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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,490	02/15/2011	RE38104	13557.112021	8186

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/28/2011

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. 90/011,490.

PATENT NO. RE38104 ET AL.

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. 90/011,490	Patent Under Reexamination RE38104 ET AL.	
	Examiner ERIC B. KISS	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 15 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)).

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cc:Requester ( if third party requester )

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

A substantial new question of patentability affecting claims 11-41 of United States Reissued Patent RE38,104 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 Reissued Patent No. RE38,104 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 patents and printed publications as raising a substantial new question of patentability (SNQ):

1. Gries, David, *Compiler Construction for Digital Computers*, (John Wiley & Sons, Inc., 1971), (hereinafter, the “Gries 1971 reference”).
2. U.S. Patent 4,571,678 (Chaitin).
3. Gabriel, Richard P., *Performance and Evaluation of Lisp Systems*, (MIT Press, 1985), (hereinafter, the “Gabriel 1985 reference”).

**Prosecution History**

RE38,104 is a reissue of U.S. Pat. 5,367,685 (issued from application 07/994,655, filed December 22, 1992). The '104 reissued patent issued from application 09/261,970, filed March 3, 1999. A reasonable summary of the prosecution history of the '104 reissued patent is contained in the request, (Request for *Ex Parte* Reexamination, 2/15/2011, pp. 6-8). Although the request selectively emphasized a portion of the examiner's reasons for allowance in the '685 patent's file, (Request at 7), the emphasized portions appear to be consistent with the scope of the claims under consideration. Specifically, the requester notes that the '104 patent's claims generally include: (1) receiving an intermediate form of code with symbolic references; and (2) determining numeric references corresponding to the symbolic references. (Request at 11.) Because these claim features are consistent with the previously stated reasons for allowance in the '685 patent file, and because there appear to be no conflicting statements or further elaboration on allowability of these claim features in the reissue applications, these features appear to have likewise been important in allowing the '104 reissue patent claims.

### **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. the Gries 1971 reference**

The request asserts that a substantial new question of patentability as to claims 11-41 of the '104 patent is raised by the Gries 1971 reference. (Request at 12-13.) The examiner agrees.

As noted by the requester, the Gries 1971 reference discloses: (1) receiving an intermediate form of code with symbolic references; and (2) determining numeric references corresponding to the symbolic references. Specifically, the Gries reference discloses resolving a symbolic reference (a pointer to a symbol table entry) to obtain a value associated with a variable (loading the value by using the address containing the value, a numerical reference).

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 in the parent patent's file, there is a substantial likelihood that a reasonable examiner would consider the Gries 1971 reference important in deciding whether or not claims 11-41 of the '104 patent are patentable. Accordingly, the Gries 1971 reference raises an SNQ as to claims 11-41.

**C. the Chaitin '678 patent**

The request asserts that a substantial new question of patentability as to claims 11-41 of the '104 patent is raised by the Chaitin '678 patent. (Request at 13-14.) The examiner agrees.

As noted by the requester, the Chaitin '678 patent discloses: (1) receiving an intermediate form of code with symbolic references (i.e., symbolic registers); and (2) determining numeric references corresponding to the symbolic references (rewriting the intermediate language code replacing symbolic registers with real machine register numbers). (Request at 13-14.)

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 in the parent patent's file, there is a substantial likelihood that a reasonable examiner would consider the Chaitin '678 patent important in deciding whether or not claims 11-41 of the '104 patent are patentable. Accordingly, the Chaitin '678 patent raises an SNQ as to claims 11-41.

**D. the Gabriel 1985 reference**

The request asserts that a substantial new question of patentability as to claims 11-41 of the '104 patent is raised by the Gabriel 1985 reference. (Request at 14-15.) The examiner agrees.

As noted by the requester, the Gabriel 1985 reference discloses: (1) receiving an intermediate form of code with symbolic references (i.e., interpreted code); and (2) determining numeric references corresponding to the symbolic references (i.e., resolving a function name to its address). Although an address of a functional may reasonably be interpreted as a numeric reference, the examiner notes that "BCD" in the Gabriel 1985 reference does not appear to mean "binary coded decimal" as described in the request.



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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 in the parent patent's file, there is a substantial likelihood that a reasonable examiner would consider the Gabriel 1985 reference important in deciding whether or not claims 11-41 of the '104 patent are patentable. Accordingly, the Gabriel 1985 reference raises an SNQ as to claims 11-41.

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**Conclusion**

Claims 11-41 of United States Reissued Patent RE38,104 will be reexamined.

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

By Mail to:        Mail Stop *Ex Parte* Reexam  
                      Central Reexamination Unit  
                      Commissioner for Patents  
                      United States Patent & Trademark Office  
                      P.O. Box 1450  
                      Alexandria, VA 22313-1450

By FAX to:        (571) 273-9900  
                      Central Reexamination Unit

By hand:           Customer Service Window  
                      Randolph Building  
                      401 Dulany Street  
                      Alexandria, VA 22314

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: /Mary Steelman/ Primary Examiner CRU 3992

ASL