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90/015,262	07/27/2023	8719101	ADN101	9031

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HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

EXAMINER

CAMPBELL, JOSHUA D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/015,262 .

PATENT UNDER REEXAMINATION 8719101 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/015,262	Patent Under Reexamination 8719101	
	Examiner JOSHUA D CAMPBELL	Art Unit 3992	AIA (FITF) Status No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 07/27/2023 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

Decision on Request

1) A substantial new question (SNQ) of patentability affecting claims 1 and 4 of United States Patent Number 8,719,101 (hereinafter “ ‘101 Patent”) is raised by the request for *ex parte* reexamination filed 23 July 2023.

35 USC 325(d)

2) A review of the post grant history for the underlying patent indicates that there have been no other Office post grant challenges made to the patent (Reexamination Proceedings or Inter Partes Review, Post Grant Review, Covered Business Method trials). Accordingly, a discretionary denial of reexamination pursuant to 35 USC 325(d) is not applicable.

Information Disclosure Statement

3) Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action.

See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner) in compliance with the

requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

Affidavits, Declarations, or Other Written Evidence

4) The Examiner recognizes that declaration by Loren Terveen (Exhibit 1003) has been referenced in support of Third Party Requester. The declaration has been considered and made of record. The Examiner further notes that affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination (see: MPEP 2258(I)(E)), but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications. In the instant case, the submitted Terveen Declaration at least further explains the contents of the prior art patents and printed publications in more detail.

Prior art cited in the Request

5) The present request indicates that the Requester considers that a substantial new question of patentability is raised as to claims 1 and 4 of the '101 Patent by the following references:

- a. **Meyer** – International Publication No. WO 99/46708
- b. **Herrmann** – U.S. Patent No. 7,406,508
- c. **Teague** – U.S. Patent Application Publication No. 2006/0212355
- d. **Merriman** – U.S. Patent Application Publication No. 2005/0038702

Prosecution History

6) The '101 Patent application was assigned serial number 12/731,973 (hereinafter "'973 application"), filed March 25, 2010. During the original prosecution, the '973 application was initially filed with claims 1-17. The '973 application had priority to provisional application 61/163,132, filed March 25, 2009.

In a first action mailed April 6, 2012, the examiner rejected all claims under 35 U.S.C. § 112, second paragraph, as being vague and failing to particularly point out and distinctively claim the subject matter which the applicant regards as the invention. Additionally, the examiner rejected all claims over Dustin et al. in view of Caughey.

In response the patent owner filed an amendment on July 5, 2012, amending claims 1, 5, 6, 9, 13, and 14, cancelling claim 17, and adding new claims 18-21.

In response to this amendment the examiner mailed a notice of non-compliance based on the premise that new claims 18-21 were directed to an invention that was distinct from the originally claimed invention. Thus, based on the received action on the merits claims 1-16 were constructively elected by original presentation.

In response the patent owner filed an amendment on October 25, 2012, amending claims 1, 5, 6, 9, 13, and 14, cancelling claims 3, 11, and 17, and adding new claims 18-21.

In response to this amendment the examiner mailed a Requirement for Restriction/Election, effectively restricting the claims into two groups (group 1 – claims 1, 2, 4-10, and 12-16; group 2 – claims 18-21).

On April 2, 2013, patent owner properly elected group 2 (claims 18-21) with traverse.

The examiner mailed a Final Rejection on June 4, 2013, rejected claims 18-21 under 35 U.S.C. § 112, second paragraph, as being vague and failing to particularly point out and distinctively claim the subject matter which the applicant regards as the invention. Additionally, the examiner rejected all claims over Elliot et al. in view of Crespo et al.

In response to the Final Rejection, patent owner filed a Notice of Appeal along with a Pre-Appeal Brief Conference Request. Patent owner argued the following regarding the rejection in over Elliot et al. in view of Crespo et al.:

First, Applicants respectfully submit that, even when combined, the portions of Elliot and Crespo cited by the Examiner at least fail to disclose “determining, in response to the receiving the indication, whether an identifier containing unique identifying information about the recipient is present on the computing device,” and subsequently performing alternate method steps based on the determination, as recited in claim 18. In more detail, the Examiner acknowledges that Elliot fails to disclose this limitation but asserts that Fig. 7 and its associated disclosure in Crespo does, and that it would be obvious to modify Elliot in view of Crespo. However, Applicants respectfully submit that Fig. 7 of Crespo also fails to disclose “determining, in response to the receiving the indication, whether an identifier containing unique identifying information about the recipient is present on the computing device,” as recited in claim 18. In that regard, paragraph [0075] of Crespo explains that in Fig. 7, it is determined “whether an anonymous email address exists for the received customer ID and merchant ID.” This determination is distinctly different than the claimed determination because (i) the former seeks to determine the existence of anonymous information about a customer, whereas the latter seeks to determine the existence of unique identifying information about a recipient. Moreover, Crespo’s determination requires that identifying information about a customer (e.g., customer ID) already be known, whereas the claimed determination seeks to determine whether unique identifying information about a recipient exists at all.

Additionally, claim 18 recites the performance of alternate method steps based on the determination of whether identifying information about a recipient is present on the recipient’s computing device. Elliot and Crespo, even when combined, fail to disclose performing every method step recited in the decision tree of claim 18. For example, none of the portions of Elliot or Crespo cited by the Examiner disclose “causing a text field to be displayed in at least a portion of the advertisement” when identifying information about a recipient is not present on the recipient’s computing device. Although Crespo discloses that a customer may enter an email address into a field on a checkout confirmation page (Fig. 10), this field is (i) not displayed in a portion of an advertisement and (ii) is not displayed in response to a determination that identifying information is not present on a recipient’s computing device. Accordingly, even when combined, Elliot and Crespo fail to disclose all of the recited features of the claims.

In response to the Pre-Appeal Brief, the Office issued a Pre-Appeal Conference decision withdrawing the rejections of the claims and reopening prosecution.

The examiner cancelled the non-elected claims and passed claims 18-21 (renumbered to patent claims 1-4) to allowance. The examiner gave the following reasons for allowance:

The following is an examiner's statement of reasons for allowance.

The Applicant's remarks/arguments dated 04 October 2013 regarding claim rejections over Elliot et al. US Publication 2006/0149630 in view of Crespo et al. US Publication 2011/0246593 deemed as the closest prior art of record, are persuasive and are incorporated by reference herein as the reasons for allowance of claims 18 – 21.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

(Notice of Allowance mailed January 8, 2014 in the '973 application)

Thus, as it currently stands based on the prosecution history of the '973 application, it appears that the claims of the '973 Patent were allowed and confirmed at least in part based on the following limitations:

determining, in response to the receiving the indication, whether an identifier containing unique identifying information about the recipient is present on the computing device;
if the identifier containing unique identifying information about the recipient is not present on the computing device:
causing a text field to be displayed in at least a portion of the advertisement; receiving contact information inputted into the text field by the recipient;

(patent claim 1)

Priority

7) As mentioned above, the '973 application has priority to provisional application 61/163,132, filed March 25, 2009.

Substantial New Question of Patentability

8) The italicized sections of claim 1 are utilized by the examiner to show how specific teachings of the proposed references create a substantial new question of patentability.

1. A method of online advertising, comprising:

providing an advertisement associated with a first party for display in a network

communication delivered to a computing device of a recipient during a browsing session,

wherein the advertisement contains an interactive element displayed within the

advertisement, and wherein the network communication is associated with a second party

different than the first party;

receiving an indication that the recipient activated the interactive element displayed within

the advertisement;

determining, in response to the receiving the indication, whether an identifier containing

unique identifying information about the recipient is present on the computing device;

if the identifier containing unique identifying information about the recipient is not present on

the computing device:

causing a text field to be displayed in at least a portion of the advertisement; receiving

contact information inputted into the text field by the recipient;

generating a user profile associated with the recipient based on the contact information;

and

causing an identifier associated with the user profile to be stored on the computing device

of the recipient; and

if the identifier containing unique identifying information about the recipient is present on the computing device;

retrieving a user profile associated with the recipient from a visitor information database using at least a portion of the identifier, wherein the user profile comprises at least delivery method preferences and demographic information;

retrieving additional information associated with the advertisement based on at least a portion of the user profile associated with the recipient;

delivering the additional information to the recipient based on the delivery method preferences, the delivering being performed without interrupting the browsing session of the recipient; and

recording the activation by the recipient of the interactive element as recipient tracking data in an analytics server, the recipient tracking data being associated with the unique identifying information about the recipient.

Meyer in view of Herrmann and/or Teague

- 9) The Request shows that Meyer in view of Herrmann and/or Teague provides teachings relevant to the determination of patentability regarding the following limitations for claim 1:

determining, in response to the receiving the indication, whether an identifier containing unique identifying information about the recipient is present on the computing device;

Meyer describes looking for the presence of a cookie in the consumer computer in response to the consumer clicking on the incentive icon (page 46, line 19-page 47, line 30 and page 48, line 10-page 49, line 2 of Meyer). Meyer discloses the cookie contains a member-ID that can be use to access the consumer profile of the identified member (page 48, line 10-page 49, line 2; page 58, line 5-9; and page 62, lines 11-15 of Meyer).

if the identifier containing unique identifying information about the recipient is not present on the computing device:

Meyer describes steps to take when it is determined that the cookie is not present in order to obtain information about the consumer and sign-up the consumer for a membership (page 48, line 10-page 49, line 2 and page 49, lines 1-28 of Meyer).

causing a text field to be displayed in at least a portion of the advertisement; receiving contact information inputted into the text field by the recipient;

Meyer describes steps to take when it is determined that the cookie is not present in order to obtain information about the consumer and sign-up the consumer for a membership (page 48, line 10-page 49, line 2 and page 49, lines 1-28 of Meyer), more specifically Meyer describes a pop-up screen with text fields is displayed to collect information from the consumer (page 49, lines 1-18 and Figs. 22-24 of Meyer).

Herrmann describes a web page including an advertisement and input area, which may be for the user to enter an email address (column 3, lines 39-49 and column 5, lines 28-30 of Herrmann). Herrmann describes that the input area may be separate from the advertisement or may be overlapped with and displayed as a part of the advertisement (column 3, lines 43-45 of Herrmann).

The Meyer, Herrmann, and Teague references were not previously discussed by the examiner nor applied to claims 1 and 4 in the prior examination of the '101 Patent as discussed above.

It is agreed that Meyer in view of Herrmann and/or Teague raises a substantial new question of patentability with respect to claims 1 and 4 of the '101 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, Meyer in view of Herrmann and/or Teague raises a substantial new question of patentability with respect to claims 1 and 4 of the '101 Patent, a question which has not been decided in a

previous examination of the '101 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '101 Patent.

Teague in view of Merriman and/or Herrmann

10) The Request shows that Teague in view of Merriman and/or Herrmann provides teachings relevant to the determination of patentability regarding the following limitations for claim 1:

determining, in response to the receiving the indication, whether an identifier containing unique identifying information about the recipient is present on the computing device;

Merriman describes a system for displaying advertisements to a user during a browsing session, including determining if a cookie or other identifier was detected on the user's computer when the user clicks on an advertisement (paragraphs [0017]-[0020] and [0027] of Merriman).

if the identifier containing unique identifying information about the recipient is not present on the computing device:

Merriman describes a system for displaying advertisements to a user during a browsing session, including determining if a cookie or other identifier was detected on the user's computer when the user clicks on an advertisement (paragraphs [0017]-[0020] and [0027] of Merriman). Merriman describes that if no cookie is detected then a new user has clicked on the advertisement (paragraph [0027] of Merriman). Merriman also describes storing a cookie on a new user's computing device for future identification (paragraph [0027] of Merriman).

Teague describes a process for signing up a new user in order to obtain information about the consumer (paragraph [0041] of Teague).

causing a text field to be displayed in at least a portion of the advertisement; receiving contact information inputted into the text field by the recipient;

Merriman describes a system for displaying advertisements to a user during a browsing session, including determining if a cookie or other identifier was detected on the user's computer when the user clicks on an advertisement (paragraphs [0017]-[0020] and [0027] of Merriman). Merriman describes that if no cookie is detected then a new user has clicked on the advertisement (paragraph [0027] of Merriman). Merriman also describes storing a cookie on a new user's computing device for future identification (paragraph [0027] of Merriman).

Teague describes a process for signing up a new user in order to obtain information about the consumer (paragraph [0041] of Teague).

Herrmann describes a web page including an advertisement and input area, which may be for the user to enter an email address (column 3, lines 39-49 and column 5, lines 28-30 of Herrmann). Herrmann describes that the input area may be separate from the advertisement or may be overlapped with and displayed as a part of the advertisement (column 3, lines 43-45 of Herrmann).

The Teague, Merriman, and Herrmann references were not previously discussed by the examiner nor applied to claims 1 and 4 in the prior examination of the '101 Patent as discussed above.

It is agreed that Teague in view of Merriman and/Herrmann raises a substantial new question of patentability with respect to claims 1 and 4 of the '101 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, Teague in view of Merriman and/Herrmann raises a substantial new question of patentability with respect to claims 1 and 4 of the '101 Patent, a question which has not been decided in a previous examination of the '101 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '101 Patent.

Scope of Reexamination

- 11) Claim 1 and 4 will be reexamined as requested.
- 12) Claims 2 and 3 are not subject to reexamination.

Conclusion

13) Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,719,101 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/JOSHUA D CAMPBELL/
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