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.

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

inventions@godaddy.com

PTOL-90A (Rev. 04/07)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
12/708,793</td><td>Applicant(s)
NICKS, PAUL</td><td></td></tr>
<tr><td>Examiner
ALBERT PHILLIPS, III</td><td>Art Unit
2155</td><td></td></tr>
</table>

-- 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>23 January 2013</u>.
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) <u>1-16 and 18-21</u> is/are pending in the application.
    5a) Of the above claim(s) _____ is/are withdrawn from consideration.
6)☐ Claim(s) _____ is/are allowed.
7)☒ Claim(s) <u>1-16 and 18-21</u> 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 <u>allowable</u>, 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 or send an inquiry to 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).
    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) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

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

DETAILED ACTION

This Office Action is in response to the RCE filed 1/23/13.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

5   forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/13

has been entered.

10

Claim Rejections - 35 USC § 102

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 –

15   (e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
20   only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1, 8, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated

by Johnson (US 2010/0058210).

25   **With respect to claim 1**, Johnson teaches "calculating, by one or more server

computers communicatively coupled to a network, an appraisal value for a domain

name comprising a domain name text string and a top level domain said appraisal value

increasing or decreasing responsive to one or more variances" in ¶ 0405 and ¶ 0453

(Examiner interprets (((10% * 10,000 per month))*12 months) as an example of an

appraisal determination value);

"i) a precision value" in ¶ 0405, ¶ 0413, ¶ 0445, ¶ 0420, and ¶ 0407;

5   "ii) a popularity value" in ¶ 0429 and ¶ 0435,

"iii) a presence value" in ¶ 0438;

"iv) a pattern value" in ¶ 0413, ¶ 0230, ¶ 0407,

"or v) a pay-per-click value; and" in ¶ 0254, ¶ 0445, ¶ 0448—¶ 0457;

"vi) a valuation value assigned to said domain name" in ¶ 0405 and abstract.

10   "determining, by said one or more server computers, whether said top level

domain comprises a .com top level domain" in ¶ 0406.

Johnson is not required to teach the remaining elements of claim 1 because they

are not required to be performed. That is, when a top level domain comprises a .com

level domain, the method stops at step B. Thus, Johnson anticipates the claim. See

15   MPEP 2111.04 (emphasis added):

> ***Claim scope is not limited by claim language that suggests or makes
> optional but does not require steps to be performed, or by claim language that
> does not limit a claim to a particular structure.***

20

With respect to claim 8, Johnson teaches "the method of claim 1, further

comprising the step of calculating ,by said one or more server computers, said presence

value for said domain name by: i) identifying a registration date for said domain name"

25   in ¶ 0438 and ¶ 0445;

"ii) generating an age value comprising an age, in regular numeric time intervals, of said domain name, said are being determined by comparing a current date with said registration date" in ¶ 0438 and ¶ 0445 (the only way to determine an age is to use the current date);

5   "iii receiving, from one or more domain name ranking services or software, a domain rank for said domain name" in ¶ 0107;

"iv) generating a domain rank value comprising said domain rank" in ¶ 0107.

With respect claim 14, Johnson teaches "the method of claim 1, further

10   comprising the step of calculating, by said one or more server computers, said pay-per-click value for said domain name by i) receiving, from one or more pay-per-click bid metrics services or software, one or more pay-per-click bid metrics for said domain name" in 0454 (Examiner interprets highest "paid" as highest bid);

"ii) generating a bid metric value comprising said one or more pay-per-click bid

15   metrics" in ¶ 0453-0454;

"iii) receiving, from one or more search engines, a number of ads returned for said domain name as measured by said one or more search engines; and" in ¶ 0237, ¶ 0240, ¶ 0247; (keywords are related to the domain; keywords are processed using a search engine; ads are displayed to user based on keywords); ¶ 0448--¶ 0457, and ¶

20   0445 (displaying advertising by advertisers suggests as displaying at least one ad);

"iv) generating a returned ads value comprising said number of ads returned for said domain name" in ¶ 0237 and ¶ 0247 (displaying advertising suggest as least one ad).

5   ***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 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
10 > 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.

Claims 2, 4, 10, and 16 rejected under 35 U.S.C. 103(a) as being

15 **unpatentable over Johnson.**

With respect to claim 2, Johnson teaches "the method of claim 1, further

comprising the step of calculating, by said one or more server computers, said precision

value for said domain name by: i) parsing one or more text strings from said domain

name text string" in ¶ 0407 and ¶ 0413 (Johnson teaches analyzing text in that it must

20 analyze the text in the domain name--otherwise nothing would happen);

"ii) generating a keyword value comprising a numeric value for a quantity of said

one or more text strings parsed from said domain name text string" in ¶ 0413 and ¶

0407;

"iii) searching an . . . dictionary in a database communicatively coupled to said

25 network for said one or more text strings" in ¶ 0407 (If a dictionary word can be

determined, then a dictionary must be used);

"iv) generating a dictionary value comprising a true or false value reflecting whether one or more of said one or more text strings are found in said electronic dictionary" in ¶ 0407 (if a determination can be made that the domain is a dictionary word, then there must be true or false logic to indicate this determination);

5   "v) generating a length value comprising a number of characters in said domain name text string; and" in ¶ 0420;

"vi) generating a numerals value comprising a true or false value reflecting whether one or more numerals are found in said domain name text string" in ¶ 0416.

It appears Johnson fails to teach an "electronic" dictionary.

10   However, electronic dictionaries were well known in the art at the time of the invention.

It would have been obvious to modify the dictionary in Johnson to include an electronic dictionary.

The motivation would have been speed--computers are generally faster than

15   humans in looking up words in a dictionary.

With respect to claim 4, Johnson teaches "the method of claim 2, further comprising the steps of: i) writing, by said one or more server computers, said keyword value to a data field in a record for said domain name stored in said database" in ¶ 0107, ¶ 0126--¶ 0131, ¶ 0160, ¶ 0403, and ¶ 0405-0407;

20   "ii) writing, by said one or more server computers, said dictionary value to a data field in said record" ¶ 0403, and ¶ 0405-0407;

"iii) writing, by said one or more server computers, said length value to a data field in said record" in ¶ 0403, and ¶ 0416;

"iv) writing, by said one or more server computers, said numerals value to a "data field in said record" in ¶ 0403, and ¶ 0416

5   "v) writing, by said one or more server computers, said precision value to a data field in said record" in ¶ 0403.

It appears Johnson fails to teach that the data fields are labeled "keyword", "dictionary", "length", "numerals", and "precision" respectively.

However labeling data fields to reflect the data stored in the fields was well

10 known in the art at the time of the invention.

It would have been obvious to modify the data fields in Johnson to include keyword", "dictionary", "length", "numerals", and "precision."

The motivation would have been to conform to standard programming practices known to one of ordinary skill in the art.

15 **With respect to claim 10**, Johnson teaches "the method of claim 8, further comprising the steps of: i) writing, by said one or more server computers, said are value to an are data field in a record for said domain name stored in a database communicatively coupled to said network" in ¶ 0403;

"ii) writing, by said one or more server computers, said domain rank value to a

20 domain rank data field in said record" in ¶ 0403;

Johnson teaches "and iii) writing, by said one or more server computers, said presence value to a presence data field in said record" in ¶ 0403.

It appears Johnson et al. fails to teach that the data fields are named "presence", "age value" and "domain rank".

However labeling data fields to reflect the data stored in the fields was well known in the art at the time of the invention.

5   It would have been obvious to modify the data fields in Johnson to include "presence", "age value" and "domain rank".

The motivation would have been to conform to standard programming practices known to one of ordinary skill in the art.

With respect to claim 16, Johnson teaches "the method of claim 14, further
10   comprising the steps of: i) writing, by said one or more server computers, said bid metric value to a bid metric data field in a record for said domain name stored in a database communicatively coupled to said network" in ¶ 0237, ¶ 0055—¶ 0056; ¶ 0453-¶ 0454;

"ii) writing, by said one or more server computers, said returned ads value to a
15   returned ads data field in said record; and" in ¶ 0237, ¶ 0055--¶ 0056; ¶ 0048--¶0457, and ¶ 0445

"iii) writing, by said one or more server computers, said pay-per-click value to a pay- per-click data field in said record" in ¶ 0055-¶ 0056; ¶ 0453-0454.

It appears the data fields in Johnson are not labeled "pay-per-click", "returned
20   ads", or "bid metric".

However labeling data fields to reflect the data stored in the fields was well known in the art at the time of the invention.

It would have been obvious to modify the data fields and "pay-per-click", "returned ads", or "bid metric" information taught in Johnson et al. data to include

5   labeling those data fields "pay-per-click", "returned ads", and "bid metric", respectively.

The motivation would have been to conform to standard programming practices known to one of ordinary skill in the art.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

10   **Johnson as applied to claim 2 above and further in view of Domain Appraisal,**

Mar. 3, 2009 [DA].

With respect to claim 3, Johnson teaches "the method of claim 2, further comprising the step of calculating, by said one or more server computers, said precision value for said domain name by: i) initializing said precision value to 0" in ¶ 0405 (by

15   definition, a "score" or "value" is zero when you haven't calculated it yet);

"ii) determining whether:

"a) said keyword value is above or below a predetermined keyword threshold value" in ¶ 0413;

"b) said dictionary value comprises said true value or said false value" in ¶ 0407;

20   "c) said length value is above or below a predetermined length threshold value" in ¶ 0420;

"and d) said numerals value comprises said true value or said false value" in ¶

0416;

It appears Johnson fails to explicitly teach

"responsive to a determination that said keyword value is above said

5   predetermined keyword threshold value, said dictionary value comprises said true

value, said length value is below said predetermined length threshold value or said

numerals value comprises said false value, increasing said precision value"

"iv)responsive to a determination that said keyword value is below said

predetermined keyword threshold value, said dictionary value comprises a false

10   value, said length value is above said predetermined length threshold value or said

numerals value comprises a true value, decreasing said precision value"

However, DA teaches these features on p. 2 ("numerals" bullet point).

DA and Johnson are analogous art because they are from the same field of

endeavor.

15   It would have been obvious to one skilled in the art to modify the precision value

in Johnson to include or said responsive to determining that said numerals value

comprises a true value, decreasing said precision value and responsive to determining

that said numerals value comprises a false value, increasing said precision value as

taught by DA.

20   The motivation would have been to provide a user with accurate appraisal of

what a domain is worth. See DA page 1.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in as applied to claim 1 above and further in view of Morgan, Do You Really Understand Domain Value? Aug. 16, 2009.

   With respect to claim 5, Johnson teaches "The method of claim 1, further

5   comprising the step of calculating, by said one or more server computers, said

popularity value for said domain name by: i) receiving, from one or more search

engines, one or more search result metrics measured by said one or more search

engines" in ¶ 0445 and ¶ 0429;

   "ii) generating a search engine metrics value comprising said one or more search

10   result metrics" in ¶ 0429 and ¶ 0445;

   "iii) receiving, from one or more search engine optimization monitoring services

or software, one or more search tracking metrics tracking, . . . an estimated number of

searches of a plurality of words via said one or more search engine optimization

monitoring services or software; and" in ¶ 0445 and ¶ 0429;

15   "iv) generating a search tracking metrics value comprising said one or more

search tracking metrics" in ¶ 0445 and ¶ 0429.

   It appears Johnson fails to teach "at regular intervals."

   However, Morgan teaches tracking search information at regular intervals on p. 1

paragraph 7.

20   Morgan and Johnson are analogous art because they are from the same field of

endeavor.

It would have been obvious to modify the tracking of searches taught in Johnson to include "at regular intervals" as taught by Morgan.

The motivation would have been to identify a domain with a high value. See Morgan title and p. 1 paragraph 7.

5   **With respect to claim 6**, Johnson teaches "the method of claim 5, further comprising the steps of calculating, by said one or more server computers, said popularity value for said domain name by: i) initializing said popularity value to 0" in ¶ 0405 (a popularity value is 0 by definition until it is calculated);

10   "ii) determining whether: a) said one or more search engine metrics comprise one or more positive or one or more negative search engines metrics" in ¶ 0429, ¶ 0449, and ¶ 0445 (it would have been obvious to one skilled in the art that "popular" is positive and "unpopular" is negative because popularity drives revenue);

It appears Johnson fails to explicitly teach

15   "b) said one or more search tracking metrics comprise one or more high or one or more low estimated searches per month"

"iii) responsive to a determination that said one or more search engine metrics comprise said one or more positive search engines metrics or said one or more search tracking metrics comprise said one or more high estimated searches per month,

20   increasing said popularity value"

"iv) responsive to a determination that said one or more search engine metrics comprise said one or more negative search engines metrics or said one or more

search tracking metrics comprise said one or more low estimated searches per

month, decreasing said popularity value."

However, Morgan teaches these features on p. 1 paragraph 7.

Morgan and Johnson are analogous art because they are from the same field of

5   endeavor.

It would have been obvious to one skilled in the art at the time of the invention to

modify the positive search metrics and popularity value taught in Johnson to include

responsive to a determination that said one or more search engine metrics comprise

said one or more positive search engines metrics or said one or more search tracking

10   metrics comprise said one or more high estimated searches per month, increasing said

popularity value as taught by Morgan.

It would have been obvious to one skilled in the art at the time of the invention to

modify the negative search metrics and popularity value taught in Johnson responsive

to a determination that said one or more search engine metrics comprise said one or

15   more negative search engines metrics or said one or more search tracking metrics

comprise said one or more low estimated searches per month, decreasing said

popularity value as taught by Morgan.

The motivation would have been to identify a domain with a high value. See

Morgan title and p. 1 paragraph 7.

20

With respect to claim 7, Johnson teaches "the method of claim 5, further

comprising the steps of: i) writing, by said one or more server computers, said search

engine metrics value to a search engine metrics data field in a record for said domain

name stored in a database communicatively coupled to said network" in ¶ 0429, ¶ 0449,

and ¶ 0445 and ¶ 0055;

"ii) writing, by said one or more server computers, said search tracking metrics

value to a search tracking metrics data field in said record; and" in ¶ 0429, ¶ 0449, ¶

5   0445, and ¶ 0055;

"iii) writing, by said one or more server computers, said popularity value to a

popularity data field in said record" in ¶ 0429, ¶ 0449, ¶ 0445, and ¶ 0055.

It appears Johnson fails to teach that its databases' data fields are labeled

"tracking metrics" and "popularity" and "search engine metrics."

10   However labeling data fields to reflect the data stored in the fields was well

known in the art at the time of the invention.

It would have been obvious to modify the data fields in Johnson to include

"tracking metrics" and "popularity" and "search engine metrics."

The motivation would have been to conform to standard programming practices

15   known to one of ordinary skill in the art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Johnson as applied to claim 8 above and further in view of Pixelrage, The Only

Domain Name Appraisal Guide You'll Ever Need, Sept. 15, 2008.

20   **With respect to claim 9,** Johnson teaches "the method of claim 8, further

comprising the step of calculating, by said one or more server computers, said presence

value for said domain name by: i) initializing said presence value to 0" in ¶ 0438;

Johnson teaches "and b) said domain rank value is above or below a predetermined domain rank threshold value" in ¶ 0112;

"iii) responsive to a determination that said age value is above said predetermined age threshold value or said domain rank value is above said

5   predetermined domain rank threshold value, increasing said presence value; and" in ¶ 0112 and ¶ 0110;

"iv) responsive to a determination that said age value is below said predetermined age threshold value or said domain rank value is below said predetermined domain rank threshold value, decreasing said presence value" in ¶ 0112

10   and ¶ 0110.

It appears Johnson et al. fails to explicitly teach "determining whether said age value is above or below a predetermined age threshold value"

However, Pixelrage teaches this feature in the title and pp. 2-3 section "Aged and Developed Domains."

15   Johnson and Pixelrage are analogous art because they are from the same field of endeavor.

It would have been obvious to one skilled in the art the time of the invention to modify the calculation of the age value in Johnson to include determining whether said age value is above or below a predetermined age threshold value as taught by

20   Pixelrage.

The motivation would have been to determine a high value domain name. See

Pixelrage title.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable

5   **over Johnson as applied to claim 1 and further in view of High Value Domain**

Yard, April 3, 2009 [HVDY] and further in view of Douglas, Why the Live Domain

Auction Bombed (and Why I'm Not Surprised) - Domain Name Wire, Comment 21,

Feb. 4, 2009.

With respect to claim 11, Johnson teaches "The method of claim 1, further

10   comprising the step of calculating, by said one or more server computers, said pattern

value for said domain name" in ¶ 0410, ¶ 0414, and ¶ 0406;

It appears Johnson fails to teach

"by i) identifying one or more characters as one or more premium characters"

"ii) generating a premium characters value comprising a percentage of said one

15   or more premium characters in said domain name"

"iii) identifying one or more parts of speech"

"iv) generating a part of speech value comprising a true or false value reflecting

whether said one or more parts of speech are represented in said domain name"

"v) identifying one or more patterns of relationships between one or more vowels

20   and one or more consonants in said domain name; and

"vi) generating a vowel consonant relationship value comprising a true or false value reflecting whether said one or more patterns of relationships between said one or more vowels and said one or more consonants are represented in said domain name."

5   However, HVDY teaches "i) identifying one or more characters as one or more premium characters ii) generating a premium characters value comprising a percentage of said one or more premium characters in said domain name" on p. 2 fourth full paragraph and pp. 3-4 section labeled "4 characters".

"v) identifying one or more patterns of relationships between one or more vowels

10   and one or more consonants in said domain name" on p. 4 under the section "Pronounceables"

"vi) generating a vowel consonant relationship value comprising a true or false value reflecting whether said one or more patterns of relationships between said one or more vowels and said one or more consonants are represented in said domain

15   name" on p. 4 under the section "Pronounceables."

HVDY and Johnson et al. are analogous art because they are from the same field of endeavor.

It would have been obvious to one skilled in the art at the time of the invention to modify the calculation of the pattern value in Johnson to include identifying one or more

20   characters as one or more premium characters; generating a premium characters value comprising a percentage of said one or more premium characters in said domain name;

identifying one or more patterns of relationships between one or more vowels and one

or more consonants in said domain name; generating a vowel consonant relationship

value comprising a true or false value reflecting whether said one or more patterns of

relationships between said one or more vowels and said one or more consonants are

5   represented in said domain name as taught by HVDY.

The motivation would have been to determine a high value domain name. See

HVDY title.

It appears Johnson et al. fail to explicitly teach "iii) identifying one or more parts

of speech; iv) generating a part of speech value comprising a true or false value

10   reflecting whether said one or more parts of speech are represented in said domain

name."

However, Douglas teaches these features on p. 6 comment 21.

Douglas and HYDY are analogous art because they are from the same field of

endeavor.

15   It would have been obvious to one skilled in the art to modify the pattern value in

Johnson to include identifying one or more parts of speech; iv. . . . a true or false value

reflecting whether said one or more parts of speech are represented in said domain

name as taught by Douglas.

The motivation would have been to determine a high value domain name. See

20   Douglas p. 6 comment 21.

Douglas fails to explicitly teach "generating", but generating data on a computer well known in the art at the time of the invention.

It would have been obvious to modify the part of speech information in Douglas to include "generating a part of speech value" on a computer.

5   The motivation would have been speed—computers can process the information generally faster than a manual computation by a human.

With respect to claim 12, Johnson teaches "12.(currently amended) The method of claim 11, further comprising the step of calculating, said one or more server computers, said pattern value for said domain name by: i) initializing said pattern value

10   to 0" in in ¶ 0410, ¶ 0414, and ¶ 0406 (by definition, all values are 0 before they are assigned a value);

HVDY teaches "ii) determining whether: a) said premium characters value is above or below a predetermined premium characters threshold value" on pp. 3-4 under "4 Characters";

15   Douglas teaches "b) said parts of speech value comprises said true value or said false value" on p. 6 comment 21 ("Expert Help" is an adjective/noun that is part of the speech="true" value);

HVDY teaches "c) said vowel consonant relationship value comprises said true value or said false value" on p. 4 "Pronounceable" section (value is "true" if domain

20   meets one of those patterns).

HVDY teaches "iii) responsive to a determination that said premium characters value is above said predetermined premium characters threshold value, said parts of speech value comprises said true value or said vowel consonant relationship value comprises said true value, increasing said pattern value; and" on pp. 3-4 "4 Characters"

5　　section.

HVDY teaches "iv) responsive to a determination that said premium characters value is below said predetermined premium characters threshold value, said parts of speech value comprises said false value or said vowel consonant relationship value comprises said false value, decreasing said pattern value" on pp. 3-4 "4 Characters"

10　　section.

See also Douglas p. 6 comment 21 (certain adjective/noun combinations not valuable).

With respect to claim 13, Johnson teaches "the method of claim 11, further comprising the steps of: i) writing, by said one or more server computers, said premium

15　　characters value to a premium characters data field in a record for said domain name stored in a database communicatively coupled to said network" in ¶ 0055-0056;

The combination of Johnson, HVDY, and Douglas teach "ii) writing, by said one or more server computers, said part of speech value to a part of speech data field in said record" in Johnson ¶ 0055-0056 and Douglas p. 6 comment 21;

"iii) writing, by said one or more server computers, said vowel consonant

relationship value to a vowel consonant relationship data field in said record; and" in

Johnson ¶ 0055-0056 and HVDY .p. 4 under the section "Pronounceables."

"iv) writing, by said one or more server computers said pattern value to a

5   presence data field in said record" in Johnson ¶ 0055 and ¶ 0056.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Johnson as applied to claim 14 above and further in view of Chef Patrick, What

Makes a Premium Domain Name, Oct. 1, 2008 [Patrick] in view of kevinfrost,

10   **Domain Name Investing: The Easiest Way to Make Money Online?, April 12, 2010.**

With respect to claim 15, Johnson teaches "the method of claim 14, further

comprising the step of calculating, said one or more server computers, said pay-per-

click value for said domain name by: i) initializing said pay-per-click value to 0" in ¶ 0454

(before any data is received, CPC is zero by definition);

15   It appears Johnson et al. fails to explicitly teach

"ii) determining whether: a) said bid metric value is above or below a

predetermined bid metric threshold value; and"

"b) said returned ads value is above or below a predetermined returned ads

threshold value"

20   "iii) responsive to a determination that said bid metric value is above said

predetermined bid metric threshold value or said returned ads value is above said

predetermined returned ads threshold value, increasing said pay-per-click value"

"iv) responsive to a determination that said bid metric value is below said

predetermined bid metric threshold value or said returned ads value is below said

predetermined returned ads threshold value, decreasing said pay-per-click value."

However, Patrick teaches b) said returned ads value is above or below a

5   predetermined returned ads threshold value" on p. 1 "End Users" section;

"iii) responsive to a determination that said bid metric value is above said

predetermined bid metric threshold value or said returned ads value is above said

predetermined returned ads threshold value, increasing said pay-per-click value" on p. 1

"End Users" section (threshold is at least one);

10   "iv) responsive to a determination that said bid metric value is below said

predetermined bid metric threshold value or said returned ads value is below said

predetermined returned ads threshold value, decreasing said pay-per-click value" on p.

1 "End Users" (threshold is at least one).

Patrick and Johnson are analogous art because they are from the same field of

15   endeavor.

It would have been obvious to one skilled in the art at the time of the invention to

modify the calculation of the pay-per-click value in Johnson et al. to include

determining whether: said bid metric value is above or below a predetermined bid

metric threshold value b) said returned ads value is above or below a predetermined

20   returned ads threshold value; iii) responsive to a determination that said bid metric value

is above said predetermined bid metric threshold value or said returned ads value is

above said predetermined returned ads threshold value, increasing said pay-per-click

value; iv) responsive to a determination that said bid metric value is below said

predetermined bid metric threshold value or said returned ads value is below said

predetermined returned ads threshold value, decreasing said pay-per-click value as

taught by Patrick.

5   The motivation would have been to identify a high value domain name. See

Patrick title.

It appears Johnson et al. fails to teach "ii) determining whether: a) said bid

metric value is above or below a predetermined bid metric threshold value."

However, kevinfrost teaches this feature on p. 2 item number 1 under "Turn your

10   knowledge into Profit."

Kevinfrost and Johnson et al. are analogous art because they are from the same

field of endeavor.

It would have been obvious to one skilled in the art at the time of the invention to

modify the pay-per-click value in Johnson et al. to include determining whether: said bid

15   metric value is above or below a predetermined bid metric threshold value as taught by

kevinfrost (the word "high" suggests some threshold).

The motivation would have been to identify a high value domain name. See

kevinfrost title.

20   **Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Johnson as applied to claim 1 above and further in view of Estibot.com

User's Guide, Feb. 4, 2010 (hereinafter Estibot).

With respect to claim 18, it appears Johnson et al. fails to explicitly teach "The method of claim 1 further comprising the step of determining, by said one or more server computers, whether said domain name text string comprises one or more dashes and, responsive to a determination that said domain name text string comprises said

5   one or more dashes, calculating a dashes multiplier wherein said dashes multiplier is less than 1, wherein said revised appraisal value is calculated according to the following formula: said revised appraisal value = (said appraisal value) * (said domain scarcity multiplier) *(said dashes multiplier).

However, Estibot teaches "determining, by said one or more server computers,

10   whether said domain name text string comprises one or more dashes" on p. 18 ("Our filtering technology is extremely flexible, and allows a buyer to filter by virtually any parameter including: Minimum / Maximum price Data Source (ex: appraisals, forums, drop lists) Extension Domain Length, Dashes, Numbers").

If the domain string does not contain dashes, then the method does not require

15   any calculation. Thus, the calculation of the dashes multiplier is an optional limitation and does not limit the claim.

Estibot and Johnson et al. are analogous art because they are from the same field of endeavor.

It would have been obvious to one skilled in the art at the time of the invention to

20   modify the determining in Johnson et al. to include determining, by said one or more server computers, whether said domain name text string comprises one or more dashes as taught by Estibot.

The motivation would have been to allow a buyer find domains without dashes (it
is well known in the art that dashes decrease value of a domain). See EstiBot p. 18.

With respect to claim 19, Johnson teaches "the method of claim 18, further
comprising the steps of writing to a database communicatively coupled to said network,

5   said appraisal value, said dashes multiplier, said domain scarcity multiplier, and/or said
revised appraisal value in association with said domain name" in ¶ 0031. See also
EstiBot p. 4.

**Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Johnson as applied to claim 1 above and further in view of Estibot.com**

10   **User's Guide, Feb. 4, 2010 [hereinafter Estibot] and further in view of Domain
Name Appraisal FAQ, Feb. 26, 2009 [hereinafter DNAF].**

With respect to claim 20, Johnson teaches "receiving, by said one or more
server computers, a domain name registration request comprising said domain name" in
¶ 0049.

15   It appears Johnson et al. fails to explicitly teach "parsing, by said one or more
server computers, said domain name text string into one or more keywords; identifying,
by said one or more server computers, one or more available domain names stored in a
database communicatively coupled to said network, each of said one or more available
domain names comprising said one or more keywords; calculating, by said one or more

20   server computers, an available domain name appraisal value for each of said one or
more available domain names by: i) increasing or decreasing said available domain
name appraisal value responsive to one or more variances in a precision value, a

popularity value, a presence value, a pattern value or a pay-per-click value assigned to

each of said one or more available domain names; ii) determining whether each of said

one or more available domain names comprises a .com top level domain; calculating a

revised available domain name appraisal value for each of said one or more available

5   domain names according to the following formula: said revised available domain name

appraisal value = (said available domain name appraisal value) * (said domain scarcity

multiplier); and J) transmitting, by said one or more server computers, to said client

computer, said revised available domain name appraisal value for each of said one or

more domain names."

10   However, EstiBot teaches "parsing, by said one or more server computers, said

domain name text string into one or more keywords" on p.4 ("cheap kicks" keywords are

parsed); p. 11 ("Parsing Keywords from Domains");

"identifying, by said one or more server computers, one or more available domain

names stored in a database communicatively coupled to said network, each of said one

15   or more available domain names comprising said one or more keywords" on p. 11;

"calculating, by said one or more server computers, an available domain name

appraisal value for each of said one or more available domain names by: i) increasing

or decreasing said available domain name appraisal value responsive to one or more

variances in a precision value, a popularity value, a presence value, a pattern value or a

20   pay-per-click value assigned to each of said one or more available domain names" on p.

11 (CPC is cost per click, for example);

"ii) determining whether each of said one or more available domain names comprises a .com top level domain" on p. 11 (all the domains are .com).

EstiBot and Johnson et al. are analogous art because they are from the same field of endeavor.

5   It would have been obvious to one skilled in the art at the time of the invention to modify the "receiving, by said one or more server computers, a domain name registration request comprising said domain name" in Johnson et al. to include "parsing, by said one or more server computers, said domain name text string into one or more keywords; identifying, by said one or more server computers, one or more available

10   domain names stored in a database communicatively coupled to said network, each of said one or more available domain names comprising said one or more keywords; calculating, by said one or more server computers, an available domain name appraisal value for each of said one or more available domain names by: i) increasing or decreasing said available domain name appraisal value responsive to one or more

15   variances in a precision value, a popularity value, a presence value, a pattern value or a pay-per-click value assigned to each of said one or more available domain names" as taught by Estibot.

The motivation would have been to provide the information and tools to assess the value of a domain name. See EstiBot page 1.

20   It appears EstiBot et al. fails to explicitly teach

"iii calculating a revised available domain name appraisal value for each of said one or more available domain names according to the following formula: said revised

available domain name appraisal value = (said available domain name appraisal

value) * (said domain scarcity multiplier); and"

"J) transmitting, by said one or more server computers, to said client computer,

said revised available domain name appraisal value for each of said one or more

5   domain names"

However, DNAF teaches "calculating a revised available domain name appraisal

value for each of said one or more available domain names according to the following

formula: said revised available domain name appraisal value = (said available domain

name appraisal value) * (said domain scarcity multiplier); and" on p. 1 ("Domain names

10   in .org and .net have value, but, all other aspects being equal, .com names are

significantly more valuable. Based on our research, .com names are worth 1.7 times the

same domain in .net and 2.2 times the same domain in .org").

DNAF teaches that the multiplier for .com domains is 1.7 and 2.2. This is

mathematically equivalent teaching that the multiplier for non-.com domains is less than

15   1.

DNAF further teaches "J) transmitting, by said one or more server computers, to

said client computer, said revised available domain name appraisal value for each of

said one or more domain names" on p. 1 (it would have been obvious to one skilled in

the art to transmit the valuation of a .com to a client on the Internet).

20   DNAF and Johnson et al. are analogous art because they are from the same field

of endeavor.

It would have been obvious to one skilled in the art to modify the calculation of a

domain name appraisal value in Johnson et al. to include calculating a revised available

domain name appraisal value for each of said one or more available domain names

according to the following formula: said revised available domain name appraisal value

5   = (said available domain name appraisal value) * (said domain scarcity multiplier); and"

transmitting, by said one or more server computers, to said client computer, said

revised available domain name appraisal value for each of said one or more domain

names" as taught by DNAF.

The motivation would have been to allow a buyer and seller of a domain name to

10   estimate of value of domain name in order to engage in an optimal negotiation. See

DNAF p. 1 paragraph 3.

With respect to claim 21, Estibot teaches "the method of claim 20, further

comprising the step of determining, by said one or more server computers, whether an

available domain name text string comprises one or more dashes" on p. 18 ("Our

15   filtering technology is extremely flexible, and allows a buyer to filter by virtually any

parameter including: Minimum / Maximum price Data Source (ex: appraisals, forums,

drop lists) Extension Domain Length, Dashes, Numbers").

If the domain string does not contain dashes, then the method does not require

any calculation. Thus, the calculation of the dashes multiplier is an optional limitation

20   and does not limit the claim.   See MPEP 2111.04 cited above.

Response to Arguments

Applicant argues "Applicant has amended claim 1 to include all the limitations of

the base claim and any intervening claims." *Remarks* at 16.

Examiner respectfully disagrees. All the features of previous claim 17 were not

5   incorporated into claim 1. The newly amended claims read on the prior art as indicated

the above rejection. Thus, the application is not in condition for allowance and

Applicant's arguments are not persuasive.   If Applicant wishes to put the application in

condition for allowance, Examiner recommends amending claim 1 to recite all the

features of claim 1 and claim 17 as filed on 8/3/12.

10   Applicant's remaining arguments point out the elements of claim 1, but fail to

distinguish the elements from the prior art. Thus, these arguments are not persuasive.

Applicant's arguments **_must_** distinguish the claims from the prior art. See MPEP

714.02 (quoting 37 CFR 1.111) (emphasis added):

> In order to be entitled to reconsideration or further examination, the applicant or patent owner
15   must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing
> which distinctly and specifically points out the supposed errors in the examiner's action and must reply to
> every ground of objection and rejection in the prior Office action. **_The reply must present arguments_**
> **_pointing out the specific distinctions believed to render the claims, including any newly presented_**
> **_claims, patentable over any applied references._**

20

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ALBERT PHILLIPS, III whose telephone number is

(571)270-3256. The examiner can normally be reached on Mon-Fri. 9:30am-7pm; First

25   Fri Off.

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

supervisor, Rehana Perveen can be reached on (571) 272-3676. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

5   Information regarding the status of an application may be obtained from the

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

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

10 you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-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.

15
/ALBERT PHILLIPS, III/
Examiner, Art Unit 2155