UNITED STATES PATENT AND TRADEMARK OFFICE

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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.

-- 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 <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 <u>04 June 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ 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

4)☒ Claim(s) <u>1-2, 4-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-10,12-14,16,17, 19, 21-25</u> is/are rejected.

7)☒ Claim(s) <u>11,15, 18, 20</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ 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).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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).

    a)☐ All b)☐ Some * c)☐ None of:

      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) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/03/2009, 06/04/2009</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   Claim 17 is objected to because of the following informalities: The phrase 'user profile variable' lacks antecedent basis. Examiner has interpreted this as 'a user profile variable' for the purpose of examination. Appropriate correction is required.

2.   Claim 21 is objected to because of the following informalities: The phrase 'site website' is redundant. It should be replaced by either of the terms –site-- or –website--.

Allowable Subject Matter

3.   Claims 11, 15, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   **Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

3.   A claim invoking 35 U.S.C. § 112 6th paragraph is indefinite if the means for performing the claimed function lacks corresponding structure. In this case,

the specification does not disclose any particular algorithm(s) by which the

means plus function claims can be implemented. A general purpose computer in

and of itself cannot be considered sufficient corresponding structure. Therefore,

the claim is indefinite. See MPEP § 2181.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   **Claims 1, 6, 23-25 are rejected under 35 U.S.C. 102(b) as being**

anticipated by Advertising.com (Visitorbid.com website).

1.   Regarding claim 1 Advertising.com teaches a method for leasing of

domain names in an electronic marketplace, comprising:

        (a) receiving domain names from lessors at an electronic marketplace

(Advertising.com: p. 9 [*How many domains can I register?*]);

        (b) presenting the domain names for lease of redirected traffic utilizing the

electronic marketplace (Advertising.com: p. 2 [*You choose which domains to bid*

on and how much you want to pay...]), wherein a potential lessee can specify

criteria for selecting the domain names on which the potential lessee wishes to

bid (Advertising.com: p. 12 [*14. Choose from View Categories, Search*

Categories and View Campaigns... a. Under View Categories you will find all

available domain categories. Click on each one to see the site names within each

category... 15. Choose the domain name(s) on which you would like to bid.]);

(c) receiving a bid from each of a plurality of bidding lessees

(Advertising.com: p. 2) at the electronic marketplace that includes information on

lessors, lessees (Advertising.com:p. 1 - both lessors and lessees must register

accounts), bid terms (Advertising.com: p. 2 [*...how much you want to pay...*]),

payment transfers from lessees to lessors (Advertising.com: p. 8 [*Where do I add*

funds to my account?]);

(d) comparing bid amounts for a domain name matching the criteria

(Advertising.com: p. 12) to determine at least one winning bid (Advertising.com:

p. 2 [*...automated bidding technology designed to ensure your bid is accepted at*

the lowest possible expense...]); and

(e) automatically redirecting traffic associated with the domain name to an

internet site associated with the winning bid (Advertising.com: p. 2 [*In-line*

Redirect]).

2.   Regarding claim 6, the method of claim 1, wherein visitor traffic is

redirected from lessors to lessees through the marketplace, where the redirected

traffic can be tracked by the marketplace (Advertising.com: p. 2).

3.   Regarding claim 23, a computer-readable medium having stored thereon

a set of instructions that are executable by at least one processor of a computer

system to carry out a method of leasing domain names, comprising:

(a) receiving domain names from lessors at an electronic marketplace (Advertising.com: p. 9 [*How many domains can I register?*]);

(b) presenting the domain names for lease of redirected traffic utilizing the electronic marketplace (Advertising.com: p. 2 [*You choose which domains to bid on and how much you want to pay...*]), wherein a potential lessee can specify criteria for selecting the domain names on which the potential lessee wishes to bid (Advertising.com: p. 12 [*14. Choose from View Categories, Search Categories and View Campaigns... a. Under View Categories you will find all available domain categories. Click on each one to see the site names within each category... 15. Choose the domain name(s) on which you would like to bid.*]);

(c) receiving a bid from each of a plurality of bidding lessees (Advertising.com: p. 2) at the electronic marketplace that includes information on lessors, lessees (Advertising.com:p. 1 - both lessors and lessees must register accounts), bid terms (Advertising.com: p. 2 [*...how much you want to pay...*]), payment transfers from lessees to lessors (Advertising.com: p. 8 [*Where do I add funds to my account?*]);

(d) comparing bid amounts for a domain name matching the criteria (Advertising.com: p. 12) to determine at least one winning bid (Advertising.com: p. 2 [*...automated bidding technology designed to ensure your bid is accepted at the lowest possible expense...*]); and

(e) automatically redirecting traffic associated with the domain name to an internet site associated with the winning bid (Advertising.com: p. 2 [*In-line*

Redirect]).

4.   Regarding claim 24, a computer system for leasing domain names,

comprising:

        (a) means for receiving domain names from lessors at an electronic

marketplace (Advertising.com: p. 9 [*How many domains can I register?*]);

        (b) means for presenting the domain names for lease of redirected traffic

utilizing the electronic marketplace (Advertising.com: p. 2 [*You choose which

domains to bid on and how much you want to pay...*]), wherein a potential lessee

can specify criteria for selecting the domain names on which the potential lessee

wishes to bid (Advertising.com: p. 12 [*14. Choose from View Categories, Search

Categories and View Campaigns... a. Under View Categories you will find all

available domain categories. Click on each one to see the site names within each

category... 15. Choose the domain name(s) on which you would like to bid.*]);

        (c) means for receiving a bid from each of a plurality of bidding lessees

(Advertising.com: p. 2) at the electronic marketplace that includes information on

lessors, lessees (Advertising.com:p. 1 - both lessors and lessees must register

accounts), bid terms (Advertising.com: p. 2 [*...how much you want to pay...*]),

payment transfers from lessees to lessors (Advertising.com: p. 8 [*Where do I add

funds to my account?*]);

        (d) means for comparing bid amounts for a domain name matching the

criteria (Advertising.com: p. 12) to determine at least one winning bid

(Advertising.com: p. 2 [*...automated bidding technology designed to ensure your*

bid is accepted at the lowest possible expense...]); and

(e) means for automatically redirecting traffic associated with the domain name to an internet site associated with the winning bid (Advertising.com: p. 2 [*In-line Redirect*]).

5.   Regarding claim 25, a computer system for leasing of domain names comprising:

at least one processor (Advertising.com: p. 2 - inherent);

a storage device connected to the processor (Advertising.com: p. 2 - inherent); and

a set of instructions on the storage device, the set of instructions being readable by the processor (Advertising.com: p. 2 - inherent) and including:

a domain name receiving module to receive domain names from lessors (Advertising.com: p. 9 [*How many domains can I register?*]);

at least one data store to store the domain names (Advertising.com: p. 2 - inherent);

a presentation module to present the domain names for lease of redirected traffic (Advertising.com: p. 2 [*You choose which domains to bid on and how much you want to pay...*]) wherein a potential lessee can specify a criteria for selecting the domain name on which the potential lessee wishes to bid (Advertising.com: p. 12 [*14. Choose from View Categories, Search Categories and View Campaigns... a. Under View Categories you will find all available domain categories. Click on each one to see the site names within each*

category... 15. Choose the domain name(s) on which you would like to bid.]);

a bid receiving module to receive bid from each of a plurality of bidding

lessees (Advertising.com: p. 2) that includes information on lessors

(Advertising.com: p. 1 - both lessors and lessees must register accounts), bid

terms Advertising.com: p. 2 [*...how much you want to pay...*]), and payment

transfers from lessees to lessors (Advertising.com: p. 8 [*Where do I add funds to

my account?*]), each bid being for a bid amount (Advertising.com: p. 2), the

information being stored in the data store (Advertising.com: p. 2);

an association module to associate each bid with a respective domain

name matching the criteria (Advertising.com: p. 12 #14, p. 14 [*An Advertiser who

elects to use the Service may, at any time, submit a bid by logging into the

VisitorBid.com web site and initiating one or more bids based on individual

domain names or categories of domains that participate in the Network.*]);

a comparing module to compare bid amounts associated with the domain

name matching the criteria (Advertising.com: p. 12) to determine at least one

winning bid (Advertising.com: p. 2 [*...automated bidding technology designed to

ensure your bid is accepted at the lowest possible expense...*]); and

a redirection module to automatically redirect traffic associated with the

domain name to an internet site associated with the winning bid of a winning

lessee (Advertising.com: p. 2 [*In-line Redirect*]).

Claim Rejections - 35 USC § 103

6.   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 though 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 negatived by the manner in which the
> invention was made.

7.   Claims 2, 4-5, 7-10, 12-14, 16-17, 19, 21-22 are rejected under 35

U.S.C. 103(a) as being unpatentable over Advertising.com (Visitorbid.com

website) in view of Sullivan et al. (2005/0105513).

8.   Regarding claim 2, Advertising.com does not explicitly teach the method

of claim 1, further comprising:

establishing criteria for selecting a winning bid for redirected traffic from a

domain name, the criteria including at least one variable selected from the group

consisting of

the online behavior of a visitor to the domain name,

the prior redirect history of a visitor to the domain name,

the geographic location of a visitor to the domain name,

the time period covered by a bid,

keywords provided by the lessor and/or potential lessee,

the total revenue received from a bidding lessee,

the geographic location of the bidding lessee, and

conversion rate of visitors to paying customers.

However, Sullivan teaches a technique of establishing criteria for selecting a winning bid for redirected traffic from a domain name (Sullivan: par 0103 [...*allowing potential buyers of redirection services to bid on various traffic before it is redirected...*]), the criteria including the geographic location of the bidding lessee (Sullivan: par 0103 [...*allowing the traffic to be classified by one or more criteria, such as geographic location...*]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Advertising.com and Sullivan with predictable results. One would be motivated to make the combination in order to enable the domain marketplace of Advertising.com to sell specifically targeted traffic, which would ensure higher quality redirections for advertisers. One would still further be motivated to combine the references due to their similarity; both references are systems for bidding for redirected traffic from a particular domain. As such, it would be readily apparent to one of ordinary skill that their teachings are interchangeable. It would also be readily apparent that the benefits gained from any particular feature in one system would result in the same benefit to the other. One would still further be motivated to combine the references because of the suggestion in Sullivan that the system be modified (Sullivan: par 0118).

9.   Regarding claim 4, the method of claim 1, wherein the winning lessee is

the exclusive recipient of redirected traffic during a specified time period

(Sullivan: par 0051, 0103).

10.   Regarding claim 5, the method of claim 1, wherein a plurality of winning

lessees receive redirected traffic during specified time periods (Sullivan: par

0051, 0103) on a prioritized basis established by weighting at least one variable

selected from the group consisting of

        the monetary amount of each winning lessee's bid (Advertising.com: p. 2),

        keywords provided by each winning lessee,

        the total revenue received from each winning lessee,

        time of day specified by each winning lessee's bid (Sullivan: par 0103),

        the geographic location of each winning lessee (Sullivan: par 0103), and

        conversion rate of visitors to paying customers.

11.   Regarding claim 7, the method of claim 2, further comprising:

        (a) receiving from each bidding lessee a cap to the amount spent in a

specified time period for redirected traffic (Advertising.com: p. 15-16 [*...provided

that Advertiser has an approved line of credit with the Company, Advertiser

understands that its bids may be delayed or inactive if bids placed by Advertiser's

result in Advertiser exceeding its approved line of credit.*]); and

        (b) redirecting traffic away from the internet site of a winning lessee when

the amount spent reaches the cap (Advertising.com: p. 15-16 [*...provided that*

Advertiser has an approved line of credit with the Company, Advertiser

understands that its bids may be delayed or inactive if bids placed by Advertiser's

result in Advertiser exceeding its approved line of credit.]).

12.   Regarding claim 8, the method of claim 2, wherein a bidding lessee bids

for redirected traffic from a plurality of domain names (Advertising.com: p. 2).

13.   Regarding claim 9, the method of claim 2, wherein one lessor retains

permission to control and manage one or more other lessor domains

(Advertising.com: p. 1 [...*you may even choose to redirect your traffic instantly to*

the highest bidders.]).

14.   Regarding claim 10, the method of claim 2, wherein a bidding lessee may

submit new bids at any time in an attempt to outbid a prior winning lessee for

redirected traffic, thereby becoming the new winning lessee (Advertising.com: p.

2), further comprising:

        periodically automatically repeating (c) to (e), wherein the winning bid

changes from one lessee to a new lessee, the new lessee thereby becoming the

new winning lessee (Advertising.com: p. 2 [*Auto Bid*]).

15.   Regarding claim 12, the method of claim 1, further comprising:

        (a) collecting payment from the winning lessee (Advertising.com: p. 2);

and

(b) transferring payment to the lessor of the domain name

(Advertising.com: p. 2).

16.   Regarding claim 13, the method of claim 12, wherein a plurality of

selected lessees receive redirected traffic during specified time periods (Sullivan:

par 0051, 0103) on a prioritized basis established by weighting at least one

variable selected from the group consisting of

      the monetary amount of each winning lessee's bid (Advertising.com: p. 2),

      keywords provided by each winning lessee,

      the total revenue received from each winning lessee,

      time of day specified by each winning lessee's bid,

      the geographic location of each winning lessee (Sullivan: par 0103), and

      conversion rate of visitors to paying customers.

17.   Regarding claim 14, the method of claim 13, wherein visitor traffic is

redirected from lessors to lessees through the marketplace (Advertising.com: p. 2

[*In-line Redirect*]), where the redirected traffic can be tracked by the marketplace

(Advertising.com: p. 2).

18.   Regarding claim 16, the method of claim 1, further comprising:

      receiving a user profile variable for a user (Sullivan: par 0103 [*geographic*

location]);

      selecting a lessee based on the user profile variable (Sullivan: par 0103);

and

redirecting traffic from the user to the selected lessee (Sullivan: par 0103).

19.   Regarding claim 17, the method of claim 1, further comprising:

determining at least one of the criteria (Advertising.com: p. 12 #14) and

the user profile variable (Sullivan: par 0103).

20.   Regarding claim 19, the method of claim 17, wherein the user profile

variable is determined by determining a geographic location of the user

(Advertising.com: p. 5 [*State/Province*]).

21.   Regarding claim 21, the method of claim 17, wherein the user profile is

determined by determining a first domain that the user is directed from (lessor

domain) and determining a second domain that the user is directed from after the

first domain (Advertising.com: p. 2 - the electronic marketplace), the user being

redirected to a third site website (lessee website) associated with the first site

website (Advertising.com: p. 2 [*In-line Redirect*]).

22.   Regarding claim 22, the method of claim 1, further comprising:

receiving a geographic area from the lessor that is not to be bid on, traffic

only being redirected to a lessee that is not in the geographic area that is not to

be bid on (Sullivan: par 0051).

Response to Arguments

23.   Applicant's arguments, filed June 4, 2009, have been fully considered and are discussed in detail below.

24.   Applicant argues that the previously relied upon references do not disclose certain limitations in the claims. Specifically, Applicant argues that the references fail to disclose that a domain/website can be selected by specifying criteria. However, as specified in the new rejection, the Advertising.com reference teaches that a domain can be selected by bidding on a category or by searching for domains within categories (see Advertising.com: p. 13-14). A category may fairly be considered a 'criteria'.

25.   The arguments relating to the deficiency of the combination of Sullivan, Google, and Woolston are moot in view of the new grounds of rejection.

26.   The double patenting rejection is withdrawn in view of Applicant's filing of a terminal disclaimer.

27.   The action is made final in view of the Information Disclosure Statement (IDS) filed June 4, 2009, which disclosed the Advertising.com reference which is now relied upon for all rejections in the present action.

Conclusion

28.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to JAMES E. CONAWAY whose telephone

number is 571-270-5640. The examiner can normally be reached on Monday -

Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, NATHAN FLYNN can be reached on 571-272-1915. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

/J. E. C./
Examiner, Art Unit 2454

/Larry D Donaghue/

Primary Examiner, Art Unit 2454