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Elaine K Lee

Name of Applicant, Assignee or  
Registered Representative

[Signature]

Signature

October 22, 1999

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Director's Office  
Group 2700

Our Case No. 9623/112

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Darren J. Davis et al.

Serial No. 09/322,677

Filing Date: May 28, 1999

For SYSTEM AND METHOD FOR  
INFLUENCING A POSITION ON A  
SEARCH RESULT LIST  
GENERATED BY A COMPUTER  
NETWORK SEARCH ENGINE

Examiner

Group Art Unit No. 2771

PETITION AND MOTION UNDER 37 CFR § 1.102(d) TO MAKE APPLICATION  
SPECIAL

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is a petition and motion under 37 C.F.R. §1.102(d) and MPEP 708.02(II), to make the above-identified application "special" because of actual infringement. In support of the petition and motion, there are presented herewith a verified showing,

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entitled DECLARATION IN SUPPORT OF PETITION AND MOTION UNDER 37 C.F.R. §1.102(d) TO MAKE APPLICATION SPECIAL; and a check for \$ 130, representing the petition fee under 37 CFR §1.17(i)(2) and §1.102(d).

#### STATEMENT OF RELIEF REQUESTED

The Commissioner, or his delegate under MPEP 1002.02 and 1002.02(s), is requested to designate Application Serial No. 09/322,677 "special", and to thus advance consideration of the application out of turn, because of actual infringement.

#### STATEMENT OF MATERIAL FACTS

As detailed in the accompanying DECLARATION IN SUPPORT OF PETITION AND MOTION UNDER 37 C.F.R. §1.102(d) TO MAKE APPLICATION SPECIAL, several infringers or potential infringers of claims pending in the above-identified application, including SearchUP.com/SearchUP, Inc., hitsgalore.com/Reports Galore, isseekit.com/I Seek It, and findwhat.com/BeFirst Internet Corporation, have been encountered by the assignee of the above-identified application, GoTo.com, Inc. These infringing activities were recently discovered by employees of GoTo.com, Inc.

A rigid comparison between the Internet search engine services of the infringers or potential infringers and the pending claims leads to the conclusion that at least some of the claims pending in the above-identified application (the "infringed claims") would unquestionably be infringed, if those infringed claims were contained in an issued U.S. patent.

In accordance with MPEP 708.02(II), applicants have made a careful and thorough search of the prior art relating to the infringed claims. Applicants also have a good knowledge of the prior art in the industry that may be pertinent to the infringed claims. Applicants have provided one copy each of the references deemed most closely related to the subject matter encompassed by the claims in the Information Disclosure Statement filed on August 27, 1999. It is believed that all of the claims now presented in the above-mentioned application as amended by the concurrently filed amendment are allowable.

The Commissioner is requested to make the application special so that infringement of the assignee's rights in the pending claims can be enjoined at an early stage, before the sales and investments of the infringers or potential infringers will have risen to a level at which they will have an interest in prolonging infringement, and before the present assignee's market position will have been irreparably damaged. Others have been seeking to duplicate the invention, despite warnings that the assignee of the above-identified application is currently pursuing comprehensive patent rights on the invention. It can be appreciated that, at an early stage, with less time and money invested in a product, such infringers or potential infringers will be less disposed to engage in litigation. As a result, the sooner the examination is concluded, the better position the assignee will be in to fully protect its interests, and at less cost to all.

It is therefore very important to the assignee of the above-identified application that a patent for the present invention issue promptly, in order that the infringement of the assignee's rights in the invention be abated.

#### CONCLUSION

37 C.F.R. § 1.102(a) provides that "[a]pplications will not be advanced out of turn for examination or further action except ... upon filing a petition ... with a showing which, in the opinion of the Commissioner, will justify so advancing it". One of the accepted grounds for advancing an application for examination out of turn (making the application "special") is "actual infringement", i.e., circumstances which would constitute infringement if the application claims were contained in an issued patent. Standards for granting a petition to make special by reason of infringement are set out in MPEP 708.02(II).

The standards of MPEP 708.02(II), including actual infringement and apparent allowability of the infringed claims, are met in this case, as shown in the DECLARATION IN SUPPORT OF PETITION UNDER 37 CFR § 1.102(d) TO MAKE APPLICATION SPECIAL, and summarized above under "Statement of Material Facts". It is therefore requested that the above-identified application be made "special" by reason of actual infringement.

Respectfully submitted,

*[Signature]*

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