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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/007,830.

PATENT NO. 6032137.

ART UNIT 3993.

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. 90/007,830	Patent Under Reexamination 6032137	
	Examiner Peter C. English	Art Unit 3993	

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

- a  Responsive to the communication(s) filed on 15 December 2006 and 30 January 2007.      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 1 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 1-67 are subject to reexamination.  
1b.  Claims \_\_\_\_\_ are not subject to reexamination.  
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.  
3.  Claims 1-67 are patentable and/or confirmed.  
4.  Claims \_\_\_\_\_ are rejected.  
5.  Claims \_\_\_\_\_ are objected to.  
6.  The drawings, filed on \_\_\_\_\_ are acceptable.  
7.  The proposed drawing correction, filed on 30 January 2007 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)

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### EX PARTE QUAYLE ACTION

1. This *ex parte* reexamination proceeding is in condition for termination of the prosecution by means of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) except for the following formal matters:

**Drawings:** The proposed corrections to Figs. 1, 2, 3A and 6 of the drawings filed on 30 January 2007 have been approved by the examiner. However, the corrected formal drawing sheets (containing Figs. 1, 2, 3A and 6) filed on 30 January 2007 have been disapproved because they fail to comply with 37 CFR 1.530(d)(3). Specifically, the corrected formal drawing sheets filed on 30 January 2007 identify *sheets* of drawings as “Amended Sheet”. However, 37 CFR 1.530(d)(3) requires that amended *figures* (not sheets) be identified as “Amended”. Preferably, the identifier “Amended” is placed adjacent the view number (e.g., FIG. 1), and should be oriented in the same direction as the figure and view number.

**Specification:** The proposed amendment to the paragraph at column 6, lines 23-26 of the specification fails to comply with 37 CFR 1.530(f), which requires that matter to be added must be underlined. Specifically, the symbol “<sup>TM</sup>” has been added to the first line of the paragraph, but is not underlined.

2. **Prosecution on the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **ONE MONTH** from the mailing date of this letter.

#### *Response to Arguments*

3. Patent owner argues that the prior art rejections set forth in the previous Office action (mailed on 30 November 2006) should be withdrawn. The examiner agrees for the following reasons:

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**35 USC 102 Rejections: Campbell et al. (US 5,373,550)**

Patent owner argues that the Campbell et al. reference fails to anticipate claims 1, 26, 42 and 43 of Patent No. 6,032,137 because, while Campbell et al. refers to the encrypting of certain information, Campbell et al. fails to teach encrypting information identifying one or more remote image capturing subsystems. This argument is persuasive; therefore, the rejections of claims 1, 26, 42 and 43 (and claims depending therefrom) based on Campbell et al. taken alone have been withdrawn.

Additionally, patent owner argues that the Campbell et al. reference fails to manage processing of transaction data as recited in claims 1, 26, 42 and 43, and fails to teach “subsystems” as recited in claims 1 and 42. While these arguments are not necessarily considered to be persuasive, the rejections based on Campbell et al. taken alone have been withdrawn for the reasons given in the preceding paragraph.

**35 USC 102 Rejections: ANSI X9.46-1995**

Patent owner argues that there is no evidence that ANSI X9.46-1995 is in fact a printed publication and therefore no evidence that it has a publication date preceding the effective filing date of Patent No. 6,032,137. Patent owner further argues that the rejections based on ANSI X9.46-1995 set forth in the previous Office action amount to a selective picking and choosing of various different disclosures in the document in an improper attempt to piece together the invention recited in claims 1, 26, 42 and 43 of Patent No. 6,032,137, and that in fact the ANSI X9.46-1995 reference never discloses a single embodiment that remotely teaches or suggests the claimed invention. These arguments are persuasive; therefore, the rejections of claims 1, 26, 42 and 43 (and claims depending therefrom) based on ANSI X9.46-1995 taken alone has been withdrawn.

**35 USC 103 Rejection: Campbell et al. (US 5,373,550) in view of Admitted Prior Art**

Patent owner argues that the Admitted Prior Art fails to make up for the deficiencies in Campbell et al. Further, patent owner argues that the rejection based on Campbell et al. in view of Admitted Prior Art set forth in the previous Office action misinterprets the Admitted Prior Art and fails to adequately establish why it would have been obvious to modify Campbell et al. in the manner suggested by the examiner. These arguments are persuasive; therefore, the rejection of claims 3-8 and 28 based on Campbell et al. in view of Admitted Prior Art has been withdrawn.

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the alleged commercial success, patent owner has failed to adequately provide objective evidence of nonobviousness. To be of probative value, any secondary evidence must be related to the claimed invention (i.e., nexus is required). See MPEP 716.01(b) and 716.03. Further, to be of probative value, any objective evidence must be supported by actual proof (i.e., factual evidence); unsubstantiated assertions are insufficient. See MPEP 716.01(c). In the case of alleged commercial success, the evidence submitted must be commensurate in scope with the claims, must show that the commercial success was derived from the merits of the claimed invention and not other factors, and must establish that the commercial success flows from the functions and advantages disclosed or inherent in the patent's disclosure of the claimed invention. See MPEP 716.03(a) and (b).

Since the rejections under 35 USC 103 have been withdrawn, objective evidence of commercial success as a secondary consideration of nonobviousness is not needed to establish the patentability of the claims in the present proceeding.

#### ***Declarations Under Rules 131 and 132***

5. The declaration of Claudio R. Ballard filed on 30 January 2007 under 37 CFR 1.131 has been considered. This declaration is not needed to overcome the ANSI X9.46-1995 reference because, as explained above, there is no evidence that ANSI X9.46-1995 is in fact a printed publication and therefore no evidence that it has a publication date preceding the effective filing date of Patent No. 6,032,137.

With respect to the Geer (US 5,930,778) reference, it is unnecessary for patent owner to antedate this reference since this reference was not relied upon to reject claims in the previous Office action. Nevertheless, since patent owner has asserted that the Claudio R. Ballard declaration overcomes the Geer reference, this declaration has been considered. The declaration of Claudio R. Ballard is ineffective to overcome the Geer (US 5,930,778) reference for the following reasons.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Geer (US 5,930,778) reference. Mr. Ballard asserts that he "sketched out some diagrams of the broad stroke elements of the invention" (see item 6 of the declaration); however, no copies of these sketched out diagrams have been provided as proof of conception.

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Since the rejections under 35 USC 103 have been withdrawn, objective evidence of commercial success as a secondary consideration of nonobviousness is not needed to establish the patentability of the claims in the present proceeding.

#### ***Declarations Under Rules 131 and 132***

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Further, Mr. Ballard asserts, "On Columbus Day 1994, I disclosed this invention to my close friend Virginia Lupoli" (see item 7 of the declaration); however, no evidence (e.g., a detailed declaration from Virginia Lupoli) has been submitted establishing that Mr. Ballard provided a complete disclosure of the invention to Virginia Lupoli on the alleged date. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Further, the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country. Mr. Ballard asserts, "By late Summer 1995, I had put together a working model..." (see item 9 of the declaration), and "Sometime in the Fall of 1995...I demonstrated the working prototype to Peter Lupoli" (see item 10 of the declaration). No evidence (e.g., documentation/pictures of the working model, a declaration from Peter Lupoli, etc.) has been provided to establish that these claims are true.

Since the rejections based on ANSI X9.46-1995 have been withdrawn and since Geer (US 5,930,778) has not been relied upon to reject claims, a declaration under 37 CFR 1.131 antedating these references is not needed to establish the patentability of the claims in the present proceeding.

6. The declaration of John E. Hiles filed on 30 January 2007 under 37 CFR 1.132 has not been considered because it fails to specifically address the rejections set forth in the previous Office action mailed on 30 November 2006. Instead, the John Hiles declaration addresses unrelated issues in litigation. While certain aspects of this declaration may be pertinent to the present reexamination proceeding, this Office lacks the resources to pick through a lengthy document attempting to decipher which portions may be relevant and which portions are to be ignored.

Since the prior art rejections have been withdrawn, a declaration under 37 CFR 1.132 is not needed to establish the patentability of the claims in the present proceeding.



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*Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information... **Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.** (emphasis added)*

#### **Remarks**

9. Litigation involving Patent No. 6,032,137 has been stayed for the purposes of reexamination. Accordingly, a shortened statutory period of 1 month is set for response to Office actions in this proceeding. See MPEP 2263.
10. 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 *ex parte* 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).
11. Any proposed amendment filed in this reexamination proceeding must be made in accordance with 37 CFR 1.530(d)-(j) and comply with the formal requirements of 37 CFR 1.52(a) and (b). See MPEP 2250.
12. Responses to this Office action may be submitted by facsimile and should be directed to the Central Reexamination Unit using facsimile number 571-273-9900. A confirmation of receipt will be generated automatically for all papers transmitted via this facsimile number.

All responses to be delivered by the United States Postal Service (USPS) should be addressed as follows:

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Mail Stop Ex Parte Reexam  
Central Reexamination Unit  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Hand-delivered responses should be labeled "Attn: Central Reexamination Unit" and delivered to:

Customer Service Window  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

NOTE: Submissions for reexamination proceedings are ***not*** accepted through EFS-Web (the USPTO's web-based document submission system), but must be made in paper. See MPEP 2224 (*ex parte*) and 2624 (*inter partes*).

13. Any document filed by either the patent owner or third party requester ***must be served*** on the other party (or parties in a merged proceeding) in the reexamination proceeding in the manner provided by 37 CFR 1.248. See 37 CFR 1.550(f) and MPEP 2266.03.

14. 37 CFR 1.33(c) has been revised to provide that the patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent. See *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007)(Final Rule).

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date. This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date. ***Parties are to take this change into account when filing papers***, and direct communications accordingly.


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In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

15. 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 the patent 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.

16. Any inquiry concerning this communication or earlier communications from the Reexamination Examiner should be directed to Peter English whose telephone number is 571-272-6671. The examiner can normally be reached on Monday through Thursday (7:00 AM - 5:00 PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andres Kashnikow, can be reached at 571-272-4361.

For general information regarding reexamination proceedings please call the Central Reexamination Unit at 571-272-7705. For guidance on reexamination practice and procedure please call the Office of Patent Legal Administration at 571-272-7703. Information regarding this reexamination proceeding may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

  
Peter C. English 5/15/07  
Primary Examiner  
Central Reexamination Unit

Conferees:   


pe  
15 May 2007