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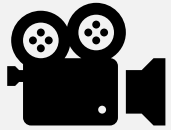

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Thomas Marlow

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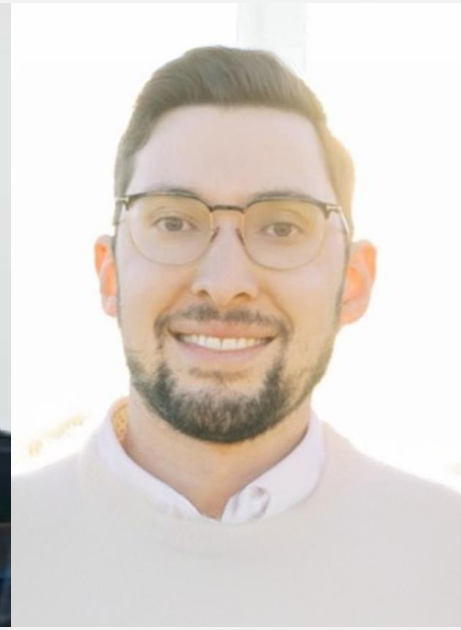

Mike Crivaro

Business Development Director

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Training and Development Support Specialist

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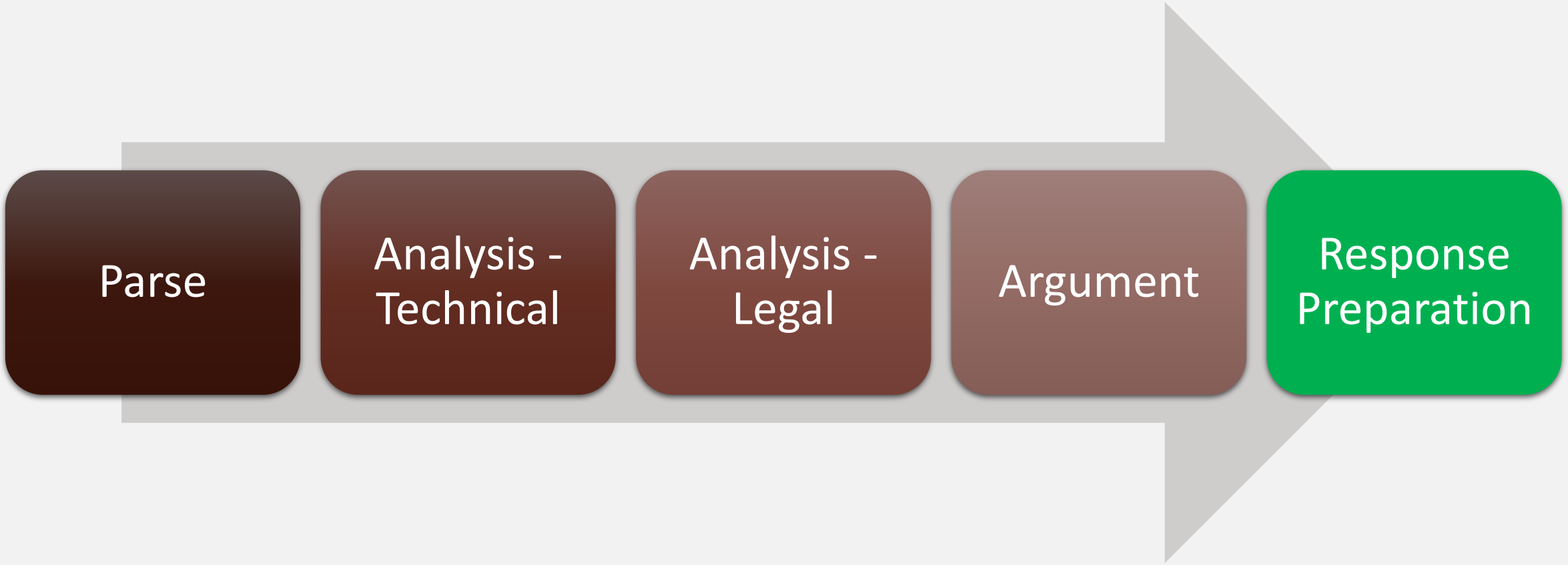
Guided Skills & Tools

Prosecution

Guided Skills – Office Action Analysis & Response



Guided Skills – Parsing

- Rejection
- Claims

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Search

SYSTEMS, METHODS, A...

SYSTEMS, METHODS, AND USER INTERFACES IN A PATENT MANAGEMENT SYSTEM - September 16, 2022

Navigation

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- File History (1)
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- Matter Data

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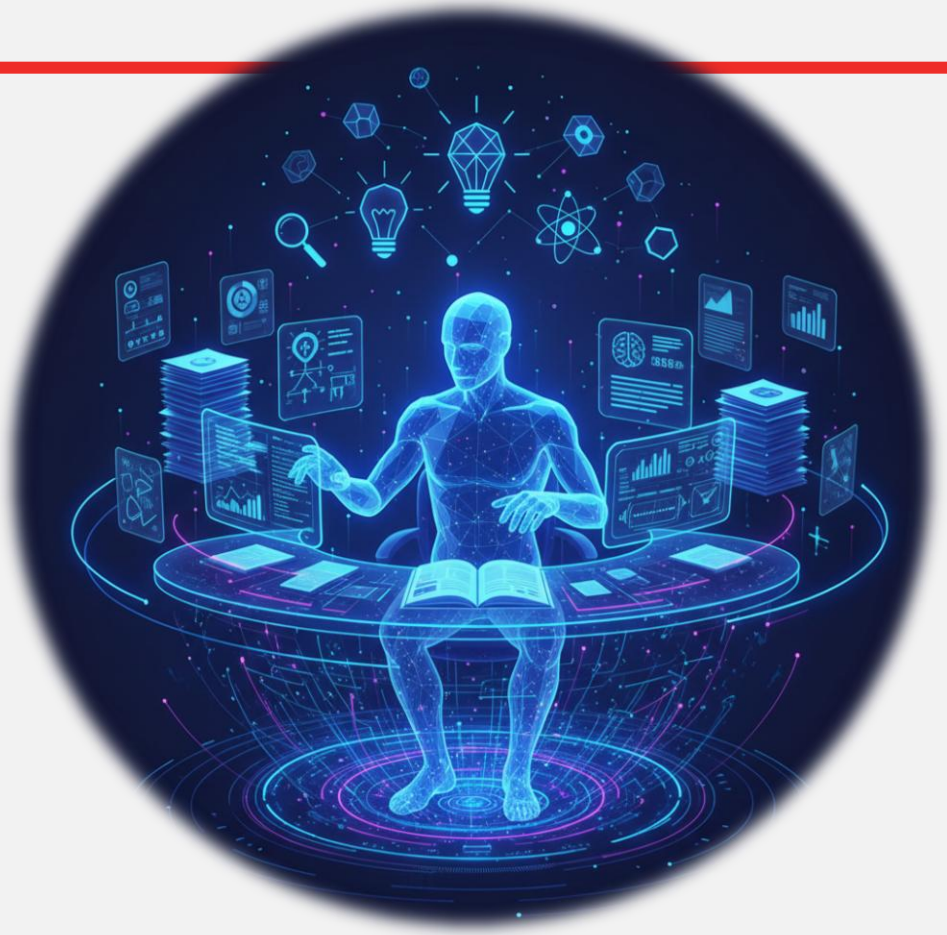
Guided Skills – Examiner's Position

- Technical/Factual Analysis



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FH | Refs | DR | Shells

SYSTEMS, METHODS, A...

Navigation

- AI Docs
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- File History (1)
  - 17/946,759
- Docketing
- Matter Data

SYSTEMS, METHODS, AND USER INTERFACES IN A PATENT MANAGE...

Inventors: Thomas Marlow, Mark Stignani, William Kalweit
Docket#: 3431.046US2
Filed: September 16, 2022
Status:

USPTO | Ref Count Cited by Applicant: 22

Application Biblio XML

Filter Applied: Key Events

December 1, 2025
Outgoing

CTNF | Non-Final Rejection
PDF DOCX XML

September 18, 2025
Incoming

REM | Applicant Arguments/Remarks Made in an Amendment
PDF XML

CLM | Claims
PDF XML

June 18, 2025
Outgoing

Chat on 2...

Ask Otto- Chat on 2026-02-23 01:31 PM

Guided Skill

Prior Art Rejection Status

WITHDRAWN - Examiner withdrew all prior art rejections

Reason: "In light of the allowance of related case # 15/183093, and in light of the originally filed disclosure the prior art cited in the related case does not read on the claim limitations"

Previously Cited References (NO LONGER APPLIED):

- Holt et al. (US 2015/0121185)
- Van Luchene et al. (US 2007/0219853)
- Van Luchene et al. (US 2007/0220041)
- Biernacki (US 2004/0181427)
- Tran (US 2005/0210009)
- Lemley et al. NPL reference
- WO 2013061152 A2

Summary of Rejection Grounds

Ground	Statute	Claims	Status
Written Description	§ 112(a)	2-21	**ACTIVE**
Indefiniteness	§ 112(b)	2-21	**ACTIVE**
Abstract Idea	§ 101	2-21	**ACTIVE**
Prior Art	§ 102/103	N/A	**WITHDRAWN**

NOTE: Examiner states 101 and 103 rejections not overcome despite withdrawal because amended claims remain abstract and indefinite.

Total Attachments : 2

A/N 17946759 : 2 files

Guided Skill - Analyze Rejection and Generate Proposed Response

Message

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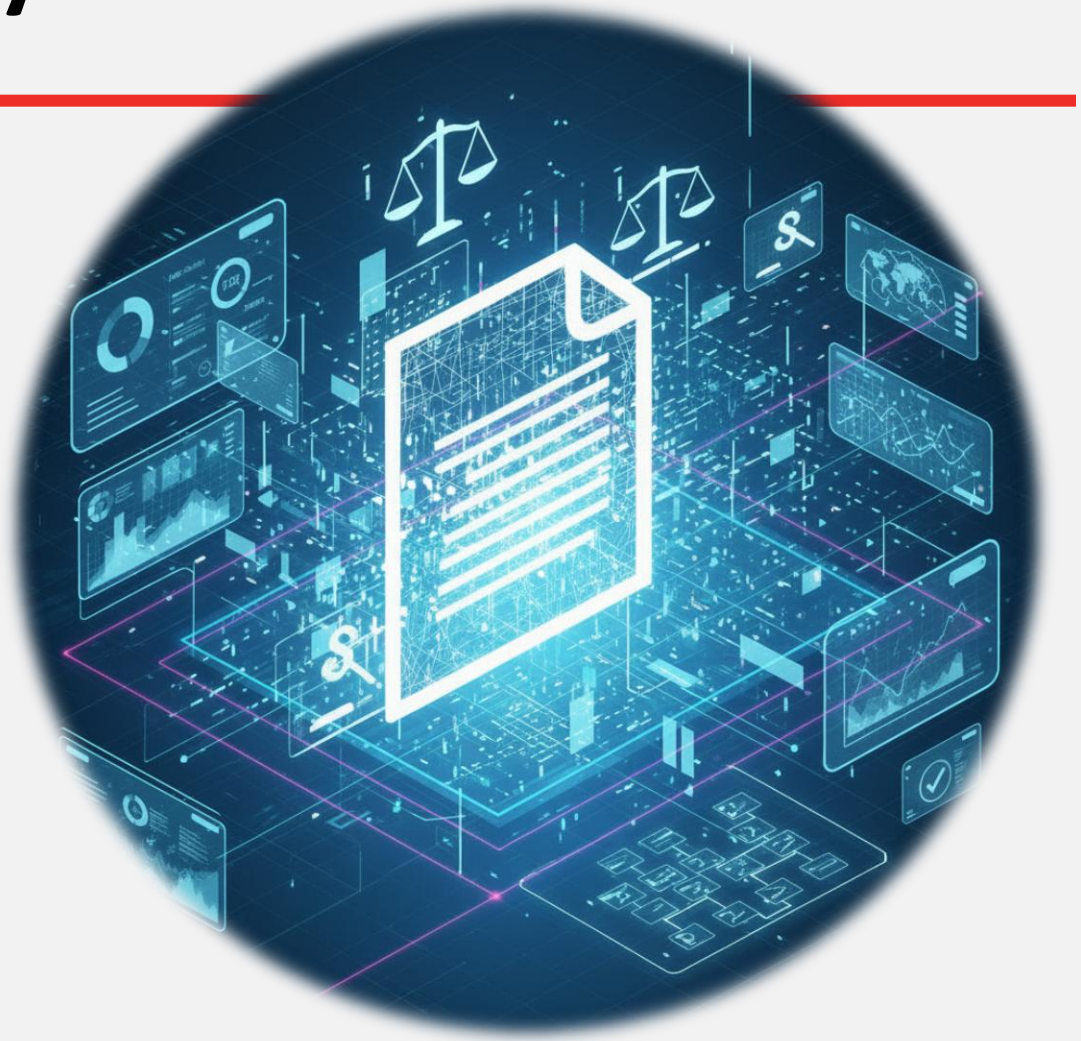
Guided Skills – Legal Analysis



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SYSTEMS, METHODS, A...

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PDF DOCX XML

Inventors	Reference Counts	Title	Actions
Holt, Christopher L. et al.	1	US-20150121185	
Van Luchene, Andrew S. et al.	2	US-20070219853	
Van Luchene, Andrew S. et al.	1	US-20070220041	
Biernacki, J V et al.	2	US-20040181427	
Tran, Bao	2	US-20050210009	
		Examiner Characteristics and Patent Office Outcomes. The	

Chat on 2...

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Guided Skill

2. ✗ **Undefined "predetermined retry limit"**
   - What determines it?
   - How is it reached?
   - What is its value?
3. ✗ **Unclear process**
   - How OCR and normalization combine
   - What "structured experience and prosecution data" means specifically

---

EXAMINER'S ACCURACY SUMMARY

Rejection Type	Examiner's Position	Accuracy	Strength
§ 112(a) - Written Description	Retry/fail/limit not described; OCR+normalization combination not described	✓ ACCURATE	STRONG
§ 112(b) - Indefiniteness	OR logic ambiguous; predetermined retry limit undefined; process unclear	✓ ACCURATE	STRONG
§ 101 - Abstract Idea	Organizing human activity; no significantly more	✓ LARGELY ACCURATE	STRONG
§ 101 - Generic Components	Processor, memory, API, database, UI are generic	✓ ACCURATE	STRONG
§ 101 - No Technological Improvement	No improvement to computer or technology	✓ ACCURATE	MODERATE-STRONG

Overall Assessment: Examiner's rejections are well-founded and will be difficult to overcome without claim amendments or significant arguments distinguishing from cited case law.

Total Attachments : 2

A/N 17946759 : 2 files

Guided Skill - Analyze Rejection and Generate Proposed Response

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Guided Skills – Argument Generation

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FH | Refs | DR | Shells

SYSTEMS, METHODS, A...

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Tran, Bao	2	US-20050210009	
		Examiner Characteristics and Patent Office Outcomes. The	

Chat on 2...

Ask Otto- Chat on 2026-02-23 01:31 PM

Guided Skill

Quality of Reasoning:

✓ **Specific, not conclusory:** Examiner didn't just say "abstract" - provided detailed element-by-element analysis

✓ **Evidence-based:** Cited record evidence (claim language, specification paragraphs)

✓ **Responsive to amendments:** Addressed newly-added limitations (retry, OCR+normalization, delta rendering)

✓ **Balanced:** Acknowledged prior art withdrawal but explained why remaining rejections stand

---

CONCLUSION ON LEGAL SUFFICIENCY

All three grounds of rejection are legally sufficient and well-reasoned.

The Examiner has:

1. Properly applied relevant legal standards
2. Provided adequate evidence and reasoning
3. Met initial burden of establishing prima facie case
4. Given Applicant sufficient information to respond

Burden has shifted to Applicant to show error in Examiner's analysis or amend claims to overcome rejections.

Recommended path forward will depend on:

- Whether Applicant can amend claims to add specific technical details
- Whether specification contains support for more specific claim language
- Whether Applicant can provide evidence of technological improvement
- Whether strategic considerations favor continued prosecution vs. appeal

Total Attachments : 2

A/N 17946759 : 2 files

Guided Skill - Analyze Rejection and Generate Proposed Response

Expand

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Docketing Workflow – Document Generation

Details

Status and Objections

Application Number: 13/944,871

Executive Summary

Office Action Response Strategy

Application No.: 13/944,871 | Docket: MD5001US01 | Mailing Date: 7/14/2015

I. CRITICAL ISSUES REQUIRING IMMEDIATE ATTENTION

A. Claim Status

Seven claims (5, 7, 11-14, 19, 20) have been **withdrawn** as non-elected species. All examined claims (1-4, 6, 8-10, 15-18) face **35 USC § 103 obviousness rejections** over Gradman in view of Walker. See Summary for complete claim listing.

B. Formal Objections

Drawing Objections: Reference characters 102A and 104B appear in drawings but are absent from specification description (37 CFR 1.84(p)(5) violation).

Specification Objections:

- Paragraph [0041]: Element mislabeled as 200 (should be 500)

- Paragraph [0052]: Tail depression 1106 incorrectly labeled as 1108

These formal matters require straightforward corrections but must be addressed to avoid prosecution delays.

II. SUBSTANTIVE REJECTION ANALYSIS

Rejection Summary

II. SUBSTANTIVE REJECTION ANALYSIS

A. Examiner's Core Theory

The Examiner's obviousness rejection follows a consistent pattern across all claims:

1. **Gradman** provides the basic two-board snow gliding structure with upturned noses and tails

2. **Walker** teaches a single ski with lower tail shovel height than nose shovel height

3. **Combination rationale:** Modifying Gradman's boards with Walker's differential shovel heights would "increase rearward stability to the user for improved balance"

For detailed rejection breakdown, see Office Action Analysis.

B. Critical Weaknesses in Examiner's Position

1. Structural Mismatch Between References

- **Walker** discloses a **single, continuous ski** for one foot

- **Gradman** discloses a **two-board system** with independent boards for each foot

- The Examiner provides **no technical explanation** for why a POSITA would apply Walker's single-ski design principle to create the specific **inter-board** shovel height relationship claimed (rear board nose higher than front board tail)

2. Insufficient Motivation to Combine

The Examiner's stated motivation—"increase rearward stability"—is conclusory and unsupported. Walker's stated purpose for differential shovel heights is to "permit the ski to go backwards," not to improve stability in a dual-board configuration. The references operate in fundamentally different mechanical contexts with different weight distribution and balance dynamics.

3. Deficient Analysis of Dependent Claims

Argument Recommendations

Caselaw

III. RECOMMENDED RESPONSE STRATEGY

A. Primary Technical Arguments

Argument 1 - Improper Combination (Conservative/Aggressive): The proposed modification lacks rational underpinning because Walker's single-ski teaching does not suggest applying differential heights to create the claimed inter-board relationship. Applying Walker to each board independently would not achieve the claimed invention. See Technical Arguments for full development.

Argument 2 - Lack of Motivation: The Examiner's "rearward stability" rationale is unsupported and contradicted by Walker's actual stated purpose. The operational dynamics of a single ski versus a breakboard system are fundamentally different, and no teaching suggests the desirability of this specific modification.

Argument 3 - Insufficient Dependent Claim Analysis: The "bodily incorporation" and "normal operation" rationale is legally deficient. These specific structural and functional relationships are not inherent consequences of the proposed combination.

B. Caselaw Support

In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990): "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." Apply to challenge the unsupported assertion that Walker's single-ski design would suggest modification of Gradman's dual-board system.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 421 (2007): Challenge hindsight reconstruction where the Examiner appears to have worked backward from the claims without identifying teaching, suggestion, or motivation in the prior art.

In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006): "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning." Apply to the "well-known technique" and "bodily incorporation" assertions.

Strategy

Action Items

C. Tone Selection

Conservative Approach Recommended If: This is the first substantive action, the Examiner relationship is productive, or budget favors avoiding appeal. Maintains collaborative tone while presenting technical distinctions.

Aggressive Approach Recommended If: This is a Final Action, prior cooperation failed, or building an appeal record is necessary. Forcefully establishes Examiner error and creates strong appellate foundation.

See Technical Arguments for side-by-side comparison of both approaches with specific trade-offs.

IV. IMMEDIATE ACTION ITEMS

1. **Correct Formal Objections:** Amend specification paragraphs [0041] and [0052]; add reference characters 102A and 104B to specification description

2. **Verify Prior Art:** Obtain complete Gradman (US 2011/0079986) and Walker (US 2006/0097484) patents to verify Examiner's figure citations and teachings

3. **Select Response Tone:** Choose conservative or aggressive approach based on prosecution history and strategic goals

4. **Consider Amendments:** Evaluate whether claim amendments could strengthen position (see Suggested Amendments)

5. **Response Deadline:** Calculate deadline from 7/14/2015 mailing date and calendar preparation time

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V. CONCLUSION

Email Template

Client Summary Email

Subject: Office Action Summary - Application No. 13/944,871 (Docket No. MD5001US01)

Dear Client,

We have received an Office Action dated July 14, 2015, for Application No. 13/944,871 (Docket No. MD5001US01). Twelve claims (1, 2, 3, 4, 6, 8, 9, 10, 15, 16, 17, and 18) were rejected, while the remaining claims were not rejected. There were objections to the drawings and specification. The rejections rely on 103 obviousness grounds.

We are currently reviewing the Office Action and preparing a response strategy. This includes analyzing options to counter the examiner's arguments and evaluating whether amendments may be appropriate.

Please let us know if you have any questions or would like to discuss this matter further.

Best regards,

Detailed Analysis

2. Specific Elements or Teachings from Gradman Being Cited

The examiner cites Gradman for disclosing:

- **Structural components**: First and second boards with gliding surfaces, top surfaces, bases, noses, and tails (Figures 1A and 1A-4)
  - **Shovel features**: Upturned portions at noses and tails rising above gliding surfaces (Figures 1A-4)
  - **Dimensional axes**: First and second major axes and minor axes defining direction of travel and rider foot placement (Figures 1A-4)
  - **Binding hardware**: First and second binding mounting hardware exposed through central areas of top surfaces (Figure 1A)
  - **Board geometry**: Sidecuts defining front hips, rear hips, and waists; noses and tails with shovel heights (Figures 1A-4)
  - **Board positioning**: Configuration with second board positioned adjacent first board with second nose nearest first tail (Figures 1A-4)
  - **Riding orientation**: Sideways riding configuration on snow (Figures 1A-4)

3. How the Examiner Connects the Reference to Claim Language

The examiner uses a **"explicit disclosure" versus "implicit disclosure" framework**:

For elements Gradman explicitly discloses, the examiner directly maps claim language to specific figures and paragraphs. For example:
- Claim 1's "first board having a first major axis, and a first minor axis" → Gradman Figures 1A-4
- Claim 6's "binding mounting hardware" → Gradman Figure 1A
- Claim 4's axes defining "direction of travel" and "rider foot placement" → Gradman Figures 1A-4

For elements Gradman does not explicitly disclose, the examiner acknowledges the gap but argues it would be obvious to combine Gradman with Walker. The examiner states Gradman "does not explicitly disclose" limitations such as:
- Second shovel height being greater than first shovel height (Claim 1)

Strengths and Weaknesses

bindings are "secured" to boards without specifying central area exposure or mounting hardware details.

4. Strengths and weaknesses of the examiner's use of this reference

Strengths:

- Gradman does disclose a two-board personal transportation device for snow
- The basic board geometry (nose, tail, side edges) is present
- The general concept of boards positioned adjacent to each other is disclosed

Weaknesses:

- **Critical gap**: The provided reference content does not support the detailed "shovel height" claims central to the examiner's rejections
- **Missing figure**: Reliance on "Fig. 1A-4" which is not provided makes verification impossible
- **Dimension mismatch**: The reference discusses plan-view geometry; the claims require vertical dimension relationships
- **Speculative interpretation**: The examiner infers three-dimensional features from what appears to be two-dimensional description
- **Incomplete disclosure**: For Claims 2, 3, 8, 16-18, the examiner acknowledges Gradman does not disclose the claimed limitations and relies on obviousness arguments rather than direct disclosure
- **Vague references**: The examiner cites "Fig. 1A-4" without clarification of what this notation means or whether it exists

Recommendation: The actual Gradman patent document should be obtained and reviewed, particularly to verify the existence and content of "Fig. 1A-4" and to determine whether the reference actually discloses the vertical/shovel height features the examiner claims.

Argument Suggestions

CLAIMS 1, 8, AND 15

Respectful Traversal of the Rejection

Applicant respectfully traverses the rejection of Claims 1, 8, and 15 and submits that the cited combination of Gradman and Walker fails to teach or suggest the claimed invention.

Deficiencies in the Prima Facie Case

The Examiner acknowledges that Gradman does not explicitly disclose the specific shovel height relationships recited in the claims. The Examiner proposes modifying Gradman using Walker's teaching of lower tail shovel heights than nose shovel heights to achieve "increased rearward stability to the user for improved balance."

However, the proposed modification is based on an improper combination that would render the Gradman device unsuitable for its intended purpose. Gradman discloses a two-piece snow gliding system where both boards are independently controlled by the user. The proposed modification would require applying Walker's single-ski shovel height relationship to **both boards** in Gradman's two-board system, which would result in:

11. The front board having a lower tail than nose
    2. The rear board having a lower tail than nose

This configuration would not achieve the claimed invention, which specifically requires the **second (rear) board nose shovel height to be greater than the first (front) board tail shovel height**—a cross-board relationship not taught or suggested by applying Walker's single-board teaching to each board independently.

Lack of Motivation to Combine

Walker teaches shovel height manipulation for a **single, continuous ski** to achieve stability for a single rider position. Gradman teaches a **two-piece system** where the boards operate in tandem with specific spatial relationships. The Examiner has not established a reasonable basis for why a person of ordinary skill in the art would apply Walker's single-ski design principle to create the specific **inter-board** shovel height relationship claimed, particularly

Amendment Suggestions

Suggested Amendment:

1. A snow gliding system comprising: a first board having a first major axis, and a first minor axis, the first board comprising: a first base including a first gliding surface; a first top surface opposite the first base; a first nose including an upturned portion of the first top surface and the first base; a first tail opposite the first nose along the first major axis, the first tail including an upturned portion of the first top surface and the first base, the first tail rising above the first gliding surface to a first shovel height; **a first core positioned between the first base and the first top surface, above the first gliding surface, but not extending into the first nose or the first tail;** and a second board having a second major axis, and a second minor axis, the second board comprising: a second base including a second gliding surface; a second top surface opposite the second base; a second nose including an upturned portion of the second top surface and the second base, the second nose rising above the second gliding surface to a second shovel height, the second shovel height being greater than the first shovel height; a second tail opposite the second nose along the second major axis, the second tail including an upturned portion of the second top surface and the second base**; a second core positioned between the second base and the second top surface, above the second gliding surface, but not extending into the second nose or the second tail**.

Rationale:

This amendment adds specific structural limitations regarding the core placement that creates flexible nose and tail regions while providing rigidity in the central portion. Under In re McNeil-PPC, Inc., 574 F.3d 1393 (Fed. Cir. 2009) (Case ID: ebfd94dc8c77), the prior art references must provide evidence of the specific structural characteristics claimed. Neither Gradman nor Walker teaches or suggests a core structure that specifically excludes the nose and tail regions to create differential flexibility. This structural feature is critical to the improved mobility of the claimed system and provides a clear distinction from the prior art.

Specification Support:

Claim 7 recites: 'further comprising a first core positioned between the first base and the first top surface, above the first gliding surface, but not extending into the first nose or the

Questions?

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