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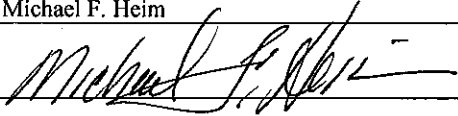
TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	95/001,073
Filing Date	July 30, 2008
First Named Inventor	Lucinda Stone
Group Art Unit	3993
Examiner Name	Jeffrey L. Gellner

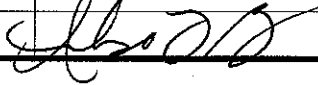| Total Number of Pages in This Submission		Attorney Docket Number	1039-0010

ENCLOSURES *(check all that apply)*

☒ Fee Transmittal Form

    ☐ Fee Attached

☒ Amendment/Reply

    ☐ After Final

    ☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/
    Incomplete Application

    ☐ Response to Missing Parts
       under 37 CFR 1.52 or 1.53

☐ Assignment
    (for an application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a
    Provisional Application

☐ Power of Attorney, Revocation
    Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s)

Remarks

☐ After Allowance Communication
    to Group

☐ Appeal Communication to Board
    of Appeals and Interferences

☐ Appeal Communication to Group
    (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) *(please
    identify below):*

Post Card and Certificate of Service

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name	Michael F. Heim
Signature	
Date	February 23, 2009

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Express Mail Service to the Commissioner for Patents, Alexandria, VA 22313 on this date: February 23, 2009.

Typed or Printed Name	Amber L. Branum		
Signature		Date	February 23, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stone, et al

Reexamination Control No.: 95/001,073

U.S. Patent No.: 7,240,025

Reexamination Request Filed: July 30, 2008

For: INERNET ADVERTISING SYSTEM
        AND METHOD

Examiner: Jeffrey L. Gellner

Technology Center/Art Unit: 3993

Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a Response to Office Action:

☐   No additional fee is required.
☒   Applicant is entitled to small entity status under 37 CFR 1.27
☒   Also attached: Certificate of Service

The fee has been calculated as shown below:

☐   Please charge my Deposit Account No. 504592 in the amount of $0.00. An additional copy of this transmittal sheet is submitted herewith.

☒   The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment, to Deposit Account No. 504592, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

Michael F. Heim
Reg. No. 32,702

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Date: February 253, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stone, et al

Reexamination Control No.: 95/001,073

U.S. Patent No.: 7,240,025

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Attn: Mail Stop "Inter Partes Reexam"
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF SERVICE

I, Amber L. Branum, hereby certify that the Response to Office Action with 2 exhibits were filed on February 23, 2009 for the above-referenced reexamination proceeding in the U.S. Patent and Trademark Office were served by this day 23rd of February 2009 by Federal Express and electronic mail:

John C. Phillips
Fish & Richardson
12390 El Camino Real
San Diego, CA 92130

the third party requester acting on behalf of the real party in interest, Google, Inc.

Respectfully submitted,

Amber L. Branum

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Facsimile: (713) 221-2021
Date: February 23, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stone, et al

Reexamination Control No.: 95/001,073

U.S. Patent No.: 7,240,025

Reexamination Request Filed: July 30, 2008

For: INERNET ADVERTISING SYSTEM
        AND METHOD

Examiner: Jeffrey L. Gellner

Technology Center/Art Unit: 3993

RESPONSE

Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed November 21, 2008, please enter and consider the following remarks.

The pending claims are reflected in the **Listing of Claims** following the Response. In this Response, no amendments have been made to the claims.

An **Appendix** and **2 Exhibits** are attached, following the Listing of Claims.

REMARKS

Patent Owner respectfully acknowledges receipt of the First Office Action mailed November 21, 2008. In that Office Action, the PTO rejected certain of the '025 claims as follows: (A) claims 1, 6-7, 11-17, 20, 23-24, 28-32, 36-39, 45-47, 50-52, 62-63, 79, 81, 90-91, 140-141, 148, 179, 185-186, 190-196, 199, 202-203, 207-211, 215-218, 224-226, 229-231, 241-242, 258, 260, 269-270, 319-320, and 327 (1) anticipated under § 102(b) by AdForce; (2) anticipated under § 102(e) by the Del Sesto '882 patent; (3) anticipated under § 102(b) by the Naqvi patent[1]; (4) obvious under § 103(a) by MarketMatch in view of AdForce; (5) obvious under § 103(a) by the Campaign Manager in view of AdForce; (6) obvious under § 103(a) by MarketMatch in view of Naqvi; and (7) obvious under § 103(a) by Campaign Manager in view of Naqvi; and (B) claims 1, 47, 50-52, 79, 81, 140-141, 148, 179, 226, 229-231, 258, 260, 319-320, and 327 anticipated under § 102(e) by the Brown '368 patent. Function Media respectfully requests reconsideration for the reasons that follow.

I.   Background

The inventors of the '025 patent are employees and principals of Function Media, the current Patent Owner. The '025 patent is a continuation of the '587 patent, which in turn is a continuation of the '045 patent. The '025 patent has an identical specification and the same effective filing date as the '045 patent. Prior to their work on the '045 invention, the inventors had developed an Internet-based directory, called First Traveler's Choice (FTC). FTC generated presentations[2] that were derived from information submitted by bed-and-breakfast innkeepers. Prospective customers could review the FTC presentations over the Internet. Through discussions with their innkeeper clients, the inventors realized that a significant problem existed for companies wishing to advertise goods or services in multiple venues on the Internet. Specifically, they discovered that on-line advertisers were required to learn the particular rules for every media outlet where they wished to publish ads, and then had to produce and submit separate ads customized to comply with the rules of each individual media outlet. The inventors also knew from their experience as a media outlet operator that the process of negotiating the placement, content, and publication of a seller's presentation was a time-consuming process, requiring significant interaction and coordination between the media outlet and seller.

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[1] WO 97/21183.

[2] The terms "presentation," "advertisement," and "ad" are used interchangeably herein.

Furthermore, the existing process did not provide media outlets with an adequate method of implementing quality control standards over submitted presentations. In an attempt to solve these problems, the inventors sought a more efficient approach that minimized the work required of sellers who wanted to advertise in multiple on-line media outlets, while providing media outlets with a greater degree of control over the submitted advertising materials. The `025 patent discloses and claims that approach.

The `025 patent significantly advanced the state of the art in on-line advertising by eliminating the need to upload pre-created ads into the system. Instead, the `025 patent disclosed entering into the system raw advertising content that then is used by the system to create ads whose look and feel can be automatically changed to match the look and feel of any number of media venues to which the advertising content is to be published. The `025 patented technology enables sellers to **create** presentations without knowing the presentation rules of the internet media venues where their presentation will be published, or even knowing in which internet media venues their presentations will be published. Further, the `025 patent enables media venues to maintain control over the content and the "look and feel" of the presentations they receive and display without requiring direct interaction with the sellers.

As a result of the inventions disclosed in the `025 patent, sellers are able to create multiple presentations customized to meet the requirements of a variety of media outlets, with considerable savings in time and effort. These savings are achieved because the different custom presentations are created automatically in presentation generation software, based on a single entry of information:

> This invention improves on the prior art by automatically publishing the information and data received from sellers in an open-access format that is readily available to public automatic search and index programs as well as to on-demand search programs. With this invention, the seller's presentation can be published in several different directories or indexes, taking on a different style, look, and feel in each as a result of the **automatic restructuring** of the data entered by the seller. This is accomplished by using different presentation formatting guidelines and rules for the targeted directories or indexes. This single-entry and automatically distributed method is more efficient than managing each directory or index individually. `025 patent at 5:14-27.

The `025 patent claims an apparatus and method that automatically creates and publishes electronic presentations customized to internet media venues' guidelines, and that allows a seller independent control of the creation and publication of these customized rule-compliant electronic

presentations. The automated creation method disclosed in the preferred embodiment is capable of applying editing, style, graphics, data, and content controls to the seller information, as well as design specification and architectural requirements of individual media venues. `025 patent at 5:4-9. In other words, presentation data input by the seller takes on a different style, look, and feel when published in different media outlets, due to "the automatic restructuring of the data entered by the seller" in accordance with guidelines specified by each media venue.

Unlike prior systems that focused on assisting a marketing firm in selecting and distributing advertising presentations to suitable media venues, the `025 patent provides the capability of replacing the marketing firm altogether by providing an environment that employs a simple data-entry system that a seller—who may have little or no knowledge of presentation software applications or low-level formatting codes—can easily use. `025 patent at 5:38-45. The invention of the `025 patent further simplifies this process by providing separate self-serve, menu-driven interfaces for internet media venues to enter their presentation rules and for sellers to enter their media venue selection and advertisement data. `025 patent at 6:3-11, 59:51-56; *see also* `025 patent abstract.

The ability to automatically transform a seller's information into multiple advertising presentations that each conform to the individual guidelines of targeted media outlets—without requiring the seller to know the presentation rules of the media outlets—provides tremendous efficiencies to both sellers and media outlets and allows sellers to advertise across the Internet, with minimal time, effort and expertise. The `025 patented apparatus and method enables even relatively unsophisticated sellers to greatly expand their marketing presence across multiple media outlets, while minimizing the labor-intensive burdens that previously had been required to customize presentations for multiple outlets.

The inventions disclosed in the `025 patent also relieve media venues of the need to examine content submitted to them. Instead, the individual media venues specify guidelines that are subsequently used when the presentation generation software automatically generates the ads. By specifying guidelines in advance of the generation process, a media venue can control the content and aesthetics of the presentations that are submitted to it.

In short, the `025 patent discloses: (1) the use of two separate interfaces by two separate entities (media venues and a seller, respectively), where the information entered via each interface is stored in a separate database, (2) a first interface prompting a media venue to input

presentation rules[3] and a first database storing these presentation rules, (3) a second interface prompting a seller to input media venue selection information and advertising content and a second database storing this selection and content information, and (4) a computer controller (a) applying the presentation rules of the media venues selected by the seller to advertising content input by the seller to automatically create customized, guideline-compliant electronic advertisements for the selected media venues, and (b) automatically publishing the electronic advertisements to the selected media venues for display.[4]

This unique combination of features allows advertising to flourish because it permits media venues and sellers that are "strangers" to each other to be brought together via participation in the system. The claimed invention allows a seller to retain control over the placement and content of its presentations, and the media venues to retain control over the content and "look and feel" of the advertisements they receive and display. This method maximizes seller and media venue exposure and revenue while at the same time saving the seller and media venue time and money.

In the following discussion, Patent Owner will focus on the basic fundamental differences between the claimed invention and the cited prior art in an attempt to narrow the issues and to streamline these proceedings, with the understanding that it reserves the right to address other differences in future responses.

II. Background of the Claims and Specification

A. The PTO Applies the Broadest Reasonable Interpretation of a Claim that is Consistent with the Specification

During a reexamination proceeding, the PTO examines claims using their "broadest reasonable interpretation." MPEP §§ 2258(I)(G), 2658; *In re Yamamoto*, 740 F.2d 1569, 1572 (Fed. Cir. 1984). This standard is different than the broadest possible interpretation, because the PTO is constrained by certain guidelines imposed by both the MPEP and the Federal Circuit. Notably, the PTO can only give claims the broadest interpretation that is both reasonable and

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[3] Presentation rules are also referred to as "guidelines." These terms should be treated synonymously.

[4] Portion (4) of this statement assumes the presentations rules of a selected media venue allow for publication of an advertisement from the seller to that venue. However, it should be noted—here and throughout this Response—that an advertisement for a media venue selected directly by the seller may not be created and published to that selected media venue if that media venue has a presentation rule that prohibits the advertisement's content from being published on the media venue or that prohibits the particular seller from submitting an advertisement to the media venue.

consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); MPEP § 2111. Further, the Federal Circuit has made it clear that the PTO must pay deference to <u>any</u> interpretive guidance offered in the patent specification:

> Some cases state the standard as "the broadest reasonable interpretation," [citation omitted] others include the qualifier "consistent with the specification" or similar language [citation omitted]. Since <u>it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description,</u> either phrasing connotes the same notion: as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, <u>taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.</u> *Id.* at 1054 (emphasis added). *See also Phillips*, 415 F.3d 1303, 1314-5 (Fed. Cir. 2005) ("... claims must be read in view of the specification, of which they are a part.... [T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive.").

Function Media respectfully submits that the specification and claim context are largely dispositive of the proper claim interpretation in this reexamination. Although neither Requester nor the PTO provided a specific interpretation of any claim terms, it is clearly the view of both that the claims may be interpreted sufficiently broadly to overlap with the prior art. With all due respect, both Requester's and the PTO's implied interpretation of these claims are unreasonable in light of the specification.

There are 74 claims from the `025 patent that are under reexamination: 1 pair[5] of independent claims (1/179), and 36 pairs of dependent claims (6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, 148/ 327). The general scope of these claims will be briefly addressed below.

B.   Independent Claims 1/ 179[6]

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[5] The `025 patent contains a number of apparatus claims and method claims that directly track one another—these claims will be referred to as "pairs" throughout the remainder of this Response.

[6] Claim 1 and claim 179 directly track one another (with one minor exception) and thus should be construed consistently. In its First Office Action, the PTO used identical references to the prior art to anticipate each element of claims 1 and 179. *See, for example,* OA at 194-196, 333-334, regarding rejection of claims 1 and 179, respectively, based on the AdForce reference. Accordingly, the rejection of these two claims will be addressed together throughout this Response. The dependent claims under reexamination also consist of matched pairs of apparatus claims and method claims that directly track one another, and that have been rejected by the PTO on the same grounds. Accordingly, the rejection of these pairs of dependent claims will also be addressed together throughout this Response.

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The plain language of claim 1[7] recites a computer system for creating customized electronic advertisements for a seller and publishing those advertisements to selected internet media venues, where the individual electronic advertisement published to each selected internet media venue is in compliance with the presentation rules of that particular media venue. The claimed apparatus requires the computer system to provide:

(1) a first interface that prompts one or more internet media venues to input presentation rules, and a first database[8] to store these rules;

(2) a second interface that prompts a seller to

(a) input information that will be used to select one or more internet media venues, and

(b) input information that will be used to create an electronic advertisement for publication to the one or more selected internet media venues, and a second database to store this information; and

(3) a computer controller that

(a) processes the aforementioned input information (entered by the media venues and the seller) to create a customized electronic advertisement for each selected internet media venue that complies with that media venue's guidelines, and

(b) publishes the created advertisement(s) to the one or more selected internet media venues for display.

When "processing" the advertisement information, the computer controller (via the use of internal presentation generation software) formats the advertisement information in accordance with each selected internet media venue's rules, thus creating a customized rule-compliant advertisement for publication to—and display on—each selected internet media venue. `025 patent at 3:31-37; 17:51-61; 19:46-55; 20:2-6. Dependent claims 140 and 142/ 319 and 321 give non-limiting examples of exactly how the computer controller may process the input data (*i.e.,* advertising information) in order to create one or more rule-compliant electronic advertisements. These claims state that the computer controller may process and create the rule-compliant advertisement "by automatically applying or comparing the internet media presentation rules to

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[7] A similar analysis of the plain language of claim 179 is attached as an Appendix.

[8] The `025 specification defines the term "database" as referring to "the structural or relational storage of data within files" as well as to "the tables or sub-divisions of data storage within those databases or files." `025 patent at 8:64-9:3.

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the information input by the seller" or by "automatically restructuring data comprising the information input by the seller."

Once the controller processes the input information and creates one or more customized electronic advertisements, the computer controller publishes each individual advertisement to the selected media venue(s) that the advertisement was customized for. The `025 specification defines the term "publishing" as:

> The act of placing or making available the presentation or information within the framework of media venue so that it is accessible by the end users, consumers, viewers, or Buyers. This may mean placing an HTML page on an Internet directory, printing a 12-word classified ad in [an online] newspaper, adding a hotel presentation to a multimedia, CD-ROM or guidebook, or any number of other examples. `025 patent at 11:48-56.

Thus, in the context of claim 1, the phrase "publishing the electronic advertisement to one or more of the selected internet media venues" requires that an electronic advertisement be electronically placed or made available on a media venue, such as a website, for display to—and viewing by—an end user, customer, or buyer. Furthermore, the claims require that a computer controller automatically publishes the customized electronic advertisement to a media venue following its creation. It should be noted that this does <u>not</u> necessarily mean that the advertisement will be published *immediately*—just that the computer controller will *automatically* publish the presentation after its creation. `025 patent at 45:10-26 (discussing "urgent" versus "course of business" publishing).

As noted above, claim 179 recites a method of using a computer system for creating customized electronic advertisements for a seller and publishing those advertisements to selected internet media venues, and contains method-type limitations that essentially track claim 1. Claims 1 and 179 were addressed in tandem by the Requester, and were rejected on the same grounds by the Examiner. Accordingly, the interpretation and rejection of this "pair" of claims will hereinafter be addressed together in this response.

While all of the limitations of claims 1/179 must be considered when determining patentability, there is at least one limitation that clearly distinguishes these claims from all of the cited prior art: the creation of one or more electronic advertisements that comply with the presentation rules entered by selected internet media venues by processing the information input by the seller with the presentation rules of the media venues selected by the seller.

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Ad Creation

As noted in the Abstract, the '025 patent discloses "an ad modification engine [that] processes or customizes the advertisement for publication and display on each internet media venue in compliance with the media venue's presentation rules." In claims 1/179, the computer system processes the creative data entered by the seller in accordance with the rules of the media venues the seller selected, thereby creating one or more rule-compliant electronic advertisements. Once an internet media venue has entered its presentation guidelines, and the media venue selection and presentation information have been entered by the seller, the Presentation Generation Program (1710) "creates a presentation designed to conform to the requirements set forth by each media [venue]" by applying the venue guidelines (stored in the Presentation Rules Database (1650)) to the information supplied by the seller. '025 patent at 59:9-15. At this juncture, the Presentation Rules Database (1650) contains the presentation rules input by media venues, and the Presentation Database (1640) contains the media venue selection and the electronic advertisement creative data input by the seller.[9] *See* '025 patent at 17:51-61 (Presentation Database); 18:29-50 (Presentation Rules Database).

The specification states that once internet media venues have been selected, the seller is prompted "for information, based on the criteria set forth by each media outlet and held in the Presentation Rules Database 1650 ... that is then used in the creation of presentations [for the selected media venues]." '025 at 59:1-5. At this point:

> The Presentation Rules Database 1650 ... holds all the criteria, formatting architecture, and distribution factors for each participating media outlet. <u>The ... Presentation Generation Program 1710, along with the Presentation Rules Database 1650 ... then creates a presentation for each and every media outlet ... chosen.</u> The Presentation Generation Program 1710 then ... transmits the presentation to the appropriate destination." '025 at 52:10-17. *See also* '025 patent at 59:9-12.

Each presentation created is "designed to conform to the requirements set forth by each [and every] media." *Id.* at 59:9-12. The specification also describes the creation process as follows:

> The Presentation Generation Program 1710 utilizes the information submitted by the Sellers ... and held in the Presentation Database 1640 ... and Seller Database 1630. The Presentation Generation Program 1710 uses these databases **to create the requested presentations** for the various desired ... media ... using the

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[9] All of these databases are located on the Central Controller and Presentation Processor (1000). *See* '059 patent Fig. 2a.

Presentations Rules Database 1650 for style and control guidelines." `025 patent at 19:46-55.

The created electronic advertisements then are published to the selected internet media venues.

The `025 claimed invention "automatically applies not only editing, style, graphics, data, and content controls, but also design specification and architectural requirements to the design environment," [`025 patent at 5:4-10] thus "[allowing] for the creation of presentations that comply with the design and architectural requirements of any and all participating media." `025 patent at 3:62-65. The claimed invention "edits and structures data and information" provided by a seller "into consistent, designed and controlled presentations." `025 patent at 13:47-50. In the method of claim 179, the seller does *not* create presentations itself—it merely enters information to select media venues and inputs data relevant to its presentation (*e.g.,* product description, product photos, contact information, *etc.*), as requested. Once this information has been entered, customized presentations conforming to the guidelines of each and every media venue selected are automatically created by the presentation generation software.

III. All Claims Should Be Allowed

A. The Prior Art Fails to Disclose Either the Creation or Automatic Publication of Electronic Advertisements in Accordance with Claims 1/ 179

Each prior art reference cited by the PTO has at least one critical deficiency: it does not disclose the ability to automatically create electronic advertisements from information input by a seller that conform to the individual guidelines of multiple media venues (based on presentation rules input by an internet media venue). In fact, ALL of the prior art teaches away from this limitation, by requiring a user to upload a manually created ad (that may or may not comply with media venue guidelines) into the system rather than having a computer controller generate it.

The PTO also has failed to articulate any apparent reason to combine the prior art materials in the manner proposed by the Office Action. And even if there was some reason to do so, it is axiomatic that even if combined, these references still fail to meet all of the claimed limitations for the reasons set forth above.

Accordingly, it is respectfully submitted that the cited art does not teach or suggest all limitations of claims 1/ 179, and thus the patentability of these claims should be confirmed.

Because all other claims under reexamination depend from claims 1/ 179, the patentability of those claims also should be confirmed.[10]

B. The Anticipation Rejections Should Be Withdrawn

1. AdForce Reference

Independent claims 1/ 179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 102(b) as anticipated by AdForce. However, the AdForce reference fails to disclose the limitations of claims 1 and 179. Accordingly, these claims are not anticipated by AdForce and, as a result, neither are the dependent claims cited above.

AdForce describes an ad management system designed for use by an advertising agency on behalf of various sellers to facilitate the targeting and placement of the sellers' presentations, and to evaluate the "success" of those placements. AdForce was a "full-service Internet advertising solution . . . [designed] to meet the unique requirements of any advertising or Web publishing organization," [AdForce at 1-3] and was supposed "to create, manage, target, and report advertising on the World Wide Web." AdForce at 1-1. The AdForce service included the following major components:

- Campaign Scheduling and Approval
- Ad Targeting
- Inventory Management
- Ad Delivery
- Reporting
- Auditing
- Billing

AdForce at 1-3. Notably missing from the list of "major components" is any mention of ad creation. The reason that the AdForce reference does not list creation as a major component is simple—AdForce did not actually provide any method or apparatus to automatically create advertisements, much less advertisements that were created in accordance with input presentation rules of an internet media venue. Instead, the AdForce system required advertisers to know the guidelines of each media venue they wished to publish to, manually create a

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[10] Although each piece of prior art and/or prior art combination will be addressed below, it should be noted that that the listing of limitations not taught or suggested by the prior art/ prior art combinations is not intended to be exhaustive.

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presentation for each media venue, and then upload each individual presentation to the server. Accordingly, AdForce does not provide an interface that prompts a seller to "input information to create an electronic advertisement"—instead, it prompts an advertiser to enter a completed advertisement in its finalized form for storage on the system. As a result, AdForce does not anticipate the claimed inventions of the `025 patent.

i. Independent Claims 1/179

The AdForce reference fails to disclose a computer system that processes input presentation rules, media venue selection input, and creative input to create a customized rule-complaint advertisement for each selected media venue for a seller, and therefore also fails to disclose an interface that prompts a seller to "input information to create an electronic advertisement."

Chapter 6 of AdForce discusses "Advertising." On page 6-22, AdForce describes "Creatives," which are defined in the AdForce Glossary as "advertising banners." AdForce at G-8. In the discussion of Creatives, the AdForce reference states that the AdForce server receives advertisements from Advertisers and delivers them to Web sites. AdForce at 6-22. The AdForce service "can deliver virtually any ad style, such as HTML scripts, JavaScripts, and JAVA applets, in addition to static/animated GIFS and redirects" that are uploaded by an advertiser. *Id.* However, while the "AdForce service can deliver virtually any ad style," it does not create these ads for the advertiser, and it certainly does not create advertisements "in compliance with the presentation rules of the internet media venue." *Id.* Thus, while the AdForce server is capable of receiving finalized advertisements from advertisers and forwarding advertisements to media venues, it clearly **does not create** advertisements by **processing** the information input by a seller with the presentation rules input by the selected media venues, and does not insure that an advertisement slated for delivery to a particular media venue is **customized** for the selected media venue—*i.e.,* that the advertisement actually conforms to the presentations rules of that media venue. Instead, the advertiser must itself author the advertisement (or "Creatives") and must submit the completed advertisement to the AdForce server for delivery to media venues.

AdForce does not disclose any "creation" software capable of applying media venue guidelines to advertising content entered into the system by a seller. The advertiser itself must make sure that a pre-created advertisement conforms to the presentation rules of the media venue(s) on which it will be displayed prior to uploading the document into the AdForce system.

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Furthermore, "the submitted advertisements must already have been tested, debugged, and functioning." AdForce at 6-22. AdForce warns advertisers that "[t]he [uploaded] advertisements must be entirely correct and follow AdForce Service's rich media ad guidelines, or campaign delivery can be delayed." *Id.* at 6-22 (referring advertisers to the *"Guidelines for Creating and Submitting Creatives* Tech Doc" in *"AdForce Online Help."*)

The "Agency Campaign Tree" section of the AdForce reference makes it clear that AdForce actually teaches away from a system that creates advertisements that are customized to conform to a selected media venue's presentation rules, where sellers and web publishers are "strangers" to one another. After completed advertisement(s) are uploaded into the AdForce system and labeled appropriately [as shown on page 6-76—6-80], the system can "send notifications" to the web sites the advertiser has selected as desired publishers of the advertisement(s).

> **Send Notification ... sends an e-mail with all the [advertising] campaign's characteristics to the Web site/** content unit, **including** the following information:
> - Campaign Name
> - Number of Impressions
> - Start/ End Dates, Times, and Days of the Week
> - Campaign contact person
> - Web tag contact person
> - **URL link to view banners targeted to Web site.** *Id.* at 6-91 (emphasis added).

If a web publisher who receives a "Send Notification" views the banners that will be targeted to its web site or content units, and finds that the advertisements are not to its satisfaction—or do not comply with its presentation rules—**the web publisher can decline campaign ad delivery**. *See* AdForce at 6-98 ("The Declined By functionality displays the Web publishers that have declined a campaign's ad on their content units"); *id.* at 6-99 ("A list displays showing all the Web sites/ content units that declined campaign ad delivery"). The only reason for a web publisher to decline a potential advertiser is because it dislikes the content or look and feel of an advertisement, or because the advertisement does not actually conform to the "ad size" or "ad style" characteristics requested by the web publisher. Presumably, this is at least one of the causes of the "campaign delivery [delay]" referred to on page 6-22, and discussed earlier in this Response. If a web publisher declines an advertiser's ad, it is likely the advertiser will have to re-check the web site's presentation rules and create (outside of AdForce system) another ad for

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that web site, and then upload the "new" advertisement. In contrast, the '025 system requires that every advertisement for a selected media venue conforms to all of that venue's presentation rules— the media venue need not check for an advertisement's compliance with its presentation rules because the system automatically applies the media venue's presentation rules to content input by the seller, creating a rule-compliant advertisement.

The AdForce system is not designed to <u>create customized ads that conform to individual media venue's presentation rules</u>—if it did, such "notification" and "decline" components would be superfluous, as any advertisement delivered to a media venue would automatically conform to ALL of a media venue's content and look and feel guidelines. This was the exact problem the invention of the '025 patent was designed to solve—the '025 patent described a system and method in which sellers and media venues could be complete strangers to one another, as the ability for a media venue to input presentation rules and be guaranteed delivery of presentations that automatically conformed to ALL of its guidelines removed the need for a "notification" and "approval/disapproval" step. As noted earlier, this decreases the time and effort a media venue must devote to acquiring advertising. AdForce does nothing to alleviate the extensive workload required of sellers to learn and conform their presentations to the disparate guidelines of various media venues, or for media venues to review the presentations for such conformance, which is a central aspect of claims 1 and 179.

To create an advertisement, the AdForce advertiser must first familiarize itself with the guidelines of particular media venues as described in their web site questionnaires. *See* AdForce at 8-1– 8-7. The advertiser then must manually create ads that conform to these guidelines, upload each ad into the AdForce server, and then describe its characteristics—*i.e.*, size and file format—to the server. Thus, it is the advertiser's responsibility to read, understand, and apply these guidelines when creating an ad for the AdForce system. The AdForce system does not attempt to "apply" or "process" these guidelines in any way—it simply provides them in a centralized location to facilitate access by the advertisers. There is certainly no computer hardware or software in AdForce that operates to take information input by an advertiser and, via the processing this data with the guidelines of each selected media venue, generate a plurality of presentations that each comply with the corresponding media venue guidelines of the media venues where the presentation is to be published. Yet the limitations of claims 1 and 179 clearly require such a piece of hardware or software. In fact, the approach outlined in the AdForce

reference is not substantially different than the prior art described in the `025 Background. AdForce (like most of the other references cited in this reexamination) highlights the very problem the `025 invention was created to solve—*i.e.*, that a seller had to know the individual guidelines of various media venues and then create a number of individual presentations that conform to each media venue's guidelines. Rather than meeting the limitations of claims 1 and 179, the AdForce reference only reinforces the need for such a solution.

The manner in which the advertiser-created advertisement is uploaded to the AdForce server is described in Chapters 6 and 7. *See* AdForce at 6-28—6-34. Initially, the advertiser selects an ad to be inserted into a particular media venue. This is done by selecting the "Pick File" tab, as shown on page 6-28. Once the advertiser selects the "Pick File" tab, the AdForce system displays a folder where pre-existing creatives have been previously stored by the advertiser. AdForce at 6-28—6-29. After the advertiser selects the specific advertisement for uploading, the advertiser must identify the file format ("ad style"—including JAVA Applets, HTML Scripts) of the presentation and the size ("ad size") of each presentation. *Id.* at 6-30. *See also id.* at 7-16 and 7-17 (requiring an advertiser to enter descriptions [size and style] of presentations uploaded into the system prior to distribution). In the example on page 6-30, an advertiser is shown uploading a first creative (Creative #1) with a pre-defined ad style (GIF89) and ad size (468 x 60). Clearly, the AdForce program is not creating these creatives for the advertiser. Instead, the advertiser manually creates an ad that complies with media venue guidelines[11], uploads the ad into the AdForce system, and then identifies the ad's characteristics. AdForce even notes that an ad can be entered into the AdForce service before the advertiser creates the ad, using the "No Image Yet" option. AdForce at 6-77. This option is used to serve as a placeholder until the presentation is subsequently created and uploaded by the seller. *Id.* This clearly illustrates that the AdForce system does not create presentations—instead it employs an uploading feature to place the manually created finalized presentations into the AdForce system for distribution.

The PTO cites page 6-30 as disclosing an interface prompting a seller to "input information to create an electronic advertisement,"and pages 1-1 and 6-22 as anticipating the creation of a rule-compliant advertisement by processing creative information input by the seller with presentations rules entered by a media venue. OA at 195-196. However, as discussed

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[11] This "creation" is done externally—*i.e.,* outside of the AdForce system.

above, NONE of these pages disclose or suggest software or hardware that prompts a seller for information that will be **processed** in accordance with presentation rules entered by selected media venues to **create** a **customized** electronic advertisement that complies with the selected media venue's presentation guidelines. Rather, these passages make evident that the advertising presentations must be created by the advertiser itself (outside of the AdForce system) and uploaded to the AdForce server for distribution.

Requester has argued elsewhere that the creative uploaded into the AdForce system is not the "electronic advertisement," but that:

> [T]he advertisement that is that is ultimately delivered to the user's browser is a combination of the banner, the hyperlink, and the ALT text (and the redirect, if applicable). This information entered by the seller is combined with the web tag embedded in the web site. *See AdForce* at 7-30 (showing example web tags that retrieve the image/banner, the hyperlink, and the ALT text for the advertisement). *See* Requester's Comments to the First `045 Response at 13, attached as Exhibit 1.

Although Patent Owner disputes Requester's characterization of what constitutes "an advertisement,"[12] even if the AdForce reference did disclose a system that combines a banner, a hyperlink, and ALT text and delivers the combination thereof to a media venue, this would not constitute "processing" and "creation" under the `025 patent. Merely <u>combining</u> elements does not meet the limitations of claims 1/179, as these claims require that a computer controller **processes** the information entered by a seller in accordance with the <u>presentation rules</u> entered by a selected media venue, resulting in the **creation** of a **customized, rule-compliant** electronic

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[12] According to the `025 patent, only the displayed **content** of a presentation constitutes the presentation/ electronic advertisement. The glossary of the `025 patent contains the following definitions:

Advertising
    Any presentation or effort to inform or influence target demographics or the general public. This includes all media types and methods such as but not limited to audio and visual, print, electronic, multimedia etc. `025 patent at 8:4-8.

Presentation
    Any **content** intended to inform or influence the viewers or readers of a given media venue. It may be in an advertising, public service, editorial, informational or any other format. It may be text, graphics, audio, multimedia, or a combination of any communication methods. `025 patent at 11:36-43.

Thus, according to these definitions, <u>only</u> the banner advertisement itself—not the ALT text or hyperlink—constitutes a "presentation" or "electronic advertisement." In fact, ALT text is not displayed to a user at all , unless the images of an advertisement cannot be shown on the browser he or she is using.

advertisement. The "combination" of elements described by the Requester results in the **exact same advertisement** being delivered to each and every media venue—the advertisement is not **customized** to meet the presentation rules of selected media venues. As a result, the combination of the three elements mentioned above does not necessarily result in a rule-compliant advertisement. As noted earlier, if the "banner" is not "entirely correct" or does not "follow AdForce Service's rich media ad guidelines ... campaign delivery can be delayed." AdForce at 6-22. If an advertiser uploads a non-rule-compliant banner, the combination of a hyperlink and ALT text with this banner (as described by Requester) would result in a non-rule compliant advertisement. Accordingly, even this awkward characterization of the AdForce reference—which Patent Owner disputes—does not anticipate claims 1/179.

Part of the innovation of the `025 patent is the creation of customized advertisements that complement and enhance a media venue's overall design, style, and look and feel. The AdForce reference fails to disclose any sort of "customization"—much less the creation of such customized advertisements via processing seller input in accordance with the presentation rules of selected media venues. Accordingly, the AdForce reference fails to anticipate a computer system "processing ... the electronic advertisement," creating an advertisement that is "in compliance with the presentation rules of [a selected] internet media venue." For at least that reason, Patent Owner respectfully requests the PTO to withdraw the § 102(b) rejection based on AdForce.

ii. Dependent Claims

In addition to independent claims 1/ 179, dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were also rejected by the PTO based on the AdForce reference. Patent Owner respectfully submits that these claims are patentable for the reasons outlined above, and for the additional reasons set forth below.

a. Claims 11-14/ 190-193[13]

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[13] Claims 11/ 190, 15/ 194, and 28/ 207 all directly depend on claims 6/ 185 (respectively), which directly depends on claims 1/179 (respectively). In this response, Patent Owner will read claims 11/ 190, 15/ 194, and 28/ 207—as well as dependent claims that depend on these claims—in light of claims 1/ 179 (respectively) alone, simply to clarify the analysis of the issues at hand—in doing this, Patent Owner in

As noted above, the AdForce reference does not disclose or suggest software or hardware that prompts a seller for information that will be **processed** in accordance with presentation rules entered by selected media venues to **create** a **customized** electronic advertisement that complies with the selected media venue's presentation guidelines. Instead, advertising presentations must be created by the advertiser itself (outside of the AdForce system) and uploaded to the AdForce server for distribution. Accordingly, the AdForce reference does not disclose the seller interface of claims 1/ 179 prompting the seller to "input information to create an electronic advertisement," and therefore it certainly does not prompt the seller "with a choice of advertisement types"—*i.e.,* prompt the user to select or enter information regarding the type of advertisement seller would like the system to create for the seller from the seller's input, when processed with selected media venue rules. As described above, the AdForce system requires advertisers to upload pre-created advertisements to be delivered to web sites types. Accordingly, it does not anticipate claims 11/ 190, nor claims 12-14/ 191-193, which depend on and further limit claims 11/ 190.

The PTO cites the text on page 6-22 as anticipating each and every one of these claims, as well as the graphic on page 6-30 as anticipating claims 11/190. As noted earlier, the content of page 6-22 reinforces the fact that AdForce does not create any sort of advertisements, and therefore would have no reason to "prompt" a seller for information regarding the type of advertisement the seller desires the system to create for the seller. According to page 6-22, "[t]he AdForce software is automated to receive advertisements from Advertisers and deliver them to websites. The submitted advertisements must already have been tested, debugged, and functioning." When scheduling a new "campaign," an advertiser is required to describe the banner ad it has uploaded into the system by "selecting" the "ad size and style." AdForce at 6-28—6-30. Thus the graphic on page 6-30 shows the AdForce software providing an advertiser with a list of ad style and ad size options that describe the advertisement the advertiser uploaded.[14] Since claims 11-14/ 190-193, when read in conjunction with claims 1/ 179, require the seller interface of claims 1/ 179 to prompt the seller to enter or select information regarding

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no way asserts or implies that these claims, and the claims that depend on them, do not include the limitations of claims 6/ 185..

[14] It should be noted that the AdForce reference never describes or discloses an advertiser's ability to upload a text advertisement—the "creative options" listed on page 6-31and 6-22 do not include text advertisements.

the type of advertisement seller would like the system <u>to create</u> for the seller, AdForce does not anticipate these claims.

b. Claims 15-17/ 194-196

As noted above, AdForce requires advertisers to create an advertisement outside of the AdForce system that is "tested, debugged, and functioning," and then <u>upload the completed, finalized, and functioning advertisement</u> to the AdForce server for distribution "as is." *See* AdForce at 6-22. Accordingly, the AdForce reference does not disclose the seller interface prompting the seller to "input information <u>to create</u> an electronic advertisement," and therefore it certainly does not prompt the seller "for advertising content or other components of the advertisement." The AdForce reference only allows advertisers to upload <u>entire</u> advertisements in a finalized, distribution-ready format. The AdForce system cannot—and does not—modify the uploaded advertisements in any way. It certainly does not prompt for "components" of an advertisement that will be processed in accordance with presentation rules of selected media venues "<u>to create</u> an electronic advertisement." Accordingly, it does not anticipate claims 15/ 194, nor claims 16-17/ 195-196, which depend on and further limit claims 15/ 194.

The PTO cites pages 6-22 and 6-30 as anticipating these claims. Specifically, the PTO cites the "Description" portion of the graphic on page 6-30 as anticipating the seller interface prompting the seller "for advertising content or other components of the advertisement," the "Alt Text" portion of the graphic on page 6-30 as anticipating the seller interface prompting the seller "for a text component of the advertisement," and the "GIF89" portion of the graphic on page 6-30 as anticipating the seller interface prompting the seller "for an image component of the advertisement." As noted earlier, the content of page 6-22 reinforces the fact that AdForce does not create any sort of advertisements, but requires an advertiser to <u>upload completed advertisements</u> for delivery to web sites. Accordingly, these rejections fail on this ground alone.

However, even putting this aside, the PTO's citations indicate that the PTO considers the "description," "alt text," and "ad styles" information shown in the graphic of page 6-30 to constitute "ad components"—however this is not the case. The "description" entry-space prompts a seller to "type the ad banner's <u>description</u>". AdForce at 6-32. This is information used internally by the AdForce system to describe and differentiate this particular uploaded advertisement from other advertisements that may have been uploaded by the advertiser—this descriptive information is not used or incorporated into the actual advertisement in any way. The

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"ad style" listing, as described in detail above, is not an "ad component" but a piece of descriptive information entered by the advertiser to <u>describe</u> the completed advertisement uploaded into the AdForce system. As noted previously, the AdForce system uses this descriptive information to decipher which advertisements are appropriate for certain websites— *i.e.,* AdForce matches web "tags" requesting certain ad styles to the "ad styles" descriptive information stored in the AdForce system. Finally, the "alt text" that is optionally entered by a seller is not "a component" of the ad—in fact, ALT text is not displayed to a user at all, unless an advertisement cannot be shown on the browser he or she is using. Accordingly, ALT text is essentially <u>an alternative</u> to the advertisement.

In any case, even if these items were "ad components"—which Patent Owner disputes, these components would not be used "to <u>create</u> an electronic advertisement" as required by claims 15-17/ 194-196 when read in conjunction with claims 1/ 179, as AdForce does not <u>process</u> this information in accordance with the presentation rules of selected media venues <u>to</u> <u>create</u> customized advertisements for each selected media venue, but delivers the exact same electronic advertisement to all of the media venues. Accordingly, AdForce does not anticipate these claims.

c. Claims 28-30/ 207-209, 46/ 225, 63/ 242, 91/ 270

Claims 28/ 207 require the seller interface of claims 1/ 179 to prompt the seller to "input advertising content to create a <u>text</u> advertisement." As discussed at length above, the AdForce system does not <u>create</u> advertisements, as it requires an advertiser to upload completed advertisements into the system for use "as is," and furthermore, does not appear to allow text advertisements. Accordingly, it does not anticipate claims 28/ 207, nor claims 29-30/ 208-209, 46/ 225, 63/ 242, or 91/ 270, which depend on and further limit claim 28/ 207. The PTO again cites pages 6-22 and 6-30 as anticipating such aspects of the invention. However, as described above, nothing on either of these pages discloses the creation of an advertisement—and especially not a text advertisement—from information entered by a seller.

d. Claims 36-39/ 215-218

Claims 36/ 215 require the internet media venue interface of claims 1/ 179 to prompt an internet media venue "for a choice of advertisement types" to so that the "advertisement type" entered or selected becomes a presentation rule for that internet media venue. However, the

AdForce reference fails to disclose any such interface. Accordingly, it does not anticipate claims 36/ 215, nor claims 37-39/ 216-218, which depend on and further limit claims 36/ 215.

The PTO cites the graphics on pages 7-2, 7-3, and 7-5 as anticipating a media interface that "prompts the internet media venue for a choice of advertisement types." However, these three pages are within the "Web Site Information" section of chapter 7, where "Web sites are created, modified, and viewed by SuperUsers." Accordingly, the interface shown on these pages is for SuperUsers—not individual media venues—and therefore does not anticipate these claims. Furthermore, even if the interface displayed on these pages was for use by a media venue, none of these pages display an interface that prompts a user with a choice of advertisement types.

The PTO cites the "Content Unit Fields/ Options" table on page 7-17 as further anticipating a media interface that "prompts the internet media venue for a choice of advertisement types." However, the only item related to "advertisement type" in the table (and the related graphic in the lower window of page 7-16) is the "java ready" selection box,[15] which web publishers can select "if planning on delivering rich media advertisements using the AdForce JavaScript or IFRAME tag." The "check box" is a way for a web site owner to describe the technical capabilities of its web site—not to select the "types of ads" the owner would like to display on its website.[16] One "selection box" for "Java Ready" is not equivalent to "a choice of advertisement types."

Finally, the PTO cites the "lower window of page 7-28" as anticipating a media interface that "prompts the internet media venue for a choice of advertisement types." However, there is no "window" on this page, so it is unclear exactly what the PTO was referring to. Presumably, the PTO was referring to the lower window of 7-16, as addressed above.

e. Claims 140/ 319

Claims 140/ 319 require that "the computer controller ... processes the advertisement ... to enforce compliance with the internet media presentation rules." However, as noted above (in the section addressing claims 1/ 179), the AdForce system does not "enforce compliance" with presentation rules. If it did, there would be no need to "send notifications" of advertisements

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[15] The "size" of an advertisement does not constitute a "type" of advertisement under the '025 patent. A "type" of advertisement describes the nature of the advertising format and/or technology—*e.g.*, text ad, image ad, interactive ad, *etc.*

[16] "Java" is a programming language and IFRAME is an HTML programming element—neither of these constitute "advertisement types" as described in the '025 patent.

slated for delivery to a web publisher, and a web publisher would have no reason to "decline campaign ad delivery." AdForce at 6-91, 6-98. In general, the AdForce system selects and delivers advertisements[17] based on descriptive information entered by an advertiser—accordingly, human error on the part of the advertiser could result in a non-compliant advertisement being delivered to a web publisher in response to a request for an advertisement. *See* AdForce at 6-30.

The PTO cites the text accompanying "Send Notifications" on page 6-91 as anticipating these claims, "in that 'targeted Web site' is in compliance with presentation rules." OA at 322. On its face, this sentence is highly unclear. "Targeting" is a procedure performed by the advertiser—*i.e.,* the advertiser searches for web sites that meet its needs, and not vice versa. *See* AdForce at 6-72—6-73 ("Profiles are selected by Advertisers during campaign scheduling to more effectively target specialized Web sites that best fit their targeting criteria"); *see also id.* at 6-36—6-38. Presumably, the PTO meant that any web site selected in a "targeting" procedure would have presentation rules that allow the design and contents of an advertisement for which this targeting was performed. However, this is an assumption on the part of the PTO that is not warranted and is simply incorrect. Although "notifications are customized for each targeted Web site," nowhere does the AdForce reference state or imply that (a) the advertisements themselves are customized for each targeted website, or (b) the advertisements slated for delivery to the web sites are actually in compliance with the presentation rules of the web sites. Accordingly, AdForce does not anticipate claims 140/319.

f. Claims 141/320, 148/327

As discussed in previous sections, the AdForce reference does not disclose or suggest a system that **processes** information entered by a seller in accordance with presentation rules entered by selected media venues to **create** a **customized** electronic advertisement that complies with the selected media venue's presentation guidelines. The AdForce reference does not discuss or disclose "automatically modifying or reformatting the advertisement" in any way, much less "to comply with the internet media venue presentation rules." The AdForce system delivers advertisements uploaded to the system by advertisers directly to web sites "as is." The content and "look and feel" of the advertisement remains unchanged. Accordingly, AdForce

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[17] Advertisements that were not created or modified by the system.

does not anticipate claims 141/ 320, nor claims 148/ 327, which depend on and further limit claims 141/ 320.

The PTO cites the text accompanying the "Example" on page 6-30 as anticipating this claim. However, this example has absolutely nothing to do with the modification or reformatting of an advertisement. When an advertiser selects multiple ad sizes for delivery (*i.e.*, uploads and selects advertisements of different sizes for delivery during a particular campaign), "the same number of ads must be selected for every ad size." AdForce at 6-30. This means that if an advertiser has uploaded and selected three 100x100 advertisements for display, and wants to use a 200x200 advertisement as well, the advertiser must either (a) upload and select three 200x200 advertisements or (b) select one 200x200 advertisement three times "as a work around." *Id.* The example on page 6-30 was designed to help explain this concept, and does nothing more. The example actually reinforces the fact that AdForce does not—and cannot—automatically modify or restructure an advertisement. Accordingly, AdForce does not anticipate claims 141/ 320, nor claims 148/ 327, which depend on and further limits claims 141/ 320.

iii. Conclusion

Given the marked differences between the `025 claims and the disclosures of the AdForce reference, Patent Owner respectfully requests confirmation of all claims over the AdForce reference.

2. Del Sesto patent

Independent claims 1 and 179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 102(e) as anticipated by the Del Sesto `882 patent. Del Sesto fails to disclose all of the limitations of claims 1 and 179, and thus the claimed inventions of the `025 patent are not anticipated by this reference.

The Del Sesto patent discloses a method for buying and selling television advertising (*i.e.*, commercials) over a computer network. It is, at its core, a match-making service designed to match advertisers with media venues. In contrast to the `025 patent, Del Sesto does not concern itself with the actual creation of those advertisements—it simply assumes that an advertisement (presentation) has been or will be created by the advertiser prior to the match-making. In fact, it does not even contemplate that the media venues will have any "guidelines"

in the first place. Advertisers search for advertising slots available in certain markets ("avails") based on parameters such as target demographics, desired dayparts (soap operas, prime time, *etc.*), and desired category of show or program, and make bids on certain avails offered by specific media venues. Del Sesto at 2:27-50; 6:40-54; 9:30-42. A media venue then may offer a contract to an advertiser for one or more avails. *Id.* Once an advertiser accepts a media venue's contract, the advertiser uploads its commercial to a server. *Id.* The media venue then downloads this content from the server and integrates it into its programming system for airing at the agreed times. *Id.* Accordingly, media venues have no control over the content of the commercials, and the content, size, look or feel of the commercials are not changed in any way after their initial creation by an advertiser. Furthermore, the commercials are not automatically published to selected media venues. As a result, the Del Sesto patent does not anticipate the claimed inventions of the `025 patent.

i. Independent Claims 1/179

a. Del Sesto Lacks a First Interface Prompting Media Venues to Input Presentation Rules/ First Database Storing Presentation Rules

The media venues in the Del Sesto patent have no ability to limit the content or "look or feel" of an advertisement. In fact, no "guidelines" or "presentation rules"—as these terms are defined and used in the `025 patent—are ever entered into the Del Sesto system. The only information entered by media venues is regarding the available time slots they have for displaying an advertisement, and the purchase cost of those slots. *See* Del Sesto at 8:36-38-43 (a media venue may "view and update her avail inventory" and "create and edit rate cards."). These pieces of information are not "guidelines" for formatting presentations. "Avail inventory" simply lists where and when the media venue has time and space to display an advertisement, and "rate cards" indicate the "day and time of a particular broadcast, the avail category (preemptable, preemptable with notification, or non-preemptable) and the price." Del Sesto at 8:42-55. And— since Del Sesto does not contemplate the media venues having (or being able to enter) presentation rules, it obviously does not disclose an "interface" that prompts media venues to "input presentation rules for the internet media venue for displaying advertisements on the internet media venue," nor a "database storing the presentation rules." Such elements are wholly absent from the reference.

The PTO cites Figures 5A-5R and the text at 8:32-41 as disclosing a "first interface" through which a media venue is "prompted to input presentation rules." OA at 197. Figures 5A-5R "illustrate interactive actions to be taken by a seller [*i.e.*, media venue].[18]" Del Sesto at 8:33-34. However, as noted above, the only information a "seller"/ media venue can enter or modify is (1) "avail inventory," specified by the "day(s) and showtimes of specific programs, the preemptable rate, and the number of avails existing for each week of a specified time span," (2) "avail sets," (3) "rate cards," which specify the price for avails, and (4) "make-good bids" on avail inventory. Del Sesto at 8:33-9:29; Figure 5A-5R. None of this information constitutes "presentation rules" to control the content, size, look or feel of the advertisements for display on the media venue.

The PTO cites block 200 of Figures 1 and 2 as disclosing a "database" that stores presentation rules entered by a media venue. However, since no media venue ever enters presentation rules, there clearly is no database that "stores" such rules. Block 200 of Figures 1 and 2 shows a database contained within a "media market place server" that holds "buyer records, seller records, contract records, schedules ... advertising content" and other such information. Del Sesto at 4:32-41; Figures 1, 2. In other words, this server database holds all of the information entered by both the "buyers" and the "sellers" who use the service.[19] However, it does NOT store media presentation rules, as defined by the '025 patent, as such rules are never entered by media venues. Accordingly, this element is also wholly absent from the reference.

b. **Del Sesto Fails to Disclose an Interface That Prompts a Seller for "information to create an electronic advertisement"—Del Sesto Does Not "Create" an Advertisement that Complies with Media Venue Presentation Rules**

The Del Sesto system does not create electronic advertisements. Instead, it requires sellers to upload pre-existing advertisements onto a central server. Figure 6 of Del Sesto illustrates the process for providing the media venues with an advertiser's presentation.[20] Once the "buyer" accepts the "seller's" contract, "the buyer uploads the advertising or commercial content to the

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[18] In the Del Sesto patent, sellers of products/services are referred to as "buyers," media venues are referred to as "sellers," and presentations are referred to as "commercial or advertising content."

[19] *I.e.*, the parties who want to place advertisements (those "buying" advertising space"), and the parties who have available space to display advertisements (those "selling" advertising space).

[20] In the Del Sesto patent, sellers of products/services are referred to as "buyers," media venues are referred to as "sellers," and presentations are referred to as "commercial or advertising content."

server." Del Sesto at 9:30-43. "Buyers are able to <u>upload</u> to the server the actual commercial or advertisement in digital form." *Id.* at 2:60-66. Thus, Del Sesto only discloses a system in which advertising content is created outside of the system and <u>uploaded</u> to a central server of the system—NOT the input of "information to create an electronic advertisement." Like the other references, Del Sesto does not teach creating advertisements.

The PTO cites Figure 7 and the text at 9:61-66 as disclosing a second interface prompting a seller "to input information to create an electronic advertisement," as well as a computer controller "processing" and creating an electronic advertisement. OA at 197. Figure 7 is a block diagram of a digital delivery system for transferring advertising content between buyers and sellers. In this system, Figures 709A-C are client stations that connect to the Digital Server 701 and Storage 707. Del Sesto at 9:59-67. These client stations are used by "buyers"/ advertisers to "<u>enter</u> advertising content into their systems, convert the content to digital format (such as MPEG files), and <u>upload</u> the content to the storage 707." *Id.* It is unclear whether the Examiner contends that converting content to a digital format constitutes the processing and creation of a presentation, or whether the examiner contends that "uploading" a converted advertisement to the server constitutes the processing and creation of a presentation. However, <u>neither one</u> of these activities constitutes the "creation" of an electronic advertisement in conformance with media venue presentation rules under the `025 patent, as the `025 requires that data input by the seller is <u>processed in accordance with the presentation rules of selected internet media venues to</u> <u>create</u> a <u>customized</u> presentation for each selected internet media venue.

Once an advertisement has been "entered into [the Del Sesto] system" by an advertiser, its content, size, shape, and all other features are "fixed." Claims 1/127 clearly require that a created presentation "complies with said guidelines of the media venues selected." The digital conversion described in Del Sesto is applied generically to the ad content, regardless of the media venue selected—this conversion is done simply to enable digital storage of the ad content, and not to conform to specific guidelines entered by media venues (especially since, as noted earlier, the media venues essentially have no guidelines—or at least are not allowed to enter them into the Del Sesto system). Nor does the act of "uploading" an advertisement to the server constitute "processing" or "creation" of an advertisement—an advertisement uploaded to the server is clearly "fixed" in nature, and transferring an existing file to a server clearly does not

"create" a "customized" electronic advertisement that conforms to the presentation rules of a media venue.

Furthermore, it should be noted that, although "buyers are able to upload to the server the actual commercial or advertisement in digital form, such as MPEG, AVI, JPEG, TIF, GIF, BMP, Targa, etc." and a "seller then downloads the content in conjunction with the executed contract" [Del Sesto at 2:60-64; *see also id.* at 9:60-67], this in no way states or implies that Del Sesto prompts (or even allows) media venues to input information specifying what digital file formats they want or expect, nor does it state or imply that Del Sesto prompts (or even allows) an advertisers to "select" what type of digital file should "result" from the digital conversion of its advertisement.

c. Del Sesto Does Not Disclose the Automatic Publication of an Electronic Advertisement to a Selected Media Venue

The system disclosed in the Del Sesto reference does not disclose the automatic publication of presentations to selected internet media venues. Instead, sellers "upload" their presentations "to the server," and the media venue then "downloads the content" from the server and "runs or plays the content." Del Sesto at 2:60-65; 9:37-43; Fig. 6.

For at least these reasons, Patent Owner respectfully requests that the PTO withdraw the anticipation rejection based on the Del Sesto patent. Patent Owner respectfully submits that the claims dependent on claims 1/179 are patentable for the reasons outlined above. In addition, a number of the dependent claims include limitations that merit patentability in their own right.

ii. Dependent Claims

In addition to independent claims 1/ 179, dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were also rejected by the PTO based on the Del Sesto patent. Patent Owner respectfully submits that these claims are patentable for the reasons outlined above, and for the additional reasons set forth below.

a. Claims 11-14/ 190-193

The Del Sesto patent does not disclose the seller interface of claims 1/ 179 prompting the seller "with a choice of advertisement types" that the seller would like the system to create from the seller's input, when that input is processed in accordance with the presentation rules of

selected media venue. As described above, the Del Sesto system requires advertisers to "enter advertising content into their systems, convert the content to digital format (such as MPEG files), and upload the content to the storage 707." Del Sesto at 9:59-67. Although Del Sesto does state that "buyers are able to upload to the server the actual commercial or advertisement in digital form, such as MPEG, AVI, JPEG, TIF, GIF, BMP, Targa, etc." [Del Sesto at 2:60-63], this merely implies that an advertisement can be converted into a variety of digital formats, depending on where and for what purpose the Del Sesto system is implemented (*i.e.,* as a TV commercial distribution system using AVI files, a radio commercial distribution system using MPEG files, or an internet advertising distribution system using JPEG, GIF, or TIF files, *etc. See* Del Sesto at 4:2-20). As noted above, in claims 1/ 179, this passage does not disclose "prompting" a seller with a "choice" of advertisements—it merely states a non-limiting list of digital file types to which a submitted advertisement may be converted, depending on the particular implementation of the invention. Del Sesto does not state or imply that an advertiser (or a media venue) will have any "choice" regarding the type of digital conversion performed by the system. In fact, it teaches away from any such choice. For example, Figure 7 shows an "MPEG decoder 708"—implying that ONLY MPEG files would be used in this particular implementation—*i.e.,* all advertiser files would be converted to MPEGS.

Furthermore, a different type of digital file does not necessary constitute a different "advertisement type" under the '025 patent. For example, TIF, BMP, and JPEG files are all image files. Thus, even if the Del Sesto patent did disclose prompting an advertiser with these file types—which it does not—the end result would always be an image advertisement, and therefore this hypothetical "prompt" for a file type would not constitute a "choice of advertisement types" under the '025 patent. Given that the Del Sesto system was designed to be implemented in a single advertising area (*i.e.,* TV, internet, print, or radio), it is likely the "advertisement type" would be "fixed." In other words, a TV advertisement distribution system would require video advertisements, a radio advertisement distribution system would require audio advertisements, a billboard advertisement distribution system would require image advertisements, *etc.*

The PTO cites the text at 2:66-67 as anticipating these limitations. Presumably, the PTO actually meant to refer to the text at 2:60-63, which was discussed above. It should be noted that this text reinforces the fact that the Del Sesto system does not "create" any sort of customized

advertisements—it merely "converts" a non-digital file into a digital file. Such conversion does not change the actual content or look and feel of an advertisement, as described in the `025 patent, nor does it "customize" an advertisement in accordance with the presentation rules of a selected media venue.

In sum, the Del Sesto patent does not anticipate claims 11/190, nor claims 12-14/ 191-193, which depend on and further limit claims 11/190. These claims—when read in conjunction with claims 1/ 179—require the seller interface of claims 1/ 179 to prompt the seller to enter or select information regarding the type of advertisement seller would like the system to create for the seller. The Del Sesto patent does not disclose prompting an advertiser with a choice of advertising types and—even if it did—this choice would not be used to create a rule-compliant advertisement for the advertiser.

b.   Claims 15-17/ 194-196

The Del Sesto reference does not disclose the seller interface of prompting the seller "for advertising content or other components of the advertisement." As described above, the Del Sesto system requires advertisers to "enter advertising content into their systems, convert the content to digital format (such as MPEG files), and upload the content to the storage 707." Del Sesto at 9:60-64. Accordingly, the Del Sesto patent only allows advertisers to enter entire completed advertisements into the system (i.e., finalized advertisements whose content, look and feel are "fixed"), which can then be converted (in their entirety) into a digital format and uploaded onto the Del Sesto server.

Furthermore, although the advertiser can "convert" the advertisement to digital format prior to uploading it to the server, this "conversion" does not constitute "processing" the information in accordance with media venue presentation rules to create a customized advertisement. Accordingly, the Del Sesto system does not prompt for "components" of an advertisement that will be processed in accordance with presentation rules of selected media venues "to create an electronic advertisement," and therefore it does not anticipate claims 15/ 194, nor claims 16-17 /195-196, which depend on and further limit claims 15/ 194.[21]

c.   Claims 31-47/ 210-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, and 90-91/ 267-270

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[21] The PTO cited the text at 9:61-66 and Figure 7 as anticipating these claims. The short-comings of these sections of the Del Sesto patent were discussed extensively in the section regarding claims 1/179, and therefore will not be addressed again in this section.

As noted above, no "guidelines" or "presentation rules"—as these terms are defined and used on the '025 specification—are ever entered into the Del Sesto system by media venues. The only information entered by media venues is regarding the available time slots they have for displaying an advertisement, and the purchase cost of those slots. Del Sesto at 8:33-9:29; Figure 5A-5R. Since the Del Sesto patent does not contemplate media venues having (or being able to enter) presentation rules, it obviously does not disclose an "interface" that prompts media venues to "input presentation rules for the internet media venue for displaying advertisements on the internet media venue." Accordingly, dependent claims that further limit and narrow the scope of the interface for internet media venues disclosed in claims 1/ 179, namely claims 31/ 210 ("self-serve interface that prompts each internet media venue to input its presentation rules using a menu-driven format"), 46/ 225 ("self-serve interface that prompts each internet media venue to input its presentation rules for a text advertisement using a menu-driven format"), 47/ 226 ("wherein the presentation rules of the internet media venue comprise design or style standards"), and 79/ 258 ("wherein the presentation rules of the internet media venue comprise distribution standards")—as well as the claims that depend on these claims (claims 32-45/ 211-224, 62/ 241, and 90/ 267 all depend on claims 31/ 210, claims 63/ 242 and 91/ 270 depend on claims 46/ 225, claims 50-52/ 229-231 depend on claims 47/ 226, and claims 81/ 260 depend on claims 79/ 258)—are not anticipated by the Del Sesto patent.

The PTO cites Figures 5A-5R as anticipating claims 31/ 210, 46/ 225, 47/ 226, and 79/ 258. However, as discussed above with regards to claims 1/ 179, these figures do not teach the Del Sesto system prompting media venues to enter presentation rules. As stated earlier, Figures 5A-5R "illustrate interactive actions to be taken by a seller [*i.e.*, media venue]." Del Sesto at 8:33-34. However, as noted above, the only information a "seller"/ media venue can enter or modify is (1) "avail inventory," specified by the "day(s) and showtimes of specific programs, the preemptable rate, and the number of avail existing for each week of a specified time span," (2) "avail sets," (3) "rate cards," which specify the price for avails, and (4) "make-good bids" on avail inventory. Del Sesto at 8:33-9:29; Figure 5A-5R. None of this information constitutes "presentation rules" to control the content, size, look or feel of the advertisements for display on the media venue. Accordingly, none of the these dependent claims—which relate to and further

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narrow the "first interface" of claims 1/179 through which a media venue is "prompted to input presentation rules"—are anticipated by the Del Sesto reference.

e. Claims 140/ 319, 141/ 320, 148/ 327

As discussed at length in the preceding sections, the Del Sesto reference does not disclose or suggest a system that **processes** information entered by a seller in accordance with presentation rules entered by selected media venues to **create** a **customized** electronic advertisement that complies with the selected media venue's presentation guidelines. In fact, the Del Sesto reference does not allow for the entry of any presentation rules by media venues, and therefore they are essentially non-existent, as far as the Del Sesto system is concerned.

Claims 140/ 319 require that "the computer controller ... processes the advertisement ... to enforce compliance with the internet media presentation rules." However, as noted above (in the section addressing claims 1/ 179), the Del Sesto system does not "enforce compliance" or do anything to an advertisement to make it "comply" with presentation rules of a media venue, since there are no presentation rules within the Del Sesto system. Furthermore, even after an advertisement is converted to digital format, the content and "look and feel" of the advertisement remains unchanged. Accordingly, AdForce does not anticipate claims 140/ 319 or 141/ 320, nor claims 148/ 327, which depend on and further limit claims 141/ 320.

iii. Conclusion

Given the marked differences between the '025 claims and the Del Sesto patent disclosures, Patent Owner respectfully requests confirmation of all claims over the Del Sesto patent.

3. Naqvi patent

Independent claims 1/179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 102(b) as being anticipated by the Naqvi patent. However, the Naqvi patent fails to disclose all of the limitations of claims 1 and 179. Accordingly, these claims are not anticipated by Naqvi and, as a result, neither are the dependent claims cited above.

The Naqvi system, like most of the other prior art systems, was designed to help "target" and place advertisements. It accomplished this goal by matching "focus" descriptions entered by the advertiser (and associated with a particular ad uploaded into the system by the advertiser)

with "focus" tags inserted into a webpage by that webpage's owner. In the Naqvi system, an advertiser enters information describing the "focus" or content of a pre-created ad the advertiser wishes to display, and then uploads the advertisement onto a server. Naqvi at 39:13-41:9. The server stores the advertisement and the "focus" information associated with it, along with multiple other advertisements and their "focus" descriptions, and is connected to a computer network, such as the world wide web. Naqvi at 3:8-12. Owners of webpages embed their webpages with tags that indicate the "focus" or content of the page, and/or the dimensions of a space (in a pixel x pixel format) available on the page for an advertisement. Naqvi at 31:21-31; *see also id.* at 8:14-24. When a user of the network enters a search query or requests a certain page, the Naqvi system retrieves advertisements that are related to the query topic or webpage content by matching the query topic or the focus tag of a webpage to the "focus" information associated with particular advertisements. Naqvi at 7:26-8:1 (the determination of which ads can be placed on a particular page is "based on matching the focus of a page with the focus of the ad"). After selecting the appropriate advertisements for display—based on focus matching, advertising space, and the terms of specific advertiser contracts—the system "dynamically mixes" the advertisements retrieved from the server with the content of the pages according to the layout specified by the page owner,[22] and "displays the pages with focused, targeted advertisements as a part of the page." Naqvi at 5:3-11; *see also id.* at 32:11-16.

The Naqvi system does not provide any sort of "media venue interface" for "entering presentation rules" as the page owners embed or insert "focus" and "advertisement space tags" into the webpages themselves. Furthermore, the Naqvi system—like the other prior art systems—assumes that an advertisement has been or will be created by the advertiser prior to the advertiser's use of the system. Accordingly, the system does not create an advertisement via processing information entered by the seller with presentation rules entered by a media venue—it simply utilizes a finalized pre-created advertisement supplied by the advertiser. The system requires an advertiser to upload an advertisement into the system, and then "mixes" the advertisement with the content of selected webpages. As a result, the Del Sesto patent does not anticipate the claimed inventions of the '025 patent.

i.   **Independent Claims 1/ 179**

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[22] If such a layout is actually specified by the page owner. If no tags are embedded in a webpage, the system either places the ads at the beginning or end of a webpage, or opts not to place an advertisement at all.

As noted above, the Naqvi patent fails to disclose at least two critical elements of claims 1 and 179. The patent wholly fails to disclose any sort of "interface" for media venues—especially one that prompts media venues to enter presentation rules. Nor does the Naqvi patent contemplate the use of any such "presentation rules" to "create" one or more electronic advertisements—in fact no advertisements are ever created by the system at all.

a.   Naqvi Lacks a First Interface Prompting Media Venues to Input Presentation Rules

In the Naqvi system, owners of webpages embed their webpages with tags that indicate the "focus" or content of the page, and/or the dimensions of a space (in a pixel x pixel format) available on the page for an advertisement. Naqvi at 31:21-31; *see also id.* at 8:14-24. These tags contain the information the system needs to determine what advertisements should be placed on the webpage. The Naqvi patent wholly fails to disclose a first interface that prompts one or more internet media venues to input presentation rules. The PTO cites Figure 5 and the text at 31:12-32:10 as disclosing a "first interface" through which a media venue is "prompted to input presentation rules." OA at 208. However, Figure 5 is a "flow chart of a parser." Naqvi at 31:12-13. The parser is a part of the "mixer" that dynamically selects completed advertisements from the server and mixes them with webpage content. The purpose of the parser is to "interpret the meta comments and meta tags inserted into the publishers' pages" to determine the "type" of advertisement the webpage publisher desires to be placed on the page, the size limitation of the advertisement, and the locations in which advertisements may be placed. Naqvi at 31:13-15. The parser "first searches for ... tags for focus and tags for advertisement space." *Id.* at 31:21-26. If the parser finds a focus tag, it extracts and stores the focus words; if the parser finds an advertisement tag, it extracts and stores the size value. *Id.* at 32:4-10; Fig. 5 at 64, 65. Clearly, this "parser" is a software component designed to search for, retrieve, interpret, and store information embedded in a publisher's webpage—it is not an "interface" that "prompts" any sort of human entity to input information. Although Naqvi states that advertisements "can be made to satisfy ... the constraints of the publisher of the page," this statement was taken out of context by the Requester. The "constraints" this statement refers to are the "focus tags" and "advertisement tags"—*i.e.*, optional tags inserted by the webpage publisher to indicate the desired subject matter of advertisements and the size/placement of those advertisements on the page. If such tags are embedded, the system will select and place advertisements on the page in

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accordance with these "constraints." However, web publishers do not have to insert such tags. In fact, the Naqvi system expects that two out of the three "types" of publishers who use the system will not use any embedded tags, and thus will not have any information to be picked up and interpreted by the parser.[23] In any case, neither Figure 5 nor the text cited above disclose an "interface" that prompts a media venue to "enter" any sort of information into the system.

b. Naqvi Fails to Disclose an Interface That Prompts a Seller for "information to create an electronic advertisement"

The Naqvi system does not create electronic advertisements. Instead, it requires sellers to upload pre-existing advertisements onto a central server. The system then uses the "focus" information—among other things—to determine where an uploaded advertisement should be placed. Accordingly, the seller interface prompts the seller to upload a completed advertisement—it does not prompt the seller to enter "information to create an electronic advertisement," as required by the '025 patent. The PTO cites step 114 of Figure 10 as disclosing an interface "through which a seller is prompted to input information to create an electronic advertisement." OA at 208. Figure 10 depicts the "flow" of the "ad placement process"—*i.e.*, the steps taken by an advertiser to upload a new advertisement into the system. Naqvi at 39:13-16 ("The purpose of ad placement is to allow advertisers to enter their advertisements into the system"). The system prompts the advertiser for the "focus" of the advertisement—which helps insure the advertisement is displayed on a webpage that is relevant "to what the [advertiser] has asked for"—as well as an "advertisement name ... for future reference." *Id.* at 39:17-32. The last item that the advertiser is asked to enter is the "contract" information—*e.g.*, a contract that helps the system decide when to display the ad, by specifying (1) where and with what frequency the advertisement should be displayed ("the ad will be shown in prime space no less than a certain percentage of the times a relevant query is made" or "the ad will be shown in prime space a certain number of time in a given time period"), (2) within what types of layouts the advertisement may be placed, and/ or (3) what other advertisements the advertisement may or may not be displayed in conjunction with. Naqvi at 40:25-27; *id.* at 6:14-

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[23] In the case of search engine-type publishers, the Naqvi invention "is free to reformat" the search results and select and optimal layout for the page, in which case the "output is taken from the search engine publisher ... adorned with certain relevant advertisements, and then shown to the user." Naqvi at 22:4-15; 23:11:14. In the case of "generic HTML home pages" where "no guidance is provided" and "there are no spaces on the home page for the system to place ads, the system will either insert the ads before or after the page, or the system may decide not to place any advertisement at all." Naqvi at 36:13-16.

7:6; 16:23-19:10. Once the seller has <u>uploaded</u> the advertisement onto the server and entered the aforementioned information, the system must "accept" the advertisement. Once the system accepts the advertisement, "the advertisement becomes a part of the database." *Id.* at 40:31-41:10; *see also* "update ad info database to include the new ad" of step 115, Fig. 10. Accordingly, Figure 10 describes the process whereby an advertiser <u>uploads</u> a pre-existing advertisement into the system, and enters the targeting and placement criteria for the ad—NOT the input of "information to create an electronic advertisement."

c. Naqvi Does Not Disclose the Automatic Creation of an Electronic Advertisement that Complies with Media Venue Presentation Rules

As noted above, the Naqvi system clearly does not take information entered by the seller and modify it in accordance with an internet media venue's rules to create a customized rule-compliant advertisement. Instead, it requires sellers to upload a completed advertisement to a central server for placement on webpages throughout the computer network, and then places the advertisement "as is" on a webpage. In other words, the seller must already have created an advertisement in order to use this system (or must have access to a previously created ad), and this advertisement is used when it "fits" into the "focus" category of and advertising space on a webpage. The PTO cites the language of Naqvi at 32:11-16 as disclosing the "creating" limitation found in the preamble of claims 1 and 179, and the language of the Abstract as disclosing the "processing" limitation found in the last section of the claims. Both of these citations refer to language concerning the Naqvi system's ability to "mix" or "combine" advertisements from the server with the content of a publisher's webpage, so that "the content and the advertisements are mixed on the same page." Naqvi at 32:11-16. However, "mixing" pre-existing advertisements with pre-existing webpage content is clearly not "creating" a customized "<u>electronic advertisement</u> ... in compliance with the presentation rules of the media venue." This is merely another way of describing the benefit of publishing an uploaded ad to a webpage, and has nothing to do with creating an advertisement customized for a media venue—*i.e.*, an advertisement that is in compliance with the content and "look and feel" standards of a media venue. At most, this mixing results in "the creation of a [web]page that is of interest to the user." Naqvi at 25:19-20. As a result, the Naqvi patent does not anticipate the claimed inventions of the '025 patent.

ii. Dependent Claims

In addition to independent claims 1/ 179, dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were also rejected by the PTO based on the Naqvi patent. Patent Owner respectfully submits that these claims are patentable for the reasons outlined above, and for the additional reasons set forth below.

a.   Claims 11-14/ 190-193, 15-17/ 194-196

As with the other pieces of prior art described above, the Naqvi patent does not disclose the seller interface of claims 1/ 179 prompting the seller "with a choice of advertisement types"—*i.e.,* it does not disclose prompting an advertiser to select or enter information regarding the type of advertisement seller would like the system <u>to create</u> for the seller from the seller's input when processed with selected media venue rules (as required by claims 11-14/ 190-193), nor does it disclose the seller interface of prompting the seller "for advertising content or other <u>components</u> of the advertisement" to be used by the system to create the advertisement (as required by claims 15-17/ 194-196). As discussed above with regards to claims 1/179, the Naqvi system requires advertisers to upload a completed advertisement to a central server for placement on webpages throughout the computer network, and then places the advertisement "as is" on a webpage. In other words, the seller must already have created an advertisement in order to use this system (or must have access to a previously created ad), and this advertisement is used when it "fits" into the "focus" category of and advertising space on a webpage. The advertiser is never "prompted with a choice of advertisement types," nor is an advertiser prompted to upload bare "content" or any other "component" of the advertisement—the advertiser must upload the entire, completed advertisement into the Naqvi system.

The PTO cites Figures 3A-3D, 8A-8C, and 13A-13B as anticipating claims 11-14/ 190-193, as well as the text at 42:14-19 to anticipate claims 13/192 and 14/193. The text at 42:14-19 as well as the graphics of Figures 13A-13B describe/depict what happens when a user "clicks on the advertisement." Naqvi at 48:6-8. This has nothing to do with the "type" of advertisement displayed, but relates to the "transaction" process that is initiated by clicking on an advertisement (*i.e.,* any advertisement). It does not depict or describe a seller interface "prompting" the seller with a choice of advertisement types of any sort. Figures 3A-3D are "pages views displayed to

the user" during "a yellow page query in which a user requests some item of interest and publisher is a yellow page publisher." Naqvi at 27:11-12 and 24:3-12, respectively. In this case, a "user" is neither an advertiser or publisher, but a person using the internet to find information/ web sites on a particular topic via search query. These pages do not depict any sort of "seller" interface and, furthermore, do not prompt anyone with "a choice of advertisement types." They simply show screen shots of a user making a query, and the advertisements that are displayed next to the query results (to depict ad targeting related to the query terms). Finally, Figures 8A-8C are "three screen displays" shown to a user (as this term was used above) during a "home page query." Naqvi at 36:21-37:5 and 34:11-20, respectively. It is the exact same type of query and process depicted in Figures 3A-3D, except for the fact that the query is entered via the site of a home page publisher, instead of a yellow page publisher. As before, these pages do not depict any sort of "seller" interface and, furthermore, do not prompt anyone with "a choice of advertisement types." They simply show screen shots of a user making a query, and the advertisements that are displayed next to the query results (to depict ad targeting related to the query terms). Accordingly, the Naqvi reference fails to anticipate claims 11-14/ 190-193.

The PTO cites step 114 of Figure 10 as anticipating claims 15-17/ 194-196, and additionally Figures 13A and 13B as anticipating claims 16/ 195 and 17/ 196. As described both above and below in great detail, Figure 10 describes the methodology whereby an advertiser uploads a pre-existing, <u>completed advertisement</u> into the system. Naqvi at 39:13-14. Step 114 allows an advertiser to select targeting subcategories that help the system deliver the advertisement to related and/or appropriate web sites. This information is not a "component" of the advertisement—it is information linked with the advertisement within the Naqvi system that helps the system "target" the delivery of the actual advertisement. As described above, Figures 13A-13B depict what happens when a <u>user</u> "clicks on the advertisement," and have nothing to do with a seller. Naqvi at 48:6-8. Neither Figure 10 nor Figures 13A-13B have anything to do with "prompting the seller for advertising content or other components of the advertisement," as required by claims 15-17/ 194-196. This is because the advertiser must upload a completed advertisement as a whole into the Naqvi system—it simply does not allow an advertiser to upload "components" of an advertisement, as the system does not create advertisements from uploaded material, but uses the uploaded material "as is."

b.   **Claims 31-47/ 210-226, 50-52/ 229-231, 62-63/ 241-242, and 90-91/ 267-270**

As noted above, the Naqvi patent wholly fails to disclose a first interface that prompts one or more internet media venues to input presentation rules. In fact, the Naqvi system does not provide any sort of "media venue interface" for "entering presentation rules" that will govern the creation of ads by the system customized to that media venue. The webpage owners embed or insert "focus" and/or "advertisement space tags" into their webpages that are used to pull ads from the ad server, reinforcing the very problem that the present invention was designed to solve. Accordingly, this reference cannot disclose the limitations of the dependent claims that further limit and narrow the scope of the interface for internet media venues disclosed in claims 1/ 179, namely claims 31/ 210 ("self-serve interface that prompts each internet media venue to input its presentation rules using a menu-driven format"), 46/ 225 ("self-serve interface that prompts each internet media venue to input its presentation rules for a text advertisement using a menu-driven format"), 47/ 226 ("wherein the presentation rules of the internet media venue comprise design or style standards"), and 79/ 258 ("wherein the presentation rules of the internet media venue comprise distribution standards")—as well as the claims that depend on these claims (claims 32-45/ 211-224, 62/ 241, and 90/ 267 all depend on claims 31/ 210, claims 63/ 242 and 91/ 270 depend on claims 46/ 225, and claims 50-52/ 229-231 depend on claims 47/ 226). None of these claims are anticipated by the Naqvi patent.

The PTO cites step 114 of Figure 10 as anticipating claims 31/ 210, 46/ 225, and 47/ 226. However, as discussed above with regards to claims 1/179, these portions of the Naqvi patent do not show the Naqvi system prompting media venues to enter presentation rules, i.e. rules entered by the media venue into the system that will be used by the system to create ads customized for publication to that media venue. As discussed above in claims 1/ 179, Figure 10 describes the process whereby an advertiser uploads a pre-existing advertisement into the system, and enters the targeting and placement criteria for the ad. Naqvi at 39:13-14. In step 114, "the [advertiser] is prompted to select one or more of the subcategories from the list that are relevant to the [advertiser's] ad" in order to help place the advertisement on appropriate/relevant websites. Naqvi at 40:15-17. Accordingly, Figure 10 has nothing to with a media venue interface—much less one that prompts media venues to enter presentation rules, and therefore does not anticipate any limitation related to "presentation rules" or a "media venue interface."

The PTO further cites Figure 11 as anticipating claims 47/ 226. Figure 11 depicts "the flow of a page placement process" which "is used for publishers interested in creating a home

page for use" in the Naqvi system and "permits publishers to provide a page with meta tags and meta contracts." Naqvi at 41:10-21. However, this Figure has nothing to do with controlling the "look or feel" of advertisements to be displayed on the home page. Although the page owner may "enter a list of key words [that describe] ... the content of the page" and "pick subcategories ... relevant to the content of the page" in order to facilitate the targeting of pre-created advertisements to that page (based on the subject matter of the ads/ home page), this has nothing to do with applying or comparing "internet media venue design or style standards" to "information input by the seller or the advertisement to control the look and feel of the advertisement to be displayed." This Figure depicts the selection and entrance of information that helps target the delivery of pre-created ads based on their subject matter, and nothing else.

c. Claims 141/ 320, 148/ 327

As discussed in previous sections, the Naqvi patent does not disclose or suggest a system that **processes** information entered by a seller in accordance with presentation rules entered by selected media venues to **create** a **customized** electronic advertisement that complies with the selected media venue's presentation guidelines. The Naqvi reference does not discuss or disclose "automatically modifying or reformatting the advertisement" in any way, much less "to comply with the internet media venue presentation rules." It simply "mixes" a pre-created advertisement "as is" with text from a web site. The content, size, and "look and feel" of the uploaded advertisement remain unchanged. Accordingly, Naqvi does not anticipate claims 141/ 320, nor claims 148/ 327, which depend on and further limit claims 141/ 320.

The PTO cites the text at 30:1-2—which describes the "layout rules" component of the "layout manager"—as anticipating claims 141/ 320. The layout manager essentially decides how uploaded advertisements and text from a webpage should be mixed. *See* Naqvi at 31:3-11. "The basic problem that the layout manager 10 is faced with is that [there] are a certain number of advertisements to show and there is a certain amount of user-requested data that has to be shown." Naqvi at 30:14-19. When quoted from the beginning of the sentence on page 29, the PTO's citation states that "The layout rules describe certain parameters that can be used to determine the best layout to use under a given set of situations." However, neither the layout manager nor the layout rules have anything to with modifying or reformatting an advertisement, much less in accordance with any presentation rules of a media venue entered into the system to govern the creation of customized ads.. Instead, they address the problem of how many

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advertisements (in a fixed format) can be placed on a specific web site, how many should be placed on the web site, and where the advertisements should be positioned or placed, with respected to the web site contents. Accordingly, the Naqvi patent does not anticipate claim 141/ 320, nor claims 148/ 327, which depend on and further limit claims 141/ 320.

iii.   Conclusion

Given the marked differences between the `025 claims and the Naqvi patent disclosures, Patent Owner respectfully requests confirmation of all claims over the Naqvi patent.

4. Brown `368 Patent

Independent claims 1/ 179, as well as dependent claims 47/ 226, 50-52/ 229-231, 79/ 258, 81/ 260, 140-141/ 319-320, and 148/ 327 were rejected under § 102(e) as being anticipated by the Brown `368 patent. However, the Brown patent fails to disclose all of the limitations of claims 1 and 179. Accordingly, these claims are not anticipated by Brown and, as a result, neither are the dependent claims cited above.

The Brown patent describes a system wherein a "computer mediated communications ("CMC") network[24] provides content and subscriber data to a queue builder and receives content segment playlists." In other words, the Brown patent describes the mechanism by which a "network for an interactive service"—such as the network of a particular ISP—can send data about its subscribers and about the advertisements[25] it has for display to a "queue builder," and, upon request, receive back a playlist (or "queue") of which advertisements to display to a particular subscriber, on a particular location, at a particular time, organized by the priority in which the advertisements should be displayed. Brown at 4:3-15; 3:28-44. Essentially, it assembles targeted advertisement playlists for a CMC network, based on descriptions of the advertisements the CMC network currently has for display, as well as descriptions of the network's individual subscribers and the advertisement display locations.

More specifically, the system assembles "queues" via the use of "rules" developed by "rule developers" based on the descriptions of (1) the network's subscribers, (2) the "content segments" (*i.e.,* advertisements) available for display, and (3) the locations that are available to

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[24] Hereinafter, a "computer mediated communications network" will be referred to as a "CMC network." However, the Brown specification alternately refers to this network as the "service provider" and "communications service."

[25] It should be noted that the advertisement information passed to the Brown system consists a description of the advertisement, rather than the advertisement itself. *See* Exhibit 2.

display those advertisements. This information is primarily obtained from the CMC network itself. *Id.* The chart attached hereto as Exhibit 2, provides a summary of relationships between the data types, what they describe, and who submits the description, as described in the Brown `368 specification (as well as citations to where such information is located in the Brown specification).

After the "descriptions" listed above (and described in the attached chart) have been entered into the system, "rule developers" analyze the data and develop "rules" and "relational databases" that ensure that certain "content segments" (*i.e.,* advertisements) are targeted to and slotted for display to a particular "subscriber" to the CMC network in an appropriate "content location" and at an appropriate time. A "queue builder" then uses these rules and databases to assemble queues for each of the network's subscribers, content locations, and content segments. When a specific request from an application of the CMC network is received—identifying the "current subscriber, the content location of the request, the date and time of the request, and the type of content record (*e.g.,* advertisement, movie, still picture)"—these queues are then combined into a single playlist, and delivered by the on-line queue manager to the CMC network.

i. Independent Claims 1/ 179

The Brown patent fails to disclose a number of critical elements of claims 1 and 179. First of all, the patent wholly fails to disclose a multiplicity of "media venues owned or controlled by other than the seller" as there is only one entity to which advertisement playlists are transmitted—namely, the CMC network. Furthermore, the one entity that receives these playlists is not "prompted" to put in presentation rules—in fact, it has no ability to input any such rules. Nor does the Brown patent contemplate the use of any "presentation rules" to create one or more electronic advertisements.

Furthermore, the Brown patent also fails to disclose a second interface prompting a seller to enter media venue selection information. In fact, the system simply does not provide any means for a seller to select internet media venues for display of advertisements, as there is only one entity to which advertisements can be delivered (the CMC network), and no means to select individual content locations within that network. As a result, the Brown patent also fails to disclose "publishing [electronic] advertisements to <u>one or more selected internet media venues</u>."

The Brown system also does not create—or even handle in any way—the "content segments" of advertisers, which are "pre-created" and stored on a server located within the CMC network prior to the network's use of the system. *See* Fig 2, block 420 ("on-line service data storage"). Instead, the system obtains <u>descriptions</u> of the "content segments"—as well as descriptions about the CMC network's subscribers and potential display locations ("content locations") within the network—from the CMC network itself, and then uses these descriptions to determine targeting rules and to generate queues. Accordingly, the Brown patent also fails to disclose a second interface prompting a seller to enter "information to create an electronic advertisement." Each of these elements will be discussed below in detail.

a. Brown Lacks First Interface/ Database and Input/ Storage of Presentation Rules by a Media Venue

In the system of the Brown patent, "applications" of the CMC network "request" the delivery of a "playlist" of advertisements for display at a particular location to a particular subscriber (at that point in time). Brown at 4:3-15; *see also* 16:24-48. In response, the Brown system delivers a "playlist" of advertisements to that media venue, based on a combination of stored "queues" the system has made for that particular subscriber, content location, and time frame. Brown at 14:24-28; 16:64-66; 17-30-41. The development and content of these playlists is dictated by the rules entered by "rule developers" of the system—the CMC network (which contains the locations on which the content segments will be displayed) has no control over the creation of these rules, and is certainly not "prompted" to put in "presentation rules" of its own.

The Brown patent only discloses receiving <u>requests</u> for playlists from—and transmitting playlists to—a <u>single entity</u>: the CMC network. Brown at 3:33-37 ("data is provided that uniquely identifies … content or application locations *within* the [CMC network] service where targeting requests may be generated); 4:3-7 ("applications of the communications service send requests for content segment playlists to the on-line queue manager"). Accordingly, the Brown patent lacks a multiplicity of "media venues," as required by the '025 patent. Furthermore, the CMC network operator has <u>no</u> control over what content segments a playlist for a particular content location (within the network) contains, because it cannot enter "presentation rules" for the particular content locations within the network. All the CMC network is allowed to do is "[input] data … <u>that uniquely identifies and describes content or application locations within the service</u> where targeting requests may be generated"—*i.e.*, describe a content location within the

network on which a content segment may be displayed. Brown at 3:28-38; *see also id.* at 6:29-35; 11:39-44.

Table 5 indicates that this content location identification data may include "location name—name used internally to identify the content location" and "location description—a brief description of the content location. This field may link the base entity record to addition[al] descriptive data that provide[s] genre-type descriptive data." In other words, the CMC inputs information <u>describing the location where a content segment may be placed.</u>

Based on this "content location" information, "<u>rule developers can create profiles of</u> subscribers, content segments, and <u>content locations</u>" that can be used to "target content segments to specific users [or] to content locations ... by creating a rule that defines the priority of a specific content segment for a specific subscriber, subscriber profile, content location [or] <u>content location profile</u>." Brown at 3:50-62; *see also id.* at 13:19-26, 32-35. This means that "rule developers" are the people who develop and enter rules about what type of advertisement should be delivered to a particular content location, and therefore it is the "rule developers" who decide what sorts of ads should be delivered to a specific content location. These rule developers are NOT part of the CMC network. Accordingly, the CMC network itself has no control over or input into the advertisements that will be referenced in a playlist for a particular content location within the network

The PTO cites block 40 of Figure 3 and the text at 7:2-5 as disclosing an "interface prompting a media venue to input presentation rules." OA at 209. However, block 40 shows the CMC network inputting information into the system, and the text at 7:2-5 describes "loading data into the queue from external sources ... [such as] the computer mediated communications network 40." Neither Figure 3 nor the passage describing it in any way disclose or imply that an interface is prompting <u>multiple media venues</u> to input <u>presentation rules</u>. The PTO cites block 50 of Figure 1 and Block 510 of Figure 3 as disclosing a database that stores "presentation rules" entered by "media venues." OA at 209. These figures depict the "Information Warehouse Manager" portion of the system, which receives and stores all the data received from the CMC network, advertisers, and third party data suppliers, as shown in the chart of Exhibit 2. However, nothing in these figures indicates that the information warehouse manager is storing any sort of "presentation rules."

The Brown patent fails to disclose the use of the system by more than one entity that has the ability to display advertisements, as the CMC network itself contains all the possible display locations for advertisements, and does not allow for the input of any sort of "presentation rules" by this entity. In fact, the Brown patent fails to disclose any sort of interface that prompts multiple media venues "to input presentation rules ... for displaying electronic advertisements on the media venue," and therefore also fails to disclose a database that stores this information.

b. Brown Does Not Prompt for the Input of Any Media Venue Selection Information

As described above, the CMC network inputs the majority of <u>descriptive</u> information required by the system regarding network subscribers, content segments, and content locations within the network. Although CMC network "interface" allows an operator to input <u>descriptions</u> of the network subscribers, the content segments the network has to display, and the content locations within the network where those content segments may be displayed, this interface does not "prompt" or provide for the entry of either "media venue selection" information or "information to create an electronic advertisement," as required by the `025 patent. As discussed above, the "rule developers" of the system are the people who create rules for the assembly of playlists. And, as will be discussed below, the Brown system does not create advertisements at all—instead, it requires that completed advertisements to be uploaded and stored within the CMC network prior to the CMC network's use of the system. Accordingly, there is no need—and thus no provision for—the input of information to <u>create</u> electronic advertisements.

The PTO cites block 42 of Figure 3 and Table 4 as disclosing a "second interface," and cites block 500 of Figure 4 and Table 4 as disclosing this interface prompting a seller to input internet media venue selection information as well as "information to create an electronic advertisement." OA at 209-210. The PTO cites block 50 of Figure 1 and block 510 of Figure 3 as disclosing a "second database" to store the information input via the second interface. OA at 210.

The disclosures of Block 50 of Figure 1 and Block 510 of Figure 3 were discussed above, and therefore will not be addressed again, other than to point out that they disclose an "Information Warehouse Manager" that receives and stores all the data received from the CMC network, advertisers, and third party data suppliers. The PTO's proposed "interface" disclosures will be discussed in depth, below.

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Figure 3 of the Brown patent is an "overview" diagram of the Information Warehouse Manager (shown as block 150 of Figure 1) and its interaction with various "external" parties. *See* Brown at 2:57-58. Blocks 42 and 500 show that the importer/ translator of the information warehouse manager (500) can receive information from an advertiser (42). However, as mentioned above, this information is limited to the "content segment" identification/ description data. Figure 4 is a more detailed view of the Information Warehouse Manager shown in Figure 3. Brown at 6:65-67. Blocks 42 and 500 of Figure 4 show that the importer/translator of the information warehouse manager (500) can receive information from an advertiser (42)—just as was shown in Figure 3. Nothing in either of these figures discloses a seller interface prompting a seller to input either internet media venue selection information or "information to create an electronic advertisement." Accordingly, nothing in these figures anticipates the aforementioned limitations.

Tables 4 and 5 show information that may be included in the "base information" for "content segments" and "content locations," respectively. As noted earlier, this information is supposed to "uniquely identif[y] and describe" the content segments held by the network for display, and the locations within the network which may request the display of advertisements. Brown at 3:28-38; *see also id.* at 6:29-35. Nothing in these tables resembles "media venue selection information," or "information ... to create an electronic advertisement."

In sum, nothing in the Brown patent discloses an interface that prompts a seller to input media venue selection information or information to be used in the creation of an advertisement.

c.   Brown Does Not Disclose an Apparatus or Method that Processes Input Creative Data in Accordance with Presentation Rules to Create a Fully Rule-Compliant Advertisement

The Brown system also does not create—or handle in any way—the "content segments" of advertisers, which are "pre-created" and stored on a server located within the CMC network prior to the network's use of the system. *See* Brown at Fig 2, block 420 ("on-line service data storage"). Instead, the system obtains descriptions of the "content segments"—as well as descriptions about the CMC network's subscribers and potential display locations within the network—from the CMC network itself, and then uses these descriptions to generate targeting rules and to generate queues. The system targets the placement of existing advertisements—nothing more. The system assumes that advertisements have already been submitted by

advertisers to the CMC network for display, and simply provides a target list of where, when, and to whom these advertisements should be displayed, and in what order. The system therefore does not disclose any sort of "ad creation."

The Brown patent states that the CMC network contains "an online application server [that is] connected to an online service data storage, "which holds subscriber account data, other business data, and content files (*i.e.*, content segments). This data storage is interconnected to an on-line business service system ... [that] sends information out to the Information Warehouse Manager." Brown at 6:54-59. The data located on the online service data storage (referred to as an "external data source") is "logically mapped ... to data structures of the queue builder" and then "imported" into the system by the information warehouse manager. In other words, the "content segments" must already have been transferred to (and stored on) the CMC network before the Brown system can be used. The Brown system requires the network provider to have the completed advertisement "in hand" for it to work. In fact, the specification specifically states that the information used to create rules for content segments will be "[provided] by the advertiser in conjunction with the network service to ensure that the segment is identified correctly." Brown at 11:7-12; *see also* Table 4. Table 4 gives examples of what such information might be, and includes a "segment description—a brief description of the material contained in the content segment file" as well as "segment media type—the media type (i.e. gif file, video stream, text file, application, etc) of the segments)." Clearly, the system both contemplates and requires that advertisers will have submitted/ uploaded completed advertisements to the network prior to the use of this system—otherwise neither the network provider nor the advertiser would be able to enter this information, which is critical to the "rule making" process that generates prioritized queues.

The PTO cites the text at 14:24-58, 13:28-36, and Table 8 as disclosing the "processing" of data input by the third party professional and the media venues to "create" an electronic advertisement "in compliance with media presentations rules of selected media venue." OA at 210. However, these portions of the Brown patent specification discuss (1) how the "queue generator" creates "prioritized segment queues"—*i.e.*, lists of content segments for display to subscribers and content locations—that will be exported to the on-line queue manager (and eventually send to the network provider), and (2) the mechanism by which a "rule developer" or "analyst" (both human employees) of the system establishes the priority given to a specific

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content segment ("advertisement") with respect to a specific subscriber or content location. Neither of these sections have anything to do with "ad creation." Furthermore, as discussed above, there are no presentation rules or information to "process."

d. Brown Does Not Disclose a Computer Controller that Automatically Publishes an Electronic Advertisement

As noted above, the CMC network is the entity in the Brown system that both requests and receives content segment playlists and, as a result, the Brown patent fails to disclose use of the system by multiple media venues. Accordingly, the Brown system also does not disclose any means or apparatus through which a party can select media venues on which to display and advertisement, nor does it allow any party to enter information to select a specific content location on the CMC network. Furthermore, the Brown system never manipulates the pre-existing advertisements, as they are all stored on the CMC network. Thus, the Brown patent clearly does not disclose automatically "publishing the electronic advertisement to one or more selected internet media venues," as required by claims 1 and 179.

For at least the reasons outlined above, the Brown patent fails to anticipate the limitations of claims 1 and 179, and Patent Owner therefore respectfully requests the PTO to withdraw the § 102(e) rejection based on the Brown patent. The dependent claims referenced above were also rejected by the PTO based on the Brown patent. Patent Owner respectfully submits that these claims are patentable for the reasons outlined above, and for the additional reasons set forth below.

ii. Dependent Claims

In addition to independent claims 1/ 179, dependent claims 47/ 226, 50-52/ 229-231, 79/ 258, 81/ 260, 140-141/ 319-320, and 148/ 327 were also rejected by the PTO based on the Brown patent. Patent Owner respectfully submits that these claims are patentable for the reasons outlined above, and for the additional reasons set forth below.

As noted above, Brown assembles playlists for advertisements. It does not disclose a system or method that has an interface that prompts a seller to enter information "to create" an advertisement—in fact, it does not handle in any way the "content segments"/ advertisements of advertisers, which are "pre-created" by the advertisers themselves and stored on a server located within the CMC network prior to the network's use of the system. The Brown patent also does not disclose a system or method that has an interface that prompts a seller to enter information

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"to select a media venue." And finally, the Brown patent does not allow multiple media venues to use the system, nor does it provide a "media venue interface," and therefore it does not allow for the entry of "presentation rules" by media venues to govern the creation of customized ads. In fact, the Brown patent is lacking virtually every component of claims 1/ 179. Accordingly, the Brown patent cannot anticipate any of the dependent claims based on claim 1/ 179, as each of these claims narrows a particular aspect of the limitations of claims 1/ 179. Claims 47/ 226 will be used as an example of the improper rejections of the dependent claims:

The PTO cites Table 5, block 110 of Figure 5 (the "rule editor"), and the text at 13:29-65 (which describes the rule editor 110) as anticipating the limitations of claims 47/ 226. As discussed above, Table 5 contains descriptive information that "will identify and describe the location ... in an on-line application where content segments can be targeted." Brown at 11:39-44. The rule editor 110 "provides the mechanism for <u>an analyst</u> to establish <u>the priority</u> with which a specific media segment ... is targeted to a specific target segment (subscribers, content locations, or time periods)." Brown at 13:29-36. These rules "maintain the relationship between target entities and content segments." *Id.* Again, this is directed to assembling a playlist, not creating customized ads. The rule editor 110 does not "automatically apply or compare internet media venue design or style standards to the information input by seller or the advertisement <u>to control the look and feel of the advertisement</u> to be displayed." This is because (a) there are no "design or style" standards to apply or compare, and (b) the system has no "control" over the "look and feel" of an advertisement. The system never has access to any advertisement input by an advertiser, nor does it ever "create" an advertisement for a seller. Accordingly, the Brown patent does not anticipate claims 47/ 226, or any of the claims that depend on these claims— namely claims 50-52/ 229-231.

iii. Conclusion

Given the marked differences between the `025 claims and the Brown patent disclosures, Patent Owner respectfully requests confirmation of all claims over the Brown patent.

C. Legal Standard for Obviousness Rejection by PTO

The PTO bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP §2142. For a claim to be obvious, every limitation must be disclosed in a combination of prior art. *Velander v. Garner*, 348 F.3d 1359, 1364 (Fed. Cir. 2003); *see also Abbott Labs. v. Sandoz, Inc.*, 500 F.Supp. 2d 846, 851 (N.D. Ill. 2007) ("the need to demonstrate

the presence of all claim limitations in the prior art . . . has not been obviated [by *KSR*].") Furthermore, there must be an "apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007)(emphasis added). *KSR* further requires that a fact finder's "apparent reason" analysis be "explicit." *Id.* at 1741. By imposing this "apparent reason" requirement in *KSR*, the Supreme Court reaffirmed the bedrock principle that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 127 S.Ct. at 1741. *KSR* also reaffirmed that "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious." *Id.* at 1740 (emphasis added).

Under *Graham v. John Deere Co. of Kansas City*, which was confirmed by *KSR*, the obviousness issue requires determination of the following factual inquiries: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the pertinent art. It is also necessary to conduct a factual inquiry into "secondary considerations [such] as commercial success, long felt but unsolved needs, failure of others, etc., ... to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. 1, 17-18 (1966). "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

It should be noted that, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. MPEP §2141.02(I); *In re Hirao*, 535 F.2d 67 (CCPA 1976). A prior art reference must also be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP §2141.03(VI).

D.   The Obviousness Rejections Should Be Withdrawn

1.   Global Response on Obviousness

Each of the PTO's obvious rejections fail for at least two reasons: (1) the PTO has failed to cite apparent reason to combine, and (2) the prior art does not disclose—alone or in combination—the creation of one or more electronic advertisements that comply with the

presentation rules entered by internet media venue(s) by processing the information input by the seller with the presentation rules of the media venues selected by the seller. Each of these reasons will be discussed in detail, below.

i.   PTO Has Failed to Cite Apparent Reason to Combine

Each of the PTO's obviousness rejections based on a combination of prior art references necessarily fail, as there is no "apparent reason" to combine the cited references in the manner suggested by the PTO. Neither the PTO nor Requester has cited any concrete reason that would have prompted a person of ordinary skill in the relevant field to piece together the elements contained in these references in the way claimed in the '025 patent. Requester repeatedly recites the same list of broad ephemeral "motivations" to combine the teachings of one reference with another, such as "the desirability of realizing various advantages and/or functionality" described by a particular reference. *See* Request at 40, 41, 48, 49, 50, *etc.* However, such generalized rationales do not rise to the level of an "apparent reason" to combine. Furthermore, Requester repeatedly states that such combinations "would involve merely combining and/or substituting known prior art elements to yield predictable results." *Id.* However, this glib statement overlooks the fact that the prior art references generally disclose disparate software models with different structures and purposes, and therefore are not readily interchangeable (not to mention the fact that the pieces of prior art cited—even when taken together as a whole—wholly fail to disclose entire elements of claims 1 and 179 of the '025 patent). Furthermore, as discussed in detail above and below, a system or method that processes seller and media venue input to create customized rule compliant advertisements is not a "known prior art element."

Meanwhile, the PTO either wholly fails to provide any reason to combine the references, or simply makes the blanket statement that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the computer system of [Reference 1] by using [an element disclosed in Reference 2]" to make the system of Reference 1 more flexible or efficient, or so as to allow for the capability to perform a certain function. *See, e.g.,* OA at 200, 203, 205, 207 *etc.* The idea that a seller can access a system, enter media venue selection information and enter information to be used in an advertisement—without knowing anything about the rules of the media venues to which that information may eventually be published—and then allow the system to create and publish customized rule-complaint ads on behalf of the seller with no further effort by the seller is simply not taught anywhere in the prior art. At least part of

the novelty of the `025 patent is that it provides a system which enables sellers and media venues, who may be completely unknown to each other, to access and use a system (through separate interfaces) and set the parameters that will be used to create multiple customized advertisements to be published in specific media venues.

In contrast, the above statements from Requester and the PTO disclose no facts and fail to provide a "clear articulation of the reason(s) why the claimed invention would have been obvious" as required by MPEP §2143. While the Supreme Court explained that the apparent reason for a combination could come from a variety of sources, it also stated that the "analysis should be made explicit" and "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of the obviousness." *KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *see also* MPEP §§ 2141, 2143. As neither the PTO nor Requester have identified any reason for the combinations they cited, Patent Owner respectfully requests that the obviousness rejections be withdrawn.

ii. All Prior Art Lacks a Means or Apparatus that Processes the Seller and Media Venues' input to Create Customized, Rule-Compliant Electronic Advertisements

As discussed at length in the preceding sections related to the anticipation rejections, none of the art of record discloses anything equivalent to the structures or methods disclosed in the `025 patent. None of the prior art cited by the PTO discloses a system that processes input presentation rules, media venue selection information, and creative information to create a rule-complaint advertisement for the one or more selected media venues. Accordingly, the prior art cited by the PTO also generally fails to disclose an interface that prompts a seller to "input information to create an electronic advertisement." In fact, **ALL** of the prior art systems require a seller to upload a completed, pre-created advertisement for distribution to media venues—one of the exact problems the inventions of the `025 patent were designed to solve. Because none of the art cited by Requester or the PTO discloses or teaches an apparatus or method that creates and publishes customized advertisements for the seller via processing information entered by the seller in accordance with presentation rules entered by the selected media venues, it necessarily follows that any proposed combination of those references also fails to meet this limitation of

both claims 1 and 179. For that reason alone, the `025 claims are allowable over the art of record.

With these general concepts in mind, Patent Owner will now address the specific obviousness rejections adopted by the PTO in the Office Action.

2.   MarketMatch in view of AdForce

Independent claims 1 and 179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 103(a) as obvious under the MarketMatch document in view of the AdForce reference. The PTO contends that MarketMatch discloses all of the limitations of the preamble of claims 1 and 179, as well as an apparatus or method that "processes" the information entered by a seller with presentation rules entered by selected media venues to create and publish an electronic advertisement to those selected internet media venues that is customized "in compliance with the presentation rules" of each individual venue. The PTO acknowledges, however, that MarketMatch fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules, as well as a separate interface that prompts sellers to enter media venue selection information and information to create an electronic advertisement for the seller, and a database to store this information. OA at 198-199. However, the PTO contends that AdForce discloses these missing limitations, and that it would be "obvious" to combine these references in a way that meets all of the limitations of claims 1 and 179. *Id.*

Before addressing the substance of the MarketMatch disclosure, Patent Owner respectfully notes that it is not even clear that the MarketMatch Guide qualifies as prior art. There is nothing in the MarketMatch Guide that serves as a copyright date or provides a clear indication of a publication date. Consequently, Patent Owner respectfully submits that this document cannot serve as prior art. Requester and Declarant Schulz contend that the code 3300-598 indicates that the document was published in the fifth month of 1998—*i.e.,* in May 1998—but establishing a publication date based on this ambiguous code, without any copyright date is extremely tenuous. The Declarant does not attest to having personal knowledge of the actual publishing date of the document or personal knowledge of the application of the code to the document, its meaning or its accuracy. The code may have nothing to do with a date, or even if it

did signify a date, the date could simply represent a version number and a preparation date, rather than a publication date. Neither the Declarant nor the Requester have explained the significance of the first portion of the code (the "3300"), and thus one is left to speculate about what this code represents. Given these questions and the lack of any corroboration of the Declaration, Patent Owner respectfully submits that requester has failed to carry its burden of showing that the MarketMatch Guide is prior art. For this reason alone, Patent Owner respectfully requests that the rejection based on AdKnowledge's MarketMatch Guide be withdrawn.

The MarketMatch reference is primarily concerned with selecting websites to maximize the effectiveness of a seller's advertisements, while also analyzing the results of such ad placement.[26] As noted on page 2, "there are a multitude of sources to help media planners identify the best media vehicles in which to place advertisements. *Planner* is the leader in providing the only comparable tool for Web media planning." The "Highlights" include:

Data needed to make relevant assessments:

- Syndicated research
- Demographics
- Audit data
- Psychographic profiling
- Site content reviews and quality ratings

. . .

And the power to use it:

- Pre-buy analysis
- Buy worksheet for scheduling and budgeting campaigns

. . .

- Personal, historical data on past buys
- Downloadable reports

MarketMatch at 3. Notably missing from this list is any mention of Advertisement Creation. This is because the focus of MarketMatch was *finding and identifying* the best media venues in which to place a presentation—not the creation or actual transfer and placement of the presentation. In fact, MarketMatch did not support any mechanism to automatically create an advertisement, much less one or more advertisements automatically customized to conform to

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[26] The MarketMatch *Planner* and the Campaign Manager are components of the AdKnowledge System. *See* Campaign Manager at 2. *Planner* is the "pre-buy and planning module designed to help media planners ... plan and negotiate smarter." *Id.* Campaign Manager is the "buy and trafficking module" that helps agencies "[execute] the buy, [traffic] the campaign, and [report] results." *Id.*

the guidelines of each media venue to which an advertisement is to be published. Instead, it assumed that the seller will have or create its own presentations for use with this system.

The AdForce reference was discussed extensively in Section III(B)(1), above. However, both of these references fail to disclose critical limitations of both claims 1 and 179, most notably including an apparatus or method for a computer system to create one or more electronic advertisements that comply with the presentation rules entered by internet media venue(s) by processing the information input by the seller in accordance with the presentation rules of the selected media venues. Furthermore, there is no apparent reason to combine these references. Accordingly, their combination cannot render these claims obvious.

i. The MarketMatch/AdForce Combination Fails to Meet the Limitations of Claims 1 /179

Contrary to the PTO's assertions, MarketMatch fails to disclose a means or apparatus that creates rule-complaint electronic advertisements as required by claims 1 and 179. The MarketMatch reference does not teach a method for creating presentations via the application of selected media venues' guidelines to data input by the seller. The reference only contemplates three "guidelines" with which presentations created by the seller must comply—(1) a presentation file size restriction, (2) a presentation size/dimensions restriction, and (3) an advertising technology restriction. MarketMatch at 22. However, the reference in no way applies these guidelines to information entered by a seller to create a conforming custom presentation. Instead, the reference allows a seller to essentially weed-out media venues that do not accept the type of ad technology the seller uses in its ads, and/ or ones that do not accept standard ad sizes. For example, under the section entitled "Ad sizes," the reference states that:

> Your advertising team has been complaining about all the different size banners that they need to create. To ease production costs and headaches, you want to advertise only on those sites that supports the IAB standard banner sizes. To find those sites, Click *Choose All.* MarketMatch at 15 (emphasis added).

This is followed by a graphic that displays eight "standard" presentation sizes, and allows a seller to see a list of media venues that use those presentation sizes. *Id.* However, in the end, the reference leaves it up to the seller to insure that it creates the correct size and "type" of presentation for each media venue. The MarketMatch system, therefore, does not create presentations customized in accordance with the media venue's guidelines.

The MarketMatch reference reiterates the same problem disclosed and addressed by the '025 patent in that a seller using the MarketMatch system will have to create multiple presentations to comply with the varying ad size requirements of media venues. Rather than solving this problem, the MarketMatch reference "eases" this problem by allowing a seller to limit its media venue selections to sites that support "standard" banner sizes. MarketMatch at 15. This means that a seller (or its "advertising team") who restricts its media venue selection in this manner will likely have to create fewer presentations than it would otherwise, since it now knows that there are only 8 possible presentation sizes. Of course, this doesn't take into account that media venues may have other guidelines, and therefore having a presentation of the "correct" size for a particular venue may not necessarily mean that the ad meets a media venue's other formatting guidelines. However, this reference doesn't contemplate that a media venue will have any other such guidelines and doesn't address compliance with such guidelines. The MarketMatch program does not apply a media venue's guidelines to seller information—it is a method to narrow down the selection of potential media venues to those venues that allow a specific presentation size. The MarketMatch program does not create an ad at all—it simply targets the selection of media venues to those which will find a particular size of presentation acceptable.

The PTO cites pages 2, 14, and 22 of MarketMatch as disclosing the processing and creation of customized electronic advertisements. OA at 198-199. Page 2 of MarketMatch says nothing about processing or creating advertisements. Page 14 describes a feature of the MarketMatch system, called "Planner," that allows a seller to search for sites that allow (or "support") specific types of ad technologies, such as java or shockwave, as well as sites that support SmartBanners. Like the selection screen provided for ad sizes on page 15, these selection screens merely "ease" the problem of ad creation by allowing a seller to limit its media venue selections to sites that support certain technologies. By restricting media venue choices to those that allow certain technologies, the MarketMatch system does nothing to maximize the seller's exposure. The seller simply insures that it will not have to create multiple presentations using a variety of technologies by selecting only media venues that allow presentations using the chosen technology. The MarketMatch system thus does not modify or restructure the presentation to meet the "technology" requirements of a media venue or take into account that media venues may have other guidelines, and therefore having a presentation using the "correct" technology

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for a particular venue may not necessarily mean that the ad meets a media venue's other formatting guidelines. Specifically, this system fails to apply any guidelines, standards, or rules that effect design and style (or look and feel) of each presentation and in no way creates customized presentations for selected media venues.

Indeed, page 22 of the MarketMatch reference teaches away from the creation of advertisements by applying presentation rules to seller input. On this page, the MarketMatch Guide describes and depicts an aspect of *Planner* that gives a seller a "report" that essentially lists the requirements of the media venues that the seller has decided to use to display a presentation. The reference states that "Now that you know what sites you are purchasing <u>you need to start producing the ads</u> ... select *view reports* to see how easy it is to <u>give your creative</u> and trafficking <u>colleagues all the information they need to create</u> and traffic <u>your banners.</u>" MarketMatch at 22 (emphasis added). In other words, *Planner* does <u>not</u> create a customized presentation for a seller—it merely gathers the three guidelines (file size, presentation size, and ad technology) of the selected media venues in one place so that the seller (or a third party) can create a presentation that complies with the guidelines of each media venue. Once again, this requires the seller to create a variety of presentations, which it will then have to upload into the system for distribution to the media venues, and to know what the guidelines are for each media venue. Accordingly, the MarketMatch reference not only fails to disclose a method for the automated creation of customized presentations via the application of media venue guidelines input into the system, but arguably teaches away from such a method, and therefore does not anticipate claims 1/179.

As discussed above in Section III(B)(1), AdForce also requires a seller to upload completed advertisements into the system, and fails to disclose an apparatus or method for the creation of a customized an advertisement, as well an interface that prompts a seller for "information to create an electronic advertisement." Because both the MarketMatch and the AdForce reference fail to disclose these elements, combining these two references together also does not disclose these elements and therefore would not render claim 1 obvious. For at least this reason, the obviousness rejection based on MarketMatch and AdForce should be withdrawn.

In addition to the failure to meet all of the limitations of claims 1/179, the proposed combination also fails because there is no "apparent reason" to combine these references. As noted above, neither the PTO nor Requester has cited any concrete reason to combine these

particular references. Furthermore, a person of ordinary skill in the art would not combine these systems, as there are a number of fundamental differences between the systems. In fact, it appears that the only reason to combine these conflicting approaches is based on the use of hindsight. For at least these reasons, this obviousness rejection should be withdrawn.

ii. The MarketMatch/ AdForce Combination Fails to Meet Limitations of Dependent Claims

The PTO contends that the combination of MarketMatch with AdForce discloses all of the additional limitations of claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327, and therefore renders each of these dependent claims obvious. Because this combination does not disclose all the elements of claims 1/179, it cannot render these claims obvious, as discussed previously. Moreover, even if the combination of MarketMatch with AdForce rendered claims 1/179 obvious—which Patent Owner disputes— this combination would still fail to render a number of the dependent claims obvious.

For example, the PTO rejected claims 15-17/ 194-196, 28-30/ 207-211, and 141/ 320 based on the disclosures of AdForce, stating that "[i]t would have been obvious ... to further modify the system of MarketMatch as modified by AdForce by [doing whatever was disclosed in AdForce] as disclosed by AdForce so as to [meet the above limitation]." However, as discussed above in Section (III)(B)(1)(ii), the AdForce reference fails to disclose the limitations found in claims 15-17/ 194-196 and 141/ 320. Accordingly, the combination of MarketMatch with AdForce cannot render these claims obvious.

Furthermore, the PTO rejected claims 11-14/ 190-193, 36-39/ 215-218 based on the disclosures of the MarketMatch reference. Claims 11-14/ 190-193, 36-39/ 215-218 further narrow the scope of what the seller interface and internet media venue interface of claims 1/ 179 must prompt the seller/ internet media venue with/for (namely, in the case of claims 11/ 190 and 36/ 215, a "choice of advertisement types."). However, as the PTO itself noted, MarketMatch fails to disclose an interface that prompts sellers to enter information to create an electronic advertisement, and also fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules. OA at 198-199. MarketMatch cannot anticipate any dependent claim that narrows the scope of an independent limitation that it

does not have. Accordingly, MarketMatch cannot possibly disclose the limitations of claims 11-14/ 190-193, 36-39/ 215-218.

iv. Conclusion

Given that the MarketMatch and AdForce references both fail to teach key aspects of claims 1/179, and because there is no apparent reason to combine together these disparate teachings, Patent Owner respectfully requests the PTO to withdraw the obviousness rejections based on the combination of these two references.

3. Campaign Manager in view of AdForce

Independent claims 1 and 179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 103(a) as obvious under the Campaign Manager reference in view of the AdForce reference. The PTO contends that Campaign Manager discloses all of the limitations of the preamble of claims 1 and 179, as well as an apparatus or method that "processes" the information entered by a seller with presentation rules entered by selected media venues to create and publish an "electronic advertisement" to those selected internet media venues that is "in compliance with the presentation rules" of those venues. The PTO acknowledges, however, that Campaign Manager fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules, as well as a separate interface that prompts sellers to enter media venue selection information and information to create an electronic advertisement for the seller, and a database to store this information. OA at 201-203. However, the PTO contends that AdForce discloses these missing limitations, and that it would be "obvious" to combine these references in a way that meets all of the limitations of claims 1 and 179. *Id.*

The Campaign Manager reference is primarily concerned with making "the planning, buying, trafficking and reporting steps [of the AdKnowledge System] link up logically and without duplication. Campaign Manager at 2. The capabilities of Campaign Manager, when used in conjunction with other components of the AdKnowledge System, include:

- Buy Worksheet Management
- Insertion Order Management
- Trafficking
- Creative Testing & Post-buy Analysis to Maximize ROI

Campaign Manager at 3. Notably missing from this list is any mention of Advertisement Creation. This is because the AdKnowledge System (as described above in the MarketMatch Planner section) does not create advertisements. The focus of the system is the placement of advertisement campaigns—accordingly, it assumes that the seller will have or create its own presentations for use with this system, upload them for use, and then deliver them "as is." *See* Campaign Manager at 3 ("Easily upload creatives and group them in a variety of ways.").

The AdForce reference was discussed extensively in Section III(B)(1), above. However, both of these references fail to disclose critical limitations of both claims 1 and 179, most notably including an apparatus or method for a computer system to create one or more electronic advertisements customized to comply with the presentation rules entered by internet media venue(s) by processing the information input by the seller with the presentation rules of the media venues selected by the seller. Furthermore, there is no apparent reason to combine these references. Accordingly, their combination cannot render these claims obvious

i. The Campaign Manager/ AdForce Combination Fails to Meet the Limitations of Claims 1 /179

Contrary to the PTO's assertions, MarketMatch fails to disclose a means or apparatus that creates rule-complaint electronic advertisements as required by claims 1 and 179. The MarketMatch reference does not teach a method for creating presentations via the application of selected media venues' guidelines to data input by the seller. The PTO cites pages 2, 3, and 16 as disclosing the "processing" of information entered by sellers and media venues to create customized electronic advertisements that conform with the presentation rules of selected media venues. However, nothing on any of these pages discloses—or even mentions—the creation of advertisements. In fact, page 3 explicitly states that creatives must be "uploaded." Page 15 shows a "Manage Creatives" page for "uploading the creatives," and states that an advertiser should "simply find the files and click to have them appear here." The image on page 15 tells users to "add creative" by "upload[ing] image or zip." Clearly, this system does not create advertisements but, like the other prior art systems, requires a seller to upload a finalized advertisement for use "as is." Accordingly, the Campaign Manager reference not only fails to disclose a method for the automated creation of presentations via the application of media venue guidelines, but arguably teaches away from such a method, and therefore does not anticipate claims 1/ 179.

As discussed above in Section III(B)(1), AdForce also requires a seller to upload completed advertisements into the system, and fails to disclose an apparatus or method for the creation of a customized advertisement, as well an interface that prompts a seller for "information to create an electronic advertisement." Because both the Campaign Manager and the AdForce reference fail to disclose these elements, combining these two references together also does not disclose these elements and therefore would not render claim 1 obvious. .

In addition to the failure to meet all of the limitations of claims 1/ 179, the proposed combination also fails because there is no "apparent reason" to combine these references. As noted above, neither the PTO nor Requester has cited any concrete reason to combine these particular references. For at least these reason, the obviousness rejection based on Campaign Manager and AdForce should be withdrawn

ii. The Campaign Manager / AdForce Combination Fails to Meet Limitations of Dependent Claims

The PTO contends that the combination of Campaign Manager with AdForce discloses all of the additional limitations of claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327, and therefore renders each of these dependent claims obvious. Because this combination does not disclose all the elements of claims 1/179, it cannot render these claims obvious, as discussed previously. Moreover, even if the combination of Campaign Manager with AdForce rendered claims 1/179 obvious—which Patent Owner disputes—this combination would still fail to render a number of the dependent claims obvious.

For example, the PTO rejected claims 15-17/ 194-196 and 141/ 320 based on the disclosures of AdForce, stating that "[i]t would have been obvious ... to further modify the system of Campaign Manager as modified by AdForce by [doing whatever was disclosed in AdForce] as disclosed by AdForce so as to [meet the above limitation]." However, as discussed above in Section (III)(B)(1)(ii), the AdForce reference fails to disclose the limitations found in claims 15-17/ 194-196 and 141/ 320. Accordingly, the combination of Campaign Manager with AdForce cannot render these claims obvious.

Furthermore, the PTO rejected claims 11-14/ 190-193, 36-39/215-218 based on the disclosures of the Campaign Manager reference. Claims 11-14/ 190-193, 36-39/ 215-218 further

narrow the scope of what the seller interface and internet media venue interface of claims 1/ 179 must prompt the seller/ internet media venue with/for (namely, in the case of claims 11/ 190 and 36/215, a "choice of advertisement types"). However, as the PTO itself noted, <u>Campaign Manager fails to disclose an interface that prompts sellers to enter information to create an electronic advertisement, and also fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules.</u> OA at 202. Campaign Manager cannot anticipate any dependent claim that narrows the scope of an independent limitation that it does not have. Accordingly, Campaign Manager cannot possibly disclose the limitations of claims 11-14/ 190-193, 36-39/215-218.

iii. Conclusion

Given that the Campaign Manager and AdForce references both fail to teach key aspects of claims 1/179, and because there is no apparent reason to combine together these disparate teachings, Patent Owner respectfully requests the PTO to withdraw the obviousness rejections based on the combination of these two references.

4. MarketMatch in view of Naqvi

Independent claims 1/179, as well as dependent claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 103(a) as obvious under the MarketMatch reference in view of the Naqvi patent. The PTO contends that MarketMatch discloses all of the limitations of the preamble of claims 1 and 179, as well as an apparatus or method that "processes" the information entered by a seller with presentation rules entered by selected media venues to create and publish an "electronic advertisement" to those selected internet media venues that is "in compliance with the presentation rules" of those venues. The PTO acknowledges, however, that MarketMatch fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules, as well as a separate interface that prompts sellers to enter media venue selection information and information to create an electronic advertisement for the seller, and a database to store this information. OA at 203-205. However, the PTO contends that Naqvi discloses these missing limitations, and that it would be "obvious" to combine these references in a way that meets all of the limitations of claims 1 and 179. *Id.*

MarketMatch and Naqvi were discussed extensively above at Sections III(D)(2) and III(B)(3), respectively. Both of these references fail to disclose critical limitations of both claims 1 and 179, most notably including the creation of customized rule-compliant advertisements by processing the input of a seller in accordance with the presentation rules of each selected media venue. Furthermore, there is no "apparent reason" to combine these references. Neither the PTO nor Requester has cited any reason to do so. A person of ordinary skill in the art would not combine these references unless influenced to do so by hindsight. Accordingly, the combination of these references cannot render these claims obvious, and Patent Owner therefore respectfully requests that the PTO withdraw the obviousness rejections based on this combination.

The PTO further contends that the combination of MarketMatch with Naqvi discloses all of the additional limitations of claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327, and therefore renders each of these dependent claims obvious. Because this combination does not disclose all the elements of claims 1/179, it cannot render these claims obvious, as discussed previously. Moreover, even if the combination of MarketMatch with Naqvi rendered claims 1/ 179 obvious—which Patent Owner disputes—this combination would still fail to render a number of the dependent claims obvious.

For example, the PTO rejected claims 15-17/ 194-196, 28-30/ 207-211, and 141/ 320 based on the disclosures of AdForce, stating that "[i]t would have been obvious ... to further modify the system of MarketMatch as modified by Naqvi by [doing whatever was disclosed in Naqvi] as disclosed by Naqvi so as to [meet the above limitation]." However, as discussed above in Section (III)(B)(3)(ii), the Naqvi reference fails to disclose the limitations found in claims 15-17/ 194-196 and 141/ 320. Accordingly, the combination of MarketMatch with Naqvi cannot render these claims obvious.

Furthermore, the PTO rejected claims 11-14/ 190-193, 36-39/ 215-218 based on the disclosures of the MarketMatch reference. Claims 11-14/ 190-193, 36-39/ 215-218 further narrow the scope of what the seller interface and internet media venue interface of claims 1/ 179 must prompt the seller/ internet media venue with/for (namely, in the case of claims 11/ 190 and 36/ 215, a "choice of advertisement types."). However, as the PTO itself noted, MarketMatch fails to disclose an interface that prompts sellers to enter information to create an electronic advertisement, and also fails to disclose an interface that prompts media venues to enter media

venue presentation rules and a database to store these rules. OA at 204. MarketMatch cannot anticipate any dependent claim that narrows the scope of an independent limitation that it does not have. Accordingly, MarketMatch cannot possibly disclose the limitations of claims 11-14/ 190-193, 36-39/ 215-218.

5. Campaign Manager in view of Naqvi

Independent claims 1/ 179, as well as 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327 were rejected under § 103(a) as obvious under the Campaign Manager reference in view of the Naqvi patent. The PTO contends that Campaign Manager discloses all of the limitations of the preamble of claims 1 and 179, as well as an apparatus or method that "processes" the information entered by a seller with presentation rules entered by selected media venues to create and publish an "electronic advertisement" customized to those selected internet media venues that is "in compliance with the presentation rules" of those venues. The PTO acknowledges, however, that Campaign Manager fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules, as well as a separate interface that prompts sellers to enter media venue selection information and information to create an electronic advertisement for the seller, and a database to store this information. OA at 205-207. However, the PTO contends that Naqvi discloses these missing limitations, and that it would be "obvious" to combine these references in a way that meets all of the limitations of claims 1 and 179. *Id.*

Campaign Manager and Naqvi were discussed extensively above at Sections III(D)(2) and III(B)(3), respectively. Both of these references fail to disclose critical limitations of both claims 1 and 179, most notably including the creation of customized rule-compliant advertisements by processing the input of a seller in accordance with the presentation rules input into the system by each of the selected media venues. Furthermore, there is no "apparent reason" to combine these references. Neither the PTO nor Requester has cited any reason to do so. A person of ordinary skill in the art would not combine these references unless influenced to do so by hindsight. Accordingly, the combination of these references cannot render these claims obvious, and Patent Owner therefore respectfully requests that the PTO withdraw the obviousness rejections based on this combination.

The PTO further contends that the combination of Campaign Manager with Naqvi discloses all of the additional limitations of claims 6-7/ 185-186, 11-17/ 190-196, 20/ 199, 23-24/ 202-203, 28-32/ 207-211, 36-39/ 215-218, 45-47/ 224-226, 50-52/ 229-231, 62-63/ 241-242, 79/ 258, 81/ 260, 90-91/ 269-270, 140-141/ 319-320, and 148/ 327, and therefore renders each of these dependent claims obvious. Because this combination does not disclose all the elements of claims 1/179, it cannot render these claims obvious, as discussed previously. Moreover, even if the combination of Campaign Manager with Naqvi rendered claims 1/ 179 obvious—which Patent Owner disputes—this combination would still fail to render a number of the dependent claims obvious.

For example, the PTO rejected claims 15-17/ 194-196 and 141/ 320 based on the disclosures of Naqvi, stating that "[i]t would have been obvious ... to further modify the system of Campaign Manager as modified by Naqvi by [doing whatever was disclosed in Naqvi] as disclosed by AdForce so as to [meet the above limitation]." However, as discussed above in Section (III)(B)(3)(ii), the Naqvi reference fails to disclose the limitations found in claims 15-17/ 194-196 and 141/ 320. Accordingly, the combination of Campaign Manager with Naqvi cannot render these claims obvious.

Furthermore, the PTO rejected claims 11-14/ 190-193, 36-39/ 215-218 based on the disclosures of the Campaign Manager reference. Claims 11-14/ 190-193, 36-39/215-218 further narrow the scope of what the seller interface and internet media venue interface of claims 1/179 must prompt the seller/ internet media venue with/for (namely, in the case of claims 11/190 and 36/215, a "choice of advertisement types."). However, as the PTO itself noted, Campaign Manager fails to disclose an interface that prompts sellers to enter information to create an electronic advertisement, and also fails to disclose an interface that prompts media venues to enter media venue presentation rules and a database to store these rules. OA at 206. Campaign Manager cannot anticipate any dependent claim that narrows the scope of an independent limitation that it does not have. Accordingly, Campaign Manager cannot possibly disclose the limitations of claims 11-14/ 190-193, 36-39/ 215-218.

CONCLUSION

For the reasons set forth above, Patent Owner Function Media respectfully requests the PTO to withdraw its rejections to claims in the office action of the `025 patent and to confirm the patentability of all claims.

Respectfully submitted,

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