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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,703	05/22/2011	7,536,046	985-P-3REEX	8835

41230 7590 01/12/2012

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/12/2012

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



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**JAN 12 2012**

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/011,703.

PATENT NO. 7,536,046.

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)).

<b>Office Action in Ex Parte Reexamination</b>	Control No. 90/011,703	Patent Under Reexamination 7,536,046
	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 3-6,8,11-52,54-100,104-109 and 113-124 are subject to reexamination.  
1b.  Claims 1,2,7,9,10,53,101-103 and 110-112 are not subject to reexamination.  
2.  Claims \_\_\_\_ have been canceled in the present reexamination proceeding.  
3.  Claims 56 and 57 are patentable and/or confirmed.  
4.  Claims 3-6,8,11-52,54,55,58-100,104-109 and 113-124 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 7,536,046*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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

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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).

2. Claims 3, 6, 11, 14, and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,028,951 (“the ‘951 patent”) in view of U.S. Patent 4,830,742 (“Takesako”).

As shown below, claim 12 of the '951 patent claims substantially the same invention as that of claim 3 of the '046 patent, except the limitations:

the transport mechanism being adapted to transport bills ... with their narrow dimension parallel to the transport direction;

the device being adapted to total the denominations of bills received in the single denominated bill output receptacle including bills of a plurality of U.S. denominations

a separate stacker bin adapted to receive bills that the device is not able to denominate, the stacker bin being separate from the denominated bill output receptacle; and

a diverter positioned along the transport path to route bills which are denominated by the denomination discriminating unit to the denominated bill output receptacle and bills which are not denominated by the denomination discriminating unit to the separate stacker bin.

<u>Claim 3, '046 Patent</u>	<u>Claim 12, '951 Patent</u>
A U.S. currency processing device for receiving a stack of U.S. currency bills and	A U.S. currency evaluation device for receiving a stack of U.S. currency bills and

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<p>rapidly processing all the bills in the stack, the device comprising:</p>	<p>rapidly evaluating all the bills in the stack, the device comprising:</p>
<p>an input receptacle positioned to receive a stack of U.S. bills of a plurality of denominations, the bills having a narrow dimension;</p>	<p>a single input receptacle positioned to receive a stack of bills to be evaluated;</p>
<p>a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism being positioned to transport the bills, one at a time, from the input receptacle along a transport path in a transport direction, the transport mechanism being adapted to transport bills at a rate in excess of 800 bills per minute <u>with their narrow dimension parallel to the transport direction</u>;</p>	<p>a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism located between the input receptacle and the output receptacle to transport the bills, one at a time, from the input receptacle to the output receptacle along a transport path; and  wherein the transport mechanism is adapted to transport ... bills at a rate of at least about 1000 bills per minute</p>
<p>a denomination discriminating unit comprising a detector positioned along the transport path and comprising a processor, the detector generating a characteristic information output signal in response to characteristic information detected from passing bills, the characteristic information output signal being electrically coupled to the processor, the processor receiving the characteristic information output signal and generating a denomination signal in response thereto, the discriminating unit being adapted to denominate bills of a plurality of U.S. denominations at a rate in excess of 800 bills per minute;</p>	<p>a denomination discriminating unit comprising a detector positioned along the transport path between the input receptacle and the output receptacle and comprising a processor, the detector generating a characteristic information output signal in response to detected characteristic information, the characteristic information output signal being electrically coupled to the processor, the processor receiving the characteristic information output signal and generating a denomination signal in response thereto, the discriminating unit being adapted to denominate bills of a plurality of U.S. denominations.  wherein the discriminating unit is adapted to denominate ... bills at a rate of at least about 1000 bills per minute</p>
<p>a single denominated bill output receptacle adapted to receive bills whose denomination have been determined by the discriminating unit including bills of a plurality of U.S. denominations, <u>the device being adapted to total the denominations of bills received in the single denominated bill output receptacle including bills of a plurality of U.S. denominations</u>;</p>	<p>a single output receptacle positioned to receive the bills after the bills have been evaluated;  the discriminating unit being adapted to denominate bills of a plurality of U.S. denominations.</p>

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<p><u>a separate stacker bin adapted to receive bills that the device is not able to denominate, the stacker bin being separate from the denominated bill output receptacle; and</u></p>	
<p><u>a diverter positioned along the transport path to route bills which are denominated by the denomination discriminating unit to the denominated bill output receptacle and bills which are not denominated by the denomination discriminating unit to the separate stacker bin.</u></p>	

Claim 12 does not claim the “transporting along the narrow dimension,” “totaling the denominations,” “separate stacker bin,” and “diverter” limitations, however, such limitations are considered obvious in view of the teachings in Takesako that it was conventional to transport bills with the narrow dimension parallel to the transport direction, to total the values of evaluated bills, and to provide a separate stacker bin and a diverter for stacking undenominated bills. See for instance, figure 1, which shows bills being fed into the machine such that the transport direction is parallel to the narrow dimension of the bills:

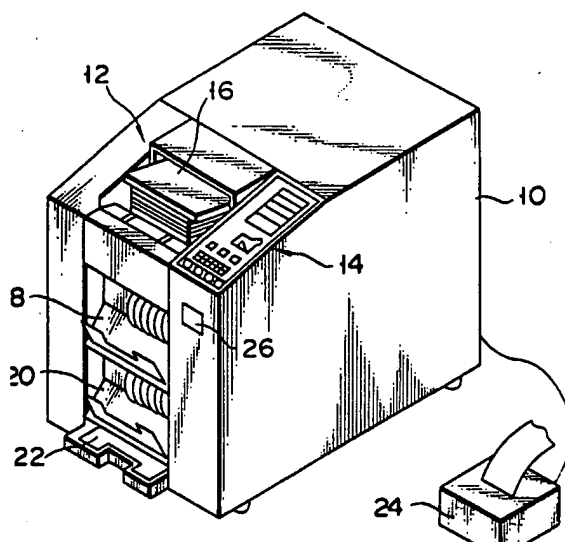


Figure 1, Takesako



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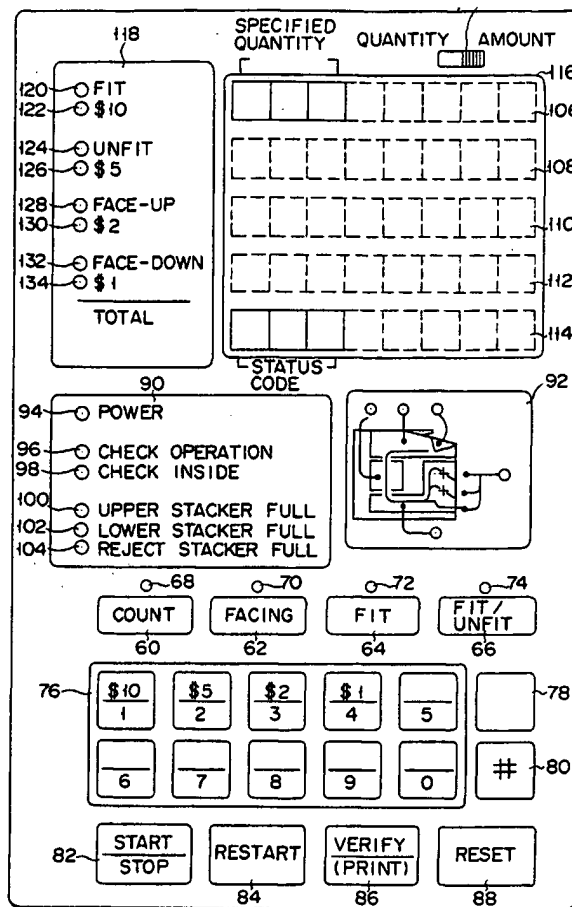


Figure 3, Takesako

In view of the above teachings in Takesako that it was conventional for a bill-counting device to transport bills along a narrow dimension, to provide totals of denominated bills, and to provide a diverter and separate stacker bin for stacking undenominated bills, it would have been obvious to modify claim 12 of the '951 patent to achieve the invention claimed in claim 3 of the '046 patent. Accordingly, claim 3 of the '046 patent is considered to be an obvious variant of claim 12 of the '951 patent.

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Claim 3 is a representative “device” claim of the ‘046 patent. Other independent “device” claims requested for reexamination—6, 11, 14, and 15—claim substantially the same or similar limitations as those found in representative claim 3 and are rejected on the same grounds.

3. Claims 4, 5, 8, 12, 13, 16, 104-109 and 113-124 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,028,951 (“the ‘951 patent”) in view of U.S. Patent 4,830,742 (“Takesako”), and further in view of U.S. Patent 4,464,786 (“Nishito”).

Independent “device” claims requested for reexamination—4, 5, 8, 12, 13, and 16—claim substantially the same limitations as those found in representative claim 3, except that claims 4, 5, 8, 12, 13, and 16 additionally recite limitations directed to generating a “received light characteristic” or a “reflected light characteristic.” These additional limitations, however, are considered obvious variants of claim 3 inasmuch as Nishito teaches that generating a reflected/received light characteristic for the purpose of identifying currency was conventional at the time of the invention. See, for instance, figures 2 and 3 of Nishito and its accompanying description, which teach how reflected light from a bill is conventionally captured (scanned) to generate a characteristic signal  $V(i)$  used in identifying the bill:

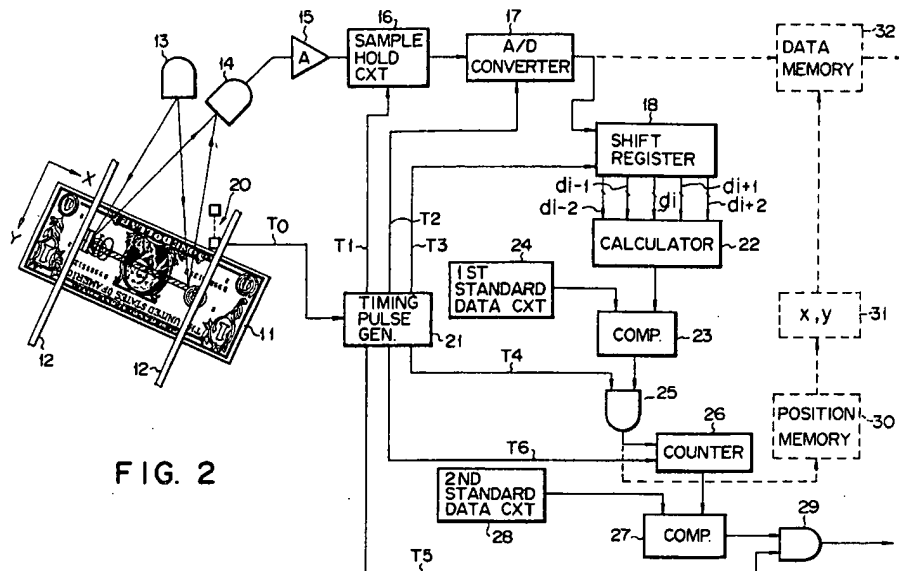
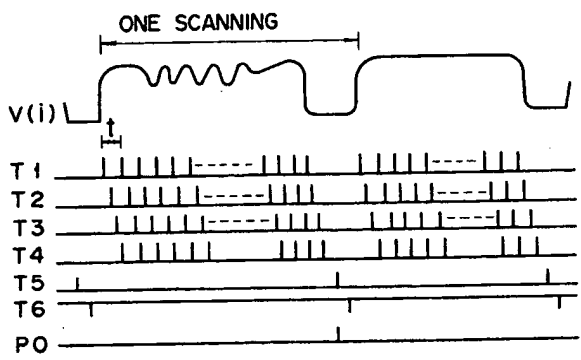


FIG. 2

FIG. 3



Dependent "device" claims 104-109 and 113-124 recite additional limitations that are either claimed by the '951 patent or rendered obvious by teachings found in Takesako and/or Nishito.

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4. Claims 17-22, 25, 35-39, 42, 43, 54, 58, and 66 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 63 of U.S. Patent No. 6,028,951 (“the ‘951 patent”) in view of U.S. Patent 4,830,742 (“Takesako”).

As shown below, claim 63 of the '951 patent claims substantially the same invention as that of claim 17 of the '046 patent, except:

flagging a bill when the denomination of the bill is not determined by the discriminating unit by diverting a bill whose denomination is not determined to a separate stacker bin.

<u>Claim 17, '046 Patent</u>	<u>Claim 63, '951 Patent</u>
A method of processing U.S. currency using a U.S. currency denominating device comprising:	A method of processing U.S. currency using a currency evaluation device comprising:
receiving a stack of U.S. bills having a plurality of denominations to be denominated in an input receptacle of the device;	receiving a stack of U.S. bills having a plurality of denominations to be evaluated in a single input receptacle of the evaluation device;
transporting the bills, one at a time, from the input receptacle along a transport path at a rate in excess of 800 bills per minute;	transporting the bills, one at a time, from the input receptacle to the output receptacle along a transport path using a transport mechanism comprising a transport drive motor and transport rollers;  wherein transporting ... [is] performed at a rate of at least about 1000 bills per minute;
determining the denomination of bills including bills of a plurality of U.S. denominations at a rate in excess of 800 bills per minute using a discriminating unit	determining the denomination of each of the bills including bills of a plurality of U.S. denominations using a discriminating unit comprising a detector positioned along the

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<p>comprising a detector positioned along the transport path and a processor;</p>	<p>transport path between the input receptacle and the output receptacle and a processor; wherein determining the denomination comprises:</p> <p>the detector detecting characteristic information from the bills;</p> <p>the detector generating a characteristic information output signal in response to detected characteristic information, the characteristic information output signal being electrically coupled to the processor;</p> <p>the processor receiving the characteristic information output signal; and</p> <p>the processor generating a denomination signal in response thereto.</p> <p>wherein ... determining the denomination [is] performed at a rate of at least about 1000 bills per minute;</p>
<p>delivering bills that have been denominated including bills of a plurality of denominations to a single denominated bill output receptacle of the device; and</p>	<p>receiving the bills after the bills have been evaluated in a single output receptacle of the evaluation device;</p>
<p>flagging a bill when the denomination of the bill is not determined by the discriminating unit by diverting a bill whose denomination is not determined to a separate stacker bin.</p>	

Claim 17 does not claim the “flagging ... by diverting” limitation, however, such a limitation is considered obvious in view of the teachings in Takesako that it was conventional to provide a separate stacker bin and a diverter for stacking undenominated bills. See for instance, figure 2, which shows a diverter 36 that routes undenominated bills to a separate reject bin 22:

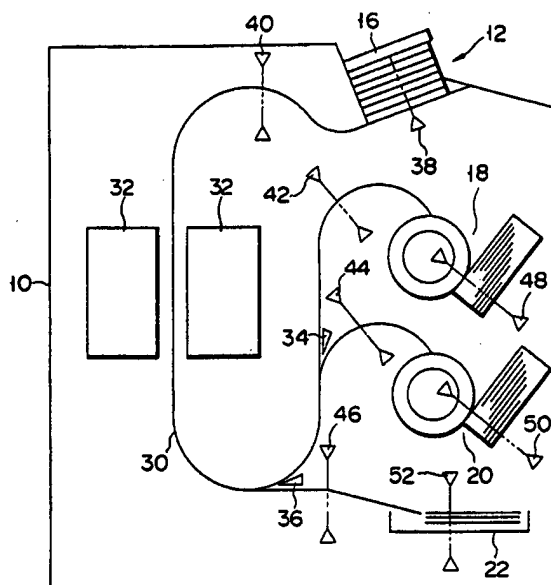


Figure 2, Takesako

Bills that are re-directed to a separate stacker bin according to Takesako's disclosure are effectively "flagged ... by diverting." In view of these teachings in Takesako that it was conventional for a bill-counting device to provide a diverter and separate stacker bin for stacking undenominated bills, it would have been obvious to modify claim 63 of the '951 patent to achieve the invention claimed in claim 17 of the '046 patent. Accordingly, claim 17 of the '046 patent is considered to be an obvious variant of claim 63 of the '951 patent.

Claim 18 claims the same limitations are that of claim 17, except claim 18 additionally recites the bills are transported "with their narrow dimension parallel to the transport direction" and "totaling the denominations of bills delivered to the single denominated bill output receptacle." As explained above for claim 3, these limitations are rendered obvious by teachings found in Takesako.

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Claim 18 is a representative “method” claim of the ‘046 patent. Other independent “method” claims requested for reexamination—19-30, 35-48, 54, 56, 58, and 66—claim substantially the same or similar limitations as those found in representative claim 18 and are rejected on the same grounds.

5. Claims 23, 24, 26-34, 40, 41, 44-52, 55, 59-65, and 67-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 63 of U.S. Patent No. 6,028,951 (“the ‘951 patent”) in view of U.S. Patent 4,830,742 (“Takesako”), and further in view of U.S. Patent 4,464,786 (“Nishito”).

Independent “method” claims requested for reexamination—23, 24, 26-30, 40, 41, and 44-48—claim substantially the same limitations as those found in representative claim 18, except that claims 23, 24, 26-30, 40, 41, and 44-48 additionally recite limitations directed to generating a received or reflected light characteristic information output signal, generating image signals, comparing generated data to master data stored in a memory, and/or illuminating bills with a rectangular strip of light. These additional limitations, however, are considered obvious variants of claim 18 inasmuch as Nishito teaches that generating a reflected/received light characteristic signal or image for the purpose of identifying currency was conventional at the time of the invention. Also, as shown in figure 2, illuminating a bill with a rectangular strip of light and performing a comparison of a generated characteristic or image signal to a master stored in memory were conventional practices. See, for instance, figures 2 and 3 of Nishito and its accompanying description, which teach how reflected light from a bill is conventionally captured

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(scanned) to generate a characteristic signal  $V(i)$  used in identifying the bill by comparison to master data:

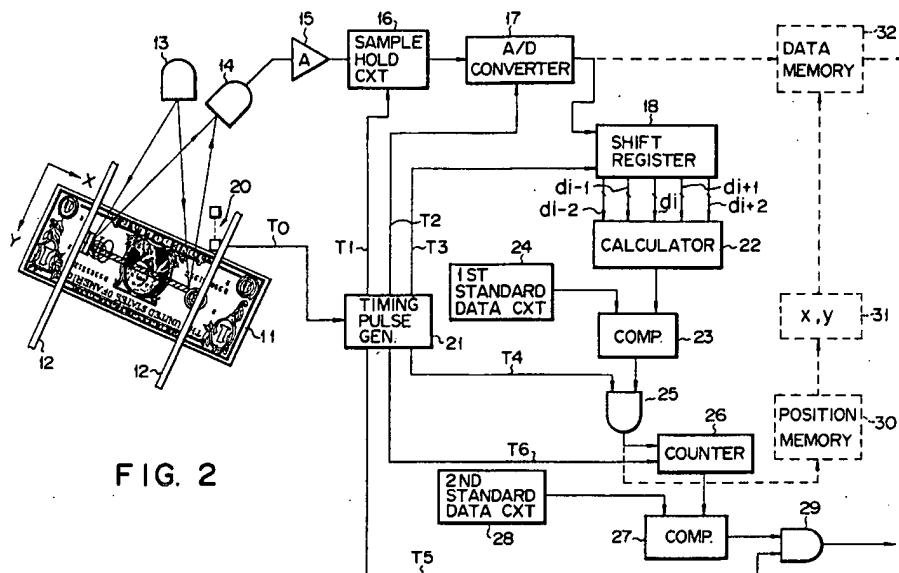
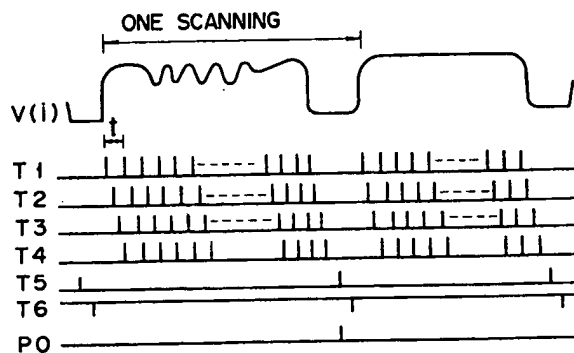


FIG. 2

FIG. 3



Dependent "method" claims 31-34, 49-52, 55, 59-65, and 67-100 recite additional limitations that are either claimed by the '951 patent or rendered obvious by teachings found in Takesako and/or Nishito.

***Conclusion***

6. 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  
                  Attn: Central Reexamination Unit  
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                  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  
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                  401 Dulany Street  
                  Alexandria, VA 22314

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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  
KDK