

Remarks

Reconsideration and withdrawal of the reexamination findings in the above-identified patent reexamination are respectfully requested in view of the remarks presented herein.

Rejection Under pre-AIA 35 U.S.C. § 103(a)

The Office Action rejects claims 1 and 4 of U.S. Patent No. 8,719,101 (the “’101 Patent”) under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Meyer (International Publication No. WO 99/46708) (herein “Meyer”), in view of Herrmann (U.S. Patent No. 7,406,508) (herein “Herrmann”), further in view of Teague (U.S. Patent Application Publication No. 2006/0212355) (herein “Teague”).

Applicant respectfully traverses this rejection and requests reconsideration for the following reasons.

I. THE OFFICE ACTION MISCONSTRUES MEYERS

Patent Owner respectfully submits that the Office Action misconstrues the disclosure of Meyer because Meyer is not directed toward a method of online advertising to an online recipient but rather to a method of distributing incentives to members of a membership organization. Therefore, Meyer fails to disclose a “method of online advertising, comprising: providing an advertisement associated with a first party for display in a network communication.”

A. MEYER IS DIRECTED TOWARD REDEEMING INCENTIVES, NOT ADVERTISING

Patent Owner respectfully submits Meyer is directed toward “redemption and clearing of promotional incentives,” not advertising. Meyer, p. 1, ln. 12-13. Meyer’s disclosure fails to disclose providing an advertisement to a consumer but instead provides only an incentive template.” Meyer, p. 33, ln. 14-15. When describing its method for distributing incentives, Meyer is silent with respect to advertising.

A method is described for **distributing incentives over a network**, which preferably is the Internet. Examples of incentives include, without limitation, **discount coupons, sweepstakes**, frequent flier program mileage, promotional points, premiums, free samples, and product tie-ins. The incentives reside on an incentive database coupled to an incentive information computer connected to the network. Each incentive has an **incentive template describing a set of parameters of the incentive, including a value**. An incentive also may include an **“incentive existence message,”** preferably including an audiovisual or graphical incentive

icon, for example in the form of HTML of an incentive icon. Meyer p. 10, ln. 12-19.

Additionally, Meyer describes a member as “a consumer that has joined the incentive service by registering.” Meyer, p. 49, ln. 3-5. The method of Meyer requires the member to sign in, or join the incentive program, *before* information about the member may be retrieved:

Display Requirements. What consumer information (stated interests, demographics, membership in an external membership organization etc.), if any, **must be available before the incentive is displayed to the consumer**. Meyer, p. 35, ln.17-19 (emphasis added).

If the consumer is not a member, Meyer’s method requires creation of a member account before information can be retrieved to display the incentive:

In the implementation described herein, Sign_On causes a sign-on screen to popup on computer 115, the pop-up screen **asking the consumer for membership information**, including the member’s account name and **preferably an e-mail address and a password**.” Meyer, p. 50, ln. 5-8.

Thus, the incentive system of Meyer cannot function without registration into the membership. This is a multi-step process that prevents retrieval of member information until after the consumer has taken proactive steps to joining the membership program.

In contrast, Patent Owner’s system is “a system and method of gathering a recipient’s email address, or other preferred information delivery method, and sending targeted advertisements via this delivery method in response to the recipient’s subsequent requests for information **made through simple interactions** with a banner advertisement **while browsing** the Internet.” ’101 Patent, 1:38-44.

Patent Owner’s system is designed for visitors that do not need a membership of any sort. This is one of the key features of Patent Owner’s method because “while browsing the internet” a visitor may use the system through simple interactions that do not interrupt the visitor’s browsing. Meyer’s requirement of a membership is contrary to the purpose of the ’101 patented method.

Accordingly, the Office Action’s equation of incentives with advertisements is contrary to the disclosure of Meyer and cannot form the basis of a proper rejection. Meyer fails to disclose a method of online advertising and Patent Owner respectfully requests the withdrawal of the rejection under pre-AIA 35 U.S.C. §103(a).

II. MEYER, HERRMANN, AND TEAGUE FAIL TO DISCLOSE THE FEATURES OF PATENT OWNER'S CLAIMS

Patent Owner respectfully submits that the proposed combination of Meyer, Herrmann, and Teague fails to disclose at least one feature of independent claim 1.

A. NONE OF MEYER, HERRMANN, OR TEAGUE DISCLOSE RETRIEVING ADDITIONAL INFORMATION ASSOCIATED WITH THE ADVERTISEMENT BASED ON AT LEAST A PORTION OF THE USER PROFILE ASSOCIATED WITH THE RECIPIENT

Patent Owner's claimed method has its origin in a user seeing an advertisement, and then, activating an interactive element displayed within the advertisement. This indicates that the user had an expressed interest in the advertised product or service. *See* '101 Patent, 3:56-59. The '101 claimed method includes the step of "retrieving additional information associated with the advertisement" based on the user's profile. *Id.* at 9:36-38.

However, Meyer fails to disclose "retrieving additional information *associated with the advertisement* based on at least a portion of the user profile associated with the recipient." In fact, the Office Action is entirely silent with respect to how Meyer allegedly discloses retrieving additional information associated with the advertisement. *See* Office Action, p. 9. This is because Meyer fails to disclose this feature. The Office Action's reliance on Meyer is limited to describing how the display incentive depends on consumer identification. *Id.* But, the Office Action fails to point out how the system of Meyer retrieves *additional information associated with the advertisement*—because it cannot.

Meyer's method fails to retrieve additional information associated with the advertisement. In Meyer, the value of the incentive is computed in step 211 (by process SRVPRVD) and returned to process DISPL, which displays it to the consumer. Meyer, p. 47, ln. 14-15. There is never any transmission of additional information associated with the advertisement by the email or otherwise to the user.

Herrmann cannot remedy this deficiency in Meyer because Herrmann is silent with respect to retrieving additional information associated with *the* advertisement based on at least a portion of the user profile associated with the recipient. Instead, Herrmann describes sending a user relevant advertising information "[b]ased on the captured information." Herrmann, 3:63-66. In Herrmann, the captured information is the user's email address. Herrmann 5:27-30. So, Herrmann fails to

retrieve additional information associated with *the* advertisement because Herrmann follows up with the user based on the user's email address, not based on a particular interest in the advertisement the user interacted with. Accordingly, Herrmann cannot remedy the deficiency in Meyer.

Teague also does not teach the feature of "retrieving additional information associated with the advertisement based on at least a portion of the user profile associated with the recipient." Specifically, in Teague, the sending of information sent to the user is not initiated by the user's interest in a specific advertisement that has been viewed, as is the case in the present invention. Rather, multiple random advertisements *based on the user's profile* may be delivered to the user from CMS 102. Teague, para. [0042] ("CMS 102 searches an offer database for offers that meet either pre-defined user criteria (**from the user's profile**)," emphasis added. Thus, the information delivered to the user in Teague will be numerous diverse pieces of advertising. These randomly selected advertisements have no relationship to the user's interest and are certainly not associated with the advertisement the user initially engaged with.

The teachings of Teague are contrary to the invention claimed in the '101 Patent. In the present invention, the method requires "retrieving additional information *associated with the advertisement*." This is because when a consumer sees a particular advertisement, and then activates an interactive element displayed within the advertisement, the consumer is indicating that he has a defined interest in that particular product or service—not in other random advertisements as taught by Teague.

Thus, the information retrieved in Teague would not be "additional information *associated with the advertisement*." Patent Owner respectfully submits neither Meyer, Herrmann, nor Teague, either alone or in combination, teach or suggest "retrieving additional information *associated with the advertisement* based on at least a portion of the user profile associated with the recipient." Therefore, the Office Action fails to establish a *prima facie* case of obviousness as to claim 1.

Patent Owner respectfully requests that the rejection under pre-AIA 35 U.S.C. §103(a) be withdrawn.

B. THE PROPOSED COMBINATION OF MEYER, HERRMANN, AND TEAGUE FAILS TO DISCLOSE CAUSING A TEXT FIELD TO BE DISPLAYED IN AT LEAST A PORTION OF THE ADVERTISEMENT

The Office Action asserts “Meyer discloses causing a text field to be displayed by disclosing a pop-up screen with text fields is displayed to be filled with consumer information.” Office Action, p. 6. Patent Owner respectfully disagrees because Meyer teaches opening of another Sign-Up Screen (a pop-up window) that includes multiple parameters for redeeming an incentive. Meyer, p. 49, ln. 8-9 (“such a pop-up screen is shown in Fig. 22.”). Meyer’s teachings are contrary to the disclosure and purpose of the ’101 Patent.

Patent Owner’s Claim 1 recites “*causing a text field to be displayed in at least a portion of the advertisement.*” ’101 Patent, 9:20-21. Put differently, this text field is a part of the advertisement object.

In contrast, Meyer does not disclose a text field displayed in the incentive banner itself, but a pop-up window with multiple parameters. *See* Meyer, Fig. 22, below. The pop-up of Meyer is displayed after a user clicks on a link. *See* Meyer Figs. 21 and 22 below. The pop-up Sign-Up Screen of Fig. 22 is a separate window from the incentive.

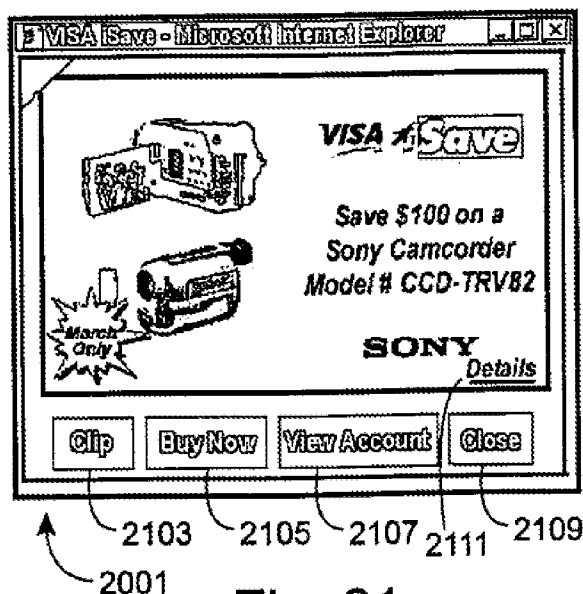


Fig. 21

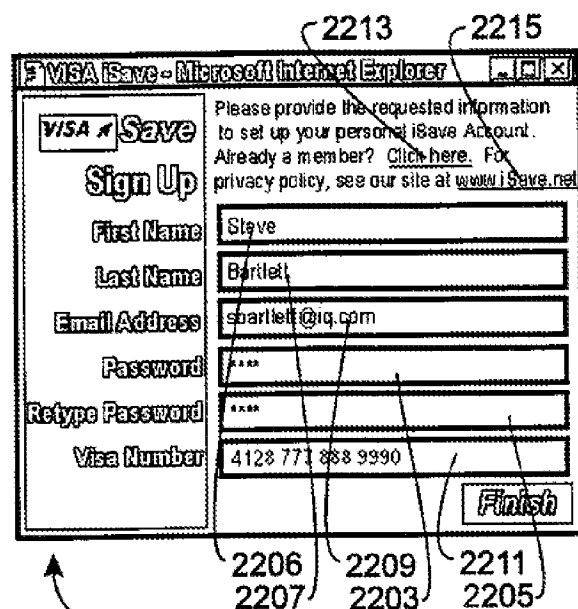


Fig. 22

As seen in Meyer Fig. 21, the Details hyperlink 2111 will direct the user to another page where the user can read a legal disclaimer. Meyer also discloses the “Buy Now” button 2105, which again

directs and opens up another page for the user. None of the links shown in Fig. 21 of Meyer cause a text field to be displayed in the window of 2001.

Meyer further states:

“When a user clicks on an incentive icon, embedded JavaScript is run to **cause a pop-up window of the incentive to appear**. [...] One of the aspects of the present invention is such use of **pop-up windows to display incentives and other information**, such use not necessitating the member's leaving whatever page he or she was viewing on the browser on consumer computer 115.” Meyer, p. 46, ln. 7-13 (emphasis added)

Meyer's links and pop-ups do not make obvious the interactivity and self-modification of an advertisement as claimed in the '101 Patent. Meyer discloses generic website links which open pop-ups and other separate pages. Meyer fails to disclose any interactive element that causes modification of the promotional incentive present on the webpage.

Furthermore, Meyer's process of “caus[ing] a sign-on screen to popup on computer 115” when a user needs to sign on to the membership program can be considered annoying to a user. Meyer, p. 49, ln. 3-4. Avoiding annoyances that disrupt a user's browsing experience is exactly the type of problem that the '101 Patent considered and aims to avoid. '101 Patent, 4:65 – 5:2 (“the recipient remains able to interact with the entire webpage displaying the banner advertisement 154 or 166 without pop-up of additional web pages, network communications, or other interruption.” For that reason, the claimed invention of the '101 Patent specifically avoids the use of pop-up windows. *Id.*

It is a stated benefit of the '101 Patent that when “receiving an indication that the recipient activated the interactive element displayed within the advertisement” no new window or popup is displayed. *Id.* Instead, receiving the indication “[causes] a text field to be displayed in at least a portion of the advertisement.” *See* '101 Patent, 9:20-21. Consequently, no new page or login page pop-up is opened. The only change to the user's browser is the introduction of a text field *into a portion* of the advertisement. '101 Patent, 8:2-4. If a user wishes to view the rest of the content on the page, the content is still there and viewable, unobscured by any pop-up. This is not possible with the method of Meyer.

The Meyer method opens a new page or a popup as shown above. Meyer's pop-ups have the same problem which is solved by the invention of the '101 Patent. First, the user will become annoyed with the pop-up and develop an unfavorable view of the incentive. Second, with Meyer's

method, if the user is no longer interested in the incentive, the user will merely close the pop-up and continue browsing without considering the promotional content. Finally, the user of Meyer's method is pulled away from the page he interacted with before he has viewed all the content he is interested in—and he may never return to what originally piqued his interest.

Furthermore, the Office Action acknowledges that Meyer fails to disclose causing a text field to be displayed in at least a portion of the advertisement. Office Action, p. 6. The Office Action relies on Herrmann to allegedly teach this feature. *Id.* However, Herrmann's input area 24 is a static portion of window 20 that even if combined with Meyer's system fails to disclose *causing* a text field to be displayed in at least *a portion* of the advertisement.

Herrmann is directed towards a system whereby an ad is displayed to a user on a webpage. See Herrmann Fig. 2, reproduced below.

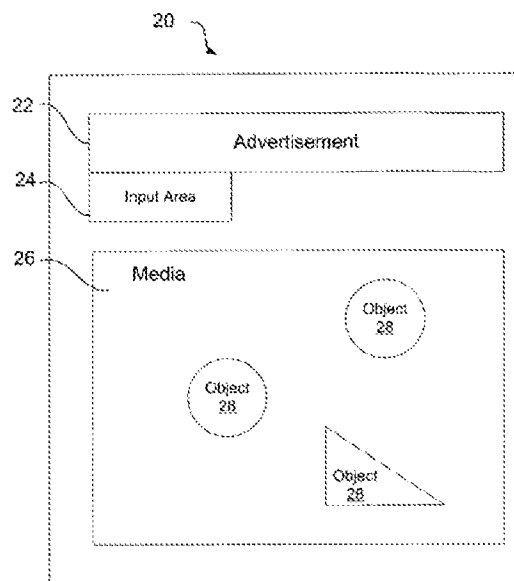


FIG. 2

With respect to the advertisement format, Herrmann discloses, “[a]lternatively, any of the elements may overlap with the other elements. For example, input area 24 may be displayed as part of advertisement 22 or media 26. Similarly, advertisement 22 and input area 24 can be displayed within media 26.” Herrmann, 3:43-46.

Herrmann describes that the input area 24 can be a text box for the user to enter e-mail. “In another configuration, the input area can be a text box in which the user enters his or her email address.” Herrmann, 5:28-29.

But, the input area 24 of Herrmann is static and present within the window 20 when the page is loaded. *See* Herrmann, 5:19-23, stating “[c]lient device 4 receives the content and presents the content to the user such that the media, the advertisement and the input area *are concurrently displayed*” (emphasis added). This is contrary to Patent Owner’s text field in the ’101 Patent where, “activating [the] interactive logo 156 causes an interface option, such as a text field 158, to appear.” ’101 Patent, 4:8-10. In the method of the ’101 Patent, there is a causal relationship between the text field being displayed in a portion of the advertisement or not.

The Office Action’s acknowledgment that Meyer’s “pop-up screen with text fields” fails to disclose causing a text field to be displayed in a portion of the advertisement is telling. *See* Office Action, p. 6 stating “[t]o the extent it could be argued that Meyer does not explicitly disclose the text field is displayed.” However, relying on Herrmann to make up for Meyer’s deficiency does not add anything significant because as shown above, Herrmann is merely a static text box in a window. Meyer already discloses static text boxes in a pop-up window. Following the reasoning of the Office Action, the combination of Meyer and Herrmann would be a pop-up box with static text input areas.

Patent Owner respectfully submits that combining the static input areas of Herrmann with Meyer’s pop-up that already has static input areas cannot teach or suggest causing a text field to be displayed in at least a portion of the advertisement because in the Office Action’s proposed combination, the text field of the pop-up is not displayed in at least a portion of the advertisement. It is an entirely separate window and the text field is displayed concurrently with the window, not as a result of the user activating an interactive element displayed within the advertisement.

Teague cannot remedy the deficiencies in Meyer and Herrmann either. Teague is directed toward a method and system for offer generation and distribution. Teague is entirely silent with respect to causing a text field to be displayed in at least a portion of the advertisement.

Accordingly, the proposed combination of Meyer, Herrmann, and Teague fails to teach or suggest each of the features of “retrieving additional information *associated with the advertisement* based on at least a portion of the user profile associated with the recipient” and “causing a text field to be displayed in at least a portion of the advertisement,” as recited in Patent Owner’s claim 1. The Office Action fails to meet all three requirements for establishing a *prima facie* case of obviousness.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any specific evidence of nonobviousness by Applicant.

The Office is also obligated to support any rejection under 35 U.S.C. § 103 with a "clear articulation" of the reasons why the claimed invention would have been obvious. M.P.E.P. § 2143. The Supreme Court in *KSR International Co. v. Teleflex Inc.* noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be "made explicit." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The "Graham factors" were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR*. M.P.E.P. § 2141. The "Graham factors," including secondary considerations when present, are the "controlling inquiries in any obviousness analysis." *Id.* The factual inquiries enunciated by the Court are as follows: (A) Ascertaining the scope and content of the prior art; (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art. *Id.*

In the present case, as described above, neither of the cited references either alone or in combination teaches or suggests all features of Applicant's claims. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claim 1.

Therefore, Applicant respectfully requests that the rejection of claim 1 under pre-AIA 35 U.S.C. § 103 be withdrawn.

Claim 4

Further, since claim 4 depends from and incorporates all the features of claim 1, claim 4 is also not obvious over Meyer, Herrmann, and Teague at least for the above reasons for which claim 1 is not obvious, and for the separate features that claim 4 recites. Thus, Applicant respectfully requests that the rejection of claim 4 under pre-AIA 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing, Patent Owner respectfully submits that each of claims 1 and 4 is patentable over the asserted references. Patent Owner therefore respectfully requests the issuance of a reexamination certificate confirming the patentability of claims 1 and 4.

The Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before using another Office Action.

Authorization is hereby granted to charge any fees due with the filing of this document to deposit account 60-4958.

Respectfully submitted,

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