

# EXHIBIT 1008(A)



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

Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, MAIL DATE, DELIVERY MODE. Includes application details for Amar LULLA and examiner NIELSEN, THOR B.

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.



The present application is being examined under the pre-AIA first to invent provisions.

### **DETAILED ACTION**

The instant application was filed on March 15, 2016.

A Preliminary Amendment was filed on October 27, 2017, in which claim 23 was amended to correct a typographical error.

Claims 1-30 are pending and under examination.

The instant claims duplicate those filed in application 14/661700 (now abandoned). All claims of application 14/661700 were allowed after:

- (1) the Applicant filed five Declarations, by Dr. Malhotra dated 09/23/2010, by Mr. Copra dated 12/08/2011, by Dr. Rajan dated 08/16/2011, by Dr. Maus dated 08/16/2011, and by Dr. Malhotra dated 09/23/2010; and
- (2) the Applicant filed Disclaimers of patent term over US Patent Nos. 8,168,620 and 8,163,723, and over Application serial No. 14/661,720 which subsequently issued as US Patent No. 9,259,928.

### ***Rejection of all Claims***

All pending claims are rejected for reasons of record in the parental applications, especially 10/518,016. In brief, the instant claims are rejected under 35 USC 102 as anticipated by, or in the alternative under 35 USC 103 as obvious over the disclosure of Cramer (EP 0780127) (of record), optionally further in view of Modi (US 6,294,153) (of

Art Unit: 1616

record), Malmqvist-Granlund et al. (US 6,391,340) (of record), and/or Alfonso et al. (US 6,017,963) (of record). The explanation of disclosures of the prior art and rationales for combining the disclosures of references as stated in examinations of US applications No. 10/518,016; 12/879515; 14/661700; and 14/661720 are incorporated in this action by reference.

Furthermore, all pending claims are rejected for obviousness type double patenting as explained below.

### ***Double Patenting***

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 claims at issue 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); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.