

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Title : System and method of on-line advertising
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Proposed Interview Agenda 90/015,262

For Discussion Purposes Only

In the March 14, 2024, Office Action, Applicant's independent Claims 1 and 4 were rejected in view of the Meyer and Teague publications. Claims 2 and 3 were have not been rejected.

Applicant wishes to discuss the allowance of Claims 1 and 4 and wishes to discuss the allowance of new claims 5 and 6 presented here.

The claims to be discussed are presented here. Points for discussion begin on Page 4 of this paper.

Listing of claims for discussion:

Existing Claims 1-4 are unchanged.

Points of argument is presented herein as to the allowability of Claims 1 and 4

Claims 2 and 3 are not rejected.

The following new claims 5 and 6 are presented for discussion:

Claim 5: (Proposed New claim) 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.

Claim 6. (Proposed New claim) A method of online advertising performed by a processor using a display having a graphical user interface, wherein the processor is configured to perform the method, the method 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.

DISCUSSION POINTS

Discussion points as to as to allowability of Claim 1

Pending Claim 1 is directed to an online advertising method that allows for the dissemination of additional ad information relating to an advertisement seen during a browsing session but providing such information without interrupting the browsing session of the recipient. This limitation is set forth as “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...”

On page 7, lines 24-27, the Office Action acknowledges that the Meyer publication does not disclose the limitation of “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.” Specifically, the Office Action states:

Meyer does not explicitly disclose 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.

The Meyer Publication is concerned with clipping an incentive for further processing the clipped information and includes a multistep process of viewing, clipping, and claiming of rewards. Any information is sent periodically and without a teaching of doing so without interrupting the browsing session of the user. Rather, information may be sent periodically [Meyer, Pg. 14, Lines 1-3].

Thus, the Meyer publication makes no suggestion as to providing information without interrupting a browsing session of the recipient.

The Office Action cites the Teague publication as allegedly disclosing the limitation of 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.

Teague discloses a system for providing targeted promotional offers to consumer in which the consumer is allowed to select a desired delivery mechanism and the offers are delivered via said desired delivery mechanism (paragraph [0013], [0035], [0041], [0043], and [0071] of Teague). Mechanisms described in Teague such as via cell phone or email would by definition not interrupt the recipient’s browsing session. See Office Action at pages 7, line 27 through page 8, line 4.

For the following reasons, Applicant respectfully disagrees that the Teague publication discloses “the delivering being performed without interrupting the browsing session of the recipient.”

Applicant’s independent claim 1 is directed to a “method of online advertising” involving a browsing session during an online experience. The Teague publication never mentions an “online session” followed by the presentment of an advertiser’s ad information. Thus, it cannot be read to suggest or render obvious that a step should be added to the Meyer publication method whereby advertisement is delivered without interrupting the browsing session of the recipient. Nowhere in the Teague publication is there a disclosure of a browsing session in relation to the forwarding of ad information with the submission being complete such that it does not interrupt the browsing session. This is because there is no browsing session in the Teague publication. The Teague publication discloses multiple ad methods and systems but they are initiated by phone or other means and not related to browsing sessions whereby the information provides is calculated to not interfere with an internet browsing session.

This is evident throughout the Teague publication, including page 4, paragraph [0043], which states:

[0043] Subsequent to establishing a user profile on CMS 102, user 108 initiates a mobile telephone call to CMS 102 through mobile device 120 through gateway 122. In one embodiment, user 108 is connected to an IVS of CMS 102. In response to received user information, CMS 102 generates and transmits offers to the user. In one embodiment, CMS 102 searches an offer database for offers that meet either pre-defined user criteria (from the user's profile), or newly input criteria generated in response to questions presented to the user while interacting with the system. When a matching offer is found, CMS 102 generates a tracking code, embeds the tracking code in a message to the user, and sends the message to the user's desired destination device, such as, for example, the user's cell phone/SMS receiver and/or the user's email address.

This does not involve an internet browsing session, but rather the communication of ad information by phone.

Further, in paragraph [0046], the Teague publication describes the alternative embodiment wherein the user dials a predetermined telephone number for practicing the invention. The Teague publication describes this as follows:

[0046] Generally, in an alternate embodiment, in operation, system 100 operates as follows. User 108 dials a predetermined telephone number and connects to an inter active voice recognition (IVR) system of CMS 102. The IVR system presents one or more offers to user 108. Once an offer is heard that appeals to user 108, user 108 can select the offer through user interface 124, and can elect to receive the offer via SMS-text message to phone 120 or via email through email system 110.

Thus, the actions from Teague cannot be in a form such that “a browsing session is not interrupted” as there is no “browsing session” involved. Thus, a combination of the teachings for Meyer and Teague would not produce the Claim 1 invention.

This distinction also demonstrates that it could not be concluded that it would be obvious to combine the teaches in Teague with those in Meyer. The two references have a fundamentally different operation and focus, and it would not be obvious to combine the teachings.

The key to the appropriateness of any rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. There is no clear articulation of obviousness in this case. The Court is KSR also noted that an obviousness determination must not be based on hindsight gained from the patent under examination, stating “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”

The rejection should provide a reasoned explanation as to why the invention as claimed would have been obvious to a person of ordinary skill in the art at the relevant time. The rejection must show that the skilled artisan would have selected the cited references and then combined their elements. An explicit explanation is missing in this case.

Even the combined teachings of the Meyer and Teague publications does not teach the “delivery the additional information to the recipient based on the delivery method preferences, and the delivering being performed without interrupting th browsing session of the recipient...”

The Office Action on pages 13–22, does not address how the Teague publication or any cited reference addresses the limitation in the claim as to “delivering the additional information to the recipient based on the delivery method preferences, the delivering being “performed

without interrupting the browsing session” as there is no “browsing session” involved in the Teague publication.

Thus, a combination of the teachings of the Meyer and Teague publication would not produce the Claim 1 invention much less render it obvious. There is no motivation here to combine the Meyer and Teague publications because their combination would not produce the claimed invention. Neither of the 2 cited references recognize the problem solved by the claimed invention, namely a method including the step of providing subsequent related information without interrupting the browsing session of the user.

Argument as to allowability of new claim 5:

As now presented, new independent claim 5 is directed to the features of the method which are not disclosed in the prior art as recognized by the prior Office Actions. Therefore, new independent claim 5 should be allowable.

Argument as to allowability of new claim 6:

New independent claim 6 recites, inter alia, “A method of online advertising performed by a processor using a display having a graphical user interface, wherein the processor is configured to perform the method.” None of the cited references include a processor configured to perform all of the claimed method steps. Therefore, new independent claim 6 should be allowable.