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MEMORANDUM

DATE: January 24, 2007

TO: Technology Center Directors

FROM: John J. Love
Deputy Commissioner
For Patent Examination Policy

SUBJECT: **Clarification of Second Action Final Rejection Practice with Respect to Claims Drafted Using Alternative Language**

This memorandum clarifies certain aspects of second action final rejection practice. Under current policy as set forth in the Manual of Patent Examining Procedure (MPEP) 706.07(a), a second or any subsequent Office action on the merits may be made be final unless the Office action contains a new ground of rejection that is: (1) not necessitated by applicant's amendment of the claims; or (2) not based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP 706.07(a) also specifies that a second or any subsequent action on the merits should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

In the context of claims drafted using alternative language (*e.g.*, so-called "Markush" claims written in an alternative form as permitted by *Ex parte Markush*, 1925 Dec. Comm'r Pat. 126 (1924)), MPEP 803.02 explains the propriety of making a second action final rejection when the applicant has been required to make a provisional election of a species, and in reply to an Office action has amended a rejected "Markush" claim to exclude species anticipated or rendered obvious by the prior art. However, where an election of species requirement has not been made, or where a claim that sets forth alternatives was rejected only on non-prior art grounds, the USPTO has not set forth a clear line of demarcation between a proper final rejection necessitated by an applicant's amendment and an improper final rejection of a claim amended to include limitations which reasonably should have been expected to be claimed. This has lead to some confusion as to when a second action on the rejected claims can be made final in such situations where applicant amends a claim to exclude unpatentable alternatives. MPEP 803.02 will be revised to clarify that, whether or not an examiner requires a provisional election of species, if a "Markush" claim or other claim that sets forth alternatives is rejected under 35 U.S.C. 102 or 103 on the basis of prior art that anticipates or renders obvious the claim with respect to any one of the alternatives, or on any other basis (*e.g.*, 35 U.S.C. 101 or 112) with respect to any one of the alternatives, a second or any subsequent Office action on the merits may be made be final, unless the Office action contains a new ground of rejection that is: (1) not necessitated by applicant's amendment of the claims (including amendment of a claim to eliminate unpatentable alternatives); or (2) not based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). However, an Office action containing a rejection of one or more claims on a prior art basis (35 U.S.C. 102 or 103) should not be made final if the prior Office action did not also contain a

rejection of such claim or claims on a prior art basis, except where the claim or claims could not have been rejected on a prior art basis in the prior Office action (*e.g.*, the claim was incomprehensible or has been amended to be broader in scope).

The provision in MPEP 904.02 that a search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed does not preclude an examiner from making the second or any subsequent Office action on the merits final if the Office action contains a new ground of rejection that was necessitated solely by applicant's amendment of the claims to eliminate an unpatentable alternative. An examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (*e.g.*, where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph).