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INTERNATIONAL BUSINESS MACHINES CORPORATION
Intellectual Property Law Department
T.J. Watson Research Center
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YORKTOWN, NY 10598

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3992

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12/12/2023

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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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,303 .

PATENT UNDER REEXAMINATION 8291243 .

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)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,303	Patent Under Reexamination 8291243	
	Examiner JALATEE WORJLOH	Art Unit 3992	AIA (FITF) Status No

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

The request for *ex parte* reexamination filed 11/21/2023 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.

/JALATEE WORJLOH/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

EX PARTE REEXAMINATION ORDER

Decision on Request

A substantial new question of patentability (SNQ) affecting claims 1, 3-6, 9-11, 15, 16, 18, and 19 of United States Patent Number 8,291,243 to Castelli et al. ('243) is raised by the request for *ex parte* reexamination.

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).

References cited in Request

- U.S. Patent 7,274,975 to Miller ("Miller");
- U.S. Patent No. 7,246,014 to Forth et al. ("Forth");
- U.S. Publication No. 2003/0036820 to Yellepeddy ("Yellepeddy"); and
- U.S. Patent No. 7,177,728 to Gardner ("Gardner").

Other

- Declaration of Scott Andrews

Issue(s) Raised by Request

Issue 1: Miller

The Requester alleges that Miller raises an SNQ with regard to claims 1, 3, 5, 9-11, 15, and 18. Miller has a filing date of June 6, 2005; therefore, it predates the effecting filing date of '243 patent.

Issue 2: Miller in view of Forth

The Requester alleges that Miller in view of Forth raises and SNQ with regard to claims 4, 6, 16, 18, and 19. Forth has an effective filing date of February 7, 2003. Therefore, the references predate the effective filing date of '243 patent.

Issue 3: Yellepeddy either alone or in view of Gardner

The Requester alleges that Yellepeddy either alone or in view of Gardner raises and SNQ with regard to claims 1,3,4, 5, 9-11, 15, 16, 18, and 19. Yellepeddy has filing date of August 16, 2001 and Gardner has an effective filing date of December 30, 2003. Therefore, these references predate the filing date of '243 patent.

Issue 4: Yellepeddy in view with Forth alone or in combination with Forth and Gardner

The Requester alleges that Yellepeddy in view of Forth alone or in combination with Forth and Gardner raises an SNQ with regard to claims 4, 18, and 19. These references predate the filing date of '243 patent.

Background

Claims 1, 3-6, 9-11, 15, 16, 18, and 19 in the instant request for reexamination of the '243 patent issued October 16, 2012 from application no. 12/257,627 ('627 application).

The '218 patent is directed to "methods, articles of manufacture, systems, articles and programmable devices for adapting the power consumption of a computational device in response to environment conditions." The system analyzes "operating environmental condition data relevant to the generation of electric power" to determine a high electric power demand indication. If "a high electric power demand indication, then a computational device automatically reduces an amount of electric power consumption." Abstract.

FIG. 1 below is a flow chart illustrating the method and the system .

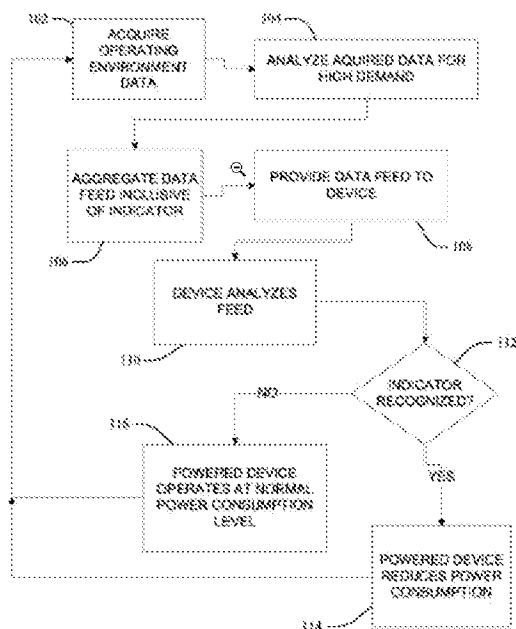


FIG 1

Claim 1 listed below is a representation of the '243 patent claims.

1. A method for adapting the power consumption of a computational device in response to environmental conditions, comprising:

acquiring operating environmental condition data relevant to the generation of electric power in a power grid system from an operating environment feed input; analyzing the operating environmental condition data to determine an indication of a high demand for electric power from the power grid system; and a computational device automatically reducing a current amount of consumption of electric power from the power grid system by the computational device if the analyzing determines the high electric power demand indication.

Original Prosecution

During the original prosecution of the '243 patent a Non-Final rejection was mailed rejecting pending claims under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant filed a response amending the claims to overcome the rejection. A notice of Allowance was issued on June 7, 2012 indicating that the claims were allowed because prior art references do not teach "a device reducing its power consumption based on an indication of high demand for electricity on the power grid."

Scope of Reexamination

On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 3030(a) and 312(a):

The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e. “old art,” does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on the old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

Analysis

Issue 1: Miller

Miller is new art not previously considered by the examiner during the prosecution of the ‘243 patent.

Miller is directed to methods and systems for optimizing the control of energy supply and demand. The reference describes “computational device scheduling the control of energy consumption devices on the basis of variables relating to forecast energy supply and demand.” Abstract. In Miller, an integrated control device manages the supply of energy from various sources (e.g. electric grid) and the demand for energy from consumption devices. Paragraph [0005]. Devices that can be scheduled for flexible turn-on times are scheduled for periods in which cheap energy supply is projected to be available. Paragraph [0006]. Power is provided when electrical grid costs exceed certain thresholds.

One example is shown in figure 10 where element 1001 is originally scheduled for service (e.g. washing the breakfast dishes); however, due to the high cost for that time, service is delayed for a least expensive period. Paragraph [0109]. It is known in the art that prices are higher during periods of high demand. Paragraph [0004]. Hence, it appears that Miller describes “automatically reducing a current amount of consumption of electric power from the power grid

system by the computational device if the analyzing determines the high electric power demand indication,” the feature found to be lacking at the time of allowance by the original examiner.

Further, it is agreed that Miller raises a SNQ that a reasonable examiner would consider these teachings as important in determining the patentability of claims 1, 3, 5, 9-11, 15, and 18.

Issue 2: Miller in view of Forth

Forth is new art not previously considered by the examiner during the prosecution of the ‘243 patent.

Forth is determined to an “Enterprise Energy Management (EEM) software system that displays EEM data and allows a user to interact with the data to better understand and manage their electrical system.” Abstract. The system collects “real-time, near real-time and historical input data from energy data sources,” generates information, and performs analytics to the data. Col. 2, ll. 48-61.

Forth collects and analysis energy related data for managing electrical systems. It is agreed that Miller in view of Forth raises a SNQ that a reasonable examiner would consider these teachings as important in determining the patentability of claims 4, 6, 16, 18, and 19.

Issue 3: Yellepeddy either alone or in view of Gardner

Yellepeddy and Gardner are considered new art not previously considered by the examiner during the prosecution of the ‘243 patent.

Yellepeddy is directed to “methods for optimizing energy consumption and cost.” The system “generate a list of energy consumption options for that particular product at a particular time period and select and implement the most efficient energy supply option.” Abstract. Energy at peak times such as early evening hours could have a higher rate than energy at non-peak hours. Paragraph [0046]. Homeowners can program appliances “to turn on at a time when the cost of energy of a supplier is below a particular threshold price.” Paragraph [0030]. It is known in the art that utilities cost is higher during peak/high demand times.

Gardner is directed to a “system and methods for maintaining power usage within a set allocation.” Abstract. “The invention uses distributed decision making to control the energy consumption of one or more dominant loads in the facility. A power monitor measures the energy usage and transmits a usage status to device controllers supporting the dominant loads in the system. These device controllers determine how much electricity they can allow their loads and maintain usage at or below allocation.” Paragraph [0010].

Yellepeddy uses the best energy supply options during periods of high demand to reduce cost and also schedule usage at low peak hours. Gardner controllers maintain usage below allocation for their loads. Hence, it appears that Yellepeddy in combination with Gardner describes “automatically reducing a current amount of consumption of electric power from the power grid system by the computational device if the analyzing determines the high electric power demand indication,” the feature found to be lacking at the time of allowance by the original examiner.

Further, it is agreed that Yellepeddy in combination with Gardner raises a SNQ that a reasonable examiner would consider these teachings as important in determining the patentability of claims 1,3,4, 5, 9-11, 15, 16, 18, and 19.

Issue 4: Yellepeddy in view with Forth alone or in combination with Forth and Gardner

It is also agreed that Yellepeddy in view of Forth alone or in combination with Forth and Gardner raises a SNQ that a reasonable examiner would consider these teachings as described above important in determining patentability of claims 4, 18, and 19.

35 USC 325(d)

" A review of the post grant history for the underlying patent indicates that there have been no other Office post grant challenges made to the patent (Reexamination Proceedings or *Inter Partes* Review, Post Grant Review, Covered Business Method trials). Accordingly, a discretionary denial of reexamination pursuant to 35 USC 325(d) is not applicable."

Conclusion

Claims 1, 3-6, 9-11, 15, 16, 18, and 19 will be reexamined.

Extension of Time

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 reexaminations 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).

Amendment in Reexamination Proceedings

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).

Service of Papers

After the filing of a request for 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. See 37 CFR 1.550.

Notification of Concurrent Proceedings

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. 8,291,243 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 proceedings throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282, and 2286.

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

By Patent Center:

<https://patentcenter.uspto.gov/>

Art Unit: 3992

By Mail to:

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By Hand:

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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.

/Jalatee Worjloh/
Reexamination Specialist, Art Unit 3992

Conferees:

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