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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 17/002,933 | 08/26/2020 | Teodoro A. Mesa | 40039-146001 | 1026 |

69713 7590 06/29/2023

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| EXAMINER | |
|---|---|
| SAHNI, VISHAL R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3657 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/29/2023 | 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):

INFO@ORPATENT.COM

| Office Action Summary | Application No. 17/002,933 | Applicant(s) Mesa et al. | |
|---|---|---|---|
| | Examiner VISHAL R SAHNI | Art Unit 3657 | AIA (FITF) Status Yes |

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

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☑ Responsive to communication(s) filed on 08/26/20.

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

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

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims***

5) ☑ Claim(s) 1-8 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☑ Claim(s) 1-8 is/are rejected.

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

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

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov.**

**Application Papers**

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

11)☑ The drawing(s) filed on 08/26/20 is/are: a)☑ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

**Priority under 35 U.S.C. § 119**

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

**Certified copies:**

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☑ Notice of References Cited (PTO-892)

2) ☑ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date 03/02/22.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

4) ☐ Other: _____.

**DETAILED ACTION**

This is a first Non-Final Office Action on the merit sin response to the application filed 08/26/20. This application claims domestic priority to a divisional application filed 08/27/19. Claims 1-8 are currently pending, yet all are rejected as detailed below. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

***Claim Rejections - 35 USC § 112***

The following is a quotation of 35 U.S.C. 112(b):
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5 and 7-8 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor (or for applications subject to pre-AIA 35 U.S.C. 112, the applicant), regards as the invention.

Claims 2-5 and 7-8 are rejected because claim 2 recites that the second dimensions of the first and second protuberances are "commensurate with the first dimension." See claim 2, lines 3-4. What does it mean for dimensions to be "commensurate" with each other? Are they similar, equal, substantially equal, or something else?

Claim 5 is rejected because it recites that the third and fourth protuberances are "diametrically opposed" but then subsequently states that they are "angularly spaced by 90 degrees." See claim 5, lines 2, 3. Which one is it – 180 degrees or 90 degrees apart?

Claim 8 is rejected because it recites "a first inner passage," but this term was previously defined in claim 1, from which this claim depends. See claim 8, line 2. This double inclusion is improper and confusing.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

**REJECTION #1: *Reeves***

Claim(s) 1 is/are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Reeves (U.S. Patent No. 6,561,931). Reeves is directed to a joint for facilitating fabrication of collapsible assemblies. See Abstract.

Claim 1: Reeves discloses an apparatus [Figs. 6, 7] for use with a frame protection system, the apparatus comprising: a coupler (601) including a first inner passage (portion of 601 that receives 503) having a first longitudinal axis and a second inner passage (portion of 601 that receives 501) having a second longitudinal axis transverse to the first longitudinal axis; and a shock absorber (505) [see col. 5, line 59 – col. 6, line 5] sized and configured to be received within the first inner passage and the second inner passage of the coupler. See Figs. 6, 7.

**REJECTION #2: *Ghosh***

Claim(s) 1 and 6 is/are rejected under 35 U.S.C. 102(a)(1) as being anticipated by Ghosh (U.S. Patent Pub. No. 2006/0193687). Ghosh is directed to a moment resisting frame bearing connector. See Abstract.

Claim 1: Ghosh discloses an apparatus [Figs. 1, 4A-4C, 6A] for use with a frame protection system, the apparatus comprising: a coupler (100, 400, 600) including a first inner passage having a first longitudinal axis and a second inner passage having a second longitudinal axis transverse to the first longitudinal axis; and a shock absorber (420, 620, 630) [para. 0048] sized and configured to be received within the first inner passage and the second inner passage of the coupler. See Figs. 1, 4A-4C, 6A.

Claim 6: Ghosh discloses that the shock absorber includes a first shock absorbing member sized and configured to be received within the first inner passage and a second shock absorbing member sized and configured to be received within the second inner passage. See Figs. 4A-4C, 6A.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**REJECTION #1: *Reeves in view of Koellner***

Claim(s) 2-5 and 7-8 is/are rejected under 35 U.S.C. 103 as being unpatentable over Reeves in view of Koellner (U.S. Patent Pub. No. 2002/0164208). Koellner is directed to a connecting element for connecting two tubes or for closing an end of a tube. See Abstract.

Claim 2: Reeves is relied upon as in claim 1 above but does not disclose that the shock absorber has "protuberances." Koellner also discloses a cylindrical L-shaped shock absorber (2) used to connect two cylindrical frame members (10), wherein the shock absorber includes a first protuberance and a second protuberance, the first protuberance and the second protuberance each having a second dimension commensurate with the first dimension. See Figs. 1, 4A, 5, 10; para. 0017, 0043, 0045. It

would have been obvious to a person having ordinary skill in the art at the effective filing date of the invention to use the Koellner elastomeric L-shaped shock absorber as the connecting element in the Reeves apparatus with a reasonable expectation of success because this is an alternate connecting means with certain design advantages, namely, that the protuberances allow for ease in installation and removal because of the presence of slots therebetween.

Claim 3: Koellner discloses that the first protuberance and the second protuberance are arcuate in shape, the first dimension is a first diameter and the second dimension is a second diameter. See Figs. 4A, 10.

Claim 4: Koellner discloses that the first protuberance and the second protuberance are diametrically opposed. See Figs. 4A, 10.

Claim 5: Koellner discloses a third protuberance and a fourth protuberance, diametrically opposed from the third protuberance, the third protuberance and fourth protuberance angularly spaced by 90 degrees, respectively. See Fig. 4A.

Claim 7: Reeves discloses that the first inner passage and the second inner passage are defined by a first cylindrical section and a second cylindrical section, respectively. See Figs. 6, 7.

Claim 8: Koellner discloses that the first protuberance and the second protuberance are angularly spaced by a first inner passage and the second inner passage are defined by a first cylindrical section and a second cylindrical section, respectively, the first cylindrical section and the second cylindrical section together forming an L-shaped coupler. See Figs. 1, 4A, 5, 10.

**REJECTION #1: *Reeves in view of Ghosh***

Claim(s) 6 is/are rejected under 35 U.S.C. 103 as being unpatentable over Reeves in view of Ghosh.

Claim 6: Reeves is relied upon as in claim 1 above but does not disclose that the shock absorber is composed of two "members." Ghosh discloses that the shock absorber (620, 420) includes a first

shock absorbing member sized and configured to be received within the first inner passage and a second shock absorbing member sized and configured to be received within the second inner passage. See Figs. 4A-4C, 6A. It would have been obvious to a person having ordinary skill in the art at the effective filing date of the invention to modify Reeves such that the hose is composed of use two members like in Ghosh because this is merely a design choice, based on cost/availability of parts, and ability to replace parts as well. The option to provide two separate shock absorbers rather than a single one is a design choice, but ultimately achieves the same function of damping frame parts that are transversely oriented.

**REJECTION #2: *Ghosh in view of Koellner***

Claim(s) 2-5 and 7-8 is/are rejected under 35 U.S.C. 103 as being unpatentable over Reeves in view of Koellner.

Claim 2: Ghosh is relied upon as in claim 1 above but does not disclose that the shock absorber has "protuberances." Koellner also discloses that the shock absorber (2) includes a first protuberance and a second protuberance, the first protuberance and the second protuberance each having a second dimension commensurate with the first dimension. See Figs. 1, 4A, 5, 10; para. 0017, 0043, 0045. It would have been obvious to a person having ordinary skill in the art at the effective filing date of the invention to use the Koellner elastomeric shock absorber as the connecting element in the Ghosh apparatus with a reasonable expectation of success because this is an alternate connecting means with certain design advantages, namely, that the protuberances allow for ease in installation and removal because of the presence of slots therebetween. In addition, Ghosh already contemplates a "protrusion" in the sense that plates/spring 620/630 extend radially inward from the walls of the inners passages.

Claim 3: Koellner discloses that the first protuberance and the second protuberance are arcuate in shape, the first dimension is a first diameter and the second dimension is a second diameter. See Figs. 4A, 10.

Claim 4: Koellner discloses that the first protuberance and the second protuberance are diametrically opposed. See Figs. 4A, 10.

Claim 5: Koellner discloses a third protuberance and a fourth protuberance, diametrically opposed from the third protuberance, the third protuberance and fourth protuberance angularly spaced by 90 degrees, respectively. See Fig. 4A.

Claim 7: Ghosh discloses that the first inner passage and the second inner passage are defined by a first cylindrical section and a second cylindrical section, respectively. See para. 0036 ("rounded"), 0038.

Claim 8: Koellner discloses that the first protuberance and the second protuberance are angularly spaced by a first inner passage and the second inner passage are defined by a first cylindrical section and a second cylindrical section, respectively, the first cylindrical section and the second cylindrical section together forming an L-shaped coupler. See Figs. 1, 4A, 5, 10.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL R SAHNI whose telephone number is (571)270-3838. The examiner can normally be reached M-F 7am-3pm PST.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Primary Examiner
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June 24, 2023