UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,022	07/21/2010	5623600	FORT-000013L	3498

26853   7590   09/16/2010

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1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2010

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

PTO-90C (Rev. 10/03)

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,022*.

PATENT NO. *5623600*.

ART UNIT *3992*.

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

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

PTOL-465 (Rev.07-04)

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/011,022	Patent Under Reexamination 5623600
	Examiner ALEXANDER J. KOSOWSKI	Art Unit 3992	

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

The request for *ex parte* reexamination filed <u>21 July 2010</u> has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892,   b)☒ PTO/SB/08,   c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

         RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535): **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

     a) ☐ by Treasury check or,

     b) ☐ by credit to Deposit Account No. _____, or

     c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-471 (Rev. 08-06)   Office Action in *Ex Parte* Reexamination   Part of Paper No. 20100907

DECISION

1)   A substantial new question of patentability affecting claims 1-22 of United States Patent

Number 5,623,600 (Ji et al) is raised by the corrected request for *ex parte* reexamination filed

7/21/10.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings

because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a

reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination

proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in

ex parte reexamination proceedings are provided for in 37 CFR 1.550(c).

References Cited in the Request

2)   Requestor has cited eleven references in the request filed 7/21/10.

Cheswick (The Design of a Secure Internet Gateway)

Cheswick and Bellovin (hereafter CB) (Firewalls and Internet Security)

Layland (A Gateway to Internet Health and Happiness)

LANProtect (Intel LANProtect Product Documentation)

Sidewinder (Special Report: Secure Computing Corporation and Network Security)

TIS Firewall (TIS Firewall Toolkit Overview)

Hile (U.S. Pat 5,319,776)

TFS Manual (TFS Gateway)

MIMEsweeper (MIMEsweeper administrator guide)

MpScan (MpScan-Email Security)

SunScreen SPF-100 (Network Security SunScreen SPF-100)

Ten of these eleven references were not of record during the original prosecution of U.S.

Pat 5,623,600, nor used in any previous rejection of the claims during the original examination.

Hile was previously considered during examination.

Identification of Every Claim for Which Reexamination is Requested

3)   The references above are discussed in the request regarding claims 1-22 of the Ji patent.

Pages 2-282 of the corrected request detail out proposed substantial new questions of

patentability in light of the eleven references cited above.

Substantial New Question of Patentability

4)   During the original prosecution of the Ji patent, the original examiner issued a notice of

allowability on 10/22/96 with no specific reasons for allowance. A claim amendment and

arguments submitted on 9/24/96 therefore appear to have overcome the prior art of record. This

amendment will be utilized to show why the newly cited references above do or do not create a

substantial new question of patentability.

For purposes of determination, independent claims 1, 4 and 11 are used as representative

claims for the various proposed prior art listed below. The italicized sections of the claims

below are utilized by the examiner to show how specific teachings of the proposed references

create a substantial new question of patentability in light of the original prosecution history

above.

Claim 1:

A system for detecting and selectively removing viruses in data transfers, the system comprising:
a memory for storing data and routines, the memory having inputs and outputs, the memory including a server for scanning data for a virus and specifying data handling actions dependent on an existence of the virus;
a communications unit for receiving and sending data in response to control signals, the communications unit having an input and an output;
a processing unit for receiving signals from the memory and the communications unit and for sending signals to the memory and communications unit; the processing unit having inputs and outputs; the inputs of the processing unit coupled to the outputs of memory and the output of the communications unit; the outputs of the processing unit coupled to the inputs of memory, the input of the communications unit, the processor controlling and processing data transmitted through the communications unit to detect viruses and selectively transfer data depending on the existence of viruses in the data being transmitted;
a proxy server for receiving data to be transferred, the proxy server scanning the data to be transferred for viruses and controlling transmission of the data to be transferred according to preset handing instructions and the presence of viruses, the proxy server having a data input a data output and a control output the data input coupled to receive the data to be transferred; and
a daemon for transferring data from the proxy server in response to control signals from the proxy server, the daemon having a control input, a data input and a data output the control input of the daemon coupled to the control output of the proxy server for receiving control signals, and the data input of the daemon coupled to the data output of the proxy server for receiving the data to be transferred.

Claim 4:

A computer implemented method for detecting viruses in data transfers between a first computer and a second computer, the method comprising the steps of:
receiving at a server a data transfer request including a destination address;
electronically receiving data at the server;
determining whether the data contains a virus at the server;
performing a preset action on the data using the server if the data contains a virus;
sending the data to the destination address if the data does not contain a virus;
determining whether the data is of a type that is likely to contain a virus; and

transmitting the data from the server to the destination without performing the steps of determining whether the data contains a virus and performing a preset action if the data is not of a type that is likely to contain a virus.

Claim 11:

A computer implemented method for detecting viruses in a mail message transferred between a first computer and a second computer, the method comprising the steps of:

receiving a mail message request including a destination address;

electronically receiving the mail message at a server;

determining whether the mail message contains a virus, *the determination of whether the mail message contains a virus comprising determining whether the mail message includes any encoded portions, storing each encoded portion of the mail message in a separate temporary file, decoding the encoded portions of the mail message to produced decoded portions of the mail message, scanning each of the decoded portions for a virus, and testing whether the scanning step found any viruses;*

performing a preset action on the mail message if the mail message contains a virus; and

sending the mail message to the destination address if the mail message does not contains a virus.

Cheswick, CB, and LANProtect

5)   Cheswick discloses a secure network configuration involving a pair of machines. CB

discloses the proper use of firewalls to increase security on networked computers. LANProtect

teaches server-based virus protection software.

The Request shows that the combination of Cheswick, CB and LANProtect, for claim 1,

teaches *a proxy server for receiving data to be transferred, the proxy server scanning the data to

be transferred for viruses and controlling transmission of the data to be transferred according to

preset handing instructions and the presence of viruses, the proxy server having a data input a

data output and a control output the data input coupled to receive the data to be transferred; and

a daemon for transferring data from the proxy server in response to control signals from

the proxy server, the daemon having a control input, a data input and a data output the control*

input of the daemon coupled to the control output of the proxy server for receiving control

signals, and the data input of the daemon coupled to the data output of the proxy server for

receiving the data to be transferred (see Request claim mapping, pages 17-20).

Cheswick, CB and LANProtect were not of record in the original prosecution of U.S. Pat

5,623,600.

It is agreed that the consideration of Cheswick, CB and LANProtect raises an SNQ as to

claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that a

reasonable examiner would consider these teachings important in deciding whether or not these

claims are patentable.

Accordingly, Cheswick, CB and LANProtect raise a substantial new question of claims

1-22, which question has not been decided in a previous examination of the Ji patent nor was

there a final holding of invalidity by the Federal Courts regarding the Ji patent.

Cheswick, CB, and MIMEsweeper

6)   Cheswick discloses a secure network configuration involving a pair of machines. CB

discloses the proper use of firewalls to increase security on networked computers.

MIMEsweeper discloses a mail filtering product for email gateways that protects networks from

virus infection via email.

The Request shows that the combination of Cheswick, CB and MIMEsweeper, for claim

1, teaches *a proxy server for receiving data to be transferred, the proxy server scanning the data*

to be transferred for viruses and controlling transmission of the data to be transferred according

to preset handing instructions and the presence of viruses, the proxy server having a data input a

data output and a control output the data input coupled to receive the data to be transferred; and

a daemon for transferring data from the proxy server in response to control signals from

the proxy server, the daemon having a control input, a data input and a data output the control

input of the daemon coupled to the control output of the proxy server for receiving control

signals, and the data input of the daemon coupled to the data output of the proxy server for

receiving the data to be transferred (see Request claim mapping, pages 56-59).

Cheswick, CB and MIMEsweeper were not of record in the original prosecution of U.S.
Pat 5,623,600.

It is agreed that the consideration of Cheswick, CB and MIMEsweeper raises an SNQ as
to claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that a
reasonable examiner would consider these teachings important in deciding whether or not these
claims are patentable.

Accordingly, Cheswick, CB and MIMEsweeper raise a substantial new question of
claims 1-22, which question has not been decided in a previous examination of the Ji patent nor
was there a final holding of invalidity by the Federal Courts regarding the Ji patent.

CB, TIS Firewall and Sidewinder

7)   CB discloses the proper use of firewalls to increase security on networked computers.
TIS Firewall discloses a set of programs and configuration practices designed to facilitate the
building of network firewalls. Sidewinder discloses that certain classes of data can be selectively
prohibited from passing to and from the external network.

The Request shows that the combination of CB, TIS Firewall and Sidewinder, for claim 4, teaches *determining whether the data is of a type that is likely to contain a virus; and transmitting the data from the server to the destination without performing the steps of determining whether the data contains a virus and performing a preset action if the data is not of a type that is likely to contain a virus* (see Request claim mapping, pages 99-100).

CB, TIS Firewall and Sidewinder were not of record in the original prosecution of U.S. Pat 5,623,600.

It is agreed that the consideration of CB, TIS Firewall and Sidewinder raises an SNQ as to claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable.

Accordingly, CB, TIS Firewall and Sidewinder raise a substantial new question of claims 1-22, which question has not been decided in a previous examination of the Ji patent nor was there a final holding of invalidity by the Federal Courts regarding the Ji patent.

LANProtect, TIS Firewall and TFS Manual

8)   LANProtect teaches server-based virus protection software. TIS Firewall discloses a set of programs and configuration practices designed to facilitate the building of network firewalls. TFS Manual discloses a gateway that receives mail message requests using SMTP and other protocols.

The Request shows that the combination of LANProtect, TIS Firewall and TFS Manual, for claim 4, teaches *determining whether the data is of a type that is likely to contain a virus; and*

transmitting the data from the server to the destination without performing the steps of

determining whether the data contains a virus and performing a preset action if the data is not of

a type that is likely to contain a virus (see Request claim mapping, pages 107-108).

LANProtect, TIS Firewall and TFS Manual were not of record in the original prosecution

of U.S. Pat 5,623,600.

It is agreed that the consideration of LANProtect, TIS Firewall and TFS Manual raises an

SNQ as to claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that

a reasonable examiner would consider these teachings important in deciding whether or not these

claims are patentable.

Accordingly, LANProtect, TIS Firewall and TFS Manual raise a substantial new question

of claims 1-22, which question has not been decided in a previous examination of the Ji patent

nor was there a final holding of invalidity by the Federal Courts regarding the Ji patent.

LANProtect, MIMEsweeper, Sidewinder and MpScan

9)   LANProtect teaches server-based virus protection software. MIMEsweeper discloses a

mail filtering product for email gateways that protects networks from virus infection via email.

Sidewinder discloses that certain classes of data can be selectively prohibited from passing to

and from the external network. MpScan discloses an e-mail content scanning firewall.

The Request shows that the combination of LANProtect, MIMEsweeper, Sidewinder and

MpScan, for claim 11, teaches *the determination of whether the mail message contains a virus*

comprising determining whether the mail message includes any encoded portions, storing each

encoded portion of the mail message in a separate temporary file, decoding the encoded portions

of the mail message to produced decoded portions of the mail message, scanning each of the

decoded portions for a virus, and testing whether the scanning step found any viruses; (see

Request claim mapping, pages 147-148).

LANProtect, MIMEsweeper, Sidewinder and MpScan were not of record in the original

prosecution of U.S. Pat 5,623,600.

It is agreed that the consideration of LANProtect, MIMEsweeper, Sidewinder and

MpScan raises an SNQ as to claims 1-22 of the Ji patent as pointed out above. There is a

substantial likelihood that a reasonable examiner would consider these teachings important in

deciding whether or not these claims are patentable.

Accordingly, LANProtect, MIMEsweeper, Sidewinder and MpScan raise a substantial

new question of claims 1-22, which question has not been decided in a previous examination of

the Ji patent nor was there a final holding of invalidity by the Federal Courts regarding the Ji

patent.

Sunscreen SPF-100 and Layland

10)   Sunscreen SPF-100 discloses firewall protection and virtual private network support

across public networks. Layland discloses an Internet gateway that subjects incoming files to a

virus scan.

The Sunscreen SPF-100 and Layland references are utilized as secondary references in

the request for claims that are dependent on independent claims. As the art above has raised an

SNQ for at least independent claims 1, 4 and 11, the Sunscreen SPF-100 and Layland references

raise a substantial new question of patentability in view of dependency.

Sunscreen SPF-100 and Layland were not of record in the original prosecution of U.S.

Pat 5,623,600.

It is agreed that the consideration of Sunscreen SPF-100 and Layland raise an SNQ as to

claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that a

reasonable examiner would consider these teachings important in deciding whether or not these

claims are patentable.

Accordingly, Sunscreen SPF-100 and Layland raise a substantial new question of claims

1-22, which question has not been decided in a previous examination of the Ji patent nor was

there a final holding of invalidity by the Federal Courts regarding the Ji patent.

Hile

11)   Hile discloses storing data in a temporary file and scanning for viruses.

Regarding claim 1, Hile, in combination with the art cited above, teaches scanning data

for computer viruses during the data transfer "on the fly" and before the data is stored on a

destination storage medium so as to prevent computer viruses from infecting the computer. Hile

then automatically inhibits virus-infected data from being store (Hile, col. 1 lines 55-62). This

teaching in combination with the art above appears to read on some aspects of claim 1, including

scanning the data to be transferred for viruses.

Hile was of record in the original prosecution of U.S. Pat 5,623,600, and was actively

used in rejections. However, Hile is now being presented in combination with the references

above, which raise an SNQ themselves. Therefore, the combination of Hile with the newly

proposed references in the request raises an SNQ.

It is agreed that the consideration of Hile in combination with the references above raises an SNQ as to claims 1-22 of the Ji patent as pointed out above. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable.

Accordingly, Hile in combination with the references above raises a substantial new question of claims 1-22, which question has not been decided in a previous examination of the Ji patent nor was there a final holding of invalidity by the Federal Courts regarding the Ji patent.

Scope of Reexamination

12)   Claims 1-22 will be reexamined as requested in the Request. All eleven proposed references have raised an SNQ as pointed out above.

Conclusion

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,623,600 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

All correspondence relating to this ex parte reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

> Mail Stop Ex Parte Reexam
> ATTN: Central Reexamination Unit
> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

By FAX to:

> (571) 273-9900
> Central Reexamination Unit

By hand to:

     Customer Service Window
     Randolph Building
     401 Dulany St.
     Alexandria, VA 22314

By EFS-Web:

     Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

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     EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

     Any inquiry concerning this communication or earlier communications from the

Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be

directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Alexander J Kosowski/

Primary Examiner, Art Unit 3992

ESK