Office Action Summary	Application No. 15/003,472	Applicant(s) STEARNS ET AL.	
	Examiner Beth Stephan	Art Unit 3633	AIA (First Inventor to File) Status No

-- 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 *1/21/2016*.

☐ 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) *1-20* 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5a) Of the above claim(s) _____ is/are withdrawn from consideration.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) *1-20* 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 *1/21/2016* 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 _____.

3) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *5/24/2016* .

4) ☐ Other: _____.

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

DETAILED ACTION

This is a non-final First Office Action on the Merits in application 15/003,472, filed 1/21/2015, which is a continuation as stated in the specification.

Claims 1-20 are pending and examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

> (a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-11 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of

the claimed invention. The claimed element "the washer includes … a second metallic portion" is not in the originally filed specification and is new matter.

> 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 1-8 and 12-20 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 pre-AIA the applicant regards as the invention.

In claims 1 and 12, line 4, "first surface adjacent the substrate" is not clear if the substrate is part of the claimed invention or not since in lines 1-2 the substrate was functionally claimed. By inserting "configured to be located" before "adjacent" or similar language the rejection would be overcome.

In claims 1 and 12, line 6, "projection extending away from the substrate" is not clear if the substrate is part of the claimed invention or not since in lines 1-2 the substrate was functionally claimed. By inserting "configured for" before "extending" or similar language the rejection would be overcome.

In claim 12, line 15, "that abuts the substrate" is not clear if the substrate is part of the claimed invention or not since in lines 1-2 the substrate was functionally claimed. By changing "that abuts" to "for abutting" the rejection would be overcome.

Other similar phrases in the claims not specified should be changed as well.

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

Claim Rejections - 35 USC § 103

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

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 9 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Bellem(4,348,846) in view of Garska(U.S. Pat. Appl. Publ. 2004/0251707).

Bellam discloses a method of mounting a roof mount assembly(50, see Figs. 3 and 4) to a roof(10), the roof including at least one rafter(12) and a substrate(20, 30) at least partially covering the at least one rafter, the method comprising:

a flashing(80) and a bracket(130) positioned on the roof such that the flashing is positioned between the roof and the bracket(see Figs. 3 and 4);

a fastener(90) extended through the flashing and the bracket and into the at least one rafter(see Fig. 4);

a washer(92, see column 34, lines 22-27) between a portion of the fastener and the bracket(see Figs. 3 and 4), wherein the washer includes a first portion and a second metallic portion(see column 3, lines 22-27 where the washer is described as a deformable material considered the first portion and a steel like material being the second portion and considered metallic);

the flashing, the bracket, and the washer retained on the roof with the fastener(see Fig. 4); and

compressing the first polymeric portion of the washer against a surface of the bracket with the fastener(see column 3, lines 24-33, the deformable material produces an outward bulge which is considered made by compression of the first portion of the washer).

Bellam lacks the first portion specifically a polymeric material, and the first portion specifically forming a seal inhibiting fluid flow.

Applicant's disclosure lends no criticality to the specific use of a polymeric material for the first portion of the washer(see paragraph [00132], "the washer can be a polymeric")

Garska discloses a washer of a compressible polymeric material.

It would have been obvious for one having ordinary skill in the art at the time of the invention to have provided the specific compressible material of the washer, such as polymeric, given the intended use of the washer and the specific design requirements thereof. The polymeric material of the washer of Garska is considered to provide the function of sealing the opening meeting the functional claim limitation.

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).

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 a nonstatutory double patenting ground provided the reference application or patent either is shown to be commonly owned with this 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 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/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 http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 1-8 and 12-20 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-14 and 22-39 of U.S. Patent No. 8,153,700. Although the claims at issue are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a roof mounting system or method having the same limitations.

Claims 1-8 and 12-20 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1, 3-10 and 13-21 of U.S. Patent No. 8,209,914. Although the claims at issue are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a roof mounting system or method having the same limitations.

Claims 1-4, 6, and 12-20 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 8,146,299.

Although the claims at issue are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a roof mounting system or method having the same limitations.

Claims 1-8 and 12-20 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-20 of copending Application No. 13/813,199 (reference application). Although the claims at issue are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a roof mounting system or method having the same limitations.

This is a provisional nonstatutory double patenting rejection because the patentably indistinct claims have not in fact been patented.

Claims 9-11 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-14 and 22-39 of U.S. Patent No. 8,153,700 in view of Bellam and Garska(as discussed above). 8,153,700 discloses the roof mounting system having a flashing, bracket, roof, fastener, substrate, rafter, and washer but lacks the specific materials of the washer. Bellam and Garska disclose the washer as claimed as discussed above.

It would have been obvious for one having ordinary skill in the art at the time of the invention to have substituted the washer of 8,153,700 with the washer of Bellam and Garska, given that the simple substitution of one known element for another would obtain the predictable results of the sealing of the system resulting in the method as claimed.

Claims 9-11 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1, 3-10 and 13-21 of U.S. Patent No. 8,209,914 in view of Bellam and Garska(as discussed above). 8,209,914 discloses the roof mounting system having a flashing, bracket, roof, fastener, substrate, rafter, and washer but lacks the specific materials of the washer. Bellam and Garska disclose the washer as claimed as discussed above.

It would have been obvious for one having ordinary skill in the art at the time of the invention to have substituted the washer of 8,209,914 with the washer of Bellam and Garska, given that the simple substitution of one known element for another would obtain the predictable results of the sealing of the system resulting in the method as claimed.

Claims 9-11 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 8,146,299 in view of Bellam and Garska(as discussed above). 8,146,299 discloses the roof mounting system having a flashing, bracket, roof, fastener, substrate, rafter, and washer but lacks the specific materials of the washer. Bellam and Garska disclose the washer as claimed as discussed above.

It would have been obvious for one having ordinary skill in the art at the time of the invention to have substituted the washer of 8,146,299 with the washer of Bellam and Garska, given that the simple substitution of one known element for another would obtain the predictable results of the sealing of the system resulting in the method as claimed.

Claims 9-11 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-20 of copending Application No. 14/813,199 in view of Bellam and Garska. 14/813,199 discloses the roof mounting system having a flashing, bracket, roof, fastener, substrate, rafter, and washer but lacks the specific materials of the washer. Bellam and Garska disclose the washer as claimed as discussed above.

It would have been obvious for one having ordinary skill in the art at the time of the invention to have substituted the washer of 14/813,199 with the washer of Bellam and Garska, given that the simple substitution of one known element for another would obtain the predictable results of the sealing of the system resulting in the method as claimed.

This is a provisional nonstatutory double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Stephan whose telephone number is (571)272-1851. The examiner can normally be reached on Mon thru Fri 9:00 am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6754. 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.

/Beth A. Stephan/
Primary Examiner, AU 3633