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95/002,038	07/18/2012	7476988	36563-0002RX1	2965

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EXAMINER
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HEYMAN, JOHN S

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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09/05/2012

PAPER

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

The time period for reply, if any, is set in the attached communication.



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

REEXAMINATION CONTROL NUMBER 95/002,038.

PATENT NUMBER 7476988.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	Control No.	Patent Under Reexamination
	95/002,038	7476988
	Examiner	Art Unit
	JOHN HEYMAN	3992

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

Responsive to the communication(s) filed by:

Patent Owner on \_\_\_\_\_

Third Party(ies) on 16 July, 2012

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

*For Patent Owner's Response:*

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

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

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

**All correspondence** relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

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

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

1.  Notice of References Cited by Examiner, PTO-892
2.  Information Disclosure Citation, PTO/SB/08
3.  \_\_\_\_\_

**PART II. SUMMARY OF ACTION:**

- 1a.  Claims 1-32 are subject to reexamination.
- 1b.  Claims \_\_\_\_\_ are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled.
3.  Claims \_\_\_\_\_ are confirmed. [Unamended patent claims]
4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5.  Claims 1-32 are rejected.
6.  Claims \_\_\_\_\_ are objected to.
7.  The drawings filed on \_\_\_\_\_  are acceptable  are not acceptable.
8.  The drawing correction request filed on \_\_\_\_\_ is:  approved.  disapproved.
9.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
  - been received.  not been received.  been filed in Application/Control No 95002038.
10.  Other \_\_\_\_\_

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## **Inter Partes First Office Action**

### **Preliminary Matters**

This Office Action is taken up in response to a Request filed on 07/16/2012, and an Inter Partes Order herein granting reexamination of Claims 1-32 of US Patent 7,476,988 to Mulhouse et al. (Mulhouse '988), based on US Application Serial No. 11/164,464. Headings employed by Requester will be used where applicable.

### **III. The References**

1. U.S. Patent No. 5,736,795 to Zuehlke (hereinafter "Zuehlke"), attached as Appendix B. Zuehlke was filed April 22, 1996 and issued April 7, 1998, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).
2. U.S. Patent No. 6,657,418 to Atherton (hereinafter "Atherton"), attached as Appendix C. Atherton was filed November 13, 2001 and issued December 2, 2003, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).
3. U.S. Patent No. 5,635,896 to Tinsley (hereinafter "Tinsley"), attached as Appendix D. Tinsley was filed December 27, 1993 and issued June 3, 1997, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).
4. U.S. Patent No. 5,957,374 to Bias et al. (hereinafter "Bias"), attached as Appendix E. Bias was filed March 17, 1998 and issued September 2, 1999, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).
5. U.S. Patent Publication No. 2003/0231001 to Bruning (hereinafter "Bruning"), attached as Appendix F. Bruning was filed June 12, 2002 and

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published December 18, 2003, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).

6. U.S. Patent No. 5,611,484 to Uhrich (hereinafter "Uhrich"), attached as Appendix G. Uhrich was filed December 17, 1993 and issued March 18, 1997, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).

7. U.S. Patent No. 6,356,038 to Bishel (hereinafter "Bishel"), attached as Appendix H. Bishel was filed December 17, 1993 and issued March 18, 1997, and is thus prior art under 35 U.S.C. §§ 102(b) and 102(e).

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 07/16/2012 was filed after the mailing date of the instant Reexam Application on 07/16/2012. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### **The Rejections**

#### ***Claim Rejections - 35 USC § 102***

(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.

Claims 1-6, 9, 10, 13-16, 22, 26, 29, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by **Zuehlke**. These rejections are **adopted** as proposed in the **Request** on pages 13-18, 22-25, 30-31, 33, 35 and 37 which are hereby incorporated herein by reference.

Claims 1-7, 9, 10, 13-18, 22-26 and 29-32 are further rejected under 35 USC 102(b) as being anticipated by **Atherton**. These rejections are **adopted** as

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proposed in the **Request** on pages 41-47, 48, 50-54, 57-61 and 64 which are hereby incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 17, 23, 24, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuehlke in view of Atherton.

Regarding Claim 7, not specifically disclosed by Zuehlke is the use of a relay for a switch. This feature is taught by Atherton, Col. 6, line 51. Thus, it would not be patentable to employ a relay as disclosed by Atherton for the switch 14 in Zuehlke for the reason expressed in the **Request** on page 19. The Examiner **agrees** with this reasoning and incorporates page 19 herein by reference. Thus, Claim 7 is not patentable.

Regarding Claim 17, not specifically disclosed by Zuehlke is a "backup" power source as recited in this claim. The Requester asserts on page 26 that the two capacitors (62 and 64) in Zuelke are shown connected in parallel so that if one fails, the other will act as backup to thus meet this recited feature.

Also, the **Request** points out pages 26-27 that Atherton shows a power stealing system for operating switching mechanisms for a thermostat that has multiple capacitors for providing power, some (e.g., C9) for providing power in

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lieu of, or in addition to, a main storage device. Atherton at Col. 6, lines 43-45 ("Capacitor C1 functions as a filter capacitor and as the voltage reference source to provide power to a control device."); Atherton Col. 3, lines 11-14 ("The capacitor provides the source of voltage utilized by voltage regulator means to develop the regulated dc voltage that is supplied to provide power to the control device."); Atherton Col. 8, lines 7-9 ("Capacitor C9 is a supercapacitor that can keep the control device operating for several hours during a power outage."); Atherton at Col. 8, lines 3-7 ("Capacitors C7 and C8 are output filter capacitors. Resistor R9 in conjunction with diode D9 limit the charging current for Capacitor C9. This allows control device 200 to start operating if capacitor C9 is completely discharged."); Atherton Col. 3, lines 42-45 ("It is necessary to provide power to a control device power source when it is determined that the control device power source has decreased below a predetermined level.").

Atherton discloses an embodiment in which the switch is a relay. Atherton at Col. 6, lines 51-54 ("The control of the application of power to output terminal 56 for application to a load (not shown) is accomplished by a controlled switch, such as relay K1 shown as dashed block 130"); Atherton at Col. 4, lines 35-37 ("It is common for power switch 16 to be a power relay that may be selectively activated by the control device 24.").

A skilled artisan would have been motivated to use the back-up power system of Atherton to supplement the Zuehlke disclosure because doing so would have made the Zuehlke system more reliable, and because Zuehlke and

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Atherton describe very similar thermostat power stealing mechanisms. Thus, Claim 17 is not patentable.

Regarding Claims 23-25, the Examiner **adopts** the reasoning of the **Request** on pages 31-33 thereof in combining Zuehlke and Atherton to show the various features recited by these claims. Thus, pages 31-33 of the **Request** are incorporated herein by reference. Thus, Claims 23-25 are not patentable.

Regarding Claim 31, as discussed above regarding the rejection of Claim 7, Atherton teaches the use of a relay (K1) for a switch. As pointed out in the **Request** on pages 36-37, it would have been obvious to modify the Zuehlke system to include a switch that is a relay as taught by Atherton because it would provide the ability to control a circuit using a low-power signal, and Zuehlke is directed to saving and conserving power. Further, a skilled artisan would have been prompted to incorporate this particular feature from the Atherton disclosure to the Zuehlke system because to do so would be merely a "[c]ombining prior art elements according to known methods to yield predictable results." MPEP § 2143(A). Here, both references describe similar power stealing systems that are used to steal power from a load power source in order to provide power to a controller. Merely implementing a switch in the form of a relay is simply "ordinary," and not sufficient to provide patent protection at the expense of the public. See *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1400 (2007) (stating that "results of ordinary innovation are not the subject of exclusive rights under the patent laws."). Thus, Claim 31 is not patentable.



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Claims 6, 10, 16, 18, 26 and 30 are rejected as unpatentable over Zuehlke in view of Tinsley. See pages 18, 20-21, 25, 27, 33 and 35-36 of the **Request** for details for using rechargeable batteries in a power stealing system, and how and why to combine Tinsley with Zuehlke. The Examiner **adopts** the reasons asserted in the **Request** for combining Tinsley with Zuehlke and incorporates pages 18, 20-21, 25, 27, 33 and 35-36 of the **Request** herein by reference. Thus, Claims 6, 10, 16, 18, 26 and 30 are not patentable.

Claim 8 is rejected under 35 USC 103(a) as unpatentable over Zuehlke in view of Bias. See pages 19-20 of the **Request** for details as to how and why the latching relay taught by Bias is rendered obvious in the system of Zuehlke to thus meet this claim. The Examiner **adopts** the reasons for combining Bias with Zuehlke and incorporates pages 19-20 of the **Request** herein by reference. Thus, Claim 8 is not patentable.

Claims 11, 12, 19, 20, 27 and 28 are rejected under 35 USC 103(a) as unpatentable over Zuehlke in view of Bruning. Not expressly disclosed by Zuehlke are the solar cell and fuel cell features as recited in these claims. Bruning teaches these features as disclosed by the **Request** on pages 21, 22, 27, 28-29 and 34-35. Thus, it would not be patentable to modify the Zuehlke system to include solar or fuel cells as taught by Bruning for the reasons given in the **Request** on the above pages. The Examiner **adopts** the reasons for combining Bruning with Zuehlke and incorporates pages 21, 22, 27, 28-29 and 34-35 of the **Request** herein by reference. Thus, Claims 11, 12, 19, 20, 27 and 28 are not patentable.

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Claim 21 is rejected under 35 USC 103(a) as unpatentable over Zuehlke in view of either Uhrich or Bishel. Not expressly disclosed by Zuehlke is the "microcontroller" for controlling the switching of power to the electrical load as recited in Claim 21. Either Uhrich or Bishel show and disclose this feature as pointed out on pages 29-30 of the Request. It would have been obvious to combine either Uhrich or Bishel with Zuehlke to thus employ a microcontroller for controlling the switching of power in Zuehlke for the reasons expressed in the Request on pages 29-30. The Examiner **adopts** the reasons for combining Uhrich and Bishel with Zuehlke and incorporates pages 29-30 of the **Request** herein by reference. Thus, Claim 21 is not patentable.

Claims 6, 10, 16, 18, 26 and 30 are further rejected under 35 USC 103(a) as unpatentable over Atherton in view of Tinsley. See pages 46, 48-49, 53-54, 54-55, 61 and 63-64 of the Request for details for using rechargeable batteries in a power stealing system, and how and why to combine Tinsley with Atherton. The Examiner **adopts** the reasons asserted in the **Request** for combining Tinsley with Atherton and incorporates pages 46, 48-49, 53-54, 54-55, 61 and 63-64 of the **Request** herein by reference. Thus, Claims 6, 10, 16, 18, 26 and 30 are not patentable.

Claim 8 is further rejected under 35 USC 103(a) as unpatentable over Atherton in view of Bias. See pages 47-48 of the **Request** for details as to how and why the latching relay taught by Bias is rendered obvious in the system of Atherton to thus meet this claim. The Examiner **adopts** the reasons for

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combining Bias with Atherton and incorporates pages 47-48 of the **Request** herein by reference. Thus, Claim 8 is not patentable.

Claims 11, 12, 19, 20, 27 and 28 are further rejected under 35 USC 103(a) as unpatentable over Atherton in view of Bruning. Not expressly disclosed by Atherton are the solar cell and fuel cell features as recited in these claims. Bruning teaches these features as disclosed by the Request on pages 49-50, 55-56 and 61-63. Thus, it would not be patentable to modify the Atherton system to include solar or fuel cells as taught by Bruning for the reasons given in the **Request** on the above pages. The Examiner **adopts** the reasons for combining Bruning with Atherton and incorporates pages 21, 22, 27, 28-29 and 34-35 of the **Request** herein by reference. Thus, Claims 11, 12, 19, 20, 27 and 28 are not patentable.

Claim 21 is further rejected under 35 USC 103(a) as unpatentable over Atherton in view either Uhrich or Bishel. Not expressly disclosed by Atherton is the "microcontroller" for controlling the switching of power to the electrical load as recited in Claim 21. Either Uhrich or Bishel shows and discloses this feature as pointed out on pages 56-57 of the **Request**. It would have been obvious to combine either Uhrich or Bishel with Atherton to thus employ a microcontroller for controlling the switching of power in Atherton for the reasons expressed in the **Request** on pages 56-57. The Examiner **adopts** the reasons for combining Uhrich and Bishel with Atherton and incorporates pages 56-57 of the **Request** herein by reference. Thus, Claim 21 is not patentable.

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### **Conclusion**

Claims 1-32 are not patentable.

### **Submissions**

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

### **Extensions of time**

Extensions of time under 37 CFR 1.136(a) will not be permitted in interpartes reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that interpartes reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in interpartes reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

### **Service of Papers**

Any paper filed with the USPTO, i.e., any submission made, by either the Patent Owner or the Third Party. Requester must be served on every other party

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in the reexamination proceeding, including any other third party requester that is part of the proceeding due to merger of the reexamination proceedings. As proof of service, the party submitting the paper to the Office must attach a Certificate of Service to the paper, which sets forth the name and address of the party served and the method of service. Papers filed without the required Certificate of Service may be denied consideration. 37 CFR 1.903; MPEP 2666.06.

### **Amendments in Reexamination Proceedings**

Any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-G), must be formally presented pursuant to 37CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c). Amendments in an inter partes reexamination proceeding are made in the same manner that amendments in an ex parte reexamination are made. MPEP 2666.01. See MPEP 2250 for guidance as to the manner of making amendments in a reexamination proceeding.

### **Notification of Concurrent Proceedings**

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the patent undergoing reexamination or any related patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

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### Correspondence

All correspondence relating to this interpartes reexamination proceeding should be directed:

By Mail to: Mail Stop Inter Partes Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
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By FAX to: (571) 273-9900  
Central Reexamination Unit

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

Signed:

/John S. Heyman/

Primary Examiner  
Central Reexamination Unit 3992  
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