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DIYON, J
EXAMINER

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ART UNIT PAPER NUMBER

2411

5

09/26/95

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 2-10-95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- Notice of References Cited by Examiner, PTO-892.
- Notice of Draftsman's Patent Drawing Review, PTO-948.
- Notice of Art Cited by Applicant, PTO-1449.
- Notice of Informal Patent Application, PTO-152.
- Information on How to Effect Drawing Changes, PTO-1474.
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Part II SUMMARY OF ACTION

- Claims 1-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- Claims _____ have been cancelled.
- Claims _____ are allowed.
- Claims 1-12 are rejected.
- Claims _____ are objected to.
- Claims _____ are subject to restriction or election requirement.
- This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- Formal drawings are required in response to this Office action.
- The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).
- The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
- Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
- Since this application appears to be 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.
- Other

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Part III DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims 1-12 have been considered but are deemed to be moot in view of the new grounds of rejection.

Specification

2. The following is a quotation of the first paragraph of 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.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed in the parent applications of this case, fails to provide support for the invention as now claimed. Moreover, the specification is further objected to under this section of the statute because the specification of the instant case fails to provide an adequate written description of the claimed invention.

A) Parent applications fail to provide support for the invention as now claimed.

As stated in the previous Office action, the claims recite "entry path means," "textual search entry path means," "graphics entry path means," "title finder entry

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path means," "means for searching through the entry path means," and "means for searching for and retrieving interrelated textual or graphical information after searching and retrieving the graphical or textual information first," respectively, which are not supported by the previous disclosures from which the applicant is claiming priority.

The applicant has amended the specification of the instant case to correct the continuity of the disclosures. In doing so, the applicant has now stated that the current applicant is a continuation-in-part of the two parent applications. Within the string of continuity, there are several CIP applications. However, the applicant then alleges, in a very confusing manner, that "the instant application is a straight continuation of '115 through '856, '026 and '610, as well as a straight continuation of '283 through '654. Moreover, Patent Number '359 which issued from '525 was fully incorporated by reference into '283." Amdt. A, page 3. The examiner is unsure of what the applicant meant by these statements. The applicant appears to be stating that the instant application is actually a straight continuation of these applications, but the examiner does not understand the reasoning. The instant application cannot be a CIP and a "straight continuation" at the same time.

The applicant went even further in his arguments that the parent applications provide support for the claimed means by providing a chart, Exhibit

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II, which allegedly points out the support for the claimed means in one of the strings of continuity. However, the examiner respectfully asserts that this chart fails to point out specific structural elements in the disclosures of those applications which correspond to the recited means of the instant claims. In fact, the applicant has pointed to, in many of the instances, at least 2 and sometimes up to 6 figures and large portions of the specification which allegedly provide support for each listed means in the claims. The examiner has begun to review the cited figures and portions of specification pointed to by the applicant in the chart, and is unable to determine where the support should be found. The examiner cannot be expected to guess which elements in those figures or the portions of the specification are the intended support for the recited means. If the applicant wants to continue with this argument, then specific elements in the figures and their related description in the specifications should be pointed to so that the examiner can make a determination as to the sufficiency of the alleged support. In response to the chart as it has been submitted, the examiner maintains that the parent cases do not provide support for the above-listed means in the instant claims.

Since the examiner does not see any convincing reason why the parent applicants provide support for the means recited in the instant claims, the objection under this section is maintained for the reasons stated above.

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NOTE: In light of the amendments to the continuity and the arguments relating to the application being a straight continuation, the examiner requests that the applicant explain exactly why the current application has been changed to a CIP. In other words, by doing so, the applicant has admitted that there is disclosure in the current application that did not have support in the parent cases. The examiner would like to know what the applicant considers to be that new disclosure as opposed to that part of the disclosure which finds support in the parent cases.

B) The instant specification fails to provide an adequate written description of the claimed invention.

a) The claims recite "entry path means," "textual search entry path means," "graphics entry path means," and "title finder entry path means," but the specification does not make it clear what these means are. In other words, it is not clear from the description in the specification what the recited means represent structurally. Since there is no mention of an entry path means in the specification in association with any structure which is represented by that recitation, a sufficient description as to the interpretation of these means has not been provided.

For the purposes of advancing prosecution on the case, the examiner has made an attempt to interpret the meanings of these recitations. The examiner

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