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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/491,449	06/07/2012	Gregory J. Mesaros	EWIN-013COO	4362
105882	7590	07/24/2014	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
			07/24/2014	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):

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<b>Office Action Summary</b>	<b>Application No.</b> 13/491,449	<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 6/16/2014.  
 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) 1,3-5 and 8-33 is/are pending in the application.  
5a) Of the above claim(s) 3-5,10,11,17 and 20-30 is/are withdrawn from consideration.
- 6)  Claim(s) \_\_\_\_\_ is/are allowed.
- 7)  Claim(s) 1,8,9,12-16,18,19 and 31-33 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 **6/16/2014**, 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:

Supervisory Patent Examiner, Art Unit 3684

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 2/14/2014, which was received 6/16/2014. Acknowledgement is made that no amendments were provided. Applicant's remarks were persuasive, however after further search and consideration the following new ground of rejection is provided below:

***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) 1,8,9,12-16,18,19, and 31-33 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 of processing a discounted offer. The remainder of the limitations, which include providing a merchant account, storing information about the merchant, Presenting an offer by the merchant, performing a buyer requested search including product category, quality rating, presenting feedback,

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storing information in a buyer profile, and associating financial account information with a buyer profile are no more than a generic computer performing 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. 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 as being directed to an abstract idea.

### ***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 1,8,14-16,19,31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojha et al (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) and in view of Fusz (US Patent 7133835) and further in view of Wanker (US Patent 7,302,429)**

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**In regards to claim 1**, Ojha discloses a non-transitory computer readable storage medium having embodied thereon a program, the program being executable by a processor to perform a method for providing a discounted offer, the method comprising:

providing a merchant account;

storing information about the merchant in the merchant account (Ojha FIG 13A-K, Walker col 13, lines 10-22, col 14, lines 1-8),

The combination of Ojha and Walker teach storing seller data, but do not specifically mention that the data stored is a location associated with the merchant.

Fusz teaches creating institutional accounts to store the locations of both the buyers and sellers (col 5, lines 20-25). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Ojha and Walker, storing the location of the seller, since this is a critical piece of information when matching of buyers and sellers is determined based on geography. It is also important in determining shipping costs by a third part carrier.

and

The combination of Ojha, Walker and Fusz teach rating information from at least one past customer (Ojha col 10, lines 31-62, col 3, lines 44-57, Walker col 13, line 63- col 14, line 7 ) and also teaches that the collected rating information may be used for decision making (Ojha, col 10, lines 58-61), but does not specifically mention that the information is viewable by the merchant. However, it would have been obvious to try, by one of ordinary skill in the art at the time the invention was made, to allow the merchant

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to view rating given by the buyer regarding the sellers performance since there are a finite number of identified, predictable potential solutions (i.e. allow review of not) to a recognized need (rating information may be used for decision making) and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success (the benefits of providing information for decision making was well understood).;

presenting an offer by the merchant (Ojha FIG 5, Fusz, FIG 11),

The combination of Ojha, Walker and Fusz teach a shipping and location information, but does not specifically mention wherein the offer includes a location and delivery information associated with the good or service. Wanker teaches developing shipping costs (delivery information) associated with the good or service offered (col 1, lines 35-47). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Ojha, Walker and Fusz the offer includes a location and delivery information associated with the good or service as taught by Wanker, because this will provide the buyer with a bottom line price that may be better compared because it is a bottom line price that includes a variable such as Shipping costs.

performing a search for offers in response to a buyer request, wherein the buyer is presented with the ability to search for offers based on:

a product category (Ojha col 14, lines 23-37, Wanker, col 2, lines 43-59), and

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a quality rating associated with a plurality of merchants providing offers within the product category (Wanker, col 4, lines 30-45)

wherein the feedback is recorded without requiring the buyer to solicit feedback from the at least one past customer (Wanker, FIG 4B);

The combination of Ojha, Walker, Fusz and Wanker teach storing buyer profile information in an account, but does not specifically mention the information including an indication of interest from the buyer, an email address, and a location associated with the buyer (Pallakoff, col 7, lines 15-30). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Ojha, Walker, Fusz and Wanker, the information including an indication of interest from the buyer, an email address, and a location associated with the buyer as is taught by Pallakoff, because this will provide another means of contacting the customer when they exhibit interest in the product for sale by the seller.

associating financial account information with the buyer profile (Walker col 13, lines 63-67, Wanker, col 5, lines 33-60).

**In regards to claim 8**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the quality rating references a minimum rating associated with the plurality of merchants providing offers (Wanker, col, 19, lines 37-55).



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**In regards to claim 9**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the information is available on the merchant account and includes stored data associated with current and past offers, total revenues for offers, and customer feedback associated with past offers (see response to claim 1).

**In regards to claim 12**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the information is updated and presented in the form of a chart table or graph (Wanker, Fig 2F).

**In regards to claim 13**, the combination of Ojha, Walker, Fusz and Wanker wherein the rating information includes information provided by the least one customer that relates to the quality of the communication by the merchant (Wanker, FIG 2G item 282).

**In regards to claim 14**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the financial account information includes a credit card associated with the buyer (Ojha col 3, lines 44-58)

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**In regards to claim 15**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the financial account information includes additional points or rewards which can be accumulated and stored to a buyer profile (Ojha col 3, lines 44-58 and col 19, lines 30-52, col 7, lines 22-45).

**In regards to claim 16**, the combination of Ojha, Walker, Fusz and Wanker teaches wherein the points or rewards are provided by a third party (Ojha col 3, lines 44-58 and col 19, lines 30-52, col 7, lines 22-45).

**In regards to claim 18**, the combination of Ojha, Walker, Fusz and Wanker teaches wherein the rating information includes information collected from the least one customer that relates to timeliness of delivery by the merchant (Wanker, col 15, lines 50-67).

**In regards to claim 19**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the offer is a one-time offer or an offer that has an accrual function associated with it that tracks a total amount purchased by a particular buyer and determines whether a threshold amount has been reached that the buyer to receive the discount or incentive (Ojha FIG 13H, 13C)

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**In regards to claim 31**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the new information includes payments made by the buyer and viewable by the buyer (Walker col 21, lines col 21, lines 23-67).

**In regards to claim 32**, the combination of Ojha, Walker, Fusz and Wanker teach updating the buyer profile with new information (Wanker, FIG 2F).

**In regards to claim 9**, the combination of Ojha, Walker, Fusz and Wanker teach wherein the buyer is contacted by way of an email address or phone number stored in the buyer profile when the buyer profile has been updated (Walker col 13, lines 1-9).

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

Applicant's arguments with respect to claim *1,8,9,12-16,18,19 and 31-33* have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

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., ranking returned objects) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

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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 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, All three cases are directed to means of conducting ecommerce.

In response to applicant's argument that each reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all the references are related to the field of ecommerce.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***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 **571.272.8109**.

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"]

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Mark Fadok

Primary Examiner, Art Unit 3625