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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 12/905,469  | 10/15/2010  | SAEED BAGHERI        | END920100105US1      | 8027             |
| 79230   | 7590        | 10/07/2013           | EXAMINER             |                  |
| Law Office of Jim Boice<br>3839 Bee Cave Road<br>Suite 201<br>West Lake Hills, TX 78746 |             |                      | DICKERSON, TIPHANY B |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 3623                 |                  |
|   |             |                      | NOTIFICATION DATE    | DELIVERY MODE    |
|   |             |                      | 10/07/2013           | ELECTRONIC       |

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Jennifer@BoiceIP.com

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>12/905,469 | <b>Applicant(s)</b><br>BAGHERI ET AL. |  |
|                              | <b>Examiner</b><br>TIPHANY DICKERSON | <b>Art Unit</b><br>3623               | <b>AIA (First Inventor to File) Status</b><br>No |

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

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 04/09/2013.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance 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.

**Disposition of Claims**

- 5)  Claim(s) 1-20 is/are pending in the application.  
5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1-20 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

**Application Papers**

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

- a)  All    b)  Some \*    c)  None of the:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 3) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 4) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. The following Non-Final Action is in response to the Appeal Brief filed on 04/09/2013. Claims 1-20 are pending.

2. The present application is being examined under the pre-AIA first to invent provisions.

3. In view of the Appeal Brief filed on 04/09/2013, PROSECUTION IS HEREBY REOPENED. Non-Final Action set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/R. David Rines/

Primary Examiner, Art Unit 3623

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***Claim Rejections - 35 USC § 112***

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

Here, claim 1, directed to a computer method of predicting future profitability of a current project, recites a number of processes that conditionally occur based on determining various conditions. However, the claimed process does not require each and every step to be performed because they are not positively recited in the claim. For example, if the system determines that the linear regression model adequately describes the historical data, an alert is generated and the process stops. None of the remaining process steps are performed thereafter. Examiner notes that the system/product claims have been addressed differently than the method claim because a programmed processor must merely be capable of performing the entirety of the process. In contrast, a method is defined as a series of actions (MPEP 2106 (IV)(A), i.e., "processes...defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). Thus, since methods are defined by actions, the capability of the processor is given

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weight only to the extent that it impacts the manipulative step of checking. See Ex parte PFEIFFER, 135 USPQ 31,33 (Bd. Pat. App. & Int. 1961), noting "recited structural limitations must affect method in manipulative sense and not amount to mere claiming of a use of a particular structure."

Examiner notes that claim 1 is interpreted as requiring all steps for prior art purposes.

#### *Allowable Subject Matter*

5. Claims 1-10 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), 2nd paragraph, set forth in this Office action.
6. Claims 11-20 are allowed.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIPHANY DICKERSON whose telephone number is (571)270-7048. The examiner can normally be reached on M-T 10:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tiphany B. Dickerson/  
Examiner, Art Unit 3623

/R. David Rines/  
Primary Examiner, Art Unit 3623