

Grewal Decl., Exhibit M

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being transmitted via facsimile to Examiner C. Nguyen, Group Art Unit No. 2764 and deposited with the United States Postal Service as first class mail, with sufficient postage. In an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

September 28, 2000
Date of Deposit

John G. Rauch, Reg. No. 37,218
Name of Applicant, Assignee or Registered Representative

John G. Rauch
Signature

9/28/00
Date of Signature



#10/CNK
MC
106-8
KWK
10/13/00
RECEIVED
OCT - 3 2000
TECH. CENTER 2700

Our Case No. 9623/112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-----------------------------|---|-------------------------|
| In re Application of: |) | |
| Davis et al. |) | |
| Serial No. 09/322,677 |) | Examiner C. Nguyen |
| Filing Date: May 28, 1999 |) | Group Art Unit No. 2764 |
| For SYSTEM AND METHOD FOR |) | |
| INFLUENCING A POSITION ON A |) | |
| SEARCH RESULT LIST |) | |
| GENERATED BY A COMPUTER |) | |
| NETWORK SEARCH ENGINE |) | |

AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This responds to the Office Action mailed June 28, 2000 and the interview between Attorneys James P. Naughton and John G. Rauch, both attorneys of record in

GOG 31718

this application, and Examiner Nguyen and Primary Examiner Trammell on August 1, 2000. Please amend the application as indicated below.

IN THE CLAIMS:

Please amend claim 1, 6, 11 and 13-15 as indicated below:

1. (Twice Amended) A method of generating a search result list substantially in real time in response to a search request from a searcher using a computer network, comprising:

- maintaining a database including a plurality of search listings, wherein each search listing is associated with a search term and a modifiable bid amount that is independent of other components of the search listing;
- receiving a search request from the searcher;
- identifying the search listings having search terms generating a match with the search request;
- ordering the identified search listings into a search result list in accordance with the values of the respective bid amounts for the identified search listings;
- receiving a retrieval request from the searcher to retrieve information associated with a search listing in the search result list; and
- recording a retrieval request event in an account database corresponding to the searcher's [apostrophe] retrieval request.

6. (Amended) The method of claim [1] 4, further comprising the step of including on the search result list search listings having a bid amount of zero.

*Q3
Sub
D2*

11. (Twice Amended) A method of generating a search result list substantially in real time in response to a search request from a searcher using a computer network, comprising:

- maintaining a database including a plurality of search listings, wherein each search listing is associated with a search term and a modifiable bid amount that is independent of other components of the search listing;
- receiving a search request from the searcher;
- identifying the search listings having search terms generating a match with the search request;
- ordering the identified search listings into a search result list in accordance with the values of the respective bid amounts for the identified search listings;
- receiving a retrieval request from the searcher to [network] retrieve information associated with a search listing in the search result list; and
- estimating the cost of a search listing for a specified time period upon receiving a request from a web site promoter.

C4

13. (Twice Amended) A method of generating a search result list substantially in real time in response to a search request from a searcher using a computer network, comprising:

- maintaining a database including a plurality of search listings, wherein each search listing is associated with a search term and a modifiable bid amount that is independent of other components of the search listing;
- receiving a search request from the searcher;

identifying the search listings having search terms generating a match with the search request;

ordering the identified search listings into a search result list in accordance with the values of the respective bid amounts for the identified search listings;

receiving a retrieval request from the searcher to [network] retrieve information associated with a search listing in the search result list; and

generating a search listing activity report including information on retrieval requests received from searchers during a specified time period.

C4
anti

14. (Twice Amended) A method of generating a search result list substantially in real time in response to a search request from a searcher using a computer network, comprising:

maintaining a database including a plurality of search listings, wherein each search listing is associated with a search term and a modifiable bid amount that is independent of other components of the search listing;

receiving a search request from the searcher;

identifying the search listings having search terms generating a match with the search request;

ordering the identified search listings into a search result list in accordance with the values of the respective bid amounts for the identified search listings;

receiving a retrieval request from the searcher to [network] retrieve information associated with a search listing in the search result list; and

suggesting alternative search terms to the searcher for generating additional search result lists related to the searcher's search request.

REMARKS

Claims 1-68 are pending in the application. By this paper, claims 1, 6, 11 and 13-15 have been amended. Entry of this amendment and reconsideration and allowance of claims 1-68 are respectfully requested.

In an interview with the Examiner conducted August 1, 2000, applicants' attorneys agreed to submit an affidavit to clarify features that were not in the prior system described in a press release dated May, 1998. Applicants further agreed to amend claim 1 to clarify the subject matter defined by this claim. Lastly, the Examiner agreed to withdraw the finality of the office action dated June 28, 2000.

Claims 1-68 stand rejected under 35 U.S.C. § 102(b). According to the examiner, the GoTo.com press release dated May 19 1998 indicates possession of the invention. Reconsideration of this rejection is respectfully requested.

Submitted herewith is the Declaration under 37 C.F.R. § 1.132 of Darren J. Davis. Mr. Davis is an inventor of the invention claimed in the present application. In this Declaration, Mr. Davis states that "The GoTo.com search engine as it existed in May, 1998 was a beta or test version of a system then under development. In May, 1998, at least some features claimed in the independent claims of the subject application were not yet implemented or in the public domain." Mr. Davis further specifies limitations of each independent claim, claim 1 as amended herein and claims 11, 14, 15, 30, 52 and 68 that were not disclosed in the May 19, 1998 press release. Further, according to Mr. Davis, those limitations are not inherent in the disclosure of the May 19, 1998 press release, nor were they disclosed in any prior art of which Mr. Davis was aware.

Claim 1 is amended to clarify that a retrieval request event is recorded in an account database corresponding to the searcher's retrieval request. This amendment clarifies the recitation of the account database. Further, this amendment clarifies the recitations of claim 4, 5 and 10 which all recite the account balance.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-68 is respectfully requested. A reference cannot anticipate a claim under 35 U.S.C. § 102(b) unless the reference discloses all limitations of the claim. As stated by Mr. Davis, each of independent claims 1 (as amended), 11, 14, 15, 30, 52 and 68 contains limitations that were not disclosed in the May 19, 1998 press release. Accordingly, this reference cannot anticipate these claims and the rejection under 35 U.S.C. § 102(b) is properly withdrawn.

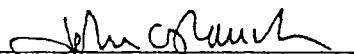
Moreover, it is respectfully submitted that the inventions defined by claims 1 (as amended), 11, 14, 15, 30, 52 and 68 are not obvious in view of the prior art of record. Each of these independent claims contains limitations nowhere shown, described or suggested by the prior art of record. Further, the prior art of record lacks any suggestion to modify any reference to obtain the inventions defined by claims 1, 11, 14, 15, 30, 52 and 68.

Claims 1, 6, 11 and 13-15 are amended to correct minor inconsistencies in these claims. These inconsistencies were discovered upon review of the application. It was noted that in some of the communications from the U.S. Patent and Trademark Office, claim 6 was described as having been cancelled. However, such a cancellation was never made by either the Examiner or applicants. By this paper, the dependency of

claim 6 is corrected to clarify the subject matter defined by this claim. No new matter is added by these amendments.

With this Amendment, the application is in condition for allowance. Should the Examiner deem a telephone conference to be helpful in expediting allowance of this application, the Examiner is invited to call the undersigned attorney at the telephone number shown below.

Respectfully submitted,


John G. Rauch
Registration No. 37,218
Attorney for Applicants

September 28, 2000

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

AF/2-164

| TRANSMITTAL LETTER | | | Case No. 9623/112 |
|--|-----------------------------|-----------------------|------------------------|
| Serial No. 09/322,677 | Filing Date May 28, 1999 | Examiner C. Nguyen | Group Art Unit 2764 |
| Inventor(s) Davis, Darren J. et al | | | |
| Title of Invention SYSTEM AND METHOD FOR INFLUENCING A POSITION ON A SEARCH RESULT LIST GENERATED BY A COMPUTER NETWORK SEARCH ENGINE | | | |



RECEIVED
OCT -3 2000
TECH CENTER 2700

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is Amendment; Declaration Under 37 CFR Section 1.132; Supplemental Information Disclosure Statement, in duplicate; PTO-1449 forms (2); cited references; postcard evidencing receipt.

Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.

- A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- Petition for a _____ month extension of time
- No additional fee is required
- The fee has been calculated as shown below:

| | | | | Small Entry | | Other Than Small Entry | | |
|--|----------------------------------|-------|---------------------------------|---------------|-----------------|------------------------|-----------------|-----------|
| | Claims Remaining After Amendment | Minus | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | Rate | Add'l Fee |
| Total | | | | | x \$9 = | | x \$18 = | |
| Indep | | | | | x \$9 = | | x \$78 = | |
| First Presentation of Multiple Dep Claim | | | | | + \$130 = | | + \$260 = | |
| | | | | | Total add'l fee | \$ | total add'l fee | \$ |

- Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$_____. A duplicate copy of this sheet is enclosed.
- A check in the amount of \$_____ to cover the filing fee is enclosed.
- The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

John C. Rauch
Registration No. 37,218
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231, on September 28, 2000

Date 9/28/00 Signature

GOG 31725

TRANSMITTAL LETTER

| | | | |
|--|-----------------------------|-----------------------|---|
| Serial No. 09/322,677 | Filing Date May 28, 1999 | Examiner C Nguuyen | Case No. 9623/112 Group Art Unit 2764 |
| Inventor(s) Davis, Darren, et al | | | |
| Title of Invention SYSTEM AND METHOD FOR INFLUENCING A POSITION ON A SEARCH RESULT LIST GENERATED BY A COMPUTER NETWORK SEARCH ENGINE | | | |



TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is Amendment; Declaration Under 37 CFR Section 1.132; Supplemental Information Disclosure Statement, in duplicate, PTO-1449 forms (2); cited references, postcard evidencing receipt.

- Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.
- Petition for a _____ month extension of time
- No additional fee is required
- The fee has been calculated as shown below

RECEIVED
OCT - 3 2000
TECH CENTER 2700

| | Claims Remaining After Amendment | Highest No Previously Paid For | Present Extra | Small Entity | | Other Than Small Entity | |
|---|----------------------------------|--------------------------------|---------------|-----------------|-----------|-------------------------|-----------|
| | | | | Rate | Add'l Fee | Rate | Add'l Fee |
| Total | | Minus | | x \$9 = | | x \$18 = | |
| Indep | | Minus | | x \$9 = | | x \$78 = | |
| First Presentation of Multiple Dep. Claim | | | | + \$130 = | | + \$260 = | |
| | | | | Total add'l fee | \$ | total add'l fee | \$ |

- Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$____. A duplicate copy of this sheet is enclosed
- A check in the amount of \$____ to cover the filing fee is enclosed.
- The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed

Respectfully submitted,

John G. Rauch
Registration No. 37,218
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231, on September 28, 2000

Date: 9/28/00 Signature: