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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/015,262	07/27/2023	8719101	ADN101	9031

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Whitestone Law, PLLC
1850 Towers Crescent Plaza, Suite 550
Tysons, VA 22182

EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
05/30/2024	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)).

Ex Parte Reexamination Advisory Action ***Before the Filing of an Appeal Brief***	**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 PROPOSED RESPONSE FILED 14 May 2024 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 14 March 2024.

1. ☑ Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.
   THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 5 MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION.
   Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. ☐ An Appeal Brief is due two months from the date of the Notice of Appeal filed on _____ to avoid dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e) .

AMENDMENTS

3. ☑ The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
   (a) ☑ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☑ They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).
4. ☐ Patent owner's proposed response filed _____ has overcome the following rejection(s): _____
5. ☐ The proposed new or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☑ For purposes of appeal, the proposed amendment(s) a) ☑ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) patentable and/or confirmed: _____
   Claim(s) objected to: _____
   Claim(s) rejected: 1 and 4
   Claim(s) not subject to reexamination: 2-3

AFFIDAVIT OR OTHER EVIDENCE

7. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____ .
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☑ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached .
12. ☐ Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____ .
13. ☐ Other: _____ .

/JOSHUA D CAMPBELL/ Primary Examiner, Art Unit 3992		

cc: Requester (if third party requester)

1) This is a response to the Patent Owner's (PO) response filed on May 14, 2024 in reference to the following issues:

a. Regarding rejection in view of Meyer and Teague (pages 10-14 of PO's response):

PO argues that Teague does not disclose "the delivering being performed without interrupting the browsing session of the recipient".

Examiner respectfully disagrees. The specification of the '101 Patent discusses not interrupting the browsing session of the recipient twice:

> *In an exemplary embodiment, recipients have previously registered their email address through the online registration mechanism described above by way of text balloon 158 to activate the clickable logos 156 and 164. In this way, banner advertisements 154 and 166 deliver advertising or other information in a timely and unobtrusive manner without the recipient leaving the website hosting the banner advertisements 154 or 166 or otherwise interrupting the recipient's browsing.*
>
> (column 4, lines 36-43 of the '101 Patent)
>
> *At step 210, additional information is delivered to the visitor's browser client 112, the visitor's e-mail client 114, or via other means to the to visitor's computing device 104. In an exemplary embodiment, 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.*
>
> (column 4, line 62-column 5, line 2 of the '101 Patent)

As can be seen in the citations above, the only requirement for this language is that the recipient does not leave the website hosting the banner advertisement, remaining able to interact with the entire webpage displaying the banner advertisement without pop-up of additional web pages, network communications, or other information. Teague discusses the following:

> ***User 108 can also interact indirectly with CMS 102 through a non-system website 222 through user interface 106. Generally, as used herein, a non-system website is a***

> ***website hosting a banner ad or other clickable presentation or offer that is coupled to CMS 102. User 108 can click on the offer and the non-system website interacts with CMS 102 to identify the terms of the offer and the user's preferred delivery method, including any referral information.*** *In a social selling context, one skilled in the art will understand that not all of the non-system website offers will correspond with social selling PSE offers. In such cases, the user 108 can be directed to system website 220 to review current social selling PSE opportunities. In an alternate embodiment, where there is no social selling PSE offer corresponding to the non-system website offer, the system 200 can respond completely independently of the social selling network.*
>
> (paragraph [0071] of Teague)

As can be in the citation above, Teague explicitly discusses a situation where a user is in a browsing session in which a website is displayed hosting a banner ad or other clickable presentation or offer that is coupled to CMS 102. Teague discusses that a user can click on the offer and the website interacts with the CMS to identify the terms of the offer and the user's preferred delivery method. Teague additionally discloses the delivery methods may include "email, SMS-text message, and/or other desired delivery methods" (paragraph [0021] of Teague). Thus, Teague discloses a user clicks on a clickable banner ad/offer on a website and is delivered the terms of the offer (additional information) via the user's preferred delivery method (email, SMS-text message, and/or other desired delivery methods). In this discussion provided by Teague, the user does not leave the website hosting the banner advertisement, remaining able to interact with the entire webpage displaying the banner advertisement without pop-up of additional web pages, network communications, or other information. Thus, the teachings of Teague clearly cover the '101 Patent's definition of what is required for "the delivering being performed without interrupting the browsing session of the recipient" as claimed. The rejection is proper and must be maintained.

PO additionally argues that the sentence in Teague stating, "In a social selling context, one skilled in the art will understand that not all of the non-system website offers will correspond with social selling PSE offers. In such cases, the user 108 can be directed to system website 220 to review current social selling PSE opportunities." shows that the user's browsing session would be interrupted based on the teachings of Teague.

Examiner respectfully disagrees. PO has taken one sentence out of context in an effort to support the arguments. The sentence relied upon by PO is regarding "a social selling context", the sentence immediately following that sentence states, "In an alternate embodiment, **where there is no social selling PSE offer** corresponding to the non-system website offer, the system 200 can respond completely independently of the social selling network." (emphasis added). As can be seen, in the case where there is no social selling PSE offer corresponding to the non-system website offer the system will respond independently of the social selling network, thus the sentence relied upon by the PO regarding "the social selling context" does not apply in this alternate embodiment that is explicitly described in Teague. Thus, the rejection is proper and must be maintained.

b. Regarding the presentation of new claims 5-8:

The amendment including the new claims has not been entered. The new claims raise new issues and most certainly do not place the proceeding in better form for appeal.

As expressed in the interview the examiner has multiple concerns about the language and form of the added claims. Using claim 5 for discussion purposes, the claim is a method claim and as such the limitations found in the preamble of the claim regarding "the at least one processor" being "configured to:" perform list of functional limitations are not limiting to a method claim. The method claim still only requires a contingency that performs one of two options based on a determination and the inclusion of a processor has no impact on this contingency in the method steps of said method claim. The PO has cited *Microprocessor Enhancement Corp. v. Texas*

Instruments Inc. and Intel Corp., 520 F.3d 1367 (Fed. Cir. 2007), however the examiner disagrees with the PO's assertion the claims in the instant case are similar to *Microprocessor.* The claims in the instant case separately try to claim a method with method limitations and a system with system claim limitations, linking them by putting the system claim limitations in the preamble. Again, as stated above this would make said limitations non-limiting to the method as claimed. In the alternative, if the claim were to impart the actual system claim limitations as currently written to the body of the claim instead of the preamble, then the claim would be rejected as indefinite under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph (See *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1318, 97 USPQ2d 1737, 1748-49 (Fed. Cir. 2011)).

Conclusion

2) 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:

Electronically: Registered users may submit via Patent Center at https://patentcenter.uspto.gov/.

By Mail to: Mail Stop *Ex Parte* Reexam
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Commissioner for Patents
United States Patent & Trademark Office
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Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For electronic transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the USPTO patent electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Joshua D. Campbell at telephone number (571)272-4133.

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

Conferees:

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992