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(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Daniel Nissanoff

Confirmation No.: 4656

Serial No.: 09/869,538

Group Art Unit: 3627

Filed: November 2, 2001

Examiner: James S. McClellan

For: SYSTEMS AND METHODS FOR ELECTRONIC COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of a Notice of Appeal, and in accordance with the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-appeal brief review of the rejection mailed April 6, 2005 in the above-identified application. No amendments are being filed with this request.

Claims 1-30 are pending in the application, with claims 1-30 having been twice rejected. An appeal is proper in accordance with 37 C.F.R. § 41.31(a), which provides that “[e]very applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board”

The sole question on appeal is whether the rejection of all claims as being unpatentable over the combination of U.S. Patent No. 6,263,317 to Sharp in view of the U.S. Patent No.

5,970,475 to Barnes et al. (“Barnes”), with dependent claim 4 being further rejected in view over the Examiner’s Official Notice, is correct. *See* April 6, 2005 Office Action, items 3-4, pages 2-4.

A. The Cited Combination Fails To Disclose Or Suggest The Claimed Invention

The Examiner errs in rejecting claims 1-3 and 5-30 as being obvious over the combination of Sharp and Barnes. Sharp discloses a web-based system that allows manufacturers and distributors of brand products to participate in the e-commerce marketplace without violating existing distribution channels. Customers’ orders are allocated to manufacturers, distributors, and retailers according to distribution channel protocols defined by the manufacturer. (Sharp, Abstract.) The allocation is in accordance with a distribution-channel conflict resolution scheme specified by the product’s manufacturer. (Sharp, column 3, lines 22-25; column 4, lines 12-15.) The manufacturer in Sharp is the supplier (i.e., vendor) of the goods, and the distributors and retailers (i.e., the manufacturer’s customers) are each a part of the supply chain providing the goods to the customer who placed the order. Thus, in Sharp it is the vendor who determines the relationship and selects the customers.

Barnes discloses an electronic procurement system “which permits any buyer and supplier organizations to establish an electronic commerce relationship with each other without regard to other establishments or enterprises, that may likewise establish electronic commerce relationships with the same or other buyer and supplier organizations.” (Barnes, column 3, lines 31-37.) In contrast to the claimed invention, Barnes discloses buyers and suppliers entering into relationships without regard for disrupting existing relationships between customers and vendors.

In the present application, the claimed inventions are directed to methods which introduce a host-selected vendor to a customer, upon a prescribed condition, “without disrupting existing relationships between the customer and its vendors.” (Claim 1, preamble.) Claim 1 includes the step of “obtaining at the host Web site relationship-data which relates the request to one or more vendors selected by the customer.” Thus, the claimed invention protects relationships between customers (who place orders) and vendors from being impacted by transactions conducted over the Internet.

In contrast, Sharp addresses relationships between a manufacturer and its distributors and retailers (subordinate members in a supply chain), so as to fill the customer’s order while preserving relationships according to an allocation scheme set by the manufacturer as the supplier (i.e., vendor) of the goods. Sharp discloses the vendor determining the allocation scheme without regard for the customer who placed the order, thus, setting the relationship in terms of vendor and its subordinates in the supply chain. This is in direct contrast to the claimed invention which seeks to preserve customer-vendor relationships selected by the vendor who places the order over the Internet. Sharp does not address existing customer-vendor relationships, nor does Sharp address customer-selected vendors as recited in the claimed invention.

In formulating the rejection the Examiner has turned the characters of Sharp on their head. The manufacturer (who does not sell to the customer) determines the preexisting relationship, and the distributors and retailers (who fill the customer’s orders) are placed in the position of the customer. The Examiner’s analysis strains the relevance of Sharp as a reference.

Further, Sharp discloses a customer seeking to buy a product landing at a product manufacturer's website, without a pre-existing relationship. The manufacturer arranges the distribution channel to supply the product to the customer. Claim 1 recites "conveying the request to the host-approved vendor only upon a prescribed condition," where dependent claim 11 recites that "the prescribed condition is that no single one of the customer-selected vendors can fully satisfy the order." Thus, orders are fulfilled in the face of market failures. In contrast, Sharp and Barnes neither disclose nor suggest addressing market failures.

With respect to the rejection of dependent claim 4, the Examiner takes Official Notice that it is well known for a customer to request a vendor quote. The subject matter of the Official Notice in combination with Sharp and Barnes does not disclose, nor suggest, the invention of claim 4.

B. There Is No Motivation To Combine The References

The Examiner has not established a *prima face* case of obviousness for combining Sharp and Barnes. The Examiner has not established a motivation (a reason or suggestion) in the art that would lead an individual to combine the references. According to the Examiner, a person of ordinary skill in the art would look to modify Sharp in view of Barnes in order to extend Sharp to customer-selected vendor relationships, which the Examiner acknowledges is missing from Sharp.

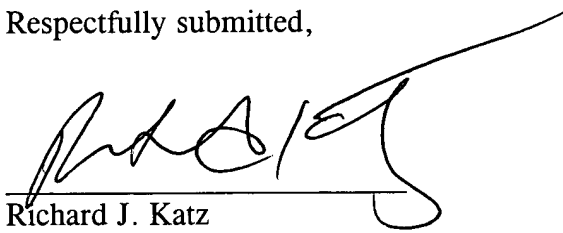
Applicants submit that Sharp teaches away from Barnes. Sharp discloses a solution to the problem of distributing brand products through e-commerce by implementing a distribution-channel conflict resolution scheme determined by a manufacturer, so as not to violate existing

relationships with its suppliers. In Sharp, the manufacturer (i.e., vendor) sets the relationship with its distributors and retailers (i.e., customers on the supply side). This is in direct difference with the claimed invention which seeks to maintain customer-vendor relationships determined by the customer, who places an order for a product.

Barnes discloses an e-commerce system where any buyer and any seller are able to establish relationships among themselves, without regard to pre-existing relationship data. Indeed, Barnes is not concerned with preserving customer-vendor relationships at all. Therefore, a person of ordinary skill in the art at the time of the invention would not look to Sharp and Barnes to solve the problem of not “disrupting existing relationships between the customer and its vendor” while “conveying [a customer] request . . . to the customer-selected vendor,” as recited in the claimed invention.

Applicants believe that claims 1-30 are patentable over the combination of Sharp and Barnes. Accordingly, Applicants request that the present rejection be withdrawn and the claims be passed to allowance.

Respectfully submitted,



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