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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,420.

PATENT NO. 5692067.

ART UNIT 3992.

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

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,420	01/07/2011	5692067	985-P-2REX	6523
70001	7590	03/24/2011	EXAMINER	
NIXON PEABODY, LLP 300 S. Riverside Plaza, 16th Floor CHICAGO, IL 60606-6613			ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2011

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/011,420	Patent Under Reexamination 5692067	
	Examiner COLIN M. LAROSE	Art Unit 3992	

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

The request for *ex parte* reexamination filed 07 January 2011 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)).

cc:Requester (if third party requester)

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

Request for Reexamination

1. An *ex parte* request for reexamination (hereinafter "Request") of claims 1-80 was received on 1/7/2011 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 E: U.S. Patent No. 4,694,963 (Takesako)
- Exhibit F: U.S. Patent No. 4,761,002 (Reed)
- Exhibit G: U.S. Patent No. 4,114,804 (Jones)
- Exhibit H: Japanese Patent Publication No. 61-41439 (with English Translation)
(Hatanaka)
- Exhibit I: U.S. Patent No. 5,295,196 (Raterman)

Prosecution History of the '067 Patent

2. The Request's summary of the prosecution history of the '067 patent (see Request, pp. 11-17) is substantially correct.

3. On 12/9/1996, the Patent Owner responded to the examiner's claim rejections in view of the Glory GFB-200/210/220/230 device with the following remarks:

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Claims 34-46 and 86-113 were rejected under § 102 on the basis of the Glory GFB-200/210/220/230, Desk-Top Bank Note Counter brochure. This rejection is respectfully traversed.

Independent claims 34, 46, 86, and 89 contain the limitation of "said discriminating unit counting and determining the denomination of said bills." Independent method claim 40 contains the limitation of "counting and determining the denomination of said bills under control of the evaluation device." As demonstrated during the interview on December 5, 1996, the Glory GFB-230 note counter does not determine the denomination of notes that it counts. Therefore it does not anticipate these claims.

Independent claim 38 contains the language:

an input receptacle for receiving a stack of documents to be evaluated, genuine ones of said documents each having one of a plurality of images thereon, said plurality of images defining a plurality of document types;...
said discriminating unit being capable of distinguishing among said plurality of document types by scanning the image on each of said documents, said discriminating unit counting and determining the document type of said documents

Independent method claim 44 contains similar language. The Glory GFB-230 is not capable of distinguishing among a plurality of document types by scanning the image of each document.

Accordingly, the Glory GFB-230 does not anticipate claims 38 and 44.

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With respect to claims 35-36, 39, 41-42, 45-46, 88, 90-96, 99-105, and 108-113, these claims are additionally distinguishable because they require the transport mechanism to halt when the discriminating unit fails to determine the denomination or type of a document. The Glory GFB-230 does not teach the determination of the denomination or document type of documents and thus does not teach halting the transport when the denomination or type is not determined. Accordingly, claims 35-36, 39, 41-42, 45-46, 88, 90-96, 99-105, and 108-113 are allowable over the Glory GFB-230.

4. On 3/18/1997, the Examiner issued a Notice of Allowability, however, no reasons for allowance were given.

Substantial New Question of Patentability

5. The Request alleges the following substantial new questions of patentability (SNQs) based on the above-identified prior art:

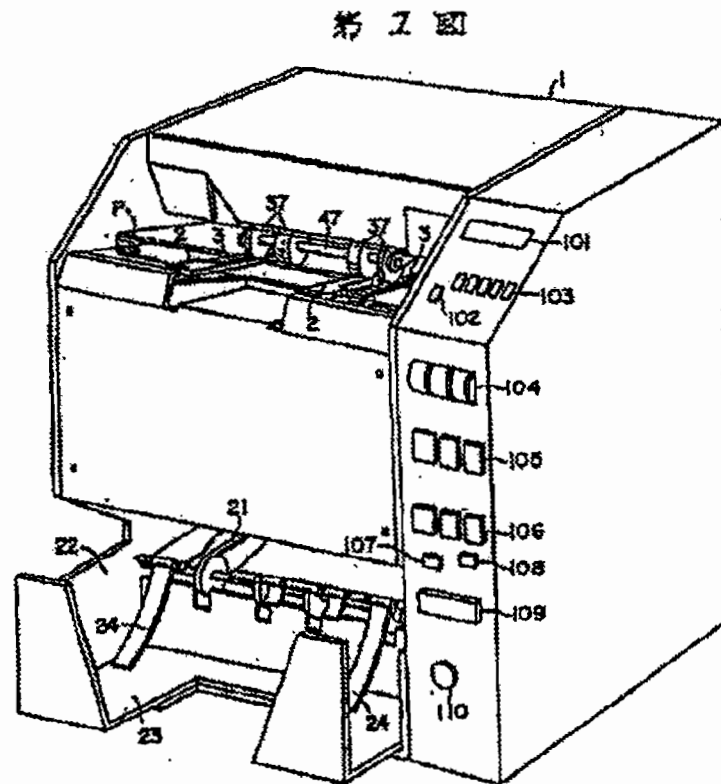
- SNQ 1: Claims 1-80 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over Hatanaka in View of Curl, Reed and Jones in Further View of Nishito**
- SNQ 2: Claims 1-80 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over O'Maley in view of Reed, Curl and Hatanaka in Further View of Nishito.**
- SNQ 3: Claims 1-80 Are Unpatentable Under 35 U.S.C. § 103 as Obvious Over Takesako in view of Curl, Reed and Hatanaka in Further view of Nishito**

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SNQ 4: Claims 37-54 Are Invalid as Claiming the Same Invention as Claims 1-18 of the Patent Owner's Earlier Issued '196 Patent Under the Doctrine of Statutory Type Double Patenting.

6. SNQs 1, 2, and 3 are based in part on Hatanaka, which is directed to a currency evaluation device. The disclosure of Hatanaka was not cited or considered during the initial examination of the '067 patent.

The Request identifies Hatanaka as teaching a currency evaluation device (pictured below) that comprises substantially all of the limitations of claim 1, *i.e.*, an input for receiving a stack of bills, a single output receptacle, a transport mechanism, a discriminating unit, and means for flagging a bill whose denomination is not determined. See Request, pp. 41-48.



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Accordingly, Hatanaka is identified as putatively teaching the "denominating" and "flagging" limitations that previously distinguished the claims from the Glory device. Hatanaka, therefore, is considered important in determining the patentability of the claims and, in combination with the other cited prior art references, does raise a bona fide substantial new question of patentability.

7. SNQ 4 asserts that claims 37-54 are identical to claims 1-18 of U.S. Patent 5,295,196 and therefore should be reexamined based on statutory double patenting. Since double patenting is an issue that is proper for a reexamination proceeding, claims 37-54 will be reexamined on such a basis. See MPEP § 2258(I)(D).

8. The Request to reexamine claims 1-80 is **GRANTED**.

Patent Owner Statement (Optional)

9. In response to this Order for Reexamination, the Patent Owner is given a two (2) month period to file an optional Patent Owner Statement in accordance with 37 C.F.R. 1.530(b) and (c). The Patent Owner Statement must clearly point out why the patent claims are believed to be patentable, considering the cited prior art patents or printed publications alone or in any reasonable combination. In addition, the Patent Owner may utilize the Patent Owner Statement

to introduce amendments. A copy of the Patent Owner Statement must be served on the Third Party Requester. See MPEP § 2249.

If a Patent Owner Statement is timely filed and served on the Third Party Requester, the Third Party is given the opportunity to reply within two (2) months from the date of service in accordance with 37 C.F.R. 1.535. The reply need not be limited to the issues raised in the Patent Owner Statement and may include additional prior art patents and printed publications as well as any issue appropriate for reexamination. A copy of the reply must be served on the Patent Owner. If no Patent Owner Statement is filed, no reply is permitted from the Third Party Requester. See MPEP § 2251.

Notice of Other Proceedings

10. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,692,067 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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Conclusion

11. 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
 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.

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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:

ESK
AJK

Receipt date: 01/07/2011

90011420 - GAI: 3992

Doc Code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		
	First Named Inventor	Raterman, Donald	
	Art Unit		
	Examiner Name		
	Attorney Docket Number	985-P-2REEX	

U.S.PATENTS						
Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	4179685		1979-12-18	O'Maley	
	2	4464786		1984-08-07	Nishito	
	3	4592090		1986-05-27	Curl	
	4	4694963		1987-09-22	Takesako	
	5	4761002		1988-08-02	Reed	
	6	4114804		1978-09-19	Jones	
	7	5295196		1994-03-15	Raterman	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S.PATENT APPLICATION PUBLICATIONS

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Receipt date: 01/07/2011		Application Number	90011420 - GAU: 3992		
			Filing Date			
			First Named Inventor	Rateman, Donald		
			Art Unit			
			Examiner Name			
			Attorney Docket Number	985-P-2REEX		

Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1					

If you wish to add additional U.S. Published Application citation information please click the Add button.

FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ²	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1	61-41439	JP			Hatanaka		<input type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

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EXAMINER SIGNATURE

Examiner Signature	/Colin LaRose/	Date Considered	02/28/2011
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.