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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/407,622	02/28/2012	Gregory J. Mesaros	EWIN-013DVA	4039
105882	7590	07/07/2014	EXAMINER	
Lewis Roca Rothgerber LLP - eWinWin Inc. 4300 Bohannon Drive Suite 230 Menlo Park, CA 94025			FADOK, MARK A	
			ART UNIT	PAPER NUMBER
			3684	
			NOTIFICATION DATE	DELIVERY MODE
			07/07/2014	ELECTRONIC

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gmesaros@ewinwin.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 13/407,622	<b>Applicant(s)</b> MESAROS, GREGORY J.	
	<b>Examiner</b> MARK FADOK	<b>Art Unit</b> 3684	<b>AIA (First Inventor to File) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 4/9/2014.
  - A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims\*

- 5)  Claim(s) 1-10 is/are pending in the application.
  - 5a) Of the above claim(s) 2,4,5, and 7-10 is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1,3 and 6 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

\* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see [http://www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp) or send an inquiry to [PPHfeedback@uspto.gov](mailto:PPHfeedback@uspto.gov).

#### Application Papers

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

#### Certified copies:

- a)  All    b)  Some\*\*    c)  None of the:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)  
Paper No(s)/Mail Date \_\_\_\_\_
- 3)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 4)  Other: \_\_\_\_\_

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The present application is being examined under the pre-AIA first to invent provisions.

In view of the **appeal**, filed on **4/9/2014**, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JASON DUNHAM/

Supervisory Patent Examiner, Art Unit 3684

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is not directed to patent eligible subject matter. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1, 3 are determined to be directed to an abstract idea. The rationale for this determination is explained below:

The claimed invention is directed to non-statutory subject matter because as determined by the Supreme Court Decision of *Alice Corporation Pty. Ltd v. Cls Bank International, et al.*, the claims are “an idea of itself” that add “...nothing more than an instruction to apply the abstract idea...using some unspecified, generic computer.” are not patentable. The claims describe an abstract idea in a method for communicating an offer. The remainder of the limitations, require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known in the industry and add nothing of substance to the abstract idea (refer to rejection below, that points out that the myriad of featured limitation were known in the art). The claims as a whole “do not, for example, purport to improve the functioning of the computer itself or effect an improvement in any other technology or technical field”., therefore the claims are rejected being directed to an abstract idea.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112(a):

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

The following is a quotation of the first paragraph of pre-AIA 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case there is no support for the negative limitation “the set of terms being non-negotiable. In fact the specification teaches away from this limitation in that para 0083 of applicant’s specification where it is stated that the conditions and terms are agreed to between the parties. Therefore, this limitation needs to be removed in the next submittal.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojha, (US Patent 6,598,026) and Walker et al (US Patent 5,794,207 which is included in the Ojha reference in its entirety by reference (Ojha col 1, lines 66) in view of Kramer (US Patent 6,327,574).**

**In regards to claim 1**, Ojha discloses a method for profile based delivery of offers, the method comprising

receiving offer information from a merchant at a server over a communications network (Ojha, col 19, lines 54-67 - col 20, lines 1-5), the offer information including:

an identification of a good or service and to be made available to a user (Ojha, FIG 11, product), when the good or service will be made available to the user (Ojha, FIG 13G when the criteria is true the product is made available to the buyer),

a quantity of the good or service to be made available to the user (Ojha, FIG 11, Units), and

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terms related to the good or service that must be accepted by the user within a predetermined period of time (Ojha, FIG 13A), the set of terms being non-negotiable;

and

executing instructions stored in memory, wherein execution of the instructions by a processor:

stores the offer information received from the merchant in a non-transitory computer readable storage medium (Ojha, col 19, lines 54-67 - col 20, lines 1-5, product information is stored in a central server where the website is located); and

delivering an offer corresponding to the offer information to the user (Ojha, FIG 13D, and 11),

the offer delivered to the user when a buyer profile associated with the user corresponds to one or more elements of the offer information (Ojha, FIG 13I),

Ojha teaches using marketing information from previous transactions (Ojha, col 12, lines 35-45, col 14, lines 23-37, col 18, lines 52-61) and retrieving transactions from outside sources related to a financial account (Ojha, col 14, lines 38-48), but does not specifically mention the buyer profile including information related to both online and offline purchases. Kramer teaches creating a profile from both online and offline transactional behaviors (col 2, lines 56-col 3, line 9, FIG 3A and 3B). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Ojha, the buyer profile including information related to both online and offline purchases associated with a financial account as is taught by Kramer, because this will

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increase the effectiveness of the profile by expanding the scope of information that is analyzed,

wherein the information includes a shipping or delivery location (Ojha, FIG 8, in stock?, Walker, col 13, lines 1-10),

wherein the offer is valid for purchase only during the predetermined period of time (Ojha, FIG 13C).

Ojha teaches presenting additional discounts based on purchase behavior (Ojha, FIG 13K, col 3, lines 22-57), but does not specifically mention that at least in part, on both the online and offline purchases. Kramer teaches using both online and offline transaction behavior to in a profile database. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Ojha the use of both online and offline behavior, because this increase the amount of information from which a discounting decision may be made, thus making the decision more accurate.

**In regards to claim 3,** Kramer teaches wherein the information related to both the online and offline purchases includes a supplier (Kramer, FIG 2).

**Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojha, (US Patent 6,598,026) in view of Kramer (US Patent 6,327,574) and further in view of Official Notice.**



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**In regards to claim 6**, Kramer teaches delivering advertisements to users, but does not specifically mention delivering includes delivering the offer to the user on a regularly scheduled basis. The examiner takes official notice that delivering advertisements on a regularly scheduled basis was notoriously well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Kramer, delivering the offer to the user on a regularly scheduled basis, because repeat advertisement is known to be effective in enticing a user to purchase the advertised product.

### ***Response to Arguments***

Applicant's arguments filed in the Appeal Brief have been fully considered but they are not persuasive.

Applicant argues that Ojha does not teach “terms related to the good or service that must be accepted by the user within a predetermined period of time, the set of terms being non-negotiable. The examiner disagrees and directs applicant to FIG 13C where an offer including terms is provided to the buyer with an offer price that is good for a predetermined period of time (8 hours) that does not have a condition open to negotiation. Furthermore as stated supra in a USC 112 rejection there is no support for the terms being non-negotiable.

Applicant argues that the combination of Ojha, Walker and Kramer do not teach “delivering an offer corresponding to the offer information to the buyer. The examiner

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disagrees and notes that clearly offer information corresponding to offer information is being submitted to a buyer in fig 13D.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., buyer's bids are non-negotiable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the combination of Ojha, Walker and Kramer does not teach that the offer is delivered to the user when a buyer profile associated with the user corresponds to one or more elements of the offer information. The examiner disagrees and notes that FIG 13e where the buyers profile (reputation) matches a particular threshold then a special offer such as a volume discount or percentage discount is provide the user (see also Ojha, col 16, lines 5-55).

Applicant argues that the combination of Ojha, Walker and Kramer does not teach storing information in a profile that includes both online and offline information. Clearly Ojha teaches storing information regarding the buyers profile (reputation) and

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Kramer teaches that it was well-known to save information on a buyers (col 2, lines 38-44, col 8, lines 64- col 9, lines 17).

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the examiner has used motivation to do so found either in the references themselves and available to one of ordinary skill in the art.

Applicant argues that the combination of Ojha, Walker and Kramer does not teach a shipping or delivery location. The examiner disagrees and directs applicant's attention to Ojha, col 4, lines 20-25, col 19, lines 1-10, Walker, claim 1, Kramer, col 21, lines 45-60).

Applicant argues that the teachings of Ojha cannot be combined with Walker. Appellant lists a litany of reason why the combination of Ojha and Walker may not be combined. The examiner notes that that Walker is incorporated in the Ojha reference in its entirety for all purposes (Ojha, col 2, lines 1-10). It is further noted that MPEP 2163.07(b) Incorporation by Reference, States, "Instead of repeating some information

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contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter". Applicant's arguments are determined to be invalid since the entirety of the Walker reference is deemed incorporated by its designation as such in the Ojha reference.

Appellant is understood to argue that the Ojha reference cannot be used because it uses a system that includes both a "buy it now" feature and a negotiating feature should the buyer reject the initial offered price. The examiner notes that the buy button that is found at least in Fig 16 of Ojha creates a means that when pressed, purchases the product at a static price that is non-negotiable. The examiner has further supported the use of Ojha by stating that omitting the additional element of negotiation and using only a single buy price that is not negotiable if not desired was obvious (see Ex Parte Wu). In an effort to clarify the state of the art the examiner further directs the Appellant's attention to Walker (5,794,207) para 1, lines 30-35, where it is stated that "the vast majority of retail purchases utilize...fixed price , non-negotiable pricing protocols".

The examiner also notes that **Omission of an Element and Its Function Is Obvious if the Function of the Element Is Not Desired**. The MPEP goes on to state in *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were

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directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient) (See MPEP 2144.04 IIA).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jason Dunham** can be reached on **571.272.8103**.

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Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300**

[Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Mark Fadok

Primary Examiner, Art Unit 3625