

Grewal Decl., Exhibit K



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

RECEIVED
 COMMERCIAL AND TECHNICAL
 DIVISION
 U.S. DEPARTMENT OF COMMERCE
 WASHINGTON, D.C. 20231

EXAMINER


ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 06/23/04

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

GOG 31667

Office Action Summary	Application No 09/322,677	Applicant(s) Davis et al.	
	Examiner Cuong H. Nguyen	Group Art Unit 2764	

Responsive to communication(s) filed on Apr 10, 2000

This action is FINAL.

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*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-68 is/are pending in the application.

Of the above, claim(s) 6 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-5 and 7-68 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

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

All Some* None of the CERTIFIED copies of the priority documents have been

received

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

S.N: 09/322,677
Art Unit 2764

DETAILED ACTION

1. This Office Action is the answer to the communication received on 4/10/2000 (the request for reconsideration), which paper has been placed of record in the file.
2. Claims 1-68 are pending in this application. Claim 6 has been canceled.

Response:

3. Applicants' arguments received on 4/10/2000 have been fully considered but they are not persuasive with previous cited references, and newly found references.
- 4.1. Applicants assert that "the amended claims 1, 11,13-15, 30, 52, and 68, contain limitations nowhere shown in any of the prior art of record, including the cited reference (e.g. claim 1 was amended by the Preliminary Amendment dated January 12, 2000 to recite that each search listing is associated with "a modifiable bid amount that is independent of other components of the search listing." Independent claims 11,13-15, 30, 52, and 68 have been amended to include similar limitations.
- 4.2. The examiner submits that these limitations are inherent in the concept that Goto.com suggested in the article published on May 19, 1998, about "GoTo.com announces first round of financing, totaling more than \$6 million, led by Draper Fisher

09/322,677
Art Unit 2764

Jurvetson", indicates possession of that invention. It obviously sets forth the mode contemplated by the inventor of carrying out his invention in "Bidding for higher placement offers big benefit to advertisers ... Any advertiser can increase a bid for a listing in order to obtain a higher ranking", this feature inherently mentions about "a modifiable bid amount that is independent of other components of the search listing". Other related articles are cited to indicate that the concept in this application already disclosed for a 35 U.S.C.102(b)/103(a) rejection.

4.3. The examiner submits that the appropriate inquiry in determining whether a particular document constitutes "printed publication" within the meaning of 35 U.S.C. 102 is whether the document was "sufficiently accessible" to one skilled in relevant art who exercised "reasonable diligence" and not whether one skilled in the art would be "highly likely" to discover document or references to it in course of research (E.I. du Pont de Nemours & Company v. Cetus Corp., 19 USPQ2nd 207); and claims that are anticipated by prior art reference are also obvious in view of that reference under 35 USC 103 (In re Baxter Travenol Labs, 21 USPQ 2nd 205); and anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "inherent" or otherwise implicit

09/322,677
Art Unit 2764

in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Inc., 21 USPQ2d 1321).

4.4. Therefore, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

4.5. 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 date of this final action.

Claim Rejections - 35 USC § 102

(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. Because the claims in a pending application should be given their broadest reasonable interpretation; claims 1-68 are rejected on 35 U.S.C. 102(b) because the article published on May 19, 1998, about "GoTo.com announces first round of financing,

09/322,677
Art Unit 2764

totaling more than \$6 million, led by Draper Fisher Jurvetson", indicates possession of that invention. It sets forth the mode contemplated by the inventor of carrying out his invention in "Bidding for higher placement offers big benefit to advertisers ... Any advertiser can increase a bid for a listing in order to obtain a higher ranking". Therefore, this article was published before the application date of the invention (May 28, 1999), in another word, the invention was described in a printed publication in this country, more than one year prior to the date of application for patent in the United States.

Conclusion

6. Claims 1-5, 7-68 are rejected.

7. These references are considered pertinent to applicants' disclosure.

- Rich, "New search engine allows sites to pay their way to top", from MediaWeek, 02/23/1998, Vol.8, Issue 8, p28.

- Database of Corporate ResourceNet, "New service puts ad auction, search engine under one roof", from Electronic Advertising & Marketplace Report, 04/28/1998, Vol.12 Issue 8, p6.

- Espe, "Online search engines start to charge for listings", from Washington Business Journal, 05/07/1999, Vol.18 Issue 1, p31.

09/322,677
Art Unit 2764

- Dawson et al., "2 search sites narrow their parameters", from Adweek-Western Edition, 10/19/1998, Vol.48 Issue 42, p5.
- Database of Corporate ResourceNet, "Bits", from Adweek-Eastern Edition, 04/05/1999, Vol.40 Issue 14, p46.
- Komando, "Searching for search engines-from Dogpile to Deja News", Business First-Columbus, 06/19/1998, Vol.14 Issue 43, p46.
- Database of Corporate ResourceNet, "New services aim to boost efficiency of search engines", from Electronic Advertising & Marketplace Report, 07/14/1998, Vol.12 Issue 13, p6.
- Database of Corporate ResourceNet, "GoTo.com chooses Quest's SharePlex(R) for Oracle software to ensure uptime for business-critical Web site, from PR Newswire, 06/15/2000.
- Database of Corporate ResourceNet, "Capitalist tool", Time Canada, 03/02/1998, vol.151 Issue 8, p41.
- Database of DialogClassic(tm), "Homestead Technologies' Continued Success Draws \$17.5 Million In Second Round of Venture Funding", PR Newswire, April 13, 1999.
- US Pat. 5,864,846 (Voorhees, et al.) filing date 6/26/1996 for "Method for facilitating world-wide-web searches utilizing a document distribution fusion strategy".
- US Pat. 5,918,014 (Robinson) filing date 12/26/1996 for "Automated collaborative filtering in world-wide-web advertising".

09/322,677
Art Unit 2764

- US Pat. 5,920,854 (Kirsch, et al.) filing date 8/14/1996 for "Real-time document collection search engine with phrase indexing".
- US Pat. 5,920,859 (Li) filing date 2/02/1997 for "Hypertext document retrieval system and method".
- APS Search Tools - Patent Search Client Strategy publishing date 9/17/1997 by US Patent & Trademark Office.
- Frequently Asked Questions NT Image Search & Retrieval (IS&R) modified 12/04/1997 by US Patent & Trademark Office.
- Chapter 1 - Introduction to Dialog, pp.1-1 to 1-14 by Dialog Information Service, Inc.
- "Automated Patent System (APS) Workstation Reference Manual published on 7/01/1996 by US Patent and Trademark Office.
- Frentzen, "Help for getting the word out about Web sites.. (Site promotion tools)", PC Week, v14, n46, p27(1), published on 11/03/1997.
- Miller, "Improve your ranking (building Web sites to attract Web searches)", Home Office Computing, v16, n1, p51(2), published on Jan. 1998.
- Lash, "Open Text updates tools" CNET News.com (<http://www.news.com/News/Item/0,4,6118,00.html>) published on 12/11/1996.

09/322,677
Art Unit 2764

- Aguillar, "New ad model charges by the click",
<http://www.news.com/News/Item/0,4,1199,00.html> published on
4/29/1996.
- Wingfield, "Another engine takes ads by the click",
<http://www.news.com/News/Item/0,4,1387,00.html> published on
5/22/1996.
- Peline, "New search engine goes commercial", by CNET NEWS.COM
published on 2/18/1998.
- Wang "Engines Battle Irrelevance of Results - New search
service hope to fill the void", by Internet World, published on
2/26/1998.
- Vonder Haar, "Searching for the highest bidder" from
Inter@ctive Week, published on 2/19/1998.
- Riedman, "Search engine startup to auction listings" from
Interactive - advertising, published on 2/23/1998.
- Rich, "New search engine allows sites to pay this way to top"
from <http://www.adweek.com/iq/1qnews02.asp>, published on
2/23/1998.
- Mardesich, "Web site operators pay for top billing - Search
engine allows site sponsors to buy place on special list", from
Knight Ridder Newspapers or Alexander Communications, published
on 3/02/1998.

09/322,677
Art Unit 2764

- Hilty, "GoTo.Hell - What happens when an online search engine accepts cash from Web sites?",
<http://www.ocweekly.com/ink/archives/97/27byte-3.11.98-1.html>,
published on 3/11/1998.
- Flynn, "With Goto.com's Search Engine, the Highest Bidder Shall Be Ranked First", by the New York Times, published on 3/16/1998.
- Clark, "Start-up plans Internet search service tying results to advertising spending" from The Wall Street Journal, published on 2/20/1998.
- "Going, Going ..." from A closer look of The Wall Street Journal - Marketplace, published on 4/02/1998.
- "coursey.com" David Coursey's insider report on Personal Computing, the Internet, and Communications, published on 3/18/1998.
- Glaser, "Who will GoTo.com", from OnlinePress.com, published on 2/20/1998.
- Mardesich, "Search engine charges hit sites",
<http://www.sjmercury.com/business/center/goto022198.htm>,
published on 2/29/1998.
- "News About Search Engines", from
<http://searchenginewatch.com/ness.html>, published on 2/23/1998.
- Wang, "Engines Battle Irrelevance of Results", from Internet world, published on 2/23/1998.

09/322,677
Art Unit 2764

- Swartz, "Browser only lists paying Web sites. Critics fear approach will squeeze out most small Internet players", from <http://www.sfgate.com/cgi-bin/>, published on San Francisco Chronicle 2/21/1998.
- McWilliams, "Search engine to sell top positions on results lists", <http://www.pcworld.com/news/daily/data/0298/...html>, published on 2/23/1998.
- "Search engine startup to auction listings", from <http://www.adage.com/interactive/daily/index.html>, published on Feb. 1998.
- Alyson, "Searching the search engines", from Bacon's, published on 5/08/1998.
- Peline, "Pay-for-placement gets another shot", <http://www.news.com/News/Item/0,4,19307,00.html>, published on 2/19/1998.

8. Notes: In re Conrad, 169 USPQ 170 (CCPA 1971)

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The

09/322,677
Art Unit 2764

examiner can normally be reached on Monday-Friday from 7:00
AM-4:30 PM.

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, James P. Trammell, can
be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee Amendments
Commissioner of Patents and Trademarks
c/o Technology Center 2700
Washington, D.C. 20231

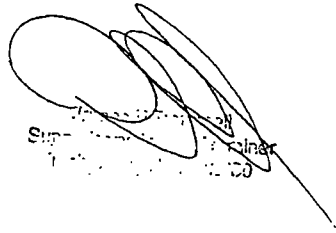
or faxed to: (703) 308-9051, (for formal communications
intended for entry)

Or: (703) 305-0040 (for informal or draft communications,
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703)305-3900.

Cuong H. Nguyen
Patent Examiner, AU 2764
June 18, 2000



Signature of Cuong H. Nguyen