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For: SYSTEM AND METHOD OF ON-LINE ADVERTISING

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Madam:

Appellant submits this Reply Brief in response to the Examiner's Answer mailed December 12, 2024.

Argument

The Rejection of claims 1 and 4 under 35 USC §103 over Meyer in view of Teague

As argued in the Appeal Brief (pages 7-10), the Final Office Action cites the Meyer reference with regard to limitations of claim 1 including:

... 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 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; ...

The Final Office Action cites the Meyer reference for the disclosure of an “incentive” that the office equates with the “advertisement” of claim 1. It is noted that the Final Office Action, in fact, presents an extended argument on pages 13-16 of the Final Office Action firmly concluding that the Meyer “incentive” meets the limitations of claim 1’s “advertisement.”

Appellant pointed out in the Appeal Brief, however, that the citations in the Final Office Action relating to the above limitations of claim 1 starting at: “receiving an indication...” to the end of the above quoted section are actually referencing an “incentive icon” in the Meyer reference and not the “incentive.” The rejection over Meyer in view of Teague thus confuses the Meyer “incentive” with the Meyer “incentive icon.” Accordingly, the Meyer in view of Teague rejection of claims 1 and 4 contains a basic factual mistake that the entirety of the rejection is founded upon.

As one specific example, claim 1 contains the limitation:

...receiving an indication that the recipient activated the interactive element displayed within the advertisement;

The office addresses this limitation on page 6 of the final office action as follows:

Meyer discloses the actions that are taken ‘When a user clicks on an incentive icon...’, thus an indication that the recipient activated the interactive element (a

user clicks on an incentive icon) is received (Figs. 2 and 5A; page 46, line 19-page 47, line 24 of Meyer).

As pointed out in the Appeal Brief, the office is here citing to the Meyer “incentive icon” and not the “incentive.” This is clearly shown in Figs 2 and 5A and on pages 46 and 47 of Meyer as cited by the office. FIG 2 shows consumer clicking on “incentive icon” in the first step 201, then getting incentive template in step 203, then computing incentive characteristics using CONSUMER INFO if available in step 211, then displaying “incentive” in step 213.

Accordingly, the office has mistakenly equated Meyer’s “incentive icon” with Meyer’s “incentive.” As clearly shown and described in FIG 2, the incentive icon and the incentive are different and appear in different steps of the Meyer process. The first step of the Meyer process is to click on the incentive icon, then if a cookie is available CONSUMER INFO is accessed, and then in a later step of the process the “incentive” is produced and displayed. The “incentive icon” is not the same as the “incentive” (and is not even asserted as such in the final office action).

Meyer’s incentive icon, as cited on page 6 of the final office action, is not a disclosure of: “receiving an indication that the recipient activated the interactive element displayed within the advertisement” recited in claim 1. As discussed above, the final office action has already equated the “advertisement” in claim 1 with Meyer’s “incentive” and not the “incentive icon.” Accordingly, Meyer does not disclose or suggest “receiving an indication that the recipient activated the interactive element displayed within the advertisement” as recited in claim 1 and the rejection over Meyer in view of Teague should be reversed. See MPEP §2143.03 (“Examiners must consider all claim limitations when determining patentability of an invention over the prior art”).

Appellant notes that this same factual mistake was also made in the Terveen Declaration filed by the third-party requester (Exhibit 1003) which is referenced in the Final Office Action on page 4.

The Examiner’s Answer responds to Appellant’s argument by arguing that “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.” See Examiner’s Answer, Page 3. It is noted that the office is thus necessarily taking the position that Meyer’s “incentive” and “incentive icon” are the same. Appellant first notes that this position is nowhere taken in the Final Office Action. Accordingly, as argued in the Petition under 37 CFR 1.181 filed by Appellant on December 23, 2024, the Examiner’s position that the incentive and incentive icon are the same, is a new ground of rejection and should have been designated as such in the Examiner’s Answer.

Nevertheless, Appellant respectfully submits that review of the Meyer reference unequivocally shows that the Meyer “incentive” is not the same as the Meyer “incentive icon.” Appellant showed in the Appeal Brief that the sections of Meyer cited in the Final Office Action show that Meyer’s “incentive icon” and Meyer’s “incentive” are different entities that appear in different steps of the Meyer process. This can be clearly seen, for example, in FIGS 2 and 5 of Meyer, heavily relied upon in the Final Office Action, as discussed in the Appeal Brief.

Appellant also emphasizes at this point that the office’s statement in the Examiner’s Answer that the Meyer “incentive” and “incentive icon” *“are not separate from each other, rather an incentive icon is included as a part of the incentive,”* can only be understood in the context of a rejection under 35 USC §103 as asserting that they are the same. If they are not the same, then it would be incumbent upon the office to provide an explanation or rationale demonstrating how it would have been obvious to modify the Meyer “incentive icon” into the Meyer “incentive” and arrive at the present invention, in order to establish a proper *prima facie* case of obviousness. As mentioned above, the Final Office Action makes no mention of this issue and simply cites the “incentive icon” as if it were the same as the “incentive” without further explanation.

The Examiner’s Answer cites three previously uncited sections of Meyer in support of the argument that the Meyer “incentive” is the same as the Meyer “incentive icon.” Appellant addresses each in turn below.

The Examiner’s Answer (pages 3-4, bridge paragraph) first cites page 10, line 12 to page 11, line 4 of Meyer and specifically highlights in bold a statement by Meyer as shown below:

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).

Appellant notes that Meyer's highlighted statement above (from the SUMMARY section) is a broad description of the invention. The highlighted Meyer statement that an incentive may include an incentive existence message, that may include an incentive icon, is a broad description of all of the elements of the Meyer invention and process. There is nothing in this statement that indicates the relationship of the "incentive," "incentive existence message", and "incentive icon" with each other in the Meyer process. In fact, two sentences later in the above quoted section, Meyer goes on to expressly describe the relationship of the incentive, the incentive existence message, and the incentive icon. This discussion (quoted above) is repeated below for convenience:

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).

Meyer thus broadly discloses two embodiments for *selecting* an incentive at one or more locations of a network. In one embodiment an *incentive icon* is clicked, this *generates* an *incentive existence message* (possibly together with other incentive existence messages), which when selected generates the incentive. Alternatively, an incentive existence message or icon is clicked or activated, and the incentive is subsequently produced.

This is shown graphically in Meyer's FIG 2. The Meyer process provides an incentive icon that is clicked (or otherwise activated), consumer info is accessed, and an "incentive" (coupon) is generated

that includes one or more parameters based on the consumer info. Thus, in general terms, the Meyer invention discloses a process that uses an “incentive icon” for incorporating “consumer info” into a subsequently generated “incentive” (coupon).

It can thus be readily seen that Meyer’s quoted statement: “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” is simply reciting the various entities included in the overall process. Meyer’s invention is a process, and Meyer is stating that their inventive process includes incentives, incentive existence messages, and incentive icons. Accordingly, the Meyer statement in bold above does not in any way imply that the incentives, incentive existence messages, and incentive icons are the same and can be cited interchangeably with each other as argued in the Examiner’s Answer.

The Examiner’s Answer further argues at the bottom of page 4:

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).

Appellant respectfully submits that this is incorrect as a matter of fact. Meyer does not disclose that one or more of the incentive parameters is displayed prior to activating the incentive icon or incentive existence message. The Examiner’s Answer cites page 11, lines 5-20 of Meyer, which refers to an “automatic” activation of an incentive icon, in support of the proposition. Appellant provides below the relevant part of this section of Meyer quoted in the Examiner’s Answer (emphasis provided in the Examiner’s Answer):

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.**

This section of Meyer is describing that “activating” an incentive icon or incentive existence message may be automatic when one accesses a particular location that includes the incentive icon. That is, in order to “activate” the incentive icon (and produce the incentive) it is not absolutely necessary to click on the icon, the selecting mechanism may be automatic when the location is accessed by a consumer. This does not in any way change the basic process of the Meyer invention. Meyer is

explaining that the icon does not have to be clicked on and that it may be activated automatically by scrolling to it on a webpage. Either way, an incentive icon or incentive existence message is first activated, consumer info is accessed, and the incentive (coupon) is then generated in a subsequent step.

Meyer also immediately follows the above quoted section with the following description of the preferred embodiment (emphasis provided in the Examiner's Answer):

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 or 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.

This section is describing that "consumer info" is used to generate the incentive and apparently may also be used for characteristics of the incentive existence message. Meyer is stating here that one or more of the displayed parameters of the incentive or incentive existence message are dependent on one or more characteristics of the consumer. Meyer is here continuing the discussion of the automatic embodiment where activating the incentive existence message or icon automatically produces the incentive. Apparently, in this case, characteristics of the incentive existence message or icon can also be based on characteristics of the consumer. This in no way infers that the incentive existence message or icon is the same as the incentive. Meyer in this section consistently describes the incentive existence message or incentive icon, and the incentive, as separate entities that perform separate functions in the Meyer process. In the embodiment where clicking on the incentive icon produces the incentive, the consumer info is accessed upon clicking. This is shown in FIG 2.

The Examiner's Answer next quotes page 12, lines 8-25, of Meyer and argues as follows:

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:

It is here noted that the “additional information associated with the advertisement” is based on “at least a portion of the user profile associated with recipient” in present claim 1. The Examiner’s Answer then quotes the following section of Meyer page 12 (emphasis as supplied in the Examiner’s Answer):

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.

It is first noted that, on its face, this section of Meyer is again describing the general process disclosed by Meyer of clicking on an incentive existence message or icon, accessing consumer info, and producing an incentive with one or more parameters based on the consumer info. Nevertheless, at the bottom of page 6 of the Examiner’s Answer, FIG 21 of Meyer is reproduced by the Examiner and the Examiner’s Answer argues that in the incentive shown in FIG 21, a “Details” hyperlink may be clicked which corresponds with “displaying another one or more of the parameters of the particular incentive” quoted above. The Examiner’s Answer is thus attempting to equate the “Details” hyperlink in FIG 21 with the reference on page 12 of displaying “another” one or more parameters of the incentive by clicking on the incentive icon.

In fact, there is no reference to FIG 21 anywhere on page 12 of Meyer. Meyer does not describe clicking on the “Details” hyperlink as an example of clicking on the incentive icon. This would be in direct contradiction to the overall process described on page 12. As a matter of fact, the quoted section above on page 12 is immediately followed with the preferred embodiment, wherein clicking on the incentive icon causes a new display window to appear displaying the *incentive*. The “Details” hyperlink in FIG 21 is not mentioned on page 12 and is not described by Meyer as being the same as an incentive existence message or icon. Respectfully, there is no connection between the “Details” hyperlink in FIG 21 and the discussion on page 12 of Meyer and there is nothing in Meyer that teaches otherwise.

FIG 21 of Meyer is described at page 52, line 19. There Meyer states that FIG 21 corresponds to the incentive template illustrated in FIG 19. The “Details” hyperlink of FIG 21 is thus described at the top of page 35 of Meyer in connection with Fig 19. There Meyer describes that the Details hyperlink produces the “terms and conditions” that describe the incentive. That is, the legal details and requirements associated with the incentive. Thus, clicking on the “Details” hyperlink produces the legal or contractual requirements associated with the incentive. This does not in any way support the

Examiner's assertion that the "incentive icon" is the same or can be interchangeably cited with the "incentive." The "Details" hyperlink is not an incentive icon or an incentive existence message and is not taught as such by Meyer.

It is thus demonstrated above that the Meyer "incentive icon" is a different entity from the Meyer "incentive" and appears at a different point in the Meyer process. This is consistently taught by Meyer in all of the sections of Meyer cited in the Final Office Action and the Examiner's Answer. There is nothing in Meyer to suggest that the "incentive icon" is the same as the "incentive" as asserted in the Examiner's Answer.

The office's *prima facie* case of obviousness is thus fundamentally flawed. Since the Meyer "incentive" and "incentive icon" are not the same, the rejection under 35 USC §103 must provide an explanation showing how the Meyer incentive icon can be modified to be interchangeably citable with the Meyer incentive, and/or to somehow lead to the presently claimed methods. There is no such explanation anywhere in the record of this proceeding. As pointed out above, the Final Office Action does not mention this issue, and the Examiner's Answer only attempts to argue that the "incentive" and "incentive icon" are the same.

It is basic to any rejection under 35 USC §103 that office personnel explain how any differences between the claimed invention and the prior art would have been obvious to one of ordinary skill in the art. See MPEP §2141(III) ("...Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art."). Accordingly, the rejection under 35 USC §103 fails to establish a *prima facie* case of obviousness and the rejection of claims 1 and 4 over Meyer in view of Teague must be reversed.

With regard to the Examiner's reliance on the Teague reference, Appellant reiterates the arguments presented in its Appeal Brief, pages 10 – 21, that demonstrate that Teague fails to disclose or suggest the limitation of claim 1 of "delivering further information without interrupting the browsing session of the recipient".

The Examiner's Answer responds by arguing that paragraph [0071] of Teague discloses 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." Examiner's Answer, page 11. This statement in Teague, however, specifically states that when a user clicks on an offer, "the non-system website interacts with CMS 102 to identify the terms of the offer and the user's preferred delivery method" Paragraph [0071] of

Teague. Contrary to the Examiner's interpretation, this disclosure does not state that the terms of the offer are "delivered" to the user but rather are "identified". By identifying the terms of the offer, this necessarily interrupts the browsing session of the user – contrary to the language of claim 1 that provides for "delivering further information without interrupting the browsing session of the recipient." Thus, Teague does not disclose or imply that this is done without interrupting the browsing session of the recipient as recited in claim 1.

Thus, paragraph [0071] of Teague does not support the office's assertion that delivering further information without interrupting the browsing session of the recipient is disclosed by Teague. As mentioned, paragraph [0071] describes that the website user clicks 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." The context of the Teague disclosure shows that the system would necessarily have to pull the terms of the offer and show them to the user to determine if the user should be sent additional information. This is the proper interpretation, and this would necessarily interrupt the browsing session. One of ordinary skill would understand that there must be some communication between the website and the CMS to identify the user's email information or phone number or additional information could not be sent to the user.

As expressly stated in [0071], when user 108 clicks on the offer, the CMS identifies the terms of the offer to user 108, and this necessarily interrupts the browsing session. To conclude otherwise is to read something more into the Teague reference than what is taught. In paragraph [0071], Teague never states or discloses that the ad information or terms of the offer are sent without disclosing them (or some other information) first to the user, in which case the browsing session would necessarily be interrupted. There is no enabling disclosure of how one could perform the steps recited in claim 1 without interrupting the browsing session of a user.

Accordingly, the combination of Meyer and Teague does not disclose or suggest delivering further information without interrupting the browsing session of the recipient as recited in claim 1. Accordingly, the rejection of claims 1 and 4 over Meyer in view of Teague should be reversed.

Conclusion

In view of the foregoing, the rejection of claims 1 and 4 should be reversed.

Respectfully submitted,

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