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

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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)).



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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 90/015,262
Filing Date: 27 Jul 2023
Appellant(s): Adnexus Incorporated

J. Mark Konieczny (Reg. No. 47,715)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 11, 2024.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated March 14, 2024 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

The following ground(s) of rejection are applicable to the appealed claims.

Claims 1 and 4 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Meyer (International Publication No. WO 99/46708) in view of Teague (U.S. Patent Application Publication No. 2006/0212355).

(2) Response to Argument

Appellant argues Meyer does not disclose express limitations of claims 1 and 4 as asserted in the final office action. More specifically, appellant argues that the rejections rely on citations from Meyer regarding both the “incentive” and the “incentive icon” which appellant argues are different entities and only the “incentive” can be equated to the “advertisement” as recited in the claims thus the citations regarding the “incentive icon” do not properly read on the claims (pages 7-9 of the Appeal Brief).

Examiner respectfully disagrees. Appellant appears to be misrepresenting both the discussions in the rejection and the discussions found in Meyer. As explicitly discussed in Meyer the “incentive” and “incentive icon” are not separate from each other, rather an incentive icon is included as a part of an incentive:

Briefly, 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.** The value of the incentive is based on meeting a set of one or more match criteria (terms and conditions). In one particular embodiment, the value is also based on applying an incentive formula. Value here includes the inherent incentive value, which may be, depending on the type of incentive, the amount of discount, an entry in a sweepstakes, a number of frequent flier program miles, a number of promotional points, one or more free samples, a free test drive, or a product tie-ins, this list meant to be non-limiting. The method includes, for any particular incentive, publishing a mechanism for selecting the incentive at one or more locations of the network, these locations, for example, being Web-pages, or e-mail messages. For example, the selecting mechanism may be an icon which when clicked generates the incentive existence message of the incentive (possibly together with the incentive existence messages of other incentives). Alternatively, the selecting mechanism may be the incentive existence message itself. The published incentive selecting mechanism preferably includes an reference which directly or indirectly points to the whereabouts in the network of the incentive or of one or more parameters of the incentive, the reference being, for example, in the form of the universal resource locator (URL) of the incentive or the one or more parameter(s).*

(page 10, line 12-page 11, line 4 of Meyer, emphasis added)

As can be seen in the citation above, an incentive may include an incentive existence message preferably including an incentive icon. Meyer explains that one or more of the incentive parameters is displayed to the consumer as a part of the incentive existence message, thus displayed prior to the user interacting with the "incentive icon" as argued by the appellant, rather Meyer explicitly states it may be automatic when one accesses one of the locations (go to a webpage that includes an advertisement/incentive).

A consumer computer connects to the network and accesses one of the locations where the

*selecting mechanism of the particular incentive exists. Activating the selecting mechanism, **which may be automatic when one accesses one of the locations** or which may be by consumer interaction, **leads to one or more parameters of the particular incentive being displayed on the consumer computer.** In the preferred embodiment, the incentive includes an incentive existence message and it is the incentive existence message which is displayed. Displayed in this context includes all means for communicating information to the consumer. **One or more of the incentive parameters displayed, for example one of more characteristics of the incentive existence message,** are dependent on one or more characteristics of the consumer, including, for example, the location accessed by the consumer computer where the selecting mechanism for the particular incentive exists, the time, or the date. Dependent in this sense does not necessarily mean the only dependency. In a particular embodiment the incentive existence message includes an audiovisual, for example an icon, and the audiovisual characteristics of the incentive existence message (including for example the icon shape, color, text associated with the message, and the wording) are dependent on one or more characteristics of the consumer.*

(page 11, lines 5-20 of Meyer, emphasis added)

Meyer continues that an incentive existence message may include a means for interacting (“clicking on the incentive icon”) which causes displaying “another one or more of the additional parameters of the particular incentive” or in other words “additional information associated with the advertisement” as stated in the claims:

*In one version, **the incentive existence message includes means for interacting,** and the method further includes **displaying another one or more of the parameters of the particular incentive on the display device of the consumer computer in response to an action by the consumer, e.g., clicking on the incentive icon.** In the preferred embodiment, this action causes a new display window (e.g., a popup window) to appear, the displaying of the parameters occurring therein. In this way, the incentive may be viewed by the consumer without the consumer leaving the window, for example the Web page, where the icon originally appeared. In another version, the displaying*

of the parameters occurs in the same window where the existence message appeared. In the version that includes the consumer joining, i.e., becoming a member of the inventive system by providing consumer identification data which is then stored in a member database coupled to a member information computer connected to the network, occurrence information about displaying the one or more of the parameters is recorded in one or more of the incentive database and the consumer database. Thus, when means for interaction are presented to the member, for example when the existence message includes interaction means, or displaying more parameters includes displaying another interaction means, occurrence information about any interaction by the consumer is recorded, preferably in the incentive database and in alternate embodiments, in the member database or in both databases.

(page 12, lines 8-25 of Meyer, emphasis added)

The example shown in the rejection shows this very clearly.

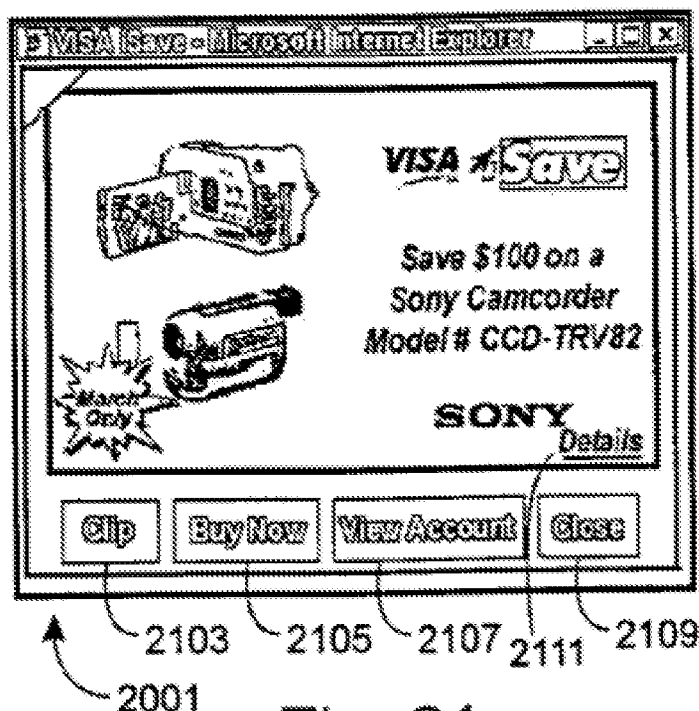


Fig. 21

As can be seen in Fig. 21 from Meyer, the incentive includes one or more of the incentive parameters

("Save \$100") and a means for interacting by clicking on the incentive icon (in this case the "Details hyperlink 2111" – page 52, lines 23 of Meyer). When a user clicks on the "Details" hyperlink as discussed above, the system displays "another one or more of the parameters of the particular incentive on the display device of the consumer computer in response to an action by the consumer, e.g., clicking on the incentive icon". Thus, the rejection is proper and must be maintained.

Appellant argues the combination of Meyer and Teague is improper. More specifically, appellant argues once again that "incentive" and the "incentive icon" are different entities and only the "incentive" can be equated to the "advertisement" as recited in the claims thus the citations regarding the "incentive icon" do not properly read on the claims. Additionally, appellant argues that in Meyer the incentive is not displayed until after the cookie has been accessed thus there would be no reason to obtain a user's delivery preferences as disclosed by Teague (pages 9-10 of the Appeal Brief).

Examiner respectfully disagrees. As discussed above, the "incentive" and "incentive icon" are not separate from each other, rather an incentive icon is included as a part of an incentive:

*Briefly, 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.** The value of the incentive is based on meeting a set of one or more match criteria (terms and conditions). In one particular embodiment, the value is also based on applying an incentive formula. Value here includes the inherent incentive value, which may be, depending on the type of incentive, the amount of discount, an entry in a sweepstakes, a number of frequent flier program miles, a number of*

promotional points, one or more free samples, a free test drive, or a product tie-ins, this list meant to be non-limiting. The method includes, for any particular incentive, publishing a mechanism for selecting the incentive at one or more locations of the network, these locations, for example, being Web-pages, or e-mail messages. For example, the selecting mechanism may be an icon which when clicked generates the incentive existence message of the incentive (possibly together with the incentive existence messages of other incentives). Alternatively, the selecting mechanism may be the incentive existence message itself. The published incentive selecting 11 mechanism preferably includes an reference which directly or indirectly points to the whereabouts in the network of the incentive or of one or more parameters of the incentive, the reference being, for example, in the form of the universal resource locator (URL) of the incentive or the one or more parameter(s).

(page 10, line 12-page 11, line 4 of Meyer, emphasis added)

Additionally, the appellant's statements regarding the display of the incentive occurring only after the cookie has been received is inaccurate. Similar to the discussion above, Meyer explains that one or more of the incentive parameters is displayed to the consumer as a part of the incentive existence message, thus displayed prior to the user interacting with the "incentive icon" as argued by the appellant, rather Meyer explicitly states it may be automatic when one accesses one of the locations (go to a webpage that includes an advertisement/incentive). These incentive parameters are dependent on one or more characteristics of the consumer such as the location accessed by the consumer computer, the time, or the date. This all occurs prior to the system attempting to identify if a cookie exists on the user computer.

*A consumer computer connects to the network and accesses one of the locations where the selecting mechanism of the particular incentive exists. Activating the selecting mechanism, **which may be automatic when one accesses one of the locations** or which may be by consumer interaction, **leads to one or more parameters of the particular incentive being displayed on the consumer computer.** In the preferred embodiment, the incentive includes an incentive existence message and it is the incentive existence message which is displayed. Displayed in this context*

*includes all means for communicating information to the consumer. **One or more of the incentive parameters displayed, for example one of more characteristics of the incentive existence message, are dependent on one or more characteristics of the consumer, including, for example, the location accessed by the consumer computer where the selecting mechanism for the particular incentive exists, the time, or the date.** Dependent in this sense does not necessarily mean the only dependency. In a particular embodiment the incentive existence message includes an audiovisual, for example an icon, and the audiovisual characteristics of the incentive existence message (including for example the icon shape, color, text associated with the message, and the wording) are dependent on one or more characteristics of the consumer.*

(page 11, lines 5-20 of Meyer, emphasis added)

Meyer explicitly confirms the examiner's interpretation in the very next paragraph of the Meyer disclosure. Meyer states that at this point, "when the consumer views the one or more incentive parameters, if the consumer is not yet a member" (in other words, no cookie exists) making the consumer a member by "storing the referral data (e.g. a cookie)".

*One version of the method of the present invention **includes making the consumer a member when the consumer views the one or more incentive parameters if the consumer is not yet a member.** Joining includes transmitting consumer identification data via the network to a member information computer connected to the network; and storing consumer identification data of the consumer in a member database coupled to a member information computer connected to the network. In one embodiment, **joining includes storing referral data (e.g., a cookie) about the consumer in the consumer computer,** the referral data for rapid identification of the consumer, for example for future interactions with the consumer. In one embodiment, the method includes recording occurrence information about displaying the incentive parameter or parameters to the member, and the storing preferably is in the incentive database, and may also include storing in the member 12 database. The occurrence information stored in the incentive database may include the identification of the member, the date and time, the location on the network where the*

message is being displayed, and one or more parameters about the incentive. When some of the parameters, for example the audiovisual characteristics of the incentive existence message (such as the icon shape, color, text associated, and the wording), are dependent on one or more characteristics of the consumer, the characteristics may include the consumer demographics, the consumer preferences and the consumer purchasing history.

(page 11, line 21-page 12, line 7 of Meyer, emphasis added)

Thus, the appellant's argued position would have been impossible because at the time of displaying the one or more incentive parameters the cookie would not yet have existed, so clearly it could not have been retrieved. The rejection is proper and must be maintained.

Appellant argues Teague does not provide an enabling disclosure of the limitations in claims 1 and 4 of "delivering further information without interrupting the browsing session of the recipient." More specifically, appellant appears to argue that because Teague does not explicitly use the language "without interrupting the browsing session of the recipient" it cannot conceivably read on the limitations as claimed (pages 10-13 of the Appeal Brief).

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.

Appellant argues Teague "directly implies" that a browsing session would necessarily be interrupted. More specifically, appellant argues that because in order to access or use the offer the user would have to print the offer or present the phone displaying the offer to a merchant at the time of purchase it would effectively interrupt the browsing session of the user (pages 13-15 of the Appeal Brief).

Examiner respectfully disagrees. As discussed above, 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 appellant has pointed to the following citation from Teague in attempt to undermine the examiner's position:

Generally, in an alternate embodiment, in operation, system 100 operates as follows. User 108 dials a predetermined telephone number and connects to an interactive 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. As above, user 108 presents phone 120 to the merchant 118 that initiated the offer and in turn, receives the terms of the offer embedded in the SMS-text message. Alternately, user 108 connects to CMS 102 through user interface 106 through a website on the Internet. User 108 clicks on an offer through a GUI and is given the option of receiving the offer via email through email system 110 or SMS-text message to phone 120. **If the offer is sent via email, user 108 prints the offer and presents the offer to merchant 118. If the offer is sent via SMS-text message, user 108 presents phone 120 (specifically user interface 124) to merchant 118 and in turn, receives the terms of the offer embedded in the SMS-text message.***

(paragraph [0046] of Teague, emphasis added)

As can clearly be seen in the citation above, this discussion is directed to what happens after the delivery of said “additional information” is completed. The citation appellant relies upon states, “If the offer is sent via email...” and “If the offer is sent via SMS-text...” which makes it clear that the delivery of said additional information is completed and this discussion is directed towards a later interaction by the user with said additional information. This distinction is important because the claim in question does not put any restriction on the user interacting with the delivered information, the claims are only concerned about “**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;” (emphasis added). There is no discussion in the claims or for that matter in the specification regarding restricting the user’s abilities to interact with the information once it is delivered. Thus, this argument is directly contradicted by the patent claims and the patent specification and the rejection is proper and must be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.