Fed' in Richmond.
14 Q. Was it at the Richmond Fed'?
15 A. No, it wasn't at the Richmond Fed'; I was
16 visiting them.
17 Q. And you saw it being used in another
18 bank?
19 A. Correct.

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14 Q Exhibit 5 makes specific
15 reference to the DeLaRue Systems' 3100
16 machine. You will see, for example,
17 DOL011 as containing this reference. Did
18 your office market the DeLaRue 3100
19 machine?

20 A Yes, we did.

21 Q Can you describe that machine
22 for us, please?

23 A It was a machine that we, you
24 know, developed specifically for the
25 purposes of sorting currency for fitness,

1 for automatic teller machines. It had
2 sensors built in to identify certain sizes
3 of holes, corner folds, the actual
4 crispness of the bill, and it was a
5 desktop machine which would act as a
6 counter as well as a sorter, and would
7 sort good bills and bad bills to
8 individual pockets. Also, there was a
9 cold pocket, so it if couldn't read the
10 bill, so we would have continuous
11 operation so there was, like, a 3 pocket.
12 You fed money into the top. It went
13 through a series of sensors. Good bills
14 in one pocket, bad bills in another
15 pocket. Those bills that couldn't be
16 distinguished were sent into a cold
17 pocket.

18 Q What country of origin was the
19 currency that was processed by the 3100?

20 A For our purposes, it was our
21 currency entirely.

22 Q Did your office, your DeLaRue
23 actually sell any of the DeLaRue 3100
24 machines --

25 MR. FOOTE: Objection.

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1 Q -- in the United States?
2 MR. FOOTE: I'll repeat my
3 objections.
4 Q You may answer.
5 A Yes, we did. To banks in New
6 York. The first sale was to, I believe,
7 Michigan National Bank in the Detroit
8 area. We sold a number of machines here
9 in New York, and even in Davenport, Iowa,
10 as I recall, we sold quite a few.

Dolgin's Deposition, 1/9/07, pp.78-80

While the above passages discuss the operations of the 3100 series De La Rue machines, they do not mention the availability of the associated DLR-H, DLR-J, and DLR-X documents as qualifying prior art. The evidence relied upon by the Third Party Requester therefore does not establish that these documents are "printed publications" under 35 U.S.C. § 102—i.e., the evidence does not establish with any degree of certainty whether the DLR-H, DLR-J, and DLR-X documents were actually distributed with the corresponding devices, or whether the documents were ever publicly disseminated, catalogued, or otherwise made available via routine business practices to those interested in the art of currency counting and denominating without restriction. That is, it is unclear whether these documents were "disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, [could have] locate[d]" them prior to the earliest effective date of the '806 patent (see MPEP § 2128).

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15. Issue VI.B—Whether DLR-J, DLR-X, and DLR-H enable the claimed invention

On pp. 71-76 of POR, the Patent Owner argues that the disclosures of DLR-J, DLR-X, and DLR-H do not enable the claimed invention. The Third Party refutes this argument on pp. 32-36 of TPR.

On this issue, the Third Party's arguments are persuasive. Based on the combination of teachings in these documents, one skilled in the art at the time the invention was made would likely not be subject to undue experimentation in order to achieve the claimed invention. An analysis of the *Wands* factors (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) weighs in favor of the documents being enabling prior art references. See MPEP § 2164.01(a). In particular, the breadth and generality of the claims, the level of predictability in the electronic and currency-sorting arts, and the level of one of ordinary skill in the art at the time of the invention all support the conclusion that one skilled in the art could have made and used the claimed invention as taught by the combination of DLR-J, DLR-X, and DLR-H without undue experimentation. As noted by the Third Party, each of the limitations alleged not to be enabled by the DLR manuals corresponds to a structure or process that was within the level of ordinary skill at the time of the invention. Prior art disclosure need not teach the specific details of how to implement each individual component or individual step that is well-known; disclosure of simply the combination of these well-known elements is sufficient to enable the claimed invention. To the extent that any of the three documents do not disclose claim limitations, such is an issue for consideration under §§ 102 and 103. However, due to the high predictability of the relevant area of technology and the general level of skill in the art at the time of the invention,

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the DLR-J, DLR-X, and DLR-H documents are considered enabling prior art disclosures with respect to the claim language.

16. Issue VI.C—Whether the § 103 Rejections based on DLR-J, DLR-X, and/or DLR-H are Proper

On pp. 76-85 of the POR, the Patent Owner asserts that the rejections in paragraphs 24 and 25 of the previous Office action are improper since (1) DLR-J, DLR-X, and DLR-H do not qualify as printed publications, (2) the disclosures of DLR-J, DLR-X, and DLR-H are not enabling with respect to the claims, and (3) the combinations of DLR-J, DLR-X, and/or DLR-H do not render the claims obvious.

The Third Party refutes these arguments on pp. 12-13 of the TPR.

With respect to the rejections in paragraph 24 (obviousness over DLR-J in view of DLR-X), Patent Owner argues that the combination does not teach: (i) automatically denominating bills of a plurality of U.S. denominations, (ii) delivering evaluated bills to an output comprising one and only one stacker wheel-containing output, and (iii) delivering any bill that has been denominated to one and only one output receptacle.

With respect to the rejections in paragraph 25 (obviousness over DLR-J in view of DLR-X and DLR-H), Patent Owner argues that the combination does not teach: (i) automatically denominating bills of a plurality of U.S. denominations, (ii) delivering evaluated bills to an output comprising one and only one stacker wheel-containing output, (iii) delivering any bill that has been denominated to one and only one output receptacle, and (iv) denominating based on reflected light characteristic information.

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(i) Patent Owner's arguments regarding the limitation of "automatically denominating bills of a plurality of U.S. denominations" are persuasive. This limitation is construed to mean that the claimed method automatically ascertains the differences among a plurality of different denominations of bills (i.e., \$1, \$5, and \$20 bills) and classifies the bills accordingly. On the other hand, the devices described in the DLR documents appear to only denominate (that is, identify and classify) bills of a single denomination at a time. The DLR machines require *manually* selecting the denomination to be identified, such that only a single denomination can be identified and classified, whereas the claimed invention allows receipt of a stack of bills and *automatically* denominating bills of a plurality of denominations. The claims do not require bills to be denominated in a single run, but they do require automatic denomination of a plurality of bill denominations—something that is not possible when manual reconfiguration is required.

(ii) Third Party Requester's arguments with respect to the limitation of "delivering evaluated bills to an output comprising one and only one stacker wheel-containing output," are persuasive. All claims in the '806 patent are method claims. Delivering denominated bills to only one stacker-wheel bin meets the claim language, regardless of the fact that the device actually includes other output bins. That is, the claims do not preclude a device from having more than one stacker-wheel output bin—they merely limit the deliverance of denominated bills to one and only one output bin.

(iii) Third Party Requester's arguments with respect to the limitation of "delivering any bill that has been denominated to one and only one output receptacle," are persuasive for substantially the same reasons as issue (ii) above. So long as denominated bills are delivered to

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one and only one output receptacle, the claim language is met. (Whether the bills are in fact "automatically denominated" as claimed is discussed in issue (i) above).

(iv) Third Party Requester's arguments with respect to the limitation of "denominating based on reflected light characteristic information," are persuasive. Based on the relevant portions of DLR-H (H0003), it is apparent that bills are denominated based on "reflected light characteristic information," as claimed. (Whether the bills are in fact "automatically denominated" as claimed is discussed in issue (i) above).

All of the claims in the '806 patent require (i) "automatically denominating bills of a plurality of U.S. denominations," which limitation is not anticipated or rendered obvious by combinations of DLR-J, DLR-X, and DLR-H, as discussed above. Accordingly, the previous obviousness rejections in paragraphs 24 and 25 of the Office action have been withdrawn. [The rejections are also withdrawn because none of the DLR-J, DLR-H, and DLR-X documents currently qualify as printed publications, as previously explained.]

Furthermore, Patent Owner's remarks with respect to Rule 1.104(a)(2) and (c)(2) and secondary considerations of non-obviousness have been considered but are moot since the rejections in question have been withdrawn.

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Disposition of the Proposed Rejections

17. **Ground #1 (not adopted as modified)** — Claims 1, 2, 6, 7, and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Toshiba in view of Mosler.

The proposed § 102 rejections over Toshiba recited in ¶¶ 1, 7, 25, 30, 47, 51, and 53 of the Request are not adopted since neither Toshiba nor Mosler qualify as printed publications, as explained above.

18. **Ground #2 (not adopted)** — Claim 16 is rejected under 35 U.S.C. § 102(b) as being anticipated by Toshiba.

This ground of rejection is not adopted as recited in ¶ 63 of the Request since Toshiba does not qualify as a printed publication, as explained above.

19. **Ground #3 (not adopted)** — Claims 91, 93, 98 and 99 are rejected under 35 U.S.C. § 102(b) as being anticipated by Toshiba, as evidenced by the Joint Claim Construction.

This ground of rejection is not adopted as recited in ¶¶ 331, 341, 358, and 363 of the Request since Toshiba does not qualify as a printed publication, as explained above.

20. **Ground #4 (not adopted as modified)** — Claim 92 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba, as evidenced by the Joint Claim Construction, in view of Mosler.

This ground of rejection (¶ 336 of the Request) is not adopted as modified since neither Toshiba nor Mosler qualify as printed publications, as explained above.

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21. **Ground #5 (not adopted as modified)** — Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba, as evidenced by the Emery Declaration, in view of Mosler.

This ground of rejection (¶ 22 of the Request) is not adopted as modified since neither Toshiba nor Mosler qualify as printed publications, as explained above.

22. **Ground #6 (not adopted)** — Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba, as evidenced by the Emery Declaration.

This ground of rejection is not adopted as recited in ¶ 85 of the Request since Toshiba does not qualify as a printed publication, as explained above.

23. **Ground #7 (not adopted as modified)** — Claims 66-68 and 70-74 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler, as evidenced by the Joint Claim Construction and by the Emery Declaration.

This ground of rejection (¶¶ 234, 238, 242, 250, 254, 258, 262, and 265 of the Request) is not adopted as modified since neither Toshiba nor Mosler qualify as printed publications, as explained above.

24. **Ground #8 (not adopted)** — Claims 76-80 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba, as evidenced by the Joint Claim Construction and by the Emery Declaration.

This ground of rejection is not adopted as recited in ¶¶ 273, 277, 281, 285, and 289 of the Request since Toshiba does not qualify as a printed publication, as explained above.

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25. **Ground #9** (not adopted as modified) — Claims 3, 17, and 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler and in view of the well-known use of flexible blades.

This ground of rejection (¶¶ 13, 70, 89, 94, and 99 of the Request) is not adopted as modified since neither Toshiba nor Mosler qualify as printed publications, as explained above.

26. **Ground #10** (not adopted) — Claims 3, 4, 8, 15, 17-19, 21-24, 28-33, 37-42, 46-48, 82-84, 87-90, 94, and 100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler.

This ground of rejection is not adopted as recited in ¶¶ 12, 17, 35, 58, 69, 74, 79, 88, 93, 98, 103, 112, 115, 119, 123, 127, 131, 139, 143, 146, 150, 154, 158, 171, 175, 179, 296, 301, 306, 315, 318, 323, 326, 346, and 366 of the Request since Toshiba does not qualify as a printed publication, as explained above.

27. **Ground #11** (not adopted) — Claims 49-58 and 125-129 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler, as evidenced by the Emery Declaration.

This ground of rejection is not adopted as recited in ¶¶ 184, 187, 190, 193, 196, 199, 202, 205, 208, 211, 441, 445, 449, 453, and 457 of the Request since neither Toshiba nor Mosler qualify as printed publications, as explained above.

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28. **Ground #12 (not adopted)** — Claims 69, 75, and 81 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler, as evidenced by the Joint Claim Construction and the Emery Declaration.

This ground of rejection is not adopted as recited in ¶¶ 246, 269, and 293 of the Request since neither Toshiba nor Mosler qualify as printed publications, as explained above.

29. **Ground #13 (not adopted)** — Claims 130 and 131 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler, as evidenced by the Emery Declaration, and further in view of Emery '829 and the Graves Testimony.

This ground of rejection is not adopted as recited in ¶¶ 461 and 465 of the Request since neither Toshiba nor Mosler qualify as printed publications, as explained above.

30. **Ground #14 (not adopted)** — Claims 18, 40-42, and 46-48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Toshiba in view of Mosler and in view of the well-known use of flexible blades.

This ground of rejection is not adopted as recited in ¶¶ 75, 151, 155, 159, 172, 176, and 180 of the Request since neither Toshiba nor Mosler qualify as printed publications, as explained above.

31. **Ground #15 (not adopted)** — Claims 1, 2, 4, 6, 7, 14, and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by O'Maley, as evidenced by the Joint Claim Construction.

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This ground of rejection is not adopted as recited in ¶¶ 2, 8, 18, 26, 31, 54, and 59, of the Request for the reasons given above for Issue V.A.

32. **Ground #16 (not adopted)** — Claims 16-19, 82, 83, 88-93, and 98-100 are rejected under 35 U.S.C. § 102(b) as being anticipated by O'Maley, as evidenced by the Joint Claim Construction.

This ground of rejection is not adopted as recited in ¶¶ 64, 71, 76, 80, 297, 302, 319, 324, 327, 332, 337, 342, 359, 364, and 367 of the Request.

Independent claims 16, 82, and 91 each recite "denominating bills of a plurality of U.S. denominations" and delivering denominated bills to "one and only one output receptacle." O'Maley, however, does not teach delivering denominated bills of *different* denominations to a single output receptacle, as claimed. As shown in figure 1 of O'Maley, there are different output receptacles for different denominations so that different denominations of bills do not get mixed up and stacked in a single output receptacle; similarly, in figure 2, only denominated bills of the denomination of interest are delivered to the output receptacle 54—all bills of other denominations are "rejected" and stacked in a separate receptacle 60.

In addition, all references to the Joint Claim Construction are moot since reexamination proceedings conform to the "broadest reasonable" interpretation of claims rather than claim constructions produced in court. See MPEP § 2258, subsection I.G. "Claim Interpretation and Treatment."

As recited in claims 16, 82, and 91 and corresponding dependant claims 17-19, 83, 88-90, 92, 93, and 98-100, "evaluating" appears to refer to analyzing a bill, whereas "denominating"

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appears to refer to identifying the value of a bill. Accordingly, "denominating" bills is considered to correspond to "evaluating" bills insofar as denominating bills is one method of evaluating bills, i.e., denominating is a subset of evaluating.

33. **Ground #17 (not adopted)** — Claims 3, 12, 13, 21-23, 29-32, 37-42, 46, 47, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Maley, as evidenced by the Joint Claim Construction.

This ground of rejection is not adopted as recited in ¶¶ 14, 48, 52, 91, 96, 101, 117, 120, 124, 128, 140, 144, 147, 152, 156, 160, 173, 177, and 181 of the Request for the reasons given above for Issue V.B.1.

34. **Ground #18 (adopted-in-part)** — Claims 1-3, 5-9, 14-25, 28-34, 37-43, 46-54, 57-60, 63-69, 72-78, 81-85, 88-95, 98-108, 110-115, 119-124, 132, and 133 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Maley in view of Jones.

As explained above for Issue V.B.2, the claims that recite processing speed (i.e., 800+ bills/minute) are patentable over the combination of O'Maley and Jones. However, claims that do not recite the high processing speed and merely arrange prior art elements in an obvious manner as considered an obvious variant of O'Maley in view of Jones for the reasons given above.

Adopted: Claims 1-3, 6-8, 14-19, 21-24, 28-33, 37-42, 46-48, 82-84, 88-94, and 98-100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Maley in view of Jones. (See explanation above for Issue V.B.2).

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Not Adopted: Claims 5, 9, 20, 25, 34, 42, 49-54, 57-60, 63-69, 72-78, 81, 85, 95, 101-108, 110-115, 119-124, 132, and 133 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Maley in view of Jones. (See explanation above for Issue V.B.2)

35. **Ground #19 (not adopted)** — Claims 10, 11, 26, 27, 35, 36, 44, 45, 55, 56, 61, 62, 70, 71, 79, 80, 86, 87, 96, 97, 109, 116-118, and 125-131 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Maley in view of Jones, as evidenced by the Graves Testimony.

As explained above for Issue V.B.2, the claims that recite processing speed (i.e., 800+ bills/minute) are patentable over the combination of O'Maley and Jones. However, claims that do not recite the high processing speed and merely arrange prior art elements in an obvious manner as considered an obvious variant of O'Maley in view of Jones for the reasons given above.

Claims 10, 11, 26, 27, 35, 36, 44, 45, 55, 56, 61, 62, 70, 71, 79, 80, 86, 87, 96, 97, 109, 116-118, and 125-131 all recite transporting/denominating in excess of 800 bills per minute; therefore, the above rejections are not adopted—see explanation above for Issue V.B.2.

36. **Ground #20 (not adopted)** — Claims 1 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellner in view of Jones.

This ground of rejection is not adopted as recited in ¶¶ 4 and 66 of the Request since the Request does not specify which claim limitations Sellner discloses and lacks or which limitations in Jones cure any deficiencies in Sellner's disclosure. In addition, the Request does not provide a specific motivation for combining the teachings Sellner of Jones—it simply refers to column 1/41-44 of Sellner, which passage merely states, "a principle of the present invention to provide a

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currency discriminator particularly useful in high speed automated banking devices such as currency counters." There is no nexus between this passage and specific teachings in Jones that would cure putative deficiencies in Sellner in relation to the claim language.

37. **Ground #21 (not adopted)** — Claims 1-3, 6, 7, 12, 14, 16, 17, 21-23, 28, 30-32, 37, 91-93, and 98 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DLR-J in view of DLR-X, as evidenced by the Joint Claim Construction and the Lacey Declaration.

This ground of rejection is not adopted as recited in ¶¶ 5, 10, 16, 28, 33, 49, 56, 67, 73, 92, 97, 102, 114, 122, 126, 130, 142, 334, 339, 344, and 361 of the Request since DLR-J and DLR-X do not qualify as printed publications, as explained above for Issue VI.A.

38. **Ground #22 (not adopted)** — Claims 4, 15, 18, 19, 29, 39, 82, 83, 88, 90, and 100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DLR-J in view of DLR-X and DLR-H, as evidenced by the Joint Claim Construction and the Lacey Declaration.

This ground of rejection is not adopted as recited in ¶¶ 19, 61, 78, 82, 118, 149, 299, 304, 321, 329, 369 of the Request since DLR-J, DLR-X, and DLR-H do not qualify as printed publications, as explained above for Issue VI.A.

Proposed Rejections Lacking a Substantial New Question of Patentability

39. The proposed rejections in ¶¶ 6, 11, 20, 21, 24, 29, 34, 37, 38, 40, 41, 43, 44, 46, 50, 57, 62, 68, 83, 84, 87, 105, 107, 109, 111, 133, 135, 137, 162, 163, 165, 166, 168, 169, 183, 186, 189, 192, 195, 198, 201, 204, 207, 210, 213, 215, 216, 218, 219, 221, 222, 224, 225, 227, 228,

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230, 232, 233, 236, 237, 240, 241, 244, 245, 248, 249, 252, 253, 256, 257, 260, 261, 264, 267, 268, 271, 272, 275, 276, 279, 280, 283, 284, 287, 288, 291, 292, 295, 300, 305, 308, 309, 311, 312, 314, 317, 322, 330, 335, 340, 345, 348, 349, 351, 352, 354, 355, 357, 362, 370, 371, 373, 374, 376, 377, 379, 380, 382, 383, 385, 387, 389, 390, 392, 393, 395, 396, 398, 399, 401, 402, 404, 405, 407, 408, 410, 412, 413, 415, 416, 418, 419, 421, 422, 424, 425, 427, 428, 430, 431, 433, 434, 436, 437, 439, 440, 443, 444, 447, 448, 451, 452, 455, 456, 459, 460, 463, 464, 467, 468, 470, and 471 of the Request have not been considered because they do not raise a substantial new question of patentability. These proposed rejections rely in part on DLR-G, DLR-O, and/or DLR-Q, each of which has not been established as eligible prior art under one or more subsections (a) and (b) of 35 U.S.C. § 102. See Order Granting Reexamination dated 5/22/2008.

Information Disclosure Statement

40. Third Party Requester is reminded that only U.S. Patents and printed publications are appropriate for reexamination. Court documents, documents of USPTO proceedings, transcripts of depositions, declarations, etc. can be submitted as supplementary evidence or exhibits and placed in the file history, however, they are not suitable for listing on an IDS and will not be printed on the face of a Reexamination Certificate. Those references appearing on the IDS submitted 7/27/09 have been lined through.

Conclusion

41. **This is an ACTION CLOSING PROSECUTION (ACP)**; see MPEP § 2671.02.

(1) Pursuant to 37 CFR 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 CFR 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 CFR 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

42. Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are

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provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3). See MPEP § 2665.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam
 Attn: Central Reexamination Unit
 Commissioner for Patents
 United States Patent & Trademark Office
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
 Central Reexamination Unit

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

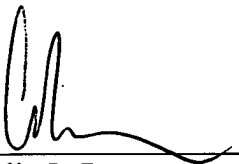
<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) state that correspondence (except for a request for reexamination and a corrected replacement request for reexamination) will be considered timely if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) it includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to the Office of Patent Legal Administration at (571) 272-7701.



Colin LaRose
Primary Examiner
Art Unit 3992

Conferees:

