

# EXHIBIT S



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,677 05/28/99 DAVIS

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EXAMNER

TM01/1122

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ART UNIT	PAPER NUMBER

2165  
DATE MAILED:

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11/22/00

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

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/322,677	Applicant(s) Davis et al.
	Examiner Cuong H. Nguyen	Group Art Unit 2165

Responsive to communication(s) filed on Oct 2, 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Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-68 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 --

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DETAILED ACTION

1. This Office Action is the answer to the communication received on 10/02/2000 (the amendment), which paper has been placed of record in the file.
2. Claims 1-68 are pending in this application.

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; the examiner withdraws previous FINAL REJECTION according to the affidavit of the main inventor; therefore, previous presented arguments about 35 U.S.C. 102(b) rejections are moot.

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 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.*

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dialog Information Service, Inc. (a commercial

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search company), in view of a **Business Wire** article title "GoTo.com announces first round of financing, totaling more than \$6 million, led by Draper Fisher Jurvetson" published on May 19, 1998, in view of **Buck et al.** (US Pat. 6,078,866), further in view of the Official Notice.

Since the subject matter of these claims are notoriously well-known in network searching business, the examiner would like to point-out that these limitations/features are in the prior art that the examiner showed in previous Office Action; some claims are analyzed herein as examples, and the other rejected claims are obvious with the same rationale set forth:

Re. to claim 1: A method of generating a (search) result list, comprising:

- maintaining a database including search listings (it is notoriously well-known in **Dialog Inc.** reference "in searching business"), and a modifiable bid amount (it is inherent with "increase a bid" in **Business Wire**);

- receiving a search request (it is notoriously well-known in **Dialog Inc.** reference "in searching business");

- identifying a match of search terms (it is notoriously well-known in **Dialog Inc.** reference "in searching business");

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- putting into order/sorting search listings according to respective bid amounts (this limitation is inherent in Dialog Classic "in searching business" for obvious/analogous to "result sorting", "hits" sorting e.g. patent issue number or date of publishing .etc.);

- receiving a retrieval request (it is notoriously well-known in Dialog Inc. reference "in searching business");

- recording a request in a database (it is notoriously well-known in Dialog Inc. reference "in searching business").

Dialog Inc. does not disclose exactly claimed languages as of the applicants.

However, the Official Notice is taken here that all claimed's limitations are well-known in the art of searching using available database in a network (see extra cited references); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for computer searching. Cited prior arts are not limited to the described embodiments in these references. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these disclosures have been described in

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connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining available teaching references in the field of network searching to apply above available suggestions in the disclosure of Dialog Inc., Business Wire and Buck et al. because this would be apparent to artisan in searching business.

5. Re. to claim 13: The subject matter is similar to claim 1; therefore, it is rejected based on 35 U.S.C.103(a) for obvious reason with references set forth.

Dialog Inc. does not disclose exactly claimed languages as of the applicants.

However, the Official Notice is taken here that all claimed's limitations are well-known in the art of searching using available database in a network (see extra cited references); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for computer searching. Cited prior arts are not limited to the described embodiments in these references. It is reasonable that various modifications and variations of the described method and

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system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these disclosures have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining available teaching references in the field of network searching to apply above available suggestions in the disclosure of Dialog Inc., Business Wire and Buck et al. because this would be apparent to artisan in searching business.

6. Re. to claims 4, 6: A step of including listings having all bid amounts (including zero) is a designer's choice. The subject matter is similar/analogous in these claims; therefore, the Official Notice is taken that it is rejected based on 35 U.S.C.103(a) for obviousness.

7. Re. to claim 11: Besides the inherent steps as in claim 1, this claim further including:

- estimating the cost of a search listing for a specified period upon receiving a request from a web site promoter. This is similar/analogous to a feature that Dialog Classic offered e.g. estimating cost at the end of a search session.



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Dialog Inc. does not disclose exactly claimed languages as of the applicants.

However, the Official Notice is taken here that all claimed's limitations are well-known in the art of searching using available database in a network (see extra cited references); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for computer searching. Cited prior arts are not limited to the described embodiments in these references. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these disclosures have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining available teaching references in the field of network searching to apply above available suggestions in the disclosure of Dialog Inc., Business Wire and Buck et al. because this would be apparent to artisan in searching business.

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8. Re. to claim 14: Besides the inherent steps as in claim 1, this claim further including:

- suggesting alternative search terms for generating additional search result lists. This is similar to a limitation that STN/CAS commercial search database offered; wherein a thesaurus and a dictionary are available to use for finding synonyms. Therefore, it is rejected based on 35 U.S.C.103(a) for obviousness.

Dialog Inc. does not disclose exactly claimed languages as of the applicants.

However, the Official Notice is taken here that all claimed's limitations are well-known in the art of searching using available database in a network (see extra cited references); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for computer searching. Cited prior arts are not limited to the described embodiments in these references. It is reasonable that various modifications and be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these disclosures have been described in connection with specific preferred embodiments, it should be understood that the

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invention as claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining available teaching references in the field of network searching to apply above available suggestions in the disclosure of Dialog Inc., Business Wire and Buck et al. because this would be apparent to artisan in searching business.

**Allowable Subject Matter**

9. Claims 52, and 68 are allowed because their combination of limitations are non-obvious to Dialog Inc., Business Wire, and Buck et al. references.

10. Claims 53-67 are allowed because they are dependent claims of the allowable, independent claims 52.

**Conclusion**

11. Claims 1-51 are rejected.

Claims 52-68 are allowed.

12. These prior cited references are considered pertinent to applicants' disclosure.

- Northern Light Technology, LLC, "Help & Hints Table of Contents", from URL address:

<http://www.sirocco.northernlight.com/docs/>, copyright 1997-1998.

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- Goto.com Inc., Goto Search Results: search engine, from URL <http://www.goto.com/d/search-results/>, printed on 8/19/1998.
- Kim Komando, With about 320 million sites, search engines offer some help, printed in 1998, Los Angeles Times Syndicate.
- "Disclosure Rules: ...", from The Industry Standard pg.2 <http://www.thestandard.net/>, posted on 8/10/1998.
- An article of "GoTo.com 's account management tool for...", from [dtc@goto.com](mailto:dtc@goto.com) (GoTo DirecTraffic Center), no date.
- Buck et al., (US Pat. 6,078,866), disclose about an Internet site searching and listing service based on monetary ranking of site listings, published on 6/20/2000; priority date is 6/24/1998.
- Hunt et al., (US Pat. 5,724,524), disclose a method and a system for listing, brokering, and exchanging carrier capacity, published on 3/03/1998.
- Kirsch, (US Pat. 5,659,732), discloses about document retrieval over networks wherein ranking and relevance scores are computed at the client for multiple database documents, published on 8/19/1997.
- Mauldin, (US Pat. 5,748,954), discloses about a method for searching a queued and ranked constructed catalog of files stored on a network, published on 5/05/1998.

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- Danny Sullivan, "Goto sells positions", from the search engine report, published on 3/03/1998.
- Laura B. Smith, "Going ... gone, from PC Week, v13, n34, pE1(2), printed on 8/26/1996.
- 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.
- 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.
- Kim 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.

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- 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".
- 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.

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- 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.
- 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, Engine sells results, draws fire, from CNET News.com, printed on 6/21/1996.
- "ClickMail Central Directory Specifications", from URL address <http://www.oneclick.com/server/>, dated on 8/18/1998.
- Wingfield, "Another engine takes ads by the click", <http://www.news.com/News/Item/0,4,1387,00.html> published on 5/22/1996.

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- Pelling, "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/ignews02.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.

- 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.



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- 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.
- 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.

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- 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.
- Pelline, "Pay-for-placement gets another shot", <http://www.news.com/News/Item/0,4,19307,00.html>, published on 2/19/1998.

13. Notes:

Applicants assert that "the amended claims 1, 11,13-15, 30, 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 have been amended to include similar limitations.

The examiner disagrees; he submits that all claims' limitations are inherent/obvious with the implementation that Goto.com suggested in the article published on May 19, 1998, about

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"GoTo.com announces first round of financing, totaling more than \$6 million, led by Draper Fisher Jurvetson" and Dialog Inc. It obviously/inherently sets forth the mode contemplated by prior art of carrying out the subject matter 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. That means the claims' subject matter is not original.

*In re Fine*, 5 USPQ2d 1596 (CA FC 1988), the court said:

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

*In re Bozek*, 163 USPQ 545 (CCPA 1969), the court said:

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

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*In re Gershon, Goldberg, and Weiditch*, 152 USPO 602 (CCPA 1967),  
the court said:

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

In re Conrad, 169 USPO 170 (CCPA 1971), the court said:

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.149. 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 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, Vincent A. Millin, can be reached on (703)308-1065.

Any response to this action should be mailed to:

Box Issue Fee

Amendments

Commissioner of Patents and Trademarks

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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 2165  
Nov. 08, 2000