

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: 8719101

Confirmation No.: 9031

Serial No.: 90/015,262

Examiner: CAMPBELL, JOSHUA D

Filed: July 27, 2023

Art Unit: 3992

For: SYSTEM AND METHOD OF ON-LINE ADVERTISING

RENEWED PETITION UNDER 37 CFR §1.181

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313

Madam:

This is a Renewed Petition to remove the finality of the office action issued on March 14, 2024.

Statement of Facts

A final office action dated March 14, 2024, was issued in this application. In the final office action, the office applied a new claim construction to claim 1. This is explained on pages 18-19 of the final office action:

Claim 1 contains contingent limitations in a method claim, thus only broadest reasonable interpretation of said claim only requires the steps be performed for one of the two conditions in the claim.

The broadest reasonable interpretation of a method (or process) claim having contingent limitations requires only those steps that must be performed and does not include steps that are not required to be performed because the condition(s) precedent are not met. For example, assume a method claim requires step A if a first condition happens and step B if a second condition happens. If the claimed invention may be practiced without either the first or second condition happening, then neither step A or B is required by the broadest reasonable interpretation of the claim. If the claimed invention requires the first condition to occur, then the broadest reasonable interpretation of the claim requires step A. If the claimed invention requires both the first and second conditions to occur, then the broadest reasonable interpretation of the claim requires both steps A and B. (MPEP 2111.04.II)

This claim construction, which applies a new broadest reasonable interpretation of the claims based on MPEP §2111.04, was not applied in the non-final office action where all of the contingent limitations were given effect. Patent owner previously filed a petition under 37 CFR §1.181 to remove the finality of the March 14, 2024, office action which was dismissed as untimely in the petition decision dated July 31, 2024.

Remarks

The petition decision dated July 31, 2024 dismissed patent owners first petition under 37 CFR §1.181 as untimely citing 37 CFR §1.181(f). Patent owner respectfully notes, however, that 37 CFR §1.181(f) provides that a petition under 37 CFR §1.181, if filed more than two months after the final office action: “*may* be dismissed as untimely, except as otherwise provided.” (Emphasis supplied). It is noted that 37 CFR §1.181(f) is normally applied in situations where an RCE can be filed and this provision does not clearly apply to a reexamination proceeding where an RCE is not available.

In a reexamination proceeding MPEP §2272 states (emphasis supplied):

... the patent owner may file a petition under 37 CFR 1.181 requesting that the final rejection be withdrawn and that prosecution be reopened, or file a petition under 37 CFR 1.181 requesting entry of the amendment, where appropriate. *The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal.*

Accordingly, MPEP §2272 otherwise provides that the petition must be filed “within the time period for filing a notice of appeal.” Patent owner submits that, in the present situation, where an RCE cannot be filed and substantive patent rights are at stake, the merits of this petition should be considered since it has been timely filed under MPEP §2272.

As mentioned above, in the final office action a new claim construction was applied to claim 1. Patent owner submits that a new claim construction will generally represent a fundamental change to any analysis as to whether a claim complies with statutory requirements for patentability. See MPEP §1207.03(III) (“A position or rationale that changes the “basic thrust of the rejection” will also give rise to a new ground of rejection” citing *In re Kronig*, 539 F.2d 1300, 1303, 190 USPQ 425, 427 (CCPA 1976)). In addition, MPEP §2103(I)(C) explains as follows (emphasis supplied):

The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. Examiners must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability.

The reason examiners must first determine the scope of a claim, before determining if the claim complies with patentability requirements is based on the foundational nature of the claim construction in the analysis. A change in the claim construction will necessarily significantly affect any analysis of whether a claim complies with the statutory requirements for patentability. The patent owner should thus be given a chance to respond to a new claim construction and any resulting rejections when one is applied.

The office argues in the final office action that the removal of a prior art reference from a rejection is not necessarily considered a new ground of rejection per MPEP §1207.03. See Final Office Action, page 3. This assertion, however, is not on point because the new claim construction changed “the basic thrust of the rejection” and is a new ground of rejection. The patent owner should therefore

be given an opportunity to respond to the new claim construction and rejection with appropriate arguments, amendments, and/or evidence.

Patent owner further notes that the contingent limitations analysis contained in newly applied MPEP §2111.04(II) is based entirely on the PTAB precedential decision in *Ex parte Schulhauser*, Appeal 2013-007847 (PTAB April 28, 2016). As set forth in MPEP §2111.04(II), and quoted in the final office action, this decision requires that “the broadest reasonable interpretation of a method (or process) claim having contingent limitations requires only those steps that must be performed and does not include steps that are not required to be performed because the condition(s) precedent are not met.” Thus, under *Ex parte Schulhauser*, contingent limitations that are not required to be performed because conditions precedent are not met are not given effect.

It is noted that the *Ex parte Schulhauser* decision was rendered in April of 2016 whereas US 8,719,101 issued prior to this decision in May of 2014. Review of the file history of US 8,719,101 accordingly reveals that no mention of contingent limitations was made in either the non-final office action dated April 6, 2012 or in the final office action dated June 4, 2013, and in both cases all limitations were given effect to. Likewise, in the nonfinal office action in the present re-examination proceeding, no mention of contingent limitations was made, and all limitations were again given effect to.

Therefore, the final office action of March 14, 2024 in this re-examination proceeding was the first time that the broadest reasonable interpretation analysis set forth in *Ex parte Schulhauser* was applied to the present claims. As discussed above, this decision completely changed the interpretation of claims with contingent limitations by providing that certain contingent limitations are not given effect to. As set forth on pages 18-19 of the final office action, this is what the office did with claim 1. The office action found a limitation to be allowable subject matter, but then declined to give effect to the allowable limitation based on a first-time application of MPEP §2111.04 and the *ex parte Schulhauser* decision.

For the reasons set forth above, the application of MPEP §2111.04 and the *ex parte Schulhauser* decision thus changed the basic thrust of the rejection and represents a new ground of rejection. The patent owner should be given an opportunity to respond to the new rejection with appropriate arguments, amendments, and evidence.

Relief requested

The finality of the March 14, 2024 office action should be withdrawn.

Respectfully submitted,

/ J. Mark Konieczny /

J. Mark Konieczny
Attorney for Patent Owner
Reg. No. 47,715

Customer No. 160962
Stonebridge IP, PLLC
10432 Balls Ford Rd., Suite 300
Manassas, VA 20109

Phone: 703-881-7718

Date: August 14, 2024