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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,946	02/16/2006	5960411		6878

25096 7590 10/09/2007

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/09/2007

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



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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,946.

PATENT NO. 5960411.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Office Action in Ex Parte Reexamination	Control No. 90/007,946	Patent Under Reexamination 5960411	
	Examiner Matthew C. Graham	Art Unit 3993	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a Responsive to the communication(s) filed on _____. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08. | 4. <input type="checkbox"/> _____. |

Part II SUMMARY OF ACTION

- 1a. Claims 1-26 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims 6-10 are patentable and/or confirmed.
4. Claims 1-5 and 11-26 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____.
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

FIRST ACTION

1. No Patent Owner statement has been filed in this proceeding.
2. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 5,819,034 by Joseph et al. (Joseph).

Joseph shows a method of placing an order for an item comprising: under control of a client system 22, displaying information identifying the item (see col. 8, lines 34-43); and in response to only a single action being performed (simply pressing a button as noted in col. 8, line 64), sending a request to order the item along with an identifier of a purchaser of the item to a server system; under control of a single-action ordering component of the server system, receiving the request; retrieving additional information previously stored for the purchaser identified by the identifier in the received request; and generating an order to purchase the requested item for the purchaser identified by

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the identifier in the received request using the retrieved additional information; and fulfilling the generated order to complete purchase of the item (see col. 8, line 52- col. 9, line 2). The use of an identifier is inherent in Joseph in that an identifier is required for the device to work. The client computer would not know which information to retrieve from the permanent memory or who to charge or send the item to unless an identifier was transmitted when the order was placed from the user's interactive TV.

Joseph does not positively recite a **shopping cart model**. The claim recites **whereby** the item is ordered **without using** a shopping cart model. However, a **shopping cart model** is not a previously recited element in the claim. It is also noted that the recitation within a "whereby" clause is considered to be optional and is not necessarily claimed subject matter. See MPEP 2111.04. Claim 1 therefore does not positively recite a shopping cart model. Further, the shopping cart model is recited as a negative limitation and a negative limitation is used as a way to define over the prior art by excluding an element. See MPEP 2173.05(i). Thus, claim 1 excludes a **shopping cart model**. Thus because claim 1 excludes a shopping cart model, the prior art need not show or disclose a **shopping cart model** to anticipate claim 1.

Regarding claim 3, pressing a button as mentioned above is "clicking" a button on a remoter control (see column 8, line 64).

Regarding claim 5, Joseph does not require that a user explicitly identify themselves when using the single action ordering system. Note col. 8, lines 52-60.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of Fan, US Patent 5,926,168.

The claimed invention differs from Joseph only in using a voice command instead of a button to place an order.

Fan teaches a wide variety of pointing devices for interacting with a computer or interactive TV. These include a television remote 1000 (see Fig. 11b) and a voice activated control. Note column 26, line 57 – column 27, line 27. It would have been obvious to one of ordinary skill in the art to have substituted the remote control as disclosed in Joseph with a voice activation as taught by Fan so as to provide users with a variety of ways to interact with the interactive TV and because Fan teaches the equivalent use of both a remote control and voice activation.. See column 27, lines 18-19.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of US Patent 5,729,594 to Klingman.

The claimed invention differs from Joseph only in the displaying of information indicating a single action for ordering. Note that in the system of Joseph a user 80 may operate a local computer 40; see col. 7, lines 52-54.

Klingman shows method for ordering an item using a client system as noted in column 13, lines 36-38, the method comprising: displaying information identifying the item and displaying an indication of a single action that is to be performed to order the

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identified item (see column 19, lines 15-34 and column 7, lines 10-24). The system of Klingman displays the item via product description 132 as shown in Figure 9. The product may be purchased by clicking on a single action button "BUY" 128. Klingman further shows that in response to only the indicated single action being performed (clicking on the "BUY" button), sending to a server system a request to order the identified item whereby the item is ordered and the order is fulfilled to complete a purchase of the item as shown in Figure 10. Upon actuating the "BUY" option, a request is sent to the server and the desired product is downloaded to complete the transaction.

It would have been obvious to one of ordinary skill in the art to have displayed the single action ordering component on the computer 40 in Joseph in view of the teaching of Klingman so as to provide for the same single action ordering on a computer as is taught for an interactive TV in Joseph.

7. Claims 11, 12, 13, 14, 15, 16, 17, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Klingman.

Regarding claim 11, Klingman shows method for ordering an item using a client system as noted in column 13, lines 36-38, the method comprising: displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item (see column 19, lines 15-34 and column 7, lines 10-24). The system of Klingman displays the item via product description 132 as shown in Figure 9. The product may be purchased by clicking on a single action button "BUY" 128. Klingman further shows that in response to only the indicated single action

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being performed (clicking on the "BUY" button), sending to a server system a request to order the identified item whereby the item is ordered and the order is fulfilled to complete a purchase of the item as shown in Figure 10. Upon actuating the "BUY" option, a request is sent to the server and the desired product is downloaded to complete the transaction.

Klingman does not show a **shopping cart model** "whereby" the item is ordered independently of a shopping cart model. A **shopping cart model** is not a recited element in the claim. The claims calls for the limitation of "independently of a shopping cart model", which means that the method is not dependent on a **shopping cart model**. It is also noted that the recitation within a "whereby" clause is considered to be optional and is not necessarily claimed subject matter. See MPEP 2111.04. As such, claim 11 does not positively recite a shopping cart model. The shopping cart model is recited as a negative limitation and a negative limitation is used as a way to define over the prior art by excluding an element. See MPEP 2173.05(i). Thus, claim 11 excludes a **shopping cart model**. Therefore, the prior art need not show or disclose a **shopping cart model** to anticipate claim 11.

Regarding claim 12, the use of an identifier is inherent in Klingman in that an identifier is required for the device to work. The client computer would not know who to charge or to transmit the item unless an identifier is sent from the user's computer. The identifier could be the TCP/IP address of the user's computer or the inherent caller ID associated with the 900 number (see column 10, lines 62-63).

Regarding claim 13, the use of the identifier identifying the client system is inherent in Klingman. As discussed above regarding claim 12, the identifier is sent from the user's computer. Klingman's system operates in the same manner disclosed in US 5,729,594. A product description 132 is sent to the user's computer from the server system along with an option to "BUY" at 128. See Figure 9. If the "BUY" button is activated (clicked on) then the identification information is transmitted so that the user will receive the product described. Thus, the identifier identifies the client system and the server system provides the identifier to the client system to the broad degree recited in claim 13.

Regarding claim 14, Klingman shows the use of the Internet—see Figure 4 and column 8, lines 50-58.

Regarding claim 15, Klingman shows an HTML document—see Figure 11 and column 18, lines 41-48.

Regarding claim 16, Klingman shows a confirmation as noted in column 17, lines 63-67. The presentation of an order form is considered to be a confirmation.

Regarding claim 17, Figure 10 of Klingman shows the use of a mouse button. Also see column 17, lines 43- 51.

Regarding claim 21, a mouse is a pointing device.

Regarding claim 22, the "BUY" button is a displayed indication—see Figure 9.

8. Claims 11, 14, 15, 16, 17, 21, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by the Newsweek article "The End of Money" by Steven Levy, October 30, 1995, pp 62-65 (Levy).

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Levy shows method for ordering an item using a client system (a computer and a Web site, see the first paragraph of page 62), the method comprising: displaying information identifying the item (for example, an article on Sandra Bullock) and displaying an indication of a single action that is to be performed to order the identified item by clicking on a button. Levy further shows that in response to only the indicated single action being performed (clicking on a button), sending to a server system a request to order the identified item whereby the item is ordered and the order is fulfilled to complete a purchase of the item. Upon clicking on the button, the file is downloaded to complete the transaction and an amount is deducted from the user's account. Also note the second paragraph of page 62 in which this system is implemented under the name of DigiCash by the Mark Twain Bank of St. Louis, Missouri.

Levy does not discuss a **shopping cart model** "whereby" the item is ordered independently of a shopping cart model. However, a **shopping cart model** is not a recited element in the claim. The claim limitation independent means "not" dependent. Thus, the ordering of the item is "not dependent" on a **shopping cart model**. It is also noted that the recitation within a "whereby" clause is considered to be optional and is not necessarily claimed subject matter. See MPEP 2111.04. Claim 11 does not positively recite a shopping cart model. The shopping cart model is recited as a negative limitation and a negative limitation is used as a way to define over the prior art by excluding an element. See MPEP 2173.05(i). Thus, claim 11 excludes a **shopping cart model**. Therefore, the prior art need not show or disclose a **shopping cart model** to anticipate claim 11.

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Regarding claim 14, a Web page as discussed in Levy is part of the Internet.

Regarding claim 15, a Web page is also an HTML document.

Regarding claim 16, the deduction of a cash amount as discussed by Levy is a confirmation of an order.

Regarding claims 17 and 21, clicking on button on a Web page on a computer is accomplished by using a mouse, which is a pointing device.

Regarding claim 22, clicking on a button on a Web page is a single action of selecting a displayed indication.

Regarding claim 25, Levy discusses the displaying of the amount left over in the bank, which is payment information as recited in claim 25.

9. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Klingman or Levy in view of Fan.

Note the previous discussions of Klingman and Levy above. Regarding claims 18, 19 and 20, the claimed invention differs only in the type of pointing device to actuate the on screen-displayed button. Fan teaches a wide variety of pointing devices for interacting with a computer or interactive TV. These include a television remote 1000 (see Fig. 11b) and a voice activated control. Note column 26, line 57 – column 27, line 27. It would have been obvious to one of ordinary skill in the art to have substituted the pointing device in either Klingman or Levy with a television remote (claim 18), which is a keypad with keys (claim 19), or a voice activation (sound as in claim 20) as a mere substitute of known equivalents as taught by Fan so as to provide users a variety of

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ways to interact with a computer screen and allow handicapped users to operate a computer. See column 27, lines 18-19 in Fan.

10. Claims 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy in view of Bezos, US Patent 5,715,399 (Bezos '399).

Regarding claim 23, the claimed invention differs from Levy only in displaying partial information supplied by the server system as to the identity of the user. Bezos '399 shows a system for online ordering that displays an identity of the user (58) as part of the transaction as shown in Figure 2. See column 6, lines 28-40. The display in Bezos '399 is sent via a separate email during the transaction. Claim 23 does not recite that displaying this information as being coincident with the single action ordering. Therefore, a subsequent display as to the identity of a user is within the scope of claim 23. As to claim 24, Bezos '399 shows the shipping information within the display. Bezos '399 shows the full shipping information and includes the street address and the city, state and zip code. Each of these elements is part of the full shipping address. The claim does not recite that ONLY the partial shipping information is displayed. As such, by disclosing all the elements that comprise the full shipping information, Bezos also discloses the partial shipping information, which meets the claim limitations. Regarding claim 26, a moniker is personal name or a nickname. Bezos '399 shows displaying the name of the customer in the shipping address. A person's name is a personal name. Therefore Bezos '399 shows a moniker within the broad meaning of the term.

It would have been obvious to one of ordinary skill in the art to have used a display including the name and address of the user in the system of Levy in view of the

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teaching of Bezos' 399 so as to provide confirmation of the order as is taught by Bezos '399.

The above prior art rejection is based upon "old art", i.e. prior art references cited in the record of the prior examination of the patent. During the previous examination of the patent, the examiner did not rely upon this "old art" (Bezos '399) to reject any claim, and the relevance of this reference to the patentability of the claims was not discussed. Therefore, rejections based on this "old art" is proper in this reexamination proceeding. See MPEP 2258.01, item "(B)", section "(1)".

11. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klingman in view of Bezos '399.

Regarding claim 23, the claimed invention differs from Klingman only in displaying partial information supplied by the server system as to the identity of the user. Bezos '399 shows a system for online ordering that displays an identity of the user (58) as part of the transaction as shown in Figure 2. See column 6, lines 28-40. The display in Bezos '399 is sent via a separate email during the transaction. Claim 23 does not recite that displaying this information as being coincident with the single action ordering. Therefore, a subsequent display as to the identity of a user is within the scope of claim 23. As to claim 24, Bezos '399 shows the shipping information within the display. Bezos '399 shows the full shipping information and includes the street address and the city, state and zip code. Each of these elements is part of the full shipping address. The claim does not recite that ONLY the partial shipping information is displayed. As such, by disclosing all the elements that comprise the full shipping

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information, Bezos also discloses the partial shipping information, which meets the claim limitations. As to claim 25, Bezos '399 also shows payment information relating to the user's credit cards. Regarding claim 26, a moniker is personal name or a nickname. Bezos '399 shows displaying the name of the customer in the shipping address. A person's name is a personal name. Therefore Bezos '399 shows a moniker within the broad meaning of the term.

It would have been obvious to one of ordinary skill in the art to have used a display including the name, address and payment information of the user in the system of Klingman in view of the teaching of Bezos' 399 so as to provide confirmation of the order as is taught by Bezos '399.

The above prior art rejection is based upon "old art", i.e. prior art references cited in the record of the prior examination of the patent. During the previous examination of the patent, the examiner did not rely upon this "old art" (Bezos '399) to reject any claim, and the relevance of this reference to the patentability of the claims was not discussed. Therefore, rejections based on this "old art" is proper in this reexamination proceeding. See MPEP 2258.01, item "(B)", section "(1)".

12. **STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

The prior art fails to show or suggest the single action ordering system that includes a shopping cart ordering component as recited in claims 6 and 9. Klingman and all of the publications cited in the request relate to one form or another of a

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DigiCash system, also called E-cash, Cybercash, Cybercoin, etc. In such DigiCash systems, a user has access to an amount of "electronic cash" available to purchase items electronically via phone lines or via the Internet. The purchaser may click on an item to buy, an amount of electronic cash is subtracted from the users account and then the item may be sent to the user, for example via an electronic connection in the case the item is software or some other downloadable product. None of these DigiCash or electronic cash systems or the prior art contemplates or suggests a single action ordering system or component that includes a shopping cart ordering component. Likewise, Joseph fails to show or suggest a shopping cart model. The interactive TV transactions in Joseph relate to only single purchase transactions. There is no need for a shopping cart model that allows for purchasing multiple items with one transaction. Claims 7-8 are considered to be patentable due to their dependency on claim 6. Claim 10 is considered to be patentable due to its dependency on claim 9.

The Patent Owner is also advised that claims 1 and 11 would be considered to be patentable if they were amended to recite providing a shopping cart model that in response to performance of an add-to-shopping-cart action, sends a request to the server system to add the item to a shopping cart within the main body of each claim and change the subsequent recitation of "a shopping cart model" to the shopping cart model.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by

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the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

13. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,960,411 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

14. Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

15. Any inquiry concerning this communication should be directed to Matthew C. Graham at telephone number 571-272-7116.

Please mail any communications to:

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Application/Control Number: 90/007,946

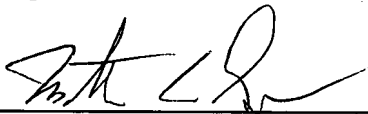
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Customer Service Window
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Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:



Matthew C. Graham
CRU Examiner
3993
(571) 272-7116

Conferees

