Examiner's Response – Fourth Office Action

Many of the above-reproduced arguments (incorporated herein) were previously presented on pages 30-33 of the Third Response. The Examiner's response these arguments is found on pages 16 and 17 of the Fourth Office Action. Initially, in the first full paragraph on page 16 of the Fourth Office Action, the Examiner asserted the following:

> Applicant next turns to the prior art rejections, beginning on page 30. On pages 31-32, Applicant argues that the manner in which the arrangement is made is distinct from the prior art cited. However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Hortsmann [sic], "A method establishes *reciprocal page links between pages on the Internet*. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party - i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed. (emphasis in original)

This portion of the Examiner's response does not address the issue argued by Appellant. Notably, Appellant is not contesting that the ultimate result of Horstmann is that reciprocal links are created between two websites. Rather, Appellant has argued that (i) the claimed invention achieves this ultimate result in a different manner than disclosed by Horstmann, and (ii) this different manner results in an improvement[9] over the teachings of Horstmann.

Referring to the second full paragraph on page 16 of the Fourth Office Action, the Examiner asserted the following:

> Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two

[9] As argued above with regard to the rejection of the claims under 35 U.S.C. § 101.

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> parties - clearly present in Horstmann. That the reference uses software to execute some of the verification does not mean there is no "reciprocal agreement" between the two.

The Examiner argues that "Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims" while asserting "[a]ll that is required is an agreement between the two parties." Here, the Examiner errs by failing to consider the actual claim language. The claims do not merely recite "an agreement between the two parties." This statement is an overgeneralization of the claimed invention. Notably, the claims recite "establishing a reciprocal arrangement between the first web page and the second web page based upon *both* the first and second users opting to participate in the reciprocal arrangement." As noted above, Horstmann explicitly teaches "page A is modified and redisplayed *without any intervention from the bookstore owner*." There cannot be an "agreement between the two parties" when one of the parties does not opt to participate in the reciprocal arrangement.

Referring to the last full paragraph on page 16 of the Fourth Office Action, the Examiner further asserts the following:

> Applicant argues that Horstmann allows any link to be initially created, however, this is untrue; the owner of the website may modify the list of links at any time. (emphasis added).

To be clear, the argument referenced by the Examiner is reproduced below:

> Aside from the differences discussed above, the claimed invention represents an improvement over Horstmann's system. As discussed above, using the information from the bike shop owner, a link from bookstore's page to the bike shop's page is *automatically created without input* from the bookstore's owner. Accordingly, the bookstore's page could be automatically linked to any page on the internet. There is a large number of pages on the internet that the owner of the bookstore's page may not want to be associated with. However, the Horstmann system allows any link to be initially created on the bookstore's page. (emphasis in original)

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The Examiner's response does not refute Appellant's arguments. Specifically, the Examiner argues that "the owner of the website may modify the list of links at any time." However, this does not change that the Horstmann system allows any link to be initially created on the bookstore's website since this link is automatically created without input from the bookstore's owner.[10] The Examiner's assertion that the bookstore owner may subsequently edit the list does not change the fact that the link can be initially created and present on the bookstore's website without input (or knowledge) of the bookstore's owner.[11] Additionally, if the bookstore owner adds a link, then that link is added not "based upon the reciprocal arrangement," as claimed but based upon the bookstore owner's own desire.

The Examiner's final response to Appellant's arguments is found in the paragraph spanning pages 16 and 17 of the Fourth Office Action and is reproduced below:

> Applicant again argues the reciprocal arrangement, however, as discussed above this is not persuasive as there is clearly an agreement between the bookstore owner and the bike shop owner in Horstmann. Applicant's claims simply require an agreement of any sort. That Horstmann goes above and beyond the creation of the agreement to include verification of performance is irrelevant.

The Examiner overgeneralizes both the claims and the teachings of Horstmann.

---

[10] As stated in column 3, lines 20-26, "Software on the links server (step 4) automatically modifies page A to include a link 6 (the fourth link information) from page A to page D as requested by the bike-shop owner. The new page A, including the link to page D, is then redisplayed to the bike-shop owner. Thus, page A is modified and redisplayed without any intervention from the bookstore owner." (emphasis added)

[11] One can imagine a situation in which a party could intentionally damage the reputation of the bookstore using the system of Horstmann via negative association. Specifically, such a party could add links to various websites associated with disreputable groups (e.g., hate groups and terrorist organizations). Potential customers of the bookstore could see this association between the bookstore and these disreputable groups negatively and avoid using the bookstore. While the bookstore owner would be subsequently able to delete the link (see column 5, lines 39-40 of Horstmann), the damage to the reputation of the bookstore has already been done.

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The Examiner's assertion that "there is clearly an agreement between the bookstore owner and the bike shop owner" does not accurately reflect either the claimed invention or the teachings of Horstmann. As argued above, the user associated with the bookstore's page opts into a scheme (i.e., Horstmann's system) that allows anybody to place a link on the bookstore's page so long as the form associated with the "add link" link has been completed. The bookstore owner cannot opt into an agreement between bookstore web page with the bike shop store page because the bookstore owner does not necessarily know of the bike shop page or the bike shop owner.

Conclusion

Based upon the foregoing, Appellant respectfully submits that the Examiner's rejections under 35 U.S.C. §§ 101, 102 are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 102.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 503611, and please credit any excess fees to such deposit account.

Date: July 5, 2019

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
CUSTOMER NUMBER 55246

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VIII. CLAIMS APPENDIX

22. A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;

including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity; and

including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity.

23. The method of claim 22, wherein

the first web page is stored in a database; and

the second web page is stored in the database.

24. The method of claim 22, further comprising

receiving, from a third user, a request for the first web page;

dynamically generating, using a database, the first web page; and

serving, to the third user, the dynamically-generated first web page.

25. The method of claim 22, wherein

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the first web page includes one or more web pages.

26. The method of claim 22, further comprising

including, within the first web page, a web asset provided by a third party separate from the computer hardware system.

28. The method of claim 26, wherein

the web asset is a functional application.

29. The method of claim 22, further comprising

providing, to the first user, at least one recommended web page, associated with the computer hardware system, into which the second link is to be included.

30. The method of claim 22, wherein

the second link is associated with a graphic image within the second web page.

31. The method of claim 30, further comprising

receiving, from the first user, the image.

32. A webpage implementation server system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:

a database system storing information associated with the first and second web pages;

a computer hardware system configured to perform:

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storing first input received from the first user into the database system;

storing second input received from the second user into the database system;

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;

generating, using the first input received from the first user and the reciprocal arrangement, the first web page; and

generating, using the second input received from the second and the reciprocal arrangement, the second web page, wherein

the second web page includes, based upon the reciprocal arrangement, a second link to the first web page; and

the first web page includes, based upon the reciprocal arrangement, a first link to the second web page.

33. The server system of claim 32, wherein

the first web page is stored in the database system; and

the second web page is stored in the database system.

34. The server system of claim 32, wherein the computer hardware system is further configured to perform

receiving, from a third user, a request for the first web page; and

serving, to the third user, the first web page, wherein

the first web page is dynamically generated based upon the request.

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35. The server system of claim 32, wherein

the first web page includes one or more web pages.

36. The server system of claim 32, wherein the computer hardware system is further configured to perform

including, within the first web page, a web asset provided by a third party separate from the computer hardware system.

38. The server system of claim 36, wherein

the web asset is a functional application.

39. The server system of claim 32, wherein the computer hardware system is further configured to perform:

providing, to the first user, at least one recommended web page, associated with the computer hardware system, into which the second link is to be included.

40. The server system of claim 32, wherein

the second link is associated with a graphic image within the second web page.

41. The server system of claim 40, wherein the computer hardware system is further configured to perform

receiving, from the first user, the image.

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42. The method of claim 22, wherein

the first and second users are both registered users with the computer hardware system.

43. The server system of claim 32, wherein

the first and second users are both registered users with the computer hardware system.

44. A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:

storing first input received from the first user into a database system coupled to the computer hardware system;

storing second input received from the second user into the database system;

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement;

generating, using the first input received from the first user and based upon the reciprocal arrangement, the first web page; and

generating, using the second input received from the second user and based upon the reciprocal arrangement, the second web page, wherein

the second web page includes, based upon the reciprocal arrangement, a second link to the first web page; and

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the first web page includes, based upon the reciprocal arrangement, a first link to the second web page.

45. The method of claim 44, wherein

the first web page is stored in the database system; and

the second web page is stored in the database system.

46. The method of claim 44, further comprising:

receiving, from a third user, a request for the first web page; and

serving, to the third user, the first web page, wherein

the first web page is dynamically generated based upon the request.

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IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

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X. RELATED PROCEEDINGS APPENDIX

A Decision on Appeal and Decision on Request for Rehearing were respectively issued on Jun 15, 2009, and September 13, 2009, in parent U.S. Application No. 09/589,551, and are attached hereto. A Memorandum Opinion was issued by the United States District Court for the District of Delaware on September 28, 2018, with regard to related U.S. Patent No. 8,768,760, and is attached hereto. That decision in currently under appeal before the Federal Circuit (Appeal No. 19-1210). A Decision Denying Institution of *Inter Partes* Review was issued by the Patent Trial and Appeal Board on June 5, 2019, with regard to related U.S. Patent No. 8,768,760, and is attached hereto. Since Appellant is unaware of any other related appeals and interferences, no other decision rendered by a court or the Board is attached hereto.

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09/589,551	06/07/2000	Thomas L. DiStefano III	1115-007U	8542

29973 7590 06/15/2009

CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER	
LASTRA, DANIEL	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. DISTEFANO, III

Appeal 2009-000339
Application 09/589,551
Technology Center 3600

Decided: [1] June 15, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Thomas L. Distefano, III (Appellant) seeks review under 35 U.S.C. § 134 of a non-final rejection of claims 1-21, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM-IN-PART.

The Appellant invented a way of assisting a website designer in establishing an arrangement between a first website being designed by the website designer and a second website to market the first website at the second website upon the activation of the first website on the internet (Spec. 6:2-5).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A method of assisting a website designer in establishing an arrangement between a first website being designed by the website designer and a second website in order to market the first website at the second website upon the activation of the first website on the internet, the method comprising:
>
> [1] during design of the first website, receiving
>
> information at a user interface indicating a type of an element for marketing
>
> that is to be displayed at the second website, and
>
> information specifying the second website at which the element is to be displayed;
>
> [2] saving the information at a first database that is coupled to the user interface;

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[3] obtaining the element for marketing of the type indicated; and

[4] causing the display of the element for marketing at the second website

when the first website is activated with respect to the internet,

wherein the element for marketing includes at least one of

a banner ad concerning the first website and

a link to the first website.

This appeal arises from the Examiner's Non-Final Rejection, mailed June 18, 2007. The Appellant filed an Appeal Brief in support of the appeal on November 19, 2007. An Examiner's Answer to the Appeal Brief was mailed on February 4, 2008. A Reply Brief was filed on April 4, 2008.

PRIOR ART

The Examiner relies upon the following prior art:

Wexler	US 5,960,409	Sep. 28, 1999
Hess	US 6,058,417	May 2, 2000
Moore	US 6,330,575 B1	Dec. 11, 2001
Mason	US 6,401,075 B1	Jun. 4, 2002

REJECTIONS

Claims 13, 16-18, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Moore.

Claims 1, 4-12, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

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Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1, 4-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore turns on to whether the art describes, or shows that it was predictable, that (1) during design of the first website, information is received that is to be displayed at the second website and that specifies the second website at which the element is to be displayed, and (2) when the first website is activated with respect to the internet, the display of the element is caused, wherein the element includes a banner ad or a link to the first website. In addition, the issues as to claims 4-6 and 8-10 turn on whether the art describes the limitations added by those dependent claims.

The issues of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore, in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler, and in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess turn on the resolution of the issues in the rejection of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

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Facts Related to Appellant's Disclosure

01. Once the design of the new website by the registered user is completed and the new website is posted/activated, the system 100 causes the selected websites of other registered users (i.e., the websites selected during the design of the new website) to display a link and/or banner ad concerning the new website (Spec. 33:9-13).

Moore

02. Moore is directed to providing a scalable distributed Internet commerce system (Moore 1:11-13).

03. Moore describes a method for designing a Web page, to be hosted on a Web page server, and for publishing the Web page at a destination of the customer's choosing. There is also a method for designing a Web page for use in a distributed electronic commerce system having a Web page server and a second server where the Web page server hosts the Web page. The method creates a link to the second server; designs the Web page such that the link can be embedded into the Web page; and embeds the link into the Web page (Moore 3:23-43).

04. Moore describes how the customer goes to a Store Server and begins shopping. When the customer finds a product to buy, he selects that product and the Store Server then jumps to the Store Builder Server by using a Uniform Resource Locator ("URL"). The URL, called a price URL, contains all of the relevant information on the product, and all the information necessary to build a "Buy Page." (Moore 6:12-20.)

05. Moore Fig. 7 shows several regions with information displayed, such that each would be a display region.

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06. Moore describes the practice of using audio in HTML documents (Moore 1:38-42).

Mason

07. Mason is directed to placing advertisements and/or other communications on multiple websites (Mason 1:5-8).

08. Mason describes obtaining Internet-type advertisements, modifying those advertisements to fit the designated advertising spaces allotted by different and unrelated online newspaper websites, automatically placing those advertisements, monitoring the success of the placed ads and modifying the ads and their placements to meet dynamic goals of an advertising campaign (Mason 2:5-12).

09. Mason facilitates the billing of an advertiser. For example, a national advertiser can purchase advertising space on an online newspaper website by the number of hits the ad receives or by the number of click-throughs (Mason 5:4-8).

10. In Mason, the advertiser can upload one or more original ads into a server which checks the configuration of the ad, and compares that configuration to specifications of online newspaper website URLs where the derivative advertisement links are going to be placed. Typically, the original advertisement must be modified, forming derivative advertisement links which are then displayed for final approval. If the reconfigured ad is approved, it is stored for placement (Mason 5:47-58).

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Facts Related To The Level Of Skill In The Art

11. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, web design, and web advertising design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

12. Those of ordinary skill in the art knew at the time of filing that posting an HTML document to a web site such that it was accessible from links to that web site activated that document within the site.

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.

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Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it 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." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements

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according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 417.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 420.

Obviousness and Nonfunctional Descriptive Material

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

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ANALYSIS

Claims 1-3, 7, and 11-21

The Appellant argues claims 1, 7, 11, 12, 19, and 21 as a group[2]. In addition, the Appellant applies the arguments in support of claim 1 as the arguments to the rejections of claims 13-18 and 20. Accordingly, we treat claims 1, 7, and 11-21 as a group and select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Mason describes the limitations of claim 1 except for "during the design of the first website causing the display of the element for marketing at the second website when the first website is activated with respect to the Internet." The Examiner found that Moore described this limitation and that one of ordinary skill knew to combine this with Mason to avoid premature advertising expense before the advertising was launched (Ans. 3-4).

The Appellant argues that (1) Mason fails to describe activity during a website design (App. Br. 7); (2) neither reference describes a problem to which the Examiner proposed a solution as the motivation to combine the references (App. Br. 8); and (3) neither reference describes causing the display of the element for marketing at the second website when the first website is activated with respect to the internet, as claimed (App. Br. 8). Additionally, the Appellant contends that (4) the Examiner failed to clearly identify how the art describes the claim limitations (App. Br. 5-6); (5) the Examiner mischaracterized limitations [1] and [4] (Appeal

[2] The Appellant included claim 6 in this group (App. Br. 5), but claim 6 depends from claim 4 which is not included in the group. We therefore consider this inclusion of claim 6 to be a typographic error and treat claim 6 with claims 4 and 5 *infra*.

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Br. 6-7); and (6) one skilled in the art would not consider the words posted and activated to be equivalent (App. Br. 9).

As to each of these arguments, the Examiner responded that (1) Moore was applied to describe activity during a website design (Ans. 16); (2) Mason described the practice of paying advertising fees based on ad click-throughs and one of ordinary skill knew the disadvantage of placing such an ad before an advertising campaign was ready (Ans. 16-17); and (3) that such display of ad elements for marketing at websites other than the site where the ad was designed was notoriously well known as evidenced by Moore's referral to Price URL's that users publish when the second web site is activated (Ans. 17).

As to the three subordinate contentions, the Examiner responded to (4) by laying out a more detailed analysis of the match between claim limitations and the references (Ans. 14-15); to (5) by finding that the Examiner's paraphrasing of limitations [1] and [4] were made in view of the support for those limitations in the Specification at 33:10-15 (Ans. 15-16); and to (6) by finding the equivalence of the words "posted" and "activated" based on Specification 33:10-15 (Ans. 18).

The Appellant responded to the Examiner's response to argument (2) by stating that the Examiner's position appeared to be based on inherency and that inherency cannot be based on probabilities (Reply Br. 3-4); and contention (5) that the Specification does not support the Examiner's paraphrase, but instead requires that once the design is completed and the website is posted/activated, then the link and/or banner ad is displayed (Reply Br. 5).

We disagree with the Appellants. There is no contention regarding the ubiquitous steps of saving and obtaining data in limitations [2] and [3]. The issues in the remaining limitations [1] and [4] come down to whether the art describes, or

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shows that it was predictable, that (1) during design of the first website, information is received that is to be displayed at the second website and that specifies the second website at which the element is to be displayed, and (2) when the first website is activated with respect to the internet, the display of the element is caused, wherein the element includes a banner ad or a link to the first website.

Limitation [1] requires that two items of information be received at a user interface. The location of the user interface is unspecified. The intent of the two items is that they indicate a marketing element type and specify a second site location. However, the verb "indicating" does not require that the information actually be displayed or used to identify the second site, only that the information be functionally capable of doing so in some context. The Examiner relied on Mason to describe this. Mason describes uploading ads into a server which checks the configuration of the ad, and compares that configuration to specifications of online newspaper website URLs where the derivative advertisement links are going to be placed (FF 10). Thus, Mason's information indicates an advertising marketing element type and specifies a second site location. This information is received at the user interface prior to final approval (FF 10) and is therefore during the design of the website, or at least that particular advertising piece of the second website. The design of any aspect of a web site is a component of the design of the web site itself and thus fits the limitation of occurring during design of the web site. We therefore find the Examiner's position that Mason describes limitation [1] supported by substantial evidence.

Limitation [4] requires causing the display of the element that includes either a banner ad concerning the first website or a link to the first website for marketing at the second website when the first website is activated with respect to the internet.

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Limitation [4] does not specify the causation trigger but does require some coincidence of timing between the display and website activation.

The verb "is activated" is the passive voice of activate, and thus limitation [4] requires that the display occur when someone or something activates the web site. The Examiner found that Moore described a system for designing websites where a first website is activated with respect to the Internet when the first website is posted to a hosting server (Answer 4; FF 03). The Examiner construed the verb "activate" as equivalent to the verb "post" based on the use of the construct "posted/activated" in the Specification (Ans. 4; FF 01). From this construction, the Examiner found that Moore described causing the display of the element that includes a banner ad concerning the first website at the *first* website when the first website is activated with respect to the internet. The Appellant's contention (6) *supra* challenged this construction. Certainly activating is not equivalent to posting in general. However, it is notoriously well known that posting an HTML document on a web site, such that links activates that document within that site. Thus, in the limited context of Internet systems, posting is synonymous with activation (FF 12).

So the issue remaining is whether it was predictable to cause the display of the element that includes a banner ad concerning the first website at the *second* website when the first website is activated with respect to the internet. The distinction is that now coordination is required to have display of an ad occur at a second site when activation of the target of the ad occurs at a difference site. The Examiner found it was predictable because without such coordination, the risk of incurring advertising costs prior to the availability of the advertised target would cause the advertising campaign to coordinate those events. The Appellant

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responded with argument (2) *supra* that the references applied fail to show this problem and that inherency cannot be based on probabilities.

Claim 1 does not specify how the coordination occurs, only that it occurs. The Appellant does not make any arguments regarding the coordination mechanism. So the sole issue is whether it was predictable at the time of filing.

> The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends.

KSR, 550 U.S. at 419. "[T]he analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* 550 U.S. at 418. "[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *id.* 550 U.S. at 417.

As the Examiner found, Mason describes the parameters of the problem in that advertising may be billed based on click-throughs (FF 09). Common sense, let alone knowledge of one of ordinary skill, informs one that with such an arrangement, the mechanism that incurs those costs should not be deployed until the advertisement would be effective, *viz.* at activation of the ad target. On the other side, with any new promotional campaign, delay beyond the earliest appropriate start time is counter to the purpose of such promotion. Thus, the time that one of ordinary skill in the promotional arts would display such an ad would

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be when the target of the ad is activated. As to the Appellant's argument regarding inherency, this rejection is one of obviousness rather than novelty.

Accordingly we find the Appellant's arguments unpersuasive.

Claims 4-6

Claim 4 depends from claim 1 and requires a reciprocal site. The Appellant argues the Examiner failed to show such reciprocity in the site described in the references (Reply Br. 9). We agree with the Appellant. The Examiner appears to have ignored this limitation in the analysis by construing the term "reciprocal" to mean simply mean a third party (Ans. 19). The Examiner refers to a definition of reciprocal in the Specification at 16:20-25, but we are unable to discern any definition at that section, which only refers to other, rather than reciprocal, sites. Claims 5 and 6 depend from claim 4 and the same argument applies to those claims as well.

Claims 8-10

Claims 8-10 depend from claim 1 and further require providing banner ads, display regions, and sonic effects. The Appellant argues these are missing from the applied references. The Examiner responds that Moore's price URL's are equivalent to banner ads and that Moore show the use of display regions and audio (Ans. 21-22). The Appellant responded that the Examiner failed to show that Moore's price URL's are equivalent to banner ads and that the Examiner failed to show all of the limitations of claims 9 and 10 (Reply Br. 9-10).

We disagree with the Appellant. A banner ad is simply a link in an HTML document. The contents of the ad are non-functional descriptive material and are accorded no patentable weight. *In re Ngai*, 367 F.3d at 1339. Moore shows such links (FF 04). Moore also shows display regions and sonic effects (FF 05 & 06).

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The general allegation that the Examiner has failed to show all of the limitations is not a specific argument.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess.

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DECISION

To summarize, our decision is as follows:

- The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore is sustained.
- The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is sustained.
- The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is not sustained.
- The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler is sustained.
- The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JRG

CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

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CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER	
LASTRA, DANIEL	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. DISTEFANO, III

Appeal 2009-000339
Application 09/589,551
Technology Center 3600

Decided: September 13, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

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STATEMENT OF THE CASE

The Appellants filed a REQUEST FOR REHEARING on August 17, 2009. The Examiner rejected claims 1-21 in a Non-Final Rejection, mailed June 18, 2007. We affirmed the rejections of claims 1-3 and 7-21 and reversed the rejections of claims 4-6 in our June 16, 2009 Decision. The Appellants seek reconsideration of the decision to affirm these rejections.

We DENY the REQUEST FOR REHEARING.

ISSUES

The issues pertinent to this request are whether the Appellants have sustained their burden of showing that we misapprehended the art or the claims and thus erred in sustaining the rejections of claims, or that we erred in any new grounds of rejection we entered. 37 C.F.R. 41.52(a)(1) and (3).

ANALYSIS

We found the following in our decision:

> The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore.
>
> The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.
>
> The Appellant had sustained its burden of showing that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.
>
> The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

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> The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess.

Decision 16.

Independent Claim 1

Independent claim 1 is directed to a method, whose first step occurs "during design of a first website." The Appellants argue that we misapprehended the Examiner's findings and changed the basic thrust of the rejection, essentially making a new ground which the Appellants now ask to argue. The Appellants in particular contend that the Examiner did not find that Mason described the "during design of the first web site" of limitation [1] and expressly found that Mason did not find it so. Thus the Appellants contend that our analysis presented a different thrust from that of the Examiner and was therefore a new ground. Request 4:19 – 6:11.

We agree that the Examiner did not apply Mason for this claim limitation and we will accept the Appellants' characterization of our analysis as a new ground in an abundance of caution to afford the Appellants the opportunity to argue our findings as to the design limitation. We found that

> Mason's information indicates an advertising marketing element type and specifies a second site location. This information is received at the user interface prior to final approval (FF 10) and is therefore during the design of the website, or at least that particular advertising piece of the second website. The design of any aspect of a web site is a component of the design of the web site itself and thus fits the limitation of occurring during design of the web site.

Decision 12:15-21.

The Appellants contend that our claim construction is not reasonable and eviscerates any definite meaning from the phrase "during the design of the first

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web site." Request 6: 9-11. To the contrary, our finding simply equates the process of design to the sum of its parts. The Appellants propose hypothetical design situations that would extend the design time frame back to 300 BC, based on the design of the triangle as a concept, in an advertisement incorporating triangles. This argument is misplaced because it hypothesizes our finding as implying a nonsensical and irrelevant design time frame prior to the beginning of a web site design while the real implication is that design may be an ongoing process that may and realistically often does extend indefinitely in the future, after the beginning of the web site design process.

Let us be clear as to what our finding was – that the design of any aspect of a web site, not of parts that might have been designed prior to the beginning of the web site design, is an aspect of the web site design. Thus, none of such aspects as we referred to can begin prior to the start of the concept of designing the web site. But they can continue indefinitely afterward.

The Appellant contends that the phrase "during the design of the first website" refers to the duration that starts when a designer makes a definitive step to design the website and ends when the design of the website has been completed. Request 7:13-15. We find little to quarrel with in this proffer, but point out that completion may never occur, since design may continue even after a web site is placed in action. To the extent the Appellants may have meant completion of an initial design, or of a particular design version, the claim does not recite that and in any event, would simply substitute the ambiguity of when an design version completes for the ambiguity of when the total design completes.

Thus, rather than our finding being unreasonable and eviscerating any definite meaning from the phrase "during the design of the first web site," our finding

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highlights the breadth of the scope of this temporal limitation. Simply pointing out how broad a limitation is does not eviscerate the limitation. Rather that very breadth might eviscerate the ability of that limitation to actually narrow the claim scope. The choice of the terms used in the claims is that of the Appellants. We simply analyzed the breadth of the terms and how they affected the scope of the claims.

As to how our finding applied to the rejection, Mason's description of changing an advertisement on a web site (Decision 6: FF 10) was evidence of a change in the design of the web site containing that advertisement, and thus occurred during the design of the web site. Thus, we find this argument unpersuasive as to error on our part.

Independent Claim 8

Independent claim 8 requires selecting a banner ad. We found that a banner ad is simply a link in an HTML document and that Moore described the link and that the contents of the ad attached to a banner ad link are non-functional descriptive material, citing to *In re Ngai*, 367 F.3d 1336,1339.(Fed.Cir. 2004). Decision 9:17-18 and15:22-25.

The Appellants argue that our citation to *In re Ngai* constituted a new ground which the Appellants now ask to argue. Request 8:7 – 9:5. We will accept the Appellants' characterization of this as a new ground in an abundance of caution to afford the Appellants the opportunity to argue our findings as to the non-functional descriptive material nature of the contents of a banner ad.

The Appellants argue that the claimed banner ad is a type of data structure that includes more than just "simply a link in an HTML document." *Id.* The Appellants

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argue that banner ads also include a graphical image file and a means to connect the link to a graphical image file, and the banner ad can also be animated, which requires a mechanism to do so or even be interactive with a user input (e.g., a mouse). The Appellants conclude that one skilled in the art would recognize the claimed "banner ad" is a particular type of data structure that includes more than just a link. *Id.*

To this argument, we find that the claim makes no reference to animation, interactivity, or user input with a mouse with respect to a banner ad. As to being a data structure, any non-functional descriptive material stored in a computer is a data structure. The issue is whether the data structure has operational functionality. The Appellants pick up on this by citing *In re Lowry*, 32 F. 3d 1579, 1583 (Fed. Cir. 1994). The Appellants contend that Lowry's data structures, which according to Lowry greatly facilitate data management by data processing systems, are processed by a machine and are not accessible other than through sophisticated software systems.

The Appellants reach the wrong conclusion from this. Lowry's data structure fundamentally altered the processing of the computer; their patentable weight arose not because they were processed by the machine, but because they affected the processing of the computer. Data structures that have no functional relationship with the claimed subject matter are, by definition, non-functional descriptive material. An advertisement, absent explicit incorporation of functional properties, even on a computer display, is non-functional descriptive material.

The Appellants argue we failed to give full weight to the meaning of a banner ad. Request 10:19-21. We equated a banner ad to a link attached to non-functional descriptive material. To the extent the link is functional, both we and the

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Examiner found that Moore's price URL's described the use of such links. The only issue was whether attaching an advertisement, as contrasted with any other descriptive matter such as in Moore, to that link should be afforded patentable weight. We found such did not, citing *In re Ngai*, 367 F.3d at 1339. To the extent the Appellants are arguing that we ignored the link component of a banner ad, our finding as to Moore makes that argument unpersuasive. To the extent the Appellants are arguing that a banner ad may have a functional component aside from its link, the claim does not recite such a functional component, and such a component is not inherent to banner ads per se. Thus, we find the arguments unpersuasive as to error on our part.

For the above reasons we are not convinced of reversible error in our decision. Accordingly, the Appellants' request for rehearing is denied.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims 1-3 and 7-21.
    - The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore remains sustained.
    - The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore remains sustained.
    - The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore remains not sustained.

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- The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler remains sustained.
- The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess remains sustained.

DENIED

mev

CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE, SUITE 3020
BOCA RATON FL 33487

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

DISTEFANO PATENT TRUST III, LLC,	:	
Plaintiff,	:	
v.	:	C.A. No. 17-1798-LPS-CJB
LINKEDIN CORPORATION,	:	
Defendant.	:	

MEMORANDUM OPINION

Timothy Devlin, DEVLIN LAW FIRM LLC, Wilmington, DE

Attorney for Plaintiff DiStefano Patent Trust III, LLC

Jack B. Blumenfeld, MORRIS, NICHOLS, ARSHT & TUNNELL LLP, Wilmington, DE

Robert T. Cruzen, Sarah E. Jelsema, Andrew M. Mason, Todd M. Siegel, KLARQUIST SPARKMAN LLP, Portland, OR

Attorneys for Defendant LinkedIn Corporation

September 28, 2018
Wilmington, Delaware

STARK, U.S. District Judge:

Plaintiff DiStefano Patent Trust III, LLC ("Plaintiff" or "DiStefano") asserts that Defendant LinkedIn Corporation ("Defendant" or "LinkedIn") infringes DiStefano's U.S. Patent No. 8,768,760 (the "'760 patent"), entitled "Reciprocal Linking Arrangement between Web Pages." (D.I. 11 at 2-3) LinkedIn has filed a motion to dismiss, pursuant to Federal Rule of Civil Procedure 12(b)(6), on the grounds that the '760 patent fails to claim patent-eligible subject matter under 35 U.S.C. § 101. (D.I. 12) The parties submitted briefing (D.I. 13, 16, 18) and the Court heard oral argument on July 31, 2018 (*see* D.I. 25) ("Tr."). For the reasons stated below, the Court will grant LinkedIn's motion to dismiss.

I. BACKGROUND

There '760 patent relates to "developing web pages through the use of a graphical user interface." '760 Pat. at 1:25-26. Specifically, the patent describes a method of creating a reciprocal arrangement between two websites in order to market the first website at the second website. *See id.* at 3:12-28.

DiStefano contends LinkedIn infringes claims 1, 4, 5, 8, and 10 of the '760 patent. (D.I. 11 at 4)[1] Independent claim 1 recites:

---

[1]In its motion to dismiss, LinkedIn asserts that "there is no meaningful difference between the asserted claims and unasserted claims for purposes of invalidity under Section 101" and, therefore, requests the Court hold all claims invalid. (*See* D.I. 13 at 3 n.1) DiStefano responds that the unasserted claims are not part of this action and further, the asserted claims are directed to a method, whereas the unasserted claims are directed to a computer hardware system. (D.I. 16 at 7 n.1) The Court agrees with DiStefano that the unasserted claims are not a part of this action and thus, the Court's analysis is limited to the asserted claims. *See Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1193 (Fed. Cir. 2014) ("The scope of any judgment should conform to the issues that were actually litigated."); *see also Uniloc USA, Inc. v. ADP, LLC*, 279 F. Supp. 3d 736, 741 (E.D. Tex. 2017) (declining to consider invalidity of unasserted claims).

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> **1.** A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:
>
> > receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement;
> >
> > receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement;
> >
> > establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement based upon both the first and second users opting to participate in the reciprocal linking arrangement;
> >
> > including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first entity; and
> >
> > including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second entity, wherein
> >
> > the second functional identification element includes a link to the first web page, and
> >
> > the first functional identification element includes a link to the second web page.

The remaining asserted claims all depend from claim 1. During oral argument, the parties agreed that claim 1 is representative. (*See* Tr. at 4 ("[C]laim 1 is representative."), 50 ("[T]his case could rise or fall on claim 1 as to the asserted claims."))[2]

[2]"The asserted dependent claims – 4, 5, 8, and 10 – add the following limitations: (4) a third party requesting the first web page and having the web page provided to it; (5) the 'first web page' including 'one or more web pages'; (8) providing the first user a plurality of recommended web pages; and (10) the 'second functional identification element' including an 'image.'" (D.I. 13 at 3)

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II. LEGAL STANDARDS

A. Rule 12(b)(6) Motion to Dismiss

Evaluating a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) requires the Court to accept as true all material allegations of the complaint. *See Spruill v. Gillis*, 372 F.3d 218, 223 (3d Cir. 2004). "The issue is not whether a plaintiff will ultimately prevail but whether the claimant is entitled to offer evidence to support the claims." *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1420 (3d Cir. 1997) (internal quotation marks omitted). Thus, the Court may grant such a motion to dismiss only if, after "accepting all well-pleaded allegations in the complaint as true, and viewing them in the light most favorable to plaintiff, plaintiff is not entitled to relief." *Maio v. Aetna, Inc.*, 221 F.3d 472, 481-82 (3d Cir. 2000) (internal quotation marks omitted).

A well-pleaded complaint must contain more than mere labels and conclusions. *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). A plaintiff must plead facts sufficient to show that a claim has substantive plausibility. *See Johnson v. City of Shelby*, 135 S. Ct. 346, 347 (2014). A complaint may not be dismissed, however, for imperfect statements of the legal theory supporting the claim asserted. *See id.* at 346.

"To survive a motion to dismiss, a civil plaintiff must allege facts that 'raise a right to relief above the speculative level on the assumption that the allegations in the complaint are true (even if doubtful in fact).'" *Victaulic Co. v. Tieman*, 499 F.3d 227, 234 (3d Cir. 2007) (quoting *Twombly*, 550 U.S. at 555). A claim is facially plausible "when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the

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misconduct alleged." *Iqbal*, 556 U.S. at 678. At bottom, "[t]he complaint must state enough facts to raise a reasonable expectation that discovery will reveal evidence of [each] necessary element" of a plaintiff's claim. *Wilkerson v. New Media Tech. Charter Sch. Inc.*, 522 F.3d 315, 321 (3d Cir. 2008) (internal quotation marks omitted).

The Court is not obligated to accept as true "bald assertions," *Morse v. Lower Merion Sch. Dist.*, 132 F.3d 902, 906 (3d Cir. 1997) (internal quotation marks omitted), "unsupported conclusions and unwarranted inferences," *Schuylkill Energy Res., Inc. v. Pa. Power & Light Co.*, 113 F.3d 405, 417 (3d Cir. 1997), or allegations that are "self-evidently false," *Nami v. Fauver*, 82 F.3d 63, 69 (3d Cir. 1996).

B. Patentable Subject Matter

Under 35 U.S.C. § 101, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." There are three exceptions to § 101's broad patent-eligibility principles: "laws of nature, physical phenomena, and abstract ideas." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). "Whether a claim recites patent eligible subject matter is a question of law which may contain disputes over underlying facts." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), the Supreme Court set out a two-step "framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). First, courts must determine if the claims at issue are directed to a patent-ineligible concept ("step

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one"). *See id.* If so, the next step is to look for an "'inventive concept' – i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself" ("step two"). *Id.* The two steps are "plainly related" and "involve overlapping scrutiny of the content of the claims." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016).

At step one, "the claims are considered in their entirety to ascertain whether their character ***as a whole*** is directed to excluded subject matter." *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015) (emphasis added); *see also Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) ("*Affinity Labs I*") (stating first step "calls upon us to look at the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter").

In conducting the step one analysis, courts should not "oversimplif[y]" key inventive concepts or "downplay" an invention's benefits. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337-38 (Fed. Cir. 2016); *see also McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) ("[C]ourts 'must be careful to avoid oversimplifying the claims' by looking at them generally and failing to account for the specific requirements of the claims.") (quoting *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)).

At step two, courts must "look to both the claim as a whole and the individual claim elements to determine whether the claims contain an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself." *McRo*, 837 F.3d at 1312 (internal brackets and quotation marks omitted). The "standard" step two inquiry includes consideration of whether claim elements

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"simply recite 'well-understood, routine, conventional activit[ies].'" *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016) (quoting *Alice*, 134 S. Ct. at 2359). "Simply appending conventional steps, specified at a high level of generality, [is] not ***enough*** to supply an inventive concept." *Alice*, 134 S. Ct. at 2357 (internal quotation marks omitted; emphasis in original).

However, "[t]he inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art." *Bascom*, 827 F.3d at 1350. In *Bascom*, the Federal Circuit held that "the limitations of the claims, taken individually, recite generic computer, network and Internet components, none of which is inventive by itself," but nonetheless determined that an ***ordered combination*** of these limitations was patent-eligible under step two. *Id.* at 1349.

The Federal Circuit recently elaborated on the step two standard, stating that "[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact. Any fact, such as this one, that is pertinent to the invalidity conclusion must be proven by clear and convincing evidence." *Berkheimer*, 881 F.3d at 1368; *see also Aatrix*, 882 F.3d at 1128 ("While the ultimate determination of eligibility under § 101 is a question of law, like many legal questions, there can be subsidiary fact questions which must be resolved en route to the ultimate legal determination."); *Automated Tracking*, 2018 WL 935455, at *5 ("We have held that 'whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.'") (quoting *Berkheimer*, 881 F.3d at 1368).

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"Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional." *Berkheimer*, 881 F.3d at 1369; *see also Exergen*, 2018 WL 1193529, at *4 ("Something is not well-understood, routine, and conventional merely because it is disclosed in a prior art reference. There are many obscure references that nonetheless qualify as prior art."). Still, "[w]hen there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, [and] conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law." *Id.*

As part of the step two "inventive concept" inquiry, the Federal Circuit has looked to the claims as well as the specification. *See Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) ("*Affinity Labs II*") ("[N]either the claim nor the specification reveals any concrete way of employing a customized user interface."). Still, it is not enough just to disclose the improvement in the specification; instead, the Court's task becomes to "analyze the asserted claims and determine whether they ***capture these improvements***." *Berkheimer*, 881 F.3d at 1369 (emphasis added). In other words, "[t]o save a patent at step two, an inventive concept must be ***evident in the claims***." *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (emphasis added); *see also Alice*, 134 S. Ct. at 2357 ("[W]e must examine the ***elements of the claim*** to determine whether it contains an 'inventive concept.'") (emphasis added); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016) ("The § 101 inquiry must focus on the language of the Asserted Claims themselves.").

At both steps one and two, it is often useful for the Court to compare the claims at issue

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with claims that have been considered in the now considerably large body of decisions applying § 101. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

Finally, as a procedural matter, the Federal Circuit has observed frequently that § 101 disputes may be amenable to resolution on motions for judgment on the pleadings, motions to dismiss, or summary judgment. *See, e.g.*, *Berkheimer*, 881 F.3d at 1368 ("Whether a claim recites patent eligible subject matter is a question of law which may contain disputes over underlying facts. Patent eligibility has in many cases been ***resolved on motions to dismiss or summary judgment. Nothing in this decision should be viewed as casting doubt on the propriety of those cases.*** When there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.") (emphasis added); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1351-52 (Fed. Cir. 2014) (affirming grant of Rule 12(c) motion for judgment on pleadings for lack of patentable subject matter); *Intellectual Ventures I LLC v. Symantec Corp.*, 2018 WL 1324863, at *1 n.1 (Fed. Cir. Mar. 15, 2018) (affirming grant of summary judgment of patent ineligibility and stating *Berkheimer* "does not compel a different conclusion").

III. DISCUSSION

LinkedIn contends that the claims of the '760 patent are ineligible under § 101 because they are directed to the abstract idea of facilitating cross-marketing relationships and fail to add any inventive concept, even when considered as an ordered combination. (*See* D.I. 13 at 5; *see also* Tr. at 15-16) DiStefano responds that the patent recites non-abstract, particularized methods of web design and hosting that improve "an already computerized field of web page

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development," making web development "easier for everyone," including those with and without technical knowledge. (Tr. at 26-28) DiStefano further contends that the ordered combination of the claim elements recites an inventive concept. (*See* D.I. 16 at 1, 7, 13-14) The Court addresses each argument in turn.

A. Step One

At step one of the *Alice/Mayo* test, the question is whether the asserted claims are directed to a patent-ineligible concept. "[A]ll inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 132 S. Ct. at 1293. Thus, "an invention is not rendered ineligible for patent simply because it involves" a patent-ineligible concept. *Alice*, 134 S. Ct. at 2354. "Indeed, to preclude the patenting of an invention simply because it touches on something natural would 'eviscerate patent law.'" *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed Cir. 2016) (quoting *Mayo*, 132 S. Ct. at 1293). "At step one, therefore, it is not enough to merely identify a patent-ineligible concept underlying the claim; we must determine whether that patent-ineligible concept is what the claim is 'directed to.'" *Id.*

Here, the Court agrees with LinkedIn that the asserted claims of the '760 patent are directed to the abstract idea of facilitating cross-marketing relationships. In broad terms, the method of claim 1 comprises two users on two computers opting into a reciprocal linking arrangement and then, through use of a computer database, establishing the reciprocal linking arrangements between the two users such that a link to the first page appears on the second and a link to the second page appears on the first. *See* '760 pat. at cl. 1. As LinkedIn explains, this method "is not essentially different from reciprocal marketing relationships formed between two

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brick and mortar stores selling complementary products." (D.I. 13 at 6) Rather than improving any technical problem in the prior art, the patent "relate[s] to . . . marketing problems or dealing with the hassle of matchmaking." (Tr. at 12; *see also* '760 Pat. at 4:20-25 ("The present invention further relates to an internet-based system for assisting a website designer . . . in order to market the first website at the second website."); Tr. at 18 ("[I]t may be difficult for novice web designers to arrange those relationships; but those aren't technical problems, those are marketing problems."); *id.* at 19 ("[A]voiding the hassle of having to interact with the web designer also is not a technical problem."))

DiStefano contends that LinkedIn oversimplifies the invention because the claims teach "transport[ing] the user instantly to the linked website," an invention not (at least yet) realistic in the real-world because the third-party agent would have to "port the physical storefronts . . . ***into*** its own establishment." (D.I. 16 at 8-9) But simply because the invention has no direct physical corollary does not render the claims patent-eligible, as DiStefano acknowledges. (Tr. at 30-31)[3]

In *Alice*, the Supreme Court found claims directed to a method of "facilitat[ing] the exchange of financial obligations between two parties by using a computer system as a third-party intermediary" unpatentable. *Alice*, 134 S. Ct. at 2352; *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (finding patent claims directed to contractual relationship for "a fundamental economic practice long prevalent in our system of commerce"). The claims at issue here similarly recite a method of facilitating relationships between two parties through a computer system intermediary. This common marketing tactic does not become patent-eligible simply

[3]Moreover, there ***is*** a corollary to the '760 patent in the physical world: seeing an advertisement at one storefront for a second storefront and then visiting the second storefront via any mode of transportation (albeit not instantly).

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through computer implementation. *See Alice*, 134 S. Ct. at 2357 ("[M]erely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention."); *see also buySAFE*, 765 F.3d at 1355 ("The claims are squarely about creating a contractual relationship [and their] invocation of computers adds no inventive concept."); *VideoShare, LLC v. Google, Inc.*, 2016 WL 4137524, at *6 (D. Del. Aug. 2, 2016), aff'd, 695 F. App'x 577 (Fed. Cir. 2017) ("[C]laims overcom[ing] the burden of manually posting a link associated with a video to a web page by automating this process [are directed to an abstract idea because they] are not directed to an improvement in computer functionality, and the physical components of the claim merely provide a generic environment for carrying out the abstract idea.").

Accordingly, the Court finds the asserted patent claims abstract under *Alice* step one.[4]

B. Step Two

At step two, the Court looks at "the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Alice*, 134 S. Ct. at 2355; *see also Mayo*, 566 U.S. at 73 (explaining that steps of claim must amount to more than "well-understood, routine, conventional activity"). "To save a patent at step two, an inventive concept must be ***evident in***

[4]LinkedIn submitted a notice of subsequent authority on September 14, pursuant to D. Del. LR 7.2(b), directing the Court to a recent "Final Rejection of certain claims in United States Patent Application No. 13/946,461," which claims priority to the same patent application and inventor as the '760 patent and shares many similarities. (D.I. 26) This is relevant, LinkedIn argues, because claims in this recent application were rejected under 35 U.S.C. § 101. (*Id.*) In response, DiStefano argues that "[t]he cited examiner arguments can be overcome by subsequent arguments or amendments submitted by the applicant, and are not the type of authority properly submitted pursuant to Local Rule 7.1.2(b)." (D.I. 27 at 1-2) The subsequent authority has played no part in the Court's conclusion that the asserted claims of the '760 patent are ineligible under Section 101.

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the claims." *RecogniCorp*, 855 F.3d at 1327 (emphasis added); *Alice*, 134 S.Ct. at 2357 ("[W]e must examine the ***elements of the claim*** to determine whether it contains an 'inventive concept.'") (emphasis added).

Claim 1 is directed to the method of facilitating cross-linking relationships by establishing reciprocal arrangements. Not only does the specification acknowledge that using reciprocal links on web pages was "very common" in the prior art, *see* '760 Pat. at 2:43-49; *see also id.* at 5:52-54 ("[T]he preferred system . . . includes a server computer . . . operably connected to the internet . . . using standard techniques well-known in the art."), but, more importantly, the claims are silent as to any manner in which the improvement actually functions and instead, only claim the desired result. *See* '760 Pat. at cl. 1 (claiming method steps of "receiving . . . a first [or second] indication to opt into a reciprocal linking arrangement," "establishing, within a database . . . the reciprocal linking arrangement" based on the users opting in, and "including . . . a first [or second] functional identification element" within each web page). Nowhere do the claims (or specification) explain how opt-ins are received, how the database works or what type of database is actually used, or how links and identification elements are created or added to the web pages.

Similarly, while the specification recognizes that creating such links in the prior art was "not always easy" and could be difficult without contractual arrangements, *see id.* at 3:49-54, the claims do not explain how the claimed system makes the creation of links any easier. Instead, the claims broadly direct that users opt into using the system and then the system establishes the linking arrangement. These conventional steps of opting into a reciprocal linking arrangement, establishing the reciprocal linking arrangement in a computer database, and including links on the reciprocal web pages, considered alone or as an ordered combination, fail to render the claims

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patent-eligible. *See buySAFE*, 765 F.3d at 1355 (finding claims directed to "familiar commercial arrangements by use of computers and networks" ineligible for patenting).

DiStefano contends a factual dispute exists regarding whether the ordered combination of steps is routine and conventional, but given its multiple concessions during oral argument – including that the method involves all conventional elements present in the prior art and that the claimed method is simply an automation of already-established steps – and its failure to identify any reason to find the ordered combination non-routine, the Court sees no reason to conclude that the method steps, considered alone or in combination, are anything but routine and conventional. (*See* Tr. at 40 ("The patent concedes that all of the individual components, at least those that are at issue here, are conventional components. There is no doubt about that. We don't contest it."); *id.* at 47 ("'[C]reating reciprocal links on web pages' was well known in the prior art."); *id.* at 48 ("[P]rior art processes accomplish the same result."))[5]

Finally, DiStefano contends factual allegations in the First Amended Complaint support the finding of an inventive concept. (*See* Tr. at 36-37; D.I. 16 at 10-11) The First Amended Complaint alleges that the claims of the '760 patent "resolve technical problems related to a streamlined process for developing web pages and posting those web pages on the internet." (D.I. 11 at 3) As addressed earlier, however, the asserted claims do not describe with any detail how to create web pages or create links on a web page, or provide any details surrounding the database associated with the computer hardware system. The remaining relevant allegations in the First Amended Complaint broadly assert that the claims "recite one or more inventive

[5]During oral argument, DiStefano conceded that no claim construction disputes preclude the Court's ruling on LinkedIn's motion. (*See* Tr. at 49-50) ("[T]he real heart of the issue here is not one of claim construction.")

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concepts" and "recite an invention that is not merely routine or conventional [and] does not preempt all ways of . . . establish[ing] reciprocal linking arrangements between web pages." (*Id.*) Each of these allegations, however, merely recites a boilerplate legal conclusion without any supporting facts in the remaining sections of the complaint, in the specification, or in the claims.[6]

IV. CONCLUSION

For the reasons stated above, the Court will grant LinkedIn's motion to dismiss. An order follows.

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[6]While DiStefano faults LinkedIn for failing to separately address preemption (*see* D.I. 16 at 11), Federal Circuit precedent explains that "where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Alice* framework, as they are in this case, preemption concerns are fully addressed and made moot." *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 879 F.3d 1329, 1339 (Fed. Cir. 2017).

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Trials@uspto.gov
571-272-7822

Paper No. 7
Entered: June 5, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LINKEDIN CORPORATION,
Petitioner,

v.

DISTEFANO PATENT TRUST III, LLC,
Patent Owner.

Case IPR2019-00419
Patent 8,768,760 B1

Before GEORGE R. HOSKINS, SCOTT B. HOWARD, and BRENT M. DOUGAL, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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I. INTRODUCTION

LinkedIn Corporation ("Petitioner") has filed a Petition (Paper 2, "Pet.") pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 8,768,760 B1 ("the '760 patent"). DiStefano Patent Trust III, LLC ("Patent Owner") has filed a Preliminary Response (Paper 6, "Prelim. Resp.").

Institution of review requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. 35 U.S.C. § 314(a). Applying that standard on behalf of the Director (37 C.F.R. § 42.4(a)), we do not institute the petitioned review. The Petition presents one ground of unpatentability, which relies on DiStefano '259 (Ex. 1003, U.S. Patent No. 7,996,259 B1, iss. Aug. 9, 2011) as prior art. Pet. 2. The Petition acknowledges the '760 patent asserts priority to the filing date of DiStefano '259 via a series of continuation applications. *Id.* at 3–4. The Petition asserts DiStefano '259 is nonetheless prior art to the '760 patent, because one of the intervening continuation applications lacks written description support for the independent claims of the '760 patent. *Id.* at 12, 16, 20, 30.

We determine the Petition fails to demonstrate that the intervening continuation application lacks written description support for the independent claims of the '760 patent. Therefore, the Petition fails to establish DiStefano '259 is prior art to the '760 patent. We do not reach the other issues raised in the Petition and the Preliminary Response.

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II. BACKGROUND

A. Real Parties in Interest and Related Proceedings

Petitioner identifies itself as the real party-in-interest. Pet. ix. Patent Owner identifies itself as the real party-in-interest. Paper 4, 2.

The parties identify one U.S. District Court litigation as related to this proceeding: *DiStefano Patent Trust III, LLC v. LinkedIn Corporation*, Civil Action No. 1:17-cv-01798 (D. Del.). Pet. ix; Paper 4, 2. In that case, the District Court granted Petitioner's motion to dismiss Patent Owner's Complaint, on the basis that claims 1, 4, 5, 8, and 10 of the '760 patent fail to claim patent-eligible subject matter under 35 U.S.C. § 101. Ex. 1014, pg. 2.[1] That decision is currently on appeal to the Federal Circuit. Pet. ix; Prelim. Resp. 1.

B. The '760 Patent

The '760 patent concerns methods for "creating and posting web pages to the internet," including "a method for more easily developing web pages through the use of a graphical user interface." Ex. 1001, 1:20–26. Figure 1 of the '760 patent is reproduced below:

[1] When citing "pg." numbers of Petitioner's Exhibits, this Decision refers to the pagination added to the bottom of each page by Petitioner.

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FIG. 1

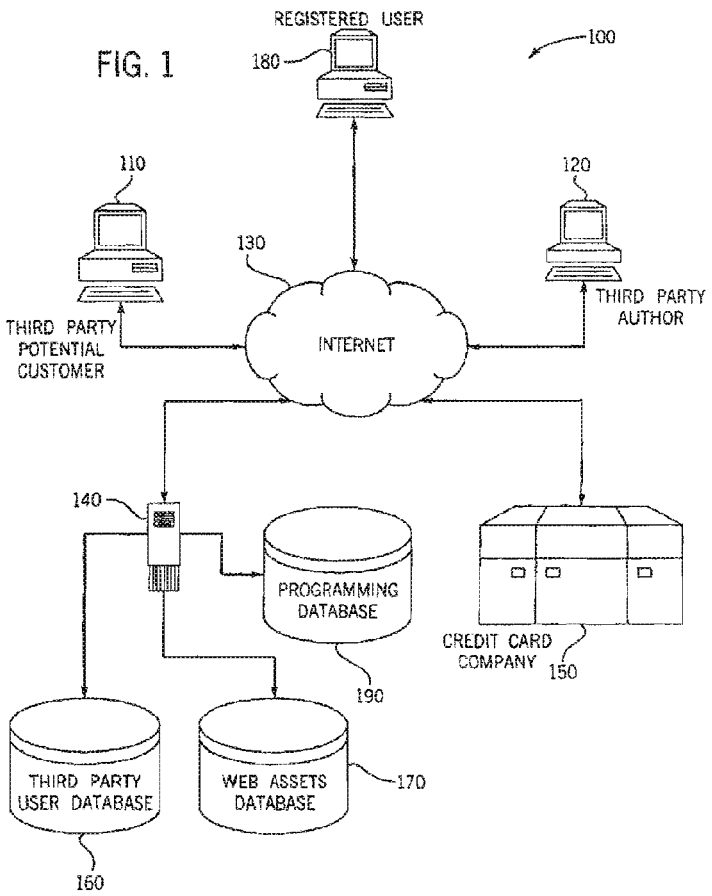


Figure 1 illustrates system 100 for developing a website. *Id.* at 4:43–44, 5:48–52. A user desiring to create a website accessible via the internet 130 uses computer 180 to register with and use server computer 140 for that purpose. *Id.* at 5:61–65, 6:58–64. In particular, server 140 presents a graphical user interface ("GUI") on computer 180, such as the interface shown in Figure 2, "to allow a registered user to easily develop a website comprising one or more web pages." *Id.* at 6:44–46, 6:64–67.

An excerpt from Figure 12 of the '760 patent, reproduced below, illustrates one aspect of the GUI presented on the registered user's computer 180:

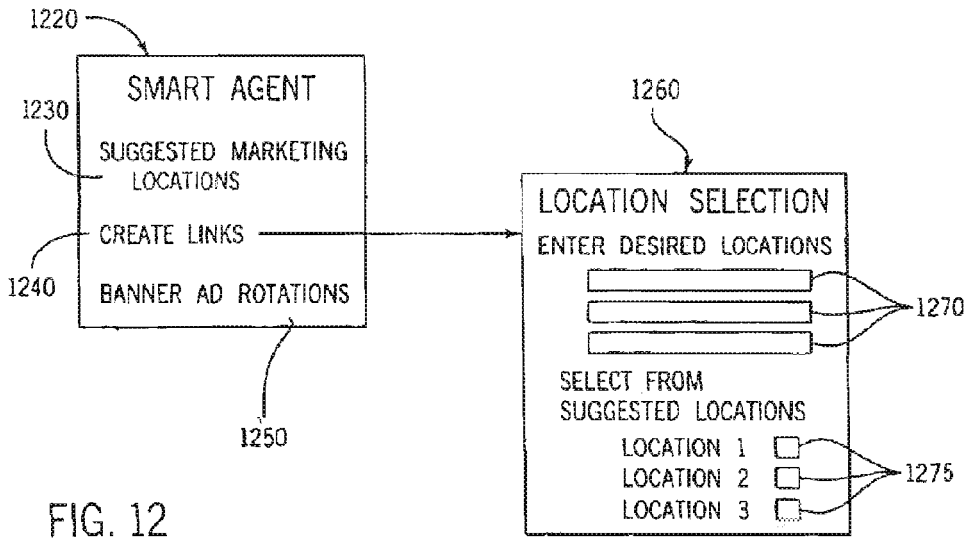


FIG. 12

Figure 12 illustrates how a registered user may access smart agent menu 1220, and select create links option 1240 to access "location selection menu 1260, in which the registered user can identify addresses for *websites to which the registered user desires its website to be linked*." *Id.* at 14:61–65, 15:24–28 (emphasis added). This can be accomplished by the registered user entering the website addresses into open fields 1270, or by the registered user checking selection boxes 1275 corresponding to website addresses that server 140 suggests may be beneficial for linking. *Id.* at 15:28–41; *see also id.* at 14:66–15:23 (describing how server 140 generates selections 1275).

Server 140 creates links to the registered user's website at the websites of other registered users identified by the registered user using location selection menu 1260. *Id.* at 15:41–45, 16:4–18. Thus, "the registered user causes its website to participate in linking . . . display functions with other websites that also were created using the system 100 by registered users who opted to participate in these linking . . . display

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functions." *Id.* at 16:5–10. Further, "each website that is developed by a registered user who opts to participate in the linking functions can display unlimited links to other registered users' websites." *Id.* at 16:15–18. In this way, system 100 "provide[s] special marketing benefits to registered users of the system 100 vis-[à]-vis one another." *Id.* at 14:53–55.

C. The Challenged Claims

The '760 patent contains twenty claims. Ex. 1001, 28:3–30:24. They include two independent claims 1 and 11. *Id.* Claim 1 recites, with lettering [A1]–[C4] being added for further reference in the discussion below:

> 1. A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:
>
> [A1] receiving, from a first computer associated with the first user, a first indication to opt into a reciprocal linking arrangement;
>
> [A2] receiving, from a second computer associated with the second user, a second indication to opt into the reciprocal linking arrangement;
>
> [B] establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement based upon both the first and second users opting to participate in the reciprocal linking arrangement;
>
> [C1] including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first user; and
>
> [C2] including, within the first web page and based upon the reciprocal linking arrangement, a first functional identification element associated with the second user, wherein

> [C3] the second functional identification element includes a link to the first web page, and
>
> [C4] the first functional identification element includes a link to the second web page.

Id. at 28:4–29; *see also id.* at pg. 47 (Certificate of Correction). Claim 11 recites a server system comprising a database and a computer hardware system, in which the hardware system is configured to perform the same steps [A1]–[C4] recited in claim 1. *Id.* at 28:58–29:20, pg. 47.

We refer to limitations [A1]–[A2] as the "Opt In Limitations." We refer to limitation [B] as "the Database Limitation." We refer to limitations [C1]–[C4] as the "Reciprocal Linking Limitations."

D. Asserted Ground of Unpatentability

Petitioner asserts claims 1–20 of the '760 patent are unpatentable under 35 U.S.C. § 103 as having been obvious over DiStefano '259. Pet. 2.

III. ANALYSIS

A. Claim Construction

We interpret the claims of the '760 patent "using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,358 (Oct. 11, 2018) (to be codified at 37 C.F.R. § 42.100(b)).

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1. The Opt In Limitations

The Opt In Limitations of claims 1 and 11 recite receiving "a first indication to opt into a reciprocal linking arrangement" from a first user, and receiving "a second indication to opt into the reciprocal linking arrangement" from a second user. Ex. 1001, 28:8–13 (claim 1), 28:65–29:3 (claim 11).

Petitioner contends the Opt In Limitations require that the two users opt into a "single, common," and "bi-directional," reciprocal linking arrangement. Pet. 13–14. In support, Petitioner contends the term "*the* reciprocal linking arrangement" in the second indication limitation refers back to the reciprocal linking arrangement previously recited in the first indication limitation. *Id.* at 14.

Patent Owner responds that the term "bi-directional" is not found in the claims or in the '760 patent specification, and Petitioner has not explained the significance of interpreting the claims to require a single, common, bi-directional linking arrangement. Prelim. Resp. 8–9, 13. Nonetheless, Patent Owner indicates Petitioner "is correct in asserting that both the claimed 'first indication' and the 'second indication' *refer to the same* 'reciprocal linking arrangement.'" *Id.* at 9–10 (emphasis added) (citing Ex. 1001, 15:24–36, 16:4–10, 24:46–55 (Fig. 20A)).

We concur with the overlap between Petitioner's and Patent Owner's claim constructions, namely, that the Opt In Limitations require the first and second user to opt into the same reciprocal linking arrangement. We also agree with Patent Owner that Petitioner's gloss on that claim construction as representing a single, common, and bi-directional arrangement, does not help to elucidate the meaning of the claim language, and is unsupported by

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citations to the '760 patent specification. *See* Pet. 13–14; Ex. 1009 ¶ 45. Thus, we construe the Opt In Limitations to require that the first and second users opt into the same reciprocal linking arrangement. No further construction is necessary for purposes of the present Decision.

2. The Database Limitation

The Database Limitation of claims 1 and 11 recites "establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement." Ex. 1001, 28:14–17 (claim 1); *id.* at 28:58–64 & 29:4–7 (claim 11).

Petitioner describes this limitation as the "Reciprocal Linking Arrangement Database" limitation, and contends it "means that the claimed database includes, that is, stores, the previously identified 'reciprocal linking arrangement.'" Pet. 14–15 (emphasis omitted). Petitioner concludes the Database Limitation "should be construed as requiring establishing the 'reciprocal linking arrangement' within the database." *Id.* at 15.

Patent Owner responds that "the claim language does not require a specific type of database," but instead "requires a database that is configured to having stored therein information that establishes the reciprocal linking arrangement." Prelim. Resp. 11–12. In Patent Owner's view, "the claims do not necessarily require that the 'reciprocal linking arrangement' itself be stored," but rather "only require[] that information (i.e., in the form of a data structure) that establishes the reciprocal linking arrangement be stored within the database." *Id.* at 12 (citing Ex. 1001, 24:50–55).

Based upon our review of the foregoing, it appears that the principal claim terms in dispute are "establishing" and "arrangement." Specifically,

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what does it mean to require *establishing* a reciprocal linking *arrangement* within a database? Petitioner contends the claims require storing the arrangement within the database. Patent Owner contends the claims are not limited to storing the arrangement *per se*, and instead are open to storing information that establishes the arrangement.

We agree with Patent Owner. We do not discern any support in the claim language for Petitioner's assertion that establishing a linking arrangement within a database requires storing an identification of that arrangement, *per se*. Petitioner, further, does not cite to any disclosures in the '760 patent specification which might support its proposed construction. *See* Pet. 14–15; Ex. 1009 ¶ 46. Patent Owner, by contrast, cites the '760 patent specification's disclosure that "*the marketing location selection information* is stored at third party user database 160," and "[t]his stored information is later *used to generate links at the selected marketing locations (i.e., websites)*." Ex. 1001, 24:50–55 (emphases added). This disclosure supports Patent Owner's assertion that establishing a reciprocal linking arrangement within a database occurs, as claimed, when information is stored within the database that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement.

3. The Reciprocal Linking Limitations

The Reciprocal Linking Limitations of claims 1 and 11 recite "including, within the second web page and based upon the reciprocal linking arrangement, a second functional identification element associated with the first user," "wherein the second functional identification element includes a link to the first web page." Ex. 1001, 28:18–29 (claim 1), 29:8–

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19 (claim 11), pg. 47. The Reciprocal Linking Limitations similarly recite that the first web page includes a first functional identification element comprising a link to the second web page, based upon the reciprocal linking arrangement. *Id.*

Petitioner contends the Reciprocal Linking Limitations "explicitly require[] two web pages, each associated with a separate user, wherein each of the two web pages includes a hyperlink to the other web page." Pet. 15. Petitioner then reiterates that "[t]his language explicitly requires that the first web page includes a link to the second web page, and further that the second web page includes a link to the first web page." *Id.*

Patent Owner responds that Petitioner's proposed construction "accurately characterizes a portion of the claim language," but it "omits that the links are included within the web pages *based upon the reciprocal linking arrangement.*" Prelim. Resp. 13–14 (emphases in original). Patent Owner contends "the concept of *two web pages, each linking to the other*, can be described as 'reciprocal links.'" *Id.* at 14 (emphasis added) (citing Ex. 1001, 15:41–45, 24:53–62); *see also id.* at 28–29 (discussing dictionary definitions of the term "reciprocal").

We concur with the overlap between Petitioner's and Patent Owner's claim constructions, namely, that the Reciprocal Linking Limitations require that the first and second web pages each include a link to the other of the first and second web pages. In this way, these respective links effectuate the "reciprocal linking arrangement" specified in the claims.

Petitioner additionally proposes that the two web pages are "each associated with a separate user." Pet. 15. However, Petitioner does not rely on this proposed claim requirement as a basis to conclude that the parent

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application(s) to the '760 patent lack written description support for the Reciprocal Linking Limitations. *Id.* at 28–29. Therefore, we need not reach this particular claim construction issue in the present Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (per curiam) (claim terms need to be construed "only to the extent necessary to resolve the controversy" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Thus, we construe the Reciprocal Linking Limitations to require that the first and second web pages each include a link to the other of the first and second web pages.

4. Remaining Claim Terms

No further explicit construction of any claim term is provided by the parties, and we determine no further explicit constructions are needed to resolve the issues presented by the arguments and evidence of record. *See Nidec*, 868 F.3d at 1017.

B. Priority Date of the '760 Patent

The parties dispute whether the '760 patent is entitled to priority to the filing date of DiStefano '259, via a chain of intervening continuation applications. Pet. 16–29; Prelim. Resp. 5–15, 20–37. In addressing this dispute, we first identify the chain of parent continuation applications at issue, then we provide an overview of the dispute, next we summarize the applicable law, then we consider the level of ordinary skill in the art, and finally we address the subject matter of the '760 patent claims at issue.

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1. Parent Continuation Applications to the '760 Patent

The '760 patent issued from U.S. Patent Application No. 14/191,746, filed on February 27, 2014 ("the 2014 Application"). Ex. 1001, at [21]–[22]. The 2014 Application was a continuation of U.S. Patent Application No. 13/763,128, filed on February 8, 2013 ("the 2013 Application"). *Id.* at [63]. The 2013 Application was a continuation of U.S. Patent Application No. 13/669,027, filed on November 5, 2012 ("the 2012 Application"). *Id.* The 2012 Application was a continuation of U.S. Patent Application No. 13/206,483, filed on August 9, 2011 ("the 2011 Application"). *Id.* The 2011 Application was a continuation of U.S. Patent Application No. 09/589,551, filed on June 7, 2000 ("the 2000 Application"). *Id.* The 2000 Application issued as DiStefano '259. *Id.*; Ex. 1003, at [10], [21].

2. Overview of the Priority Dispute

The Petition is premised upon the assertion that the 2011 Application fails to provide written description support for the '760 patent claims. *See* Pet. 12, 16–17, 20–29, 30. If that assertion is accurate, then the continuity chain linking the '760 patent back to the filing date of the 2000 Application is broken at the 2012 Application, which was never co-pending the 2000 Application. *See id.* at 16, 20, 30. In that circumstance, the '760 patent is entitled to, at the earliest,[2] the 2012 Application's filing date

[2] Petitioner suggests the actual priority date is later: February 27, 2014, which is the actual filing date of the 2014 Application. *See* Pet. 16 & n.2, 17 n.4, 21 & n.6. However, that contention is not supported by citation to, or any meaningful discussion of, the disclosures of the parent applications intervening between the 2011 Application and the 2014 Application. *See id.* Thus, we focus our attention on the 2011 Application disclosure, and do not address the 2012 or 2013 Application disclosures.

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of November 5, 2012 (Ex. 1001, at [63]), which is more than one year after the issuance of DiStefano '259 on August 9, 2011 (Ex. 1003, at [45]). *See* Pet. 16, 20, 30. Therefore, in that circumstance, DiStefano '259 is prior art to the '760 patent. *See id.*

Patent Owner misconstrues the Petition as relying on a lack of written description support in the 2000 Application, which issued as DiStefano '259, rather than the 2011 Application. *See, e.g.*, Prelim. Resp. 25 ("LinkedIn's argument is that the specification of the '259 Patent does not provide written descriptive support"); *id.* at 22 n.15 ("LinkedIn has not separately asserted that the other applications in the chain of priority fail to satisfy the written description requirement."). As a result, Patent Owner generally cites to the disclosures of the '760 patent and DiStefano '259 when opposing Petitioner's written description arguments. *See, e.g.*, *id.* at 5–6, 20, 25. For clarity and consistency, in this Decision, we re-cast the '760 patent and DiStefano '259 citations in the Preliminary Response to refer, instead, to the corresponding disclosures of the 2011 Application.

Petitioner contends the 2011 Application fails to provide written description support for each of the Opt In Limitations, the Database Limitation, and the Reciprocal Linking Limitations. *See* Pet. 20–29. Patent Owner disputes each contention. *See* Prelim. Resp. 5–15, 26–37.

3. Pertinent Legal Standards for Establishing Priority

Pursuant to 35 U.S.C. § 120, the '760 patent is entitled to assert priority to the filing date of the 2011 Application only if the 2011 Application discloses the invention claimed in the '760 patent in the

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manner provided by 35 U.S.C. § 112(a).[3] The test for sufficiency of a written description under 35 U.S.C. § 112(a) is whether the earlier application's disclosure "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The written description "test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Id.*

4. Level of Ordinary Skill in the Art

Neither the Petition nor the Preliminary Response addresses the level of ordinary skill in the art pertaining to the '760 patent. However, Petitioner's declarant, Dr. Loren G. Terveen, does address this issue. *See* Ex. 1009 ¶¶ 33–35. We have applied Dr. Terveen's understanding of the level of ordinary skill in the art in reaching the present Decision.

5. The Opt In Limitations

The Opt In Limitations of claims 1 and 11 recite receiving "a first indication to opt into a reciprocal linking arrangement" from a first user, and

[3] We cite to the post-AIA version of § 112, because the 2014 Application (which issued as the '760 patent) was filed on February 27, 2014, after the AIA amendments to § 112 took effect on September 16, 2012. *See* Leahy-Smith America Invents Act ("the AIA"), Pub. L. No. 112-29, § 4(e), 125 Stat. 284, 297 (2011) (amendments to § 112 "shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and *shall apply to any patent application that is filed on or after that effective date*") (emphasis added). However, our Decision is not affected by the changes to § 112 enacted via the AIA; we would reach the same result applying either the pre-AIA version or the post-AIA version.

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receiving "a second indication to opt into the reciprocal linking arrangement" from a second user. Ex. 1001, 28:8–13, 28:65–29:3. We have construed these limitations to require that the first and second users opt into the same reciprocal linking arrangement. *See supra* Section III.A.1. Petitioner focuses on two phrases in the Opt In Limitations: "indication to opt into" and "reciprocal linking arrangement." Pet. 21.

Regarding the "indication to opt into" phrase, Petitioner argues "the only disclosure of a user 'opt[ing] into' anything" in the 2011 Application "falls short of disclosing the claimed subject matter," because "[i]t does not describe how a first user is supposed to '***opt into***' a reciprocal linking arrangement with a particular second user." *Id.* at 22–24 (emphases in original) (citing Ex. 1005, pg. 69 (lines 5–21)); Ex. 1009 ¶¶ 53–54. Petitioner asserts the 2011 Application, instead, "merely recites that users may '***opt[] to participate***' in the linking . . . display functions." Pet. 24 (emphasis in original). This is insufficient, in Petitioner's view, because it does not "describe how a user '***opts into***' a particular arrangement with another user," or "how the system '***receive[s] an indication***' from a first or, more importantly, a second user '***to opt into***' that particular arrangement." *Id.*

Regarding the "reciprocal linking arrangement" phrase, Petitioner argues: "Although the 2011 Application refers to a '***reciprocal link site***,' the description thereof is in a significantly different context than the . . . '***reciprocal linking arrangement***'" recited in the '760 patent claims. Pet. 22 (citing Ex. 1005, pg. 26 (Fig. 20), pg. 86 (lines 12–24)); Ex. 1009 ¶¶ 52, 54. Petitioner's view is that the "reciprocal link site" of the 2011 Application "indicate[s] a location on one website where other websites will be

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marketed," whereas the reciprocal linking arrangement of the '760 patent claims concerns "the existence of, or establishing, a two-way linking relationship between two such sites." *Id.*

Patent Owner contends the 2011 Application demonstrates possession of the Opt In Limitations by describing how registered users may select create links options 1240 to access location selection menu 1260. Prelim. Resp. 9–10, 31, 33–35 (citing Ex. 1005, pg. 26 (Fig. 20, steps 2018–2022), pgs. 67 (line 20) – 68 (line 10), pg. 69 (lines 5–21), pg. 86 (lines 12–19)). Patent Owner asserts location selection menu 1260 allows a registered user to create links within the websites of other registered users, wherein such links lead to the registered user's own website. *Id.* Further according to Patent Owner, "the other registered users can also identify websites to which these other registered users would like [their websites] to be linked." *Id.* at 10, 31 (citing Ex. 1005, pg. 69 (lines 5–9)). Patent Owner's view is that "[t]he identification of a particular website, by a registered user, is an example of an indication to opt into a reciprocal linking arrangement" with the other registered user of the other website, as claimed. *Id.* at 10–11, 31, 34–35.

We agree with Patent Owner that the 2011 Application demonstrates possession of receiving a first indication to opt into a reciprocal linking arrangement from a first user, and receiving a second indication to opt into the same reciprocal linking arrangement from a second user. An excerpt from Figure 12 of the 2011 Application, which is identical to Figure 12 of the '760 patent, is reproduced below:

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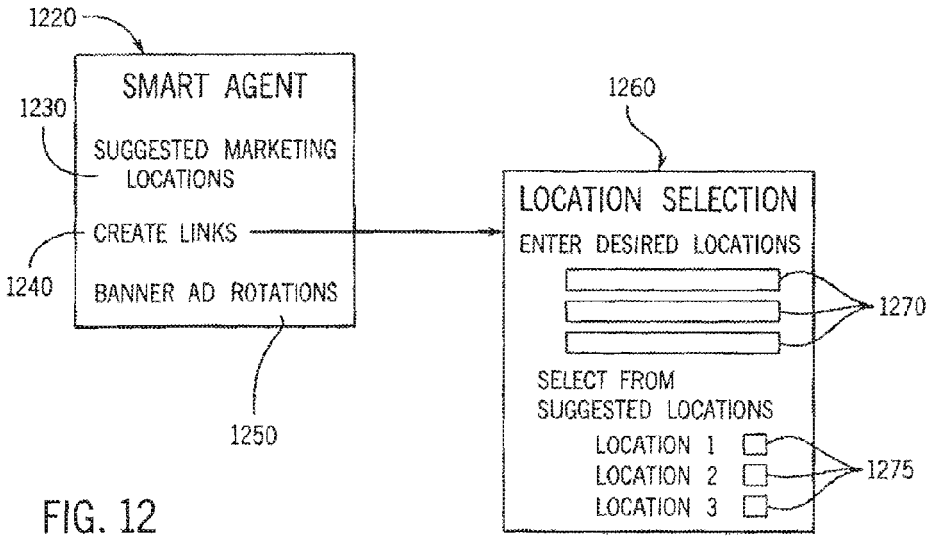


FIG. 12

Ex. 1005, pg. 18. Figure 12 illustrates how a registered user may access smart agent menu 1220, and select create links option 1240 to access location selection menu 1260. *Id.* at pg. 66 (lines 21–26), pg. 67 (lines 20–21). In the following discussion of the 2011 Application disclosure concerning this process, we will refer to a "new" user and to "preexisting" users.

The "new" user is the registered user who is selecting, for the first time, create links option 1240 to access location selection menu 1260, in order to "identify addresses for websites to which the [new] registered user desires its website to be linked." *Id.* at pg. 67 (lines 20–23). The "preexisting" users are the registered users who have, previously to the new user, completed the process of location selection menu 1260. *See id.* at pg. 67 (lines 23–25) ("the websites can be selected from among the websites that have been created by *other registered users* using system 100" (emphasis added)). In this way, each "new" registered user becomes a "preexisting" registered user once the new registered user completes the

process of location selection menu 1260. Pursuant to that process, the new user selects the websites of preexisting users which the new user would like to contain links to the new user's website in order to market the new user's website, and system 100 creates those links. *Id.* at pgs. 67 (line 1) – 68 (line 10).

The 2011 Application expressly describes the process of location selection menu 1260 as the new user *causing* the new user's website to participate in linking functions with the websites of preexisting users who *opted to participate* in the linking functions. *Id.* at pg. 69 (lines 5–9) ("By completing the[] steps relating to the create links option 1240 . . . , the [new] registered user *causes its website to participate in linking . . . functions* with other websites that also were created using the system 100 by [preexisting] registered users who *opted to participate in these linking . . . functions*." (emphases added)). Further according to the 2011 Application, "each website that is developed by a [new] registered user who *opts to participate in the linking functions* can display unlimited links to other registered users' websites." *Id.* at pg. 69 (lines 14–16) (emphasis added). From these disclosures, a person of ordinary skill in the art would understand that the 2011 Application demonstrates possession of each new user opting into participation in the linking functions with preexisting users, and demonstrating that option by completing the process of location selection menu 1260, just like the preexisting users did prior to the new user.

Further, we determine that the optional linking functions provided by system 100 of the 2011 Application correspond to "a reciprocal linking arrangement" as recited in the '760 patent claims. The 2011 Application describes the linking functions as a feature that "provide[s] special

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marketing benefits to *registered users* of the system 100 *vis-[à]-vis one another*."[4] *Id.* at pg. 66 (lines 14–26) (emphases added). In particular, as each new user opts into the linking functions of system 100, the new user's website is modified to include "a *reciprocal* link site . . . for displaying links to other websites." *Id.* at pg. 86 (lines 12–24) (emphasis added). From these disclosures, and the other disclosures discussed above, a person of ordinary skill in the art would understand that the linking functions of system 100 in the 2011 Application represent a *quid pro quo* between the various users who opt into the linking functions. Each new user is granted the authority to modify the websites of preexisting users to include a link to the new user's website, so long as the new user is willing to have its own website contain links to the websites of other registered users opting into the linking function. In this way, the linking functions described in the 2011 Application correspond to a reciprocal linking arrangement.

Petitioner's declarant, Dr. Terveen, reaches a contrary conclusion. Dr. Terveen testifies that the 2011 Application merely discloses "a *general willingness* to participate in linking services with an unknown and undefined

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[4] Another aspect of the special marketing benefits is implemented by choosing banner ad rotations option 1250 in smart agent menu 1220. Ex. 1005, pg. 66 (lines 14–26), pgs. 68 (line 11) – 69 (line 4). Petitioner and Patent Owner both discuss this feature in their arguments. However, we conclude this feature is not particularly pertinent to the '760 patent claims, because there is no indication that the banner ads include *links*, which are specifically required by the '760 patent claims. *See id.* at pgs. 39 (line 24) – 40 (line 10) (differentiating between "banner ads" and "links"), pg. 52 (lines 20–25) (describing banner ads), pg. 59 (lines 8–22) (describing design of banner ads). We appreciate that a banner ad may include a link to the advertised website, but that is not necessarily so, and the 2011 Application does not suggest that its banner ads in fact include a link. *See id.*

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set of other (currently existing as well as yet-to-be-designed) sites, but does not disclose the existence of, or establishing, a two-way linking relationship between two such sites." Ex. 1009 ¶¶ 52, 54 (emphasis in original). This testimony is not persuasive. It equates the claimed "reciprocal linking arrangement" to "a two-way linking relationship between two" websites. *Id.* However, the Opt In Limitations merely require that the first and second users opt into the same reciprocal linking arrangement. *See supra* Section III.A.1. That occurs in the 2011 Application each time a new user completes the process of location selection menu 1260, and thereby opts into participating in the reciprocal linking functions of system 100 with other such users.

For the foregoing reasons, we determine the 2011 Application demonstrates possession of receiving a first indication to opt into a reciprocal linking arrangement from a first user, and receiving a second indication to opt into the same reciprocal linking arrangement from a second user.

6. The Database Limitation

The Database Limitation of claims 1 and 11 recites "establishing, within a database associated with the computer hardware system, the reciprocal linking arrangement." Ex. 1001, 28:14–17, 28:58–64, 29:4–7. We have construed this limitation to require storing information within the database that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement. *See supra* Section III.A.2.

Petitioner contends the 2011 Application "does not disclose the claimed database for storing information regarding a particular 'reciprocal

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linking arrangement' . . . into which two separate [users] have each opted." Pet. 25–26 (discussing Ex. 1005, pg. 42 (lines 5–9), pg. 43 (lines 12–16)); Ex. 1009 ¶¶ 55–56. According to Petitioner, the 2011 Application's third party user database 160 does not "contain[] information about particular 'reciprocal linking arrangements' that have been 'opted into' by two different users." *Id.* at 26–27 (citing Ex. 1005, pg. 49 (lines 9–20), pg. 17 (Fig. 11, "LOGIN" menu 1150)); Ex. 1009 ¶¶ 56–58.

Patent Owner contends the 2011 Application "explain[s] that, '[u]pon receiving the [website] selection information, the [website] selection information is stored at . . . database 160 [and t]his stored information is later used to generate links at the selected [websites]." Prelim. Resp. 12, 35–36 (paraphrasing Ex. 1005, pg. 86 (lines 15–19)). Patent Owner asserts "[t]he storage of this information is an example of establishing the reciprocal linking arrangement within a database." *Id.* at 12, 36–37 (citing Ex. 1005, pgs. 67 (line 20) – 68 (line 10)).

We agree with Patent Owner that the 2011 Application demonstrates possession of storing information within third party database 160 that is sufficient to generate links within first and second web pages to effectuate the reciprocal linking arrangement. According to the 2011 Application, third party user database 160 stores "the marketing location selection information" entered by each new user opting into the linking functions provided by system 100 using location selection menu 1260. Ex. 1005, pg. 86 (lines 12–17). This marketing location selection information includes the website addresses of preexisting users that the new user desires to include a link to the new user's website. *Id.* at pg. 86 (lines 12–17), pg. 67 (lines 20–25). After the new user has completed the process of location

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selection menu 1260, server 140 uses the marketing location selection information "to *generate links at the selected marketing locations (i.e., websites)*" of the preexisting users. *Id.* at pg. 86 (lines 17–19) (emphasis added). From these disclosures, a person of ordinary skill in the art would understand that the marketing location selection information is sufficient to generate a link within each of the preexisting user's websites leading to the new user's website.

As discussed above, the process of location selection menu 1260 is completed by each new user who opts into the linking functions provided by system 100 of the 2011 Application. In this way, over time, the marketing location selection information stored within third party user database 160 is used to generate links within first and second web pages to effectuate the reciprocal linking arrangement.

Petitioner contends the District Court opinion (Exhibit 1014), holding that claim 1 of the '760 patent fails to claim patent-eligible subject matter under 35 U.S.C. § 101, supports a contrary view. *See* Pet. 27 (citing Ex. 1014, pg. 13); Ex. 1014, pgs. 2, 13. We disagree. Patent eligibility under § 101 and written description under § 112 are different issues, requiring different analyses. The District Court's analysis establishes, at the most, that the specification and claims of the '760 patent describe and define the claimed invention only at a high level of abstraction, amounting to no more than well-understood, routine, and convention activity, without containing an inventive concept. Ex. 1014, pgs. 13–14. Even if that is true, the '760 patent specification (or the equivalent parent 2011 Application disclosure) may still demonstrate possession of the claimed invention, as abstract or as broad as the claimed invention may be.

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For the foregoing reasons, we determine the 2011 Application demonstrates possession of establishing the reciprocal linking arrangement within a database, namely, third party user database 160.

7. The Reciprocal Linking Limitations

The Reciprocal Linking Limitations of claims 1 and 11 require first and second web pages that each include a link to the other of the first and second web pages. *See supra* Section III.A.3.

Petitioner contends the 2011 Application fails to disclose "two web pages . . . wherein each page provides a hyperlink to the other." Pet. 28; Ex. 1009 ¶ 59. According to Petitioner, the 2011 Application instead discloses only "a system that creates a web site of links . . . that essentially serve as one-directional links," via "reciprocal link ***sites***." Pet. 28 (emphasis in original) (citing Ex. 1005, pg. 86 (lines 12–24)); Ex. 1009 ¶ 59. In Petitioner's view, "nothing in the 2011 Application discloses actually requiring *links back to* the specific webpage hosting the reciprocal link site." *Id.* at 28–29 (emphasis added) (citing Ex. 1005, pgs. 87 (line 23) – 88 (line 2)); Ex. 1009 ¶¶ 59–60.

Patent Owner contends the 2011 Application "disclose[s] that 'the system determines whether a reciprocal link site has already been created in the registered user's website, for displaying links to other websites . . . [, and i]f a link site has not yet been created, the system creates a link site on the registered user's website.'" Prelim. Resp. 14 (emphasis in original) (paraphrasing Ex. 1005, pg. 86 (lines 20–24)). In Patent Owner's view, this description of "a *reciprocal link* site . . . provide[s] support for the concept of two webpages, each linking to the other." *Id.* at 14, 28–29.

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Patent Owner also cites the 2011 Application's disclosure that "[o]nce the registered user has selected its desired [websites], the system 100 has sufficient information to create links to the registered user's website at other websites." *Id.* at 14 (paraphrasing Ex. 1005, pg. 68 (lines 7–10)), 31 (citing Ex. 1005, pgs. 67 (line 20) – 68 (line 10)). Patent Owner further relies on original claims 4 and 6 of the 2011 Application. *Id.* at 26–27.[5] Based on these disclosures, Patent Owner concludes the 2011 Application "disclose[s] a link, at a reciprocal link site, to another web page, and creating a link back, to the registered user's website, at this other web page." *Id.* at 14, 31.

We agree with Patent Owner that the 2011 Application demonstrates possession of first and second web pages that each include a link to the other of the first and second web pages. In this regard: (A) the first web page corresponds to the "reciprocal link site" portion of the website of the new user, and (B) the second web page corresponds to the "reciprocal link site" portion of the website of a preexisting user selected by the new user using location selection menu 1260. *See* Ex. 1005, pg. 86 (lines 12–24) (each time a new user opts into the linking functions provided by system 100, the system creates "a reciprocal link site . . . in the [new] registered user's website, for displaying links to other websites"). We discuss each aspect (A) and (B) in turn.

Beginning with (B), a person of ordinary skill in the art would understand the 2011 Application indicates that the respective reciprocal link

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[5] In part, Patent Owner states: "Originally-filed claim 5 further clarifies that 'the ***element for marketing the first website is a link*** to the first website.'" Prelim. Resp. 27 (underlined emphasis added, otherwise emphasis in original). However, the quoted limitation appears in claim 6, not in claim 5. *See* Ex. 1005, pg. 96.

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sites of each preexisting user includes a link to the new user's website. The 2011 Application correspondingly discloses that the new user's completion of the process of location selection menu 1260 provides server 140 with "sufficient information to create links to the [new] registered user's website *at other websites*." Ex. 1005, pgs. 67 (line 20) – 68 (line 10) (emphasis added). The 2011 Application further indicates those other websites include "the selected websites of other [preexisting] registered users (i.e., the websites selected during the design of the new website [by the new user using location selection menu 1260])." *Id.* at pg. 69 (lines 5–13).

Next considering (A), a person of ordinary skill in the art would understand the 2011 Application indicates that the reciprocal link site of the new user includes links to each of the preexisting users' websites selected by the new user with location selection menu 1260. Possession of that subject matter is demonstrated, first, in the 2011 Application's description of the process of location selection menu 1260 as the new user "identify[ing] addresses for websites to which the registered user desires its website to be linked." Ex. 1005, pg. 67 (lines 20–23). The 2011 Application describes that process as "*caus[ing] [the new user's] website to participate in linking . . . functions with other websites*." *Id.* at pg. 69 (lines 5–9) (emphasis added); *see also id.* at pg. 69 (lines 13–16) ("*each website* that is developed by a registered user who opts to participate in the linking functions can display unlimited links to other registered users' websites" (emphasis added)). A person of ordinary skill in the art would understand such participation of the new user's website is effectuated by populating the reciprocal link site of the new user's website with links to the preexisting

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users' websites selected by the new user via location selection menu 1260. *See id.* at pg. 86 (lines 12–24).

Possession is further demonstrated by the 2011 Application's description of the reciprocal nature of the linking functions provided by system 100, as providing special marketing opportunities to each registered user vis-à-vis other registered users. That is, the 2011 Application describes the linking functions implemented by create links option 1240 (which invokes location selection menu 1260) as "provid[ing] the registered user with . . . *marketing opportunities* with respect to[] other registered users," including "*special marketing benefits to registered users of the system 100 vis-[à]-vis one another*." *Id.* at pg. 66 (lines 14–19), pg. 67 (lines 20–23). The 2011 Application further indicates that these special marketing benefits are implemented by creating, within the website of each user who opts into the marketing link functions, "a *reciprocal* link site . . . for displaying links to" the websites of other users who have also opted into the marketing link functions. *Id.* at pg. 86 (lines 12–24) (emphasis added). A person of ordinary skill in the art would understand that the foregoing reciprocal marketing opportunities, provided by system 100 to two registered users vis-à-vis one another, would involve the respective websites of *each* user linking to the website of the *other* user, based on one of the two users identifying the website of the other user via location selection menu 1260.

For the foregoing reasons, we determine the 2011 Application demonstrates possession of first and second web pages that each include a link to the other of the first and second web pages.

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8. Conclusion Concerning Priority Date of the '760 Patent

For the reasons provided above, the Petition fails to demonstrate that the 2011 Application lacks written description support for the independent claims of the '760 patent. Therefore, the Petition fails to establish that the '760 patent is not entitled to priority to the filing date of DiStefano '259.

C. Obviousness over DiStefano '259

Petitioner asserts claims 1–20 of the '760 patent are unpatentable under 35 U.S.C. § 103 as having been obvious over DiStefano '259. Pet. 2, 30–54. Patent Owner provides several arguments in opposition. Prelim. Resp. 37–50. Patent Owner's first argument is that the Petition does not establish DiStefano '259 is prior art to the '760 patent, by virtue of the 2011 Application lacking written description support for the independent claims of the '760 patent. *Id.* at 37. For the reasons provided above, we agree with Patent Owner in that regard. Therefore, we need not address the other obviousness issues raised in the Petition and the Preliminary Response.

IV. CONCLUSION

We determine the Petition fails to demonstrate that the 2011 Application lacks written description support for the independent claims of the '760 patent. Therefore, the Petition fails to establish DiStefano '259 is prior art to the '760 patent, such that claims 1–20 of the '760 patent might be unpatentable as having been obvious over DiStefano '259. Therefore, the Petition is denied.

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V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is *denied*, and no *inter partes* review is instituted.

PETITIONER:

Todd M. Siegel
Andrew M. Mason
KLARQUIST SPARKMAN, LLP
todd.siegel@klarquist.com
andrew.mason@klarquist.com

PATENT OWNER:

Meredith Addy
ADDYHART P.C.
meredith@addyhart.com

Scott D. Paul
CUENOT, FORSYTHE & KIM, LLC
scott.paul@iplawpro.com

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IPR2025-01061
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Electronic Patent Application Fee Transmittal	
Application Number:	13946461
Filing Date:	19-Jul-2013
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Filer:	Scott David Paul/Alaine Allison
Attorney Docket Number:	8201-0013
Filed as Small Entity	
Filing Fees for Utility under 35 USC 111(a)	

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension - 3 months with $0 paid	2253	1	700	700
Miscellaneous:				
		Total in USD ($)		**700**

Electronic Acknowledgement Receipt	
EFS ID:	36507048
Application Number:	13946461
International Application Number:	
Confirmation Number:	9140
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Customer Number:	55246
Filer:	Scott David Paul/Alaine Allison
Filer Authorized By:	Scott David Paul
Attorney Docket Number:	8201-0013
Receipt Date:	05-JUL-2019
Filing Date:	19-JUL-2013
Time Stamp:	16:11:57
Application Type:	Utility under 35 USC 111(a)

Payment information:

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RAM confirmation Number	070819INTEFSW00001303503611
Deposit Account	
Authorized User	
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Appeal Brief Filed	8201-0013_AppealBrief_07-05-19.pdf	1238325 265ce8bf439ac34a19eff30f36042dc29ecc8cd8	no	127
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	30799 873732ca5ccec210b1b8cd87e6872f52b8441926	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	1269124		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.
National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.
New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 10/18/2019

Cuenot, Forsythe & Kim
12161 KEN ADAMS WAY
SUITE 120
WELLINGTON, FL 33414

EXAMINER	
KOLOSOWSKI-GAGER, KATHERINE	

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
10/18/2019	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kevin.cuenot@iplawpro.com
ptomail@iplawpro.com
terry.forsythe@iplawpro.com

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 13/946,461
Filing Date: 19 Jul 2013
Appellant(s): DISTEFANO, THOMAS, L.

Scott Paul (Reg. No. 42984)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5 JULY 2019

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 10 AUG 2018 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(2) Response to Argument

A. Regarding the rejection of Claims 22-26, 28-36, 38-46 under 35 USC §101:

The Final Rejection mailed on 10 AUG 2018 did not incorporate the 2019 Revised Patent Subject Matter Eligibility Guidance (hereinafter 2019 PEG), which "(a)ll USPTO personnel...as a matter of internal agency management, (are) expected to follow." Examiner notes that while the analysis of the claims changes slightly in view of the 2019 PEG, the conclusion, i.e. lack of subject matter eligibility for claims 22-26, 28-36, 38-46 has not. Examiner has an analysis incorporating the 2019 PEG below for purposes of both compact prosecution and convenience. Examiner's response to Appellants remarks will follow.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-26, 28-36, 38-46 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As explained below, the claim(s) does/do not fall within at least one of the four categories of patent eligible subject matter.

With respect to claims 2-26, 28-36, 38-46, the independent claims (claims 22, 32, 44) recite a process, which is a statutory category of invention. Claims 2-26, 28-36, 38-46 are directed further to establishing a reciprocal agreement between a first user and a second user opting to participate in the reciprocal agreement, and including elements of the agreement on pages associated with each of the users. These claim elements are considered to be

abstract idea(s) because they are directed to a) a method of organizing human activity which include commercial or legal interaction, including agreements in the form of contracts, as well as advertising, marketing or sales activities or behaviors, and business relationships, as well as managing personal behavior or relationships.

For example, a reciprocal agreement as claimed is clearly an "agreement" between the "first user and second user" as claimed. The remaining limitations as pertaining to the reciprocal agreement between the first and second user are contractual obligations on the part of the first and second user(s), with the resulting pages being fulfillment of the contract or obligation between the first and second user(s). Facilitating a reciprocal agreement between one or more users is categorically managing personal behaviors, and if done for commercial purposes it is a sales or marketing activity. If a claim limitation, under its broadest reasonable interpretation recites commercial and legal interactions, then it falls within the "method of organizing human activity" grouping of abstract ideas. Accordingly, the claim(s) recite abstract ideas.

These judicial exception(s) is/are not integrated into a practical application, in that there are no additional elements or combination thereof to impose a meaningful limit on the judicial exception(s). In particular, claim 22 recites only a computer hardware system configured to serve a first web page and a second web page, and that the page(s) contain "links." Claim 32, 44 further include a "webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)." The computing elements in all claims, such as the computer based method/systems in claim 22, as well as the "computer hardware system," "webpage implementation server system" and "database system," used to "generate a web page" claim elements is/are recited at a high-level of generality (i.e., as a generic processor performing a generic computer function of sending/receiving data, a database used to store data/inputs, etc.) such that it amounts no more than mere instructions to apply the exception using a generic computer component. Further, the web pages and links contained therein are at best extra solution activity – rendering a web page, even with added input, is not a practical application (see MPEP 2106.05g). Examiner finds in particular that the "links" as claimed are not even claimed *as* a hyperlink or with any capabilities therein – a "link" as claimed could simply be data, but could also just be an advertisement or a note. For example, a paper or other document may contain footnotes therein, which are a "link" to either a source or a different location within the document.

Examiner finds no evidence of an improvement to either the functioning of the computer itself nor any technology or field – the computing technology is nominally recited (see MPEP 2106.05(a)). Accordingly, the additional element(s) do not integrate the abstract idea into a practical application, as Examiner finds that there are no meaningful limits to practicing the abstract idea beyond the application of a technology or a drafting effort.

The claim(s) are directed to an abstract idea.

The independent claims are additionally directed to claim elements such as: only a computer hardware system configured to serve a first web page and a second web page, and that the page(s) contain "links" as in claim 22, and Claims 32, 44 further include a "webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)." When considered individually, the computer hardware system configured to serve a first web page and a second web page, the page(s) containing "links" as in claim 22, and the "webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)" as in computer hardware system configured to serve a first web page and a second web page, as in claims 32, 44, claim elements only contribute generic recitations of technical elements, and extra solution activities to the claims. It is readily apparent, for example, that the claim is not directed to any specific improvements of these elements. Examiner looks t Applicant's specification at, for example: [018] which describes the database in functional terms only – i.e. that it saves information and is coupled to a server computer. At [044] server computer 140 has or is coupled to a plurality of databases 160, 170, 190. When viewing figure 1 and related text, these databases appear to be linked to or only require a generic, all purpose computer as attached to a registered user (180), a third party potential customer (110), and/or a third party author (12). These paragraphs, and others, make it clear that the invention is in no way directed to a technical improvement, and in fact categorically relies on the "application of" the computing environment to the abstract ideas listed above. Again, Examiner finds the rendering of the webpage, even with "links" to be at best insignificant extra solution activity (see MPEP 2106.05g). Examiner further notes that turning to for example, at [074, 075] the term "link" is used interchangeably with the term "banner," thus further supporting Examiner's conclusion above that a "link" as claimed is merely data or the appearance of information analogous to a footnote and/or banner advertisement.

When the claims are considered individually and as a whole, the additional elements noted above, the claims appear to merely apply the abstract concept to a technical environment in a very general sense – i.e. a generic computer receives information from another generic computer, processes the information and then sends information back (see MPEP 2106.05(f), (h)). The limitations simply append well understood, routine and conventional activities known to the industry at a high level of generality to the judicial exception, in that they recite, at best, sending and receiving of data between one or more computing devices (see MPEP 2106.05(d)). The most significant elements of the claims, that is the elements that outline the inventive elements of the claims, are set forth in the elements identified as an abstract idea. Examiner finds that, particularly in view of the remaining details in the specification, the claims represent a clear drafting attempt at best. The fact that the generic computing devices are facilitating the abstract concept is not enough to confer statutory subject matter eligibility (see MPEP 2106.05(h)).

The claims are directed to an abstract idea, without significantly more.

Dependent claims 23, 33, 45 are not directed any additional abstract idea, however they are directed to the use of a "database" as discussed above with respect to claims 32, 44. As discussed above, storing information in a database is neither a practical application nor significantly more. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as the type(s) of information stored in the database. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 24, 34, 46 are not directed any additional abstract idea, however they are directed to the use of a "database" as discussed above with respect to claims 32, 44. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as the previously identified extra solution activity of rendering/generating a webpage. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 25, 35, are not directed any additional abstract ideas and are also not directed to any additional non-abstract claim elements than those recited above. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as information regarding types of web pages included. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 26, 28, 36, 38 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of a web asset and providing description of said web asset as a "functional" asset on the page. While providing a web asset provides context, the providing of the descriptive matter of a "functional" asset describes the abstract idea of managing human behaviors as claimed above. The fact that the claim recites the additional elements of "functional" applications is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 29, 39, are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of providing a recommended page. While providing recommended pages further describes the abstract idea of managing human behaviors as claimed above, that the claim recites the additional elements of recommended pages is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 30, 31, 40, 41 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of providing a graphic from a first user. While providing or including a graphic on a web page further describes the abstract idea of managing human behaviors as claimed above, that the claim recites the additional elements of graphics is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 42, 43 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of a registered user. While requiring user registration further describes the abstract idea of managing human behaviors as claimed above, particularly in view of the types of relationships identified as being "managed;" that the claim recites the additional elements of registration is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Appellant's remarks begin in earnest on page 12, with some restatement of statutory and case law into page 13. Appellant provides some discussion from the relevant portions of the specification, regarding designing or creation of a webpage, however, Examiner respectfully submits that Appellant's claims recite placing "links" on existing webpages, rather than the creation of an entirely *new* webpage. As per Appellant's assertions on page 14, Examiner again notes that as discussed above, Appellant's links in the claims are not required to be active links or hyperlinks, rather they could be associated with/to data. On page 14 Appellant argues aspects of the prior art in a related Application; Examiner finds this somewhat irrelevant and also unpersuasive; the prior art cited appears to

teach that the process of a reciprocal link is in fact known at the time of the invention. Appellant's discussion of the cited prior art is somewhat more relevant, however the cited portions provided by Appellant are at best evidence to the contrary of Appellant's assertion – that the use of reciprocal links does not represent an improvement in the functioning of a computer or related technology. That the cited reference allows a user to "remove" a link further lends to Examiner's point that the use of a link on a webpage, as monitored or manipulated by a user, does not represent an improvement. The process identified on page 15 of Appellant's remarks further describes a process of reciprocal links, at least as far as is *claimed.* While Appellant's comparison to the prior art is helpful in some ways, Examiner notes that prior art is not a consideration of subject matter eligibility.

On page 17, Appellant asserts that two limitations in particular represent an improvement to "web page and reciprocal link creation." Examiner respectfully disagrees; again while Appellant's remarks are helpful contextually, serving a first web page and a second web page was in no way at the time of the invention an "improvement." Again, Appellant's claims *do not* recite the creation of a web page at any stage, rather, the claims a best recite the rending of modified webpage. This is not the same. Appellant's claims in no way circumvents the (purported) number of entities as Appellant argues; in contrast the claim is broad enough that each of these "entities" could be easily included in the limitations. Appellant again restates portions of the prior art on pages 18, however this is also unpersuasive in view of *the limitations as claimed*. Examiner respectfully submits that *serving* a web page, even with the web page *including* a first and second link is in no way an improvement to the generation of a webpage, nor the "creation" of a reciprocal link. At best, these limitations require that an existing page is served with additional information at a later time.

Appellant discusses "undesired" reciprocal links on pages 19, 20, and argues that the claims represent an improvement to this purported "problem." Appellant provides no disclosure or support for the assertion that this itself represented a problem, and again discusses the prior art at hand rather than describing improvements found *in the claim language*. Appellant appears to be arguing, on page 20, that reciprocal links themselves were both a solution and a problem at the time of the invention – Examiner respectfully submits that Appellant cannot have it both ways. For example, reciprocal links as claimed cannot be a solution to a problem of *reciprocal links* as found in Horstmann without Appellant necessarily conceding they are one in the same. Again, while Examiner does not

dispute that within the specification there is likely disclosure of such a solution, the claims presented do not recite one or differentiate between the two.

On pages 20/21 Appellant discusses remarks raised in the most recent Office Action; Examiner respectfully submits that as noted in the Final Rejection, the solution itself being presented is at least *arguably* rooted in technology or represents a technical solution, however, the problem being solved, that of "reciprocal agreements" itself is not. Examiner respectfully submits that the term "ancient lineage" as discussed was Appellant's terminology and suggestion. Examiner respectfully disagrees with Appellant's remarks, and finds them to be not relevant.

Appellant's remarks beginning on page 21 discuss the 2019 PEG, issued in January of 2019. The most recent Office Action was mailed in August of 2018, and as such the 2019 PEG was not available at the time. Examiner has provided an updated rejection for purposes of convenience, as discussed above. As Examiner does not assert that the claims fall within a mathematical concept or a mental process, these remarks are found to be moot. With respect to the discussion of the category of "Certain Methods of Organizing Human Activity," Examiner finds Appellant's remarks to be misguided. "Methods of organizing human activity" and "operations necessarily performed on a computer" are not mutually exclusive in any way per the 2019 PEG. Rather, Appellant instead *again* incorrectly asserts that the claim limitations recite "creation" of a webpage, rather than at best, the display or rendering of a webpage. The claim limitations, as discussed above, represent a method of human activities in the form of a contractual obligation between two entities – i.e. a *reciprocal agreement*.

Appellant's remarks on page 23, regarding the invention falling into "one of the excluded categories" is found unpersuasive in that it lacks a formal conclusion, and moot in view of the new analysis/conclusions reached above. Examiner respectfully submits that the claim limitations recite an abstract idea in the category of human behaviors/activity.

Appellant further alleges Examiner has not "properly characterized the claimed invention." Appellant again essentially repeats the incorrect conclusion that the claims are directed to *generating* web pages, when the claims at best recite serving existing webpages for display. This is in no way analogous to the *creation* of a new webpage. The claimed invention may be computer implemented, however as noted above the involvement of the computing elements *as claimed* is so minimal that it appears to at best be applying the abstract idea(s) identified

to the computing environment. Again, as noted in the most recent Office Action, Appellant simply asserts a conclusion rather than providing evidence that supports an *actual* improvement.

Appellant repeats the argument that Examiner has "overgeneralized" the claimed invention, however at least in view of the analysis above this is unpersuasive. Examiner has categorized the invention appropriately as per the 2019 PEG, and did so with current USPTO Guidance in the Final Office Action. Appellant's reliance on the assertion of "reciprocal links" is again misguided is it does not recite or require any technical features, and therefore does not even imply an improvement.

Appellant's arguments on page 25, regarding the "result" of a reciprocal agreement are found unpersuasive, precisely because exemplary claim 22 at best recites a "result" of a reciprocal agreement – that an existing web page is distributed with additional content. Appellant's claim in no way requires or recites a reduction in the participating entities, an elimination of reciprocal enforcement, or an improved ability to police links. The claims *only* require a reciprocal agreement between two parties, and displaying the result of the agreement in two web pages. None of the assertions on page 26 are recited in, or even fairly inferred from, Appellant's claim limitations.

As touched upon above, Appellant's remarks regarding analogy to DDR Holdings (beginning on page 26) are similarly misplaced and incorrect. Again, while Examiner finds that the solution is, at least somewhat, rooted in technology, the test of DDR Holdings requires that the *problem itself* necessarily arise in the realm of computing technology. The improvement in this case is directed to the abstract idea – of agreements between people or entities.

Appellant next turns to a discussion of preemption on page 27 of the Brief. Appellant argues that there is no preemption found; however, as further noted by Appellant, preemption itself is not the sole test of subject matter eligibility nor does lack of complete preemption imply eligible subject matter. Appellant submits the pending claims do not "tie up" or "prevent" all such agreements between web pages, and thus are statutory under a streamlined analysis. Examiner respectfully disagrees. Though the Supreme Court has described the concern driving the judicial exceptions as preemption, the courts do not use preemption as a stand-alone test for eligibility. (See July 2015 Update: Subject Matter Eligibility.)

Instead, questions of preemption are inherent in the two-part framework from Alice Corp. and Mayo. Examiner notes that "(w)hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." Ariosa v. DNA Diagnostics Center, Inc., __F.3d__, Nos. 2014-1139, 2014-1144, Fed. Cir. 2015 (slip op. at 14). Moreover, the use of "tie up" refers to the results of Steps 2A and 2B of the two-part framework, and is not meant to imply that the streamlined analysis is either a preemption test or a means of avoiding the results that would occur if a claim were to undergo the full eligibility analysis. In fact, the results of the streamlined analysis will always be the same as the full analysis, in that a claim that qualifies as eligible after step 2A or 2B of the full analysis would also be eligible if streamlined analysis were applied to the claim. Moreover, as noted by Examiner throughout the remarks, the abstract idea identified is that of one of managing human activities in the form of agreements or contracts, rather than Appellant's alleged abstract idea of "reciprocal links."

On page 29 of the remarks, Appellant begins a discussion of Step Two of the analysis as applied in prior prosecution and the rejection above. Examiner has provided, both above and in prior prosecution, appropriate evidence for the finding that the use of the computing elements is well understood, routine and conventional. Examiner respectfully disagrees with Appellant's assertion that no evidence has been provided; Examiner has identified the limitations in question as well as identified the sections of the MPEP upon which Examiner has relied to form the conclusion(s). (See MPEP 2106.05(d), (f), (h).)

Appellant's remarks on pages 30-33 of the Brief are exclusively directed to the rejection presented in the Final Office Action, primarily consisting of a discussion of Examiner's previous reliance on buySafe. Examiner again reiterates that the rejection presented at that time was in compliance with USPTO Policy regarding subject matter eligibility, and the appropriate analysis was executed. In view of the 2019 PEG, which no longer requires specific citation or analogy to relevant examples, these remarks are found largely moot. Further, as noted in the Final Office Action, – the limitations as they stand specifically recite "establishing a reciprocal arrangement" between a first and second party, and then specifically require that "based on the reciprocal arrangement" both parties are bound to perform. This is analogous with the contract formed between two parties as in buySafe. A contract at its most basic form requires an offer, and acceptance, and an intent to be bound. These elements are found in independent claims 22, 32, 46: the reciprocal arrangement between the two parties is "established" by the "first

and second users opting to participate" – i.e. offer, accept, and clear intent. The claim further includes the performance of the contract, in that based on the arrangement, the display occurs.

Similarly, Appellant's remarks on pages 35-37 regarding Examiner's previous citation of/analogy to Return Mail are found similarly unpersuasive/moot. Examiner again respectfully submits that Appellant has misconstrued the remarks in the Final Office Action; Examiner in no way concludes all web pages or links are abstract. Again, Examiner reiterates that while the claims are found to be technical in nature, this is separate from Examiner's reliance on the case as discussed.

With regard to claims 23, 24, 33, 34, 45, 46, as discussed above the recitation of a database is included in these claims, and said recitation is analogous to that found in independent claims 32, 44. As noted in the Final Office Action and above, storing and retrieving information from a database is not itself an immediate indicator of subject matter eligibility in that these limitations are analogous to functions of a computer found to be well understood, routine and conventional ((see MPEP 2106.05(d)). Further, as discussed above the claims *as recited* do not provide anything beyond description of the data itself being stored. Description of data being stored is not itself an indicator of subject matter eligibility. As noted above and in the Final Office Action, per then and now current USPTO policy the limitation(s) were considered both individually and as a whole. When considered individually, the storage of information in a database is not sufficient to amount to subject matter eligibility. When considered in combination, the limitations *as claimed* provide only description of the types of data being stored. Contrary to Appellant's assertions on page 39, these elements/limitations do not "transform the nature of the claim" in to a patent eligible application. As such Examiner respectfully disagrees with Appellant's remarks and submits that the prima facie case of patent ineligible subject matter was properly raised.

Appellant paraphrases claim 24, 32 on page 39, however Examiner respectfully disagrees with Appellant's conclusions at least in view of the discussion above and the Final Office Action. Examiner believes the rejection should be sustained.

On page 40, Appellant begins a discussion of the prior art.

Claim 22 recites, in pertinent part, "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Subsequently claim 22 recites "including within the first/second page and based upon the reciprocal agreement..." links to the respective entity on the second/first webpage. Examiner has interpreted these limitations to mean that two parties agree to subsequently provide links to one another's pages when said pages are later rendered. However, Examiner finds that the claim limitations neither implicitly nor explicitly define what constitutes a "reciprocal arrangement" and/or a given timeline. Examiner therefore relies on the dictionary definition of reciprocal: "a) an agreement or obligation that is bearing or binding on each of two parties; concerning each of two or more persons or things; b) given or done in return." Thus, "reciprocal" is defined more by the mutual assent of the parties involved rather than the content or agreement reached. A reciprocal agreement could exist when two parties mutually agree to perform the exact same service for one another, but a reciprocal agreement also exists when the parties mutually agree to execute different services for one another, or when parties exchange a service for some other consideration as in a typical transaction, and also wherein both parties agree that one party will perform a task for the other. A reciprocal arrangement could also require performance by one party prior to the other – if friends agree to watch one another's dogs while each is out of town separately, this necessarily requires that one party perform prior to the other.

Further, by definition as noted above, a reciprocal gesture may require that the gesture or agreement may in fact require a predicating action on the part of one of the parties – the reciprocal agreement may be performed *in return*. For example, if one friend treats another to coffee, unprompted, at a subsequent outing the second friend would likely want to make a reciprocal gesture. Again, this could include purchasing the coffees at a later time, but could also include purchasing desert right after. Similarly, if one friend offers to drive, the other might reciprocate with an offer of gas or lunch either before, during or after the ride. Thus, Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual agreement of the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links.

Turning to Applicant's specification, Examiner finds support for this interpretation. Notably, the term reciprocal does not appear until [098, 0100] of the PG Pub. In [098] the system must "determine" if a "reciprocal link site has already been created in the registered user's website" – this supports Examiner's interpretation that the agreement exists at some point, but that performance has not begun. Similarly, at [0100] "The system

> ... determines whether a reciprocal banner ad site has already been created on the registered user's website, so that banner ads from other websites can be displayed on the registered user's website once it is activated. If a banner ad site has not yet been created, the system 100 creates a banner ad site at step 2036 before returning to step 1650. Otherwise, if a banner ad site has already been created, the system 100 immediately returns to step 1650. Upon activation of the registered user's website, the registered user's website can display an unlimited number of banner ads from other websites on its reciprocal banner ad site, and the system 100 also displays the registered user's banner ad at the marketing locations (websites) that the registered user specified at step 2030."

As such, it is clear from the specification that both the timing of, and the agreement itself, are intentionally left in flux. The specification nowhere else defines the agreement, beyond that both parties "agree" at some point to show the links. Further, the specification clearly recites several steps of checks and "determinations" before the links are both included in each page. The specified paragraphs clearly require that a user's website be both activated, and include a banner ad site being *previously* created. When comparing these paragraphs to the limitations of claim 22, a "first or second user" could seek a "reciprocal agreement" with the other, but it is possible that the opposite user would not have created the banner ad site. Per the specification, the creation of the banner ad site is required prior to inclusion of the reciprocal links per said reciprocal agreement.

Horstmann as cited teaches that two merchants agree to mutually share links pertaining to one another on their respective pages. A cursory review of figure 1 shows that Bookstore Site 1 and Bike Shop Site 2 are in such an agreement. In figure 2, the Bike shop views a first page including a link to Bookstore. Bookstore then *solicits* the mutual agreement – including which of Bike Shop's pages Bookstore is to link to. Bookstore then completes the mutual agreement, and verifies that the Bike Shop linked back to the appropriate page of Bookstore. and outputs link information. Similarly to the claimed invention, at step 33 of figure 3, there is a "check" to verify that the pages

exists for the locations. Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages would be referred to the bookstore;" and "A method establishes reciprocal page links between pages on the Internet." In col. 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop. Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links.

Turning to Appellant's remarks, beginning on page 41, Examiner respectfully submits Appellant continues to argue that which is not claimed – the content of the agreement, and the timing or manner in which the agreement "must" be executed. The use of verification software to determine *performance* on the part of one of the owners does not negate that a reciprocal agreement is present. If the second owner does not want to participate, then there is naturally, no reciprocal agreement found and the links are removed or not displayed. If both parties agree, and the verification software finds that both have fulfilled the *explicitly* reciprocal agreement as in Horstmann, then the pages are displayed as such. Contrary to Appellant's remarks on page 43, a reciprocal agreement is proposed when the Bike Store owner seeks inclusion of the link on the Book Store page. If the Bike Shop does not fulfill the proposed reciprocal agreement, then the link is removed. This is, per dictionary definition and Appellant's specification, a reciprocal agreement.

Appellant's remarks on page 43 regarding the "scheme" of Horstmann necessarily fails, at least in view of Appellant's own remarks: Appellant partially correctly states that Horstmann "allows anybody to place a link on the bookstore's page so long as the form associated with the "add link" link has been completed," however Appellant leaves out that the receiving page must also include the link in order to perfect or complete the reciprocal agreement. That the identity is potentially unknown to one or more parties is not relevant to the *claims as presented*. Continuing through Appellant's remarks on page 43, Examiner again contends that when considering the incredibly broad definition of a reciprocal agreement, as well as Appellant's clear lack of definition in the specification and claims as per the timing of said agreement, these remarks are unpersuasive. The inclusion of the verification process

does not nullify that an agreement must be reached *prior to* the mutual display of the pages with the corresponding reciprocal links.

On page 44, Appellant submits that while the end result is uncontested, i.e. the display of reciprocal links, Appellant finds some distinction in the manner of achieving the result. Examiner respectfully disagrees, at least in view of the discussion above with respect to the interpretation of the claims. Examiner reiterates that which is supplied by Appellant on page 44, and found in the Final Office Action:

> "However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Horstmann, "A method establishes reciprocal page links between pages on the Internet. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party – i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed.
>
> Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two parties – clearly present in Horstmann. That the reference uses software to execute some of the verification does not mean there is no "reciprocal agreement" between the two."

Despite Appellant's remarks on page 45, Examiner has clearly demonstrated a fair and reasonable interpretation of the claim language in view of the limitations and the specification. It is not possible to "overgeneralize" when the limitation itself has been left so intentionally broad. Again, Examiner reiterates that the claims themselves are not distinguishable over Horstmann in that Horstmann does not allow *both* pages to be rendered with the corresponding links until both parties have fulfilled the agreement. That one party performs their portion – be it including a link, or a friend picking up the check, without first being "asked" is no different from the

limitations as claimed. The parties agree to perform, as Appellant does not dispute, reciprocal link inclusion. Appellant's claims in no way preclude the means in which Horstmann executes this end result, despite encouragement from Examiner to do so.

Appellant's final remarks appear to have been addressed at length elsewhere in Examiner's. However, Examiner again notes that per the claim language, and per the specification, Examiner's interpretation both in the Final Office Action (as replicated by Appellant on page 46) is appropriate. All that is required to satisfy claim 22 is that two parties mutually submit to an agreement. Despite Appellant's remarks, there is no limitation or requirement for timing, no description as to what the agreement itself is, and no requirement as to when both or one must perform the agreement. The owners of the respective stores are in no way limited as to when and how they agree to ultimately display the corresponding reciprocal links, it is only required that at some point both agree to fulfill the obligation mutually.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/KATHERINE KOLOSOWSKI-GAGER/
Primary Examiner, Art Unit 3622

Conferees:

/PATRICIA H MUNSON/
Supervisory Patent Examiner, Art Unit 3624

/MEHMET YESILDAG/
Primary Examiner, Art Unit 3624

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

Patent Appeal Center Return

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Examiner:	KOLOSOWSKI-GAGER, KATHERINE	**GAU:**	AU3622
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13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 10/24/2019

Cuenot, Forsythe & Kim
12161 KEN ADAMS WAY
SUITE 120
WELLINGTON, FL 33414

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/KATHERINE KOLOSOWSKI-GAGER/
Primary Examiner, Art Unit 3622

PTO-90C (Rev.04-03)

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Application Number	13946461
Filing Date	2013-07-19
First Named Inventor	DiSTEFANO III
Art Unit	2447
Examiner Name	Unassigned
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	2	5913212		1999-06-15	SUTCLIFFE et al.	
	3	5950200		1999-09-07	SUDAI et al.	
	4	5963951		1999-10-05	COLLINS	
	5	5987440		1999-11-16	O'NEIL et al.	
	6	6029141		2000-02-22	BEZOS et al.	
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First Named Inventor	DiSTEFANO III
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Attorney Docket Number	8201-0013

	9	6073105		2000-06-06	SUTCLIFFE et al.	
	10	6073138		2000-06-06	DE L'ETRAZ et al.	
	11	6009410		1999-12-28	LEMOLE et al.	
	12	6175831	B1	2001-01-16	WEINREICH et al.	
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	18	8412570	B1	2013-04-02	DiSTEFANO III	
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	20	8423399	B2	2013-04-16	DiSTEFANO III	
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	4	20130073397	A1	2013-03-21	DiSTEFANO III	
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	1	CASEY, C., "Creating and managing webrings: a step-by-step guide," [online] Information Technology and Libraries, Vol. 18, No. 4, pp. 214-224, Dec. 1, 1999 [retrieved July 27, 2013], retrieved from the Internet: <http://www.accessmylibrary.com/article/print/1G1-59021370>, 12 pgs.	☐
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	Attorney Docket Number	8201-0013

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

☐ That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

☐ See attached certification statement.

☐ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/SCOTT D. PAUL/	Date (YYYY-MM-DD)	2013-08-02
Name/Print	SCOTT D. PAUL	Registration Number	42984

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Privacy Act Statement

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TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
Page 1162 of 1793

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (01-10)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT
(Not for submission under 37 CFR 1.99)

Application Number	
Filing Date	2013-07-19
First Named Inventor	DISTEFANO III
Art Unit	
Examiner Name	
Attorney Docket Number	8201-0013

U.S.PATENTS						Remove
Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	6401075	B1	2002-06-04	MASON et al.	
	2	6330575	B1	2001-12-11	MOORE et al.	
	3	6629135	B1	2003-09-30	ROSS et al.	
	4	5937392		1999-08-10	ALBERTS	
	5	6029141		2000-02-22	BEZOS et al.	
	6	6058417		2000-05-02	HESS et al.	
	7	5960409		1999-09-28	WEXLER	
	8	6601057	B1	2003-07-29	UNDERWOOD et al.	

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		
	Application Number	
	Filing Date	2013-07-19
	First Named Inventor	DISTEFANO III
	Art Unit	
	Examiner Name	
	Attorney Docket Number	8201-0013

	9	7996259	B1	2011-08-11	DiSTEFANO III	
	10	8335713	B1	2012-12-18	DiSTEFANO III	
	11	8417567	B1	2013-04-09	DiSTEFANO III	
	12	8442860	B1	2013-05-14	DiSTEFANO III	
	13	8412570	B1	2013-04-02	DiSTEFANO III	
	14	8423399	B1	2013-04-16	DiSTEFANO III	

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Examiner Initial*	Cite No	Publication Number	Kind Code[1]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20120185339	A1	2012-07-19	DiSTEFANO III	
	2	20130151982	A1	2013-06-13	DiSTEFANO III	
	3	20130173401	A1	2013-07-04	DiSTEFANO III	

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	Application Number	
	Filing Date	2013-07-19
	First Named Inventor	DISTEFANO III
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	Examiner Name	
	Attorney Docket Number	8201-0013

	4	20130151338	A1	2013-06-13	DiSTEFANO III	
	5	20130151354	A1	2013-06-13	DiSTEFANO III	

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Examiner Initial*	Cite No	Foreign Document Number[3]	Country Code[2] i	Kind Code[4]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T[5]
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Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T[5]
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EXAMINER SIGNATURE

Examiner Signature	/KATHERINE KOLOSOWSKI-GAGER/	Date Considered	10/21/2019

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[1] See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. [2] Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). [3] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [4] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. [5] Applicant is to place a check mark here if English language translation is attached.

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Signature	/SCOTT D. PAUL/	Date (YYYY-MM-DD)	2013-07-19
Name/Print	SCOTT D. PAUL	Registration Number	42984

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TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
Page 1166 of 1793

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TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
Page 1167 of 1793

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (03-15)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	13946461
Filing Date	2013-07-19
First Named Inventor	THOMAS L. DISTEFANO III
Art Unit	3622
Examiner Name	DANIEL LASTRA
Attorney Docket Number	8201-0013

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TikTok Inc. EX1002
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	Filing Date	2013-07-19
	First Named Inventor	THOMAS L. DISTEFANO III
	Art Unit	3622
	Examiner Name	DANIEL LASTRA
	Attorney Docket Number	8201-0013

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Examiner Signature	/KATHERINE KOLOSOWSKI-GAGER/	Date Considered	12/11/2017

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	Filing Date	2013-07-19
	First Named Inventor	THOMAS L. DISTEFANO III
	Art Unit	3622
	Examiner Name	DANIEL LASTRA
	Attorney Docket Number	8201-0013

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Doc code: IDS
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Application Number	13946461
Filing Date	2013-02-08
First Named Inventor	THOMAS L. DISTEFANO III
Art Unit	2172
Examiner Name	PESIN, BORIS
Attorney Docket Number	8201-0013

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Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	5560006	A	1996-09-24	LAYDEN et al.	
	2	5787254	A	1998-07-28	MADDALOZZO JR. et al.	
	3	5995099	A1	1999-11-30	HORSTMANN	
	4	6035334	A	2000-03-07	MARTIN et al.	
	5	6199111	B1	2001-03-06	HARA et al.	
	6	8589222	B1	2013-11-19	DISTEFANO III	
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(Not for submission under 37 CFR 1.99)

Application Number	13946461
Filing Date	2013-02-08
First Named Inventor	THOMAS L. DISTEFANO III
Art Unit	2172
Examiner Name	PESIN, BORIS
Attorney Docket Number	8201-0013

Examiner Initial*	Cite No	Publication Number	Kind Code[1]	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20130311876	A1	2013-11-21	DISTEFANO III	

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	1	0016210	WO	A1	2000-03-23	NEXCHANGE CORP.		☐
	2	9923591	WO	A1	1999-05-14	SAGE ENTERPRISES INC.		☐
	3	0021012	WO	A2	2000-04-13	ELECTRONIC COMMERCE & CATALOG SERVICES, INC.		☐
	4	0140968	WO	A2	2001-06-07	MOGHUL		☐
	5	H10301911	JP	A	1998-11-13	FUJITSU LTD.		☒
	6	H10162029	JP	A	1998-06-19	DAEWOO ELECTRON CO. LTD.		☒
	7	20000012595	KR	A	2000-03-06	WEBEASY CORP.		☒

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TikTok Inc. v. Distefano Website Innovations, LLC
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	1	LAZAR, J., "THE 10 BIGGEST BLUNDERS THAT BUSINESSES MAKE ON THE WEB," [online] Adapted from Interactive Age, May 22, 1995. Copyright 1995, Lazar Productions [retrieved 04/24/14] retrieved from the Internet: <http://www.jr.co.il/training/web01.txt>, 4 PG.	☐
	2	KENNEDY, D.M., "PRACTICE MANAGEMENT: SITE PLAN 12 STEPS TO PROMOTING YOUR WEBSITE," [online] In General Practice, Solo & Small Firm Division Magazine, Vol. 17, No. 6, Sep. 2000 [retrieved 04/24/14] retrieved from the Internet: <http://www.americanbar.org/newsletter/publications/gp_solo_magazine_home/gp_solo_magazine_index/sep2000kennedy.html>, 4 pg.	☐
	3	"SELLING ONLINE: MORE THAN HITTING A FEW KEYS," In ProQuest, Interactive Daily, Phillips Business Information Corporation © Sep 5, 1995.	☐
	4	PALMER, A. et al., "THE ROLE OF ELECTRONIC COMMERCE IN CREATING VIRTUAL TOURISM DESTINATION MARKETING ORGANISATIONS," [online] In Int'l. J. of Contemporary Hospitality Management, Vol. 12, No. 3, pp. 198-204, 2000.	☐
	5	IYER, S., "FACTORS DISTINGUISHING HIGH TRAFFIC ONLINE STORES FROM LOW TRAFFIC ON-LINE STORES," Thesis - Carleton University, Sprott School of Business, 2000, 94 pg.	☐
	6	SCHWABACH, A., "Intellectual Property: A Reference Handbook," ABC-CLIO, 2007, Pub. Apr. 26, 2007, 318 pg, [Abstract only].	☐
	7	KUMAR, N.S. et al., "Social Networking Site for Self Portfolio,"[online] In UREAT Int'l. J. of Research in Engineering & Advanced Technology, Vol. 1, No. 1, March 2013, retrieved from the Internet: <http://www.ijreat.org/Papers%202013/Volume1/IJREATV1|1055.pdf>, 4 pg.	☐
	8	"LiveJournal.com", [online] LiveJournal, Inc. © 1999, retrieved Jan. 27, 2014, retrieved from the Internet: <http://web.archive.org/web/20000604011251/http://www.livejournal.com/>, 15 pg.	☐
	9	"AsianAvenue.com", [online] Community Connect Inc. © 1997-2000, retrieved Jan. 27, 2014, retrieved from the internet: <https://web.archive.org/web/20000510055338/http://www.asianavenue.com/>, 11 pg.	☐

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	10	"BlackPlanet.com," [online] BlackPlanet.com © 2000, retrieved Jan. 27, 2014, retrieved from the Internet: <https://web.archive.org/web/20000606010618/http://www.blackplanet.com/>, 10 pg.	☐

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Examiner Signature	/KATHERINE KOLOSOWSKI-GAGER/	Date Considered	10/21/2019

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TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
Page 1175 of 1793

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☐ See attached certification statement.

☐ The fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ A certification statement is not submitted herewith.

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A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/SCOTT D. PAUL/	Date (YYYY-MM-DD)	2014-04-28
Name/Print	SCOTT D. PAUL	Registration Number	42984

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Page 1176 of 1793

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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TikTok Inc. EX1002
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Page 1177 of 1793

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	13946461
Filing Date	2013-07-19
First Named Inventor	DISTEFANO III
Art Unit	2172
Examiner Name	PESIN, BORIS M.
Attorney Docket Number	8201-0013

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Examiner Initial*	Cite No	Patent Number	Kind Code[1]	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
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	1	KUMAR, N.S. et al., "Social Networking Site for Self Portfolio," [online] In UREAT Int'l. J. of Research in Engineering & Advanced Technology, Vol. 1, No. 1, March 2013, retrieved from the Internet: <http://www.ijreat.org/Papers%202013/Volume1/IJREATV1I1055.pdf>, 4 pg.	☐
	2	"LiveJournal.com", [online] LiveJournal, Inc. © 1999, retrieved Jan. 27, 2014, retrieved from the Internet: <http://web.archive.org/web/20000604011251/http://www.livejournal.com/>, 15 pg.	☐
	3	"AsianAvenue.com", [online] Community Connect Inc. © 1997-2000, retrieved Jan. 27, 2014, retrieved from the internet: <https://web.archive.org/web/20000510055338/http://www.asianavenue.com/>, 11 pg.	☐
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Signature	/SCOTT D. PAUL/	Date (YYYY-MM-DD)	2014-01-27
Name/Print	SCOTT D. PAUL	Registration Number	42984

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Page 1181 of 1793

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed

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Application Number	13946461
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Art Unit	2447
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Signature	/SCOTT D. PAUL/	Date (YYYY-MM-DD)	2013-08-27
Name/Print	SCOTT D. PAUL	Registration Number	42984

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To: terry.forsythe@iplawpro.com,kevin.cuenot@iplawpro.com,ptomail@iplawpro.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 55246

Oct 24, 2019 03:45:56 AM

Dear PAIR Customer:

Cuenot, Forsythe & Kim
12161 KEN ADAMS WAY
SUITE 120
WELLINGTON, FL 33414
UNITED STATES

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	1449	10/24/2019	8201-0013
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Attorney Docket No.: 8201-0013 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 55246
Thomas DISTEFANO III	:	Confirmation Number: 9140
Application No.: 13/946,461	:	Group Art Unit: 3622
Filed: July 19, 2013	:	Examiner: K. Kolosowski-Gager

For: RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES

PETITION UNDER 37 C.F.R. §§ 1.181, 41.40

Director
Office of Petitions
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition seeks review of the Examiner's failure to designate a rejection as a new ground of rejection in an Examiner's Answer. Pursuant to 37 C.F.R. § 41.40(a), Appellant requests that the period in which to respond to the Examiner's Answer dated October 18, 2019, be tolled pending disposition of the present Petition.

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ISSUE PRESENTED

The issue is whether the Examiner failed to designate, in the Examiner's Answer dated October 18, 2019, the Examiner's rejections of the claims under 35 U.S.C. §§ 101, 103, as new grounds of rejection.

STATEMENT OF FACTS

On August 10, 2018, the Examiner issued a Final Office Action rejecting pending claims 22-26, 28-35, and 38-46. Claims 22-26, 28-35, and 38-46 were subject to a rejection under 35 U.S.C. § 101. Claims 22-26, 28-35, and 38-46 were also subject to a rejection under 35 U.S.C. § 102 for anticipation based upon Horstmann, U.S. Patent No. 5,995,099.

In the Examiner's Answer dated October 18, 2019, the Examiner maintained the rejection of claims 22-26, 28-35, and 38-46 under 35 U.S.C. § 101. The Examiner also maintained the rejection of claims 22-26, 28-35, and 38-46 under 35 U.S.C. § 103. The Examiner's Answer did not indicate any new grounds of rejection. The specific differences between the Final Office Action and the Examiner's Answer will be discussed in more detail below.

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STATEMENT OF LAW

The Patent Rules provide that "[a]n examiner's answer may include a new ground of rejection." 37 C.F.R. § 41.39(a)(2). Referring to M.P.E.P. 1207.03(I), any new ground made in an Examiner's Answer must be:

(i) approved by a Technology Center Director and

(ii) prominently identified in the Examiner's Answer with a subheading "New Grounds of Rejection."

New grounds when the Examiner changes thrust of rejection

As stated by the Federal Circuit, "the PTO must 'provide prior notice to the applicant of all 'matters of fact and law asserted' prior to an appeal hearing before the Board.'" Rambus Inc. v. Rea, 731, F.3d 1248, 1255 (Fed. Cir. 2013) (quoting 5 U.S.C. § 554(b)(3)). "[T]he ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection." In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976). In these instances, an applicant must be given fair opportunity to react to the thrust of the rejection.

New grounds with legal arguments and new facts not previously-relied upon by the Examiner

In the decision of In re Stepan Co., 660 F.3d 1341, 1343 (Fed. Cir. 2011), the Federal Circuit stated the following:

> Allowing the Board unfettered discretion to designate a new ground of rejection—when it relies upon facts or legal argument not advanced by the examiner—would frustrate the

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> notice requirements of the APA. *See Dickinson v. Zurko*, 527 U.S. 150, 154 (1999) (stating that the PTO is an agency subject to the APA). (emphasis added)

Thus, the reliance upon facts or legal arguments not advanced by the Examiner constitutes a new grounds of rejection.

New grounds can be found despite relying upon the same statutory ground

Additionally, whether the Examiner has relied upon the same statutory ground (e.g., 35 U.S.C. §§ 101, 102) is not dispositive. See In re Leithem, 661 F.3rd 1316, 1319 (Fed. Cir. 2011) ("[m]ere reliance on the same statutory basis and the same prior art references, alone, is insufficient to avoid making a new ground of rejection when the Board relies on new facts and rationales not previously raised to the applicant by the Examiner") (emphasis added); Stepan at 1345. Thus, where a position or rationale new to the proceedings is advanced, an applicant must be afforded an opportunity to respond to that position or rationale. In re DeBlauwe, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984).

New grounds even when the Examiner is responding to Appellant's arguments

Moreover, even if the Examiner is just responding to Appellant's arguments, new findings and new analysis still constitute new grounds of rejection. In re Biedermann, 733 F.3d 328, 338 (Fed. Cir. 2013), ("[a] new ground of rejection is not negated by the fact that the Board is responding to an appellant's argument") (citing Stepan at 1345).

New claim construction can be a new grounds of rejection

Former Chief Administrative Patent Judge Michael Fleming, in a presentation entitled "Making Effective Use of the Appeal Process & Practice Tips," made the observation that

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"Appeals are won or lost on: Claim interpretation [and] Findings of fact."[1] Consequently, how the claim language is interpreted is a basic thrust of a rejection that is oftentimes determinative of the appeal. Accordingly, in the past, the Board has designated new grounds of rejection in which they relied upon a claim construction not previously-presented. See Ex parte Kelly, Appeal No. 2018-006129 (June 7, 2019) ("Our decision sustaining the rejection is based on an interpretation of independent claim 17 that differs from the Examiner's … we designate the sustained rejection of claim 17 as a new ground of rejection."); Ex parte Silverstein, Appeal No. 2017-006283 (May 15, 2018) (designating new grounds of rejection after relying upon new claim construction); CSR PLC, v. Skullcandy, Inc., Appeal 2013-000114 (April 28, 2015) (Board considered the rejection anew in light of the Federal Circuit's claim interpretation and entered a new ground of rejection based on new reasoning in light of the new claim interpretation[2]).

[1] Available at https://www.uspto.gov/page/making-effective-use-appeals-process-practice-tips.
[2] This characterization of the decision comports with the characterization found on page 10 of the PTAB Standard Operating Procedure 9 available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf

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ARGUMENT

As will be discussed in more detail below, the Examiner presented undesignated new grounds of rejection in both the Examiner's rejection of the claims under 35 U.S.C. § 101 and the rejection of the claims under 35 U.S.C. § 102. Although the Examiner has relied upon the same statutory grounds, the Examiner's Answer contains a number of findings, reasoning, or explanations that differ from the Examiner's analysis contained within the statement of the rejection provided in the Final Office Action.

Moreover, as will also be discussed in more detail below as to the rejection under 35 U.S.C. § 102, this difference is not merely the Examiner citing a different portion of Horstmann that "goes no farther than, and merely elaborates upon, what is taught in the previously cited portion of that reference," see M.P.E.P. § 1207.03(a)(II), or merely "restates the reasoning of the rejection in a different way." See M.P.E.P. § 1207.03. Rather, the Examiner has changed the basic thrust of the rejection to which Appellant has not had a fair opportunity to react.

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New Grounds Within Rejection Based Upon 35 U.S.C. § 102

Examiner's analysis in the Final Office Action

"*establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement*"

The above-reproduced claim language is found within independent claims 22, 32. and 44. (App. Br. 49, 53). This claim language was the subject of Appellant's arguments prior to and during the appeal. (App. Br. 40-48). The Examiner's initial analysis contained within the Statement of the Rejection as to these limitations is found on page 6 of the Final Office Action and reproduced below:

> at least figures 1, 2, 3, and related text, including col 2, lines 55 through col 3, line 41: the bike shop owner and the book store owner form an agreement to display one another's advertisements on their respective pages.

Referring to pages 16 and 17 of the Final Office Action and in response to Appellant's previously-presented arguments, the Examiner also presented the following additional assertions regarding the limitations at issue:

> Applicant next turns to the prior art rejections, beginning on page 30. On pages 31-32, Applicant argues that the manner in which the arrangement is made is distinct from the prior art cited. However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Hortsmann [sic], "A method establishes *reciprocal page links between pages on the Internet*. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party - i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed.

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> Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two parties - clearly present in Horstmann. That the reference uses software to execute some of the verification does not mean there is no "reciprocal agreement" between the two.
>
> Applicant argues that Horstmann allows any link to be initially created, however, this is untrue; the owner of the website may modify the list of links at any time. (emphasis added).
>
> Applicant again argues the reciprocal arrangement, however, as discussed above this is not persuasive as there is clearly an agreement between the bookstore owner and the bike shop owner in Horstmann. Applicant's claims simply require an agreement of any sort. That Horstmann goes above and beyond the creation of the agreement to include verification of performance is irrelevant. (emphasis in original)

The entirety of the Examiner's analysis founds within the Final Office Action regarding the limitations at issue is reproduced above.

Examiner's analysis in the Examiner's Answer

The Examiner's response to Appellant's arguments in the Appeal Brief are found on pages 14-18 of the Examiner's Answer.

New claim construction

Referring to page 14 of the Examiner's Answer, the Examiner presented the following new claim construction:

> Examiner has interpreted these limitations to mean that two parties agree to subsequently provide links to one another's pages when said pages are later rendered. However, Examiner finds that the claim limitations neither implicitly nor explicitly define *what constitutes a "reciprocal arrangement" and/or a given timeline*. Examiner therefore relies on the dictionary definition of reciprocal: "a) an agreement or obligation that is bearing or binding on each of two parties; concerning each of two or more persons or things; b) given or done in return." Thus, "reciprocal" is defined more by the mutual assent of the parties involved rather than the content or agreement reached. A reciprocal agreement could exist when two parties mutually agree to perform the exact same service for one another, but a reciprocal agreement also exists when the parties mutually agree to execute different services for one another, or when parties exchange a service for some other consideration as in a typical transaction, and also wherein both parties agree that

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> one party will perform a task for the other. A reciprocal arrangement could also require performance by one party prior to the other – if friends agree to watch one another's dogs while each is out of town separately, this necessarily requires that one party perform prior to the other. (emphasis added, Examiner's underlining of "both" omitted)
>
> Further, by definition as noted above, a reciprocal gesture may require that the gesture or agreement may in fact require a predicating action on the part of one of the parties – the reciprocal agreement may be performed in return. For example, if one friend treats another to coffee, unprompted, at a subsequent outing the second friend would likely want to make a reciprocal gesture. Again, this could include purchasing the coffees at a later time, but could also include purchasing desert right after. Similarly, if one friend offers to drive, the other might reciprocate with an offer of gas or lunch either before, during or after the ride. Thus, Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual agreement of the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links. (emphasis added, Examiner's italicizing of "in return" omitted).[3]

Here, the Examiner's response to Appellant's arguments involve the presentation of a claim construction not found in the Examiner's prior analysis.

Referring to the italicized portions of the above-reproduced passage, the Examiner first asserts that the claims do not implicitly/explicit define "a reciprocal arrangement" or "a given timeline" (the *given timeline* presumably refers to the order in which the claimed operations occur). The Examiner then proceeds to provide an (uncited) dictionary definition of "reciprocal" while presenting several examples of what the Examiner believes to constitute a "reciprocal arrangement." The Examiner concludes with a claim construction that the "Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual agreement of the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links." Notably,

[3] The Examiner's basis for construing the term "reciprocal arrangement" further continues onto page 15 of the Examiner's Answer.

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this claim construction has not been presented by the Examiner at any other time during prosecution of the application.[4]

The proper claim construction of "reciprocal arrangement" constitutes a basic thrust of the rejection since the three claimed operations of independent claim 22 each refer to a reciprocal arrangement and Appellant's arguments have specifically referred to the limitations associated with the reciprocal arrangement as being a deficiency of the prior art.[5] Referring back to the Examiner's Answer, the Examiner's only analysis regarding the "reciprocal arrangement" is "Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement" and "Applicant again argues the reciprocal arrangement, however, as discussed above this is not persuasive as there is clearly an agreement between the bookstore owner and the bike shop owner in Horstmann." None of these statements present a claim construction of the term "reciprocal arrangement." Additionally, the Examiner's claim construction involves timing aspects (i.e., "and that at some point after the agreement, but not necessarily before performance

[4] At most, the Examiner previously asserted in the Final Office Action that "Applicant's claims simply require an agreement of any sort." To the extent that the Examiner's statement that "claims simply require an agreement of any sort" could be considered a claim construction, such a claim construction substantially differs from the claim construction now presented in the Examiner's Answer.

[5] See, e.g., page 39 of the Appeal Brief ("the bookstore owner has not opted into this particular reciprocal arrangement at the time that the links were included in the first and second web pages" and "at no time does Horstmann inherently (i.e., necessarily) or explicitly teach that both of the users opt to participate in the reciprocal arrangement since one of the users"); page 41 of the Appeal Brief ("creation of the link from the bookstore's page to the bike shop's page is not based upon a reciprocal arrangement," "the user associated with the bookstore's page does not opt to participate in the reciprocal arrangement, as claimed," "the user associated with the bookstore's page cannot opt into "a reciprocal arrangement between the first web page and the second web page"); page 42 of the Appeal Brief ("the bookstore's owner has not opted to participate in this particular reciprocal arrangement," "the bike shop owner has not necessarily opted into the reciprocal arrangement since a link from the bike store page to the bookstore page does not necessarily exist"); page 43 of the Appeal Brief ("|t]here cannot be an 'agreement between the two parties' when one of the parties does not opt to participate in the reciprocal arrangement").

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on the part of the other") that were not previously relied upon by the Examiner in the Final Office Action.[6]

Of particular note, the Examiner admits that the Examiner's analysis is based upon the Examiner's claim construction. Specifically, referring to page 16 of the Examiner's Answer, the Examiner asserted:

> Continuing through Appellant's remarks on page 43, Examiner again contends that when considering the incredibly broad definition of a reciprocal agreement, as well as Appellant's clear lack of definition in the specification and claims as per the timing of said agreement, these remarks are unpersuasive. (emphasis added)

Similarly, on page 17 of the Examiner's Answer, the Examiner asserted:

> Examiner respectfully disagrees, at least in view of the discussion above with respect to the interpretation of the claims. (emphasis added)

Therefore, the Examiner's analysis is predicated upon the Examiner's newly-presented claim construction, which constitutes an undesignated new grounds of rejection that changes the basic thrust of the Examiner's rejection to which Appellant has not had an opportunity to respond.

New findings of fact regarding cited reference of Horstmann

To recap the Examiner's relevant findings regarding Horstmann from the Final Office Action, the Examiner asserted "the bike shop owner and the book store owner form an agreement to display one another's advertisements on their respective pages" and "Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement."

[6] The Examiner presents additional analysis supporting the Examiner's newly-presented claim construction as to what is covered by the claims in the first full paragraph on page 16 of the Examiner's Answer. These additional arguments as to the scope of the claim language are not found in the Final Office Action.

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New finding (1)

Turning to page 16 of the Examiner's Answer, the Examiner stated the following:

> Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages [sic] would be referred to the bookstore." (the Examiner's cited "45 pages" is not found within Horstmann)

However, at no point during prosecution has the Examiner cited to the Background Information portion of Horstmann. Moreover, the Examiner's misleading[7] citation goes to a previously-argued deficiency in Horstmann, which is whether both users opt into the reciprocal arrangement. In this instance, Appellant has not been given an opportunity to react to this new thrust of the rejection in which the Examiner, for the first time, attempts to take teachings from the background of Horstmann (as to Horstmann's admitted prior art) and fold those teachings into Horstmann's disclosed invention. Thus, this new finding is a new grounds to which Appellant has not been afforded an opportunity to respond.

New finding (2)

Turning to page 16 of the Examiner's Answer, the Examiner further stated the following:

> In col. 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop.

This inaccurate[8] characterization of Horstmann goes to the type of information that is provided by each user (i.e., regarding the claimed "based upon both the first and second users opting to

[7] The Examiner's cited portion to the Background Information refers to how links were created in the past – not how Horstmann proposes to create links as part of Horstmann's invention.

[8] The bike shop does not add the link to the bookstore page; rather software on the links server adds the link (column 3, lines 20-24). Moreover, the bike shop does not "then" provide information for the

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participate in the reciprocal arrangement"), and Appellant has not been afforded to address this finding in support of the Examiner's analysis.

New finding (3)

Referring to the paragraph spanning pages 16 and 17 of the Examiner's Answer, the Examiner asserted:

> The inclusion of the verification process does not nullify that an agreement must be reached *prior to* the mutual display of the pages with the corresponding reciprocal links. (emphasis in original)

Yet again, the Examiner presents an inaccurate[9] characterization, critical to the Examiner's rejection, to which Appellant has not been afforded an opportunity to respond. The Examiner did not argue in the Final Office Action that "an agreement must be reached *prior to* the mutual display of the pages with the corresponding reciprocal links" (emphasis in original). The Examiner emphasizes the "prior to" alleged teaching within Horstmann, yet no such finding has been previously made by the Examiner – as to either the "prior to" finding or the entire finding made by the Examiner.

New finding (4)

Referring to the paragraph spanning pages 16 and 17 of the Examiner's Answer, the Examiner asserted:

---

bookstore to create the link; rather, this information is provided by the bike shop user before the link is created in the bookstore web page.

[9] Column 3, lines 24-26 of Horstmann explicitly states that "page A is modified and redisplayed without any intervention from the bookstore owner." Consequently, Horstmann contemplates display of links without an agreement.

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> Examiner reiterates that the claims themselves are not distinguishable over Horstmann in that Horstmann does not allow *both* pages to be rendered with the corresponding links until both parties have fulfilled the agreement. (emphasis in original)

Here the Examiner intermixes a new finding of fact not previously presented with an implied new claim construction. The claims call for both users to "opting to participate in the reciprocal arrangement" – not "both parties have fulfilled the agreement," as alleged by the Examiner. This redefining of what the claims require constitutes a new grounds to which Appellant has not been afforded an opportunity to respond. Thus, this new finding is a new grounds to which Appellant has not been afforded an opportunity to respond.

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New Grounds Within Rejection Based Upon 35 U.S.C. § 101

Referring to page 3 of the Examiner's Answer, the Examiner admits that the Examiner's rejection has changed. Specifically, the Examiner writes:

> The Final Rejection mailed on 10 AUG 2018 did not incorporate the 2019 Revised Patent Subject Matter Eligibility Guidance (hereinafter 2019 PEG), which "(a)ll USPTO personnel...as a matter of internal agency management, (are) expected to follow." Examiner notes that while the analysis of the claims changes slightly in view of the 2019 PEG, the conclusion, i.e. lack of subject matter eligibility for claims 22-26, 28-36, 38-46 has not. Examiner has an analysis incorporating the 2019 PEG below for purposes of both compact prosecution and convenience. Examiner's response to Appellants remarks will follow. (emphasis added)

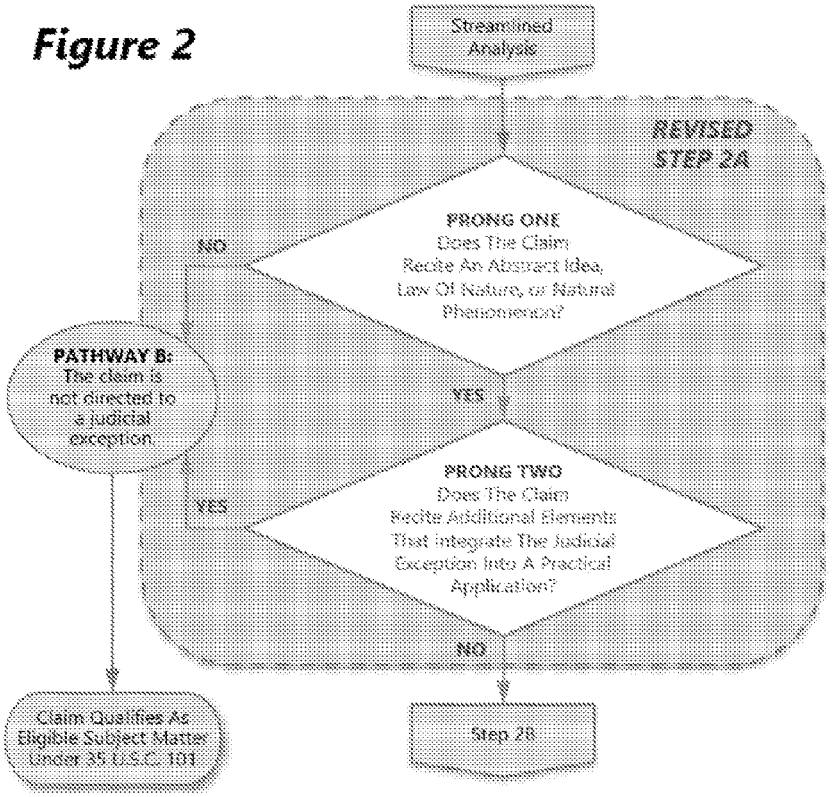
Here, the Examiner admits that the analysis has changed. Although the Examiner attempts to mitigate this admission by asserting that the change is "slightly," the Examiner's changed analysis has changed the thrust of the rejection, and accordingly, these changes should have been designated new grounds of rejection. In the past, the Board has deemed even slight changes to a rejection under 35 U.S.C. § 101 as been sufficient to require designation of a new grounds of rejection. See Ex parte Cataline, Appeal No. 2017-009918 (April 11, 2019) ("Given our characterization of the abstract idea to which claim 58 is directed is somewhat different from that of the Examiner, we denominate our affirmance as a new ground of rejection"); Ex parte An, Appeal No. 2015-004499 (September 19, 2016) ("[b]ecause we expand the § 101 rejection to additional claims and include additional reasoning, we designate this rejection as a new ground").

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New analysis regarding Prong 2 of Step 2A of the Alice/Mayo test

Referring to the October 2019 Update: Subject Matter Eligibility, the following flow chart was presented:

Figure 2



As characterized in the October 2019 Update, "[t]hese figures demonstrate how the revised Step 2A analysis created by the 2019 PEG fits into the overall eligibility analysis set forth in the MPEP." Prong Two asks whether the claim recites additional elements that integrate the judicial exception into a practical application. The Final Office Action does not address this step. However, in the last full paragraph on page 4 of the Examiner's Answer, the Examiner presents a Prong Two analysis not previously-presented by the Examiner. Since a Prong Two analysis is a necessary part of a rejection under 35 U.S.C. § 101 and the Examiner has not

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previously-presented a Prong Two analysis, this new analysis found within the Examiner's Answer constitutes an undesignated new grounds of rejection.

New claim construction

Referring to the bottom of page 4, the Examiner presented the following new analysis:

> Examiner finds in particular that the "links" as claimed are not even claimed *as* a hyperlink or with any capabilities therein – a "link" as claimed could simply be data, but could also just be an advertisement or a note. For example, a paper or other document may contain footnotes therein, which are a "link" to either a source or a different location within the document.

This claim construction was presented as part of the Examiner's analysis as to Prong Two. Of note, this claim construction was made in order to refute that the alleged abstract idea was integrated into a practical application. Not only is the Examiner's analysis as to Prong Two a new ground of rejection, this additional claim construction as to the meaning of "link" is also a new ground of rejection to which Appellant has not had an opportunity to respond.

New analysis regarding the dependent claims

The Examiner's analysis regarding the dependent claims is found on pages 4 and 5 of the Final Office Action. However, the entirety of the Examiner's analysis for each of the dependent claims can be summarized as follows. First, for each dependent claim, the Examiner asserts that the dependent claim is not directed to any additional abstract ideas. Second, for each dependent claim, the Examiner incompletely characterizes the limitations contained therein. Third, for each dependent claim, the Examiner presents the conclusory assertion that this incomplete characterization is not enough to amount to significantly more. In the Appeal Brief, Appellant argued dependent claims 23 and 24.

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Claim 23

Referring to page 6 of the Examiner's Answer, the Examiner asserted the following:

> Dependent claims 23, 33, 45 are not directed any additional abstract idea, however they are directed to the use of a "database" as discussed above with respect to claims 32, 44. As discussed above, storing information in a database is neither a practical application nor significantly more. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as the type(s) of information stored in the database. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention. (emphasis added)

The underlined portion of the above-reproduced passage represents the Examiner's additional analysis that is not found within the Final Office Action. Moreover, the Examiner's rational that "these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention" appears to be a legal argument (dismissing the significance additional elements) under a Step 2B analysis to which Appellant has not has not been afforded a fair opportunity to respond.

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PRAYER FOR RELIEF

Pursuant to 37 C.F.R. § 41.40, Appellant respectfully requests that the present Petition be granted and a new ground of rejection be designated within the Examiner's Answer by which Appellant can reopen prosecution by filing a reply under 37 C.F.R. § 1.111.

Please charge any shortage in fees due, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 503611, and please credit any excess fees to such deposit account.

Date: December 18, 2019

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
CUSTOMER NUMBER 55246

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Electronic Patent Application Fee Transmittal	
Application Number:	13946461
Filing Date:	19-Jul-2013
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Filer:	Scott David Paul/Alaine Allison
Attorney Docket Number:	8201-0013

Filed as Small Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
PETITION FEE - 37 CFR 1.17(F)(GROUP I)	2462	1	200	200
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension-of-Time:				
Miscellaneous:				
		Total in USD ($)		**200**

Electronic Acknowledgement Receipt	
EFS ID:	38073186
Application Number:	13946461
International Application Number:	
Confirmation Number:	9140
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Customer Number:	55246
Filer:	Scott David Paul/Alaine Allison
Filer Authorized By:	Scott David Paul
Attorney Docket Number:	8201-0013
Receipt Date:	18-DEC-2019
Filing Date:	19-JUL-2013
Time Stamp:	15:24:59
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$200
RAM confirmation Number	E2019BHF25192752
Deposit Account	
Authorized User	
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Petition under Rule 41.3 to Chief Admin Patent Judge	8201-0013_PetitiontoDirector_12-18-19.pdf	239236 ec2cb9fac3b8e269c9dd2dd04c00388c703fef4a	no	19
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	30404 d9fad152eaa443bb35a21ca05519f20a29bfacdc	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	269640		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.
National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.
New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 06/02/2020

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109

EXAMINER
KOLOSOWSKI-GAGER, KATHERINE

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
06/02/2020	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kevin.cuenot@iplawpro.com
ptomail@iplawpro.com
terry.forsythe@iplawpro.com

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Cuenot, Forsythe & Kim
12161 KEN ADAMS WAY
SUITE 120
WELLINGTON, FLORIDA 33414

In re Application of DISTEFANO, THOMAS L. III Appl. No. 13/946,461 Filed: July 19, 2013 For: RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES	:	DECISION ON PETITION UNDER 37 CFR §1.181

This decision is in response to Applicant's Petition under 37 CFR §1.181 filed on December 18, 2019, requesting designation of a new grounds of rejection within the Examiner's Answer mailed October 18, 2019 so that prosecution can be reopened.

The Petition is **GRANTED.**

Background

- On August 10, 2018, a Final Office Action was mailed which included a rejection of Claims 22-26, 28-36 and 38-46 under 35 CFR § 101. The Final Office Action also included a rejection of Claims 22-26, 28-36 and 38-46 under 35 CFR § 102 as being anticipated by Horstmann (U.S. Patent No. 5,995,099).

- On February 11, 2019, A Notice of Appeal was filed.

- On July 5, 2019 an Appeal Brief was filed which presented arguments for both the 35 CFR § 101 and the 35 CFR § 102 rejections.

- On October 18, 2019, An Examiner's Answer was mailed.

- On December 18, 2019 the instant petition was filed requesting that the Examiner's Answer designate a new grounds of rejection.

Petition Information

The petition presents the following issues for review:

Issue #1) The Examiner's statements regarding the interpretation of "reciprocal agreement" on page 14 of the Examiner's Answer constitute an undesignated new grounds of rejection.

Issue #2) The statement on page 16 of the Examiner's Answer that "Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages [sic] would be referred to the bookstore" is an undesignated new grounds of rejection.

Issue #3) The statement on page 16 of the Examiner's Answer that "In col. 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop" is an undesignated new grounds of rejection.

Issue #4) The statement on pages 16 and 17 of the Examiner's Answer that "The inclusion of the verification process does not nullify that an agreement must be reached prior to the mutual display of the pages with the corresponding reciprocal links" is an undesignated new grounds of rejection.

Issue #5) The statement on page 17 of the Examiners Answer that "Examiner reiterates that the claims themselves are not distinguishable over Horstmann in that Horstmann does not allow both pages to be rendered with the corresponding links until both parties have fulfilled the agreement" is an undesignated new grounds of rejection.

Issue #6) The 101 analysis in view of the 2019 Revised Patent Subject Matter Eligibility Guidance is an undesignated new grounds of rejection as per:

A) Step 2A Prong 2 analysis
B) The claim construction as to the meaning of "link"
C) The Examiner's discussion of dependent claims

Relevant Rules, Statutes and Procedures

MPEP 1207.03(III) New Ground of Rejection in Examiner's Answer [R-08.2017] states in part:

> *A position or rationale that changes the "basic thrust of the rejection" will also give rise to a new ground of rejection. In re Kronig, 539 F.2d 1300, 1303, 190 USPQ 425, 427 (CCPA 1976). A rejection relying on the same statutory basis and same prior art references, may nevertheless raise a new ground of rejection, when the rejection relies*

on new facts or rationales not previously raised. See In re Leithem, 661 F.3d 1316, 100 USPQ2d 1155 (Fed. Cir. 2011); Rambus v. Rea, 731 F.3d 1248, 108 USPQ2d 1400 (Fed. Cir. 2013) (the inclusion of a new motivation to combine prior art references did not merely elaborate on the examiner's findings with "more detail"). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the "basic thrust of the rejection" is the same. In re Kronig, 539 F.2d at 1303, 190 USPQ at 427; see also In re Jung, 637 F.3d 1356, 1364–65, 98 USPQ2d 1174, 1180 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time "did not change the rejection" and appellant had fair opportunity to respond); In re Noznick, 391 F.2d 946, 949, 157 USPQ 266, 269 (CCPA 1968) (no new ground of rejection made when "explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner"); In re Krammes, 314 F.2d 813, 817, 137 USPQ 60, 63 (CCPA 1963) ("It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection." (citations omitted)); In re Cowles, 156 F.2d 551, 555, 70 USPQ 419, 422 (CCPA 1946) (holding that the use of "different language" does not necessarily trigger a new ground of rejection).

MPEP 1207.03(a)(II) sets forth:

[t]here is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)"...

[i]f the examiner's answer cites a different portion of an applied reference which goes no farther than, and merely elaborates upon, what is taught in the previously cited portion of that reference, then the rejection does not constitute a new ground of rejection.

Discussion and Analysis

In the FAQs posted on https://www.uspto.gov/sites/default/files/documents/faqs_on_2019peg_20190107.pdf on January 8, 2019, the office gave guidelines in Item C2 on what constitutes changing the thrust of the invention. The guidelines state "Relying on the same Step 2B considerations under Revised Step 2A-Prong 2 and Step 2B was were previously relied upon;" does not constitute a new grounds of rejection.

With respect to Issue #6, Item B) Claim construction: the Petitioner argued that the Examiner's analysis of "link" on page 4 of the Examiner's Answer constituted a new grounds

of rejection. A review of the Final Office Action, mailed on August 10, 2018 and the Examiner's Answer mailed October 18, 2019 reveals that the examiner's rationale for Step 2A, Prong 2 in the examiner's Answer includes an additional analysis on the additional element of the "link". This analysis was not previously presented in Step 2B of the Final Office Action. Therefore the examiner did not rely on the same Step 2B considerations under Revised Step 2A-Prong 2 in the Examiner's Answer.

Therefore since the additional element of the "link" is first presented in the Examiner's Answer, this changes the thrust of the rejection and constitutes a new grounds of rejection.

SUMMARY: The Petition is **Granted.**

In order to clarify the record, the examiner is being directed to 1) with the TC Director's approval, clearly identify the examiner's grounds of rejection of the claims in the revised Examiner's Answer as a new grounds of rejection or 2) re-open prosecution (with supervisory approval) with the new grounds of rejection.

The Application will be returned to the Supervisory Patent Examiner of Art Unit 3622 for further processing.

Any questions regarding this decision should be directed to Jamisue Plucinski, Quality Assurance Specialist, at 571-272-6811.

_/TARIQ R HAFIZ/
Director, Technology Center 3600

Tariq Hafiz, Director
Technology Center 3600
(571) 272-5350

To: terry.forsythe@iplawpro.com,kevin.cuenot@iplawpro.com,ptomail@iplawpro.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 55246

Jun 03, 2020 04:51:42 AM

Dear PAIR Customer:

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 55246 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

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Application	Document	Mailroom Date	Attorney Docket No.
13946461	PETDEC	06/02/2020	8201-0013

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 08/25/2020

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109

EXAMINER
KOLOSOWSKI-GAGER, KATHERINE

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
08/25/2020	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kevin.cuenot@iplawpro.com
ptomail@iplawpro.com
terry.forsythe@iplawpro.com

TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
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Office Action Summary	Application No. 13/946,461	Applicant(s) DISTEFANO, THOMAS L.	
	Examiner KATHERINE KOLOSOWSKI-GAGER	Art Unit 3622	AIA (FITF) Status No

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

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☑ Responsive to communication(s) filed on 12/18/2019.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL.** 2b) ☑ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance 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.

Disposition of Claims*

5) ☑ Claim(s) 22-26,28-36 and 38-46 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☑ Claim(s) 22-26,28-36 and 38-46 is/are rejected.

8) ☐ Claim(s) _____ is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov.**

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

4) ☐ Other: _____.

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Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

This action is in response to the granting of Applicant's petition as filed on 12/18/2019, and granted on 6/2/2020.

Examiner notes that the petition was granted solely with respect to the rejection under 35 USC 101.

Claims 22-26, 28-36, 38-46, as filed on 4/20/2018, are present and have been examined.

Prosecution Re-Opened

In view of the Petition Granted filed on 6/2/2020 PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, Applicant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Applicant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/PETER H CHOI/
Supervisory Patent Examiner, Art Unit 3622

Claim Rejections - 35 USC § 101

The Final Rejection mailed on 10 AUG 2018 did not incorporate the 2019 Revised Patent Subject Matter Eligibility Guidance (hereinafter 2019 PEG), which "(a)ll USPTO personnel...as a matter of internal agency management, (are) expected to follow." Examiner notes that while the analysis of the claims changes slightly in view of the 2019 PEG, the conclusion, i.e. lack of subject matter eligibility for claims 22-26, 28-36, 38-46 has not.

Claims 22-26, 28-36, 38-46 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As explained below, the claims are directed to an abstract idea without significantly more.

With respect to claims 2-26, 28-36, 38-46, the independent claims (claims 22, 32, 44) recite a process, which is a statutory category of invention. Claims 2-26, 28-36, 38-46 are directed further to establishing a reciprocal agreement between a first user and a second user opting to participate in the reciprocal agreement, and including elements of the agreement on pages associated with each of the users. These claim elements are considered to be abstract idea(s) because they are directed to a) a method of organizing human activity which include commercial or legal interaction, including agreements in the form of contracts, as well as advertising, marketing or sales activities or behaviors, and business relationships, as well as managing personal behavior or relationships.

For example, a reciprocal agreement as claimed is clearly an "agreement" between the "first user and second user" as claimed. The remaining limitations as pertaining to the reciprocal agreement between the first and second user are contractual obligations on the part of the first and second user(s), with the resulting pages being fulfillment of the contract or obligation between the first and second user(s). Facilitating a reciprocal agreement between one or more users is categorically managing personal behaviors, and if done for commercial purposes it is a sales or marketing activity. If a claim limitation, under its broadest reasonable interpretation recites commercial and legal interactions, then it falls within the "method of organizing human activity" grouping of abstract ideas. Accordingly, the claim(s) recite abstract ideas.

These judicial exception(s) is/are not integrated into a practical application, in that there are no additional elements or combination thereof to impose a meaningful limit on the judicial exception(s). In particular, claim 22 recites only a computer hardware system configured to serve a first web page and a second web page, and that the page(s) contain "links." Claim 32, 44 further include a "webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)." The computing elements in all claims, such as the computer based method/systems in claim 22, as well as the "computer hardware system," "webpage implementation server system" and "database system," used to "generate a web page" claim elements is/are recited at a high-level of generality (i.e., as a generic processor performing a generic computer function of sending/receiving data, a database used to store data/inputs, etc.) such that it amounts no more than mere instructions to apply the exception using a generic computer component. Further, the web pages and links contained therein are at best extra solution activity – rendering a web page, even with added input, is not a practical application (see MPEP 2106.05g). Examiner finds in particular that the "links" as claimed are not even claimed *as* a hyperlink or with any capabilities therein – a "link" as claimed could simply be data, but could also just be an advertisement or a note. For example, a paper or other document may contain footnotes therein, which are a "link" to either a source or a different location within the document.

Examiner finds no evidence of an improvement to either the functioning of the computer itself nor any technology or field – the computing technology is nominally recited (see MPEP 2106.05(a)). Accordingly, the additional element(s) do not integrate the abstract idea into a practical application, as Examiner finds that there are no meaningful limits to practicing the abstract idea beyond the application of a technology or a drafting effort.

The claim(s) are directed to an abstract idea.

The independent claims are additionally directed to claim elements such as: only a computer hardware system configured to serve a first web page and a second web page, and that the page(s) contain "links" as in claim 22, and Claims 32, 44 further include a "webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)." When considered individually, the computer hardware system configured to serve a first web page and a second web page, the page(s) containing "links" as in claim 22, and the

"webpage implementation server system" configured for similar purposes, as well as a "database system" storing information including a first and second input, a "computer hardware system," and generating the first and second "web page(s)" as in computer hardware system configured to serve a first web page and a second web page, as in claims 32, 44, claim elements only contribute generic recitations of technical elements, and extra solution activities to the claims. It is readily apparent, for example, that the claim is not directed to any specific improvements of these elements. Examiner looks at Applicant's specification at, for example: [018] which describes the database in functional terms only – i.e. that it saves information and is coupled to a server computer. At [044] server computer 140 has or is coupled to a plurality of databases 160, 170, 190. When viewing figure 1 and related text, these databases appear to be linked to or only require a generic, all purpose computer as attached to a registered user (180), a third party potential customer (110), and/or a third party author (12). These paragraphs, and others, make it clear that the invention is in no way directed to a technical improvement, and in fact categorically relies on the "application of" the computing environment to the abstract ideas listed above. Again, Examiner finds the rendering of the webpage, even with "links" to be at best insignificant extra solution activity (see MPEP 2106.05g). Examiner further notes that turning to for example, at [074, 075] the term "link" is used interchangeably with the term "banner," thus further supporting Examiner's conclusion above that a "link" as claimed is merely data or the appearance of information analogous to a footnote and/or banner advertisement.

When the claims are considered individually and as a whole, the additional elements noted above, the claims appear to merely apply the abstract concept to a technical environment in a very general sense – i.e. a generic computer receives information from another generic computer, processes the information and then sends information back (see MPEP 2106.05(f), (h)). The limitations simply append well understood, routine and conventional activities known to the industry at a high level of generality to the judicial exception, in that they recite, at best, sending and receiving of data between one or more computing devices (see MPEP 2106.05(d)). The most significant elements of the claims, that is the elements that outline the inventive elements of the claims, are set forth in the elements identified as an abstract idea. Examiner finds that, particularly in view of the remaining details in the specification, the claims represent a clear drafting attempt at best. The fact that the generic computing devices are facilitating the abstract concept is not enough to confer statutory subject matter eligibility (see MPEP 2106.05(h)).

The claims are directed to an abstract idea, without significantly more.

Dependent claims 23, 33, 45 are not directed any additional abstract idea, however they are directed to the use of a "database" as discussed above with respect to claims 32, 44. As discussed above, storing information in a database is neither a practical application nor significantly more. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as the type(s) of information stored in the database. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 24, 34, 46 are not directed any additional abstract idea, however they are directed to the use of a "database" as discussed above with respect to claims 32, 44. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as the previously identified extra solution activity of rendering/generating a webpage. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 25, 35, are not directed any additional abstract ideas and are also not directed to any additional non-abstract claim elements than those recited above. Rather, these claims offer further descriptive limitations of elements found in the independent claims and addressed above – such as information regarding types of web pages included. While these descriptive elements may provide further helpful context for the claimed invention these elements do not serve to confer subject matter eligibility to the invention since their individual and combined significance is still not heavier than the abstract concepts at the core of the claimed invention.

Dependent claims 26, 28, 36, 38 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of a web asset and providing description of said web asset as a "functional" asset on the page. While providing a web asset provides context, the providing of the descriptive matter of a "functional" asset describes the abstract idea of managing human behaviors as claimed above. The fact that the claim recites the additional elements of "functional" applications is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or

practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 29, 39, are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of providing a recommended page. While providing recommended pages further describes the abstract idea of managing human behaviors as claimed above, that the claim recites the additional elements of recommended pages is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 30, 31, 40, 41 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of providing a graphic from a first user. While providing or including a graphic on a web page further describes the abstract idea of managing human behaviors as claimed above, that the claim recites the additional elements of graphics is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Dependent claims 42, 43 are not directed to any additional abstract ideas beyond those identified above. However, the claim does recite the additional limitations of a registered user. While requiring user registration

further describes the abstract idea of managing human behaviors as claimed above, particularly in view of the types of relationships identified as being "managed;" that the claim recites the additional elements of registration is no different than as discussed in the inclusion of reciprocal pages as discussed above in that this claim provides no improvement to, or practical application beyond the *application of* a website to the abstract idea. The use of a website and related limitations does not amount to significantly more, at least as the use of a website and parsing (again, as claimed), does not reach beyond what is well understood routine and conventional, nor is there any improvement or claim language beyond the general linking of the use of the judicial exception to the field/technological environment of a website (see MPEP 2106.05(h)).

Claim Rejections - 35 USC § 102

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

The following is a quotation of the appropriate paragraphs of pre-AIA 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 –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (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.

Claim(s) 22-26, 28-36, 38-46 is/are rejected under pre-AIA 35 U.S.C. 102(a)/ (e) as being anticipated by Horstmannn et al (US 5995099, filed on 6/10/1996).

- **In reference to claim 22,**

  Horstmannn teaches:

  A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising:

establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement (at least figures 1, 2, 3, and related text, including col 2, lines 55 through col 3, line 41: the bike shop owner and the book store owner form an agreement to display one another's advertisements on their respective pages; *figure 1 shows that Bookstore Site 1 and Bike Shop Site 2 are in such an agreement. In figure 2, the Bike shop views a first page including a link to Bookstore. Bookstore then solicits the mutual agreement – including which of Bike Shop's pages Bookstore is to link to. Bookstore then completes the mutual agreement, and verifies that the Bike Shop linked back to the appropriate page of Bookstore and outputs link information. Similarly to the claimed invention, at step 33 of figure 3, there is a "check" to verify that the pages exists for the locations. Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages would be referred to the bookstore" and "A method establishes reciprocal page links between pages on the Internet." In col 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop. Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links. (Ex. Note as the specification does not specifically describe reciprocal or provide a definition: per the Oxford Dictionary definition of reciprocal: "a) Given, felt or done in return, b) an agreement or obligation that is bearing or binding on each of two parties equally; concerning each of two or more persons or things; b) given or done in return." Thus, "reciprocal" is defined more by the mutual assent of the parties involved rather than the content or agreement reached Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual agreement of*

the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links);

including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and (at least figures 1-3, and related text, including col 3, lines 15-41: once the bike store owner/website has made the agreement, the bookstore owner/website would then have their link included in relevant locations on the bike shop website; *Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links*);

including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity (at least figures 1- 3, and related text, including col 2 line 55 through col 3, lines 15-41: bookstore website now shows the link to the bike store website, based on the bike shop's request and the agreement between the two; *Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links*).

- **In reference to claims 23, 33**

  Horstmannn teaches:

  Wherein the first web page is stored in a database; and the second web page is stored in the database (at least col 2, lines 41-55: websites may be stored in separate or the same server, see also figure 5 and related text: common database stores the reciprocal agreements and/or the updated pages).

- **In reference to claim 24 , 46**

  Horstmannn teaches:

  receiving, from a third user, a request for the first web page (at least col 5 lines 25-34: viewers request the website with the newly updated links, see also figures 5, 3 and related text);

  dynamically generating, using a database, the first web page (at least col 5, lines 5-34: once approved, the links update as in figures 5, 3 and related text); and

  serving, to the third user, the dynamically-generated first web page (at least col 4 lines 6-20, col 5 lines 5-24, figures 3,5 and related text: webpage is rendered with the updated links; bike store owner and/or viewers see the rendered page including links).

- **In reference to claims 25, 35**

  Horstmannn teaches:

  wherein the first web page includes one or more web pages (at least fig 1, 5, 7 and related text, including col 5 lines 25-35, and col 6 lines 41-57: embodiments including "a number of links pages stored" to verify that each link links to an existing page within the website).

- **In reference to claims 26, 36**

  Horstmannn teaches:

  including, within the first web page, a web asset provided by a third party separate from the computer hardware system (at least fig 4 and related text, including col 4 lines 35-43, and figure 5 & related text, including col 4 lines 43-.col 5 line 24: two embodiments of the "add link" feature both are provided by a separate provider, and the pages may interact with them – i.e. "if a bike shop owner is impressed with the "add link" feature of website A...", bike shop owner may add it to his page to make it easier for, for example, bookstore owner to interact).

- **In reference to claims 28, 38**

  Horstmannn teaches:

  wherein the web asset is a functional application (see figure 4, 5, and related text, including col 4 line 43- col 5, line 24: "add link" feature/button is used to functionally modify the page itself).

- **In reference to claims 29, 39**

  Horstmannn teaches:

  providing, to the first user, at least one recommended web page, associated with the computer hardware system, into which the second functional identification element is to be included (at least figures 4, 5, and related text, including col 4, line 43- col 5, line 24: add link is a functional element found on webpage A, and bike shop owner, may decide to include the feature on the bike shop page, or to add a link between the two pages himself, further, system recommends bookstore to bike store owner).

- **In reference to claims 30, 40**

  Horstmannn teaches:

  Wherein the second link is associated with a graphic image *within the second web page* (at least col 4, lines 60-65, fig 5 and related text: link includes the bike shop logo).

- **In reference to claims 31, 41**

  Horstmannn teaches:

  receiving, from the first user, the image (at least col 4, lines 60-65, fig 5 and related text: link includes the bike shop logo; bike shop owner uploads/includes it in the link/editing page).

- **In reference to claim 32, 44**

  Horstmannn teaches:

  A database system storing information associated with the first and second web pages (at least fig 5 and related text, see also col 2 lines 52-54; websites can exist on the same server, at col 3 lines 15-20 "The links server includes software that presents and processes forms, and could be the same server that maintains the bookstore's pages or some other server."), comprising:

  Storing first input received from the first user into the database system (at least col 4 line 45- col 5 line 33: bike shop owner inputs links, which are stored in "links server", see also col 6 line 5-12)

  storing second input received from the second user into the database system (at least col 4 line 45 to col 5 line 59, the bookstore owner, second input, may modify the links page which is again then stored in links server) ,

  establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the

reciprocal arrangement (at least figures 1, 2, 3, and related text, including col 2, lines 55 through col 3, line 41: the bike shop owner and the book store owner form an agreement to display one another's advertisements on their respective pages (at least figures 1, 2, 3, and related text, including col 2, lines 55 through col 3, line 41: the bike shop owner and the book store owner form an agreement to display one another's advertisements on their respective pages; *figure 1 shows that Bookstore Site 1 and Bike Shop Site 2 are in such an agreement. In figure 2, the Bike shop views a first page including a link to Bookstore. Bookstore then solicits the mutual agreement – including which of Bike Shop's pages Bookstore is to link to. Bookstore then completes the mutual agreement, and verifies that the Bike Shop linked back to the appropriate page of Bookstore and outputs link information. Similarly to the claimed invention, at step 33 of figure 3, there is a "check" to verify that the pages exists for the locations. Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages would be referred to the bookstore" and "A method establishes reciprocal page links between pages on the Internet." In col 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop. Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links. (Ex. Note as the specification does not specifically describe reciprocal or provide a definition: per the Oxford Dictionary definition of reciprocal: "a) Given, felt or done in return, b) an agreement or obligation that is bearing or binding on each of two parties equally; concerning each of two or more persons or things; b) given or done in return." Thus, "reciprocal" is defined more by the mutual assent of the parties involved rather than the content or agreement reached Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual*

agreement of the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links);

generating, using the first input received from the first user and the reciprocal agreement, the first web page (at least fig 1-3 and related text, including col 2 line 55 to col 4 line 24; Page B, bike site, is now displayed with the link to the book store); and

generating, using the second input received from the second and the reciprocal arrangement, the second web page (at least fig 1-3 and related text, including col 2 line 55 to col 3 line 25: Page A, book site, is now displayed with the link to the bike store), wherein

the second web page includes, and based upon the reciprocal arrangement, a second link to the first web page and (at least figures 1-3, and related text, including col 3, lines 15-41: once the bike store owner/website has made the agreement, the bookstore owner/website would then have their link included in relevant locations on the bike shop website *Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links*);

the first web page includes, and based upon the reciprocal arrangement, a first link to the second web page (at least figures 1- 3, and related text, including col 2 line 55 through col 3, lines 15-41: bookstore website now shows the link to the bike store website, based on the bike shop's request and the agreement between the two; *Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the*

agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links).

- **In reference to claim 34 , 46**

  Horstmannn teaches:

  receiving, from a third user, a request for the first web page (at least col 5 lines 25-34: viewers request the website with the newly updated links, see also figures 5, 3 and related text);

  and serving, to the third user, the dynamically-generated first web page, wherein the first web page is dynamically generated based upon the request (at least col 4 lines 6-20, col 5 lines 5-24, figures 3, 5 and related text: webpage is rendered with the updated links; bike store owner and/or viewers see the rendered page including links; at col 3, lines 20-25: the page is "redisplayed").

- **In reference to claims 42, 43**

  Horstmannn teaches:

  The first and second users are both registered users with the computer hardware system (at least col 4, line 61 to col 5, line 5, fig 6, 7, and related text; both users must enter a password to access the links, i.e. they have registered with the service).

- **In reference to claims 45**

The first web page stored in the database system at least fig 5 and related text, see also col 2 lines 52-54; websites can exist on the same server, at col 3 lines 15-20 "The links server includes software that presents and processes forms, and could be the same server that maintains the bookstore's pages or some other server."; and

The second web page is stored in the database system (at least fig 5 and related text, see also col 2 lines 52-54; websites can exist on the same server, at col 3 lines 15-20 "The links server includes software that presents and processes forms, and could be the same server that maintains the bookstore's pages or some other server.")

Response to Arguments as Filed with Appeal Brief

As applicant's remarks regarding the petition are moot in view of the petition being granted, in the interest of compact prosecution Examiner has included responses largely presented in the Examiner's Answer dated 12/18/2019 as these were the last substantive remarks raised.

Applicant's remarks begin in earnest on page 12, with some restatement of statutory and case law into page 13. Applicant provides some discussion from the relevant portions of the specification, regarding designing or creation of a webpage, however, Examiner respectfully submits that Applicant's claims recite placing "links" on existing webpages, rather than the creation of an entirely new webpage. As per Applicant's assertions on page 14, Examiner again notes that as discussed above, Applicant's links in the claims are not required to be active links or hyperlinks, rather they could be associated with/to data. On page 14 Applicant argues aspects of the prior art in a related Application; Examiner finds this somewhat irrelevant and also unpersuasive; the prior art cited appears to teach that the process of a reciprocal link is in fact known at the time of the invention. Applicant's discussion of the cited prior art is somewhat more relevant, however the cited portions provided by Applicant are at best evidence to the contrary of Applicant's assertion – that the use of reciprocal links does not represent an improvement in the functioning of a computer or related technology. That the cited reference allows a user to "remove" a link further lends to Examiner's point that the use of a link on a webpage, as monitored or manipulated by a user, does not represent an improvement. The process identified on page 15 of Applicant's remarks further describes a process of reciprocal links, at least as far as is claimed. While

Applicant's comparison to the prior art is helpful in some ways, Examiner notes that prior art is not a consideration of subject matter eligibility.

On page 17, Applicant asserts that two limitations in particular represent an improvement to "web page and reciprocal link creation." Examiner respectfully disagrees; again while Applicant's remarks are helpful contextually, serving a first web page and a second web page was in no way at the time of the invention an "improvement." Again, Applicant's claims do not recite the creation of a web page at any stage, rather, the claims a best recite the rending of modified webpage. This is not the same. Applicant's claims in no way circumvents the (purported) number of entities as Applicant argues; in contrast the claim is broad enough that each of these "entities" could be easily included in the limitations. Applicant again restates portions of the prior art on pages 18, however this is also unpersuasive in view of the limitations as claimed. Examiner respectfully submits that serving a web page, even with the web page including a first and second link is in no way an improvement to the generation of a webpage, nor the "creation" of a reciprocal link. At best, these limitations require that an existing page is served with additional information at a later time.

Applicant discusses "undesired" reciprocal links on pages 19, 20, and argues that the claims represent an improvement to this purported "problem." Applicant provides no disclosure or support for the assertion that this itself represented a problem, and again discusses the prior art at hand rather than describing improvements found in the claim language. Applicant appears to be arguing, on page 20, that reciprocal links themselves were both a solution and a problem at the time of the invention – Examiner respectfully submits that Applicant cannot have it both ways. For example, reciprocal links as claimed cannot be a solution to a problem of reciprocal links as found in Horstmannn without Applicant necessarily conceding they are one in the same. Again, while Examiner does not dispute that within the specification there is likely disclosure of such a solution, the claims presented do not recite one or differentiate between the two.

On pages 20/21 Applicant discusses remarks raised in the most recent Office Action; Examiner respectfully submits that as noted in the Final Rejection, the solution itself being presented is at least arguably rooted in technology or represents a technical solution, however, the problem being solved, that of "reciprocal agreements" itself is not. Examiner respectfully submits that the term "ancient lineage" as discussed was Applicant's terminology and suggestion. Examiner respectfully disagrees with Applicant's remarks, and finds them to be not relevant.

Applicant's remarks beginning on page 21 discuss the 2019 PEG, issued in January of 2019. The most recent Office Action was mailed in August of 2018, and as such the 2019 PEG was not available at the time. Examiner has provided an updated rejection for purposes of convenience, as discussed above. As Examiner does not assert that the claims fall within a mathematical concept or a mental process, these remarks are found to be moot. With respect to the discussion of the category of "Certain Methods of Organizing Human Activity," Examiner finds Applicant's remarks to be misguided. "Methods of organizing human activity" and "operations necessarily performed on a computer" are not mutually exclusive in any way per the 2019 PEG. Rather, Applicant instead again incorrectly asserts that the claim limitations recite "creation" of a webpage, rather than at best, the display or rendering of a webpage. The claim limitations, as discussed above, represent a method of human activities in the form of a contractual obligation between two entities – i.e. a reciprocal agreement.

Applicant's remarks on page 23, regarding the invention falling into "one of the excluded categories" is found unpersuasive in that it lacks a formal conclusion, and moot in view of the new analysis/conclusions reached above. Examiner respectfully submits that the claim limitations recite an abstract idea in the category of human behaviors/activity.

Applicant further alleges Examiner has not "properly characterized the claimed invention." Applicant again essentially repeats the incorrect conclusion that the claims are directed to generating web pages, when the claims at best recite serving existing webpages for display. This is in no way

analogous to the creation of a new webpage. The claimed invention may be computer implemented, however as noted above the involvement of the computing elements as claimed is so minimal that it appears to at best be applying the abstract idea(s) identified to the computing environment. Again, as noted in the most recent Office Action, Applicant simply asserts a conclusion rather than providing evidence that supports an actual improvement.

Applicant repeats the argument that Examiner has "overgeneralized" the claimed invention, however at least in view of the analysis above this is unpersuasive. Examiner has categorized the invention appropriately as per the 2019 PEG, and did so with current USPTO Guidance in the Final Office Action. Applicant's reliance on the assertion of "reciprocal links" is again misguided is it does not recite or require any technical features, and therefore does not even imply an improvement.

Applicant's arguments on page 25, regarding the "result" of a reciprocal agreement are found unpersuasive, precisely because exemplary claim 22 at best recites a "result" of a reciprocal agreement – that an existing web page is distributed with additional content. Applicant's claim in no way requires or recites a reduction in the participating entities, an elimination of reciprocal enforcement, or an improved ability to police links. The claims only require a reciprocal agreement between two parties, and displaying the result of the agreement in two web pages. None of the assertions on page 26 are recited in, or even fairly inferred from, Applicant's claim limitations.

As touched upon above, Applicant's remarks regarding analogy to DDR Holdings (beginning on page 26) are similarly misplaced and incorrect. Again, while Examiner finds that the solution is, at least somewhat, rooted in technology, the test of DDR Holdings requires that the problem itself necessarily arise in the realm of computing technology. The improvement in this case is directed to the abstract idea – of agreements between people or entities.

Applicant next turns to a discussion of preemption on page 27 of the Brief. Applicant argues that there is no preemption found; however, as further noted by Applicant, preemption itself is not the sole

test of subject matter eligibility nor does lack of complete preemption imply eligible subject matter. Applicant submits the pending claims do not "tie up" or "prevent" all such agreements between web pages, and thus are statutory under a streamlined analysis. Examiner respectfully disagrees. Though the Supreme Court has described the concern driving the judicial exceptions as preemption, the courts do not use preemption as a stand-alone test for eligibility. (See July 2015 Update: Subject Matter Eligibility.)

Instead, questions of preemption are inherent in the two-part framework from Alice Corp. and Mayo. Examiner notes that "(w)hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." Ariosa v. DNA Diagnostics Center, Inc., __F.3d__, Nos. 2014-1139, 2014-1144, Fed. Cir. 2015 (slip op. at 14). Moreover, the use of "tie up" refers to the results of Steps 2A and 2B of the two-part framework, and is not meant to imply that the streamlined analysis is either a preemption test or a means of avoiding the results that would occur if a claim were to undergo the full eligibility analysis. In fact, the results of the streamlined analysis will always be the same as the full analysis, in that a claim that qualifies as eligible after step 2A or 2B of the full analysis would also be eligible if streamlined analysis were applied to the claim. Moreover, as noted by Examiner throughout the remarks, the abstract idea identified is that of one of managing human activities in the form of agreements or contracts, rather than Applicant's alleged abstract idea of "reciprocal links."

On page 29 of the remarks, Applicant begins a discussion of Step Two of the analysis as applied in prior prosecution and the rejection above. Examiner has provided, both above and in prior prosecution, appropriate evidence for the finding that the use of the computing elements is well understood, routine and conventional. Examiner respectfully disagrees with Applicant's assertion that no evidence has been provided; Examiner has identified the limitations in question as well as identified

the sections of the MPEP upon which Examiner has relied to form the conclusion(s). (See MPEP 2106.05(d), (f), (h).)

Applicant's remarks on pages 30-33 of the Brief are exclusively directed to the rejection presented in the Final Office Action, primarily consisting of a discussion of Examiner's previous reliance on buySafe. Examiner again reiterates that the rejection presented at that time was in compliance with USPTO Policy regarding subject matter eligibility, and the appropriate analysis was executed. In view of the 2019 PEG, which no longer requires specific citation or analogy to relevant examples, these remarks are found largely moot. Further, as noted in the Final Office Action, – the limitations as they stand specifically recite "establishing a reciprocal arrangement" between a first and second party, and then specifically require that "based on the reciprocal arrangement" both parties are bound to perform. This is analogous with the contract formed between two parties as in buySafe. A contract at its most basic form requires an offer, and acceptance, and an intent to be bound. These elements are found in independent claims 22, 32, 46: the reciprocal arrangement between the two parties is "established" by the "first and second users opting to participate" – i.e. offer, accept, and clear intent. The claim further includes the performance of the contract, in that based on the arrangement, the display occurs.

Similarly, Applicant's remarks on pages 35-37 regarding Examiner's previous citation of/analogy to Return Mail are found similarly unpersuasive/moot. Examiner again respectfully submits that Applicant has misconstrued the remarks in the Final Office Action; Examiner in no way concludes all web pages or links are abstract. Again, Examiner reiterates that while the claims are found to be technical in nature, this is separate from Examiner's reliance on the case as discussed.

With regard to claims 23, 24, 33, 34, 45, 46, as discussed above the recitation of a database is included in these claims, and said recitation is analogous to that found in independent claims 32, 44. As noted in the Final Office Action and above, storing and retrieving information from a database is not itself an immediate indicator of subject matter eligibility in that these limitations are analogous to

functions of a computer found to be well understood, routine and conventional ((see MPEP 2106.05(d)). Further, as discussed above the claims as recited do not provide anything beyond description of the data itself being stored. Description of data being stored is not itself an indicator of subject matter eligibility. As noted above and in the Final Office Action, per then and now current USPTO policy the limitation(s) were considered both individually and as a whole. When considered individually, the storage of information in a database is not sufficient to amount to subject matter eligibility. When considered in combination, the limitations as claimed provide only description of the types of data being stored. Contrary to Applicant's assertions on page 39, these elements/limitations do not "transform the nature of the claim" in to a patent eligible application. As such Examiner respectfully disagrees with Applicant's remarks and submits that the prima facie case of patent ineligible subject matter was properly raised.

Applicant paraphrases claim 24, 32 on page 39, however Examiner respectfully disagrees with Applicant's conclusions at least in view of the discussion above.

On page 40, Applicant begins a discussion of the prior art.

Claim 22 recites, in pertinent part, "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Subsequently claim 22 recites "including within the first/second page and based upon the reciprocal agreement..." links to the respective entity on the second/first webpage. Examiner has interpreted these limitations to mean that two parties agree to subsequently provide links to one another's pages when said pages are later rendered. However, Examiner finds that the claim limitations neither implicitly nor explicitly define what constitutes a "reciprocal arrangement" and/or a given timeline. Examiner therefore relies on the dictionary definition of reciprocal: "a) an agreement or obligation that is bearing or binding on each of two parties; concerning each of two or more persons or things; b) given or done in return." Thus, "reciprocal" is defined more by the mutual assent of the parties involved rather than the content or agreement reached. A reciprocal agreement could exist

when two parties mutually agree to perform the exact same service for one another, but a reciprocal agreement also exists when the parties mutually agree to execute different services for one another, or when parties exchange a service for some other consideration as in a typical transaction, and also wherein both parties agree that one party will perform a task for the other. A reciprocal arrangement could also require performance by one party prior to the other – if friends agree to watch one another's dogs while each is out of town separately, this necessarily requires that one party perform prior to the other.

Further, by definition as noted above, a reciprocal gesture may require that the gesture or agreement may in fact require a predicating action on the part of one of the parties – the reciprocal agreement may be performed in return. For example, if one friend treats another to coffee, unprompted, at a subsequent outing the second friend would likely want to make a reciprocal gesture. Again, this could include purchasing the coffees at a later time, but could also include purchasing desert right after. Similarly, if one friend offers to drive, the other might reciprocate with an offer of gas or lunch either before, during or after the ride. Thus, Examiner has interpreted the reciprocal arrangement as claimed to simply require a mutual agreement of the two parties, and that at some point after the agreement, but not necessarily before performance on the part of the other, both parties present their web pages with corresponding links.

Turning to Applicant's specification, Examiner finds support for this interpretation. Notably, the term reciprocal does not appear until [098, 0100] of the PG Pub. In [098] the system must "determine" if a "reciprocal link site has already been created in the registered user's website" – this supports Examiner's interpretation that the agreement exists at some point, but that performance has not begun. Similarly, at [0100] "The system... determines whether a reciprocal banner ad site has already been created on the registered user's website, so that banner ads from other websites can be displayed on the registered user's website once it is activated. If a banner ad site has not yet been created, the

system 100 creates a banner ad site at step 2036 before returning to step 1650. Otherwise, if a banner ad site has already been created, the system 100 immediately returns to step 1650. Upon activation of the registered user's website, the registered user's website can display an unlimited number of banner ads from other websites on its reciprocal banner ad site, and the system 100 also displays the registered user's banner ad at the marketing locations (websites) that the registered user specified at step 2030."

As such, it is clear from the specification that both the timing of, and the agreement itself, are intentionally left in flux. The specification nowhere else defines the agreement, beyond that both parties "agree" at some point to show the links. Further, the specification clearly recites several steps of checks and "determinations" before the links are both included in each page. The specified paragraphs clearly require that a user's website be both activated, and include a banner ad site being previously created. When comparing these paragraphs to the limitations of claim 22, a "first or second user" could seek a "reciprocal agreement" with the other, but it is possible that the opposite user would not have created the banner ad site. Per the specification, the creation of the banner ad site is required prior to inclusion of the reciprocal links per said reciprocal agreement.

Horstmannn as cited teaches that two merchants agree to mutually share links pertaining to one another on their respective pages. A cursory review of figure 1 shows that Bookstore Site 1 and Bike Shop Site 2 are in such an agreement. In figure 2, the Bike shop views a first page including a link to Bookstore. Bookstore then solicits the mutual agreement – including which of Bike Shop's pages Bookstore is to link to. Bookstore then completes the mutual agreement, and verifies that the Bike Shop linked back to the appropriate page of Bookstore and outputs link information. Similarly to the claimed invention, at step 33 of figure 3, there is a "check" to verify that the pages exists for the locations. Column 1, while mostly providing background, specifically states: "In return for providing a link to the bike shop, the bookstore would likely require a link from the bike shop back to the bookstore so that users accessing bike-shop 45 pages would be referred to the bookstore;" and "A method establishes

reciprocal page links between pages on the Internet." In col. 2, 3, as cited, the first party, the bike shop, adds a link to the bookstore page, and then provides information so that the bookstore may appropriately link to the pages of the bike shop. Verification software ensures this actually occurs. Similarly, in column 4, the links software will verify that the reciprocal agreement has taken place. The reciprocal agreement is initiated when the first user indicates to the second user that links are to be provided, and then once the agreement is executed on both parts, the pages are subsequently rendered as complete with the additional links.

Turning to Applicant's remarks, beginning on page 41, Examiner respectfully submits Applicant continues to argue that which is not claimed – the content of the agreement, and the timing or manner in which the agreement "must" be executed. The use of verification software to determine performance on the part of one of the owners does not negate that a reciprocal agreement is present. If the second owner does not want to participate, then there is naturally, no reciprocal agreement found and the links are removed or not displayed. If both parties agree, and the verification software finds that both have fulfilled the explicitly reciprocal agreement as in Horstmannn, then the pages are displayed as such. Contrary to Applicant's remarks on page 43, a reciprocal agreement is proposed when the Bike Store owner seeks inclusion of the link on the Book Store page. If the Bike Shop does not fulfill the proposed reciprocal agreement, then the link is removed. This is, per dictionary definition and Applicant's specification, a reciprocal agreement.

Applicant's remarks on page 43 regarding the "scheme" of Horstmannn necessarily fails, at least in view of Applicant's own remarks: Applicant partially correctly states that Horstmannn "allows anybody to place a link on the bookstore's page so long as the form associated with the "add link" link has been completed," however Applicant leaves out that the receiving page must also include the link in order to perfect or complete the reciprocal agreement. That the identity is potentially unknown to one or more parties is not relevant to the claims as presented. Continuing through Applicant's remarks on

page 43, Examiner again contends that when considering the incredibly broad definition of a reciprocal agreement, as well as Applicant's clear lack of definition in the specification and claims as per the timing of said agreement, these remarks are unpersuasive. The inclusion of the verification process does not nullify that an agreement must be reached prior to the mutual display of the pages with the corresponding reciprocal links.

On page 44, Applicant submits that while the end result is uncontested, i.e. the display of reciprocal links, Applicant finds some distinction in the manner of achieving the result. Examiner respectfully disagrees, at least in view of the discussion above with respect to the interpretation of the claims. Examiner reiterates that which is supplied by Applicant on page 44, and found in the Final Office Action:

"However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Horstmannn, "A method establishes reciprocal page links between pages on the Internet. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party – i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed.

Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two parties – clearly present in Horstmannn. That the reference uses software to execute some of the verification does not mean there is no "reciprocal agreement" between the two."

Despite Applicant's remarks on page 45, Examiner has clearly demonstrated a fair and reasonable interpretation of the claim language in view of the limitations and the specification. It is not possible to "overgeneralize" when the limitation itself has been left so intentionally broad. Again, Examiner reiterates that the claims themselves are not distinguishable over Horstmannn in that Horstmannn does not allow both pages to be rendered with the corresponding links until both parties have fulfilled the agreement. That one party performs their portion – be it including a link, or a friend picking up the check, without first being "asked" is no different from the limitations as claimed. The parties agree to perform, as Applicant does not dispute, reciprocal link inclusion. Applicant's claims in no way preclude the means in which Horstmannn executes this end result, despite encouragement from Examiner to do so.

Applicant's final remarks appear to have been addressed at length elsewhere in Examiner's. However, Examiner again notes that per the claim language, and per the specification, Examiner's interpretation both in the Final Office Action (as replicated by Applicant on page 46) is appropriate. All that is required to satisfy claim 22 is that two parties mutually submit to an agreement. Despite Applicant's remarks, there is no limitation or requirement for timing, no description as to what the agreement itself is, and no requirement as to when both or one must perform the agreement. The owners of the respective stores are in no way limited as to when and how they agree to ultimately display the corresponding reciprocal links, it is only required that at some point both agree to fulfill the obligation mutually.

Response to Arguments as Included in the 8/10/2018 Final Rejection

Selected relevant excerpts from Examiner's remarks as shown in the August 2018 Final rejection have been included for Applicant's convenience:

Applicant next turns to the prior art rejections, beginning on page 30. On pages 31-32, Applicant argues that the manner in which the arrangement is made is distinct from the prior art cited. However, claim 22 specifically only requires: "establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Per the cited portions of Hortsmann, "A method establishes *reciprocal page links between pages on the Internet*. According to the method, individual sites (collections of pages) include dedicated links pages that contain lists of links, primarily to other sites." Col 3 further discloses that the bike shop owner and the bookstore owner agreed to the reciprocal arrangement, and that the system automatically checks for the reciprocity. Further, if the system does not find the required reciprocal link, the system removes the reciprocal link of the compliant party – i.e. if the bookstore does not post the required reciprocal link, the like on the bike shop page is removed.

Applicant is attempting to argue limitations or aspects of the invention that are simply not present in the claims. All that is required is an agreement between the two parties – clearly present in Horstmannn. That the reference uses software to execute some of the verification does not mean there is no "reciprocal agreement" between the two.

Applicant argues that Horstmannn allows any link to be initially created, however, this is untrue; the owner of the website may modify the list of links at any time.

Applicant again argues the reciprocal arrangement, however, as discussed above this is not persuasive as there is clearly an agreement between the bookstore owner and the bike shop owner in

Horstmannn. Applicant's claims simply require an agreement of any sort. That Horstmannn goes above and beyond the creation of the agreement to include verification of performance is irrelevant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE KOLOSOWSKI-GAGER whose telephone number is (571)270-5920. The examiner can normally be reached on Monday - Friday.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Uber can be reached on 571-270-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE KOLOSOWSKI-GAGER/
Primary Examiner, Art Unit 3622

Search Notes	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13/946,461	DISTEFANO, THOMAS L.
	Examiner	Art Unit
	KATHERINE KOLOSOWSKI-GAGER	3622

CPC - Searched*		
Symbol	Date	Examiner
(G06F17/2247 OR G06F3/0481 OR G06F17/2235 OR G06Q30/02 OR G06Q30/0207 OR G06Q30/0256 OR G06Q30/0273 OR G06Q30/0276 OR G06Q30/0277 OR G06Q30/0641 OR G06Q30/08 OR A01G9/227 OR B60R22/19 OR E06B3/285 OR	1/10/16	dl

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
705	14.1	1/10/16	dl

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
east	1/10/16	dl
EAST	December 2017	KKG
Online	December 2017	KKG
Consulted with SPE Peter Choi re: reopening	August 2020	KKG

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
705/G06Q	14.1/30/00	1/10/16	DL

/KATHERINE KOLOSOWSKI-GAGER/ Primary Examiner, Art Unit 3622	/KATHERINE KOLOSOWSKI-GAGER/ Examiner.Art Unit 3622

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To: terry.forsythe@iplawpro.com,kevin.cuenot@iplawpro.com,ptomail@iplawpro.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
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Aug 25, 2020 03:53:38 AM

Dear PAIR Customer:

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UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 55246 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

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Application	Document	Mailroom Date	Attorney Docket No.
13946461	CTNF	08/25/2020	8201-0013

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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

Attorney Docket No.: 8201-0013 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 55246
Thomas DISTEFANO III	:	Confirmation Number: 9140
Application No.: 13/946,461	:	Group Art Unit: 3622
Filed: July 19, 2013	:	Examiner: K. Kolosowski-Gager

For: GRAPHICAL USER INTERFACE FOR MODIFYING WEB PAGES TO INCLUDE HYPERLINKS (as amended)

AMENDMENT

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following Amendment and Remarks are submitted in response to the Office Action dated August 25, 2020.

Electronic Acknowledgement Receipt	
EFS ID:	41232648
Application Number:	13946461
International Application Number:	
Confirmation Number:	9140
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Customer Number:	55246
Filer:	Scott David Paul/Alaine Allison
Filer Authorized By:	Scott David Paul
Attorney Docket Number:	8201-0013
Receipt Date:	25-NOV-2020
Filing Date:	19-JUL-2013
Time Stamp:	19:35:13
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		US_Appln_13946461_ResponsetoNonFinalRejection_11-25-2020.pdf	633188 a05a570b7f475cffa0be0d0cb373c989c5c08f40	yes	22

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Applicant Arguments/Remarks Made in an Amendment	11	22
	Claims	3	10
	Specification	2	2
	Amendment/Req. Reconsideration-After Non-Final Reject	1	1
Warnings:			
Information:			
	Total Files Size (in bytes):	633188	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.
National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.
New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

REMARKS

At the time of the Fifth Office Action dated August 25, 2020, claims 22-26, 28-36, and 38-46 were pending and rejected in this application. Applicant has cancelled claims 22-26, 28-36, and 38-46 and added new claims 47-66. Applicant is not conceding in this application that those claims are not patentable over the prior art cited by the Examiner, as the present claim cancellations and presentation of new claims are only for facilitating expeditious prosecution of the present application.

Applicant acknowledges, with appreciation, Examiner Kolosowski-Gager's courtesy and professionalism in conducting a telephonic interview on November 25, 2020, during which the present Amendment was discussed. As discussed during the interview, the presentation of new claims 47-66 renders the Examiner's prior rejections moot. However, Applicant will address certain portions of the Examiner's rejections as they could apply to the currently-presented claims.

During the interview, the Examiner raised a question as to whether the concept of "Election by Original Presentation"[1] applies to the current claims. Under 37 C.F.R. § 1.142(a), "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted." Additionally, under 37 C.F.R. § 1.142(b), "[c]laims to the invention ... not elected ... are nevertheless withdrawn from further consideration by the examiner by the

[1] See Form ¶ 8.04 found in M.P.E.P. § 821.03.

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election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled."

Reference is made to M.P.E.P. § 803(I), which states:

> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
>
> - (A) The inventions must be independent ... or distinct as claimed ...; and
> - (B) There would be a serious burden on the examiner if restriction is not required. (internal citations to the M.P.E.P. omitted)

Referring to M.P.E.P. § 802.01(I), "[t]he term 'independent' (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect." Referring to M.P.E.P. § 802.01(II), "[r]elated inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER" (emphasis in original). To be clear, the issue does not revolve upon whether the claims are different – any amendment to claims necessarily introduces some differences between old and new claims. Rather, the issue is whether there is "no disclosed relationship" such that "they are not connected in at least one of design, operation, and affect."

Applicant's position is that the claims are connected "in at least one of design, operation, or effect." Consequently, the currently-presented claims are not independent from the previously-presented claims. Generically speaking, both the old claims and the new claims are connected in that they both describe (i) receiving information associated with two different users regarding the creation of hyperlinks between first and second websites respectively associated with these users,

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(ii) storing information pertaining to (i), and (iii) modifying the first and second websites to include the hyperlinks based upon the stored information.

As to points (i) and (ii) independent claim 44 included the limitations of "storing first input received from the first user into a database system coupled to the computer hardware system; storing second input received from the second user into the database system; establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Similarly, newly-presented claim 47 recites "receiving, from the first client device ..., a first identification associated with a second website to create a first hyperlink from the first website to the second website" and "receiving, from a second client device ..., a second identification associated with the first website to create a second hyperlink from the second website to the first website." Thus, information is received regarding the creation of hyperlinks between first and second websites. Claim 47 also recites storing first and second information respectively indicating that the first and second identification was received. As to point (iii), independent claim 22 included the limitations of "including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity." Similarly, newly-presented claim 47 recites "modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received." Therefore, the claims are connected "in at least one of design, operation, or effect." Consequently, had both sets of claims been 'originally presented,' an election requirement between these set of claims would not be

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proper. Thus, the concept of "Election by Original Presentation" does not apply to the currently-presented claims.

As discussed in the interview, Applicant intends to file a Petition under 37 C.F.R. § 1.182 and M.P.E.P. § 1490(VIII)[2] to withdraw the Terminal Disclaimer that was filed on August 27, 2013, as to U.S. Patent Nos. 8,423,399, 8,412,570, 8,442,860, 8,417,567, 8,335,713, and 7,996,259.[3] In past petitions, a determination by the Examiner that a previously-filed terminal disclaimer did not apply to the currently-amended claims was a factor in granting the petition. For example, in U.S. Application No. 11/011,176, the following was written:

> The petition is **GRANTED**.
>
> The examiner responsible for the above-identified application has indicated that the terminal disclaimer filed June 30, 2009 does not apply to any of the claims as currently amended. Accordingly, on petition the terminal disclaimer is withdrawn.

Similarly, in U.S. Application No. 10/753,066, the following was written:

> The petition is **granted**.
>
> Examiner Phylesha Dabney has determined that it is appropriate for the terminal disclaimer filed June 29, 2006, to be withdrawn[1]. The terminal disclaimer is withdrawn, accordingly.

Another example is found in U.S. Application No. 08/487,081, in which the following was written:

---

[2] "If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent."

[3] U.S. Patent No. 7,996,259 has been reissued as U.S. Patent No. RE45,971.

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The petition is granted.

Petitioners assert that the Terminal Disclaimer filed on 15 June, 2004, does not apply to any claim currently of record and was erroneously submitted.

As the examiner has concurred that the Terminal Disclaimer does not apply to any claim currently of record, the request can be favorably considered.

In this instance, the currently-amended claims recite, in part, the following limitations:

> the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system,
>
> the first identification is based upon a selection associated with the second website, and
>
> the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface.

These limitations, describing specific aspects of the graphical user interface, had not been previously-claimed in any of U.S. Patent Nos. 8,423,399, 8,412,570, 8,442,860, 8,417,567, 8,335,713, and 7,996,259. Moreover, Applicant's position is that these claim limitations are not obvious in view of the claims contained within these patents. Consequently, consistent with the Petition decisions described above, the previously-filed Terminal Disclaimer is unnecessary with respect to the currently-presented claims. So as to expedite prosecution, Applicant respectfully requests that the Examiner review the previously-disclaimed patents and to confirm, in the written record, Applicant's position that the previously-filed Terminal Disclaimer is unnecessary with respect to the currently-presented claims.

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The Examiner asserted that the previously-presented claims are anticipated under 35 U.S.C. § 102 based upon Horstmann, U.S. Patent No. 5,995,099. Reference is made to column 3, lines 20-26 of Horstmann, which is reproduced below:

> other server. Software on the links server (step **4**) automatically modifies page A to include a link **6** (the fourth link information) from page A to page D as requested by the bike-shop owner. The new page A, including the link to page D, is then redisplayed to the bike-shop owner. Thus, page A is modified and redisplayed without any intervention from the bookstore owner.

While Horstmann describes the creation of links between web pages, this is done "without any intervention" from one of the users associated with these web pages. Referring to the prior "[g]enerically speaking" description of the claimed invention, the claimed invention involves "receiving information associated with two different users regarding the creation of hyperlinks between first and second websites respectively associated with these users." However, as described above, this does not occur since the link is created "without any intervention from the bookstore owner."

The additional limitations (discussed above and not contained in any of the previously-disclaimed patents) also distinguish the currently-claimed invention over Horstmann. For example, the claims now recite "the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system." In Horstmann, however, there is no display of identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system. Instead, the process of adding a link to a

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page involves a user filling out a form (associated with the page to which the user would like a link from), which is illustrated in steps 30-33 in Figure 3 and further described in column 3, line 43 through column 4, line 11. As described therein, a user visiting a website can "select[] add-link button 3 to add a link from [the visited] site 1 to [the user's] site 2." The user "retrieves form 4" which solicits information used to generate the link (to the user's site 2) on the visited site 1. Consequently, these additional limitations also distinguish the claimed invention over Horstmann.

Previously, the Examiner rejected the pending claims under 35 U.S.C. § 101. As recognized by the Examiner in the interview, the currently-presented claims are substantially more detailed than the previously-presented claims. Applicant refers to the *2019 Revised Patent Subject Matter Eligibility Guidance* (*2019 P*EG) published on January 7, 2019 (84 Fed. Reg. 50), as well as the *October 2019 Update: Subject Matter Eligibility* (*October 2019 PEG Update*) published on October 18, 2019 (84 Fed. Reg. 55942). Reference is also made to the *2019 PEG Examples 37 through 42*,[4] which were also published on January 7, 2019. As stated on page 12 of the *2019 PEG*, "[t]he Supreme Court has long distinguished between principles themselves (which are not patent eligible) and the integration of those principles into practical applications (which are patent eligible)." Referring to page 18 of *2019 PEG* and as Prong 2 of Step 2A, the Examiner is asked to "evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception." This Step 2A Prong 2 is further described in detail on pages 10-15 of the *October 2019 PEG Update*.

[4] Available at https://www.uspto.gov/sites/default/files/documents/101_examples_37to42_20190107.pdf.

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Prong One of Revised Step 2A

As stated on page 17 of the *2019 PEG*, under Prong One of the Revised Step 2A, Examiners are now to perform the following:

> (a) identify the specific limitation(s) in the claim under examination (individually or in combination) that the examiner believes recites an abstract idea; and
> (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance.

As further stated in the *2019 PEG*, "[i]f the ... limitation(s) [identified in (a)] falls within the subject matter groupings of abstract ideas enumerated in Section I, analysis should proceed to Prong Two in order to evaluate whether the claim integrates the abstract idea into a practical application." As stated on page 15 of the *2019 PEG*, "[i]f the claim does not recite a judicial exception ... then the claim is eligible at Prong One of revised Step 2A" and "[t]his concludes the eligibility analysis." Applicant's position is that the claims do not recite an abstract idea, and consequently, Prong Two of revised Step 2A does not have to be addressed.

Mental Processes

The 2019 PEG has described the category of "Mental process" as "concepts performed in the human mind and provided examples as being "an observation, evaluation, judgement, opinion." Reference is made to page 11, footnote 14 of the *2019 PEG*, which states the following about processes that can be performed in the mind:

> If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind. (emphasis added)

The current claims recite operations relating to the generation of websites. These operations include: (i) receiving information from a client device and via a graphical user interface; (ii)

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storing related information in a computer database information; (iii) modifying a website based upon a received selection of a web asset; (iv) modifying websites to include hyperlinks between one another; and (v) serving, in response to a web page request from a third client device, a web page of one of these websites to the third client device. These are all computer operations necessarily performed with the use of a computer. Notably, the claimed invention cannot practically be performed in the mind. The end results (i.e., the modification of a website and the serving of a web page of the website) cannot be performed at all in the human mind (practically or impractically). Consequently, Applicant's position is that the claims do not recite an abstract idea.

Certain Methods of Organizing Human Activity

Reference is made to pages 4 and 5 of the *October 2019 PEG Update*, which states as follows:

> The term "certain" qualifies the "certain methods of organizing human activity" grouping as a reminder of several important points. First, not all methods of organizing human activity are abstract ideas (e.g., "a defined set of steps for combining particular ingredients to create a drug formulation" is not a "certain method of organizing human activity"). Second, this grouping is limited to activity that falls within the enumerated sub-groupings of fundamental economic principles or practices, commercial or legal interactions, managing personal behavior, and relationships or interactions between people, and is not to be expanded beyond these enumerated sub-groupings except in rare circumstances as explained in Section III(C) of the 2019 PEG. (emphasis added)

As stated therein, not all methods of organizing human activity are abstract ideas, and this grouping is limited, except in rare circumstances, to those activities identifying within the *2019 PEG*. Consistent with the description above, Applicant respectfully submit that the claims do not involve one of the enumerated "certain methods of organizing human activity." The claims describe operations used in the modifying and serving of a web page of a website. The claims do not involve "fundamental economic principles or practices, commercial or legal interactions,

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managing personal behavior, and relationships or interactions between people," and consequently, the claims do not recite an abstract idea that falls within the grouping of "certain methods of organizing human activity."

Prong Two of Revised Step 2A

Referring to page 18 of *2019 PEG* and as Prong 2 of Step 2A, the Examiner is asked to "evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception." This Step 2A Prong 2 is further described in detail on pages 10-15 of the *October 2019 PEG Update*. Referring to page 19 of the *2019 PEG*, the Examiner is required to perform the following:

> (a) identify[] whether there are any additional elements recited in the claim beyond the judicial exception(s); and
>
> (b) evaluat[e] those additional elements individually and in combination to determine whether they integrate the exception into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit.

Reference is also made to page 12 of the *October 2019 PEG Update*, which states:

> The additional limitations should not be evaluated in a vacuum, completely separate from the recited judicial exception. Instead, the analysis should take into consideration all the claim limitations and how those limitations interact and impact each other when evaluating whether the exception is integrated into a practical application.

Therefore, the integration analysis involves both the additional elements as well as those elements directed to the judicial exception.

Applicant's position is that the claims do not recite an abstract idea, and as noted above, "[i]f the claim does not recite a judicial exception … then the claim is eligible at Prong One of

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revised Step 2A" and "[t]his concludes the eligibility analysis." However, to the extent that the Examiner believes that there is something within the currently-presented claims that could be considered the recitation of an abstract idea, Applicant respectfully submits that this alleged abstract idea has been integrated into a practical application.

Reference is made to *2019 PEG Examples 37 through 42*, and in particular, reference is made to Claim 1 of Example 37 and Claim 1 of Example 42. In both of these instances, a determination was made that each of the claims recited a judicial exception. However, in both of these instances, a determination was made that these claims also included additional elements that integrated the alleged judicial exception into a practical application. Notably, these "additional elements" were more than generic computing devices (i.e., "memory…processor…device…"). For example, Claim 1 of Example 42 was determined to include the following additional elements:

> The claim recites a combination of additional elements including storing information, providing remote access over a network, converting updated information that was input by a user in a non-standardized form to a standardized format, automatically generating a message whenever updated information is stored, and transmitting the message to all of the users.

The two claimed "storing …" operations are comparable to the "storing information" described with regard to Claim 1 of Example 42. The three different claimed "modifying …" operations describe the modification of a websites, which are neither a mental process nor one of the aforementioned "certain methods of organizing human activity." The claims also describe that the identification associated with the second website involves a particular graphical user interface. All of these limitations serve to integrate whatever possible abstract idea recited in the claims into a practical application – i.e., an improve technique for modifying web pages of websites. Thus, a rejection of the currently-presented claims under 35 U.S.C. § 101 would not be proper.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503611, and please credit any excess fees to such deposit account.

Date: November 25, 2020

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
CUSTOMER NUMBER 55246

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AMENDMENTS TO THE CLAIMS

Claims 1-46 (Cancelled)

47. (New) A method performed within and by a server system configured to modify and serve web pages, comprising:

receiving, from a first client device associated with a first user and via a graphical user interface provided by the server system, information indicating a selection of a web asset to be used in a first website associated with the first user;

receiving, from the first client device and via the graphical user interface, a first identification associated with a second website to create a first hyperlink from the first website to the second website;

storing, within a computer database system of the server system, first information indicating that the first identification was received;

receiving, from a second client device associated with the second website, a second identification associated with the first website to create a second hyperlink from the second website to the first website;

storing, within the computer database system, second information indicating that the second identification was received;

modifying the first website to include the web asset;

modifying the first website to include the first hyperlink to the second website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; and

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modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received;

serving, in response to a web page request from a third client device, a first web page of the first website to the third client device, wherein

the second website is associated with a second user,

the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system,

the first identification is based upon a selection associated with the second website, and

the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface.

48. (New) The method of claim 47, wherein

the graphical user interface is configured to receive an entry associated with the first identification within an entry field box.

49. (New) The method of claim 47, wherein

the graphical user interface is configured to present respective selection boxes adjacent the identifiers respectively associated with the plurality of the previously-created websites.

50. (New) The method of claim 47, wherein

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the server system is configured to identify the plurality of the previously-created websites based upon a receipt, by the server system, of a request generated by the graphical user interface for suggested linking locations for the first website.

51. (New) The method of claim 47, wherein

the graphical user interface is configured to receive information supplied by the first user within at least one information collection field of the graphical user interface, and

the server system is configured to select the plurality of the previously-created websites to be displayed to the first user based upon the information supplied by the first user within the at least one information collection field of the graphical user interface.

52. (New) The method of claim 51, wherein

the information supplied by the first user within the at least one information collection field of the graphical user interface and used to select the plurality of the previously-created websites includes at least one of a group consisting of:

a name of the first user,

an email address of the first user,

a hobby of the first user,

a business of the first user, and

an interest of the first user.

53. (New) The method of claim 51, wherein

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the server system is configured to select the plurality of the previously-created websites by searching information previously-supplied by the other users and stored within the server system, and

the searching is performed by a search engine using the information supplied by the first user within the at least one information collection field of the graphical user interface.

54. (New) The method of claim 51, wherein

the server system is configured to validate the information provided within the at least one information collection field of the graphical user interface.

55. (New) The method of claim 47, wherein

the first website of the first user includes a plurality of web pages including the first web page.

56. (New) The method of claim 47, wherein

the graphical user interface includes:

a primary display screen in which the web asset is displayed, and

an editing platform in a secondary display screen and configured to

edit the web asset and

display an edited version of the web asset.

57. (New) A server system configured to modify and serve web pages, comprising:

a hardware database system, and

a hardware system configured to perform:

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receiving, from a first client device associated with a first user and via a graphical user interface provided by the server system, information indicating a selection of a web asset to be used in a first website associated with the first user;

receiving, from the first client device and via the graphical user interface, a first identification associated with a second website to create a first hyperlink from the first website to the second website;

storing, within the hardware database system, first information indicating that the first identification was received;

receiving, from a second client device associated with the second website, a second identification associated with the first website to create a second hyperlink from the second website to the first website;

storing, within the hardware database system, second information indicating that the second identification was received;

modifying the first website to include the web asset;

modifying the first website to include the first hyperlink to the second website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; and

modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received;

serving, in response to a web page request from a third client device, a first web page of the first website to the third client device, wherein

the second website is associated with a second user,

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the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system,

the first identification is based upon a selection associated with the second website, and

the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface,.

58. (New) The server system of claim 57, wherein

the graphical user interface is configured to receive an entry associated with the first identification within an entry field box.

59. (New) The server system of claim 57, wherein

the graphical user interface is configured to present respective selection boxes adjacent the identifiers respectively associated with the plurality of the previously-created websites.

60. (New) The server system of claim 57, wherein

the hardware system is configured to identify the plurality of the previously-created websites based upon a receipt, by the hardware system, of a request generated by the graphical user interface for suggested linking locations for the first website.

61. (New) The server system of claim 57, wherein

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the graphical user interface is configured to receive information supplied by the first user within at least one information collection field of the graphical user interface, and

the hardware system is configured to select the plurality of the previously-created websites to be displayed to the first user based upon the information supplied by the first user within the at least one information collection field of the graphical user interface.

62. (New) The server system of claim 61, wherein

the information supplied by the first user within the at least one information collection field of the graphical user interface and used to select the plurality of the previously-created websites includes at least one of a group consisting of:

a name of the first user,

an email address of the first user,

a hobby of the first user,

a business of the first user, and

an interest of the first user.

63. (New) The server system of claim 61, wherein

the hardware system is configured to select the plurality of the previously-created websites by searching information previously-supplied by the other users and stored within the server system, and

the searching is performed by a search engine using the information supplied by the first user within the at least one information collection field of the graphical user interface.

64. (New) The server system of claim 61, wherein

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the hardware system is configured to validate the information provided within the at least one information collection field of the graphical user interface.

65. (New) The server system of claim 57, wherein

the first website of the first user includes a plurality of web pages including the first web page.

66. (New) The server system of claim 57, wherein

the graphical user interface includes:

a primary display screen in which the web asset is displayed, and

an editing platform in a secondary display screen and configured to

edit the web asset and

display an edited version of the web asset.

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AMENDMENTS TO THE SPECIFICATION

Please amend the Title of the Invention as follows:

GRAPHICAL USER INTERFACE ~~RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS~~ FOR MODIFYING WEB PAGES TO INCLUDE HYPERLINKS

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PTO/SB/06 (09-11)
Approved for use through 1/31/2014. OMB 0651-0032
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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 13/946,461	Filing Date 07/19/2013	☐ To be Mailed

ENTITY: ☑ LARGE ☐ SMALL ☐ MICRO

APPLICATION AS FILED - PART I

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA		RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A		N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (l), or (m))	N/A	N/A		N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*		x $80 =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*		x $420 =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).				
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))					
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL	

APPLICATION AS AMENDED - PART II

AMENDMENT		(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	11/25/2020							
	Total (37 CFR 1.16(i))	* 20	Minus	** 23	= 0		x $100 =	0
	Independent (37 CFR 1.16(h))	* 2	Minus	*** 3	= 0		x $480 =	0
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	0

AMENDMENT		(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	Total (37 CFR 1.16(i))	*	Minus	**	=		x $0 =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=		x $0 =	
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.	LIE
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".	/TRACEY M YOUNG/
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".	
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.	

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 12/10/2020

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109

EXAMINER
KOLOSOWSKI-GAGER, KATHERINE

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
12/10/2020	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kevin.cuenot@iplawpro.com
ptomail@iplawpro.com
terry.forsythe@iplawpro.com

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Applicant-Initiated Interview Summary	**Application No.** 13/946,461	**Applicant(s)** DISTEFANO, THOMAS L.	
	Examiner KATHERINE KOLOSOWSKI-GAGE	**Art Unit** 3622	**AIA (FITF) Status** No

All participants (applicant, applicants representative, PTO personnel):

(1) KATHERINE KOLOSOWSKI-GAGER. (3) _____.

(2) Scott Paul, 42984. (4) _____.

Date of Interview: 25 November 2020.

Type: ☑ Telephonic ☐ Video Conference
☐ Personal [copy given to: ☐ applicant ☐ applicant's representative]

Exhibit shown or demonstration conducted: ☐ Yes ☐ No.
If Yes, brief description: _____.

Issues Discussed ☑101 ☐112 ☐102 ☑103 ☐Others
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: 47.

Identification of prior art discussed: _____.

Substance of Interview
(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant and Examiner discussed the rejection under 101 and 102. No agreement was reached. Examiner was unable to comment further in view of the lengthly agenda/documentation provided.

Applicant is encouraged to incorporate the remarks regarding terminal disclaimers in the submitted response..

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☑ Attachment

/KATHERINE KOLOSOWSKI-GAGER/ Primary Examiner, Art Unit 3622	

TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
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Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) 1.133 Interviews
Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiners responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicants correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,-
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
   (The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicants record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiners version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, Interview Record OK on the paper recording the substance of the interview along with the date and the examiners initials.

Doc Code: M865 or FAI.REQ.INTV

PTOL-413A (07-16)
Approved for use through 07/31/2016. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: 13/946,461 First Named Applicant: THOMAS L. DISTEFANO III
Examiner: KATHERINE KOLOSOWSKI-GAGER Art Unit: 3622 Status of Application: PENDING

Tentative Participants:
(1) KATHERINE KOLOSOWSKI-GAGER (2) SCOTT D. PAUL
(3)_____ (4)_____

Proposed Date of Interview: 11-25-2020 **Proposed Time:** 10:30 (◉AM ◉PM)

Type of Interview Requested:
(1) ☑ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☑ NO
If yes, provide brief description:_____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1)			☐	☐	☐
(2)			☐	☐	☐
(3)			☐	☐	☐
(4)			☐	☐	☐

☑ Continuation Sheet Attached ☑ Proposed Amendment or Arguments Attached
Brief Description of Arguments to be Presented: SEE ATTACHED

An interview was conducted on the above-identified application on _____

NOTE: This form should be completed and filed by applicant in advance of the interview (see MPEP § 713.01). If this form is signed by a registered practitioner not of record, the Office will accept this as an indication that he or she is authorized to conduct an interview on behalf of the principal (37 CFR 1.32(a)(3)) pursuant to 37 CFR 1.34. This is not a power of attorney to any above named practitioner. See the Instruction Sheet for this form, which is incorporated by reference. By signing this form, applicant or practitioner is certifying that he or she has read the Instruction Sheet. After the interview is conducted, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible. This application will not be delayed from issue because of applicant's failure to submit a written record of this interview.

/SCOTT D. PAUL/
Applicant/Applicant's Representative Signature

Examiner/SPE Signature

SCOTT D. PAUL
Typed/Printed Name of Applicant or Representative

561-801-7700, EXT. 1206
Applicant's/Applicant's Representative's Telephone Number

42984
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

US PATENT APPLN. 13/946,461
Our Ref. 8201-0013
ATTACHMENT TO APPLICANT INITIATED
INTERVIEW REQUEST FORM

Applicant wishes to address:

1) Proposed new claims (see Attachments 1A and 1B);

2) Discuss cited reference of Horstmann – in particular, the cited passage reproduced herein:

other server. Software on the links server (step **4**) automatically modifies page A to include a link **6** (the fourth link information) from page A to page D as requested by the bike-shop owner. The new page A, including the link to page D, is then redisplayed to the bike-shop owner. Thus, page A is modified and redisplayed without any intervention from the bookstore owner.

3) Discuss new claims as it pertains to claims in recently allowed 10/868,312 (see Attachments 2A, 2B and 2C); and

4) Discuss terminal disclaimers (see Attachments 3A and 3B)

Respectfully submitted,

/ Scott D. Paul /

Scott D. Paul
Registration No. 42984
CUENOT, FORSYTHE & KIM, L.L.C.
Tel.: (561) 801-7700, ext. 1206
Fax.: (561) 423-9297

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IPR2025-01061
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Claims 1-46 (Cancelled)

47. (New) A method performed within and by a server system configured to modify and serve web pages, comprising:

receiving, from a first client device associated with a first user and via a graphical user interface provided by the server system, information indicating a selection of a web asset to be used in a first website associated with the first user;

receiving, from the first client device and via the graphical user interface, a first identification associated with a second website to create a first hyperlink from the first website to the second website;

storing, within a computer database system of the server system, first information indicating that the first identification was received;

receiving, from a second client device associated with the second website, a second identification associated with the first website to create a second hyperlink from the second website to the first website;

storing, within the computer database system, second information indicating that the second identification was received;

modifying the first website to include the web asset;

modifying the first website to include the first hyperlink to the second website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; and

modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received;

serving, in response to a web page request from a third client device, a first web page of the first website to the third client device, wherein

the second website is associated with a second user,

the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system,

the first identification is based upon a selection associated with the second website, and

the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface.

48. (New) The method of claim 47, wherein

the graphical user interface is configured to receive an entry associated with the first identification within an entry field box.

49. (New) The method of claim 47, wherein

the graphical user interface is configured to present respective selection boxes adjacent the identifiers respectively associated with the plurality of the previously-created websites.

50. (New) The method of claim 47, wherein

the server system is configured to identify the plurality of the previously-created websites based upon a receipt, by the server system, of a request generated by the graphical user interface for suggested linking locations for the first website.

51. (New) The method of claim 47, wherein

the graphical user interface is configured to receive information supplied by the first user within at least one information collection field of the graphical user interface, and

the server system is configured to select the plurality of the previously-created websites to be displayed to the first user based upon the information supplied by the first user within the at least one information collection field of the graphical user interface.

52. (New) The method of claim 51, wherein

the information supplied by the first user within the at least one information collection field of the graphical user interface and used to select the plurality of the previously-created websites includes at least one of a group consisting of:

a name of the first user,

an email address of the first user,

a hobby of the first user,

a business of the first user, and

an interest of the first user.

53. (New) The method of claim 51, wherein

the server system is configured to select the plurality of the previously-created websites by searching information previously-supplied by the other users and stored within the server system, and

the searching is performed by a search engine using the information supplied by the first user within the at least one information collection field of the graphical user interface.

54. (New) The method of claim 51, wherein

the server system is configured to validate the information provided within the at least one information collection field of the graphical user interface.

55. (New) The method of claim 47, wherein

the first website of the first user includes a plurality of web pages including the first web page.

56. (New) The method of claim 47, wherein

the graphical user interface includes:

a primary display screen in which the web asset is displayed, and

an editing platform in a secondary display screen and configured to

edit the web asset and

display an edited version of the web asset.

57. (New) A server system configured to modify and serve web pages, comprising:

a hardware database system, and

a hardware system configured to perform:

receiving, from a first client device associated with a first user and via a graphical user interface provided by the server system, information indicating a selection of a web asset to be used in a first website associated with the first user;

receiving, from the first client device and via the graphical user interface, a first identification associated with a second website to create a first hyperlink from the first website to the second website;

storing, within the hardware database system, first information indicating that the first identification was received;

receiving, from a second client device associated with the second website, a second identification associated with the first website to create a second hyperlink from the second website to the first website;

storing, within the hardware database system, second information indicating that the second identification was received;

modifying the first website to include the web asset;

modifying the first website to include the first hyperlink to the second website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; and

modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received;

serving, in response to a web page request from a third client device, a first web page of the first website to the third client device, wherein

the second website is associated with a second user,

the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system,

the first identification is based upon a selection associated with the second website, and

the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface,.

58. (New) The server system of claim 57, wherein

the graphical user interface is configured to receive an entry associated with the first identification within an entry field box.

59. (New) The server system of claim 57, wherein

the graphical user interface is configured to present respective selection boxes adjacent the identifiers respectively associated with the plurality of the previously-created websites.

60. (New) The server system of claim 57, wherein

the hardware system is configured to identify the plurality of the previously-created websites based upon a receipt, by the hardware system, of a request generated by the graphical user interface for suggested linking locations for the first website.

61. (New) The server system of claim 57, wherein

the graphical user interface is configured to receive information supplied by the first user within at least one information collection field of the graphical user interface, and

the hardware system is configured to select the plurality of the previously-created websites to be displayed to the first user based upon the information supplied by the first user within the at least one information collection field of the graphical user interface.

62. (New) The server system of claim 61, wherein

the information supplied by the first user within the at least one information collection field of the graphical user interface and used to select the plurality of the previously-created websites includes at least one of a group consisting of:

a name of the first user,

an email address of the first user,

a hobby of the first user,

a business of the first user, and

an interest of the first user.

63. (New) The server system of claim 61, wherein

the hardware system is configured to select the plurality of the previously-created websites by searching information previously-supplied by the other users and stored within the server system, and

the searching is performed by a search engine using the information supplied by the first user within the at least one information collection field of the graphical user interface.

64. (New) The server system of claim 61, wherein

the hardware system is configured to validate the information provided within the at least one information collection field of the graphical user interface.

65. (New) The server system of claim 57, wherein

the first website of the first user includes a plurality of web pages including the first web page.

66. (New) The server system of claim 57, wherein

the graphical user interface includes:

a primary display screen in which the web asset is displayed, and

an editing platform in a secondary display screen and configured to

edit the web asset and

display an edited version of the web asset.

To: terry.forsythe@iplawpro.com,kevin.cuenot@iplawpro.com,ptomail@iplawpro.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 55246

Dec 10, 2020 04:04:35 AM

Dear PAIR Customer:

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 55246 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

Disclaimer:
The list of documents shown below is provided as a courtesy and is not part of the official file wrapper. The content of the images shown in PAIR is the official record.

Application	Document	Mailroom Date	Attorney Docket No.
13946461	EXIN	12/10/2020	8201-0013
	INTV.SUM.APP	12/10/2020	8201-0013
	OA.APPENDIX	12/10/2020	8201-0013
	OA.APPENDIX	12/10/2020	8201-0013

To view your correspondence online or update your email addresses, please visit us anytime at https://sportal.uspto.gov/secure/myportal/privatepair.

If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov with 'e-Office Action' on the subject line or call 1-866-217-9197 during the following hours:

Monday - Friday 6:00 a.m. to 12:00 a.m.

Thank you for prompt attention to this notice,

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/946,461	07/19/2013	THOMAS L. DISTEFANO III	8201-0013	9140

55246 7590 01/19/2021

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109

EXAMINER
KOLOSOWSKI-GAGER, KATHERINE

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
01/19/2021	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kevin.cuenot@iplawpro.com
ptomail@iplawpro.com
terry.forsythe@iplawpro.com

TikTok Inc. EX1002
TikTok Inc. v. Distefano Website Innovations, LLC
IPR2025-01061
Page 1285 of 1793

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR/ PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
13/946,461	07/19/2013	DISTEFANO, THOMAS L.	8201-0013

Cuenot, Forsythe & Kim
5425 Park Central Court Suite 111
Naples, FL 34109

EXAMINER	
KATHERINE KOLOSOWSKI-GAGER	
ART UNIT	PAPER
3622	20210107

DATE MAILED: _____

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

Commissioner for Patents

See attached

/KATHERINE KOLOSOWSKI-GAGER/
Primary Examiner, Art Unit 3622

PTO-90C (Rev.04-03)

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

Notice of Non-Responsive Amendment

The amendment filed on 25 NOV 2020 is not fully responsive to the prior Office Action (Non-Final Rejection dated 25 AUG 2020) because of the following omission(s) or matter(s)

Applicant has canceled elected claims 22-26, 28-36, 38-46, and has added claims 47-66. As such, Applicant has canceled all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03) and has not been entered. The remaining claims are not readable on the elected invention because:

Newly submitted claims 47, 57, recite a method performed within and by a server system configured to modify and serve web pages (claim 47), as well as a server system configured to modify and serve web pages comprising a hardware database system and a hardware system configured to perform (claim 57), receiving from a first client device associated with a first user and via graphical user interface provided by the system, information indicating a selection of a web asset to be used in a first website associated with the first user, receiving from the first client device and via the graphical user interface, a first identification associated with a second website to create a first hyperlink from the first website to the second website; storing within a computer database system of the server system, first information indicating that the first identification was received; receiving, from a second client device associated with the second website, a second identification associated with the first website to create a second hyperlink from the second website to the first website; storing, within the computer database system, second information indicating that the second identification was received; modifying the first website to include the web asset; modifying the first website to include the first hyperlink to the second website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; and modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received; serving, in response to a web page request from a third client device, a first web page of the first website to the third client device, wherein

the second website is associated with a second user, the graphical user interface is configured to display identifiers respectively associated with a plurality of previously-created websites that were previously-created by other users of the server system, the first identification is based upon a selection associated with the second website, and the selection associated with the second website is performed using the graphic user interface and is from the plurality of the previously-created websites displayed within the graphical user interface.

These claims and related dependents are separate and distinct from the previously elected claim set of claims 22-26, 28-36, 38-46, because the previously elected claims recite a different invention.

Previously elected claim 22 recites: A method, within and by a computer hardware system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising: establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement; including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity; and including, within the first web page and based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity.

Previously elected claim 32 recites: A webpage implementation server system that is configured to serve a first web page associated with a first user and a second web page associated with a second user, comprising: a database system storing information associated with the first and second web pages; a computer hardware system configured to perform: storing first input received from the first user into the database system: storing second input received from the second user into the database system: establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement; generating, using the first input received from the first user and the reciprocal arrangement, the first web page: and generating, using the second input received from the second and the reciprocal arrangement, the second web page, wherein the second web page includes based on the reciprocal arrangement, a second link to the first web page and the first web page includes based upon the reciprocal arrangement, a first link to the second web page.

including, within the second web page includes, [[and]] based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity; and including, within the first web page includes, [[and]] based upon the reciprocal arrangement, a first link to the second web page and associated with the second entity.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47-66 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a shortened statutory period of TWO (2) MONTHS from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE KOLOSOWSKI-GAGER whose telephone number is (571)270-5920. The examiner can normally be reached on Monday - Friday.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter H. Choi can be reached on (469)295-9171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see https://ppair-my.uspto.gov/pair/PrivatePair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE KOLOSOWSKI-GAGER/
Primary Examiner, Art Unit 3622

Electronic Acknowledgement Receipt	
EFS ID:	41681856
Application Number:	13946461
International Application Number:	
Confirmation Number:	9140
Title of Invention:	RECIPROCAL INSERTION OF IDENTIFICATION ELEMENTS FOR WEB PAGES
First Named Inventor/Applicant Name:	THOMAS L. DISTEFANO
Customer Number:	55246
Filer:	Scott David Paul/Alaine Allison
Filer Authorized By:	Scott David Paul
Attorney Docket Number:	8201-0013
Receipt Date:	19-JAN-2021
Filing Date:	19-JUL-2013
Time Stamp:	15:16:15
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Supplemental Response or Supplemental Amendment	8201-0013_ResponsetoNoticeofNonCompliantAM_01-19-2021.pdf	276185 05dc812c76d4dc8a7d2d92b966b2b1a05f544953	no	8
Warnings:					

Information:	
Total Files Size (in bytes):	276185

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

To: terry.forsythe@iplawpro.com,kevin.cuenot@iplawpro.com,ptomail@iplawpro.com
From: PAIR_eOfficeAction@uspto.gov
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Jan 19, 2021 03:31:35 AM

Dear PAIR Customer:

Cuenot, Forsythe & Kim
5425 Park Central Court
Suite 111
Naples, FL 34109
UNITED STATES

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Application	Document	Mailroom Date	Attorney Docket No.
13946461	NTC.A.NONCPL	01/19/2021	8201-0013

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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

Attorney Docket No.: 8201-0013 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 55246
Thomas DISTEFANO III	:	Confirmation Number: 9140
Application No.: 13/946,461	:	Group Art Unit: 3622
Filed: July 19, 2013	:	Examiner: K. Kolosowski-Gager

For: GRAPHICAL USER INTERFACE FOR MODIFYING WEB PAGES TO INCLUDE HYPERLINKS

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following Remarks are submitted in response to the Notice of Non-Compliant Amendment dated January 19, 2021 (hereinafter the "Notice").

REMARKS

Referring to page 2 of the Notice, the Examiner initially asserted the following in the last full paragraph:

> Applicant has canceled elected claims 22-26, 28-36, 38-46, and has added claims 47-66. As such, Applicant has canceled all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03) and has not been entered. The remaining claims are not readable on the elected invention because:

In the paragraph spanning pages 2 and 3 of the Notice, the Examiner then proceeded to reproduce the limitations of independent claim 47. In the first full paragraph on page 3 of the Notice, the Examiner then asserted:

> These claims and related dependents are separate and distinct from the previously elected claim set of claims 22-26, 28-36, 38-46, because the previously elected claims recite a different invention. (emphasis added)

Referring to the last full paragraph on page 3 of the Notice and to the paragraph spanning pages 3 and 4 of the Notice, the Examiner then reproduced the limitations of previously-presented independent claims 22 and 32. Referring to the first full paragraph on page 4 of the Notice, the Examiner's analysis concluded as follows:

> Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47-66 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's response

At the outset, Applicant notes that the Examiner has not set forth any reasoning for invoking the principle of "Election by Original Presentation." At most, the Examiner has: (i) reproduced the language of the new claims, (ii) reproduced the language of the old claims, and (iii)

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presented the unsupported and conclusory assertion that "these claims ... are separate and distinct ... because the previously elected claims recite a different invention."

Reference is made to the Decision on Petition Under 37 C.F.R. § 1.144 dated December 10, 2018, in U.S. Application No. 13/926,638,[1] which was filed in Tech Center 3600 (hereinafter the Decision). As in the present application, the Examiner in the '638 Application refused to enter new claims asserting that "the invention has been constructively elected by original presentation for prosecution on the merits." Referring to page 2 of the Petition, the Patent Office reproduced the following language from the M.P.E.P.:

MPEP § 803 states:

> **803 Restriction — When Proper [R-08.2017]**
>
> Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01) or distinct (MPEP § 806.05 - § 806.05(j)).
>
> If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.
>
> **I. CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**
>
> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
>
> (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and
>
> (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

[1] The undersigned prepared the underlying Petition that was the basis for this Decision.

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Turning to the present Notice, the Examiner has not presented any analysis regarding either the (A) criteria or the (B) criteria for establishing a proper requirement for restriction. At most, the Examiner has alleged that "the previously elected claims recite a different invention." However, "a different invention" is not the standard. Rather, the standard stated in 35 U.S.C. § 121 is as follows:

> If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. (emphasis added)

Claims are not "independent"

Referring to M.P.E.P. § 802.01(I), "[t]he term 'independent' (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect." To be clear, the issue does not revolve upon whether the claims are different – any amendment to claims necessarily introduces some differences between old and new claims. Rather, the issue is whether there is "no disclosed relationship" such that "they are not connected in at least one of design, operation, and affect."

Applicant's position is that the claims are connected "in at least one of design, operation, or effect." Consequently, the currently-presented claims are not independent from the previously-presented claims. Generically speaking, both the old claims and the new claims are connected in that they both describe (i) receiving information associated with two different users regarding the creation of hyperlinks between first and second websites respectively associated with these users, (ii) storing information pertaining to (i), and (iii) modifying the first and second websites to include the hyperlinks based upon the stored information.

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As to points (i) and (ii) independent claim 44 included the limitations of "storing first input received from the first user into a database system coupled to the computer hardware system; storing second input received from the second user into the database system; establishing a reciprocal arrangement between the first web page and the second web page based upon both the first and second users opting to participate in the reciprocal arrangement." Similarly, newly-presented claim 47 recites "receiving, from the first client device ..., a first identification associated with a second website to create a first hyperlink from the first website to the second website" and "receiving, from a second client device ..., a second identification associated with the first website to create a second hyperlink from the second website to the first website." Thus, information is received regarding the creation of hyperlinks between first and second websites. Claim 47 also recites storing first and second information respectively indicating that the first and second identification was received. As to point (iii), independent claim 22 included the limitations of "including, within the second web page and based upon the reciprocal arrangement, a second link to the first web page and associated with the first entity." Similarly, newly-presented claim 47 recites "modifying the second website to include the second hyperlink to the first website based upon both the first information indicating that the first identification was received and the second information indicating that the second identification was received." Therefore, the claims are connected "in at least one of design, operation, or effect." Consequently, had both sets of claims been 'originally presented,' an election requirement between these set of claims would not be proper. Thus, the concept of "Election by Original Presentation" does not apply to the currently-presented claims.

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Claims are not "distinct"

Reference is made to M.P.E.P. § 802.01(II), which discusses the meaning of the phrase "related but distinct":

> Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. In this definition the term related is used as an alternative for dependent in referring to inventions other than independent inventions.
>
> Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.

The old and new claims do not refer to a "combination and subcombination" (M.P.E.P. § 806.05(c)), "subcombinations usable together" (M.P.E.P. § 806.05(d)), "process of making and product made" (M.P.E.P. § 806.05(f)), "apparatus and product made" (M.P.E.P. § 806.05(g)), "product and process of using" (M.P.E.P. § 806.05(h)), "product, processing of making, and process of using" (M.P.E.P. § 806.05(i)), or "related products; related processes" (M.P.E.P. § 806.05(j)). Consequently, these cannot serve as a basis for arguing that the claimed limitations are "related but distinct."

Referring to M.P.E.P. § 806.05(e), it is stated that:

> Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another materially different process. (italics in oringal)

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Both the previously-presented claims already include both process and apparatus claims. As such, the distinction described above cannot be made in the present claims. Moreover, the Examiner cannot establish either the (A) showing or (B) showing discussed immediately above.

No allegations of "serious burden"

The other factor that must be established is that "[t]here would be a serious burden on the examiner if restriction is not required." However, neither facts supporting such an assertion nor the assertion itself was presented by the Examiner.

For the reasons presented above, Applicant respectfully requests that the previously-presented claims 47-66 be entered and examined by the Examiner.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503611, and please credit any excess fees to such deposit account.

Date: January 19, 2021

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
CUSTOMER NUMBER 55246

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506470550 01/27/2021

PATENT ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

EPAS ID: PAT6517326

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT

CONVEYING PARTY DATA

Name	Execution Date
DISTEFANO PATENT TRUST III, LLC	01/26/2021

RECEIVING PARTY DATA

Name:	DISTEFANO WEBSITE INNOVATIONS, INC.
Street Address:	2910 N.W. 26TH AVENUE
City:	BOCA RATON
State/Country:	FLORIDA
Postal Code:	33434

PROPERTY NUMBERS Total: 3

Property Type	Number
Application Number:	13963050
Application Number:	13946461
Application Number:	13946489

CORRESPONDENCE DATA

Fax Number: (561)423-9297

Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

Phone: 5618017700
Email: ptomail@iplawpro.com
Correspondent Name: CUENOT, FORSYTHE & KIM, LLC
Address Line 1: 20283 STATE ROAD 7
Address Line 2: SUITE 300
Address Line 4: BOCA RATON, FLORIDA 33498

ATTORNEY DOCKET NUMBER:	8201-0013, -0014 & -0015
NAME OF SUBMITTER:	SCOTT D. PAUL
SIGNATURE:	/SCOTT D. PAUL/
DATE SIGNED:	01/27/2021
	This document serves as an Oath/Declaration (37 CFR 1.63).

Total Attachments: 3
source=DiStefano_Patent_Trust_III_LLC_Assignment_to_DiStefano_Website_Innovations (1)#page1.tif
source=DiStefano_Patent_Trust_III_LLC_Assignment_to_DiStefano_Website_Innovations (1)#page2.tif

source=DiStefano_Patent_Trust_III_LLC_Assignment_to_DiStefano_Website_Innovations (1)#page3.tif

PATENT ASSIGNMENT AGREEMENT

This PATENT ASSIGNMENT AGREEMENT, dated as of January 26, 2021, is entered into by DISTEFANO PATENT TRUST III, LLC, a company established under the laws of the State of Florida ("Assignor");

WHEREAS, Assignor has the right to assign the "Assigned Patents" as defined in Exhibit "A";

NOW THEREFORE, in consideration of the premises and mutual covenants herein contained, Assignor agrees as follows:

For good and valuable consideration, the receipt of which is hereby acknowledged, Assignor assigns to DISTEFANO WEBSITE INNOVATIONS, INC., a company established under the laws of the State of Florida ("Assignee"), all of Assignor's right, title and interest in and to the Assigned Patents identified in Exhibit "A" hereto, to have and to hold the same, unto Assignee for its own use and enjoyment and for the use and enjoyment of its successors and assigns, for the full term or terms of all such rights, together with the entire right, title and interest in and to the application, and in and to the Letters Patent which may be issued upon the listed applications, and upon any divisions, extensions, continuations or reissues thereof.

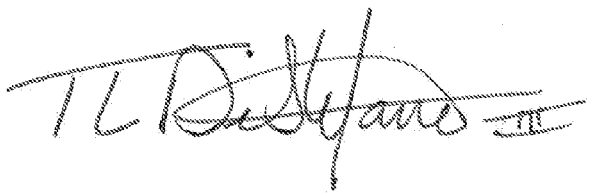
Assignor hereby also sells, assigns and transfers unto Assignee, the entire right, title and interest in and to the invention and in and to applications for Letters Patent therefore in all countries foreign to the United States of America, including all rights under any and all international conventions and treaties in respect of the invention and the applications for Letters Patent in foreign countries, and Assignor, further authorizes Assignee to apply for Letters Patent in foreign countries directly in its own name, and to claim priority of the filing date of the application for

Letters Patent of the United States of America under the provisions of any and all international conventions and treaties.

Assignor hereby authorizes and requests the Commissioner of Patents of the United States of America to issue Letters Patent upon the aforesaid applications, divisions, extensions, continuations or reissues, to DISTEFANO WEBSITE INNOVATIONS, INC., for the sole use and benefit of DISTEFANO WEBSITE INNOVATIONS, INC., its successors, assigns and legal representatives, to the full end of the term for which the Letters Patent may be granted, the same as they would have been held and enjoyed by Assignor had this assignment note been made, and Assignor hereby authorizes and requests the equivalent authorities in foreign countries to issue the patents of their respective countries to DISTEFANO WEBSITE INNOVATIONS, INC.

Assignor:

DISTEFANO PATENT TRUST III, LLC



By: _____

Name: Thomas L. DiStefano III

Title: Member Manager of DISTEFANO PATENT TRUST III, LLC

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