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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. 90/011,719.

PATENT NO. 7672499.

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. 90/011,719	Patent Under Reexamination 7672499
	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 1-110 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 1-110 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 7,672,499

Documents Cited Herein

1. U.S. Patent 4,114,804 (“Jones”);
U.S. Patent 3,912,255 (“McInerny”); and
U.S. Patent 6,028,951 (“’951 patent”).

Double Patenting

2. 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).

Independent Claims 1, 19, 26, 37, 55, 72, 88, and 97

3. Claims 1, 19, 26, 37, 55, 72, 88 and 97 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,028,951 in view of Jones.

As shown below, claim 6 of the '951 patent claims substantially the same invention as that of claim 1 of the '499 patent, except the limitations:

wherein the device is configured to deliver any bill that has been denominated to the one and only one of the at least one output receptacle including bills of a plurality of U.S. denominations; and

wherein the device is configured (a) to halt the transport mechanism when the denomination of a bill is not determined by the denomination discriminating unit and (b) to permit the transport mechanism to be restarted after being halted while maintaining a cumulative value of bills in the stack which have been denominated and delivered to the denominated bill output receptacle.

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Claim 6, however, does recite "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."

These limitations render obvious "the device [being] configured to deliver any bill that has been denominated to the one and only one of the at least one output receptacle including bills of a plurality of U.S. denominations."

Claim 6 does not claim the (a) "halting" and (b) "restarting" limitations, however, such limitations are considered obvious in view of the teachings in Jones that it was conventional to halt a bill-counting process (including halting a transport mechanism) when a "suspect" bill is encountered and to restart the bill-counting process (including restarting the transport mechanism) after the suspect bill removed or removed and replaced. According to Jones, the cumulative count value of the bills that have been evaluated is maintained, and the suspect bill can be either included or withheld from the total count. See Jones, columns 5:63—6:14:

During normal high-speed counting, each note passing through apparatus 10 is tested for certain properties of genuineness. Any note which does not satisfy all of the tests for genuineness will cause the machine to stop immediately and will light the "suspect" indicator lamp 65. At this time the suspect note will be the top-most

note in the output stacker, i.e., the top-most note in stack 24, shown in FIG. 1. The suspect note may then be easily and quickly removed from the stacker for further detailed inspection while permitting substantially immediate reinitiation of the counting operation either after removal or after removal and replacement of the suspect note. Suspect notes are preferably included in the count since they are only "suspect" and may be quickly recognized by one having the requisite skill in currency handling as actually being genuine, or damaged, exceedingly worn (unfit), or in some other way defective. However, the suspect detection circuitry may be readily and simply modified to withhold the count of the "suspect" bill.

In view of the above teaching in Jones that it was conventional for a bill-counting device to halt and restart operation based on encountering a suspect bill, it would have been obvious to modify claim 6 of the '951 patent to achieve the invention claimed in claim 1 of the '499 patent. Accordingly, claim 1 of the '499 patent is considered to be an obvious variant of claim 6 of the '951 patent.

<u>Claim 1, '499 Patent</u>	<u>Claim 6, '951 Patent</u>
A U.S. currency processing device for receiving a stack of U.S. currency bills and rapidly processing all the bills in the stack, the device comprising:	A U.S. currency evaluation device for receiving a stack of U.S. currency bills and rapidly evaluating all the bills in the stack, the device comprising:
an input receptacle positioned to receive a stack of U.S. bills;	a single input receptacle positioned to receive a stack of bills to be evaluated;
at least one output receptacle positioned to receive bills, only one of the at least one output receptacle being an output receptacle for receiving denominated bills;	a single output receptacle positioned to receive the bills after the bills have been evaluated;
a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism being configured to transport the bills, one at a time, from the input receptacle to the at least one output receptacle along a transport path; and	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
a denomination discriminating unit comprising a detector positioned along the transport path between the input receptacle and the at least one output receptacle and comprising a processor, the detector generating a characteristic information output signal in response to detected characteristic information,	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

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<p>the characteristic information output signal being electrically coupled to the processor, the processor receiving the characteristic information output signal and generating a denomination signal, the discriminating unit being configured to denominate and count bills of a plurality of U.S. denominations;</p>	<p>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.</p>
<p>wherein the device is configured to deliver any bill that has been denominated to the one and only one of the at least one output receptacle including bills of a plurality of U.S. denominations; and</p>	
<p>wherein the device is configured (a) to halt the transport mechanism when the denomination of a bill is not determined by the denomination discriminating unit and (b) to permit the transport mechanism to be restarted after being halted while maintaining a cumulative value of bills in the stack which have been denominated and delivered to the denominated bill output receptacle.</p>	

Claim 19 of the '499 patent is substantially the same as claim 1 of the '499 patent except that it additionally recites "a memory storing a cumulative value of the bills that have been denominated." Jones teaches that recording the cumulative count of bills processed in a counting operation and displaying the accumulated count in an observable readout (column 3:54-55) was conventional at the time the invention was made. Accordingly, combining claim 6 of the '951 patent with the teachings of Jones would render claim 19 obvious. That is, modifying claim 6 in order to store a count of the cumulative value of the denominated bills would have been obvious

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in view of Jones' teaching of recording and displaying the accumulated total of counted bills. In addition, modifying claim 6 of the '951 patent to include the "halt" and "restart" limitations would have been obvious for the same reasons as above for claim 1 of the '499 patent.

Claim 26 of the '499 patent is substantially identical to claim 19 of the '499 patent except that it recites storing "one or more counts" associated with the bills that have been denominated (rather than "a cumulative value of the bills"). Claim 26 is rendered obvious over claim 6 of the '951 patent in view of Jones for the same reasons.

Claim 37 of the '499 patent is substantially similar to claims 19 and 26 of the '499 patent except that it recites "a processor programmed to determine an aggregate total of the amount of denominated bills received in a denominated bill output receptacle," rather than a "memory storing" a cumulative value of bills or one or more counts associated with the bills. Jones teaches that "count pulses are accumulated in a counter 57 having a visually observable readout" (see column 3:54-55). That is, the counter is programmed to count and accumulate pulses, which are then visually represented in a numerical display. Accordingly, the counter functions as a processor that determines an aggregate count of processed bills. In view of this teaching in Jones that it was conventional for a bill-counting device to include a processor that determines an aggregate total of counted bills, it would have been obvious to modify claim 6 of the '951 patent to achieve the invention claimed in claim 37 of the '499 patent. Accordingly, claim 37 of the '499 patent is considered to be an obvious variant of claim 6 of the '951 patent.

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Claim 55 of the '499 patent is substantially identical to claim 1 of the '499 patent except that it recites totaling the bills, in addition to denominating them. Also, claim 55 does not include the "halting" and "restarting" limitations of claim 1.

Jones teaches that at the time of the invention it was conventional for a bill-counting device to include a counter that determines an aggregate total of counted bills, and the total is displayed to the user (see column 3:54-55). In view of this teaching, it would have been obvious to modify claim 6 of the '951 patent to achieve the invention claimed in claim 55 of the '499 patent by totaling the denominated bills. Accordingly, claim 55 of the '499 patent is considered to be an obvious variant of claim 6 of the '951 patent.

<u>Claim 55, '499 Patent</u>	<u>Claim 6, '951 Patent</u>
A U.S. currency processing device for receiving a stack of U.S. currency bills including bills of a plurality of U.S. denominations and rapidly processing all the bills in the stack, the device comprising:	A U.S. currency evaluation device for receiving a stack of U.S. currency bills and rapidly evaluating all the bills in the stack, the device comprising:
an input receptacle positioned to receive a stack of U.S. bills including bills of a plurality of U.S. denominations;	a single input receptacle positioned to receive a stack of bills to be evaluated;
at least one output receptacle positioned to receive bills after processing, one and only one of the at least one output receptacle being configured to receive denominated bills;	a single output receptacle positioned to receive the bills after the bills have been evaluated;
a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism being adapted to transport the bills, one at a time, from the input receptacle to the at least one output receptacle along a transport path; and	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

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	transport path; and
<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 and processing the characteristic information output signal and generating denomination signals, the discriminating unit being adapted to denominate <u>and total</u> bills of a plurality of U.S. denominations;</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.</p>
<p>wherein the device is configured to deliver any bill that has been denominated <u>and totaled</u> to the one and only one of the at least one output receptacle including bills of a plurality of U.S. denominations.</p>	

Claim 72 of the '499 patent is substantially the same as claim 55 of the '499 patent except that it additionally recites transport and denomination rates "in excess of about 800 bills per minute." Claim 12 of the '951 patent claims all of the limitations of claim 6 of the '951 patent, as well as transporting and denominating at about 1000 bills per minute. Accordingly, claim 72 of the '499 patent is considered an obvious variant of claim 12 of the '951 patent for the same reasons (identified above) that claim 55 of the '499 is considered an obvious variant of claim 6 of the '951 patent.

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Claim 88 of the '499 patent claims all of the limitations of claim 6 of the '951 patent except that claim 88 additionally recites a "stacking mechanism" and the transport direction of the bills being parallel to the "narrow dimension" of the bills. However, Jones teaches that both limitations are conventional and would have been obvious variants to claim 6 of the '951 patent. In particular, Jones teaches that it is conventional for bills to travel in the direction of the narrow edge in a bill-processing device (see figures 3c and 3d) and that it was also conventional to utilize a stacking mechanism comprising flexible blades. Jones employs the stacking mechanism of U.S. Patent 3,912,255 by McInerny (see Jones, column 3:56-66). McInerny's disclosure demonstrates that stacking mechanisms comprising flexible blades, as claimed, were conventional at the time of the invention as means for stacking documents processed by document counters and the like. Accordingly, the limitations of claim 6 of the '951, when combined with the conventional bill-transport direction and "stacking mechanism" of Jones and McInerny, render claim 88 of the '499 patent obvious.

<u>Claim 88, '499 Patent</u>	<u>Claim 6, '951 Patent</u>
A U.S. currency processing device for receiving a stack of U.S. currency bills and rapidly processing all the bills in the stack, the device comprising:	A U.S. currency evaluation device for receiving a stack of U.S. currency bills and rapidly evaluating all the bills in the stack, the device comprising:
an input receptacle positioned to receive a stack of U.S. bills including bills of a plurality of U.S. denominations, each bill being rectangular and having a wide dimension and a narrow dimension;	a single input receptacle positioned to receive a stack of bills to be evaluated;
a single denominated bill output receptacle positioned to receive bills after processing;	a single output receptacle positioned to receive the bills after the bills have been evaluated;

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<p>a stacking mechanism comprising flexible blades positioned to restack bills that have been denominated in the denominated bill output receptacle, the denominated bill output receptacle being the only output receptacle having a stacking mechanism comprising flexible blades associated therewith;</p>	
<p>a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism being adapted to transport the bills, one at a time, from the input receptacle to the denominated bill output receptacle along a transport path in a transport direction, the transport mechanism being adapted to transport bills with their narrow dimension parallel to the transport direction; and</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</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;</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.</p>
<p>wherein the device is configured such that after processing the entire stack of bills, the denominated bill output receptacle includes denominated bills of a plurality of U.S. denominations.</p>	<p>[a single output receptacle positioned to receive the bills after the bills have been evaluated;</p> <p>the discriminating unit being adapted to denominate bills of a plurality of U.S. denominations]</p>

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Claim 97 of the '499 patent claims all of the limitations of claim 6 of the '951 except for the "stacker wheel" in the output receptacle. However, Jones' disclosure, which incorporates the teachings of McNerny, demonstrates that stacking mechanisms comprising flexible blades were conventional at the time of the invention as means for stacking documents processed by document counters and the like. Accordingly, the limitations of claim 6 of the '951, when combined with the conventional "stacking mechanism" of McNerny, render claim 97 of the '499 patent obvious.

<u>Claim 97, '499 Patent</u>	<u>Claim 6, '951 Patent</u>
A high-speed U.S. currency processing device for receiving a stack of U.S. currency bills and rapidly processing all the bills in the stack, the device comprising:	A U.S. currency evaluation device for receiving a stack of U.S. currency bills and rapidly evaluating all the bills in the stack, the device comprising:
an input receptacle positioned to receive a stack of U.S. bills;	a single input receptacle positioned to receive a stack of bills to be evaluated;
one and only one <u>stacker wheel</u> containing output receptacle positioned to receive denominated bills after processing and form a stack of U.S. bills;	a single output receptacle positioned to receive the bills after the bills have been evaluated;
a transport mechanism comprising a transport drive motor and transport rollers, the transport mechanism being adapted to transport the bills, one at a time, from the input receptacle to the output receptacle along a transport path, the transport mechanism being adapted to transport bills at a rate in excess of about 800 bills per minute; and	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
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	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

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<p>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, the discriminating unit being adapted to denominate bills of a plurality of U.S. denominations at a rate in excess of about 800 bills per minute.</p>	<p>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.</p>
	<p>Claim 12, '951 Patent (depends indirectly from Claim 6):</p> <p>wherein the transport mechanism is adapted to transport and the discriminating unit is adapted to denominate bills at a rate of at least about 1000 bills per minute.</p>

Dependent Claims

4. Dependent claims 2-18, 20-25, 27-36, 38-54, 56-71, 73-87, 89-96, and 98-110 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 or various other claims of U.S. Patent No. 6,028,951 in view of Jones.

Appendices 1-3 of the Request demonstrate how the '951 patent claims substantially the same limitations as those found in dependent claims 2-18, 20-25, 28-36, 38-54, 56-71, 73-87, 89-96, and 98-110 of the '499 patent, which limitations, when combined with the teachings of Jones, render the claims obvious.

Conclusion

5. 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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United States Patent & Trademark Office
P.O. Box 1450
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By FAX to: (571) 273-9900
Central Reexamination Unit

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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*