

The "Pertinence of Each Reference, If Not Apparent, must Be Clearly Explained" in a Rejection of Claims in an Office Action

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The thesis of this article is that practitioners can require examiner's to comply with the rule requirements to clearly explain the basis of a rejection in an office action.

Language is an imperfect tool, and people are imperfect. Consequently, the statements in office actions explaining the basis for a rejection of a claim are sometimes vague. If the examiner will not or cannot clarify the rejection, the applicant is faced with the daunting task of either correcting their claim to avoid the rejection or traversing the rejection without really knowing the basis for the rejection. Sometimes that applicant can obtain sufficient clarity by speaking with the examiner.

However, an examiner issuance of an office action is considered a procedural matter and therefore is *petitionable*.² Moreover, the rules required that an office action clearly state the pertinence of each reference for each rejected claim. Specifically, that requirement is specified by rule 1.104(c)(2). This rule reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. ***The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.***

Some clarity was provided on the limitations on office actions imposed by 37 CFR 1.104(c)(2) in the "Decision on Petition to Invoke Supervisory Authority under 37 Cfr §1.181" dated 11/12/2009, in application 09/776,714, regarding the requirement to clearly state the pertinence of each reference for each rejected claim.

That petition decision was in response to a petition to have an office action withdrawn for failure to comply with rule 1.104(c). The petition asserted the following facts, relevant here:

4. The office action dated 11/18/2008, in the paragraph spanning pages 3 and 4, identifies the basis for rejection under 35 USC 102 of some 36 claims (claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65) solely as:

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss [sic] teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3).

5. The paragraph spanning pages 3 and 4 in the office action dated 11/18/2008 fails to specifically correlate any disclosure in the reference, Swix, to any claim.

6. The limitations purportedly addressed in the foregoing passage correspond generally to those in independent claim 1.

7. The limitations purportedly addressed in the foregoing passage fail to correspond to limitations in many of the other claims identified in the first paragraph of the foregoing passage.

The decision on petition noted the following as relevant facts:

A review of the file reveals that several Office actions employing the prior art reference Swix et al. (US 6,718,551) iii a 35 USC 102 rejection were issued. The first, a non-final rejection, was issued on June 8, 2004, followed by a final rejection on January 7, 2005, then an Examiner's Answer on December 14, 2007, and then a non-final rejection, mailed November 18, 2008. ... Petitioner requests withdrawal of the Office action mailed November 18, 2008 for failure to comply with both 37 C.F.R. 1.104(c)(I) and (c)(2).

The decision on petition then provided the following analysis applying rule 1.104(c)(2) to the facts:

However, as indicated above and by petitioner, rule 1.104(c)(2) indicates in relevant part that when "a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable", and that the "pertinence of each reference, if not apparent, must be clearly explained".

As noted above, the final rejection of January 7, 2005 provides additional discussion of and citations to Swix on pages 9-10 to support the rejection, as does the Examiner's Answer of December 14, 2007 on pages 10-11. However, the Office action of November 18, 2008 does not include or refer back to this additional content with respect to Swix relied upon by the examiner.

As a result, the pertinence of Swix has not been clearly explained in the November 18, 2008 action as per 37 C.F.R. 1.104(c)(2).

Therefore, the Office action of November 18, 2008 is hereby WITHDRAWN.

Accordingly, the foregoing petition decision stands for the following points. First, dependent claim limitations not addressed in an office action fail the rule 1.104(c)(2) test. Second, discussion of a reference in an earlier office action not expressly included or incorporated by reference into a later office action is not available for meeting the rule 1.104(c)(2) requirements.

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2. Issuance of an office action is an action of an examiner that is not appealable. Therefore, it is petitionable. See 37 CFR 1.181(a) (Petition may be taken to the Director: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, ... which is not subject to appeal to the Patent Trial and Appeal Board or to the court").