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Pilloff & Passino LLP 1940 Duke Street Suite 200 Alexandria, VA 22314			FLORY, CHRISTOPHER A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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

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DETAILED ACTION

Response to Amendment

1. Applicant's reply filed 24 December 2018 makes no amendments to the claims. Claims 28, 30-32, 34, 35, 39-46, 48, 49 and 53-63 are pending.
2. It is noted that claim 59 is improperly listed as being New instead of Previously Presented. Future submissions should correct this deficiency.
3. Further, claims 30, 31, 34 and 35 are improperly listed as depending from canceled claim 29. Correction is required in future submissions.

Response to Arguments

4. Applicant's arguments filed 24 December 2018 have been fully considered but they are not persuasive. Claims 28, 30-32, 34, 35, 39-46, 48, 49 and 53-63 stand rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 9,427,568. Claims 28, 30-32, 34, 35, 39-46, 48, 49 and 53-63 stand rejected under pre-AIA 35 U.S.C. §102(e) as being anticipated by Kuzma'968.
5. Applicant traverses the basis of the obviousness-type double patenting rejection that the claims of the parent application represent a narrower species *in toto* of the instant claims. Applicant asserts that many pending claims have features not present in the claims of the parent, but beyond the broad assertion provides no evidence or indication as to what the argued differences might be. Applicant generally asserts that the office has not established a prima facie case of obviousness type double patenting against the dependent claims 30-32, 34, 35, 39-43, 45, 46, 48, 49 and 54-63.

6. The Examiner respectfully disagrees. As was clearly presented in the Final Office Action filed 25 October 2018, there is substantially overlapping subject matter between the patented claims of 9,427,568 and the instant application in the form of an intra-cochlear electrode array comprising an elongate member, a plurality of electrode disposed thereon, and a tapered distal tip. The dependent claims in both cases focus on further defining the tip member as being frusto-conical with a blunt and/or rounded distal end. The patented independent claim contains additional narrowing limitations, and as such clearly constitutes a narrower species or sub-genus of the genus presented in the instant claims. Applicant is directed to MPEP 806.04(i) regarding generic claims presented in separate applications after issuance of species claims:

“If a **generic claim** is presented in a separate application after the issuance of a patent claiming one or more **species within the scope of the generic claim**, the Office **may reject the generic claim on the grounds of nonstatutory double patenting when the patent and application have at least one common inventor** and/or are either (1) commonly assigned/owned or (2) non-commonly assigned/owned but subject to a joint research agreement as set forth in **35 U.S.C. 102(c)** or **pre-AIA 35 U.S.C. 103(c)(2) and (3)**. See **MPEP § 804**. **Applicant may overcome such a rejection by filing a terminal disclaimer**. See *In re Goodman*, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993); *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).”

Further MPEP 804(II)(B)(1) states:

“The claim under examination is not patentably distinct from the reference claim(s) if the claim under examination is anticipated by the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015-16 (Fed. Cir. 1993). This type of nonstatutory double patenting situation arises when the claim being examined is, for example, **generic to a species or sub-genus claimed in a conflicting patent or application, i.e., the entire scope of the reference claim falls within the scope of the examined claim**. In such a situation, **a later patent to a genus would, necessarily, extend the right to exclude granted by an earlier patent directed to a species or sub-genus**. In this type of nonstatutory double patenting situation, **an obviousness analysis is not required for the nonstatutory double patenting rejection**. The nonstatutory double patenting rejection in this case should explain the fact that the species or sub-genus claimed in the conflicting patent or application anticipates the claimed genus in the application being examined and, therefore, a patent to the genus would improperly extend the right to exclude granted by a patent to the species or sub-genus should the genus issue as a patent after the species or sub-genus.”

7. Thus the Office has properly presented its case according to the statutes and established case law. Nonetheless, in order to assist Applicant the following chart maps the overlapping subject matter between the claims in the instant application to those of the issued patent.

Instant claims (15/248,001)	US 9,427,568	Notes
Independent -		
<p>28. (Previously Presented) An intra-cochlea electrode array comprising: 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 <i>tapers distally</i>.</p>	<p>1. A hearing prosthesis comprising: an elongate member, configured to be implanted into a duct of a recipient's cochlea, having a preformed curved orientation, proximal and distal ends, electrodes disposed thereon, and a longitudinally-extending lumen for receiving a stiffening element; and a tip member, extending distally from the distal end of the elongate member, configured to have a substantially uniform bending stress distribution in an axial direction, and a length sufficiently short to avoid substantially damaging walls of the duct when the elongate member is in a fully implanted location in the cochlea, and sufficiently long to guide the elongate member through the duct to the fully implanted location as the elongate member adopts its preformed curved orientation in response to withdrawal of the stiffening element from the lumen.</p>	<p>Equivalent subject matter: A - A "hearing prosthesis configured to be implanted into a duct of a recipient's cochlea" is reasonably interpreted as equivalent to an intra-cochlear device or cochlear implant. B - An elongate member is an elongate member. C - A plurality of electrodes is equivalent to "electrodes disposed thereon" D - A tip member being "disposed adjacent a distal end of the carrier member", "proximate an end of the carrier member", and "extending distally from the distal end of the elongate member" all describe a tip member in the same location/configuration.</p>

<p>44. (Previously Presented) An intra-cochlea electrode array comprising: an elongate carrier member having an axis and a <i>first taper</i> along the axis; a plurality of electrodes spaced along the carrier member; and a flexible tip member disposed proximate an end of the carrier member, wherein the tip member has a <i>second taper greater than the first taper</i>.</p>	<p>8. A hearing prosthesis comprising: an elongate member, configured to be implanted into a duct of a recipient's cochlea, having a preformed curved orientation, proximal and distal ends, electrodes disposed thereon, and a longitudinally-extending lumen for receiving a stiffening element; and a tip member, extending distally from the distal end of the elongate member, <i>having a substantially uniform bending stress distribution</i> and a length sufficiently long to prevent the tip member from folding over as the elongate member adopts the preformed curved orientation in response to withdrawal of the stiffening element from the lumen.</p>	<p><i>Similar subject matter:</i> The instant claims recite that the carrier member and tip member taper along the axis, with claim 44 specifying that the tip member has a greater taper than the first taper. The claims of the '568 patent construct the carrier member and tip member are configured to have a substantially uniform bending stress distribution in the axial direction, which a reading of the Specification indicates requires a structure which tapers distally with the taper increasing more distally. Thus the limitation in the patented application is narrower in scope since it not only necessitates the same structure but is configured for a particular purpose.</p>
<p>53. (Previously Presented) 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</p>	<p>16. A hearing prosthesis comprising: an elongate member, configured to be implanted into a duct of a recipient's cochlea, having a preformed curved orientation, proximal and distal ends, electrodes</p>	<p>Uniform bending stress also necessarily applies to a flexible structure, and cochlear prostheses are necessarily configured to stimulate tissue of the recipient.</p>

<p>carrying the electrodes and a tip section, wherein the tip section is flexible and disposed adjacent a distal end of the carrier section.</p>	<p>disposed thereon, and a longitudinally-extending lumen for receiving a stiffening element; and a tip member, extending distally from the distal end of the elongate member, having a substantially uniform bending stress distribution and a length sufficiently long to prevent the tip member from catching on the duct wall as the elongate member adopts the preformed curved orientation in response to withdrawal of the stiffening element from the lumen.</p>	
<p>Dependent -</p>		
<p>30. (Previously Presented) The electrode array of claim 29, wherein the blunt distal end is rounded.</p>	<p>12. The hearing prosthesis of claim 8, wherein the tip member comprises...a conical tapered portion at a distal end of the barrel portion, the conical tapered portion tapering distally; and a blunt end portion at a distal end of the tapered portion.</p>	
<p>31. (Previously Presented) The electrode array of claim 29, wherein the blunt distal end of the tip member has a first diameter and the distal end of the carrier member has a second diameter, and wherein the second diameter is greater than the first diameter.</p>	<p>15. The hearing prosthesis of claim 12, wherein the blunt end portion has one of an ellipsoidal shape and a spherical shape.</p>	

<p>32. (Previously Presented) The electrode array of claim 31, wherein the second diameter is at least 0.2mm greater than the first diameter.</p>		<p>Obvious by virtue of non-critical range. Obvious in light of applied prior art Kuzma'968 directly disclosing the limitation.</p>
<p>34. (Previously Presented) The electrode array of claim 29, wherein the tip member is substantially frusto-conical in shape.</p>	<p>12. The hearing prosthesis of claim 8, wherein the tip member comprises... a conical tapered portion at a distal end of the barrel portion, the conical tapered portion tapering distally...</p>	<p>A tapered cone distal to a barrel shaped section meets the definition of "frusto-conical".</p>
<p>35. (Previously Presented) The electrode array of claim 29, wherein the tip member tapers continuously from the distal end of the carrier member to the blunt distal end.</p>	<p>13. The hearing prosthesis of claim 12, wherein the conical tapered portion tapers continuously.</p>	
<p>39. (Previously Presented) The electrode array of claim 28, wherein the tip member is resiliently flexible.</p>	<p>10. The hearing prosthesis of claim 8, wherein the tip member is resiliently flexible.</p>	<p>Identical claims.</p>
<p>40. (Previously Presented) The electrode array of claim 28, wherein the carrier member is pre-curved to position the electrodes adjacent the modiolus wall of the cochlea.</p>	<p>Claims 1, 5, 8 and 16 recite a "preformed curved orientation".</p>	<p>Pre-curved is clearly just a shorthand notation for "preformed curved".</p>
<p>41. (Previously Presented) The electrode array of claim 40, wherein: the carrier member defines a lumen, the lumen extends in an axial direction, and the lumen is</p>	<p>1, 8 and 16 each recite "a longitudinally-extending lumen for receiving a stiffening element"</p>	<p>The Specification of the '568 patent clearly indicates that the stiffening element is stilet 422.</p>

<p>configured to receive a stylet.</p>		
<p>42. (Previously Presented) The electrode array of claim 41, wherein the lumen does not extend into the tip member.</p>	<p>Claims 1, 8 and 16 clearly state that the lumen is part of the elongate member, preceding and recited separately from the tip member.</p>	<p>The BRI of such recitation clearly accounts for an arrangement in which the lumen does not extend into the tip member.</p>
<p>43. (Previously Presented) The electrode array of claim 28, wherein the tip member has substantially uniform bending stress distribution in an axial direction.</p>	<p>1, 8 and 16 each recite "a tip member... configured to have a substantially uniform bending stress distribution in an axial direction"</p>	
<p>45. (Previously Presented) The intra-cochlear electrode array of claim 44, wherein the tip member comprises a distal end, and wherein the taper is substantially consistent to the distal end.</p>	<p>13 - "conical tapered portion tapers continuously" 14 - "angle between notional diametrically opposed sides of the conical tapered portion is about 18.9 degrees."</p>	<p>A conical taper with a specific angle is clearly a substantially consistent taper to meet the claim.</p>
<p>46. (Previously Presented) The intra-cochlear electrode array of claim 45, wherein the flexible tip member comprises a substantially cylindrical barrel portion, wherein the substantially cylindrical barrel portion is fixed to the elongate carrier member.</p>	<p>12. The hearing prosthesis of claim 8, wherein the tip member comprises: a substantially cylindrical barrel portion at a proximal end of the tip member; a conical tapered portion at a distal end of the barrel portion,</p>	
<p>48. (Previously Presented) The intra-cochlear electrode array of claim 44, wherein the elongate carrier member comprises a first cross-sectional shape and wherein the flexible tip member comprises a second cross-sectional shape different than</p>	<p>15. The hearing prosthesis of claim 12, wherein the blunt end portion has one of an ellipsoidal shape and a spherical shape.</p>	<p>In this arrangement, the carrier member of the '568 patent is described as being a barrel shape (i.e. round cross-section) with the tip member having potentially an ellipsoidal shape thus being different from the round or</p>

<p>the first cross-sectional shape.</p>		<p>circular cross-section of the barrel.</p>
<p>49. (Previously Presented) The intra-cochlear electrode array of claim 48, wherein the second cross-sectional shape is substantially round.</p>	<p>Ibid.</p>	
<p>54. (Previously Presented) The cochlear implant of claim 53, wherein: the tip section tapers distally.</p>	<p>See previous reference to claim 12.</p>	
<p>55. (Previously Presented) 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.</p>	<p>See previous reference to claim 12.</p>	
<p>56. (Previously Presented) The cochlear implant of claim 53, wherein the tip section does not exceed 1.2mm in length.</p>	<p>2. The hearing prosthesis of claim 1, wherein the length of the tip member is about 1.2 mm. Claims 9 and 17 present an identical limitation.</p>	
<p>57. (Previously Presented) The electrode array of claim 28, wherein the tip member is distinct portion of the array relative to the carrier member.</p>	<p>21. The hearing prosthesis of claim 16, wherein the elongate member is formed of a first material and the tip member is formed of a second material. 23. The hearing prosthesis of claim</p>	

	<p>21, wherein the first material has a relatively greater stiffness than the second material. 26. The hearing prosthesis of claim 16, wherein the tip member is mounted on the distal end of the elongate carrier member.</p>	
<p>58. (Previously Presented) The electrode array of claim 28, wherein the tip member has a different functionality than the carrier member.</p>	<p>At least claims 1, 8 and 16 state that the tip member has it's own configuration with uniform bending stress such that it avoids damaging walls during insertion and also guides the elongate member through the duct to the final implantation location, which is a different function from supporting the electrodes and receiving a stiffening element/stylet.</p>	
<p>59. (New) 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.</p>	<p>Follows from the discussion of differing taper angle and cross-section above.</p>	
<p>60. (Previously Presented) 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.</p>	<p>Electrode location and rounded tip discussed above.</p>	
<p>61. (Previously Presented) The cochlear implant of claim 53, wherein the tip section is a straight section.</p>		<p>Obvious design choice, no criticality as evidenced by the vast exposition on tapered tips.</p>

<p>62. (Previously Presented) 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.</p>	<p>See previous reference to claim 12.</p>	
<p>63. (Previously Presented) 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.</p>	<p>Ibid.</p>	

8. Should Applicant still find that there are features in the instant claims which are not present in the claims of the parent, Applicant is respectfully requested to actually set forth what those perceived differences are in place of making a broad allegation that many exist.

9. The Examiner's position regarding the Applicant's purportedly scholarly and righteous arguments remains consistent with that made clear in the Final Rejection. The mathematical logic shown is a false equivalence to the opinion statement that Applicant asserts as fact regarding the relationship between Double Patenting and rejections

under §102 and §103. In terms of syllogistic construction, Applicant is reminded of the fallacy of the undistributed middle and the self-reliant fallacy.

10. Applicant appears to dismiss paragraphs 3 and 4 of the Final Action as “cut and paste language” and irrelevant and stock language. Respectfully, and ad hominem fallacy aside, paragraph 3 outlines the very basis, both factual and legal, under which patent examination is conducted. It is hardly cut and paste, nor is it irrelevant. Double Patenting is considered on its own statutory bases, and relates to what is *claimed in a related issued patent*. Separately, and under their own specific legal statutes, anticipation (§102) and obviousness (§103) are determined against what is *disclosed in the prior art*. As examination and analysis under each statute is performed separately, Applicant’s attempt to disprove the possibility of one by the mere presence of the other, and vice versa, is moot and unsupportable.

11. Further, it is an attempt to compare apples to oranges and contains several critical errors which were explained in the Final Rejection. It fails to take into account that it is the patented claim which is narrower than and therefore anticipatory of the instant, critically broader claim. Applicant’s assertion is only true when one assumes the patented claim is identical to the instant claim. Indistinct and identical are not the same. It also, as stated before, fails to take into consideration that the claims comprise more than one element. The instant rejection is an obviousness-type Double Patenting rejection because the claims are indistinct, *not identical*. If the claims were identical, the rejection would be made under Statutory double patenting.

12. The previously given example clearly shows this difference and illustrates why double patenting, anticipation and obviousness must be considered individually on their

own merits, and why it is and always has been perfectly valid for an Office Action to contain rejections under all such statutes without conflict, such that the existence of one rejection cannot of itself refute the propriety of another.

The instant independent claim presents limitations A, B and C.

The patented independent claim comprises elements A, B, C and D. Thus it is a narrower species/sub-species of the more broadly claimed invention of the instant application, and is properly rejected under ODP as set forth above and supported by the MPEP.

The prior art is shown to disclose at least A, B and C amongst other features, but does not disclose D. The reference or prior art as a whole are not found to fairly teach or render obvious element D. Thus the patented independent claim was patentable over the prior art. Clearly though, the instant *broader* claim is still anticipated by the prior art since the prior art discloses all limitations now claimed. It is inconceivable therefore to argue that because Kuzma was not applied against the patented claims it cannot be applied against the instant claims, because the patented and instant claims are not the same or identical. They are indistinct, which is different from being the same or identical.

13. On page 12 of the Response, Applicant establishes pending claims to be Z, parent patented claims to be X, and prior art reference Kuzma to be Y (this is a different construct than before, but nonetheless attempts to relate to the same syllogism). Applicant asserts that $X = Z$ because the pending claims are indistinct from the patented claims. This is the critical error in the major premise. The pending claims are not identical or the same as the claims that are patented. Indistinct claims are not identical.

Thus $X \neq Z$. Per the record in the parent case, patented claims X are distinct from Kuzma Y, i.e. $X \neq Y$ as correctly indicted by Applicant on page 12. However, Applicant wrongly concludes therefrom that $Z \neq Y$. This is a fallacy of exclusive premises. Both premises when correctly constructed are negative, meaning no link can be established between the major and minor terms, and no relationship between Z and Y can be established from the information present.

14. Applicant, again, is attempting to refute the rejection under Obviousness-type double patenting simply by assuming the correctness of the rejections under §102/§103 rather than addressing the rejection on its own merits. Thus, the position is not found convincing.

15. Applicant repeatedly refers to "the record" and asserting that the record is clear. Importantly, Applicant is referring to the record of the parent case, not the record of the instant case. They are different cases, and the merits of past cases, while considered, are simply not dispositive of prosecution in any other case, related or otherwise. Should Applicant be referring to the present record, this statement seen to its logical conclusion must be taken as an admission that although Applicant does not accept that both rejections can be valid at the same time, one of the two must be irrefutably proper in order to disprove the other, given that indeed Applicant assumes the 102 rejection to be correct in order to argue against double patenting, and assumes double patenting to be correct to argue against 102. Thus by admission, at least one rejection is irrefutably true, and by such admission all claims should stand rejected under one statute or the other. The only way to deny such admission would be to address each rejection on its own merits and independently of the other, which Applicant has not done to date.

16. Applicant again asserts that Kuzma discloses a monolithic electrode array carrier in which the tip is part of the carrier, and asserts that this is different from what is claimed because Applicant presents two separate elements, a carrier member and a flexible tip member not a carrier member having a flexible tip. As before, this is not convincing and not found to be commensurate to the broadest reasonable interpretation of the claims. The claim language does not require the carrier and tip to be separately formed elements only later connected together.

17. Per Applicant's own specification in at least paragraphs [0027]-[0029], [0047] and [0048], although the tip member may be formed separately, it is also a contemplated embodiment of the invention that "the tip member may be formed of the same material as the body of the elongate member", "the tip member may be integrally formed with the body of the elongate member", and "in general the tip member is made of any material that allows the tip member to be resiliently flexible". Further, in paragraph [0029] "the tip member may be formed as part of an elongate member". Thus a BRI as evidenced by Applicant's disclosure clearly includes a tip member made of the same material and integrally formed with the body of the elongate carrier member, and therefore the claim language as presented does not require separate physical structures as appears to be argued. Kuzma's electrode array carrier, which Applicant describes as monolithic, clearly reads on the broadest reasonable interpretation to meet the claim.

18. Regarding Applicant's comments pertaining to claim 55 (e.g. page 15), the Office has made no attempt to rewrite claim 55 as hypothetically presented. This should be clearly evident as the Office Action specifically refers to the identical language of the claim, and cites portions of Kuzma against each limitation in the actual claim language

presented. Applicant provides no basis or citation in support of their assumption, which amounts to a straw man if not tu quoque logical fallacy asking the Examiner to disprove a negative founded on a position which was never taken. It is not a requirement that the USPTO defend a position which was never taken. The actual merits of the actual rejection are clear and valid.

19. Applicant contests the statement in the Office Action that the wording of the claim does not preclude electrodes on the tip, and that Applicant's own specification considers that the tip portion may be integral with and of the same material as the elongate body such that distinction between the two can be an arbitrary point along the lead. Applicant asks "where is this said in the specification" and asserts that the USPTO does not say. It is unclear if Applicant is referring to both points set forth in the citation or only one. As to the first point, it relates to the wording *of the claim*, which does not preclude additional electrodes residing on the tip section because it utilizes open-ended "comprising" claim language. As to which portions of the specification consider that the tip portion may be integral with and of the same material as the elongate body, the previous Office Action very clearly cited, with specific quotations, that such disclosure is provided in at least paragraphs [0027]-[0029], [0047] and [0048].

20. Of the elements beholden from the Specification as presented by Applicant (comprising solely Fig. 4A as presented on page 16 of the response), it is simply noted that a singular depiction of a singular *possible* embodiment does not preclude the remainder of the disclosure or a broadest reasonable interpretation of what is actually presented in the claims. As it pertains to the instant application, although the disclosure may contemplate a single embodiment in which the tip member is potentially separately

formed from the elongate member (as appears to be shown in Fig. 4A), the Disclosure also explicitly recites other contemplated embodiments in which the tip member is formed of the same material as the elongate member or integrally formed with the elongate member. The disclosure explicitly recites that "the tip member may be integrally formed with the body of the elongate member" as cited. A broadest reasonable interpretation of the claims must consider *all* possible embodiments consistent with the actually presented claim language, not a singular embodiment of Applicant's choosing which is not necessitated by the presented language. Since the disclosure explicitly recites "the tip member may be integrally formed with the body of the elongate member", a BRI of the claim should include constructions in which the tip member and elongate member are integrally formed since the claims do not implicitly or explicitly require a separate construction.

21. Applicant asserts that the USPTO has interpreted claims differently from the plain language, but provides no examples of what language is considered to be given anything other than the plain meaning or evidence that the rejection does not apply to a broadest reasonable interpretation of the claims.

22. Applicant also asserts that the USPTO has interpreted the claims differently from what the specification presents, but the above is an actual direct citation from the Specification allowing that the tip member and elongate member may be made of the same material and integrally formed. This comes directly from Applicant's own Specification in at least paragraphs [0027]-[0029], [0047] and [0048]. Thus considering a BRI which includes a tip member and elongate member that are made of the same

material and/or integrally formed is neither arbitrary nor capricious as asserted, but is taken directly from the Specification.

23. As to Applicant's assessment of the conclusions in *In re Smith*:

1) "An applicant did not act as a lexicographer." – It was not asserted that the applicant did or did not act as their own lexicographer.

2) "The specification does not define a meaning of a phrase." – No additional or alternate definition beyond the plain meaning of each word was relied upon.

3) "The specification does not preclude an interpretation." – It should be appreciated that due to direct quotation, the Specification expressly discloses the interpretation being relied upon, and does not simply "not preclude" the interpretation as asserted.

4) "This is the broadest possible interpretation" – as admitted, this is the opinion of the Applicant. As is well established by the MPEP, opinion of counsel cannot replace material fact.

24. Applicant's remaining broad allegations that the rejection is arbitrary and capricious are not found to be convincing. The record as presented in the Office Actions filed 5/17/18 and 9/17/18 more than amply considers and explains the BRI of claims when necessary, and provides direct and specific citations to the prior art related to each and every claim limitation presented, given their plain meaning in the art. Applicant's apparent assertion that the burden is placed on the Examiner to exhaustively provide evidence for every customary meaning of each claim phrase is simply unfounded. The Broadest reasonable interpretation of the claims, as is reasonably applicable, is clearly presented in the previous Office Action.

25. The assertion that “nowhere on the record is there any evaluation of Applicant’s specification or drawings” is unfounded. There is clearly consideration thereof throughout the citation, and in the previous and presently presented citations to paragraphs [0027]-[0029], [0047] and [0048] establishing the BRI of the argued/relevant claim phrases.

26. There is absolutely no requirement to exhaustively analyze the interpretation of each claim phrase that those skilled in the art would reach, in particular when Applicant has provided no actual evidence or suggestion as to what that interpretation might be or how the interpretation provided in the Office Action differs therefrom. Without at least that feedback from the Applicant, there is no starting point from which such an analysis could or should take place.

27. Applicant merely alleges that there is “doubt” as to whether the USPTO has properly interpreted the claims, but provides no evidence or example of which limitations are supposedly misinterpreted, or what is seen as the proper interpretation thereof.

28. The Examiner believes this addresses every properly constructed and good faith argument presented by Applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER A FLORY whose telephone number is (571) 270-5305. The examiner can normally be reached on Monday-Friday 9am-5pm (PST) PST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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

/CHRISTOPHER A FLORY/
Primary Examiner, Art Unit 3792

4 January 2019

Advisory Action Before the Filing of an Appeal Brief	Application No. 15/248,001	Applicant(s) DADD et al.	
	Examiner CHRISTOPHER A FLORY	Art Unit 3792	AIA Status No

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

THE REPLY FILED 24 December 2018 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
NO NOTICE OF APPEAL FILED

1. The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:

a) The period for reply expires ____ months from the mailing date of the final rejection.

b) The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

c) A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires ____ months from the mailing date of the prior *Advisory Action* or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANTS FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37CFR 41.37(a).

AMENDMENTS

3. The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because

a) They raise new issues that would require further consideration and/or search (see NOTE below);

b) They raise the issue of new matter (see NOTE below);

c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____ (See 37CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicants reply has overcome the following rejection(s): _____

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): (a) will not be entered, or (b) will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8. A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____

9. The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

10. The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellants fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

11. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

12. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

13. Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

14. Other: _____

STATUS OF CLAIMS

15. The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 28,30-32,34-35,39-46,48-49 and 53-62.
 Claim(s) withdrawn from consideration: _____

/CHRISTOPHER A FLORY/ Primary Examiner, Art Unit 3792	
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