

Application No. 12/846,635
Reply Dated June 28, 2012
Reply to Office Action of March 1, 2012

REMARKS:

The Office Action dated March 1, 2012, has been received and carefully reviewed. Reconsideration of the rejection is respectfully requested in view of the amendments to the claims and remarks below.

I. § 102 Rejection

In response to the Examiner's rejection under 102(e) as being anticipated by Work, Applicant respectfully disagrees that Work discloses all of the features of the present invention. Work appears to disclose matching search queries and potential targets of search queries by comparing search criteria with profile criteria describing potential targets. Work discloses using database queries or SQL queries to perform the comparison feature. Work does not disclose providing threshold requirements of the candidate, in fact the only reference within the specification of threshold appears in the background portion when discussing Patent 6,115,709 and a system for constructing a user's knowledge profile. Work does not disclose each and every feature of claims 13-14, 19, 24 -25.

Work appears to disclose utilization of an employee's profile criteria including capabilities, history, values, interests, style, goals, projects, human networks, contacts, profiles of the contacts, employment history, education history, organizational activities, organizations, profiles of the organizations or compensation requirements in data provided by the candidate. Employers (initiators) may search through profiles using the search criteria, including descriptive portions provided by the candidate. However, Work does not disclose utilization of the structured profile criteria provided by the employer related to the candidate being sought as specified in claims

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13-14, 19 and 24-25. Because Work fails to teach each and every limitation of the present invention, Applicant respectfully requests that the 102(e) rejection be removed.

II. § 103 Rejection

Regarding the 103 rejection, Claims, 13-14, 19 and 24-25 are rejected as being unpatentable in light of Work. Applicant respectfully disagrees. Initially, the rejection of record acknowledges that Work “fails to explicitly disclose these claimed features.” However, the action concludes with the statement that the claimed features are “old and well known” without stating which features are not disclosed or which are old and well known. The rejection fails to adequately support or specify the basis for the rejection and therefore it is an improper rejection under 103. Which claimed features are taught and not taught by Work is not disclosed by the examiner and which features are old and well known or upon whose knowledge is also not disclosed.

These statements, however, do not satisfy the factual inquiry required by *Graham v. John Deere Co.*, 383 U.S. 1 (1966) to make a prima facie case of obviousness. See MPEP Section 2144 (“It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.”) A prima facie case of obviousness cannot be made with conclusory statements that certain limitations are well known in the art, but rather is made with factual support.

If the Examiner's factual findings are based on the Examiner's personal belief of what was well known in the art at the time of the invention, Applicant requests that the Examiner provide an affidavit specifically explaining why the limitations of the amended claims would have

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been known to a person of ordinary skill in the art at the time of invention. See 37 CFR Section 1.104(d)(2) ("When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by Applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of Applicant and other persons.") Should the Examiner rely on a personal affidavit to satisfy his burden under *Graham*, Applicant requests that any rejections based on the Examiner's personal knowledge be made non-final so that Applicant may have opportunity to adequately address Examiner's affidavit. See MPEP Section 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that Applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.").

Without waiving the request for a proper rejection, for the same reasons as previously indicated, Work fails to teach either singly or in combination the utilization of the structured profile criteria provided by the employer related to the candidate being sought as specified in claims 13-14, 19 and 24-25 and therefore the 103 rejection is improper.

Claims 18, 21-23 and 26-31 are rejected as being unpatentable over Work in view of Kurzius (6,385,620). Again, Work does not disclose either singly or in combination with Kurzius the utilization of the threshold requirement or structured profile criteria provided by the employer related to the candidate being sought.

Kurzius discloses a system for matching job descriptions with candidate profiles and for enabling employers to search candidate profiles for suitable employees or enabling candidates to

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search for suitable job descriptions. Kurzius receives information based upon a candidate survey which is provided by a candidate or from candidate data from third party sources. The term “threshold” occurs in only one paragraph in Kurzius: at column 24 lines 10-20 which refers to the third party sources which may be used to obtain additional candidate data. In that case, the data is obtained from sources other than the employer itself. Because Work does not disclose or suggest the limitations of Claim 12, including threshold requirement or storing the candidate attributes in a structured format, it does not either alone or in combination with Kurzius render claim 12, 21 or 29 unpatentable nor the remaining claims which depend therefrom.

The Examiner is invited to contact applicant's attorney at the telephone number listed below in the event that prosecution of this application can be expedited thereby.

Respectfully submitted,

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Application No. 12/846,635
Reply Dated December 22, 2011
Reply to Office Action of November 10, 2011

REMARKS:

The Advisory Action dated November 10, 2011, has been received and carefully reviewed. Reconsideration and modification of the requirement for restriction is respectfully requested in view of the remarks below.

I. § 121 Restriction Requirement

In response to the Examiner's restriction requirement, Applicant respectfully disagrees that the requirement of restriction appropriately groups the claims. The Examiner has grouped the claims into five categories: (I) 1-11; (II) 12-28; (III) 29-34; (IV) 35-48; and (V) 49-60. Applicant suggests grouping the claims as follows: (I) 1-11; (II) 12-20; (III) 21-34; and (IV) 35-60.

Based upon MPEP § 802.01, the Director may require restriction if two or more "independent and distinct" inventions are claimed in one application. See also 35 U.S.C. § 121. According to MPEP § 802.01, Independent means unrelated. Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design, operation, or effect. MPEP § 802.01(II).

This application includes six independent claims (1, 12, 21, 29, 35, and 49). Generally stated, all six independent claims are related to methods for matching employee candidates with job opportunities of prospective employers.

The MPEP provides authority for the examiner to group together species in a patent application, when plural species exist, if the species are patentably distinct.

Applicant believes that several of these species may be related in design, operation or effect. Therefore, Applicant suggests modifying the restriction requirement to group the claims as

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