## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIME WIRE & CABLE, INC.	)	
	)	
Petitioner,	)	
	)	
<b>v.</b>	)	Case: IPR2018-01592
	)	Patent No.: 9,320,122
CANTIGNY LIGHTING	)	
CONTROL, LLC.	)	<b>EXHIBIT 1012</b>
	)	
Patent owner	)	
	)	
JASCO PRODUCTS, INC.	)	
	)	
Licansoa	,	





## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/822,295	11/27/2017	John Joseph King	CEIC401D4	7414
62081 7590 03/26/2018 THE LAW OFFICE OF JOHN J. KING, P.C.			EXAMINER	
P.O. BOX 1555 WHEATON, IL 60187-1555		TRAN, ANH Q		
			ART UNIT	PAPER NUMBER
			2844	
			NOTIFICATION DATE	DELIVERY MODE
			03/26/2018	ELECTRONIC

### 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):

JOHN.KING@JKINGLAWOFFICE.COM



	15/822,295		KING, JOHN JOSEPH	
Office Action Summary	Examiner ANH TRAN	Art Unit 2844	AIA (First Inventor to File) Status Yes	
The MAILING DATE of this communication a Period for Reply	appears on the cover sheet wit	th the corresponder	nce address	
A SHORTENED STATUTORY PERIOD FOR REF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory peri  - Failure to reply within the set or extended period for reply will, by sta Any reply received by the Office later than three months after the may earned patent term adjustment. See 37 CFR 1.704(b).	1.136(a). In no event, however, may a re tod will apply and will expire SIX (6) MONT tute, cause the application to become ABA	eply be timely filed FHS from the mailing date of ANDONED (35 U.S.C. § 13	of this communication. 33).	
Status				
1) $\boxtimes$ Responsive to communication(s) filed on $\underline{11}$	1/27/17.			
A declaration(s)/affidavit(s) under 37 CFR				
· , , , , , , , , , , , , , , , , , , ,	his action is non-final.			
3) An election was made by the applicant in re		ement set forth duri	ing the interview on	
the restriction requirement and elect	· ·			
4) Since this application is in condition for allow	wance except for formal matte	ers, prosecution as	to the merits is	
closed in accordance with the practice unde	er <i>Ex parte Quayle</i> , 1935 C.D.	. 11, 453 O.G. 213.		
Disposition of Claims*				
5) Claim(s) 1-20 is/are pending in the application 5a) Of the above claim(s) is/are with defended for the above claim(s) is/are with defended for claim(s) is/are allowed.  7) Claim(s) 1-20 is/are rejected.  8) Claim(s) is/are objected to.  9) Claim(s) are subject to restriction and allowed for the corresponding articipating intellectual property office for the corresponding articipating intellectual property office for the corresponding articipation intellectual property office for the corresponding articipation intellectual property office for the corresponding articipation property office for the corresponding articipation intellectual property office for the corresponding articipation are articipa	d/or election requirement. e eligible to benefit from the Pate g application. For more information end an inquiry to PPHfeedback@ iner. ☐ accepted or b) ☐ objected the drawing(s) be held in abeyand	on, please see ouspto.gov.  o by the Examiner. ce. See 37 CFR 1.85	5(a).	
Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreith Certified copies:  a) All b) Some** c) None of the:  1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority document application from the International Burest See the attached detailed Office action for a list of the certified copies.	ents have been received. ents have been received in A priority documents have been eau (PCT Rule 17.2(a)).	pplication No		
ttachment(s)				
Notice of References Cited (PTO-892)	3) Interview S	ummary (PTO-413)		
∖	Paper No(s	)/Mail Date		



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1. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

#### **DETAILED ACTION**

## Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, 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, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination under the first inventor to file



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provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(I)(1) - 706.02(I)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-l.jsp.

2. Claims 1, 8-9, 14-15, and 20 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-2, 7, 8, 14-17, and 20 of U.S. Patent No. 9,320,122. Although the claims at issue are not identical, they are not patentably distinct from each other because the claim recitations are merely reworded to recite the same limitation in different language and some of the limitations have been grouped in a slightly different manner but still overall set forth the same limitations. All the recited elements and limitations are found in claims 1-2, 7, 8, 14-17, and 20 of U.S. Patent No. 9,320,122.



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