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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,489	02/17/2011	6061520	13557.112021	8173

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/23/2011

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



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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/011,489.

PATENT NO. 6061520.

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)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	Control No.	Patent Under Reexamination	
	90/011,489	6061520	
	Examiner	Art Unit	
	ERIC B. KISS	3992	

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

The request for *ex parte* reexamination filed 17 February 2011 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 )

### **ORDER GRANTING EX PARTE REEXAMINATION**

A substantial new question of patentability affecting claims 1-4, 6-13, 15, 16, and 18-23 of United States Patent 6,061,520 is raised by the request for *ex parte* reexamination.

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).

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. 6,061,520 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.

### **Printed Publications Cited in the Request**

The request cites the following prior art printed publications as raising a substantial new question of patentability (SNQ):

1. Brian T. Lewis, L. Peter Deutsch, and Theodore C. Goldstein. *Clarity MCode: A Retargetable Intermediate Representation for Compilation*, ACM, IR '95, 1/95, San Francisco, California, USA (1995) (hereinafter "Lewis").
2. M. Cierniak & W. Li. *Briki: an Optimizing Java Compiler*, IEEE Comcon '97 Proceedings (Feb. 1997) (hereinafter "Cierniak").
3. Dyer, *Java Decompilers Compared*, JavaWorld.com (July 1, 1997).

### **Prosecution History**

The '520 patent issued from application 09/055,947, filed April 7, 1998.

In the first action on the merits of the '947 application, the examiner: 1) rejected claims 1 and 3 as anticipated by the *Cierniak* reference also cited by the present requester, 2) objected to claims 2, 4, and 5, indicating that these claims would be allowable if rewritten in independent form, and 3) indicated that claims 6-23 were allowable as filed. '947 App., Non-Final Rejection, 7/21/1999. The examiner provided a statement of reasons for the indication of allowable subject matter: "[The Cierniak reference] fails to teach... constant pool storage; and... explicit operations (e.g., initialization, allocation, manipulation and simulation) with respect to 'play' execution." *Id.* at 4.

Following a telephonic interview conducted October 13, 1999, the applicants amended the limitation of claim 1 that included the term "play executing" by substituting different language for that term: "simulating execution of [play executing] the byte codes of the clinit

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method against a memory without executing the byte codes to identify the static initialization of the array by the preloader;”. ’947 App., Amendment, 10/18/1999, p. 2 (markup in original, indicating the added and deleted text).

The examiner subsequently allowed claims 1-23, providing the following reasons for allowance:

[T]he cited prior art, either singly or in combination, fails to anticipate or render obvious the simulation of execution with respect to class initialization, without executing byte codes.

Ciemiak, “Briki: An Optimizing Java Compiler”, teaches of comparing the execution of byte codes, but fails to address the issue of simulating the process without execution.

’947 App. Notice of Allowability, 1/4/2000, p. 2.

### **Substantial New Questions of Patentability**

#### **A. The SNQ Requirement**

The Office may only grant a reexamination request if an SNQ affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. 35 U.S.C. §§ 303(a) and 304.

The court in *Swanson* evaluated the scope of the SNQ requirement in reexamination, extensively citing the legislative history of the original reexamination statute and the 2002 amendment:

“[I]n passing the original reexamination statute, Congress stated that ‘this new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application,’ and explained that the substantial new question requirement bars ‘reconsideration of any argument already

decided by the office, whether during the original examination or an earlier reexamination.” *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008) (quoting H.R. Rep. No. 96-1307 (1980)) (emphasis omitted). “[T]he substantial new question requirement ‘guard[s] against simply repeating the prior examination on the same issues and arguments’ and bars ‘a second examination, on the identical ground that had previously been raised and overcome.” *Id.* at 1380 (quoting *In re Recreative Technologies Corp.*, 83 F.3d 1394, 1396-97 (Fed. Cir. 1996)). Further, “[t]he issue raised must be more than just questioning the judgment of the examiner.” *Id.* (quoting H.R. Rep. No. 107-120 (2002)). “[T]o decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose.” *Id.*

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable, unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. MPEP § 2242.

**B. Lewis**

The request asserts that a substantial new question of patentability as to claims 1-4, 6-13, 15, 16, and 18-23 the '520 patent is raised by *Lewis*. (Request at 13-16.) The examiner agrees.

As noted by the requester, *Lewis* discloses simulating execution of code without actually running the code in order to identify the targeted output of a given section of code. (Request at

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15 (citing *Lewis* at 126).) Once the targeted output of a given section of code is known, a shortcut, referred to as a “CGValue,” is created, which represents the state of the individual entries of the simulated stack, including constants, variable references, previously “executed” subexpressions, and procedure or method calls. (*Id.*) The CGValues operate as a set of shortcut instructions, such that “[g]ood code can be generated” when “the value of the expression is needed.” (*Id.*)

Because this new, non-cumulative teaching appears to be relevant to the features asserted to be missing from the prior art in the examiner’s reasons for allowance, there is a substantial likelihood that a reasonable examiner would consider *Lewis* important in deciding whether or not claims 1-4, 6-13, 15, 16, and 18-23 of the ’520 patent are patentable. Accordingly, *Lewis* raises an SNQ as to claims 1-4, 6-13, 15, 16, and 18-23.

### C. **Cierniak**

The request asserts that a substantial new question of patentability as to claims 1-4 and 6-23 the ’520 patent is raised by *Cierniak*. (Request at 16-18.) The examiner disagrees.

The requester cites *Cierniak* at 182 as allegedly teaching play execution or simulated execution of computer code and alleges that this teaching is inconsistent with the examiner’s reasons for allowance, asserting that the examiner “seems to have overlooked the disclosure of simulated execution of computer code within the *Cierniak* reference.” (Request at 16-18.)

The prosecution history shows that the examiner considered this same cited section of *Cierniak*, including the disclosed symbolic emulation, in evaluating the patentability of the claims. ’947 App., Non-Final Rejection at 3. Specifically, in the context of the rejection of claims 1 (originally reciting play execution) and 3 (more specifically defining play execution of



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claim 1), the examiner cited section 3.2 of *Cierniak* several times, mapping the stack allocation, stack recovery, and stack manipulation processes of *Cierniak* to the various steps involved in play execution as recited in the claims. *Id.* Accordingly, the requester's position that the examiner seemed to overlook the disclosure of a simulated execution of computer code within the *Cierniak* reference is unfounded.

Rather than raising a new question, the requester appears to be merely questioning the judgment of the examiner and asking the Office to initiate a second examination on grounds that had previously been raised and overcome. Thus, the request fails to show that a substantial new question of patentability is raised by *Cierniak*.

**D. Cierniak in view of Dyer**

The request asserts that a substantial new question of patentability as to claims 1-4 and 6-23 the '520 patent is raised by *Cierniak* in view of *Dyer*. (Request at 16-18.) The examiner disagrees.

As discussed above, the requester's characterization of the context in which *Cierniak* was previously considered and the scope of the prior consideration does not alone raise an SNQ. In presenting the combination of *Cierniak* in view of *Dyer*, the request cites *Dyer* as additionally "disclos[ing] the simulated execution of byte codes against a memory without executing the byte codes to identify the static initialization of an array." (Request at 18.)

*Dyer* discloses the results of testing 3 different JAVA decompilers: DeJaVu, Mocha, and WingDis version 2.06. *Dyer* at 1. In the context of decompiling code containing a static initializer, the decompilers produced results as follows:

- 1) Mocha produced an illegal construction that used a bracketed initializer list as part of an assignment operation that was not a variable declaration,
- 2) WingDis apparently produced the same result as Mocha (code that was syntactically correct but semantically incorrect), and
- 3) DeJaVu “emitted perfectly legal (but ugly) code” that initialized a temporary array, allocated memory for the temporary array, then individually assigned values to the temporary array elements before assigning the values of the temporary array to the variable of interest.

*Dyer* at 3-4.

The output of the DeJaVu decompiler is similar to the pseudo-code used in the '520 patent to describe the functions performed by a <clinit> method created by the JAVA compiler, '520 patent at col. 2, lines 1-13 (Code Table #2), but there does not appear to be an indication that any of the decompilers identified the static initialization as such, *e.g.*, the keyword `static` does not appear in any of the segments of example decompiled code corresponding to static initializers. *See Dyer* at 3-4 and 9-10. Further, there is no discussion in *Dyer* as to how any of the decompilers achieved the illustrated results, *i.e.*, it is not clear whether any of the decompilers disclosed by *Dyer* simulated execution of byte codes against a memory without executing the byte codes.

Because the disclosure of *Dyer* does not appear to support the new teaching alleged by the requester, the request fails to persuasively show that *Dyer*, considered alone or in combination with *Cierniak*, raises an SNQ.

**Conclusion**

Claims 1-4, 6-13, 15, 16, and 18-23 of United States Patent 6,061,520 will be reexamined.

Claims 5, 14, and 17 of United States Patent 6,061,520 will not be reexamined.

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


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By FAX to: (571) 273-9900  
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Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.

/Eric B. Kiss/  
Primary Examiner, Art Unit 3992

Conferees:   
Primary Examiner 3992  
