

REMARKS/ARGUMENTS

Interview Summary

Initially, the Examiners are thanked for the courtesies extended during the interview that occurred on November 1, 2023. During the interview the rejections set forth in the outstanding Office Action were discussed. The Examiner has identified the issues in the Interview Summary made of record and, for the Applicant, each of these matters will be individually discussed below.

Priority

The Applicant notes with appreciation that acknowledgement is made of the benefit to priority for claims 11-16 and 20 all the way back to U.S. Provisional Application 61/237,128, as well as the benefit to priority back to U.S. Patent Application No. 16/853,133 for claims 1-10 and 17-19. Still, the Examiner has not accepted the Applicant's full claim for priority. More specifically, the Examiner alleges that Application Nos. 61/237,128, 12/711,867, 13/270,848 and PCT/US2010/046747 fail to provide adequate support for two specific claim limitations, i.e. the Examiners specifically held there is no support for the following terms/phrases: "failing to locate" and "replacement product" in independent claim 1 and claims that depend therefrom. The Applicant respectfully traverses this position.

During the above-referenced interview, it was agreed that the written description requirement prevents an applicant from claiming subject matter which is not adequately disclosed, i.e., not disclosed in sufficient detail that one skilled in the art would recognize that the applicant had possession of the invention. Possession of the invention is not limited to situations where the exact wording in the claims is employed in the specification. Instead, as also agreed during the interview, MPEP 2163 specifically sets forth that the exact terms or phrases used in the claims need not find direct correspondence in the specification, but rather it is whether the

specification supports the claimed terminology through “express, implicit, or inherent disclosure.”

Initially, the Applicant would like to address the support for “replacement product.” To start, as raised during the interview, the Oxford dictionary’s definition of “replacement” is “person or thing that takes the place of another.” As understood, the Examiners acknowledge full support of the term/phrase “another product.” In fact, this term/phrase can find clear support all the way back to provisional patent application 61/237,128, e.g., paragraph 0018 discloses the customer reviewing one or more products and specifically refers to “another product.” In fact, the use of “another product” is prevalent in the line of priority applications. Actually, it was understood that the Examiners would approve priority support for the use of “another product” in the claims, but not “replacement product” per the holding. However, as a **replacement thing** is something that takes the place of **another thing** per the definition set forth above, and the Examiners acknowledge the priority support for “another product” being presented to the customer, it is respectfully submitted that the Applicant clearly had possession of the customer being presented with a “replacement product.”

Regarding the “failing to locate” phrase, the agent goes to the store to look for the “one or more goods” of the “acquisition request.” By way of a simple example, the acquisition request can be constituted by just one specific product. If the acquisition request included just one specific product and the agent finds that product, the product could just be purchased and the remaining limitations of the claimed invention would not be involved, i.e., the invention would not be used for the purchase. However, the invention is particularly concerned with when a specific product cannot be found and another or replacement product is going to be proposed to the customer for approval or denial. During the interview, a simple example was postulated wherein the customer wanted various groceries and one product of the acquisition request was a 50.5 oz bottle of Heinz ketchup. If the agent can go to a store and find all the products identified in the acquisition request, the invention would not be needed. However, assume the agent found all the products but the store was out of Heinz ketchup or perhaps just the specified bottle size then, in accordance with the invention, the agent could obtain information on another product,

say a similar sized bottle of Hunts ketchup, convey an image to the customer in connection with the purchase of this product instead. During the interview, the Examiners seemingly agreed that this example was operating in accordance with the invention. Then it was questioned, isn't it clear that the example logically shows that it would only be necessary to bother the customer to approve another product if the agent cannot find or locate the actual product requested? Given the Examiner's indication of "understanding" the Applicant's position on this point, this argument is now being presented for reconsideration of the priority decision.

Regardless of the Applicant's disagreement on the holding of priority for these two identified phrases, to advance prosecution, the terms/phrases "failing to locate" and "replacement product" have simply been removed from the claims. It is respectfully submitted that these changes and/or the arguments presented above obviates the full priority objection, even though just getting the priority date back to USSN 13/270,848 removes the Carr reference as prior art.

Double Patenting

Claims 1-10 have been rejected on the ground of non-statutory double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 11,238,465 in view of Hopson. In addition, claims 11-20 stand rejected on the ground of non-statutory double patenting as being unpatentable over claims 1-20 in US Pre-Grant Publication No. 2020/0302451, i.e., the pre-grant publication for US 11,238,465. The Applicant is willing to advance prosecution by filing one or more terminal disclaimers upon allowance of the claims and an indication that the Examiners still deem a double patenting rejection on such allowed claims is appropriate. Therefore, it is just submitted that filing one or more terminal disclaimers at this point would be premature.

Claim Rejections Under 35 U.S.C. 112

Claim 3 has been rejected for not providing proper antecedent basis for the global positioning system. Claim 3 has been amended to recite a global positioning system and therefore the Applicant requests that the rejection be withdrawn. During the interview, the

Examiners indicated that it would be helpful for clarity to interrelate getting an approval by the customer to the image sent. Claim 1 has been amended to clarify the purpose of sending the image to the customer is for approval of the product.

Claim Rejections Under 35 U.S.C. 101

In connection with this rejection, the Office Action holds claim 1 to recite only an abstract idea. In taking this position, it is respectfully submitted that various claim limitations are left out of the listing of what claim 1 “substantially recite[s]” on page 10 of the Office Action. In prior related applications in this family, the Applicant was confronted by similar §101 rejections, each of which were withdrawn by USPTO Examiners. On this point, the Examiners were questioned during the interview as to the potential inappropriateness of subjecting the Applicant to the same type of analysis in multiple patent applications in this family, wondering why the Examiners do not give deference to prior USPTO decisions. As correctly outlined on the Examiner Interview Summary Record, the Examiners noted that “previous analysis does not factor into the analysis done in this application.” Although this was considered unfortunate, the Examiners were questioned whether Board or Court decisions on such matters would be factor into reconsidering their positions. Although no affirmative response was received, the undersigned would like to bring the Examiners attention to a Federal Court decision dated April 28, 2022 in *Conuseron, LLC vs. Maplebear, Inc*, pending Civil Action No. 21-01147-LPS (see copy enclosed). Therein Judge Leonard P. Stark of the District of Delaware Court and currently appointed to the CAFC goes to great lengths to analyze the two step process of *Alice* in connection with broader claims associated with priority claim U.S. Patent Nos. 8,244,594, 9,202,191, 10,115,067 and 10,628,835 (particularly see pages 59-76) taking into account and holding the issuance of the patents by the USPTO over §101 supports the Court’s decision that the patents are directed to more than just an abstract idea, thereby denying the motion to invalidate the patents under §101.

More specifically, Judge Stark actually identified on pages 59- 61 of his decision [DKT#54] a broader abstract idea of "using computing devices to exchange information to

facilitate the acquisition and delivery of goods via personal shoppers." The Judge cited cases in support. See, for example, *Baggage Airlines Guest Services Inc. v. Roadie Inc.* 351 F. Supp 3d 753. However, the Judge went on to decide that he could not hold that the claimed combination of the structural and functional elements captured in the claims was conventional, routine and well understood at the time of the invention. The Judge therefore dismissed the defendant's motion that the claims were not directed to patentable subject matter. In addition, the Court held that the claims include structural components like "a remote server and the Mobile Delivery Agent System itself that work in combination to convert a request received over the internet into a communication that can be processed by the MDAS" which was "unconventional at the time of the invention." As the Judge noted even, "off-the-shelf generic components, when employed in an unconventional way, survive step two challenges." The Judge noted the claims (similar to the claims in present application) recite additional structure, mentioning at least the mobile agent system, the use of bar codes and a delivery limitation. For all of these reasons, the subject claims are directed to patentable subject matter at least under step 2 of a proper §101 analysis and the Applicant request that the rejections be withdrawn.

Claim Rejections Under 35 U.S.C. 103

To overcome at least the relied upon prior art to Carr (US20160148302), the Applicant only needs to prove a priority date to the filing of 13/270,848 which was on October 11, 2011. As discussed above, the claim changes and/or arguments presented should result in removal of the priority claim issue, as well as Carr being effective prior art. Upon removal of Carr as a prior art reference, it is respectfully submitted that rejections of claims 1-10 and 17-19 should be withdrawn. In view thereof, arguments concerning perceived distinctions between the invention and Hopson, as well as Hopson in view of Carr, are superfluous and will not be presented here.

With respect to the rejections of claims 11 and 14-16 based on US Patent Publ. 2004/0068443 to Hopson in view of JP 2006/004096 to Otsaka and US 2006/0196935 to Moto, the Applicant notes a similar rejection was presented in U.S. 11,238,465 based on Hopson and Otsaka and then withdrawn. In general, Hopson is concerned with grocery shopping based on

receipt of a buyer's list, with the shopper using a UPC scanner only to verify the products which are collected by the shopper. There is no additional information collected. More specifically, paragraphs 67 and 78 of Hopson describe that a list of desired items to be picked is displayed and the list includes a UPC for each desired item. The picker then scans the UPC of an actual item being picked. The implication is that the UPC of the desired item is compared to the UPC of the located item to confirm the correct item has been picked. As the verification on the identified product is directly made through the UPC verification, there is no need to contact the customer at all, let alone provide an image to the customer based on the UPC. The Examiner argues that Otsuka discloses sending an image to the customer. However, such a modification would both be unnecessary in the invention of Hopson and render the combination unable to achieve the goals of the base reference which is specifically to use the UPC to verify a product for the picker in a simple manner. The Examiner's proposed combination complicates the arrangement in Hopson without any apparent reason, particularly absent hindsight of the present invention. Therefore, the modifications are not obvious and the rejection should be withdrawn.

Additional Point on Priority

It is considered important that USSN 16/853,133 received an obviousness-type double patenting rejection based on the claims in US 10,628,835 such that the USPTO required a terminal disclaimer to be filed for allowance. In making the double patenting rejection, the USPTO held that any distinctions between the claimed subject matter was obvious to one of ordinary skill in the art **and, inherently**, US 10,628,835 contained and supported all the claimed subject matter. With this in mind, given that the '465 patent (and/or the related publication) is relied upon for double patent rejection in the present application and the claims in the '465 patent were rejected under a double patenting rejection based on the '835 claims, it is evidenced that the present claims should be accorded the priority of at least the '835 patent.

Conclusion

Based on the discussions held during the interview, the above remarks and the amendments to the claims, the Applicant respectfully requests reconsideration of the priority issue and the objections and rejections in this application, while submitting that the present invention is patentably defined over the prior art of record such that allowance of all claims and passage of the application to issue are respectfully requested. If the Examiners should have any additional questions or concerns regarding this matter, the Examiners are cordially invited to contact the undersigned at the number provided below in order to further prosecution. In particular, if the Examiners deem the claims to be in condition for allowance except for the need for a terminal disclaimer, the Examiners are requested to contact the undersigned to expedite this filing and allowance.

Respectfully submitted,

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