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EXAMINER

NASSER, ROBERT L

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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. 90/015,086.

PATENT UNDER REEXAMINATION 8423322.

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. 90/015,086	Patent Under Reexamination 8423322	
	Examiner ROBERT L NASSER	Art Unit 3992	AIA (FITF) Status No

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

- a. ☐ Responsive to the communication(s) filed on _____.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

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. ☐ Notice of References Cited by Examiner, PTO-892. | 3. ☐ Interview Summary, PTO-474. |
| 2. ☒ Information Disclosure Statement, PTO/SB/08. | 4. ☐ _____. |

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 1-14 are subject to reexamination.
- 1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims 1-14 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)

NON-FINAL REJECTION

This action address claims 1-14 of US patent 8,423,322 to Steinberg et al (the '322 Patent), for which a substantial new question of patentability was deemed to be raised by the Request For Ex Parte Reexamination, which was August 4, 2022.

PRIOR ART APPLIED

US Patent 5,729,474 to Hildebrand et al, filed December 9, 1994 and issued March 17, 1998 (Hildebrand).

US Patent 6,789,739 to Rosen, filed November 4, 2002 and issued September 14, 2004 (Rosen).

US PG PUB 2005/0171645 to Oswald et al, filed November 26, 2004 and published August 4, 2005 (Oswald).

US PG PUB 2006/0111816 to Spalink et al, filed November 9, 2005 and published May 25, 2006 (Spalink).

US PG PUB 2010/0070234 to Steinberg et al, filed September 16, 2008 and published March 18, 2010 (Steinberg '234).

Effective Filing Date¹

The '322 patent is a continuation of US Application 12/211690 (the '690 application), filed September 16, 2008, which claims the benefit of US provisional application 60/994,011 (the provisional application), filed September 17, 2007. On pages 10-13, the Third Party Requester (3PR) alleges that the claims 1-7 lack support in either the parent application or the provisional application, as neither application supports the limitation in claim 1 of comparing an inside temperature recorded inside the first structure with an inside temperature of said first

¹ Under MPEP 2217, the Examiner in reexamination may decide whether the claims are supported by a parent application.

structure recorded at a different time to determine whether the operational efficiency of the HVAC system has decreased over time. Similarly, the request alleges that neither prior application supports the limitation in claims 8-14 of comparing said temperature measurements from said first HVAC system and said second HVAC system and said outside temperature measurements over time to determine the efficiency of the first HVAC system and the second HVAC system.

All references to the '690 application will be made relative to the published application, US PG PUB 2010/0070234.

The Examiner agrees with 3PR that the current claims 1-7 are not supported in the '690 application. The Examiner sees no discussion in the '690 application of comparing an inside temperature at a location to previous inside temperature taken at the same location to determine whether an operational efficiency of the HVAC system has decreased over time. Paragraph [0020] discusses determining an operational efficiency. This section discusses measuring temperature at a first location, i.e. an indoor location, receiving an outdoor temperature measurement, and comparing temperature measurements from the first location, i.e. the indoor measurement, to expected temperature measurements, i.e. which are based on past temperature measurements at the first location and the outdoor temperature measurements. However, this section does not compare the inside temperature to an inside temperature at a different time, but rather an inside temperature to a value related to a previous inside temperature. Further, there is an issue of whether Applicant discloses in the '690 application, sufficient steps or algorithms for calculating the operational efficiency to establish that Applicant was in possession of the claimed invention. See MPEP 2161.01.

In the ITC proceeding, the Patent Owner argued that there was support for this comparison in paragraphs [0063]-[0064]. However, again there is no disclosure in this section of comparing the inside temperature to an inside temperature taken at a different time to determine if the operational efficiency of the HVAC system has decreased over time. For example, in column 9, lines 10-22, the system uses current temperature and other information compared to historical performance to determine the efficiency. However, there is no comparison of the two inside temperatures, as required by the claim.

Also, in paragraphs [0067]-[0070], the '690 application determines whether there is a reduction in efficiency of a HVAC system. However, it does not compare the inside temperature to a previous inside temperature to determine the reduction in efficiency.

The Examiner sees no other support for this claim limitation. As such, claims 1-7 lack support in the '690 application.

The provisional Application does not have the disclosure in column 4 of the '690 application, but otherwise has the same disclosure as the '690 application. Hence, the provisional application also does not support claims 1-7.

As such, claims 1-7 are only entitled to the filing date of the '322 patent, or September 12, 2011.

As to claims 8-14, the Examiner also agrees that the claims are not supported by the '690 application. Claim 8 requires that the system compares a first temperature measurement from a first HVAC control system, a second temperature measurement from a second HVAC control system, and outside temperature measurements. The Examiner does not see support for this claim limitation. While the system gathers temperature measurements from multiple system and outside temperature measurements, the Examiner sees no disclosure of comparing the three

measurements. In paragraph [0067], for example, the system compares the efficiency of one HVAC system to another, but not the temperature measurements.

As the provisional application has the same disclosure as the '690 application, the provisional application also does not support claims 8-14.

As such, claims 8-14 are only entitled to the filing date of the '322 patent, or September 12, 2011.

The effective filing date of the claims is September 12, 2011. Because the effective filing date of the instant application is not on or after March 16, 2013, the AIA First Inventor to File ("AIA-FITF") provisions do not apply to examination of this reexamination application. Rather, the previous first to invent provisions apply.

RELEVANT STATUTES

The following is a quotation of the appropriate paragraphs of pre-AIA 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.

The following is a quotation of pre-AIA 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, 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.

REJECTIONS

The Examiner notes that the declaration of Rajendra Shah has been considered in its entirety.

The rejections below are confined to what has been deemed to be the best available art from the Request. However, prior to conclusion of this reexamination proceeding, claims must be patentable over all prior art cited in the order granting reexamination in order to be considered patentable or confirmed on the reexamination certificate.

REJECTIONS BASED ON HILDEBRAND

Claim(s) 1, 2, 6, and 7 are rejected under pre-AIA 35 U.S.C. 102(b) as being anticipated by Hildebrand.

Claim 1 is rejected as follows:

A system for evaluating changes in the operational efficiency of an HVAC system over time comprising:

Hildebrand teaches a system for evaluating the efficiency of an HVAC system in a home (see column, 2, lines 29-51 and column 7, lines 5-34, for example).

at least one HVAC control system associated with a first structure that receives temperature measurements from at least a first structure conditioned by at least one HVAC system, and receives status of said HVAC system;

Hildebrand shows a system that includes an HVAC control system, energy management apparatus 2, that is associated with a first structure, such as a building (see column 4, lines 46-52). Hildebrand's system receives temperature measurements from a inside the building, via

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inside temperature sensor 20. Furthermore, Hildebrand determines whether heating or cooling is needed based on the temperature difference between an actual temperature and a temperature setpoint (column 5, lines 18-39). Determining whether heating or cooling is needed is determining the status of the HVAC system, i.e. whether the system is keeping the building at the desired temperature.

one or more processors that receive measurements of outside temperatures from at least one source other than said HVAC system and compare said temperature measurements from said first structure, wherein said one or more processors compares the inside temperature of said first structure and the outside temperature over time;

Hildebrand has a processor 4 is system 2 that receives measurements from sensor 22 that measures outside temperature from a source other than the HVAC system. As seen in figure 1, the sensor 18 is not part of system 2, but is external to and connected to system 2. It is clear that the microprocessor receives the temperature readings from sensor 22, Tout from the discussion in columns 6 and 7, as the microprocessor determines efficiency and Tout is used in the efficiency determination.

Furthermore, Hildebrand compares the inside and outside temperatures over time (see column 6, lines 17-40 and column 7, lines 45-55).

and one or more databases that store at least said temperature measurements obtained from said first structure over time,

Hildebrand teaches one or more databases that store the temperature measurements, i.e. memory 10, see also discussion at column 7, lines 45-55).

wherein said one or more processors compares an inside temperature recorded inside the first structure with an inside temperature of said first structure recorded

at a different time to determine whether the operational efficiency of the HVAC system has decreased over time.

Finally, Hildebrand compares the time it takes to change from a temperature T_{start} to the set temperature T_{aim} , to determine an efficiency value (see column 6, lines 18+). The efficiency value is compared to a previous efficiency value to determine whether the efficiency has changed over time (see column 7, lines 15-17, for example).

2. A system as in claim 1 in which said processors receive measurements of outside temperatures for geographic regions such as ZIP codes from sources other than said HVAC control systems.

As to claim 2, Hildebrand receives outside temperature measurements from the geographic region where the building is located. The term "such as zip codes" does not limit the claim.

6. A system as in claim 1 in which said HVAC system measures inside said first structure at only one physical location.

Hildebrand has a single temperature sensor for internal temperature measurements and hence only measures temperature at a single physical location.

7. A system as in claim 1 in which the status of said HVAC system includes whether said system is "on" or "off".

Hildebrand teaches determining whether the system is in heat or cool mode, which would indicate that the system is on (see paragraph [012]). If the system is in neither mode, then the system is off.

Claims 3 and 5 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Hildebrand in view of Rosen.

3. A system as in claim 1 wherein said temperature measurements are obtained from a programmable thermostat that communicates using a network.

Hildebrand does not have a programmable thermostat that communicates with a network. As Hildebrand allows the user to set the desired temperature, it is likely programmable. However, Rosen teaches that programmable thermostat is well known (see column 6, lines 62+). As such, it would have been obvious to modify Hildebrand to use a programmable thermostat, as it is merely the use of a known thermostat in the art. The Examiner notes that figure 1 of Hildebrand shows a network, i.e. an interconnection of electronic elements that communicate.

5. A system as in claim 1 in which said HVAC system includes a programmable thermostat and said programmable thermostat is the sole source for current data regarding temperature inside said first structure conditioned by said HVAC system.

Hildebrand does not have a programmable thermostat that communicates with a network. As Hildebrand allows the user to set the desired temperature, it is likely programmable. However, Rosen teaches that programmable thermostat is well known (see column 6, lines 62+). As such, it would have been obvious to modify Hildebrand to use a programmable thermostat, as it is merely the use of a known thermostat in the art. The Examiner notes that figure 1 of Hildebrand shows a single temperature sensor. Hence, the programmable thermostat is the sole source of current data regarding the building.

Claim 4 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Hildebrand in view of Oswald.

4. A system as in claim 1 in which said processors communicate with said HVAC system using a network that includes an electricity meter.

Hildebrand does not have a network containing an electricity meter. However, Oswald shows a HVAC system or managing energy consumption in a house, that monitor both the

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electrical and HVAC system to provide an analysis of the whole house energy usage profile (see paragraphs [0050]+). As such, it would have been obvious to modify Hildebrand to include an electricity meter, to provide a more thorough picture of the home efficiency.

REJECTIONS BASED ON SPALINK

Claim(s) 8, 9, and 14 are rejected under pre-AIA 35 U.S.C. 102(b) as being anticipated by Spalink.

8. A system for detecting and correcting for anomalous behavior in HVAC control systems comprising:

In figure 2, Spalink shows an HVAC control system for several homes/buildings. In paragraph [0076], Spalink teaches that the system uses reference data to compare the efficiencies of the buildings to reveal a systemic problem in the building. Hence, Spalink detects anomalous behavior. Spalink teaches then adjusting parameters to correct the behavior (see paragraph [0076]).

a first HVAC control system that receives temperature measurements from at least a first structure conditioned by at least one HVAC system, and receives status of said HVAC system;

In figure 2, Spalink shows a first HVAC control system in figures 2 and 3, including a local data processor 200 or 300 and a central data processor 205 or 305 that receives temperature measurements from sensors 215 (see paragraphs [0030]-[0031]). The control system further receives the status of the system (see paragraph [0080]).

at least a second HVAC control system that obtains temperature measurements from at least a second structure conditioned by a second HVAC system, and status of said second HVAC system;

The system of Spalink includes multiple buildings with multiple HVAC systems (shown in figures 2 and 3 including a local data processor 200 or 300 and a central data processor 205 or 305, which operates the same as the first system discussed above.

one or more processors that receive measurements of outside temperatures from at least one source other than said first and second HVAC systems

Spalink teaches that the control system includes one or more processors that receives outside temperature measurements from sensors located outside of the building (see paragraph [0030]-[0031]). The sensors are not part of the control system but are inputs to the control system.

and compare said temperature measurements from said first HVAC system and said second HVAC system and said outside temperature measurements over time to determine the relative efficiency of the first HVAC system and the second HVAC system;

Spalink teaches that there is a central analyzing module 132 which compares reference data from one building with reference data from another building (see paragraph [0057]). As discussed above, the reference data includes inside and outside temperatures. Additionally, in paragraph [0076], Spalink teaches that the data from one building is compared with the data from another building to determine if the building is operating efficiently, i.e. determines the relative efficiency of the building. The data compared includes inside and outside temperatures from both buildings. As noted in paragraph [0073], the data is evaluated over time.

and one or more databases that store said temperature measurements from said first and second HVAC systems.

Spalink teaches that the reference data is stored (see paragraph [0031]). As such, the stored data is a database. Further, the data is stored as aggregated data in data store 156.

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9. A system as in claim 8 in which said processors receive said outside temperature measurements for geographic regions such as ZIP codes from sources other than said HVAC control systems.

As to claim 9, Spalink receives outside temperature measurements from the geographic region where the building is located. The term "such as zip codes" does not limit the claim.

14. A system as in claim 8 in which the status of said first HVAC system includes whether said first HVAC system is "on" or "off".

As to claim 14, the control system of Spalink discusses in paragraphs [0080]-[0082] that the control system receives information as to the state of the HVAC system. One of ordinary skill would have understood that such information includes on/off information.

Claims 10, 12, and 13 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Spalink in view of Rosen.

10. A system as in claim 8 wherein said temperature measurements are obtained from a programmable thermostat that communicates with said first HVAC control system using a network.

Spalink does not have a programmable thermostat that communicates with a network. However, Rosen teaches that programmable thermostat is well known (see column 6, lines 62+). As such, it would have been obvious to modify Spalink to use a programmable thermostat, as it is merely the use of a known thermostat in the art. The Examiner notes that figure 2 of Spalink shows a network, i.e. an interconnection of electronic elements that communicate.

12. A system as in claim 8 in which said first HVAC system includes a programmable thermostat and said programmable thermostat is the sole source for current data regarding temperature inside said location conditioned by said first HVAC system.

Spalink does not have a programmable thermostat that communicates with a network. However, Rosen teaches that programmable thermostat is well known (see column 6, lines 62+). As such, it would have been obvious to modify Spalink to use a programmable thermostat, as it is merely the use of a known thermostat in the art. Spalink shows 3 sensors 215 but also states in paragraph [0062] that other configurations are possible. Rosen shows a single thermostat for a structure. As noted in the Shah declaration in paragraph 306, it was common in single family homes to use a single temperature sensor. As such, it would have been obvious to modify Spalink to use a single temperature sensor, as it is merely the substitution of a known configuration of sensors for another.

13. A system as in claim 8 in which said first HVAC system measures inside said first location at only one physical location.

Spalink shows 3 sensors 215 but also states in paragraph [0062] that other configurations are possible. Rosen shows a single thermostat for a structure. As noted in the Shah declaration in paragraph 306, it was common in single family homes to use a single temperature sensor. As such, it would have been obvious to modify Spalink to use a single temperature sensor, as it is merely the substitution of a known configuration of sensors for another.

Claim 11 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Spalink in view of Oswald.

11. A system as in claim 8 in which said processors communicate with said first HVAC system using a network that includes an electricity meter.

Spalink does not have a network containing an electricity meter. However, Oswald shows a HVAC system or managing energy consumption in a house, that monitor both the electrical and HVAC system to provide an analysis of the whole house energy usage profile (see paragraphs [0050]+). As such, it would have been obvious to modify Spalink to include an electricity meter, to provide a more thorough picture of the home efficiency.

REJECTIONS BASED ON STEINBERG '234

Claim(s) 1-14 are rejected under pre-AIA 35 U.S.C. 102(b) as being unpatentable over Steinberg '234 in view of Hildebrand.

Claim 1 is rejected as follows:

A system for evaluating changes in the operational efficiency of an HVAC system over time comprising:

Steinberg '234 shows a HVAC that evaluates operational efficiency and its changes over time (see for example, paragraph [0063])

at least one HVAC control system associated with a first structure that receives temperature measurements from at least a first structure conditioned by at least one HVAC system, and receives status of said HVAC system;

As shows in figure 2, and discussed throughout, Steinberg '234 shows a control system that receives temperature measurements from a first structure via thermostat 108, which sends temperature information to the server 106 (see also paragraph [0057]). Furthermore, the system receives status information about the HVAC system such as cycle times (see paragraph [0057], for example).

one or more processors that receive measurements of outside temperatures from at least one source other than said HVAC system and compare said temperature measurements from said first structure, wherein said one or more processors compares the inside temperature of said first structure and the outside temperature over time;

Steinberg '234 teaches one or more processors that receive outside temperature measurements from outside of the HVAC system (see paragraph [0019] and [0059]-[0062], for example. Steinberg further compares the inside temperature and the outside temperature over time (see figures 6-8 and the associated discussion).

and one or more databases that store at least said temperature measurements obtained from said first structure over time,

Steinberg '234 stores the temperature measurements over time (see figures 6-8). Hence, it has a database.

wherein said one or more processors compares an inside temperature recorded inside the first structure with an inside temperature of said first structure recorded at a different time to determine whether the operational efficiency of the HVAC system has decreased over time.

Steinberg '234, as discussed above, does not determine whether the operational efficiency has change by comparing the two inside temperatures, as claimed. It does, however,

mention determining the efficiency. Hildebrand compares the time it takes to change from a temperature T_{start} to the set temperature T_{aim} , to determine an efficiency value (see column 6, lines 18+). The efficiency value is compared to a previous efficiency value to determine whether the efficiency has changed over time (see column 7, lines 15-17, for example). As such, it would have been obvious to modify Steinberg '234 to use the efficiency evaluation technique of Hildebrand, to provide a better picture of the overall state of the HVAC system.

2. A system as in claim 1 in which said processors receive measurements of outside temperatures for geographic regions such as ZIP codes from sources other than said HVAC control systems.

As to claim 2, Steinberg '234 teaches this element in paragraph [0023].

3. A system as in claim 1 wherein said temperature measurements are obtained from a programmable thermostat that communicates using a network.

Steinberg '234 teaches this element in paragraphs [0053] and [0056], for example

4. A system as in claim 1 in which said processors communicate with said HVAC system using a network that includes an electricity meter.

Steinberg '234 teaches using an electricity meter in figure 2 and claim 7, for example.

5. A system as in claim 1 in which said HVAC system includes a programmable thermostat and said programmable thermostat is the sole source for current data regarding temperature inside said first structure conditioned by said HVAC system.

Steinberg '234 teaches this element in paragraphs [0056], for example, where the thermostat is the only sensor in the structure (see figure 2).

6. A system as in claim 1 in which said HVAC system measures inside said first structure at only one physical location.

Steinberg '234 teaches this element in paragraphs [0056], for example, where the thermostat is the only sensor in the structure (see figure 2).

7. A system as in claim 1 in which the status of said HVAC system includes whether said system is "on" or "off".

Steinberg '234 teaches this element in paragraph [0020], for example

8. A system for detecting and correcting for anomalous behavior in HVAC control systems comprising:

Steinberg '234 detects anomalous behavior in a HVAC control; system (see paragraphs [0063]-[0065], for example).

a first HVAC control system that receives temperature measurements from at least a first structure conditioned by at least one HVAC system, and receives status of said HVAC system;

As shows in figure 2, and discussed throughout, Steinberg '234 shows a control system that receives temperature measurements from a first structure via thermostat 108, which sends temperature information to the server 106 (see also paragraph [0057]). Furthermore, the system receives status information about the HVAC system such as cycle times (see paragraph [0057], for example).

at least a second HVAC control system that obtains temperature measurements from at least a second structure conditioned by a second HVAC system, and status of said second HVAC system;

Steinberg '234 shows multiple structures that provide temperature measurements to the control system in figure 2,

one or more processors that receive measurements of outside temperatures from at least one source other than said first and second HVAC systems

Steinberg '234 teaches one or more processors that receive outside temperature measurements from outside of the HVAC system (see paragraph [0019] and [0059]-[0062], for example.

and compare said temperature measurements from said first HVAC system and said second HVAC system and said outside temperature measurements over time to determine the relative efficiency of the first HVAC system and the second HVAC system;

Steinberg does compare temperature measurements from the first and second system over time as part of an efficiency determination (see paragraph [0067]). It does not use outside temperature measurements over time to determine efficiency. However, Hildebrand determines efficiency of a structure using inside temperature measurements correlated to exterior temperature over time (see column 2, lines 29-51 and columns 6 and 7). A change in efficiency is only determined by comparing efficiencies at the same exterior temperature. As such, it would have been obvious to modify Steinberg '234 to correlate efficiency to outside temperature over time, like in Hildebrand, to provide a more accurate picture of the overall efficiency of the system.

and one or more databases that store said temperature measurements from said first and second HVAC systems.

Steinberg '234 stores the temperature measurements over time (see figures 6-8). Hence, it has a database.

9. A system as in claim 8 in which said processors receive said outside temperature measurements for geographic regions such as ZIP codes from sources other than said HVAC control systems.

As to claim 9, Steinberg '234 teaches this element in paragraph [0023].

10. A system as in claim 8 wherein said temperature measurements are obtained from a programmable thermostat that communicates with said first HVAC control system using a network.

Steinberg '234 teaches this element in paragraphs [0053] and [0056], for example.

11. A system as in claim 8 in which said processors communicate with said first HVAC system using a network that includes an electricity meter.

Steinberg '234 teaches using an electricity meter in figure 2 and claim 7, for example.

12. A system as in claim 8 in which said first HVAC system includes a programmable thermostat and said programmable thermostat is the sole source for current data regarding temperature inside said location conditioned by said first HVAC system.

Steinberg '234 teaches this element in paragraphs [0056], for example, where the thermostat is the only sensor in the structure (see figure 2).

13. A system as in claim 8 in which said first HVAC system measures inside said first location at only one physical location.

Steinberg '234 teaches this element in paragraphs [0056], for example, where the thermostat is the only sensor in the structure (see figure 2).

14. A system as in claim 8 in which the status of said first HVAC system includes whether said first HVAC system is "on" or "off".

Steinberg '234 teaches this element in paragraph [0020], for example

CONCLUSION

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).

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.

EXTENSIONS 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 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

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 8,423,322 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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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
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