



7274 U.S. PTO



03/20/09

Re-exam

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:		Confirmation No.: 4117
James M. Hair, III et al.		Atty. Docket No.: 2543-0454
Control No.:	90/009,232 1	Art Unit: 3993
Patent No.:	7,191,915	Examiner: Peter C. English
Issued:	March 20, 2007	Date: 3/20/09
Title:	OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF VENDING MACHINE	

TRANSMITTAL

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached please find the following documents from the previously identified pending continuation application Serial No. 12/010,126, submitted for filing in connection with the above-identified application:

- Amendment filed on February 6, 2009
- Office Action from USPTO mailed on November 12, 2008
- Supplemental Preliminary Amendment filed on April 29, 2008
- Supplemental Preliminary Amendment filed on April 1, 2008
- Preliminary Amendment filed on January 22, 2008
- Certificate of Service

Application of: James M. Hair, III et al.
Application S.N.: 90/009,232 I
Attorney Docket No.: 2543-454

Our Deposit Account No.: 501860

Our Order No. (Client-Matter No.2543-454):

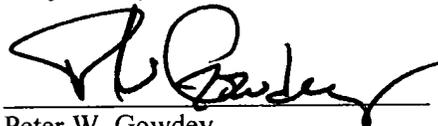
CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. (or Attorney Docket No.) shown in the heading hereof for which purpose a duplicate copy of this paper is attached.

This Charge Statement does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

CUSTOMER NUMBER 42624

Respectfully submitted,

By:



Peter W. Gowdey

Registration No.: 25,872

Davidson Berquist Jackson & Gowdey LLP
Phone: (703) 894-6400

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Transmittal, Amendments, and Office Action from the pending continuation Serial No. 12/010,126 have been served by Federal Express on counsel for third party requester, Crane Merchandising Systems, Inc., on March 20, 2009:

William A. Munck
Munck Carter, P.C.
600 Banner Place Tower
12770 Coit Rd.
Dallas, TX 75251

March 20, 2009


Peter W Gowdey



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,231	07/31/2008	7,191,915	CRAN01-00299	8969

42624 7590 01/02/2009

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 01/02/2009

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DOCKET CLERK
P.O. BOX 800889
DALLAS, TX 75380

Date: MAILED

JAN 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009231
PATENT NO. : 7191915
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)).



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Davidson Berquist Jackson & Gowdey, LLP
4300 Wilson Boulevard
7th Floor
Arlington, Virginia 22203

(For Patent Owner)

MAILED

JAN 02 2009

CENTRAL REEXAMINATION UNIT

Docket Clerk
PO Drawer 800889
Dallas, Texas 75380

(For Third Party Requester)

In re Hair III et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,231
Filed: July 31, 2008
For: U.S. Patent No. 7,191,915 C1

:
: DECISION
: DENYING
: PETITION
:

This is a decision on the third party requester petition entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)," filed on October 20, 2008, in which requester seeks reconsideration of the Order Denying *Ex Parte* Reexamination mailed September 19, 2008. The petition is before the Director of the Central Reexamination Unit for consideration.

Summary: The third party requester petition is **denied**. The decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c).

REVIEW OF FACTS

1. U.S. Patent No. 7,191,915 (hereinafter, the '915 patent) issued on March 20, 2007.
2. A request for *ex parte* reexamination was filed by a third party requestor, on July 31, 2008. The resulting reexamination proceeding was assigned Control No. 90/009,231 (hereinafter, the '9231 proceeding).
3. Reexamination was requested for claims 1-46 of the '915 patent.
4. A Notice of Reexamination Request Filing Date was issued on August 5, 2008.

5. An order denying the request for reexamination for claims 1-46 was mailed on September 19, 2008.
6. On October 20, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.515(c).
7. On October 31, 2008, the third party requester filed a request for refund for the \$400 petition fee charged to Deposit Account No. 50-0208.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '9231 reexamination proceeding has petitioned seeking relief from the examiner's September 19, 2008 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR 1.515(c) provides:

The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable." [Emphasis added.]

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*. Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

35 USC § 303(c) and 37 CFR 1.515(c) provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the

instant petition, has been made as to whether the July 31, 2008 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter “SNQ”). For the reasons set forth below, the request for reexamination of the ‘915 patent filed in the ‘9231 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner’s decision to deny reexamination is proper.

II. Examiner’s Basis for Finding that the Request for Reexamination Did Not Raise an SNQ

The examiner’s decision to deny the request for reexamination was based on a determination that the request for reexamination did not establish a SNQ because U.S. Pat. No. 6,330,958 to Rushkin (hereinafter “the Rushkin ‘958 patent”) – the reference relied upon as providing the new teaching to establish the SNQ – does not qualify as prior art to the ‘915 patent for which reexamination was requested.

Specifically, the examiner determined that the ‘915 patent had an effective filing date of, at least, March 3, 1999, and Rushkin was only entitled to a prior art date of October 8, 1999, its actual U.S. filing date and was not 102(e) prior art based on any internationally filed application. Since Rushkin’s prior art date as determined by the examiner is not prior to the effective filing date of the ‘915 patent, the examiner found that Rushkin was not prior art to the ‘915 patent, and therefore, does not raise an SNQ. The examiner also stated that the references cited in the request were considered both alone and in combination, and that the references fail to raise an SNQ to any one of the claims of the ‘915 patent. See paragraph 7 of the Order dated September 19, 2008.

III. Petitioner’s Argument that the Request for Reexamination Did Raise an SNQ

Petitioner takes the position that the request in the ‘9231 reexamination request must be deemed to raise a substantial “new” question of patentability, because, under the current form of 35 USC 102(e), the proper prior art date for the Rushkin ‘958 patent is earlier than the April 29, 1998 priority date of the ‘915 patent.

In support of this position, petitioner states that the Rushkin ‘958 patent (filed October 8, 1999) is a continuation-in-part of international application PCT/US98/08064 [hereinafter “PCT ‘064”], filed on April 15, 1998, and PCT ‘064 is a continuation-in-part of U.S. Patent Application No. 08/844,767 [hereinafter “the ‘767 application”], which was filed on April 22, 1997.¹

Petitioner presents two arguments in support of his position:

(1) Relying on the text of the amendments to 35 USC 102(e) enacted with an effective date of November 29, 2000, the petition argues that the subject matter of Rushkin supported by PCT ‘064 receives the benefit of the earlier filing date of April 15, 1998, and the subject matter of

¹ Petitioner does not raise the question of whether Rushkin is entitled to the October 13, 1998 priority date of provisional application 60/104,006 from which it claims priority. Presumably, such priority would not avail requester, since the ‘915 patent is given benefit back to April 29, 1998.

Rushkin support by both PCT '064 and the '767 application receives the benefit of the earlier filing date of April 22, 1997; and

(2) Articles 11(3) and 64(4)(a) of the Patent Cooperation treaty require the granting of such benefit under 35 USC 102(e). (See petition pages 3-6).

Thus, in light of the assertion that the Ruskin '958 patent qualifies as prior art under 35 USC 102(e), the petitioner requests reconsideration of the order denying reexamination.

IV. Analysis of Petitioner's Arguments

(1) Petitioner's first argument is fatally flawed in that it ignores the effective date provision of the AIPA for the amendments to 35 USC 102(e). This fact alone is dispositive. Therefore, petitioner's detailed parsing of the statutory language as amended by the AIPA will not be addressed.

The effective date provision, reproduced below, clearly states that for a patent resulting from an international application filed before November 29, 2000 the prior art date is based on the version of 35 USC 102(e) in effect on November 28, 2000. As the Rushkin '958 patent was filed on October 8, 1999, the prior art effect of the Rushkin '958 patent is governed by the version of 35 U.S.C. 102(e) in effect on November 28, 2000, and as a result, its prior art date cannot be any international filing date but is instead the U.S. filing date of the later filed 35 U.S.C. 111(a) application or, possibly, the provisional filing date under 35 U.S.C. 111(b).^{2, 3} Accordingly, the prior art date of the Rushkin '958 patent is no earlier than October 13, 1998, the filing date of Rushkin's provisional application.⁴

The '915 patent has an effective priority date of April 29, 1998 based on the filing date of a provisional application under 35 U.S.C. 111(b). Requester has not raised (per MPEP 2617) any question as to the patent's entitlement to that priority.

Because the '915 priority date is before Rushkin's 102(e) prior art date, the Rushkin '958 patent is not available as prior art relative to the '915 patent for which reexamination is requested. Therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '915 patent are patentable.

35 U.S.C. § 102(e) currently provides:

² Particularly instructive and relevant to the instant situation is example 9 in MPEP 706.02(f)(1) See the text below the timeline in Example 9 in MPEP 706.02(f)(1) that states: "If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 35 U.S.C. 102(e) date of the actual filing date of later-filed 35 U.S.C. 111(a) application in the example above (01 Dec 2000)."

³ It is further noted that the '767 application was abandoned on October 14, 1998, which was prior to the filing date of Rushkin's 35 U.S.C. 111(a) application, which issued as the '958 patent. Therefore, there was no co-pendency between the Rushkin '958 patent and the '767 application

⁴ This decision takes no position as to whether the '958 patent is actually entitled to the earlier provisional filing date, and is thus prior art as of that date.

A person shall be entitled to a patent unless —

...

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

...

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); Subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

“Sec. 4508. Effective Date” of the AIPA provides in relevant part:

Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

35 U.S.C. § 102(e) in effect on November 28, 2000 provided:

A person shall be entitled to a patent unless —

...

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent,

(2) Petitioner’s second argument that Articles 11(3) and 64(4)(a) of the Patent Cooperation Treaty (PCT) require the granting of such benefit under 35 USC 102(e) will not be explicitly addressed in this decision. Petitioner’s argument is solely based on the language of the PCT, and does not adequately address U.S. law, *e.g.*, as set by the applicable U.S. statutes (see subsection IV(1) above). The PCT is not a self-executing treaty and is only put in effect by the enactment of U.S. law (*e.g.*, statutes and regulations). Therefore, petitioner’s second argument is not convincing.

V. De Novo Review of the Request for Reexamination - Findings and Analysis

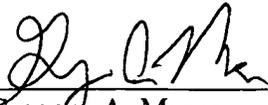
A *de novo* review of the request for reexamination in the ‘9231 *ex parte* reexamination, as it was filed on July 31, 2008, shows that the request for reexamination was based upon an assertion by third party requester that the Rushkin ‘958 patent qualifies as a prior art reference based upon 35 USC 102(e). Review of the record resulted in a determination that the examiner properly found

the Rushkin '958 patent not to qualify as prior art to the '915 patent by applying the version of 35 USC 102(e) that was in effect prior to the enactment of the AIPA.

The *de novo* review on the record of the request for reexamination in the '9231 reexamination proceeding, undertaken in light of the arguments presented in the present petition compels the conclusion that the request for reexamination in the '9231 reexamination proceeding does not raise a new SNQ with respect to the claims of the '915 patent for which reexamination was requested. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

CONCLUSION

1. The third party requester petition seeking review of the examiner's decision is **denied**, as to the underlying relief requested. Based on a *de novo* review on the record of the request for re-examination, the Rushkin '958 patent is not available as prior art relative to the '915 patent for which reexamination is requested, and therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '915 patent are patentable. Accordingly, a SNQ is not found to have been raised by the request for reexamination.
2. The request for refund of the petition fees, filed on October 31, 2008, will be acted upon in due course.
3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).
4. This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.
5. Telephone inquiries related to the present decision may be directed to Jeanne Clark at (571) 272-7714, Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director
Central Reexamination Unit

Pet7/Deny reexam
12-30-08

DOCKET NO. CRAN01-00299
Customer No. 23990

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of : James M. Hair, III et al.
Control No. : 90/009,231
Filed : July 31, 2008
Patent No. : 7,191,915
Issued : May 4, 2004
For : OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF
VENDING MACHINE

MAIL STOP 16
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR REFUND

Applicant hereby requests a refund in the amount of \$400.00 for a petitions fee charged to Deposit Account No. 50-0208 on October 21, 2008. A copy of the Deposit Account Statement dated October 2008 is attached. The Deposit Account Statement indicates a Fee Code of 1462, which corresponds to the petition fee set forth in 37 C.F.R. § 1.17(f), and a charge of \$400.00, which corresponds to the fee specified in 37 C.F.R. § 1.17(f).

Requester, Crane Co., filed a Petition Under 37 C.F.R. §§ 1.181(a) and 1.515(c) on October 16, 2008. A copy of the Petition Under 37 C.F.R. §§ 1.181(a) and 1.515(c) and Certificate of Mailing as filed on October 16, 2008 are enclosed.

37 C.F.R. § 1.181(a) reads:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

Requester's petition filed on October 16, 2008 was from an action of an Examiner in an *ex parte* reexamination proceeding, which action was not subject to appeal to the Board of Patent Appeals and Interferences or to a court. 37 C.F.R. § 1.181(a) makes no mention of any fee required, and makes to reference to 37 C.F.R. § 1.17(f).

37 C.F.R. § 1.515(c) reads:

(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

Requester's petition filed on October 16, 2008 was from an Examiner's determination in an *ex parte* reexamination proceeding, which determination is nonappealable. 37 C.F.R. § 1.515(c) specifically provides for Requester's petition filed October 16, 2008. 37 C.F.R. § 1.515(c) makes no mention of any fee required, and makes to reference to 37 C.F.R. § 1.17(f).

37 C.F.R. § 1.17(f) reads (emphasis supplied):

- (f) For filing a petition under one of the following sections which refers to this paragraph: \$400.00
- § 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.
 - § 1.53(e)—to accord a filing date.
 - § 1.57(a)—to accord a filing date.
 - § 1.182—for decision on a question not specifically provided for.
 - § 1.183—to suspend the rules.
 - § 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
 - § 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

Note that 37 C.F.R. § 1.17(f) specifically indicates that the fee is applicable to petitions under section “which refers to this paragraph.” Requester’s petition was filed pursuant to 37 C.F.R. §§ 1.181(a) and 1.515(c), which do NOT refer to 37 C.F.R. § 1.17(f). Moreover, 37 C.F.R. § 1.181(a) is not applicable to Requester’s petition filed October 21, 2008 since that provision applies, as stated, to petitions “for decision on a question not specifically provided for.” The petition filed October 16, 2008 requests reconsideration of a decision on a request for reexamination, which is specifically provided for under 37 C.F.R. § 1.515(c). Accordingly, 37 C.F.R. § 1.17(f) is not applicable to, the petition fee specified in 37 C.F.R. § 1.17(f) is not required for, the petition filed on October 16, 2008.

No fee is believed to be required for the petition filed October 21, 2008. Please issue a credit in the amount of \$400.00 to Deposit Account No. 50-0208 for this charge.

Respectfully submitted,

MUNCK CARTER, P.C.

Date: 10-31-2008


Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
E-mail: dvenglarik@munckcarter.com



**United States
Patent and
Trademark Office**

Return To:
USPTO
Home
Page
Finance
Online
Shopping
Page

Deposit Account Statement

Requested Statement Month: October 2008
Deposit Account Number: 500208
Name: MUNCK CARTER, P.C.
Attention: WILLIAM A. MUNCK, ESQ
Street Address 1: 600 BANNER PLACE TOWER
Street Address 2: 12770 COIT ROAD
City: DALLAS
State: TX
Zip: 75251
Country: UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
10/01	23396	60963073	. PRES06-00423	8007	\$20.00	\$7,678.00
10/02	48	12151708	DBKH01-00022	2252	\$170.00	\$7,508.00
10/02	15164	77491116	KIDK01-00057	7001	\$325.00	\$7,183.00
10/06	41	11053056	P06238	1251	\$10.00	\$7,173.00
10/07	6589	78606143	CART05-00002	7004	\$150.00	\$7,023.00
10/07	60	10750008	03-SIN-091	1251	\$10.00	\$7,013.00
10/08	4395	61103461	H0020797-0102	1005	\$220.00	\$6,793.00
10/08	4576	61103461	H0020797-0102 US	8021	\$40.00	\$6,753.00
10/08	5077	11419398	H0004650-0760	1251	\$130.00	\$6,623.00
10/08	5078	11419398	H0004650-0760	1801	\$810.00	\$5,813.00
10/08	6406	E-REPLENISHMENT		9203	-\$260.00	\$6,073.00
10/08	10908	78872559	WORK02-00041	7004	\$150.00	\$5,923.00
10/08	10934	78871990	WORK02-00039	7004	\$150.00	\$5,773.00
10/09	10887	77589223	CHIM01-00003	7001	\$325.00	\$5,448.00
10/09	10985	77589236	CHIM01-00004	7001	\$325.00	\$5,123.00
10/10	60	11773918	2006.11.008.WT0	8007	\$60.00	\$5,063.00
10/10	61	11773918	2006.11.008.WT0	8023	\$120.00	\$4,943.00
10/10	143	12287413		9204	-\$545.00	\$5,488.00
10/15	2449	E-REPLENISHMENT		9203	-\$2,292.00	\$7,780.00
10/15	3518	10745396	ILFI01-00145	1253	\$1,110.00	\$6,670.00
10/15	6796	E-REPLENISHMENT		9203	-\$220.00	\$6,890.00
10/15	7130	61105314	H0020425-0760	1005	\$220.00	\$6,670.00
10/15	7241	78892606	ALBR01-00017	7402	\$300.00	\$6,370.00
10/15	15169	12251732	H0018998-0783	1011	\$330.00	\$6,040.00
10/15	15171	12251732	H0018998-0783	1111	\$540.00	\$5,500.00
10/15	15172	12251732	H0018998-0783	1311	\$220.00	\$5,280.00

10/15	15173	12251732	H0018998-0783	1202	\$52.00	\$5,228.00
10/15	15360	12251732	H0018998-0783 US	8021	\$40.00	\$5,188.00
10/16	640	US0628256	STMI01-00226	8021	\$40.00	\$5,148.00
10/16	6680	61105716	H0009736-0103	1005	\$220.00	\$4,928.00
10/16	66	12287845		9204	-\$863.00	\$5,791.00
10/16	3	09967867	US010584US	1251	\$130.00	\$5,661.00
10/21	2	90009231	CRAN01-00299	1462	\$400.00	\$5,261.00
10/21	3	90009234	CRAN01-00300	1462	\$400.00	\$4,861.00
10/22	7827	12119957	H0017870-0102 US	8021	\$40.00	\$4,821.00
10/22	8	10693753	2003.07.003.WS0	1251	-\$120.00	\$4,941.00
10/23	10065	77254964	SAMS02-00091	7004	\$150.00	\$4,791.00
10/23	11002	12118930	H0018963-0102 US	8021	\$40.00	\$4,751.00
10/24	8433	12257293	H0020254-0785 US	8021	\$40.00	\$4,711.00
10/24	10813	E-REPLENISHMENT		9203	-\$940.00	\$5,651.00

START	SUM OF	SUM OF	END
BALANCE	CHARGES	REPLENISH	BALANCE
\$7,698.00	\$7,287.00	\$5,240.00	\$5,651.00

[Need Help?](#) | [USPTO Home Page](#) | [Finance Online Shopping Page](#)

DOCKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al
Control No. : 90/009,231
Filed : July 31, 2008
Patent No. : 7,191,915
Issued : March 20, 2007
Title : OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF VENDING MACHINE
Group No. : 3993
Examiner : Peter C. English
Confirmation No. : 8969

Mail Stop Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Petition Under 37 C.F.R. §§1.181 and 1.515(c)(w/Certificate of Service); and
2. A postcard receipt

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Ex Parte Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 16, 2008.

Date: 10/16/08

Kathy Longenecker
Mailing

Date: 10-16-2008

Daniel E. Venglarik
Daniel E. Venglarik
Reg. No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: dvenglarik@munckcarter.com

DOCKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al
Control No. : 90/009,231
Filed : July 31, 2008
Patent No. : 7,191,915
Issued : March 20, 2007
Title : OPTICAL VEND-SENSING SYSTEM FOR
CONTROL OF VENDING MACHINE
Group No. : 3993
Examiner : Peter C. English
Confirmation No. : 8969

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

Sir:

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515(c)

Requester Crane Co. respectfully petitions for reconsideration of the Order Granting/Denying Request for Ex Parte Reexamination mailed September 19, 2008 in the above-identified matter.

The Order denies reexamination on the basis that the primary reference, U.S. Patent No. 6,330,958 to *Ruskin et al*, is not prior art under 35 U.S.C. § 102(e). However, the language of 35 U.S.C. § 102(e) and the provisions of Articles 11(3) and 64(4)(a) of

the Patent Cooperation Treaty, to which the United States is a signatory, requires that the *Rushkin et al* '958 patent be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998, the filing date of PCT Patent Application Serial No. PCT/US98/08064.

The patent for which reexamination was requested claims priority through a series of continuation applications to U.S. Patent Application Serial No. 09/261,221 filed March 3, 1999, which in turn claims priority to U.S. Provisional Patent Application Serial No. 60/083,533 filed April 29, 1998. Accordingly, the earliest priority date to which the subject patent is entitled is April 29, 1998.

The *Rushkin et al* '958 patent (attached as Exhibit B to the Request) issued on U.S. Patent Application Serial No. 09/414,910 filed on October 8, 1999, and claims priority as a continuation-in-part of PCT International Application Serial No. PCT/US98/08064 filed April 15, 1998 (published as WO 98/47799, attached as Exhibit B-1 to the Request), which in turn claims priority as a continuation-in-part of U.S. Patent Application Serial No. 08/844,767 filed April 22, 1997 (attached as Exhibit B-2 to the Request). Accordingly, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within PCT International Application Serial No. PCT/US98/08064, the *Rushkin et al* '958 patent is entitled to an effective date under 35 U.S.C. § 102(e) of April 15, 1998 with respect to that subject matter. Moreover, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within both PCT International Application Serial No. PCT/US98/08064 and U.S. Patent Application Serial No. 08/844,767, the *Rushkin et al* '958 patent is

entitled to an effective date under 35 U.S.C. § 102(e) of April 22, 1997 with respect to that subject matter.

The effective date of an issued U.S. patent under 35 U.S.C. § 102(e) is at least the date on which the underlying application was filed in the U.S. Where the U.S. patent claims priority to one or more earlier provisional application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(III), pages 2100-94 to 2100-95 (8th ed. rev. 7, July 2008). Similarly, where the U.S. patent claims priority as a continuation or continuation-in-part to one or more earlier application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(IV), page 2100-94. Thus, for an issued U.S. patent properly claiming priority to a earlier-filed co-pending application (either directly or through a series of co-pending applications), the effective date of that patent under 35 U.S.C. § 102(e) is earliest date on which an application within the priority claim was filed in the U.S. with a disclosure of the cited subject matter complying with the requirements of 35 U.S.C. § 112, first paragraph.

Although the Patent Office once held that the effective date of an issued U.S. patent also extended to the priority date of an earlier application filed in a foreign country, the Court of Customs and Patent Appeals held that the language “filed in the United States” precluded such prior art effect. *In re Hilmer*, 359 F.2d 859, 883 (CCPA 1966) (prior art reference was entitled to an effective date under 35 U.S.C. § 102(e) only to filing date of application filed in U.S., not to filing date of priority application filed in

Switzerland). However, 35 U.S.C. § 102(e) does not differentiate between types of applications *filed in the U.S.*:

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language . . .

Thus, under the plain language of 35 U.S.C. § 102(e), an international application filed in the U.S. (i.e., with the United States as the Receiving Office) is “an application for patent . . . filed in the United States,” while an international application filed in a foreign Receiving Office is not an application for patent filed in the United States.

In addition, Patent Cooperation Treaty Articles 11(3) and 64(4)(a) require that an international application filed in the U.S. be accorded all benefits – including an effective date under 35 U.S.C. § 102(e) – that are accorded to national applications filed in the U.S. Subject to certain permissive reservations, Article 11(3) requires (note the mandatory “shall” language) that an international application have the same effect as a regular national application:

Article 11

Filing Date and Effects of the International Application

....

(3) Subject to Article 64(4), any international application fulfilling the requirement listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

The reservations to the benefits of filing an international application that are permitted under the PCT are set forth in Article 64(4), of which only Article 64(4)(3) is relevant to the effective date of a U.S. patent claiming priority to an international application:

Article 64

Reservations

....

(4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11(3).

(c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.

Section 4(a) of Article 64(4) is thus addressed to the question of the effective date of 102(e)-type prior art. More specifically, Section 4(a) of Article 64(4) addresses PCT Contracting States with 102(e)-type prior art provisions (“Any State whose national law provides for prior art effect of its patents as from a date before publication”) that extend only to national filing dates, and not to foreign priority filing dates (“but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State”). However, the permissible reservation is limited in effect to international applications filed *in a different Contracting State*: “may declare that the filing *outside that State* of an international application designating that State is not equated to an actual filing in that State for prior

art purposes.” Under this provision, the United States may reserve the right to not accord an international application filed “outside” the United States (i.e., in a different Receiving Office than the United States Receiving Office) section 102(e) effective date based on such “foreign” filing of the international application, but MUST still treat an international application filed in the United States (i.e., filed in the United States Receiving Office) with the same prior art effect as a national application within the United States. For the purposes of section 102(e), therefore, the United States is required to accord the same prior art effect to the US-filed international application as would be accorded to a US-filed national application. It may (and has) made reservations with respect to foreign-filed international applications, but may not also make such reservations with respect to US-filed international applications. An international application filed in the U.S. is “an application for patent by another filed in the United States” under the provisions of 35 U.S.C. § 102(e), just as are provisional applications filed in the United States and (national) utility applications filed in the United States. The provisions of 35 U.S.C. § 102(e) regarding “an international application” relate only to international applications filed outside the United States, not to international applications filed within the United States.

The *Rushkin et al* ‘958 patent claims priority as a continuation-in-part to an international application filed in the United States, as indicated by the serial number: PCT/US98/08064. The application on which the *Rushkin et al* ‘958 patent issued was filed prior to the deadline for entry into the national stage based on that international application, such that the two applications were co-pending. As detailed within the chart and discussion on pages 13-16 of the Request, the subject matter relied upon in the

Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed international application. Accordingly, the subject matter within the *Rushkin et al* '958 patent that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998.

Moreover, the *Rushkin et al* '958 patent claims priority through the international application as a continuation-in-part to a prior national application filed in the U.S. As detailed within the chart and discussion on pages 13-16 of the Request, most of the subject matter relied upon in the Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed national application. Accordingly, such subject matter common to both the *Rushkin et al* '958 patent and the earlier national application that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of April 22, 1997.

Because the *Rushkin et al* '958 patent should be accorded an effective date under 35 U.S.C. § 102(e) that is prior to the earliest priority date to which the subject patent is entitled, reconsideration of the order denying reexamination on the basis of the *Rushkin et al* '958 patent is respectfully requested.

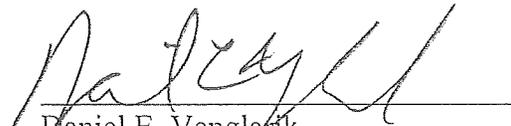
If any issues arise, or if the Examiner has any questions, Requester respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at dvenglarik@munckcarter.com.

The Commissioner is hereby authorized to charge any fees required in connection with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, P.C.

Date: 10-16-2008



Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: dvenglarik@munckcarter.com

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITION UNDER 37
C.F.R. §§1.181 and 1.515(c) was served upon Patent Owner:

Automated Merchandising Systems, Inc.
255 W. Burr Boulevard
Kearneysville, West Virginia 25430

on this 16 day of October, 2008.



Daniel E. Venglarik

Electronic Acknowledgement Receipt

EFS ID:	4214873
Application Number:	90009231
International Application Number:	
Confirmation Number:	8969
Title of Invention:	OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF VENDING MACHINE
First Named Inventor/Applicant Name:	7,191,915
Customer Number:	42624
Filer:	Daniel Venglarik/Keith Woods
Filer Authorized By:	Daniel Venglarik
Attorney Docket Number:	CRAN01-00299
Receipt Date:	31-OCT-2008
Filing Date:	31-JUL-2008
Time Stamp:	15:43:39
Application Type:	Reexam (Third Party)

Payment information:

Submitted with Payment	no
------------------------	----

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Refund Request	RefundRequest.pdf	738949 <small>a80608e1b21f0090a631e6fb518d145818b63794</small>	no	16

Warnings:

Information:

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



10/20/08CKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al

Control No. : 90/009,231

Filed : July 31, 2008

Patent No. : 7,191,915

Issued : March 20, 2007

Title : OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF VENDING MACHINE

Group No. : 3993

Examiner : Peter C. English

Confirmation No. : 8969

DUPLICATE

Mail Stop Ex Parte Reexam
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Petition Under 37 C.F.R. §§1.181 and 1.515(c)(w/Certificate of Service); and
2. A postcard receipt

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Ex Parte Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 16, 2008.

Date: 10/16/08

Rathy Longenecker
 Mailer

Date: 10-16-2008

Daniel E. Venglarik
 Daniel E. Venglarik
 Reg. No. 39,409

P.O. Drawer 800889
 Dallas, Texas 75380
 Phone: (972) 628-3600
 Fax: (972) 628-3616
 E-mail: dvenglarik@munckcarter.com

DOCKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al
Control No. : 90/009,231
Filed : July 31, 2008
Patent No. : 7,191,915
Issued : March 20, 2007
Title : OPTICAL VEND-SENSING SYSTEM FOR
CONTROL OF VENDING MACHINE
Group No. : 3993
Examiner : Peter C. English
Confirmation No. : 8969

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

Sir:

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515(c)

Requester Crane Co. respectfully petitions for reconsideration of the Order Granting/Denying Request for Ex Parte Reexamination mailed September 19, 2008 in the above-identified matter.

The Order denies reexamination on the basis that the primary reference, U.S. Patent No. 6,330,958 to *Ruskin et al*, is not prior art under 35 U.S.C. § 102(e). However, the language of 35 U.S.C. § 102(e) and the provisions of Articles 11(3) and 64(4)(a) of

10/21/2008 JHCDOUGA 00000002 500200 90009231
01 FC:1962 400.00 DA

the Patent Cooperation Treaty, to which the United States is a signatory, requires that the *Rushkin et al* '958 patent be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998, the filing date of PCT Patent Application Serial No. PCT/US98/08064.

The patent for which reexamination was requested claims priority through a series of continuation applications to U.S. Patent Application Serial No. 09/261,221 filed March 3, 1999, which in turn claims priority to U.S. Provisional Patent Application Serial No. 60/083,533 filed April 29, 1998. Accordingly, the earliest priority date to which the subject patent is entitled is April 29, 1998.

The *Rushkin et al* '958 patent (attached as Exhibit B to the Request) issued on U.S. Patent Application Serial No. 09/414,910 filed on October 8, 1999, and claims priority as a continuation-in-part of PCT International Application Serial No. PCT/US98/08064 filed April 15, 1998 (published as WO 98/47799, attached as Exhibit B-1 to the Request), which in turn claims priority as a continuation-in-part of U.S. Patent Application Serial No. 08/844,767 filed April 22, 1997 (attached as Exhibit B-2 to the Request). Accordingly, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within PCT International Application Serial No. PCT/US98/08064, the *Rushkin et al* '958 patent is entitled to an effective date under 35 U.S.C. § 102(e) of April 15, 1998 with respect to that subject matter. Moreover, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within both PCT International Application Serial No. PCT/US98/08064 and U.S. Patent Application Serial No. 08/844,767, the *Rushkin et al* '958 patent is

entitled to an effective date under 35 U.S.C. § 102(e) of April 22, 1997 with respect to that subject matter.

The effective date of an issued U.S. patent under 35 U.S.C. § 102(e) is at least the date on which the underlying application was filed in the U.S. Where the U.S. patent claims priority to one or more earlier provisional application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(III), pages 2100-94 to 2100-95 (8th ed. rev. 7, July 2008). Similarly, where the U.S. patent claims priority as a continuation or continuation-in-part to one or more earlier application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(IV), page 2100-94. Thus, for an issued U.S. patent properly claiming priority to a earlier-filed co-pending application (either directly or through a series of co-pending applications), the effective date of that patent under 35 U.S.C. § 102(e) is earliest date on which an application within the priority claim was filed in the U.S. with a disclosure of the cited subject matter complying with the requirements of 35 U.S.C. § 112, first paragraph.

Although the Patent Office once held that the effective date of an issued U.S. patent also extended to the priority date of an earlier application filed in a foreign country, the Court of Customs and Patent Appeals held that the language “filed in the United States” precluded such prior art effect. *In re Hilmer*, 359 F.2d 859, 883 (CCPA 1966) (prior art reference was entitled to an effective date under 35 U.S.C. § 102(e) only to filing date of application filed in U.S., not to filing date of priority application filed in

Switzerland). However, 35 U.S.C. § 102(e) does not differentiate between types of applications filed in the U.S.:

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language . . .

Thus, under the plain language of 35 U.S.C. § 102(e), an international application filed in the U.S. (i.e., with the United States as the Receiving Office) is “an application for patent . . . filed in the United States,” while an international application filed in a foreign Receiving Office is not an application for patent filed in the United States.

In addition, Patent Cooperation Treaty Articles 11(3) and 64(4)(a) require that an international application filed in the U.S. be accorded all benefits – including an effective date under 35 U.S.C. § 102(e) – that are accorded to national applications filed in the U.S. Subject to certain permissive reservations, Article 11(3) requires (note the mandatory “shall” language) that an international application have the same effect as a regular national application:

Article 11

Filing Date and Effects of the International Application

....

(3) Subject to Article 64(4), any international application fulfilling the requirement listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

The reservations to the benefits of filing an international application that are permitted under the PCT are set forth in Article 64(4), of which only Article 64(4)(3) is relevant to the effective date of a U.S. patent claiming priority to an international application:

Article 64

Reservations

....

(4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11(3).

(c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.

Section 4(a) of Article 64(4) is thus addressed to the question of the effective date of 102(e)-type prior art. More specifically, Section 4(a) of Article 64(4) addresses PCT Contracting States with 102(e)-type prior art provisions (“Any State whose national law provides for prior art effect of its patents as from a date before publication”) that extend only to national filing dates, and not to foreign priority filing dates (“but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State”). However, the permissible reservation is limited in effect to international applications filed *in a different Contracting State*: “may declare that the filing *outside that State* of an international application designating that State is not equated to an actual filing in that State for prior

art purposes.” Under this provision, the United States may reserve the right to not accord an international application filed “outside” the United States (i.e., in a different Receiving Office than the United States Receiving Office) section 102(e) effective date based on such “foreign” filing of the international application, but MUST still treat an international application filed in the United States (i.e., filed in the United States Receiving Office) with the same prior art effect as a national application within the United States. For the purposes of section 102(e), therefore, the United States is required to accord the same prior art effect to the US-filed international application as would be accorded to a US-filed national application. It may (and has) made reservations with respect to foreign-filed international applications, but may not also make such reservations with respect to US-filed international applications. An international application filed in the U.S. is “an application for patent by another filed in the United States” under the provisions of 35 U.S.C. § 102(e), just as are provisional applications filed in the United States and (national) utility applications filed in the United States. The provisions of 35 U.S.C. § 102(e) regarding “an international application” relate only to international applications filed outside the United States, not to international applications filed within the United States.

The *Rushkin et al* ‘958 patent claims priority as a continuation-in-part to an international application filed in the United States, as indicated by the serial number: PCT/US98/08064. The application on which the *Rushkin et al* ‘958 patent issued was filed prior to the deadline for entry into the national stage based on that international application, such that the two applications were co-pending. As detailed within the chart and discussion on pages 13-16 of the Request, the subject matter relied upon in the

Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed international application. Accordingly, the subject matter within the *Rushkin et al* '958 patent that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998.

Moreover, the *Rushkin et al* '958 patent claims priority through the international application as a continuation-in-part to a prior national application filed in the U.S. As detailed within the chart and discussion on pages 13-16 of the Request, most of the subject matter relied upon in the Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed national application. Accordingly, such subject matter common to both the *Rushkin et al* '958 patent and the earlier national application that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of April 22, 1997.

Because the *Rushkin et al* '958 patent should be accorded an effective date under 35 U.S.C. § 102(e) that is prior to the earliest priority date to which the subject patent is entitled, reconsideration of the order denying reexamination on the basis of the *Rushkin et al* '958 patent is respectfully requested.

If any issues arise, or if the Examiner has any questions, Requester respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at dvenglarik@munckcarter.com.

The Commissioner is hereby authorized to charge any fees required in connection with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, P.C.

Date: 10-16-2008


Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: dvenglarik@munckcarter.com

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing PETITION UNDER 37
C.F.R. §§1.181 and 1.515(c) was served upon Patent Owner:

Automated Merchandising Systems, Inc.
255 W. Burr Boulevard
Kearneysville, West Virginia 25430

on this 16 day of October, 2008.



Daniel E. Venglarik



10/20/08

DOCKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al

Control No. : 90/009,231

Filed : July 31, 2008

Patent No. : 7,191,915

Issued : March 20, 2007

Title : OPTICAL VEND-SENSING SYSTEM FOR CONTROL OF VENDING MACHINE

Group No. : 3993

Examiner : Peter C. English

Confirmation No. : 8969

Mail Stop Ex Parte Reexam
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Petition Under 37 C.F.R. §§1.181 and 1.515(c); and
2. A postcard receipt

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Ex Parte Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 15, 2008.

Date: 10/15/08Date: 10-15-2008

Kathy Longenecker
 Mailer

Daniel E. Venglarik
 Daniel E. Venglarik
 Reg. No. 39,409

P.O. Drawer 800889
 Dallas, Texas 75380
 Phone: (972) 628-3600
 Fax: (972) 628-3616
 E-mail: dvenglarik@munckcarter.com

DOCKET NO. CRAN01-00299

REEXAMINATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent issued to : James M. Hair, III et al
Control No. : 90/009,231
Filed : July 31, 2008
Patent No. : 7,191,915
Issued : March 20, 2007
Title : OPTICAL VEND-SENSING SYSTEM FOR
CONTROL OF VENDING MACHINE
Group No. : 3993
Examiner : Peter C. English
Confirmation No. : 8969

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

Sir:

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515(c)

Requester Crane Co. respectfully petitions for reconsideration of the Order Granting/Denying Request for Ex Parte Reexamination mailed September 19, 2008 in the above-identified matter.

The Order denies reexamination on the basis that the primary reference, U.S. Patent No. 6,330,958 to *Ruskin et al*, is not prior art under 35 U.S.C. § 102(e). However, the language of 35 U.S.C. § 102(e) and the provisions of Articles 11(3) and 64(4)(a) of

the Patent Cooperation Treaty, to which the United States is a signatory, requires that the *Rushkin et al* '958 patent be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998, the filing date of PCT Patent Application Serial No. PCT/US98/08064.

The patent for which reexamination was requested claims priority through a series of continuation applications to U.S. Patent Application Serial No. 09/261,221 filed March 3, 1999, which in turn claims priority to U.S. Provisional Patent Application Serial No. 60/083,533 filed April 29, 1998. Accordingly, the earliest priority date to which the subject patent is entitled is April 29, 1998.

The *Rushkin et al* '958 patent (attached as Exhibit B to the Request) issued on U.S. Patent Application Serial No. 09/414,910 filed on October 8, 1999, and claims priority as a continuation-in-part of PCT International Application Serial No. PCT/US98/08064 filed April 15, 1998 (published as WO 98/47799, attached as Exhibit B-1 to the Request), which in turn claims priority as a continuation-in-part of U.S. Patent Application Serial No. 08/844,767 filed April 22, 1997 (attached as Exhibit B-2 to the Request). Accordingly, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within PCT International Application Serial No. PCT/US98/08064, the *Rushkin et al* '958 patent is entitled to an effective date under 35 U.S.C. § 102(e) of April 15, 1998 with respect to that subject matter. Moreover, to the extent that subject matter within the *Rushkin et al* '958 patent is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within both PCT International Application Serial No. PCT/US98/08064 and U.S. Patent Application Serial No. 08/844,767, the *Rushkin et al* '958 patent is

entitled to an effective date under 35 U.S.C. § 102(e) of April 22, 1997 with respect to that subject matter.

The effective date of an issued U.S. patent under 35 U.S.C. § 102(e) is at least the date on which the underlying application was filed in the U.S. Where the U.S. patent claims priority to one or more earlier provisional application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(III), pages 2100-94 to 2100-95 (8th ed. rev. 7, July 2008). Similarly, where the U.S. patent claims priority as a continuation or continuation-in-part to one or more earlier application(s) filed in the U.S., the effective date of the U.S. patent under 35 U.S.C. § 102(e) is the earliest date on which the requirements of 35 U.S.C. § 112, first paragraph were satisfied. See MPEP § 2136.03(IV), page 2100-94. Thus, for an issued U.S. patent properly claiming priority to a earlier-filed co-pending application (either directly or through a series of co-pending applications), the effective date of that patent under 35 U.S.C. § 102(e) is earliest date on which an application within the priority claim was filed in the U.S. with a disclosure of the cited subject matter complying with the requirements of 35 U.S.C. § 112, first paragraph.

Although the Patent Office once held that the effective date of an issued U.S. patent also extended to the priority date of an earlier application filed in a foreign country, the Court of Customs and Patent Appeals held that the language “filed in the United States” precluded such prior art effect. *In re Hilmer*, 359 F.2d 859, 883 (CCPA 1966) (prior art reference was entitled to an effective date under 35 U.S.C. § 102(e) only to filing date of application filed in U.S., not to filing date of priority application filed in

Switzerland). However, 35 U.S.C. § 102(e) does not differentiate between types of applications filed in the U.S.:

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language . . .

Thus, under the plain language of 35 U.S.C. § 102(e), an international application filed in the U.S. (i.e., with the United States as the Receiving Office) is “an application for patent . . . filed in the United States,” while an international application filed in a foreign Receiving Office is not an application for patent filed in the United States.

In addition, Patent Cooperation Treaty Articles 11(3) and 64(4)(a) require that an international application filed in the U.S. be accorded all benefits – including an effective date under 35 U.S.C. § 102(e) – that are accorded to national applications filed in the U.S. Subject to certain permissive reservations, Article 11(3) requires (note the mandatory “shall” language) that an international application have the same effect as a regular national application:

Article 11

Filing Date and Effects of the International Application

....

(3) Subject to Article 64(4), any international application fulfilling the requirement listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

The reservations to the benefits of filing an international application that are permitted under the PCT are set forth in Article 64(4), of which only Article 64(4)(3) is relevant to the effective date of a U.S. patent claiming priority to an international application:

Article 64

Reservations

....

(4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11(3).

(c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.

Section 4(a) of Article 64(4) is thus addressed to the question of the effective date of 102(e)-type prior art. More specifically, Section 4(a) of Article 64(4) addresses PCT Contracting States with 102(e)-type prior art provisions (“Any State whose national law provides for prior art effect of its patents as from a date before publication”) that extend only to national filing dates, and not to foreign priority filing dates (“but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State”). However, the permissible reservation is limited in effect to international applications filed *in a different Contracting State*: “may declare that the filing *outside that State* of an international application designating that State is not equated to an actual filing in that State for prior

art purposes.” Under this provision, the United States may reserve the right to not accord an international application filed “outside” the United States (i.e., in a different Receiving Office than the United States Receiving Office) section 102(e) effective date based on such “foreign” filing of the international application, but MUST still treat an international application filed in the United States (i.e., filed in the United States Receiving Office) with the same prior art effect as a national application within the United States. For the purposes of section 102(e), therefore, the United States is required to accord the same prior art effect to the US-filed international application as would be accorded to a US-filed national application. It may (and has) made reservations with respect to foreign-filed international applications, but may not also make such reservations with respect to US-filed international applications. An international application filed in the U.S. is “an application for patent by another filed in the United States” under the provisions of 35 U.S.C. § 102(e), just as are provisional applications filed in the United States and (national) utility applications filed in the United States. The provisions of 35 U.S.C. § 102(e) regarding “an international application” relate only to international applications filed outside the United States, not to international applications filed within the United States.

The *Rushkin et al* ‘958 patent claims priority as a continuation-in-part to an international application filed in the United States, as indicated by the serial number: PCT/US98/08064. The application on which the *Rushkin et al* ‘958 patent issued was filed prior to the deadline for entry into the national stage based on that international application, such that the two applications were co-pending. As detailed within the chart and discussion on pages 13-16 of the Request, the subject matter relied upon in the

Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed international application. Accordingly, the subject matter within the *Rushkin et al* '958 patent that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of at least April 15, 1998.

Moreover, the *Rushkin et al* '958 patent claims priority through the international application as a continuation-in-part to a prior national application filed in the U.S. As detailed within the chart and discussion on pages 13-16 of the Request, most of the subject matter relied upon in the Request is described and enabled in compliance with 35 U.S.C. § 112, first paragraph within that earlier-filed national application. Accordingly, such subject matter common to both the *Rushkin et al* '958 patent and the earlier national application that is relied upon within the Request should be accorded an effective date under 35 U.S.C. § 102(e) of April 22, 1997.

Because the *Rushkin et al* '958 patent should be accorded an effective date under 35 U.S.C. § 102(e) that is prior to the earliest priority date to which the subject patent is entitled, reconsideration of the order denying reexamination on the basis of the *Rushkin et al* '958 patent is respectfully requested.

If any issues arise, or if the Examiner has any questions, Requester respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at dvenglarik@munckcarter.com.

The Commissioner is hereby authorized to charge any fees required in connection with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, P.C.

Date: 10-15-2008


Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: dvenglarik@munckcarter.com



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,231	07/31/2008	7,191,915	CRAN01-00299	8969

42624 7590 09/19/2008

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/19/2008

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



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Docket Clerk
PO Drawer 800889
Dallas, TX 75380

MAILED

SEP 19 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,231.

PATENT NO. 7,191,915.

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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/009,231	7,191,915	
	Examiner	Art Unit	
	PETER C. ENGLISH	3993	

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

The request for *ex parte* reexamination filed 31 July 2008 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. 50-0208, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

DECISION DENYING *EX PARTE* REEXAMINATION

1. No substantial new question of patentability is raised by the request for *ex parte* reexamination and prior art cited therein for the reasons set forth below.

Effective Filing Date

2. Patent No. 7,191,915, for which reexamination is requested, is a continuation of Application No. 09/729,853 filed on 06 December 2000 (now Patent No. 6,794,634), which is a continuation of Application No. 09/261,221 filed on 03 March 1999 (now Patent No. 6,384,402), which claims priority to Provisional Application No. 60/083,522 filed on 19 April 1998. Parent Application No. 09/729,853 and grandparent Application No. 09/261,221 contain disclosures which are essentially identical to the disclosure of Patent No. 7,191,915, and therefore provide support under 35 USC 112, first paragraph, for the subject matter recited in claims 1-46 of Patent No. 7,191,915. Accordingly, ***claims 1-46 of Patent No. 7,191,915 are entitled to an effective filing date of at least as early as 03 March 1999***, i.e., the filing date of grandparent Application No. 09/261,221. A determination as to whether claims 1-46 of Patent No. 7,191,915 are fully supported by the disclosure of Provisional Application No. 60/083,522 has not been made since such a determination is not necessary for the instant reexamination proceeding.

Critical Reference Date

3. In determining the critical reference date of a potential prior art reference, i.e., the 102(e) date of the reference, it is necessary to determine which version of 35 USC 102(e) applies. The revised version of 35 USC 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, supersedes all previous versions of 35 USC 102(e), with only one important exception. The exception is when the potential reference is based on an international application filed prior to November 29, 2000. Accordingly, references based on international applications that were filed prior to November 29, 2000 are subject to the pre-AIPA version of 35 U.S.C. 102(e). See MPEP 2136. Therefore, when the potential reference is based on an international application filed prior to November 29, 2000, the critical reference date is the

Art Unit: 3993

earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1),(2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application. See MPEP 706.02(f)(1) and 2136.03.

In the instant reexamination proceeding, the third party requester is asserting the Ruskin et al. reference (US 6,330,958) as a prior art patent. The Ruskin et al. reference is a continuation-in-part of International Application No. PCT/US98/08064, which has an international filing date of 15 April 1998. Since International Application No. PCT/US98/08064 was filed prior to November 29, 2000, determination of the critical reference date is governed by the pre-AIPA version of 35 U.S.C. 102(e). Accordingly, no benefit of the international filing date (nor any U.S. filing dates prior to the international application) is given for 35 USC 102(e) prior art purposes since the international application was filed prior to November 29, 2000. Therefore, ***the critical reference date of the Ruskin et al. reference is the actual U.S. filing date under 35 U.S.C. 111(a), i.e., 08 October 1999.*** See Example 9 in MPEP 706.02(f)(1).

Substantial New Questions of Patentability Proposed by Requester

4. The request indicates that the third party requester considers the following substantial new questions of patentability to be raised by the prior art cited in the request:
 - A. The third party requester considers a substantial new question of patentability as to claims 32, 33, 35-41, 43, 45 and 46 of Patent No. 7,191,915 to be raised by Ruskin et al. (US 6,330,958) taken together with Dogul et al. (US 5,218,196) and the Admitted Prior Art¹.
 - B. The third party requester considers a substantial new question of patentability as to claims 1-31, 34, 42 and 44 of Patent No. 7,191,915 to be raised by Ruskin et al. (US 6,330,958) taken together with Dogul et al. (US 5,218,196) and the Admitted Prior Art and further taken together with Barnes (US 4,260,882) or Philipp (US 4,736,097).

¹ The admissions asserted by the third party requester are set forth on pages 10-11 and 16-18 of the request of *ex parte* reexamination. These asserted admissions were made in previous Reexamination Control No. 90/007,450 and during the prosecution history of grandparent Application No. 09/261,221 (Patent No. 6,384,402).

Art Unit: 3993

5. Consideration of Ruskin et al. (US 6,330,958) taken together with Dogul et al. (US 5,218,196) and the Admitted Prior Art does not raise a substantial new question of patentability as to any of the claims 32, 33, 35-41, 43, 45 and 46 of Patent No. 7,191,915 for the following reason:

The Ruskin et al. reference does not qualify as prior art with respect to claims 1-46 of Patent No. 7,191,915 because the critical reference date (i.e., 08 October 1999) of the Ruskin et al. reference is subsequent to the effective filing date (i.e., at least as early as 03 March 1999) of claims 1-46 of the patent. See the explanation in items 2 and 3 above.

6. Consideration of Ruskin et al. (US 6,330,958) taken together with Dogul et al. (US 5,218,196) and the Admitted Prior Art and further taken together with Barnes (US 4,260,882) or Philipp (US 4,736,097) does not raise a substantial new question of patentability as to any of the claims 1-31, 34, 42 and 44 of Patent No. 7,191,915 for the following reason:

The Ruskin et al. reference does not qualify as prior art with respect to claims 1-46 of Patent No. 7,191,915 because the critical reference date (i.e., 08 October 1999) of the Ruskin et al. reference is subsequent to the effective filing date (i.e., at least as early as 03 March 1999) of claims 1-46 of the patent. See the explanation in items 2 and 3 above.

7. The references set forth in the request have been considered both alone and in combination. They fail to raise a substantial new question of patentability as to any one of the claims of Patent No. 7,191,915. Accordingly, the request for *ex parte* reexamination is DENIED.

Information Disclosure Statement

8. The Information Disclosure Statement filed with the request for *ex parte* reexamination has been considered by the examiner. Documents which do not constitute prior art patents or printed publications have been lined through on Form PTO/SB/08.

Remarks

9. 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

Art Unit: 3993

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).

10. 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:

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

Submissions for reexamination proceedings may also be submitted through EFS-Web (the USPTO's web-based document submission system).

11. 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.

12. 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.

Art Unit: 3993

13. 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 571-272-43614361.

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.


Peter C. English 9/17/08
Primary Examiner
Central Reexamination Unit

Conferees: *BKJ*
MCB

pe
17 September 2008

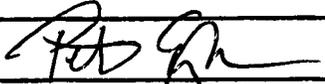
90/009,231

PTO/SB/08B (08-03)
 Approved for use through 07/31/2006. OMB 0651-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Complete if Known			
		Patent Number	7,191,915		
		Issue Date	May 4, 2004		
		First Named Inventor	James M. Hair, III		
		Art Unit			
		Examiner Name			
Sheet	2	of	2	Attorney Docket Number	CRAN01-00299

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	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, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Patent application and drawings as filed in USSN 08/044,767 on April 22, 1997 (Exhibit B-2)	
		Amendment Under 37 C.F.R. 1.111 as filed in USSN 09/261,221 on November 8, 2001 (Exhibit D)	
PE		NAIS Worldwide Matsushita, "High Reliability, Wide Coverage of 7m 22.97ft X 1,260mm 49.606inch HIGH," UZK200 Series, 3 pages, (Exhibit D-1) Copyright 1996.	
		Statement Under 37 C.F.R. 1.510(B)(1) Identifying Substantial New Questions of Patentability Based on Prior Patents and Printed Publications as filed in U.S. Patent No. 6,732,014 on May 27, 2005, 38 pages (Exhibit E)	
PE		SUNX Catalog, 1996, pp. 28-29 (Exhibit D-2)	
		AMS Memorandum in Support of Its Proposed Markman Claim Construction as filed in the United States District Court for the Northern District of West Virginia, Automated Merchandising Systems, Inc. vs. Crane Co., Fawc Engineering Corp., and U-Select It Corp., Civil Action Nos. 3:03CV88/3-04CV07/48/80 (Exhibit F)	

Examiner Signature		Date Considered	9/16/08
--------------------	---	-----------------	---------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.
 This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.