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16/274,164	02/12/2019	Michael Miskin	53998.14US05	8373

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HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue
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Dallas, TX 75219

EXAMINER

HAMMOND, CRYSTAL L

ART UNIT	PAPER NUMBER
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2844

NOTIFICATION DATE	DELIVERY MODE
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06/27/2019

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):

ipdocketing@haynesboone.com

DETAILED ACTION

Notice of Pre-AIA or AIA Status

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

Applicant is required to cancel the new matter in the reply to this Office Action.

1. 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.

2. **Claims 1-15 and 18-21** 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. **No amendment shall introduce new mater.**

Examiner can not find any of the newly added subject matter of Claims 1-5, 6-10, 13-15 and 18-21. There is no mention in the original disclosure of a driver, coatings on the LEDs, the LEDs being different sizes, the LEDs being on an insulated substrate the LEDs being coupled to a driver with a 12V output, or a dimmer switch.

Claim Rejections - 35 USC § 103

3. 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.

4. 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, 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 negated by the manner in which the invention was made.

5. **Claims 11 and 17** is is/are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Colby (US 7,748,887) in view of Li et al. (US 2005/0168156).

(1) regarding Claim 11:

Colby discloses a first LED circuit and at least one additional LED circuit (configuration of light source 620 in Fig 7E and Fig 6A), each of the first LED circuit and the at least one additional LED circuits including at least two LEDs connected in series or parallel (706A and 706B in Fig 7E); and a switch (1215 in Fig 12) wherein switching of the switch is selectable by a user to independently switch on or off at least one of the first LED circuit or the at least one additional LED circuit (Col 3 lines 43-49, 55-64 and Col 8 lines 22-25), wherein the LED lighting device is configured to connect to an AC voltage power source (Col 3 lines 55-64).

However, Colby does not disclose the package.

Li, in the same field of endeavor, discloses:

wherein the first LED circuit, the at least one additional LED circuit, and the switch are integrated within or onto an LED package ([0005]-decorative string lights have everything integrated withing the one package).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of Li into the system of Colby in order to achieve better lighting control as taught by Li.

(2) regarding Claim 17:

Colby discloses an LED lighting device comprising:

a first operating LED circuit and at least one additional LED circuit (configuration of light source 620 in Fig 7E and Fig 6A), wherein at least one of the first operating LED circuit or the at least one additional LED circuit includes at least two LEDs connected in either series or parallel (706A and 706B in Fig 7E); and

a switch (1215 in Fig 12) capable of switching the at least one additional LED circuit on or off (Col 3 lines 43-49, 55-64 and Col 8 lines 22-25), wherein switching of the at least one additional LED circuit is selectable by a user switching the switch (Col 3 lines 55-64 see Fig 12); and

wherein the LED lighting device is configured to connect to an AC mains power source (Col 3 lines 55-64).

However, Colby does not disclose the heat sink.

Li, in the same field of endeavor, discloses:

wherein the first operating LED circuit and the at least one additional LED circuit are mounted on a substrate including a heat sink ([0032]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features of Li into the system of Colby in order to achieve better forward voltage drops as taught by Li.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

7. Applicant's arguments with respect to claims 1-15 have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRYSTAL L HAMMOND whose telephone number is (571)270-1682. The examiner can normally be reached on M-F 12pm-4pm Alt Fridays.

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, Alexander Taningco can be reached on 571-272-8048. 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.

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/CRYSTAL L HAMMOND/
Primary Examiner, Art Unit 2844