

# BEST AVAILABLE COPY

## REMARKS

Reconsideration of the application in light of the following remarks is respectfully requested.

Applicants acknowledge the courtesy and effort extended their attorney, Richard J. Katz, during a telephone interview conducted on September 22, 2004. The distinctions of the pending claims over the Sharp patent were discussed. The Examiner indicated that the arguments presented appeared to overcome Sharp, but reserved judgment until the filing of an official response.

During the telephone interview the Examiner questioned whether the present claims were doing more than just automating a known method of conducting business. Although not an official rejection, Applicant makes the following comments addressing the Examiner's question with the expectation of foreclosing such a rejection from being made in the future. The Examiner stated that it is a known business method for a customer to request quotes from multiple vendors, and then select a vendor based on the quote most suitable to the customer.

Although the claimed inventions do convey vendor quotations to the customer in response to a request, the claimed inventions represent an advance in the art. In particular, the claimed inventions introduce a host-selected vendor to the customer, upon a prescribed condition, "without disrupting existing relationships between the customer and its vendors." (Claim 1, preamble.) The application discloses that "[b]y relating in [a] database particular goods, services or parts to specific vendors, the customer can identify a desired ware in a web browser form and submit the form to the host 106. . . . The customer can select a vendor from

that list, but will only be permitted to post the request to that vendor if the customer has an existing relationship with the selected vendor. In this manner, the customer is not able to “shop” a request for quote to a vendor with whom it does not have a prior relationship. Optionally, the system filters the set of vendors in the vendors selection list to include only those that the customer has previously identified as being one of its vendors.”

Application claim 1 also recites “obtaining at the host Web site relationship data which relates the request to one or more vendors selected by the customer.” Applicants submit that the prior art does not disclose nor suggest such customer interaction with vendors based on “relationship-data which relates the request to one or more vendors selected by the customer.” The method of claim 1 conveys “the request to the host-approved vendor only upon a prescribed condition.” Thus, relationships between vendors and customers are not impacted by any transactions conducted over the Internet. In contrast, under the business method suggested by the Examiner, a customer can contact any number of potential vendors for a quotation, regardless of whether there was a prior relationship. That conduct causes the commoditization of wares and services, with customer seeking lowest prices and vendor-customer relationships being sidestepped.

**Status of the Claims**

Claims 1-30 are pending.

**Information Disclosure Statement**

Applicants respectfully note that an Information Disclosure Statement, accompanied by PTO Form 1449, was filed concurrently with the application on June 27, 2001. A photocopy of the IDS, the accompanying Form 1449, certificate of mailing, and return postcard stamped

by OIPE are included in **Attachment A**. Applicants note that the Office Action dated June 29, 2004 does not include a copy of the June 27, 2001 Form 1449 initialed by the Examiner and, therefore, request that the Examiner review the cited references and initial the Form 1449 so that the references are made of record and identified on the face of any patent which may issue from this application.

The photocopy of the IDS submission and other documentation in Attachment A demonstrates that the references cited in the IDS were properly in the case at the time of the Examiner's action. However, there is no indication that the Examiner considered these references when formulating the first examination of the claims on the merits as required by 37 C.F.R. § 1.104(b). Should the Examiner fail to allow all of the claims over these references or those cited by the Examiner, as currently urged by the Applicants, the Examiner should issue a non-final Office Action for a rejection premised on any of the references in the IDS.

**Rejection Under 35 U.S.C. § 102**

Claims 1-3 and 5-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 6,263,317 to Sharp et al. ("Sharp"). Applicant respectfully traverses this rejection.

The Examiner contends that Sharp discloses all the features of claims 1-3 and 5-30 including conveying a request from a customer to one or more vendors selected by the customer. Applicants respectfully disagree with the Examiner's reading of Sharp.

Sharp discloses a web-based system that allows manufactures and distributors of brand products to participate in the e-commerce marketplace without violating existing distribution channels. Sharp discloses that orders placed by customers are allocated to manufactures,

distributors, and retailers according to distribution channel protocols defined by the manufacturer. (Sharp, Abstract.) This allocation of orders is done by a computer program implementing a distribution channel conflict resolution scheme specified by the product's manufacturer. (Sharp, column 3, lines 22-25; column 4, lines 12-15.)

In contrast, claim 1 recites “obtaining at the host Web site relationship-data which relates the request to one or more **vendors selected by the customer**” and “conveying the request obtained by the host Web site to the **customer-selected vendors.**” Similarly, independent claim 25 recites “providing from the customer station information which relates one or more **customer-selected vendors** with whom the customer has an existing relationship with the product or service in the request” and “receiving from the host any responses to the request from the **customer-selected vendors.**” (Emphasis added.) Independent claim 15 recites “accepting over an Internet connection a request from a customer” and “for each of said pre-selected vendors formatting said request for delivery in the established communication format of the customer with that vendor.” The preamble to claim 15 states that the pre-selected vendors are “vendors with whom the customer has an existing relationship.”

In contrast, Sharp discloses that the vendors are selected in accordance with distribution protocols defined by a manufacturer. Therefore, Applicant submits that Sharp does not disclose each and every feature of independent claims 1, 15 and 25. Thus, Sharp does not anticipate claims 1, 15 and 25. Claims 2, 3 and 5-14 depend from claim 1. Claims 16-24 depend from claim 15. Claims 26-30 depend from claim 25. Applicant submits that Claims 2, 3, 5-14, 16-24 and 26-30 distinguish over Sharp for at least the same reasons as their respective base claims. Withdrawal and reconsideration of the rejection is requested.

**Rejection Under 35 U.S.C. § 103**

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of the Examiner's statement of what was known by an ordinary person of skill in the art at the time of the invention. Applicant respectfully traverses this rejection.

The Examiner acknowledges that Sharp fails to disclose all the features of claim 4. However, the Examiner contends by Official Notice that it is well known in the art for customers to request quotes and vendors to respond. The Examiner states that it would have been obvious for a person of ordinary skill in the art at the time of the invention to have combined Sharp with the Official Notice to achieve the invention of claim 4.

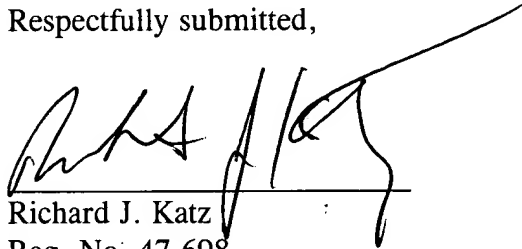
Claim 4 depends from claim 1 and recites all the features of claim 1 in addition to its own features. Applicant submits that the combination of Sharp and the Official Notice neither discloses nor suggests, singly or in combination, the features of claim 4 which are missing from Sharp as discussed with respect to claim 1 in the previous section. Therefore, Applicant submits that the Examiner has not met the burden to establish a *prima facie* case of obviousness. Withdrawal and reconsideration of the rejection is requested.

**CONCLUSION**

Each and every point raised in the Office Action dated June 29, 2004 has been addressed on the basis of the above remarks. In view of the foregoing it is believed that claims 1-30 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



Richard J. Katz  
Reg. No. 47,698  
Attorney for Applicant

Dated: December 23, 2004

DARBY & DARBY, P.C.  
Post Office Box 5257  
New York, N.Y. 10150-5257  
Phone: (212) 527-7700

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- 3. Unsigned Declaration (2 pgs.)
- 4. International Preliminary Examination Report (5 pgs.)
- 5. Information Disclosure Statement (3 pgs.)
- 6. PTO FORM 1449 (1 pg.)
- 7. 6 References

Applicant : Daniel NISSANOFF & Mark A. SCHENECKER

Serial No. : t/b/a **JC17 Rec'd PCT/PTO 27 JUN 2001**

Filed : Concurrently Herewith

For : SYSTEM AND METHODS FOR ELECTRONIC

Attorney : DL:HR

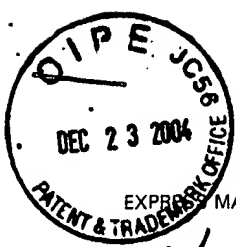
File No. : 2637/1F581-US2

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PATENT TRADEMARK OFFICE

Docket No.: 2637/1F581-US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Daniel NISSANOFF; Maark Allan SCHENECKER

Serial No.: t/b/a

Confirmation No.:

Filed: Concurrently Herewith

For: SYSTEMS AND METHODS FOR ELECTRONIC COMMERCE

INFORMATION DISCLOSURE STATEMENT

Hon. Commissioner of  
Patents and Trademarks  
Washington, DC 20231

Sir:

In order to comply with 37 CFR 1.97 and 1.98, attached hereto is a copy of Form PTO-1449 and copies of the documents listed thereon.



In accordance with MPEP Sections 609 and 707.05(b), it is requested that each document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing Form PTO-1449 next to the document. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

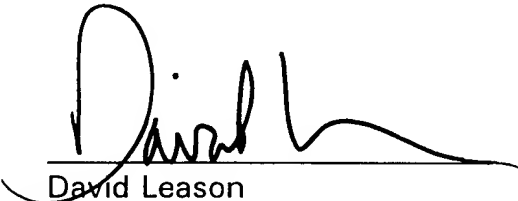
This submission is filed before a first action on the merits has been mailed.

The present Information Disclosure Statement is being submitted in compliance with 37 CFR 1.56, but the citation of such document is not to be construed as an admission that such document is necessarily relevant or prior art. No representation is intended that the cited documents represent the results of a complete search, and it is anticipated that the Examiner, in the normal course of examination, will make an independent search and will determine the best prior art consistent with 37 CFR 1.104(a) and 1.106(b) and, in the course of each search, will review for relevance every document cited on the attached form even if not initialed.

It is believed that no fee is due. However, if the Commissioner determines that a fee is due, the Commissioner is hereby authorized to charge the above deposit account for any deficiency.

Early and favorable consideration is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David Leason", written over a horizontal line.

David Leason  
Registration No. 36,195  
Attorney for Applicant(s)

Dated: June 25, 2001

DARBY & DARBY  
805 Third Avenue  
New York, NY 10022  
(212) 527-7700



**LIST OF REFERENCES CITED BY APPLICANT**

(Use Several Sheets if Necessary)

DOCKET NO.: 2637/1F581-US2 SERIAL NO: t/b/a  
APPLICANT: Daniel NISSANOFF et al. FILING DATE: Concurrently  
Herewith  
CONFIRMATION NO:

**U.S. PATENT DOCUMENTS**

<u>*EXAMINER INITIALS</u>	<u>DOCUMENT NUMBER</u>	<u>DATE</u>	<u>NAME</u>	<u>CLASS</u>	<u>SUBCLASS</u>	<u>FILING DATE</u>
A.	6,023,683	2/8/00	Johnson et al.	705	26	8/10/94
B.	5,970,475	10/19/99	Barnes et al.	705	271	10/10/97
C.	5,842,178	11/24/98	Giovannoli	705	26	1/30/98
D.	5,319,542	6/7/94	King et al.	364	401	9/27/90
E.	5,734,890	3/31/98	Case et al.	395	605	8/22/95
F.	5,224,034	6/29/93	Katz et al.	364	401	12/21/90

**FOREIGN PATENT DOCUMENTS**

<u>*EXAMINER INITIALS</u>	<u>DOCUMENT NUMBER</u>	<u>DATE</u>	<u>COUNTRY</u>	<u>CLASS</u>	<u>SUBCLASS</u>	<u>TRANSLATION</u>
						<u>YES</u> <u>NO</u>

**OTHER REFERENCES**  
**(INCLUDING AUTHOR, TITLE DATE, PERTINENT PAGES, ETC.)**

\*EXAMINER INITIALS

EXAMINER: \_\_\_\_\_

DATE CONSIDERED: \_\_\_\_\_

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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