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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/04/2007

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,980.

PATENT NO. 5612524.

ART UNIT 3992.

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

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

Office Action in Ex Parte Reexamination	Control No. 90/007,980	Patent Under Reexamination 5612524	
	Examiner Majid A. Banankhan	Art Unit 3992	

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

- a Responsive to the communication(s) filed on 06 June 2006 and 06 August 2006. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08. | 4. <input type="checkbox"/> _____. |

Part II SUMMARY OF ACTION

- 1a. Claims 1-32 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims 6,7,11-14,17-19 and 25 are patentable and/or confirmed.
4. Claims 1-5,8-10,15,20-24 and 26-32 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____.
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

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DETAILED ACTION

Reexamination

1. This is an *ex parte* reexamination of U.S. Patent No. 6,076,094. Claims 1 – 35 are pending. The references discussed herein are as follows:

Brochure advertising the “Vericode Identification System” (“Vericode Brochure” or “Brochure”)

Patrick Dalton, Technologies for Security Environments, SCAN-TECH '86 Conference (“Dalton Paper” or “Dalton”)

Bryan Cockel, “when bar coding can’t fit the real estate”, Automatic I.D. News, October, 1986 (“Automatic I.D. News Article” or “Article”)

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(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 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.

3. Claims 1 – 5, 8 – 10, 15, 20 – 24, and 26 – 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Vericode Brochure.

4. With respect to claim 1, Vericode Brochure discloses **an identification symbol system for an object, comprising:**

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an identification symbol (page 1, rectangular Vericode symbols shown in various sizes),
comprising:

a substrate associated with the object (page 1, right column, last paragraph, “Vericode achieves ... when laser etched directly on paper, ... And ... products, packaging and labels can ...”);

a computer readable data matrix data field (10x10 matrix of small squares or data cells bordered by 12x12 solid lines of small squares) **formed on said substrate and providing symbol information for uniquely identifying the symbol** (page 1, left hand column, third paragraph, “a technology that gives each and every product its own electronic “finger print” that is so unique ...”); **and**

computer readable orientation means (12x12 solid border surrounding the 10x10 data matrix data field; see patent specification, col. 2, lines 63 – 67, “The internal data field 12 is surrounded by an orientation and/or timing data cell border 16 which is used for timing and symbol orientation. The border is typically formed from “on” data cell where an “on” cell can be a light reflecting or light absorbing spot depending on the application.”; Vericode Brochure discloses a structure that is identical to Patent owner’s disclosed structure), **formed on said substrate and positioned adjacent said field on at least one side, for providing orientation information from a substantially omni-directional three-dimensional orientation of capture** (since Vericode’s structure is identical to Patent Owner’s disclosed structure, it necessarily provides this orientation information); **and**

a device for capturing the symbol, identifying the object from the symbol information (page 2, left hand column, first paragraph, “Since Vericodes originate in a

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computer, it is a relatively simple task for the Vericode system to verify them using existing computer techniques. The same type of technology used in scanning bar codes is applied with the Vericode Identification System.”; see also the drawings of a bar code wand on page 2 and a bar code scanner on page 3).

5. With respect to claim 2, **a symbol as recited in claim 1, wherein said orientation means further comprises a timing border for data capture timing** (page 1, left edge of the Vericode shows an alternating black and white squares; see specification, col. 5, lines 43 – 47, “a symbol as illustrated in FIG. 6 is preferably used, in which ... an internal timing data cell border of alternating ON and OFF timing cells 90.”).

6. With respect to claim 3, **said orientation means surrounds said field** (see Vericode on page 1).

7. With respect to claim 4, see rejection of claim 1 above. The data matrix is a 10x10 square matrix and the disclosed orientation means is a border as shown above.

8. With respect to claim 5, see rejection of claim 1 above. The main difference between this claim and claim 1 is the limitation **border means comprising a width of a known number of data cells**. Vericode symbol disclosed by Vericode Brochure clearly shows a solid border formed with 12 small black squares on each side.

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9. With respect to claim 8, see rejection of claim 5 above.

10. With respect to claim 9, **said timing line is on two sides of said border** (page 1, right vertical edge of the border has a column of five rectangles, each formed by two adjacent cells, of alternating color resulting in a regular timing pattern).

11. With respect to claim 10, **said timing line is a different distance from the border on each side** (the timing line on the left hand side is adjacent to the left border but is several columns apart from the right border, i.e., "a different distance").

12. With respect to claim 15, Vericode Brochure discloses **an identification symbol system for an object, comprising:**

an identification symbol (see rejection of claim 1), **comprising:**

a substrate associated with the object (see rejection of claim 1);

a data matrix data field formed on said substrate and providing symbol information (see rejection of claim 1);

a computer readable orientation border (Vericode shown on page 1 has a 12x12 border), **formed on said substrate and positioned adjacent said field on at least one side** (the border is adjacent to the 10x10 data matrix data field), **and providing orientation information from a substantially omni-directional three-dimensional orientation of capture** (see rejection of claim 1); **and**

a timing cell in said field (see rejection of claim 2); **and**

a device for capturing the symbol, identifying the object from the symbol information (see rejection of claim 1).

14. With respect to claim 20, Vericode Brochure discloses **an apparatus, comprising: means for producing a symbol image of a symbol comprising a rectilinear data matrix data field of information data cells and an orientation border on at least one side of the data field** (page 1, right column, second paragraph, “Vericodes are generated by the Veritec computer”; see patent Figure 4, 42, and col. 4, lines 41 – 43, microcomputer is the only means disclosed); **and**

means for forming the image on a substrate (page 1, right column, second paragraph, “The manufacturer can then apply the Vericode to his products by computer controlled peripheral equipment. This can be any peripheral ... ink-jet printers, laser etchers, laser printers and dot matrix printers.”; see patent Figure 4, 48, and col. 4, lines 44 – 45, printer is the only means disclosed).

15. With respect to claim 21, see rejection of claim 1 above. The **data matrix data field** and the **orientation border** disclosed by Vericode Brochure comprise **individually addressable data cells** of small squares.

16. With respect to claim 22, see rejection of claim 1.

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17. With respect to claim 23, Vericode Brochure discloses **an identification symbol system for an object, comprising:**

an identification symbol (see rejection of claim 1), comprising:

a substrate associated with the object (see claim 1);

a data field formed on said substrate (see claim 1); and

a border, formed on said substrate and adjacent said data field, and indicating an orientation from any direction of image capture, (see claim 1) the border means having first and second sides where each data cell in the border has a same value (Vericode shown has top and bottom edges formed with black cells); and

a device for capturing the symbol, identifying the object from the symbol information (see claim 1).

18. With respect to claim 24, Vericode Brochure discloses **an identification symbol system for an object, comprising:**

an identification symbol (see claim 1), comprising:

a substrate associated with the object (see claim 1);

a data field formed on said substrate (see claim 1); and

a border, formed on said substrate and adjacent said data field, indicating an orientation from any direction of image capture, the border having first and second sides where each data cell in the border has a same value (see claim 1 and claim 23); and

a device for capturing the symbol, identifying the object from the symbol information (see claim 1); and

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wherein said border further comprises third and fourth sides where the cells in the third and fourth sides have alternating values (the Examiner notes that this limitation seems to be in direct conflict with the limitation “each data cell in the border has a same value”; moreover, left and right side borders comprising two columns of cells have cells of alternating values).

19. With respect to claim 26, see rejection of claim 20 above.

20. With respect to claim 27, Vericode Brochure discloses **a decoding process, comprising the steps of:**

(a) scanning (page 2, left hand column, first paragraph, “Since Vericodes originate in a computer, it is a relatively simple task for the Vericode system to verify them using existing computer techniques. The same type of technology used in scanning bar codes is applied with the Vericode Identification System.”; see also the drawings of a bar code wand on page 2 and a bar code scanner on page 3) **a symbol comprising a data field of information data cells and orientation means for indicating an orientation of the field** (see Vericode shown on page 1; see also claim 1);

(b) identifying the location of the data cells (page 1, left col., third paragraph and right col., first paragraph, Vericode system uses a coded pattern to create a unique “finger print” for each item to be tagged. This requires that each cell, which is the basic unit of information of a Vericode pattern, be located and recognized.); **and**

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(c) **decoding the symbol from the located data cells** (page 2, left hand column, first paragraph, "Since Vericodes originate in a computer, it is a relatively simple task for the Vericode system to verify them using existing computer techniques"; verification requires decoding of a Vericode pattern.).

21. With respect to claim 28, **step (b) comprises:**

(b1) determining an orientation of the symbol (this is implicit if not inherent in the Vericode Identification system or any other bar code type scanning system; see also page 3, drawing of a scanner and four items being scanned shows scanned items in specific positions determining the orientation of the symbol attached to it; the Examiner notes that the claim does not specify who or what must perform this step); **and**

(b2) determining a timing of the data cells (this limitation is also implicit if not inherent as the data cells must be sampled or captured according to some timing requirements; the Examiner notes that the claim does not require that the step use the timing information derived from the symbol).

22. With respect to claims 29 and 30, 31, see rejection of claim 1 and other similar claims above.

23. With respect to claim 32, see rejection of claim 1 above. The only substantive difference between this claim and claim 1 is the limitation **wherein said orientation means provides distortion correction information**. As explained above in the rejection of claim 1, Vericode's

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structure that corresponds to the orientation means is identical to Patent Owner's disclosed structure. Therefore, Vericode necessarily provides this information because it contains the same information as Patent owner's disclosed structure that corresponds to the claimed orientation means.

Examiner's Statement of Reasons for Patentability/Confirmation

24. Claims 6, 7, 11 – 14, 17 – 19, and 25 are deemed to be patentable and/or confirmed over the prior art of record for the following reasons:

25. With respect to claims 6 and 7, Brochure discloses Vericode data cells encoded in black and white. Brochure does not teach or suggest data cells encoded using a gray scale or a color scale.

26. With respect to claims 11 and 12, Brochure does not disclose a timing line on three sides of the border.

27. With respect to claims 13 and 14, Brochure does not disclose a timing line that surrounds the border.

28. With respect to claim 16, Brochure does not disclose a timing cell outside the orientation borderr.

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29. With respect to claim 17, Brochure does not disclose an orientation cell outside the orientation border means.

30. With respect to claim 18, Brochure does not disclose an external data field as recited in the claim.

31. With respect to claims 19 and 25, Brochure does not disclose the claimed decoding means for processing the image data. See Response to Arguments section for further discussion of these claims.

Other References Submitted by the Requester

32. Other references submitted by Requester (Dalton and Article) are highly material and relevant because they anticipate at least one of the claims. However, because these references contain substantially the same disclosure based on the same Vericode symbol as Vericode Brochure with respect to the claimed subject matter, additional rejections based on them would be redundant and unnecessary at this time.

Response to Arguments

33. Patent Owner's arguments presented in Patent Owner's Statement filed under 37 CFR 1.530 have been fully considered but they are not persuasive.

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34. Patent Owner argues that a substantial new question of patentability (SNQ) does not exist. The Examiner disagrees. A SNQ is present if the teaching of the prior art patent or printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not at least one claim is patentable. In this case, an examiner has considered the teaching of the prior art submitted by the third party Requester and considered the teaching important enough to issue the order. It is not necessary that a “prima facie” case of unpatentability exist as to the claim in order for a SNQ to be present. See MPEP 2242.I. The importance of the teaching of the submitted prior art is explicitly confirmed by this action.

Claim 1

35. Patent Owner argues that none of the Vericode Brochure, Dalton Paper, or Automatic ID News Article disclose a system including a device that is capable of “capturing a symbol” that includes orientation means “for providing orientation information from a substantially omnidirectional three-dimensional orientation of capture,” and “identifying the object from the symbol information” (Patent Owner’s Statement, page 10). Patent Owner also argues that the Vericode Brochure is not enabling, because it supposedly contains inaccurate information. The basis for these arguments is the Declaration of Robert Sant’Anselmo filed with the Statement.

36. The Declaration states at page 4, item 15, “An important element of certain claims in the ‘524 patent is the concept of reading a symbol from an omnidirectional, three-dimensional orientation of capture. This aspect of the invention was conceived and developed in late 1987 in response to the meeting I had with Fred Schramm of NASA in the fall of 1987.” The

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Declaration further states at page 6, item 22, “Anyone of ordinary skill in the art at the time of the invention attempting to produce a system capable of determining symbol orientation using the description contained in the Vericode Brochure would have failed.” Thus, the Examiner interprets Mr. Sant’Anselmo’s statements in the context of a system with a device that is capable of recognizing a symbol and determining its orientation based on the information extracted from the symbol itself from any angle (omni-directional) in a three-dimensional orientation of capture.

37. Claim 1 is directed to a system that comprises an identification symbol and a device. The identification symbol comprises “computer readable **orientation means, ... for providing orientation information** from a substantially omni-directional three-dimensional orientation of capture”. This portion of the claim is written in a “means plus function” language. As Patent Owner stated (Statement, page 7), the Federal Circuit has held that “[c]onstruction of a means-plus-function limitation involves two steps. The court must identify the claimed function.” After identifying the function, “the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function.” In this case, the recited function is to **provide orientation information** from a substantially omni-directional three-dimensional orientation of capture. A structure disclosed in the specification that corresponds to this function is a border (see patent specification, col. 2, lines 63 – 67). The Vericode symbol shown in the Brochure has the border structure as described in the specification. Vericode’s border provides the orientation information from a substantially omni-directional three-dimensional orientation of capture just as claimed. Patent Owner or anyone else can easily verify this by viewing the

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Vericode symbol on the Brochure from different angles and “capturing” its image. It provides the same type of information as the border shown in Figure 3 of the specification.

38. The claim also recites the limitation “a device for capturing the symbol, identifying the object from the symbol information.” The claimed device is a generic device for capturing the symbol and identifying the object from the symbol information. It is not limited to a specific device for capturing the symbol from a substantially omni-directional three-dimensional orientation of capture and identifying the symbol from the captured information. Simply put, the claim does not require that the device use the omni-directional three-dimensional orientation information provided by the captured symbol to identify an object, as Patent Owner seems to be arguing. In fact, the claim does not even require that the captured symbol be used to identify an object. It merely requires that the object be identified from the symbol information.

39. As discussed above, the Examiner interprets the statements in the Declaration in the context of a system that actually uses the captured omni-directional three-dimensional orientation information to identify an object. This interpretation is further supported by statement 6 where the declarant indicates that rotating symbols (two-dimensional orientation of capture) were read prior to the publication of the prior art documents (the Examiner presumes that the events and activities described in the Declaration are listed in chronological order because all statements containing dates are listed in chronological order). Therefore, declarant’s statements on which Patent Owner relies to support non-anticipation and non-enablement arguments are not applicable to the claims. In fact, Patent Owner’s non-enablement arguments

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are directly contradicted by the specification (specification, col. 7, lines 1 – 2, “FIG. 15 illustrates a symbol 10 that can be read by a vision system as described herein **as well as a bar code reader**”).

40. Patent Owner makes similar arguments for other claims. Because these arguments have been addressed above, they will not be repeated.

Claim 4

41. Patent Owner argues that it is “impossible to determine from the figures of the cited references whether the matrix data field is square and surrounded by a solid black border, or whether the figures of the cited references show an orientation border that includes an internal timing data cell border along one of the sides, resulting in a matrix data field that is rectangular, not square as recited in claim 4.” It may be impossible for Patent Owner to discern that the matrix data field is square in the Vericode figure disclose in the Brochure, but the Examiner had no trouble identifying the 10x10 data matrix square surrounded by a solid border formed with rows and columns of 12 black data cells. Moreover, the Brochure explicitly states that “[a] Vericode may be any size from a six inch **square** to the size of a pinhead.” Likewise, the Examiner had no trouble discerning that the symbol disclosed in the Dalton page (and the Automatic I.D. News article) is the same type of Vericode disclosed in the Brochure, especially since the Dalton paper specifically identifies the symbol as Vericode. As to the internal timing data cell border, this “limitation” is nowhere to be found in the claim. If Patent Owner wishes to add this limitation to claim 4, it can be easily done via amendment.

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Claim 5

42. Patent Owner argues that “[i]t would appear to one of ordinary skill in the art the system would include software capable of knowing the width of a selected symbol without expressly reciting the system as including such software.” The claim requires that the border comprises “a width of a known number of data cells” and the Vericode symbol disclosed in the Brochure has a width of a known number of data cells. The claim does not require that the device “knows” the width of the border.

Claim 8

43. Patent Owner’s argument that “[t]he recited timing line is incapable of being recognized as such by any device disclosed in any of the recited references” is irrelevant as this is not a limiting feature of the claimed device.

44. Patent Owner’s argument that it is impossible to determine from the figure of the cited references whether the data matrix field is immediately adjacent the solid black border, or whether the figures show the timing line of data cells along one of the sides with the data matrix seems frivolous as the Examiner had no trouble discerning 10x10 data matrix (or 9x10 data matrix) and a timing line of 10x1 data cells of alternating color (The Examiner notes that the claim does not preclude the timing line from being inside the data matrix field. Nor does not claim require that the data field be the entire square field within the orientation border.).

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Claim 9

45. Because Patent Owner argues limitations that are not present in the claim (interior or exterior sides), the argument is not persuasive.

Claim 15

46. The timing cell argument has been address above in reference to claim 8

Claim 21

47. Patent Owner's argument that "[t]he symbols in each of the cited references does not indicate that it includes data cells that are "individually addressable" in the data matrix field and the orientation border" seems frivolous, as the Examiner had no trouble discerning from the symbol disclosed in the Brochure that the upper left corner cell in the 10x10 data matrix is a white cell while the thee cells that surround this cell are black cells. This argument is also contradicted by the Declaration. In statement 20, Mr. Sant'Anselmo states that graphic illustrations in Dalton Paper and the Automatic I.D. News Article do not have cells that are individually addressable (this is an incorrect statement because Dalton Paper explicitly shows a Vericode symbol with cells that are individually addressable in Figures 1 and 2). Vericode symbol shown in the Vericode Brochure is conspicuously absent in the statement even though other statements in the Declaration indicate that the declarant has examined and is very familiar with the Brochure. The Examiner interprets this statement as an implicit admission that the declarant considers Vericode symbol shown in the Brochure as having individually addressable cells. The Examiner will withdraw the rejection of this claim if the declarant files a declaration

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stating that Vericode symbols do not have individually addressable data cells, and not a statement to the effect that because of poor quality of printed reproduction, individual cells in a particular reproduction of a Vericode are not readily discernable.

Claim 23

48. It is not clear to the Examiner how the disclosure of “a cell having a magnetic ink property while others may not” leads to Patent Owner’s conclusion that there is no way to discern whether the border shown in the cited references have the same value. The cells that form the border in the Vericode symbol disclosed in the Brochure are all black.

Claim 24

49. While the Examiner will not address any 35 USC 112 issue, the Examiner does not believe that it is improper to point out any inconsistency for the purposes of claim interpretation. As discussed above, the Vericode shown in the Brochure has two columns of cells that form a regular repeating pattern of alternating ON and OFF timing cells. The specification discloses that a timing line is an internal timing data cell border of alternating ON and OFF timing cells.

Claim 32

50. Patent Owner argues that the prior art references do not disclose a symbol providing distortion correction information. The Examiner disagrees. The specification does not specifically disclose what this information is. Therefore, the information must be inherently present in the orientation means. The Vericode contains an identical structure as the Patent

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Owner's disclosed means. Therefore, Vericode's border provides this information as much as Patent Owner's symbol border provides.

Claims 19 and 25

51. The Examiner agrees with Patent Owner that the prior art references do not disclose an apparatus that includes a decoding means "for processing the image data to identify the border, determine orientation and timing information from the border and sample the data cells" as recited in claim 19. The function of the means is to process the image data to identify the border, determine orientation and timing information from the border and sample the data cell. Contrary to Requester's assertion that the specification does not discuss software for instructing the claimed "decoding means" to perform the claimed functions (Request, page 46), the specification does disclose the processing steps (see Figure 5, and col. 15 – 53) and the software that implements the process (col. 5, lines 29 – 33; see Appendix to the application 07/125616 which was incorporated to the specification by reference). The disclosed means is software running in a computer performing processing steps disclosed in the specification at col. 5, lines 15 – 53 and shown in Figure 5.

52. The prior art references submitted by Requester do not disclose software running in a program performing the disclose steps to process the image data to identify the border, determine orientation and timing information from the border and sample the data cells. Nor are these claims obvious over the disclosed computer decoding hardware with admitted prior art algorithms as Requester contends because, while the specification discloses that techniques for

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determining the orientation of a symbol when three corners are known are known graphics techniques (see specification, col. 3, lines 44 – 48), it does not does not disclose that the steps of determining timing information from the border and sampling the data cells were known in the art and prior art references do not disclose these steps.

53. The decoding means of claim 25 does not recite the “timing information” as in claim 19. However, the only means disclosed for sampling the data cells is to poll the data cell area using the timing information obtained from the symbol itself, either by deriving it from the border or from timing cells (see specification, col. 5, lines 36 – 53). Therefore, this limitation is implicit in the claim.

Claims 20 and 26

54. Patent Owner’s argument that “none of the cited references disclose an apparatus includes a means for producing a symbol image of a symbol comprising “an orientation border””, because “[t]he technology for determining the orientation of a symbol did not exist at the time the cited references were publicly available” is inaccurate and frivolous. It is inaccurate because the specification clearly discloses that techniques for determining the orientation of a symbol with three known corners are known in the art (specification, col. 3, lines 44 – 48). It is frivolous because Patent Owner is trying to relate an alleged symbol detection problem with symbol production claims. The Examiner would like Patent Owner’s explanation as to how an existence or non-existence of a certain type of symbol detection device negates a disclosure of an apparatus that produces and prints a two dimensional pattern of squares in black and white.

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55. Patent Owner also contends that “none of the cited art ..., teach of suggest a means for producing a symbol image of a symbol having “a rectilinear data matrix data field of information data cells.”” Vericode Brochure discloses an apparatus that produces Vericode. The Examiner cannot discern any patentable distinction between Verocode’s 10x10 data matrix data field and the claimed data matrix field. Thus, if Vericode’s data field is not “a rectilinear data matrix field ...” as Patent Owner contends, it seems that the disclosed symbol’s data field cannot be the claimed symbol’s rectilinear data matrix field. The Examiner invites Patent Owner to explain the difference between Vericode’s data field and the disclosed symbol’s data field and provide specific support for this limitation from the specification.

Amendment in Reexamination Proceedings

56. Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced. See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Service of Papers

57. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

Extensions of Time

58. 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).

Litigation Reminder

59. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,076,094 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 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.

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.

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.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Art Unit: 3992

All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

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

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand to: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.



Majid A. Banankhan
Primary Examiner
Central Reexamination Unit 3992

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ESK