

EXHIBIT G



Attorney Docket No. 63000.16
(Formerly 031612.0041)

#11B
3/9/04
AW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)	
Tom MATHAI, <i>et al.</i>)	Examiner: Jacques VEILLARD
Serial No.: 09/959,654)	Group Art Unit: 2175
Filed: May 3, 2000)	
For: METHOD AND SYSTEM FOR)	
PROVIDING PERSONALIZED)	
ONLINE SERVICES AND)	
ADVERTISEMENTS IN)	
PUBLIC SPACES)	

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

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Dear Sir:

In response to the non-final Office Action mailed August 28, 2003, Applicants respectfully request entry of the following amendments and reconsideration of all rejections in view of these amendments and the following remarks. Concurrently submitted herewith is a Request for a three-month extension of time, thereby extending the deadline for submitting a timely reply up to and including March 1, 2004.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims, which begins on page 3 of this paper.

In sum, claims 1, 4, 13, 14, 16, 22, and 24 are currently amended.

Claims 2, 3, 5-12, 15, 17-21, 23, and 25-42 remain unchanged.

No claims have been added or cancelled by way of this Reply.

Accordingly, claims 1-42 are currently pending.

Remarks/Arguments begin on page 9 of this paper.



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Amendments to the Specification:

Please add the following abstract at the appropriate location:

ABSTRACT OF THE DISCLOSURE

31 A method and system for providing, personalized and integrated online services for communications and commercial transactions both in private and public venues. The invention provides personalized information that is conveniently accessible through a network of public access stations (or terminals) which are enabled by a personal system access card (e.g., smart card). The invention also provides advertisers the opportunity to directly engage action; and potential user-consumers with selected advertising or marketing content based on each user's profile and usage history.



Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (currently amended) A system, comprising:
a terminal, wherein said terminal has an identification code for determining an exact physical location of said terminal;
a database having a profile for a user; and
a program for displaying personalized information, wherein said personalized information is selected for display based upon said profile.

2. (original) ~~The system of claim 1, wherein said database includes usage history information for said user.~~

2
3. (original) The system of claim 2, wherein said personalized information is also selected for display based upon said usage history information.

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3
4. (currently amended) The system of claim 1, wherein said personalized information is also selected for display based upon the exact physical location of said terminal.

4
5. (original) The system of claim 1, wherein said personalized information includes an advertisement.

5
6. (original) The system of claim 1, wherein said personalized information includes an online service.

6
7. (original) The system of claim 1, wherein the system records the time said user logs on to and logs off of the system, and wherein said personalized information is also selected for display based upon the time said user logs on to the system.

7
8. (original) The system of claim 1, wherein said profile is progressively developed and updated based upon said usage history information.

9. (original) The system of claim 1, wherein said usage history information comprises information selected from the group consisting of demographic information, personal interest information, behavior-tracking information, responses to other advertising content, locations of terminals used by the user, and the time at which the user uses the system.

8
10. (original) The system of claim ~~9~~^{8, 7}, wherein said program displays advertising content tailored to said user's interests and behavior.

9
11. (original) The system of claim 1, wherein said terminal comprises a keyboard and a touch sensitive screen.

10
12. (original) The system of claim 1, wherein said terminal comprises a credit card swipe terminal for processing credit transactions.

11
13. (currently amended) The system of claim 1, wherein said terminal ~~includes an identification representing the physical location of said terminal~~ is publicly accessible.

12
14. (currently amended) A system, comprising:
a plurality of terminals located in public spaces and accessible to a user,
each of said plurality of terminals having [[an]] a unique identification representing its code for determining an exact physical location of said terminal;
a user access card for allowing said user access to said plurality of terminals, said card having a unique user identification code corresponding to said user;
a database comprising a user profile for said user;
a program for recording the usage history information of said user; and
a program for displaying personalized information to said user, wherein said personalized information is selected based upon said user profile.



¹³
~~13~~. (original) The system of claim ~~14~~¹², wherein said personalized information is also selected for display based upon said usage history information.

¹⁴
~~16~~. (currently amended) The system of claim ~~14~~¹², wherein said personalized information is also selected for display based upon the exact physical location of said terminal.

¹⁵
~~17~~. (original) The system of claim ~~14~~¹², wherein said personalized information includes an advertisement.

¹⁶
~~18~~. (original) The system of claim ~~14~~¹², wherein said personal information includes an online service.

¹⁷
~~19~~. (original) The system of claim ~~14~~¹², wherein said program for recording records the time said user logs on to and logs off of the system, and wherein said personalized information is also selected for display based upon the time said user logs on to the system.

¹⁸
~~20~~. (original) The system of claim 14, wherein said usage history information comprises information selected from the group consisting of: demographic information, personal interest information, behavior-tracking information, responses to other advertising content, locations of terminals used by the user, and the time at which said user uses the system.

¹⁸
~~21~~. (original) The system of claim ~~14~~¹², further comprising an email program for allowing said user to send and receive emails.

¹⁹
~~22~~. (currently amended) A method, comprising:
providing a terminal accessible by a consumer, wherein said terminal has an identification code for determining an exact physical location of said terminal;
maintaining a database having a profile of said consumer;
recording usage history information of said consumer;
maintaining a plurality of advertisements and online services;

selecting among said plurality of advertisements and online services based upon said profile;

providing selected advertisements and online services to said consumer.

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~~23.~~ (original) The method of claim ~~22~~¹⁹, wherein said selecting step also uses said usage history information.

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~~24.~~ (currently amended) The method of claim ~~22~~¹⁹, wherein said selecting step also uses the exact physical location of said terminal.

22

~~25.~~ (original) The method of ~~22~~¹⁹, wherein said selected advertisements are displayed to said consumer on a rolling basis.

23

~~26.~~ (original) The method of claim ~~22~~¹⁹, wherein said selecting step also uses the time said consumer logs on to said terminal.

~~27.~~ (original) A system, comprising:
a plurality of terminals located in public spaces; and
a server operably connected with said plurality of terminals and having content;
wherein the system displays at least a portion of said content on each of said plurality of terminals based upon the physical location of said each of said plurality of terminals.

~~28.~~ (original) The system of claim 27, wherein said content includes an advertisement.

~~29.~~ (original) The system of claim 2, wherein said content includes a service.

~~30.~~ (original) The system of claim 27, wherein each of said terminals is accessible free of charge to users.

~~31.~~ (original) The system of claim 27, wherein said network is a private network.

32. (original) The system of claim 27, wherein said network includes broadband communications.
33. (original) The system of claim 27, wherein said network includes wireless communications.
34. (original) The system of claim 33, wherein said wireless communications include communication via satellite.
35. (original) The system of claim 27, wherein said server is operably coupled to said plurality of terminals by wireless and wired communications.
- B2 36. (original) The system of claim 27, wherein said wireless communications include communication via satellite for downloading said content and said wired communications includes communication via telephone lines for uploading information from each of said plurality of terminals to said server.
37. (original) The system of claim 27, further comprising an email program for allowing users to send and receive emails.
38. (original) The system of claim 27, wherein each of said plurality of terminals includes cache memory for accessing said content.
39. (original) A method, comprising
providing a plurality of terminals located in public spaces which are operably connected by a network;
maintaining advertisements and services; and
providing at least a portion of said advertisements and services to each of said plurality of terminals based upon the physical location of said each of said plurality of terminals.

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40. (original) The method of claim 39, wherein use of said plurality of terminals is provided access free of charge.
41. (original) The method of claim 39, wherein sponsors provide for the expense of said plurality of terminals and the operating cost of said maintaining and said providing advertisements and services.
42. (original) The method of claim 39, wherein said public spaces include retail stores and restaurants.

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REMARKS

Claims 1-42 are currently pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks:

Applicants are submitting an abstract to satisfy the Examiner's request. However, Applicants note that an abstract was submitted in the specification as-filed, i.e., the copy of the International Application PCT/US00/11840, which is presented by way of Publication No. WO 00/67092, submitted under 35 U.S.C. § 371.

I. Rejection under 35 U.S.C. § 102(b)

Claims 1-10 and 22-26 stand rejected under 35 U.S.C. 102(b), as allegedly anticipated by Sara Hedberg, "Agents for Sale: First Wave of Intelligent Agents Go Commercial," IEEE Expert, Vol. 11, Issue 6, pages 16-19 ("Hedberg"). Applicants contend that the instant rejection is unsustainable.

In order for there to be anticipation, the identical invention must be shown in as complete detail as is contained in the patent claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)

Although Applicants conclude that the grounds for the instant rejection are unsoundly based, independent claim 1 has nonetheless been amended to better describe the claimed invention. Claim 1 as amended is repeated as follows:

1. A system, comprising:
 - a terminal, wherein said terminal has an identification code for determining an exact physical location of said terminal;
 - a database having a profile for a user; and
 - a program for displaying personalized information, wherein said personalized information is selected for display based upon said profile.(Emphasis added.)

Support for the amendments to this claim are found at least in claim 13 as originally filed and page 8, lines 6-8 of Applicants' specification. Claim 1 as it is now presented captures the concept of a terminal having an identification code for determining the exact physical location of the terminal. Such an identifier is particular useful, for example, to enable presentation of information based on the actual physical location of the terminal such as, but no limited to, information pertaining to adjacent or neighborhood restaurants, shops, museums, etc. (i.e., the "street space") near the terminal. The Firefly agent disclosed by Hedberg merely makes

personal interest suggestions based on a user's profile or other users' recommendations (*see* page 16), and not on the physical location of a terminal. In fact, Hedberg is solely focused on presenting an overview of the Firefly agent and provides no specifics whatsoever about a terminal or computer ~~that~~ would facilitate the agent. Thus, Hedberg fails to teach or suggest "a terminal, wherein said terminal has an identification code for determining an exact physical location of said terminal" as recited in independent claim 1. Handel also fails to teach or suggest this limitation. *See* remarks, *infra*.

With regard to dependent claims 2, 3, 8, and 9, Hedberg fails to teach or suggest the recited "usage history" as the Examiner otherwise contends. Referring to page 8, line 24 to page 9, line 3 of Applicants' specification, a "usage history" includes information such as location or time of terminal access, user responses to advertising, and types of content accessed by the user. Firefly as described by Hedberg records a user profile based merely upon answers to preference questions. Hedberg does not even identify the particular questions that Firefly purportedly asks the user. Hedberg does not teach or suggest the tracking, storing or displaying of personalized information associated with a user's "usage history."

Hedberg also fails to teach or suggest "personalized information . . . selected for display based upon the exact physical location of said terminal" as recited in dependent claim 4. *See* remarks, *supra*.

With regard to dependent claims 5 and 10, Hedberg fails to explicitly disclose "personalized . . . advertisement" as recited. Hedberg discusses general advertising (*see* page 17), but it does not explicitly teach or suggest that the advertising is personalized according to, for example, a user's interests and behavior.

Hedberg fails to teach or suggest "the system records the time said user logs on to and logs off of the system, and wherein said personalized information is also selected for display based upon the time said user logs on to the system" as recited in claim 7. Hedberg provides no teaching or suggestion that supports anticipation of this claim. *See* remarks, *supra*.

Independent claim 22 has also been amended to better describe the claimed invention. Claim 22 as amended is repeated as follows:

22. A method, comprising:
providing a terminal accessible by a consumer, wherein said terminal has an identification code for determining an exact physical location of said terminal;
maintaining a database having a profile of said consumer;

recording usage history information of said consumer;
maintaining a plurality of advertisements and online services;
selecting among said plurality of advertisements and online services based upon said profile;
providing selected advertisements and online services to said consumer.
(Emphasis added.)

As with independent claim 1, claim 22 recites an identification code for determining the exact physical location of the terminal. Hedberg fails to teach or suggest this limitation. *See* remarks, *supra*. Moreover, Hedberg fails to teach or suggest “usage history information” or “advertisements . . . based on [a user’s] profile.” *See* remarks, *supra*. Simply put, Hedberg does not provide the specific details that are contained in this independent claim and all claims dependent therefrom, *e.g.*, claims 23-26.

For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and unsustainable, and request that the Examiner withdraw the rejection of claims 1-10 and 22-26.

II. Rejection under 35 U.S.C. § 103(a)

Dependent claims 11-13 stand rejected under 35 U.S.C. 103(a), as allegedly rendered unpatentable over Hedberg in view of U.S. Patent No. 6,195,651 to Handel *et al.* (“Handel”). Applicants contend that this rejection is unsustainable at least because Handel fails to provide the teachings missing from Hedberg noted with respect to independent claim 1. For example, Hedberg fails to teach or suggest “a terminal, wherein said terminal has an identification code for determining an exact physical location of said terminal” as recited in claim 1. *See* remarks, *supra*. Handel provides a web-based interface that employs a user profile. *See* Handel abstract. The closest Handel touches upon location information is a “location the user indicates as the meeting place” as the Examiner has pointed to in Handel col. 28, ll. 14-26. However, Handel’s meeting location is just that, a location specified for a meeting, and clearly not an identification code pertaining to an actual physical location of a terminal. Thus, Hedberg taken alone, or in combination with Handel, fails to teach or suggest all of the limitations recited in claims 11-13.

For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and unsustainable, and request that the Examiner withdraw the rejection of claims 11-13.

Claims 14-21 and 27-42 stand rejected under 35 U.S.C. 103(a), as allegedly rendered unpatentable over Hedberg in view of Handel. Applicants contend that this rejection is unsustainable.

Independent claim ~~14~~ has been amended to better describe the claimed invention. Claim 14 as amended is repeated as follows:

14. A system, comprising:

a plurality of terminals located in public spaces and accessible to a user, each of said plurality of terminals having a unique identification representing its code for determining an exact physical location of said terminal;

a user access card for allowing said user access to said plurality of terminals, said card having a unique user identification code corresponding to said user;

a database comprising a user profile for said user;

a program for recording the usage history information of said user; and

a program for displaying personalized information to said user, wherein said personalized information is selected based upon said user profile. (Emphasis added.).

The system of independent claim 14 recites a plurality of terminals, wherein each one has a unique identification code for determining the exact physical location of the terminal like set forth in independent claim 1. Neither Hedberg nor Handel teach or suggest a plurality of terminals, each of which has the recited unique identification code pertaining to an exact physical location of the terminal. See remarks, *supra*. Thus, Hedberg taken alone, or in combination with Handel, fails to teach all of the limitations recited in independent claim 14 and all claims dependent therefrom, *i.e.*, claims 15-21.

Independent claim 27 is presented as originally filed and is repeated as follows:

27. A system, comprising:

a plurality of terminals located in public spaces; and

a server operably connected with said plurality of terminals and having content;

wherein the system displays at least a portion of said content on each of said plurality of terminals based upon the physical location of said each of said plurality of terminals. (Emphasis added.).

The system of independent claim 27 recites a display of content "based upon the physical location of said each of said plurality of terminals." Independent claim 39 similarly recites this limitation. Neither Hedberg nor Handel teach or suggest the display of information based upon the physical location of a terminal. See remarks, *supra*. Thus, Hedberg taken alone, or in

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combination with Handel, fails to teach all of the limitations recited in independent claim 27 or 39, and all claims dependent therefrom, *i.e.*, claims 28-38 or claim 40-42, respectively.

For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and unsustainable, and request that the Examiner withdraw the rejection of claims 14-21 and 27-42.

CONCLUSION

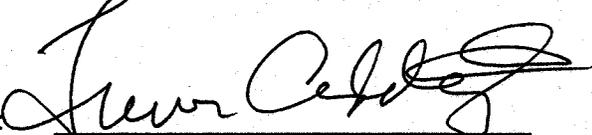
Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. Should the Examiner believe any patentability issues remain upon considering this Reply, the Examiner is invited to contact the Applicants' undersigned representative to discuss a resolution of such.

Applicants are submitting herewith a Petition for a Three-Month Extension of Time and requisite fees totaling \$465.00. In the event that a variance exists between the fee amount submitted by Applicants and that deemed necessary by the United States Patent and Trademark Office in order to enter and consider this Reply, or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:



Trevor Coddington, Ph.D.
Patent Agent
Registration No. 46,633

Dated: February 26, 2004

TC:cdh

