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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,420	01/07/2011	5692067	985-P-2REX	6523

41230 7590 01/13/2012

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/13/2012

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



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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,420.

PATENT NO. 5692067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/011,420	Patent Under Reexamination 5692067
	Examiner COLIN LAROSE	Art Unit 3992

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

- a Responsive to the communication(s) filed on _____. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

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

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO/SB/08. 4. _____.

Part II SUMMARY OF ACTION

- 1a. Claims 1-80 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1-80 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____.
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

REEXAMINATION OF U.S. PATENT 5,692,067

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 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 negated by the manner in which the invention was made.

Rejections based on Hatanaka (SNQ 1)

3. Claims 1, 6, 9, 13, 16, 22, 25, 28, 30, and 76, are rejected under 35 U.S.C. 102(b) as being anticipated by Hatanaka.

Regarding claim 1, Hatanaka discloses a currency evaluation device for receiving a stack of currency bills and rapidly evaluating all the bills in the stack, said device comprising:

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an input receptacle for receiving a stack of bills to be evaluated (paper currency placement platform 2, figures 1 and 2);

a single output receptacle for receiving said bills after said bills have been evaluated (paper currency stacking platform 23, figures 1 and 2);

a transport mechanism for transporting said bills, one at a time, from said input receptacle to said output receptacle along a transport path (as shown in figure 2 of Hatanaka);

a discriminating unit for evaluating said bills (discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200), said discriminating unit including a detector positioned along said transport path between said input receptacle and said output receptacle (see figure 4), said discriminating unit counting and determining the denomination of said bills (see last paragraph, p. H0014: discriminator unit discriminates the denomination of the paper currency; see p. H0015: count calculation device 200 counts the number of bills); and

means for flagging a bill when the denomination of said bill is not determined by said discriminating unit (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture).

Regarding claim 13, Hatanaka discloses a document evaluation device for receiving a stack of documents and rapidly evaluating all the documents in the stack, said device comprising:

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an input receptacle for receiving a stack of documents to be evaluated, genuine ones of said documents each having one of a plurality of images thereon, said plurality of images defining a plurality of document types (paper currency placement platform 2, figures 1 and 2, received mixed currency);

a single output receptacle for receiving said documents after said documents have been evaluated (paper currency stacking platform 23, figures 1 and 2);

a transport mechanism for transporting said documents, one at a time, from said input receptacle to said output receptacle along a transport path (as shown in figure 2 of Hatanaka);

a discriminating unit for evaluating said documents (discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200), said discriminating unit including a detector positioned along said transport path between said input receptacle and said output receptacle (see figure 4), said discriminating unit being capable of distinguishing among said plurality of document types by scanning the image on each of said documents, said discriminating unit counting and determining the document type of said documents (see last paragraph, p. H0014: discriminator unit discriminates the denomination of the paper currency; see also third paragraph, p. H0014: "mixed denomination" mode can be selected, and see third full paragraph, p. H0015: count calculation device counts the bills); and

means for flagging a document when the type of said document is not determined by said discriminating unit (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture).

Regarding claim 16, Hatanaka discloses a method of counting and discriminating currency bills of different denominations using a currency evaluation device comprising the steps of:

receiving a stack of bills to be evaluated in an input receptacle of the evaluation device (paper currency placement platform 2, figures 1 and 2, receives bills to be denominated and counted);

transporting, under control of the evaluation device, said bills, one at a time, from said input receptacle to a single output receptacle of the evaluation device (Hatanaka's bill transport system, shown in figure 2, transports bills one at a time to the paper currency stacking platform 23, figures 1 and 2);

counting and determining the denomination of said bills under control of the evaluation device (counting and denominating is carried out by discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200); and

flagging a bill when the denomination of said bill can not be determined under control of the evaluation device (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture).

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Regarding claim 28, Hatanaka discloses a method of counting and discriminating documents of different types using a document evaluation device comprising the steps of:

receiving a stack of documents to be evaluated in an input receptacle of the evaluation device, genuine ones of said documents each having one of a plurality of images thereon, said plurality of images defining a plurality of document types (paper currency placement platform 2, figures 1 and 2, receives bills of mixed denomination to be denominated and counted);

transporting, under control of the evaluation device, said documents, one at a time, from said input receptacle to a single output receptacle of the evaluation device (Hatanaka's bill transport system, shown in figure 2, transports bills one at a time to the paper currency stacking platform 23, figures 1 and 2);

counting and determining the type of said documents under control of the evaluation device (counting and denominating is carried out by discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200), said evaluation device distinguishing among said plurality of document types by scanning the image on each of said documents (see third paragraph, p. H0014: "mixed denomination" mode can be selected); and

flagging a document when the type of said document can not be determined under control of the evaluation device (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture).

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Regarding claim 30, Hatanaka discloses a currency evaluation device for receiving a stack of currency bills and rapidly evaluating all the bills in the stack, said device comprising:

an input receptacle for receiving a stack of bills to be evaluated (paper currency placement platform 2, figures 1 and 2);

at least one output receptacle for receiving said bills after said bills have been evaluated (paper currency stacking platform 23, figures 1 and 2);

a transport mechanism for transporting said bills, one at a time, from said input receptacle to said output receptacle along a transport path (as shown in figure 2 of Hatanaka);

a discriminating unit for evaluating said bills (discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200), said discriminating unit including a detector positioned along said transport path between said input receptacle and said output receptacle (see figure 4), said discriminating unit counting and determining the denomination of said bills (see last paragraph, p. H0014); and

means for flagging a bill when the denomination of said bill is not determined by said discriminating unit (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture), wherein said means for flagging causes said transport mechanism to halt (p. H0014: "if the signal indicates a mismatch, the conveyer drive unit 120 is stopped").

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Regarding claim 76, Hatanaka discloses a currency evaluation device for receiving a stack of currency bills and rapidly evaluating all the bills in the stack, said device comprising:

an input receptacle for receiving a stack of bills to be evaluated (paper currency placement platform 2, figures 1 and 2);

a single output receptacle for receiving said bills after said bills have been evaluated (paper currency stacking platform 23, figures 1 and 2);

a transport mechanism for transporting said bills, one at a time, from said input receptacle to said output receptacle along a transport path (as shown in figure 2 of Hatanaka);

a discriminating unit for evaluating said bills (discriminator unit 112, figure 3, in conjunction with pattern detection device 111, denomination memory device 113, denomination comparison device 114, and count calculation device 200), said discriminating unit including a detector positioned along said transport path between said input receptacle and said output receptacle (see figure 4), said discriminating unit counting and determining the denomination of said bills (see last paragraph, p. H0014: discriminator unit discriminates the denomination of the paper currency; see p. H0015: count calculation device 200 counts the number of bills); and

means for flagging a bill meeting or failing to meet a certain criteria (dissimilar paper currency rejector device 123: flags a mismatched bill by routing it to a rejection aperture).

See Appendix 1 of the Request for explanations regarding the anticipation of dependant claims 6, 9, 22, and 25 by Hatanaka.

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4. Claims 2, 3, 5, 12, 14, 17, 18, 26, 27, 29, 31, 33, 34, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka.

See Appendix 1 of the Request for explanations regarding the obviousness of independent claim 79 and dependant claims 2, 3, 5, 12, 14, 17, 18, 26, 27, 29, 31, 33, 34, 77, 78, and 80 over Hatanaka.

5. Claims 4, 7, 8, 10, 11, 15, 19, 20, 21, 23, 24, 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka in view of Curl, Reed, and Jones.

Regarding claims 4, 7, 8, 10, 11, 15, 19, 20, 21, 23, 24, 32, 35, and 36, Hatanaka, in combination with the teachings of Curl and Reed, is considered to render the claims obvious. See Appendix 1 of the Request.

6. Claims 37-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatanaka in view of Curl, Reed, Jones, and Nishito.

See Appendix 1 of the Request for explanations regarding the obviousness of independent claims 37, 56, and 75 and dependant claims 38-55 and 57-74 over Hatanaka in view of Curl, Reed, Jones, and Nishito.

Rejections based on O'Maley (SNQ 2)

7. Claims 1, 2, 3, 5, 6, 9, 12, 13, 14, 16-18, 22, 25-31, 33, 34, 76-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Maley in view of Hatanaka and Reed.

See Appendix 2 of the Request for explanations regarding the obviousness of independent claims 1, 13, 16, 28, 30, 76, and 79 and dependant claims 2, 3, 5, 6, 9, 12, 14, 17, 18, 22, 25-27, 29, 31, 33, 34, 77, 78, and 80 over O'Maley in view of Hatanaka and Reed.

8. Claims 4, 7, 8, 10, 11, 15, 19-21, 23, 24, 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Maley in view of Hatanaka, Reed, and Curl.

See Appendix 2 of the Request for explanations regarding the obviousness of dependant claims 4, 7, 8, 10, 11, 15, 19-21, 23, 24, 32, 35, and 36 over O'Maley in view of Hatanaka, Reed, and Curl.

9. Claims 37-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Maley in view of Hatanaka, Nishito, Curl, and Reed.

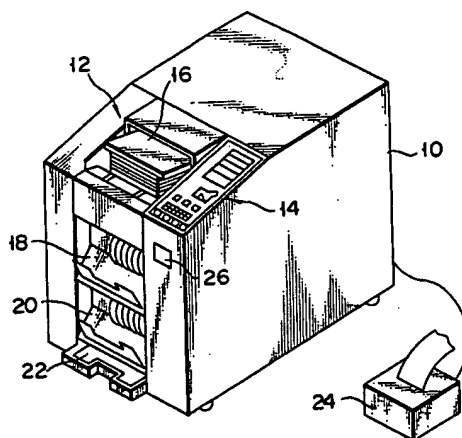
See Appendix 2 of the Request for explanations regarding the obviousness of independent claims 37, 56, and 75 and dependant claims 38-55 and 57-74 over O'Maley in view of Hatanaka, Nishito, Reed, and Curl.

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Rejections based on Takesako (SNQ 3)

10. Claims 1, 2, 5, 9, 12-14, 16, 17, 25-31, 33, 34, and 76-80 rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako in view of Hatanaka.

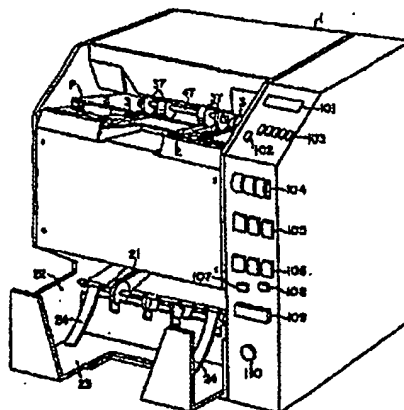
See Appendix 3 of the Request for explanations regarding the obviousness of independent claims 1, 13, 16, 28, 30, 76, and 79 over Takesako and Hatanaka. Takesako's device includes two output receptacles for evaluated bills:



Takesako, figure 1

However, for claims 1, 13, 16, 28, 76, and 79, it would have been obvious to include only a single output receptacle, which as shown by Hatanaka was conventional at the time of the invention:

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Hatanaka, figure 1

Also, for claims 30 and 79, Takesako does not appear to teach halting the transport mechanism when a bill is flagged, however, Hatanaka teaches that it was conventional to stop the transporting of bills when a flagging occurs (see Hatanaka, p. H0014), and such a feature would have been obvious to those skilled in the art for allowing a flagged bill to be manually examined while the operation of the device is suspended.

For dependent claims 2, 5, 9, 12, 14, 17, 25-27, 29, 31, 33, 34, 77, 78, and 80, see Appendix 3 of the Request for explanations of obviousness over the combination of Takesako and Hatanaka.

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11. Claims 3, 6, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako in view of Hatanaka, and further in view of Nishito.

See Appendix 3 of the Request for explanations regarding the obviousness of claims 3, 6, 18, and 22 over Takesako, Hatanaka, and Nishito.

12. Claims 4, 7, 8, 10, 11, 15, 19-21, 23, 24, 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako in view of Hatanaka, and further in view of Curl and Reed.

See Appendix 3 of the Request for explanations regarding the obviousness of claims 4, 7, 8, 10, 11, 15, 19-21, 23, 24, 32, 35, and 36 over Takesako, Hatanaka, Curl, and Reed.

13. Claims 37, 40-44, 47, 54-56, 59-63, 66, and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako in view of Nishito, and further in view of Curl and Reed.

See Appendix 3 of the Request for explanations regarding the obviousness of independent claims 37, 56, and 75 and dependant claims 40-44, 47, 54, 55, 59-63, 66, 73, and 74 over Takesako, Nishito, Curl, and Reed.

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14. Claims 38, 39, 45, 46, 48-53, 57, 58, 64, 65, and 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako in view of Nishito, Curl, Reed, and further in view of Hatanaka.

See Appendix 3 of the Request for explanations regarding the obviousness of claims 38, 39, 45, 46, 48-53, 57, 58, 64, 65, and 67-72 over Takesako, Nishito, Curl, Reed, and Hatanaka.

Rejections based on Double Patenting (SNQ 4)

15. 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

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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).

16. Claims 37-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,295,196. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 37-54 of the '067 patent are fully anticipated by claims 1-18 of the '196 patent.

Independent claim 1 of the '196 patent (as well as dependant claims 2-18) is identical to independent claim 37 of the '067 patent (as well as dependant claims 38-54) except that claim 1 recites receiving "reflected light," whereas claim 37 recites receiving merely "light," as shown in the claim charts of Appendix 4 of the Request. Accordingly, claims 37-54 of the '067 patent are anticipated by, and therefore rendered obvious by, claims 1-18 of the '196 patent.

Conclusion

17. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c). See MPEP § 2265.

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

By Mail to: Mail Stop *Ex Parte* Reexam
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By FAX to: (571) 273-9900
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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 Colin LaRose at (571) 272-7423.

/Colin LaRose/
Primary Examiner
Art Unit 3992

Conferees: ALB
ADK