REMARKS

In response to the Final Office Action of October 2018, Applicant submits the following.

Double Patenting

The Office rejected every single claim on the grounds of obviousness-type double patenting over the claims of the issued parent. We traverse.

As a preliminary matter, why are the claims of the parent application "a narrower species" than all the claims as pending – every single one of them:

> end. The claims in the '568 patent represent a narrower species of the same invention, such that the patented narrower species necessarily anticipates the broader genus represented in the instant claims.

(OA, page 7.) We thus traverse the assertion that every single claim is broader than what is in the '568 patent. The USPTO has not explained why this is the case. Indeed, there are many claims that have features not present in the claims of the parent.

The USPTO is not allowed to sweepingly reject all claims. It must evaluate all claims. Thus, assuming arguendo that a prima facie case of obviousness type double patenting has been established against the independent claims, such has not been established against claims 30, 31, 32, 34, 35, 39, 40, 41, 42, 43, 45, 46, 48, 49, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63.

* * * * *

We proffered through geometric though and logic reasoning why the Double Patenting rejection is inconsistent with the rejections, and we are told that our logic is not valid. Not the first time we have heard that. (One would think that my clients would have gotten rid of me by now for such illogical assertions that simply cannot be correct.)

Specifically, the OA states:

> 4. On its face, Applicant's intended logic is not valid. Applicant asserts that if X is not Y (i.e. are not the same invention and therefore are patentably distinct) and X is also not Z, then Y cannot be Z. There is critical fallacy to this assertion, as it could also be used to conclude that because a bird is not a monkey and a bird is also not a mammal, then a monkey cannot be a mammal which is clearly false.

(OA, page 2.) We will assume that the first sentence is accepted by the USPTO as correct. If not, please let us know.

The analogy is apt and it supports our position. Is it the USPTO's position that all mammals are the same? That is the problem.

Also, the bird is not a mammal. Thus, our point is valid. The bird is different, and the record indicates that the monkey and the mammal are different from the bird.

Also, what about Y = Z? The analogy does not take into account that there are two things that the USPTO alleged are the same.

X = bird (not mammal)

Y= Monkey (Mammal)

Z = Y

USPTO says that Z is the same as Y.

We will assume that the USPTO recognizes that X (bird) is not the same as Y (Monkey). If this is wrong, let us know.

Does not the USPTO agree that the bird cannot be the same as Z.

The OA states the following, which is cut and paste language and irrelevant:

3. Applicant is reminded that Double Patenting and prior art rejections under either §102 and §103 are applicable to different legal statutes and are examined separately in accordance with their respective statutes. In particular the statute of Double Patenting is based on what is claimed, whereas the statues under §102 and §103 are based on what is previously disclosed. The mere presence of one cannot be used to disqualify the possibility of the other, or vice versa. Each case before the Office is considered on its own merits, and to the Applicants benefit the validity of previously issued patents is not questioned by the Office when prosecution of the more recently filed case leads to discover or a new interpretation of the prior art.

(OA, page 2.)

Then, there is this, which again is simply stock language:

5. As it pertains to the instant case, Applicant's assertion fails to take into consideration that the rejection is a non-statutory/obviousness-type Double Patenting rejection and therefore the claims are not identical. Further, Applicant's assertion fails to take into consideration that claims comprise more than one element. A more appropriate logical construct would be to say that the patented claim might be represented as comprising elements ABC. The instant claims comprise elements AB. Thus clearly the examined application claim is either anticipated by or would have been obvious over the patented reference claim to properly warrant a nonstatutory double patenting rejection. A prior art reference might exist which discloses elements AB, or perhaps ABD. Thus that prior art reference did not anticipate or render obvious the patented claims because it does not fairly disclose element C, but very clearly applies under §102 against the instant claims because it does disclose elements AB.

(OA, page 3.)

We again repeat our scholarly and righteous arguments.

With respect to the issued patent parent of this application, the Office Action asserts that every single pending claim is unpatentable in view those claims. Yet every single claim of this application is alleged to be unpatentable in view of prior art that was considered by the USPTO when it examined and allowed the claims of the parent patent (the prior art is Kuzma (US 2004 0127968)). Thus, as a matter of logic, the claims cannot be patentably indistinct from the claims of the parent, which was deemed patentably distinct from the prior art now alleged to be patentably indistinct from the current claims.

In this regard, it is a matter of logic that if X and Y are patentably distinct, and Z is patentably indistinct from X, Z must be patentably distinct from Y. Thus, if the claims of the parent application (X) are patentably distinct from the cited references in the rejections under 35 U.S.C. 102 (Y) – which is necessarily the case because the USPTO allowed those claims in view of Kuzma (US 2004/0127968) – and the pending claims (Z) are patentably indistinct from the cited references in the rejections under 35 U.S.C. 102 (Y), as is alleged, then the pending claims (Z) must be patentably distinct from the claims of the parent application (X).

To put things in mathematical terms:

$$\text{If } X \neq Y$$

$$\text{and } Y = Z$$

$$\text{then } Z \neq X$$

Accordingly, the record indicates that the pending claims are patentably distinct from the claims of the parent, and thus the double patenting rejection should be withdrawn.[1]

[1] In the alternative, the prior art rejections should be withdrawn, more on this below.

Claim Rejections Under 35 U.S.C. §102

The Office Action has rejected all but claim 33 under 35 U.S.C. §102 for allegedly being anticipated by U.S. Patent Application Publication No 2004/0127968 to Kuzma. In response, Applicant traverses the rejections of all these claims for at least the reasons that follow.

Applicant relies on MPEP §2131, entitled "Anticipation – Application of 35 U.S.C. §102(a), (b), and (e)," which states that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Section 103 amplifies the meaning of this anticipation standard by pointing out that anticipation requires that the claimed subject matter must be "*identically* disclosed or described" by the prior art reference. (Emphasis added.) MPEP §2131 states that "[t]he identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). It is respectfully submitted that Kuzma does not disclose each and every element of any independent claim now pending.

We again note that the claims have been alleged to be patentably indistinct from claims that have been granted in view of Kuzma. Thus, the record indicates that the claims should not be anticipated.

The Office Action states:

> its own merits. Double Patenting and prior art rejections are considered independently and arguments and remarks thereto should also be made independently. Lest under Applicant's own attempted logic, one of their assertions must necessarily disprove the other. i.e. In order for their assertions against the double patenting rejection to be true, it must also be true that the claims are properly anticipated under §102(e). Conversely in order for their assertion against the rejection under §102(e) to be true, it must also be true that the double patenting rejection is proper.

(OA, page 4.) Yet the record is clear.

The USPTO has established a record that the pending claims (Z) are patentably indistinct from the claims of the parent application (X). Thus:

$$X = Z$$

The USPTO has also established a record that the claims of the parent application (X) are patentably distinct from the cited references in the rejections under 35 U.S.C. 102 (Y) – which is necessarily the case because the USPTO allowed those claims in view of Kuzma (US 2004 0127968). Thus:

$$X \neq Y$$

Therefore,

$$Z \neq Y$$

In any event, claim 28 recites:

> an elongate carrier member;
> a plurality of electrodes spaced along the carrier member; and
> a flexible tip member disposed adjacent a distal end of the carrier member,
> wherein the tip member extends distally from the distal end of the carrier member, and wherein the tip member tapers distally.

(Claim 28.)

This feature is not present as exactly claimed in Kuzma.

Kuzma discloses a typical monolithic electrode array carrier. There is no difference between the tip of the carrier and the central portion. Indeed, the carrier extends to the tip. The tip is the carrier.

We claim an array comprising two elements: a carrier member and a flexible tip member. We do not claim a carrier member having a flexible tip. The latter is what is Kuzma.

Thus, claim 28 is not anticipated.

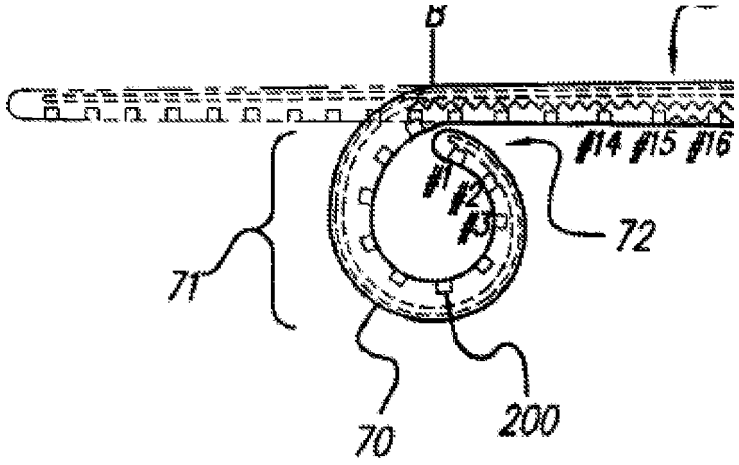
Claims 44 and 50 are not anticipated for at least the above detailed pertinent reasons articulated above with respect to claim 28.

Now, the new claims we added in our failed attempt to advance prosecution.

Claim 53 recites:

> A cochlear implant, comprising:
>
> an intra-cochlea electrode array including a plurality of electrodes configured to stimulate tissue of a recipient of the array, an electrode carrier section carrying the electrodes and a tip section, wherein the tip section is flexible and disposed adjacent a distal end of the carrier section.

(Claim 53.) Kuzma does not disclose a flexible tip section disposed adjacent a distal end of the carrier section. Instead, it is the carrier section:



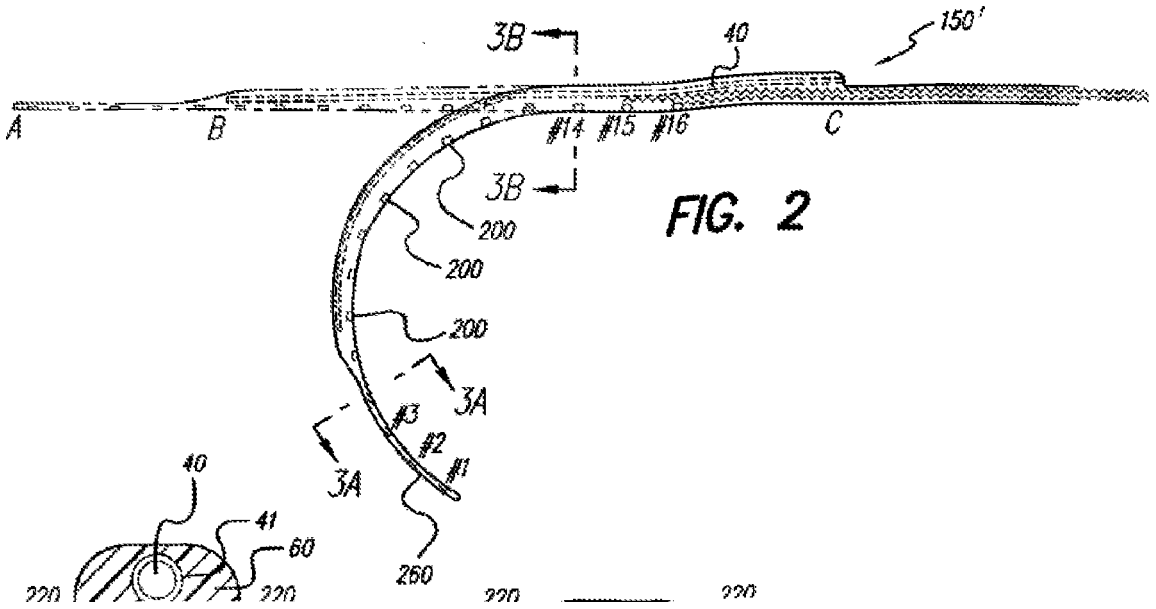


FIG. 2

On claim 54, claim 54 recites:

> The cochlear implant of claim 53, wherein:
>
> the tip section tapers distally.

(Claim 54.) Again, the tip section is part of the carrier section.

Claim 55 recites:

> The cochlear implant of claim 53, wherein:
>
> the electrodes of the electrode array are spaced along the carrier section in a longitudinal direction of the array;
>
> the tip section includes a proximal end disposed proximate the distal end of the carrier section, a part-spherical blunt end disposed opposite the proximal end and a continuous tapered portion between the proximal end and the part-spherical blunt end.

(Claim 55.) In denying Applicant its right to a patent, the Office Action states that:

> 29. Regarding claims 55, 62 and 63, Kuzma'968 shows wherein the electrodes of the array are spaced along the carrier section in a longitudinal direction of the array (e.g. Figs. 1, 2; paragraph [0002]); the tip section includes a proximal end disposed proximate the distal end of the carrier section (e.g. as seen in Fig. 1, the tip section can be any portion distal of where the channel 50 terminates or past the last electrode, or alternatively could be considered the section shown bending starting at point B. The wording of the claim does not preclude electrodes also residing on the tip section, and applicant's own specification considers that the tip portion may be integral with and of the same material as the elongate body such that the distinction between the two can be any arbitrary point along the lead), a part-spherical blunt end disposed opposite the proximal end (e.g. the embodiments of both Fig. 1 and Fig. 2 have rounded, semi-spherical or hemispherical, i.e. part-spherical blunt tips) and a continuous tapered portion between the proximal end and the part-spherical blunt end (ibid.).

(OA, page 12.) Let us begin.

The above indicates that the USPTO has examined claim 55 as follows:

> 55. The cochlear implant of claim 53, wherein:
>
> the electrodes of the electrode array are spaced along the **array** ~~**carrier section**~~ in a longitudinal direction of the array;
>
> the tip section includes a **portion** ~~**proximal end disposed proximate the distal end of the carrier section**~~, a part-spherical blunt end disposed opposite the proximal end and a continuous tapered portion between the **portion** ~~**proximal end**~~ and the part-spherical blunt end.

(Effective rewrite of claim 55 by the USPTO.) We ask how the above is any different than the construction used by the USPTO when it examined the claim.

The OA states:

alternatively could be considered the section shown bending starting at point B. The wording of the claim does not preclude electrodes also residing on the tip section, and (OA, page 12.) Why is this the case? We traverse. The claim specifically details different sections. The USPTO must defend this or withdraw the rejection.

The OA then states:

> wording of the claim does not preclude electrodes also residing on the tip section, and applicant's own specification considers that the tip portion may be integral with and of the same material as the elongate body such that the distinction between the two can be any arbitrary point along the lead), a part-spherical blunt end disposed opposite the

(OA, page 12.) Where is this said in the specification? The USPTO does not say. Also, why is this not simply an unclaimed embodiment?

Behold some of the things in our specification:

FIG. 4A

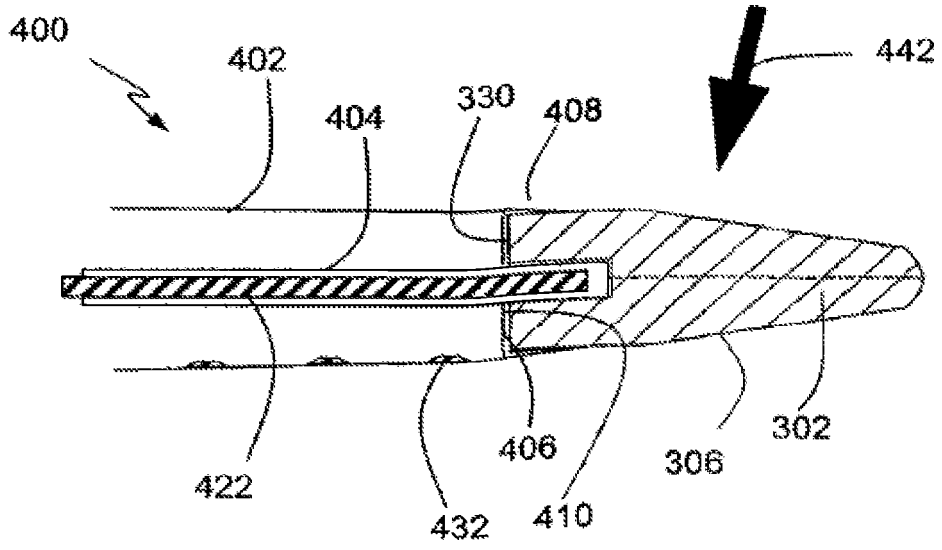


FIG. 4A

Thus, the specification depicts an embodiment that is consistent with a construction that would render the rejections not good.

In any event, the lack of support and explanation as to why the USPTO has interpreted the claims different from the plain language and from the specification presents a record that makes clear that the construction of the claim is arbitrary and capricious, thus violating the Administrative Procedures Act (APA) to which the USPTO is bound per the Supreme Court's Ruling in *Zurko*.

Appendix A contains the decision in *In re Smith*. This is precedential, according to the CAFC website. (*In re Smith*, CAFC appeal number 16-2303, Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. 90/012,912 – Appendix A.) This case instructs the USPTO on how to implement the BRI standard. As will be seen from the below, the USPTO is not following those instructions.

What the BRI standard is and is not:

The Federal Circuit held the following regarding the broadest reasonable interpretation:

> The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is "consistent with the specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted); *see also In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

(*In re Smith*, pages 12-13, paragraph spanning.)

The BRI standard is thus:

1) Not whether the specification proscribes some broad reading.

2) Not whether the specification precludes some broad reading.

3) Not simply an interpretation that is not inconsistent with the specification.

4) An interpretation that is consistent with the specification.

Broadest possible interpretation *vs.* Broadest reasonable interpretation:

In re Smith further goes on to states that

> The Board emphasized that the patentee here did not act as a lexicographer, and that the specification neither defines nor precludes the examiner's reading of the term "body." Accordingly, the Board found that nothing in the specification would disallow the examiner's interpretation, rendering it "reasonable." However, following such logic, any description short of an express definition or disclaimer in the specification would result in an adoption of a broadest *possible* interpretation of a claim term, irrespective of repeated and consistent descriptions in the specification that indicate otherwise. That is not properly giving the claim term its broadest reasonable interpretation *in light of* the specification.

(*In re Smith*, page 13.)

Thus, a BRI justified on the following is not proper:

1) An applicant did not act as a lexicographer.

2) The specification does not define a meaning of a phrase.

3) The specification does not preclude an interpretation.

4) This is the broadest possible interpretation (although that is not mutually exclusive from BRI, in our opinion – again, this is why the procedure is so important).

Now, for a more detailed presentation of *In re Smith*, I present the following. In *In re Smith* the Federal Circuit declared that the term "body" must be interpreted according to the specification, even though that claim term was used generically in the claim. In that case, the USPTO arbitrarily divided up the prior art to meet the recitations, and this was deemed to be not good.

> It is true that some of the claims at issue recite a broad term "body" without further elaboration on what the term "body" encompasses. J.A. 15, 17 (claims 28 and 43). However, the remainder of the specification does not use the term as a generic body. There is no dispute that the '817 patent specification consistently describes and refers to the body as a component distinct from others, such as the mandrel, piston, and drive ring. *See* Appellee's Br. 29–30. Therefore, the Board's reasoning that because the specification does not "in and of itself proscribe the Examiner's construction," the examiner's interpretation was reasonable, *Board Decision*, 2016 Pat. App. LEXIS 3764, at *4, was erroneous.
>
> The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some

broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is "consistent with the specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted); *see also In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

The Board emphasized that the patentee here did not act as a lexicographer, and that the specification neither defines nor precludes the examiner's reading of the term "body." Accordingly, the Board found that nothing in the specification would disallow the examiner's interpretation, rendering it "reasonable." However, following such logic, any description short of an express definition or disclaimer in the specification would result in an adoption of a broadest *possible* interpretation of a claim term, irrespective of repeated and consistent descriptions in the specification that indicate otherwise. That is not properly giving the claim term its broadest reasonable interpretation *in light of* the specification.

Relying on the incorrect interpretation of the term "body" as a generic term in the claims, the Board affirmed the examiner's arbitrary inclusion and exclusion of separately described components to and from the term "body." It reasoned that although a body, a mandrel, and moveable arms are all consistently identified and described separately in the specification, the *generic claim term* "body" includes some of the separately described components, such as a mandrel, but not others, such as moveable arms, solely because the "moveable arm" is recited in the claims and the "mandrel" is not. *See* Oral Argument at 15:16–46, *In re Smith Int'l, Inc.*, No. 16-2303 (Fed. Cir. Aug. 8, 2017), http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2016-2303.mp3 (applying this reasoning to a hypothetical

> claim reciting other separate components of the tool but not a mandrel). But, giving the term "body" such a strained breadth in the face of the otherwise different description in the specification was unreasonable.

(*In re Smith*, pages 12-14.)

In view of the above, it cannot be said that the claim phrases, when construed in view of Applicant's specification, as required, covers the prior art.

Anyway, to ensure that there is no MPEP loophole (it is not in the MPEP, so it does not count), I repeat my prior arguments, which are MPEP based, and I submit that this is completely consistent with *In re Smith*. That is, *In re Smith* simply states what the MPEP states.

Again, Applicant notes that the MPEP has detailed procedures for what to do in such situations. In particular, MPEP 2111 indicates that the claims must be examined under the "broadest reasonable interpretation" standard. Thus, the question becomes what is the "broadest reasonable interpretation" of claim 55. (If the USPTO disagrees that this is the starting place for the issues that prevent us from reaching resolution, Applicant asks the USPTO to state such on the record and explain why Applicant is incorrect.)

MPEP 2111 states that:

> The broadest reasonable interpretation does not mean the broadest possible interpretation. Rather, the meaning given to a claim term must be consistent with the ordinary and customary meaning of the term (unless the term has been given a special definition in the specification), and must be consistent with the use of the claim term in the specification and drawings. Further, the broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.). Thus the focus of the inquiry regarding the meaning of a claim should be what would be reasonable from the perspective of one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010); *In re Buszard*, 504 F.3d 1364, 84 USPQ2d 1749 (Fed. Cir. 2007). In *Buszard*, the claim was directed to a flame retardant composition comprising a flexible polyurethane foam reaction mixture. 504 F.3d at 1365, 84 USPQ2d at 1750. The Federal Circuit found that the Board's interpretation that equated a "flexible" foam with a crushed "rigid" foam was not reasonable. *Id.* at 1367, 84 USPQ2d at 1751. Persuasive argument was presented that persons experienced in the field of polyurethane foams know that a flexible mixture is different than a rigid foam mixture. *Id.* at 1366, 84 USPQ2d at 1751.

(PDF Snapshot of MPEP 2111, emphasis added.) Applicant also submits that the above-cited cases cited in the MPEP where the Courts reversed the USPTO are applicable to the scenario at hand.

Thus, as has been seen from the above, the MPEP mandates that Examiners must use "the meaning given to a claim term [that is] consistent with the ordinary and customary meaning of the term" and, that meaning "must be consistent with the use of the claim term in the specification" and "must be consistent with the interpretation that those skilled in the art would reach."

Thus, the MPEP states three "musts" that an Examiner must do when examining claims. The question then becomes does the Office Action meet those "musts." Applicant now evaluates those musts.

I. Must Use The Meaning Given To A Claim Term That Is Consistent With The Ordinary And Customary Meaning Of The Term.

Nowhere on the record is there any evidence or rationale that the ordinary and customary meaning of the claim phrases at issue encompass the cited reference. Thus, as a matter of procedure, a *prima facie* case of anticipation has not been established.

Indeed, nowhere on the record does the USPTO even identify the broadest reasonable interpretation of the claim phrase at issue. Instead, there is mere assertion that nouns of the claim correspond to nouns in the prior art. That is prior art analysis, not claim construction.

Until the USPTO puts forth the broadest reasonable interpretation of the recitations at issue (noted above and below) on the record, and explains how that was developed per MPEP 2111, no case of anticipation can be established.

II. Must Be Consistent With The Use Of The Claim Term In The Specification And Drawings.

Nowhere on the record is there any evaluation of Applicant's specification or drawings. Thus, as a matter of procedure, a *prima facie* case of anticipation has not been established.

III. Must Be Consistent With The Interpretation That Those Skilled In the Art Would Reach.

Nowhere on the record is there any evaluation of the interpretation that those skilled in the art would reach. Thus, as a matter of procedure, a *prima facie* case of anticipation has not been established.

* * * * *

In view of the above, it is clear that Applicant has articulated reasoning to support a finding that there is doubt as to whether the USPTO has properly interpreted the claims. Until the record is made clear, and the USPTO supports its position, it cannot be said that as a matter of procedure, a prima facie case of anticipation has not been established.

We thus traverse the BRI of claim 55. We ask the USPTO to put forth the BRI of that claim, and then explain why that is consistent with the specification, with proper citations thereto, and then explain why that encompasses Kuzma.

Claim 56 recites:

> The cochlear implant of claim 53, wherein the tip section does not exceed 1.2mm in length.

(Claim 56.)

The OA states:

> 30. Regarding claim 56, Kuzma'968 discloses an inter-contact spacing of about 1.20 millimeters (e.g. paragraph [0076], given such scale, both Figs. 1 and 2 show a tip section that does not exceed 1.2mm in length as the tip is shown consistently to be less than the inter-contact distance).

(OA, page 12.) So, to be clear, paragraph 0076 does not disclose anything about the tip section length, correct?

The answer is yes. We thus have MPEP 2125, entitled "Drawings as Prior Art," which prohibits the action taken in the Office Action. Specifically, the MPEP 2125 states that

> ***Proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale***. When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *hockerson-halberstadt, inc. V. Avia groupint'l*, 222 f.3d 951, 956, 55 uspq2d 1487, 1491 (fed.cir. 2000) (the disclosure gave no indication that the drawings were drawn to scale. "[i]t is well established that patent drawings do not define the precise proportions of the elements and ***may not be relied on to show particular sizes if the specification is completely silent on the issue***.").

(MPEP 2125, emphasis added.) There is nothing in Kuzma that indicates scale. The rejection is thus not supported.

Claim 57 recites:

> The electrode array of claim 28, wherein the tip member is distinct portion of the array relative to the carrier member.

(Claim 57.)

The OA states:

> 31. Regarding claim 57, by virtue of being distally located and clearly distinguishable from the relative longer section of the carrier member, the tip portion of Kuzma'968 is reasonably considered to be distinct portion of the array relative to the carrier member. They are distinct in such features as e.g. the channel 50 has terminated and or the lead has markedly narrowed to super-flexible tip 260 which has different flexural properties from the more proximal portion of the lead. As worded, "distinct" does not appear to require that the tip member be a discrete component or separately fabricated physical structure from the carrier member, merely that they be "distinct portions of an array". Their distinction is easily made based on the above attributes.

(OA, pages 12-13.) The above is not good in view of *In re Smith*.

We thus traverse the BRI of claim 57, and ask the USPTO to put that on the record, and then explain why that is consistent with our specification, and then explain why that covers the prior art.

We refer the USPTO to the above explanation of *In re Smith* and MPEP 2111. The rejection must be withdrawn.

Claim 58 recites:

> The electrode array of claim 28, wherein the tip member has a different functionality than the carrier member.

(Claim 58.)

The OA states:

> 32. Regarding claim 58, the super-flexible tip 260 of Kuzma'968 clearly has a separate functionality than the carrier member as already cited, particularly to be very compliant and thereby being gentle and curving to allow the device to follow the anatomical structure and curve into the scala timpani. The functionality of the higher compliance carrier member is to advance the entirety of the structure from the outer ear into the deeper inner ear structures (e.g. paragraph [0078]).

(OA, page 13.) The functions identified above are those of both the tip member and the carrier member.

Claim 59 recites:

> The electrode array of claim 28, wherein a majority of the outer diameters of the tip member are distinctly different from a diameter of the carrier member adjacent the tip member.

(Claim 59.)

The OA states:

> 33. Regarding claim 59, as shown in Kuzma'968, in particular in Fig. 2, the outer diameter or diameters of the tip portion are clearly different and smaller than a diameter of the carrier member adjacent to the tip member.

(OA, page 13.) This is not present in FIG. 2. The outer diameter of the tip member are clearly not different and not smaller than a diameter of the carrier member adjacent the tip member.

Note that the above is as much explanation as given in the OA. The USPTO says it is, we say it is not. And that is the point. The rejection is arbitrary and capricious, thus violating the APA. In any event, procedurally, because Applicant has responded with as much reasoning as proffered by the USPTO, and because 35 USC 102 indicates that a person shall be entitled to a patent unless, there is no unless, and thus we are entitled to a patent.

Also, we traverse the BRI of a majority of the outer diameters of the tip member are distinctly different from a diameter of the carrier member adjacent the tip member. We ask the USPTO to explain the BRI used to reject claim 59, and explain why that is consistent with our specification, and then explain why that interpretation encompasses FIG. 2, or else withdraw the rejection.

Claim 60 recites:

> The electrode array of claim 28, wherein the end of the tip is rounded and all the electrodes of the array are located on the carrier member.

(Claim 60.)

The OA states:

34. Regarding claim 60, as shown in Fig. 1 of Kuzma'968 the tip is rounded and it is reasonable to consider all of the electrodes to be located on the carrier member (i.e. the tip section starts just distal of the distalmost electrode).

(OA, page 13.) Why is it reasonable?

We ask the USPTO to explain the BRI used to reject claim 60, and explain why that is consistent with our specification, and then explain why that interpretation encompasses FIG. 2, or else withdraw the rejection.

Claim 61 recites:

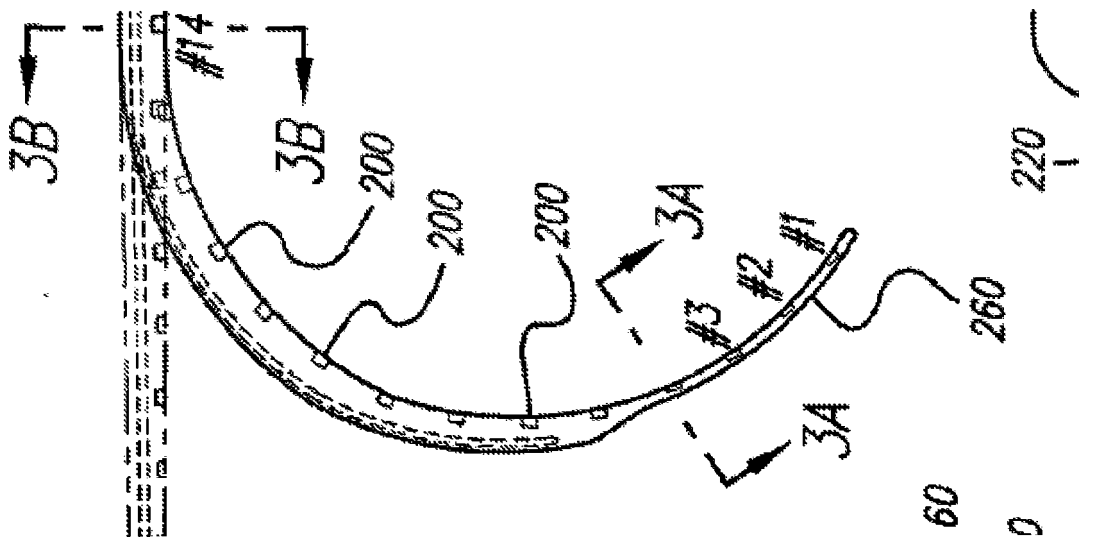
> The cochlear implant of claim 53, wherein the tip section is a straight section.

(Claim 61.)

The OA states:

35. Regarding claim 61, as shown in Fig. 2, the tip section distal of line 3A is reasonably considered to be straight.

(OA, page 13.) Why is it reasonable? Why is the stuff distal of 3A straight?



We ask the USPTO to explain the BRI used to reject claim 61, and explain why that is consistent with our specification, and then explain why that interpretation encompasses FIG. 2, or else withdraw the rejection.

Claim 62 recites:

> The cochlear implant of claim 53, wherein the tip section includes a proximal end disposed proximate the distal end of the carrier section, an at least partially hemispherical blunt end disposed opposite the proximal end and a continuous tapered portion between the proximal end and the at least partially hemispherical blunt end.

(Claim 62.) In denying Applicant its right to a patent, the Office Action states that:

> 29. Regarding claims 55, 62 and 63, Kuzma'968 shows wherein the electrodes of the array are spaced along the carrier section in a longitudinal direction of the array (e.g. Figs. 1, 2; paragraph [0002]); the tip section includes a proximal end disposed

> proximate the distal end of the carrier section (e.g. as seen in Fig. 1, the tip section can be any portion distal of where the channel 50 terminates or past the last electrode, or alternatively could be considered the section shown bending starting at point B. The wording of the claim does not preclude electrodes also residing on the tip section, and applicant's own specification considers that the tip portion may be integral with and of the same material as the elongate body such that the distinction between the two can be any arbitrary point along the lead), a part-spherical blunt end disposed opposite the proximal end (e.g. the embodiments of both Fig. 1 and Fig. 2 have rounded, semi-spherical or hemispherical, i.e. part-spherical blunt tips) and a continuous tapered portion between the proximal end and the part-spherical blunt end (ibid.).

(OA, page 12.) Where is the continuously tapered portion? The OA does not identify such. We traverse the rejection as being arbitrary and capricious. This is a fiat decision.

Claim 63 recites:

> The cochlear implant of claim 53, wherein the tip section includes a proximal end disposed proximate the distal end of the carrier section, an a partially hemispherical blunt end disposed opposite the proximal end and a continuous tapered portion between the proximal end and the partially hemispherical blunt end.

(Claim 63.) In denying Applicant its right to a patent, the Office Action states that:

> 29. Regarding claims 55, 62 and 63, Kuzma'968 shows wherein the electrodes of the array are spaced along the carrier section in a longitudinal direction of the array (e.g. Figs. 1, 2; paragraph [0002]); the tip section includes a proximal end disposed

> proximate the distal end of the carrier section (e.g. as seen in Fig. 1, the tip section can be any portion distal of where the channel 50 terminates or past the last electrode, or alternatively could be considered the section shown bending starting at point B. The wording of the claim does not preclude electrodes also residing on the tip section, and applicant's own specification considers that the tip portion may be integral with and of the same material as the elongate body such that the distinction between the two can be any arbitrary point along the lead), a part-spherical blunt end disposed opposite the proximal end (e.g. the embodiments of both Fig. 1 and Fig. 2 have rounded, semi-spherical or hemispherical, i.e. part-spherical blunt tips) and a continuous tapered portion between the proximal end and the part-spherical blunt end (ibid.).

(OA, page 12.) Where is the continuously tapered portion? The OA does not identify such. We traverse the rejection as being arbitrary and capricious. This is a fiat decision.

Also, there is this:

> 12. Applicant is advised that should claim 62 be found allowable, claim 63 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). As presented it does not appear that a recitation of "at least partially hemispherical" is any different in scope than being "partially hemispherical".

(OA, page 7.) Simply because an individual Examiner does not understand the difference does not mean that there no difference. The USPTO must put forth the BRI of both of these claims and explain why the BRI would be the same in view of the specification, as would be understood by the person of ordinary skill in the art, or else withdraw the rejection.

Conclusion

It is believed that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

Examiner Flory is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 60-2213 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: December 24, 2018
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