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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,255	03/12/1999	RICHARD PAUL RICHMAN	096828/24	6780

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EXAMINER	
KYLE, CHARLES R	
ART UNIT	PAPER NUMBER
2164	9

DATE MAILED: 03/13/2002

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

RCAMC EXHIBIT 2005

NM

Office Action Summary	Application No.	Applicant(s)	
	09/267,255	RICHMAN ET AL.	
	Examiner	Art Unit	
	Charles Kyle	2164	

-- 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) 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 the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- 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 *26 December 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ 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

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ 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).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

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

a)☐ All b)☐ Some * c)☐ None of:

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.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> 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.

The 35 USC Section 112 rejections set forth in the prior Official Action are withdrawn based on Applicant's amendment.

Claims 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase "wherein the present benefit is a benefit that is realized in the future". This is illogical; a present benefit cannot be realized in the future as well as in the present.

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 negatived by the manner in which the invention was made.

Claims 1-4, 6-8 and 11-13 are rejected under 35 U.S.C. 102(e) as being unpatentable over Golden in view of Mirer.

Concerning Claim 1, Golden discloses the invention substantially as claimed, including in a method of providing present value to a beneficiary based on future retirement payments, the steps of:

a. designating an account in a depository for a beneficiary to receive future retirement payments payable to said beneficiary from a source of said retirement payments for a preselected period of time (Col.8, lines 15-18);

b. designating a benefit provider for providing a present benefit to said beneficiary (Col. 7, lines 2–9);

c. authorizing said depository to periodically disburse a predetermined portion of said retirement payments deposited in said account to said benefit provider during said preselected period of time (Col. 6, lines 62-67);

d. providing said present benefit to said beneficiary from said benefit provider based at least in part on present value of a designated portion of said retirement payments (Col. 7, lines 10-24);

e. causing said retirement payments to be deposited into said account throughout said preselected period of time (Col. 1, lines 24-44); and

f. causing said depository to transfer a portion of said retirement payments to said benefit provider during said preselected period of time (Col. 4, line 12 to Col. 5, line 55).

Applicant has amended Claim 1 to recite that retirement payments are future retirement payments. In the treatment of Claim 15 set forth in the prior office

action, the Examiner specifically cited an article discussing Social Security as support for rejection of that Claim. It appears that Applicant argues that Social Security is not disclosed as specifically providing future payments. Mirer specifically discloses Social Security as comprising future benefits and equates it to an annuity. See particularly Page 2, fifth through eighth full paragraphs. Golden does not specifically disclose that Social Security benefits are equivalent to the annuity payments he describes at Col. 6, lines 60-67. Mirer does indeed discloses that Social Security payments are equivalent to annuity payments at the above cited text. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included Social Security benefits disclosed by Mirer as a way to fund the invention of Golden because they are analogous to annuity payments and would have been a readily available and reliable source of payments to the benefit provider. It would further have been obvious to have utilized a "holding account" for future benefit payments transfer to a benefits provider because this would have allowed both client and benefits provider access to the account for money transfer and audit purposes.

As to Claim 2, Golden further disclose the steps of determining if said preselected period of time has expired, and if said preselected period of time has not expired, repeating steps a and f, and if said preselected period of time has expired, making said retirement payments available for the exclusive use of said beneficiary at Col. 11, lines 34-54 and Fig 2d and Fig. 2a "period certain".

Regarding Claim 3, Golden discloses the invention substantially as claimed. See the discussion of Claim 1 above. Golden does not specifically disclose the renewal of the method after the preselected time expires as recited in Claim 3. Golden suggests such a renewal at Col. 3, lines 3-19. Golden discloses the need for a person to select a time certain period, a first contract period, during which the person is sure of needing benefits and a renewal as a second period, if the person needs continuing benefits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided renewal such as disclosed by Golden because this would have allowed beneficiaries to realize benefits during a time certain period when they were actuarially confident of needing benefits while also providing benefits for later periods when they were less confident of such need.

As to Claim 4, see the discussion of Claim 1 above and it would further have been obvious to have paid the benefit provider for benefits unreimbursed by retirement payments and then allowed the payments to revert to the beneficiary in premature termination because this arrangement would have avoided ujust enrichment by either party.

Concerning Claim 6, Golden discloses a monetary payment as present benefit from the Life Contingent Annuity at Col. 7, line 54 to Col. 8, line 7.

With respect to Claim 7, Golden discloses the GIRO as a non-monetary asset distributed as a present benefit.

As to Claim 8, see the discussion of Claim 1 above and it would further have been obvious to have liquidated assets so as to have paid the benefit provider for

benefits unreimbursed by retirement payments and then allowed the payments to revert to the beneficiary in premature termination because this arrangement would have avoided unjust enrichment by either party.

Regarding Claim 11, it is the system form of Claim 1 discussed above and is rejected in a like manner.

Regarding Claims 12 and 13, see the discussion of Claims 6 and 7 above.

Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden and Mirer in view of the Dictionary of Finance and Investment Terms, hereinafter Dictionary.

Regarding Claim 5, Golden discloses the invention substantially as claimed. See the discussion of Claim 1 above. Golden does not specifically disclose the use of insurance on the life of a party. Dictionary discloses life insurance as a means to pay beneficiaries on the death of an insured. It would have been obvious to one of ordinary skill in the art at the time of the invention to have obtained life insurance on the life of a beneficiary who might not have survived to preselected period of time, because this would have compensated the benefit provider for "lost business".

Concerning Claim 19, see the discussion of Claims 1 and 5 above.

Claims 9-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden and Mirer in view of the Gross et al.

Regarding Claim 9, Golden discloses the invention substantially as claimed. See the discussion of Claim 1 above. Golden does not specifically disclose the present benefit as a service. Ross et al disclose, in a system for releasing the value of an asset analogous to Applicants' and Golden's, the provision of a service, nursing home care, at Col. 11, lines 28-36. See also Col. 11, line 12 to Col. 12, line 42 and Summary of the Invention.

As to Claim 10, see the discussion of Claims 4 and 8 above and it would further have been obvious to have suspended service to the beneficiary because this would have avoided provision of unreimbursed service to and unjust enrichment by the beneficiary.

Regarding Claim 14, see the discussion of Claims 1 and 9 above.

Claims 15-18 and 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view Mirer.

Regarding Claim 15, see the discussion of Claims 1 above.

As to Claims 16-17, see the discussions of Claims 2-3 and 15 above.

Regarding Claim 18, see the discussions of Claims 1 and 10 above.

As to Claims 20 and 21, see the discussions of Claims 15 and 6 and 7 above.

Regarding Claim 22, see the discussions of Claims 15 and 8 above.

Regarding Claim 23, see the discussions of Claims 15 and 9 above.

Concerning Claim 24, see the discussions of Claims 15 and 10 above.

Concerning Claims 25-28, see the discussions of Claims 11-14 set forth above.

With respect to Claims 29-32, see the discussion of Claims 1, 11, 15 and 25 and note that the realization of a current benefit is based on future retirements payments as disclosed by a combination of Golden and Mirer.

Response to Arguments

Applicant's arguments filed December 26, 2001 have been fully considered but they are not persuasive.

Applicant begins Reply at page 6 with a description of the invention. Applicant remarks that the invention enables conversion of future payments into current available financial resources without violating current legislated proscriptions. The Examiner observes that no feature recited in the claims reflects this element and it cannot, therefore, confer patentable distinction.

Applicant continues with a description of the invention at page 7 to mid-page 8 where substantive arguments begin. Specifically, Applicant argues that the art cited in rejections of the prior office action do not teach the newly claimed feature of conversion of future retirement payments into current value. The Examiner notes that the rejection of claims 15 and 25 in the prior office action discussed applicability of Social Security, which is known to provide future retirement payments. From the prior office action, pages 6-7:

> *Bulletin discloses that Social Security payments are periodic payments at bracketed text. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included Social Security benefits disclosed by Bulletin as a way to fund the invention of Golden because they are analogous to annuity payments and would have been a readily available and reliable source of payments to the benefit provider.*

Additionally, to support the Examiner's argument that Social Security provides future benefits, Mirer has been cited in the treatment of the amended claims above. See the discussion of Claim 1 above.

Further, the Examiner notes that Applicant did not argue that Golden was inapplicable to the claimed invention; rather the argument was made that Golden disclosed an annuity which used a contribution of a current asset. Mirer clearly shows that Social Security, which provides future benefit, is equivalent to an annuity; it would therefore be applicable. Specifically, Mirer discloses at page 2, fifth full paragraph that:

> *The benefits received from Social Security are like the benefits from an annuity, and we therefore use the terms interchangeably.*

For these reasons, Claims 1, 11, 21 and 25 stand rejected.

At page 10, Applicant sets forth arguments regarding claims 2, 6 and 7. Applicant asserts that Golden does not permit the repetition of steps e and f of claim 1, but does not state why this is so. Applicant asserts that Golden is not concerned with depositing future retirement benefits, which benefits are a newly claimed feature discussed in the treatment of claim 1 above with respect to Mirer.

Applicant, at paragraph 2, page 11 disagrees with the Examiners contention regarding monetary and non-monetary benefits as disclosed by Golden but does not explain why the Examiner's contention is wrong.

In Applicant's discussion of Claim 3, page 12, paragraph 3, he asserts that renewal is not suggested in the first to second transition of Golden. The Examiner provided motivation for such renewal at page 4 of the prior office action and Applicant has provided no substantive rebuttal of the Examiner's motivation to modify Golden with such a renewal feature.

As to Applicant's discussion of Claims 4 and 8, Golden modified by Mirer does indeed look to future benefits to fund an annuity. For this reason there might well be unreimbursed benefits for which a prudent benefit provider would seek repayment in the event of a premature termination of the program.

Applicant's reasoning regarding Claims 5 and 19 follow a similar line as those of claims 4 and 8. The Examiner observes that his argument regarding reimbursement for "lost business" through life insurance on the client is unrebutted. See page 5 of the prior office action. Applicant's substantive argument is that Golden does not look to future benefits to fund an annuity. The Examiner observes that the combination of

Golden and Mirer, as discussed above does look to future benefits, and that a prudent benefit provider would insure the life of a client so as to maintain profitability, if realized future benefits were not as expected due to a client's death.

At page 14, Applicant begins discussion of claims 9, 10 and 14. At the beginning of page 16, Applicant begins substantive argument of the Gross reference and asserts that Gross is not concerned with converting future retirement payments into current value as newly claimed. The combination of Golden and Mirer discussed above does address such future payments, as set forth in the discussion of claim 1 above, and the Examiner maintains essentially the same reasoning as that set forth for the rejection of claims 9, 10 and 14 as set forth in the prior office action and restated above.

The nexus of all of Applicant's arguments is that Golden alone does not concern itself with converting future retirement payments into current value. This feature is addressed in the rejection of the amended claims set forth above with respect to Golden and Mirer.

Applicants arguments regarding Claims 15-18 and 20-28 follow the same lines as those set forth above and are viewed in a like manner.

Rejection of the claims is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reimers, C., Honig, M. Responses to Social Security by Men and Women: Myopic and Far-sighted, Journal of Human Resources, v31n2, Spring 1996, p359(24).

WO 00/49543 24 August 2000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincen Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

CRK

crk
March 4, 2002

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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Notice of References Cited	Application/Control No. 09/267,255	Applicant(s)/Patent Under Reexamination RICHMAN ET AL.	
	Examiner Charles Kyle	Art Unit 2164	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	WO 00/49543	08-2000	GB	Wood et al	Go6F 17/60
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Mirer, Thad W. Th Optimal time to File for Social Securit Benefits, Public Finance Review v26n6, Nov. 1998, pp 611-636
	V	Reimers, C., Honig, M. Responses to Social Security by Men and Women: Myopic and Far-sighted, Journal of Human Resources, v31n2, Spring 1996, p359(24)
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.