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EXAMINER	
OSMAN BILAL AHMED, AFAF	
ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
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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):

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Office Action Summary	Application No. 13/269,774	Applicant(s) BROUMAND, JOSEPH	
	Examiner AFAF AHMED	Art Unit 3622	AIA (First Inventor to File) Status 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 *11/11/2013*.

☐ 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) *1-12* 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5a) Of the above claim(s) _____ is/are withdrawn from consideration.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) *1-12* 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 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).

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: _____.

DETAILED ACTION

Status of Claims

1. In view of the Appeal brief filled on 11/11/2013, Prosecution is HEREBY REOPENED. A new ground of rejection is 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 filling a notice of appeal under 37 CFR 41.31 followed by an appeal fee and appeal brief fee can be applied to the new appeal. If however, the appeal 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.

2. This action is in reply to the amendment filed on 11/11/2013.
3. Claims 1, 4, 5, 7-9 have been amended.
4. Claims 10-12 have been added.
5. Claims 1-12 are currently pending and have been examined.

Response to Applicant's Arguments

6. Applicant's amendments and arguments filed on 07/16/2012 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.

7. With regard to the drawing objection, Applicant has canceled the corresponding paragraphs in the specification. Therefore, no drawing is required to be submitted by the Applicant.

8. With regard to claims 7-9 rejection 35 USC § 101, applicant has amended independent claim 7, however, applicant's amendment fails to tie the core of the invention to a specific machine and /or recite which step is actually performed by a machine.

9. Applicant argues that claim 7 requires that "*database access comparisons, display of an opt-in window, receiving specified information and is directs to operations conducted to interface with a device that is operated by a user (providing an opt-in window for display on the display of the device*"). These

electronic and perceptible actions specifically contrast **with purely mental process that could occur entirely within a human brain**, for example.

Examiner respectfully disagrees, because Applicant's arguments are not persuasive. Claim 7 rejection under 35 USC § 101, was maintained because Applicant's amendment fails to tie the core of the invention to a specific machine and /or recite which step is actually performed by a machine. The recitation of *accessing a database, stored on a tangible computer readable medium coupled... is operated by a user as* ***Applicant admitted***. So accessing a database.... is not the core of the claimed invention and is not performed by a machine automatically without any human interference. Additionally, no where the office action stated that the rejection of claim 7 under 35 USC § 101, with regard to a *database access comparisons, ...* These electronic and perceptible actions specifically contrast **with purely mental process that could occur entirely within a human brain**, as Applicant asserted. The rejection of claim 7 under 35 USC § 101, was maintained simply because There is no actual step performed by a **particular machine** that is directed to **the core of the invention**. Furthermore, as stated previously the recitation of *"communicating, over a network, by a promoter server with a web server belonging to a web host that is operable to serve a web page to a device, the web page for display on a display of the device and comprising an interface providing an opportunity for a user to register with the web host by entering information in plurality of fields in a form provided by the web host to the device for display, the information comprising both personal information capable of being used to identifier the user and target information, additional to the personal information, for determining whether the user satisfies advertiser opt-in offer criteria."* However, the citation of ***communicating, over a network,*** *by a promoter server with a web server belonging to a web host that is operable to* serve *a web page to a device* **is a positive recitation of insignificant extra solution, because it is simply a way to collect user's information and** it does not impose meaningful limits on the claims' scope to impart patentability. There is no actual step performed by a **particular machine** that is directed to **the core of the invention**. Therefore, the claim rejection of claims 7, 9 and their dependent claims are maintained.

10. With regard to claims 1, 7 and 9 rejection under 35 USC § 112 second paragraph. Applicant's arguments and/or clarifications are considered. Therefore, the claim rejection of claims1, 7 and 9 under 35 USC § 112 second paragraph is withdrawn.

11. With regard to claims 1 and 9 rejection with regard to the limitation of: Applicant's arguments are considered, but they are moot based on the new ground of rejection.

Claim Rejections - 35 USC § 101

12. 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.

13. Claims 7, 9 and their dependent claims are rejected under 35 U.S.C. § 101. Based upon consideration of all of the relevant factors with respect to the claim as a whole, these claims are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. § 101. In light of the recent Supreme Court decision in *Bilski v. Kappos*, 561 U.S. ___ (2010), the *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos* provides factors to consider in determining whether a claim is directed to an abstract idea and is therefore not patent-eligible under 35 U.S.C. § 101. Factors weighing toward eligibility include:

- Recitation of a machine or transformation (either express or inherent).
- The claim is directed toward applying a law of nature.
- The claim is more than a mere statement of concept.

Factors weighing against eligibility include:

- No recitation of a machine or transformation (either express or inherent).
- Insufficient recitation of a machine or transformation.
- The claim is not directed to an application of a law of nature.
- The claim is a mere statement of a general concept.

14. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a 35 U.S.C. § 101 statutory process, the claim could positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Furthermore, the use of a particular machine or transformation of a particular article must involve more than insignificant extra-solution activity.

15. In light of the factors in the Supreme Court decision, Applicant's method steps do not meet the requirements of 35 U.S.C. § 101, because there is insufficient recitation of a machine, or transformation. Involvement of machine, or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps. e.g., data gathering or merely recites a field in which the method is intended to be applied.

Claim Rejections - 35 USC § 112

16. 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.

17. Claims 1, 7 and 9 are 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.

18. Claims 1, 7 and 9 recite the limitations of:

- *communicating, over a network, by a promoter server with a web server belonging to a web host that is operable to serve a web page to a user device, the web page for display on a display of the user device, and comprising an interface providing an opportunity for a user to register with the web host by entering information in a plurality of data fields in a form provided by the web host to the user device for display. It is unclear whether the web host provides comprising an interface providing an opportunity for a user to register with the web host by entering information in a plurality of data fields in a form provided by the web host to the user device for display or the a promoter server provides comprising an interface providing an opportunity for a user to register with the web host by entering information in a plurality of data fields in a form provided by the web host to the user device for display.* Appropriate correction and/or clarification is required.
- *Comparing the target information with the respective criteria…providing an opt-in window for display...* It is unclear whether the comparison step is performed at the promoter server or performed at the web host server. It is also unclear whether the providing step is performed by the web host server. Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

19. 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.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or non obviousness.

20. Claims 1, 4, 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, US Pat No: 5,855,008 in view of Frengut et al, US Pub No: 2002/0046,099 A1.

Claims 1, 7 and 9-10

Goldhaber discloses:

- *communicating, over a network, by a promoter server that is with a web server and is operable to serve a web page to a user device, the web page for display on a display of the user device, and comprising an interface providing an opportunity for a user to register with the web server by entering information in a plurality of data fields in a form provided by the web server to the user device for display, the information comprising both personal information capable of being used to identifier the user and target information additional to the personal information, for use in determining whether the user satisfies advertiser opt-in offer criteria* (see at least column 7, lines 27-47, column 13, lines 1-67, column 14, lines 1-7);
- *receiving at the promoter server only the target information for advertiser criteria comparison entered by the user in the form* (see at least column 12, lines 62-67 and column 14, lines 9-46);
- *accessing a database, stored on a tangible computer readable medium coupled with the promoter server, the database comprising descriptions of offers from a plurality of advertisers, each offer comprising a set of criteria to be matched with received target information about the user, in order for that offer to be presentable to that user as an opt-in opportunity* (see at least column 14, lines 9-46);
- *comparing the user data from the server with the respective criteria for the offers to identify matching offers* (see at least column 14, lines 9-46);
- *providing an opt-in window for display on the display of the device, responsive to a match between the user target information and respective criteria of one or more of the offers, the opt-in window presenting each offer that matches with a corresponding interface element, by which the user can provide input to indicate a desire to opt-into that offer and responsive only to acceptance of a presented offer, receiving personal information and providing the personal information to the advertiser responsible for the accepted offer, wherein if the target information is found not to match advertiser criteria, no personal information is received by the promoter server* (see at least column see at least column 7, lines 27-47, column 13, lines 1-67, column 14, lines 1-7)*;*

Goldhaber does not specifically disclose, but Frengut however discloses:

- *communicating, over a network, by a promoter server with a server belonging to a web host that is operable to serve a web page to a user device* (see at least paragraphs 25-28 and 30);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Goldhaber, communicating, over a network, by a promoter server with a server belonging to a web host that is operable to serve a web page to a user device, that will result will result in providing a forum for buyers and sellers to interact while satisfying the preferences of both parties simultaneously as taught by Frengut, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 4:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *wherein the media further has stored thereon offer presentation history data comprising a list of users whose information has been sent to the advertiser and a list of promotions that have been shown to each user* (see at least column 16, lines 24-47);

Claims 11-12:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *wherein the target information comprises information used for selecting target groups and includes one or more of sex, age, zip code, and area code of the user* (see at least column 13, lines 36-67, column 14, lines1-9);

21. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, US Pat No: 5,855,008 in view of Frengut et al, US Pub No: 2002/0046,099 A1 in view of Henry, US Pub No: 2003/0200,265.

Claims 2 and 3:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *providing information about the user to each advertiser* (see at least column least column 7, lines 27-47, column 13, lines 1-67, column 14, lines 1-7);

Goldhaber does not specifically disclose, but Frengut however discloses:

- *each offer selected by the user, sending a confirmation e-mail addressed to an e-mail address of the user, the e-mail sent on behalf of an advertiser whose offer was accepted by the user* (see at least paragraph 40)*;*

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Goldhaber, confirmation of email address on behalf of an advertiser whose offer is being accepted by the user, the will result of building consumer loyalty as taught by Frengut, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The combination of Goldhaber/ Frengut does not specifically disclose, but Henry however discloses:

- *verifying the validity of the e-mail address* (see at least paragraphs 13-14 and 28);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Golhaber/Frengut the ability to validate and verify e-mail address of a user before sending a desired message as taught by Henry, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination (minimizing misdirected email that will not be delivered due the specification of an invalid email address (Henry paragraph 4)) were predictable.

22. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, US Pat No: 5,855,008 in view of Frengut et al, US Pub No: 2002/0046,099 A1 in view of Hoerenz, US Pub No: 2004/0267611 A1.

Claim 5:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *wherein the data stored in a tangible computer readable medium correlating user-identifying data elements with offers that were accepted by that user comprises elements of personal information for each user of a list of users* (see at least column 12, lines 49-67 and column 13, lines1-67);

The combination of Goldhaber/ Frengut does not specifically disclose, but Hoerenz however discloses:

- *an identification of a promotion, attributable to a particular advertiser that was a source of that element of personal information for that user* (see at least paragraphs 27, 38-39, 41,48 and 91);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Goldhaber/ Frengut the ability to identify a promotion of an advertiser that was a source of personal information of a user as taught by Hoerenz, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination (increasing product marketability based on specific known element of user's information) were predictable.

23. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, US Pat No: 5,855,008 in view of Frengut et al, US Pub No: 2002/0046,099 A1 in view of Hoerenz, US Pub No: 2004/0267611 A1 in view of Galuten, US Pub No: 2002/0123956 A1.

Claim 6:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *providing one or more elements of information about a user in the list of users, to an advertiser responsible for an offer that the user opted in to accept* (see at (see at least column least column 7, lines 27-47, column 13, lines 1-67, column 14, lines 1-7);

Frengut does not specifically disclose, but Galuten however discloses:

- *but for which the user did not provide those one or more elements of information, wherein the provided one or more elements were sourced from a promotion by a different advertiser than an advertiser responsible for the offer that the user opted in to accept* (see at least paragraph 74);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Golharber/ Frengut, the ability to get user's information from a different source than the offer provided source as taught by Galuten, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination (sharing users information between different parties in order to meet users' need) were predictable.

24. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, US Pat No: 5,855,008 in view of Frengut et al, US Pub No: 2002/0046,099 A1 in view of French et al US Pat No: 6,282,658 B2 in view of Hoerenz, US Pub No: 2004/0267611.

Claim 8:

The combination of Goldhaber/ Frengut discloses the limitations as shown above.

Goldhaber further discloses:

- *providing identifying information to the advertiser responsible for the accepted offer as a completed opt-in for that advertiser offer* (see at least (see at least column least column 7, lines 27-47, column 13, lines 1-67, column 14, lines 1-7);

The combination of Goldhaber/ Frengut does not specifically disclose, but French however discloses:

- *determining all of the requested information has been received, and for any part of information requested, but not provided, determining whether that information is stored in a tangible machine readable medium in association with identifying*

information about the user, the stored information originating from previous interactions with the user, and if all the information requested can be provided, either from the user response, or by retrieval from the tangible machine readable medium (see at least column 7, lines 57-65, column 10, lines 51-65 and column 9, lines 27-28);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Goldhaber/Frengut's method and system for customized user interface and targeted marketing forum with French's method and system of verifications of user's identity when conducting an on–line transactions with the motivation of (validating submitted user's information are correct) were predictable.

The combination of Goldhaber /Frengut/ French does not specifically disclose, but Hoerenz however discloses:

- *using e-mail addresses as indexes into the information stored on the tangible machine readable medium* (see at least paragraphs 80-81, 85 and 91);

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the method and system for providing opt-in customized user interaction and targeted marketing forum of Goldhaber /Frengut/French, the ability to use e-mail addresses as indexes into the information stored, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination (funding a quick reference to user's stored information) were predictable.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. 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 files within TWO MONTHS from 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.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. 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 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 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.

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