

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

PRIME WIRE & CABLE, INC.)
)
Petitioner,)
)
v.)
)
CANTIGNY LIGHTING)
CONTROL, LLC.)
)
Patent owner)
)
JASCO PRODUCTS, INC.)
)
Licensee)

**Case: IPR2018-01592
Patent No.: 9,320,122**

EXHIBIT 1012



UNITED STATES PATENT AND TRADEMARK OFFICE

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| 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 | EXAMINER | |
| THE LAW OFFICE OF JOHN J. KING, P.C. P.O. BOX 1555 WHEATON, IL 60187-1555 | | | TRAN, ANH Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2844 | |
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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.

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JOHN.KING@JKINGLAWOFFICE.COM

Art Unit: 2844

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(l)(1) - 706.02(l)(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-I.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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