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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,419	08/27/2010	7672499	985-P-1REEX	2038
41230	7590	02/14/2011	EXAMINER	
CUMMINS-ALLISON CORP. C/O NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			LAROSE, COLIN M	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			02/14/2011	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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HONOLULU, HI 96816-4002

Date: **MAY 10**

**PTO 147011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001419  
PATENT NO. : 7672499  
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.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	Control No.	Patent Under Reexamination	
	95/001,419	7672499	
	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 \_\_\_\_\_

Third Party(ies) on \_\_\_\_\_

**RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

*For Patent Owner's Response:*

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

*For Third Party Requester's Comments on the Patent Owner Response:*

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

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.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

**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.  \_\_\_\_\_

**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.
- 3.  Claims 3-6,10,12,17,22,24,25,27,31,38,41,42,44,49,50,52,61,66,67,72-87,89,91,92,97-110 are confirmed. [Unamended patent claims]
- 4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
- 5.  Claims See Continuation Sheet 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: 5. Claims rejected are 1,2,7-9,11,13-16,18-21,23,26,28-30,32-37,39,40,43,45-48,51,53-60,62-65,68-71,88,90 and 93-96.

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**REEXAMINATION OF U.S. PATENT 7,672,499**

*Documents Cited Herein*

- Exhibit B: U.S. Patent No. 4,179,685 (O'Maley)
- Exhibit C: U.S. Patent No. 4,464,786 (Nishito)
- Exhibit D: U.S. Patent No. 4,592,090 (Curl)
- Exhibit F: U.S. Patent No. 4,694,963 (Takesako)
- Exhibit G: Japanese Patent Publication No. 61-41439 (with English Translation) (Hatanaka)
- Exhibit I: U.S. Patent No. 4,114,804 (Jones)
- Exhibit J: Glory Ltd., Instruction Manual Model GFR-100 Currency Reader Counter (Aug. 31, 1995) ("GFR-100 Instruction Manual")
- Exhibit K: Glory Ltd., Service Manual Currency Reader Counter GFR-100 (December 1995) ("GFR-100 Service Manual")
- Exhibit K1: U.S. Patent No. 5,680,472 (Conant)

*Claim Rejections - 35 USC § 103*

1. 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.

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*Disposition of Proposed Grounds of Rejection*

2. **Ground #1** (adopted-in-part, as modified)

—Claims 1, 2, 8, 9, 14-16, 19, 21, 23, 55, 63-65, and 68-71 are rejected under 35 U.S.C § 103(a) as being unpatentable over Hatanaka in view of Nishito.

These rejections are adopted as modified and as explained on the corresponding pages of the claim charts of the Request (see **Replacement Appendix 1**).

—Claims 7, 18, 20, 26, 28-30, 32, 33, 35-37, 39, 40, 46-48, 53, 54, 56-60, 88, 90, and 93-96 are rejected under 35 U.S.C § 103(a) as being unpatentable over Hatanaka in view of Nishito, and further in view of Jones.

These rejections are adopted as explained on the corresponding pages of the claim charts of the Request (see **Replacement Appendix 1**).

—Claims 3, 4-6, 10-13, 17, 22, 24, 25, 27, 31, 34, 38, 41-45, 49-52, 61, 62, 66, 67, 72-87, 89, 91, 92, and 97-110 are **not** rejected under 35 U.S.C § 103(a) as being unpatentable over Hatanaka in view of Nishito, and further in view of Curl and Jones.

These rejections are not adopted for the following reasons:

Regarding claims 3 and 22, Hatanaka does not teach that the bill whose denomination has not been determined is the last bill delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivers such bills to a rejection aperture separate from the output

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receptacle. Requester's claim chart (Replacement Appendix 1) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious:

However, it would be obvious to anyone ordinary skilled in art to direct such a "mismatch" bill in Hatanaka device to any discharge, for example, the discharge where counted bills have been collected, thus making the "mismatch" bill the last bill on the pile of bills, the counted bills being below the "mismatch" bill.

The above statement, however, is a mere assertion of obviousness and provides insufficient rationale for rendering the claim obvious.

To facilitate review, [obviousness] analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

Regarding claims 4-6, 27, 38, 61, and 89, Hatanaka does not teach that (b) at least some bills the device has not denominated and that remain undenominated are delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivered such bills to a rejection aperture separate from the output receptacle. Requester's claim chart (Replacement Appendix 1) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious, however, there is insufficient rationale for making such a modification. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

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Regarding claims 10, 17, 24, 25, 31, 41-44, 49-52, 66, 72-87, 91, and 97-110, Requester's claim chart (Replacement Appendix 1) notes that Hatanaka does not disclose any particular transport speed and relies upon Curl for teaching that at the time the invention was made it was conventional to transport bills at speeds of 1200 bills per minute. However, such a teaching in Curl is only directed to transporting bills at such a speed rather than denominating bills. It appears that Curl is directed to denominating only a single denomination of currency, rather than mixed currency. That is, Curl obtains a waveform of a scanned bill and compares the waveform to a predetermined waveform (or two predetermined waveforms—one for each possible orientation of the bill or one for each side of the bill). If the scanned waveform and the predetermined waveform(s) match, then the bill is identified; otherwise, it is not. See columns 2/44-46, 6/15-19, and 8/46-55. Curl, therefore, is only capable of identifying one denomination of bill at a time, as opposed to multiple denominations, as claimed. As such, Curl is not considered to enable or otherwise teach denominating mixed currency in speeds excess of 800 bills per minute.

In addition, neither Nishito nor Jones appears to cure such a deficiency in Hatanaka—that is, they neither teach nor enable denominating mixed U.S. currency at speeds in excess of 800 bills per minute.

Regarding claims 11-13 and 62, none of Hatanaka, Nishito, Curl, and Jones appears to teach restacking bills on their edges, as claimed. Rather, in each of the prior art references, it appears that the bills lie on either face in a stack.

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Regarding claims 34, 45, 67, and 92, Hatanaka does not disclose printing the total value of denominated bills and the number of denominated bills of each denomination, as claimed. The Request merely asserts that such a limitation is obvious without sufficient supporting rationale. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

3. **Ground #2** (adopted-in-part, as modified)

—Claims 1, 2, 8, 9, 14-16, 19, 21, 23, 26, 29, 30, 32, 33, 35-37, 39, 40, 46-48, 53-56, 58-60, 63-65, 68-71, 88, 90, and 93-96 are rejected under 35 U.S.C § 103(a) as being unpatentable over O'Maley in view of Hatanaka.

These rejections are adopted as modified and as explained in the claim charts of the Request (see **Replacement Appendix 2**).

—Claims 7, 18, 20, 28, and 57 are rejected under 35 U.S.C § 103(a) as being unpatentable over O'Maley in view of Hatanaka, and further in view of Jones.

These rejections are adopted as explained in the claim charts of the Request (see **Replacement Appendix 2**).

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—Claims 3-6, 11-13, 22, 27, 34, 38, 45, 61, 62, 67, 89, and 92 are **not** rejected under 35 U.S.C § 103(a) as being unpatentable over O'Maley in view of Hatanaka, and further in view of Jones.

These rejections are not adopted for the following reasons:

Regarding claims 3 and 22, the combination of O'Maley and Hatanaka does not teach that the bill whose denomination has not been determined is the last bill delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivers such bills to a rejection aperture separate from the output receptacle. Requester's claim chart (Replacement Appendix 2) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious, however, such an assertion of obviousness provides insufficient rationale for rendering the claim obvious. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

Regarding claims 4-6, 27, 38, 61, and 89, Hatanaka does not teach that (b) at least some bills the device has not denominated and that remain undenominated are delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivered such bills to a rejection aperture separate from the output receptacle. Requester's claim chart (Replacement Appendix 2) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious, however, there is insufficient rationale for making such a modification. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

Regarding claims 11-13 and 62, none of O'Maley, Hatanaka, and Jones appears to teach restacking bills on their edges, as claimed. Rather, in each of the prior art references, it appears that the bills lie on either face in a stack.

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Regarding claims 34, 45, 67, and 92, the combination of O'Maley and Hatanaka does not disclose printing the total value of denominated bills and the number of denominated bills of each denomination, as claimed. The Request merely asserts that such a limitation is obvious without sufficient supporting rationale. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

4. **Ground #3** (adopted-in-part, as modified)

—Claims 1, 2, 8, 9, 13-16, 18-21, 23, 26, 29, 30, 32-36, 55, 56, 58-60, 63-65, and 67-71, are rejected under 35 U.S.C § 103(a) as being unpatentable over Takesako in view of Hatanaka and Nishito.

These rejections are adopted as modified and as explained in the claim charts of the Request (see **Replacement Appendix 3**).

—Claims 7, 11, 28, 37, 39, 40, 45-48, 53, 54, 57, 62, 88, 90, and 93-96, are rejected under 35 U.S.C § 103(a) as being unpatentable over Takesako in view of Hatanaka and Nishito, and further in view of Jones.

These rejections are adopted as explained in the claim charts of the Request (see **Replacement Appendix 3**).

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—Claims 3-6, 10, 12, 17, 22, 24, 25, 27, 31, 38, 41-44, 49-52, 61, 66, 72-87, 89, 91, and 97-110 are **not** rejected under 35 U.S.C § 103(a) as being unpatentable over Takesako in view of Hatanaka, and further in view of Jones and Nishito.

These rejections are not adopted for the following reasons:

Regarding claims 3 and 22, the combination of Takesako and Hatanaka does not teach that the bill whose denomination has not been determined is the last bill delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivered such bills to a rejection aperture separate from the output receptacle. Requester's claim chart (Replacement Appendix 3) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious, however, such an assertion of obviousness provides insufficient rationale for rendering the claim obvious. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

Regarding claims 4-6, 12, 27, 38, 61, and 89, the combination of Takesako and Hatanaka does not teach that (b) at least some bills the device has not denominated and that remain undenominated are delivered to the output receptacle. Rather, as the claim chart points out, Hatanaka instead delivered such bills to a rejection aperture separate from the output receptacle. Requester's claim chart (Replacement Appendix 3) asserts that modifying Hatanaka to achieve the claimed invention would have been obvious, however, there is insufficient rationale for making such a modification. See *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007).

Regarding claims 10, 17, 24, 25, 31, 41-44, 49-52, 66, 72-87, 91, and 97-110, Requester's claim chart (Replacement Appendix 3) identifies Takesako as transporting bills at 600 per minute and argues that "using advances in microprocessor technology since the filing of Takesako, it would have been obvious and within the capabilities of one skilled in the art to

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update the device illustrated by Takesako with modern electronics to establish a transporting rate in excess of about 800 bills."

At the time of the invention, transporting bills at over 800 per minute was within the capabilities of the existing technology—see, *e.g.*, the Jones patent. Denominating mixed currency at such high speeds, on the other hand, was not known to be within the capabilities of the existing technology. Takesako's 600 bills per minute is a substantial difference from the claimed 800 bills per minute. While it may have been obvious to try to produce a device that denominates mixed currency at speeds over 800 bills per minute, such a limitation cannot be considered a "design choice" satisfied merely by altering arbitrary parameters. It has been previously established that achieving such denominating speeds simply by "updating the electronics" of the Takesako device (*i.e.*, utilizing faster microprocessors and the like) was unlikely without undue experimentation. See *inter partes* reexamination serial no. 95/001,220, Action Closing Prosecution dated 10/1/2010, pp. 5-8.

In addition, neither Nishito nor Jones appears to cure such a deficiency in Hatanaka—that is, they neither teach nor enable denominating mixed U.S. currency at speeds in excess of 800 bills per minute.

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5. **Ground #4** (adopted)

—Claims 43 and 51 are rejected under 35 U.S.C § 103(a) as being unpatentable over the GFR-100 Instruction Manual in view of the GFR-100 Service Manual.

These rejections are adopted as explained in the claim charts of the Request (see **Replacement Appendix 4**).

6. **Ground #5** (adopted)

—Claims 43 and 51 are rejected under 35 U.S.C § 103(a) as being unpatentable over Conant in view of the GFR-100 Instruction Manual.

These rejections are adopted as explained in the claim charts of the Request (see **Replacement Appendix 5**).

***Conclusion***

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 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.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

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

Art Unit: 3992

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

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

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: *ESK*  
*JOT*



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,419	08/27/2010	7672499	985-P-1REEX	2038

41230 7590 11/19/2010  
CUMMINS-ALLISON CORP.  
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300 S. Riverside Plaza  
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EXAMINER
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LAROSE, COLIN M

ART UNIT	PAPER NUMBER
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3992

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11/19/2010

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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HONOLULU, HI 96816-4002

Date: **MAILED**  
**NOV 19 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001419  
PATENT NO. : 7672499  
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.

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b> 95/001,419	<b>Patent Under Reexamination</b> 7672499	
	<b>Examiner</b> COLIN M. LAROSE	<b>Art Unit</b> 3992	

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

The request for *ex parte* reexamination filed 27 August 2010 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)  PTO-892,      b)  PTO/SB/08,      c)  Other: \_\_\_\_\_

1.  The request for *ex parte* reexamination is GRANTED.

**RESPONSE TIMES ARE SET AS FOLLOWS:**

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2.  The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a)  by Treasury check or,  
b)  by credit to Deposit Account No. \_\_\_\_\_, or  
c)  by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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cc:Requester ( if third party requester )

<b>Transmittal of Communication to Third Party Requester Inter Partes Reexamination</b>	Control No.	Patent Under Reexamination	
	95/001,419	7672499	
	Examiner	Art Unit	
	COLIN M. LAROSE	3992	

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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.

**ORDER GRANTING REEXAMINATION OF U.S. PATENT 7,672,499**

***Request for Reexamination***

1. A third-party Request for Reexamination of claims 1-110 was received on 8/27/2010

based on the following prior art patents and/or publications:

- Exhibit B: U.S. Patent No. 4,179,685 (O'Maley)
- Exhibit C: U.S. Patent No. 4,464,786 (Nishito)
- Exhibit D: U.S. Patent No. 4,592,090 (Curl)
- Exhibit F: U.S. Patent No. 4,694,963 (Takesako)
- Exhibit G: Japanese Patent Publication No. 61-41439 (with English Translation)  
(Hatanaka)
- Exhibit I: U.S. Patent No. 4,114,804 (Jones)
- Exhibit J: Glory Ltd., Instruction Manual Model GFR-100 Currency Reader Counter  
(Aug. 31, 1995) ("GFR-100 Instruction Manual")
- Exhibit K: Glory Ltd., Service Manual Currency Reader Counter GFR-100 (December  
1995) ("GFR-100 Service Manual")
- Exhibit K1: U.S. Patent No. 5,680,472 (Conant)

***Prosecution History of the '499 Patent***

2. On 9/3/2009, the Examiner allowed all pending claims and issued the following statement regarding claims 252, 270, 277, 288, 306, 323, 339, and 348 (now patent claims 1, 19, 26, 37, 55, 72, 88, and 97, respectively):

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1. The following is an examiner's statement of reasons for allowance: None of the prior art discloses the claimed invention. Specifically, independent claim 252 requires, among other features, the combination of inventive features of "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" 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".

Independent claim 270 requires, among other features, the combination of inventive features of "at least one output receptacle positioned to receive bills after processing, only one of the at least one output receptacle being a denominated bill output receptacle" and "wherein the device is configured (a) to automatically 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 re-started while maintaining said cumulative value and the processing of said characteristic information output signal for bills following the bill for which the denomination could not be determined".

Independent claim 277 requires, among other features, the combination of inventive features of "at least one output receptacle positioned to receive bills after processing, only one of the at least one output receptacle being a denominated bill output receptacle" and "wherein the device is configured (a) to automatically halt the transport

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mechanism when the denomination of a bill is not determined by the denomination discriminating unit and then (b) to be restarted after being halted without any disruption of the one or more counts”.

Independent claim 288 requires, among other features, the combination of inventive features of “a single denominated bill output receptacle” and “wherein the device is configured (a) to automatically halt the transport mechanism when the denomination of the bill is not determined by the denomination discriminating unit and then (b) to be restarted after being halted, including restarting the transport mechanism, without any disruption of the aggregate total”.

Independent claim 306 requires, among other features, the combination of inventive features of “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” and “wherein the device is configured to deliver any bill that has been denominated and totaled to the one and only one of the at least one output receptacle including bills of a plurality of U.S. denominations”.

Independent claim 323 requires, among other features, the combination of inventive features of “at least one output receptacle positioned to receive bills after processing, a single one of the at least one output receptacle for receiving all denominated bills” and “wherein the device is configured to deliver any bill that has been denominated and totaled to the single output receptacle for receiving all denominated bills”.

Independent claim 339 requires, among other features, the combination of inventive features of “a single denominated bill output receptacle positioned to receive

bills after processing” and “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”.

Independent claim 348 requires, among other features, the combination of inventive features of “one and only one stacker wheel containing output receptacle positioned to receive denominated bills after processing and form a stack of U.S. bills”, “the transport mechanism being adapted to transport bills at a rate in excess of about 800 bills per minute” and “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”.

The inclusion of such combination of inventive features, in combination with other features, in the claims renders all claims allowable.

3. On 10/2/2009 and 12/1/2009, after the Applicant filed two different requests for continued examination for consideration of information disclosure statements, the Examiner issued additional separate notices of allowability containing the same reasons for allowance.

***Substantial New Question of Patentability***

4. The request for *inter partes* reexamination ("Request") alleges the following substantial new questions of patentability (SNQs) based on the above-identified prior art:

- SNQ 1: Claims 1-110 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over Hatanaka in View of Nishito in Further View of Curl and Jones**
- SNQ 2: Claims 1-9, 11-16, 18-23, 26-30, 32-40, 45-48, 53-65, 67-71, 88-90, 92-96 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over O'Maley in view of Hatanaka in Further View of Jones.**
- SNQ 3: Claims 1-110 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over Takesako in view of Hatanaka in Further view of Jones and Nishito**
- SNQ 4: Claims 43 and 51 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over the GFR-100 Instruction Manual in View of the GFR-100 Service Manual**
- SNQ 5: Claims 43 and 51 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over Conant in View of the GFR-100 Instruction Manual**

5. SNQs 1, 2, and 3 are each based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

"The existence of a substantial new question of patentability is not precluded by the fact that a patent or

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printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists SNQs based solely on the above-cited references. Replacement Appendices 1, 2, and 3 each identify teachings in the references that correspond to limitations the Examiner considered to be missing in the prior art during the previous examination.

For instance, in Replacement Appendix 1, the combination of Hatanaka, Nishito, Curl, and Jones is identified as putatively teaching the limitations in claim 1 that the Examiner considered to render the claims patentable:

"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 ... 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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Replacement Appendix 1 also identifies how the same combination putatively teaches the limitations that rendered independent claims 19, 26, 37, 55, 72, 88, and 97 patentable during the previous examination.

Similarly, Replacement Appendix 2 identifies how the combination of O'Maley, Hatanaka, and Jones putatively teaches the limitations that rendered independent claims 1, 19, 26, 37, 55, and 88 patentable during the previous examination, and Replacement Appendix 3 identifies how the combination of Takesako, Hatanaka, Jones, and Nishito putatively teaches the limitations that rendered independent claims 1, 19, 26, 37, 55, 72, 88, and 97 patentable during the previous examination.

Although the above-cited prior art references for SNQs 1-3 were cited during the previous examination and considered by the Examiner, they were not previously utilized as any bases of rejection, nor were their teachings discussed by the Examiner or Applicant with respect to the claims. Accordingly, the Request raises bona fide substantial new questions of patentability with regards to the claims by shedding "new light" on the above-identified "old art."

Regarding SNQs 4 and 5, the Request alleges that claims 43 and 51 are not supported by any of the '499 patent's parent applications and therefore should not receive benefit of priority to any of the parent applications. Claims 43 and 51 recite transporting and denominating bills "at a rate in excess of 1000 bills per minute." Absent evidence tending to support such limitations in the parent applications, these claims will be assigned a priority date of June 6, 2002, which corresponds to the filing date of the '499 patent.

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SNQs 4 and 5 are each based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined.

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists SNQs based solely on the above-cited references. Replacement Appendices 4 and 5 each identify teachings in the references that correspond to limitations the Examiner considered to be missing in the prior art during the previous examination.

For instance, Replacement Appendices 4 and 5 identify the GFR Instruction Manual and Conant as putatively teaching the limitations of claims 43 and 51 (GFR at AMRO 01131: counting at about 1000 notes/min.; and Conant at column 3/11-14) in combination with the limitations of the corresponding base claims.

Although the above-cited prior art references for SNQs 4 and 5 were cited during the previous examination and considered by the Examiner, they were not previously utilized as any bases of rejection, nor were their teachings discussed by the Examiner or Applicant with respect to the claims. Accordingly, the Request raises bona fide substantial new questions of patentability with regards to the claims by shedding "new light" on the above-identified "old art."

6. The Request to reexamine claims 1-110 is **GRANTED**.

***Notice of Other Proceedings***

7. The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,672,499 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability under 35 CFR 1.985(b) to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686.

***Conclusion***

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 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 ex parte reexamination proceeding should be directed:

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By Mail to: Mail Stop *Inter Partes* Reexam  
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://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

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.

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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: /J.R.P./

A handwritten signature in black ink, appearing to read 'M. Reinhart', with a long horizontal flourish extending to the right.

MARK J. REINHART  
CRU SPE-AU 3992