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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,491	02/15/2011	6,125,447	13557.112021	8208

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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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:

MAILED

MAR 23 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011491
PATENT NO. : 6125447
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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/011,491	6,125,447	
	Examiner	Art Unit	
	MARY STEELMAN	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)).

cc:Requester (if third party requester)

DECISION GRANTING EX PARTES REEXAMINATION

Substantial New Question of Patentability

A substantial new question of patentability affecting claims 1-24 of USPN 6,125,447 to Gong (hereinafter '447) is raised by the present request for ex partes reexamination filed on 02/15/2011.

Patent Assignment

The '447 Patent is currently assigned to Sun Microsystems, Inc. The '447 Patent issued from US Patent Application No. 08/988,439 (hereinafter '439), filed on 12/11/1997.

Information Disclosure Statement

IDS received 02/15/2011 has been considered.

References Presenting Substantial New Question of Patentability

In the request for reexamination, the Requester alleges that '447 claims 1-24 are unpatentable over the following references, alone or in combination:

USPN 5,412,717 to Fischer ("Fischer" or '717) (file date 05/15/1992, issue date 05/02/1995), qualifies as a 35 U.S.C § 102(b) reference. Previously cited on an IDS, but never used in a rejection of Application '439.

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"The Gateway Security Model in the Java Electronic Commerce Framework" by Theodore Goldstein ("Goldstein") 11/29/1996, qualifies as a 35 U.S.C § 102(b) reference.

"Java APIs: Playing Monopoly with Java via the JECF", Rawn Shah ("Shah") 12/01/1996, qualifies as a 35 U.S.C § 102(b) reference.

Prosecution History

The '447 patent issued from the '439 application filed on 12/11/1997. The '447 patent is generally directed (2: 52-65) to a method and apparatus for maintaining and enforcing security rules/policies using protection domains. An association is established between the protection domain and a class of object. The association and the class to which the object belongs are used in the determination of permissible actions for the object.

A non-final Office action (08/25/1999) rejected all claims, claims 1-24. Claims 1, 10, and 19 were rejected as anticipated by USPN 5,758,153 to Atsatt et al. Claims 2-9, 11-18, and 20-24 were rejected under 35 USC 103(a) as unpatentable over Atsatt et al. The non final rejection noted that, while obvious, Atsatt failed to clearly disclose:

- a code identifier associated with at least one protection domain and at least one class, where the step and means for establishing the association between the protection domains and the classes of one or more objects includes the step and means for associating the protection domains and the classes based on the code identifier.
- the use of a source code to define each class in accordance with the code identifier.

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-keys, however keys are well known in the art as being identifiers for a record or group of records in a data file (See definition of key).

Regarding claims 6, 15, and 24, the non final rejection noted that Atsatt discloses associating the protection domains and the classes based on data persistently stored (access control list), wherein the data associates code identifiers, as described above, with a set of permissions (rights).

Applicant's response (11/24/1999) included arguments that failed to persuade the Examiner: protection domains are associated with users (which are internally represented by objects that are instances of the class TCredentials); a system that associates protection domains and object classes. A Final Rejection was issued (02/16/2000) maintaining all rejections. During an interview 05/05/2000, it was agreed that the Atsatt reference does not teach an association between the classes and the protection domain and does not teach "sources of code" associated with protection domains. Claims were found to be allowable, pending an update search of prior art. In the Reasons for Allowance the Examiner noted "With respect to claims 1, 7, 10, 16 and 19, the Examiner asserts that the novelty of the claims, when read as a whole, are the steps and means for establishing an association between one or more protection domains and one or more classes of one or more objects (or sources of code) and determining whether an action requested by an object is permitted based on this association." The '439 application issued as the '447 patent on 09/26/2000.

Reexamination Requester's Position

The Request indicates that the Third Party requester considers:

Ground #1: Claims 1-24 to be unpatentable over Fischer.

Ground #2: Claims 1-24 to be unpatentable over Goldstein in view of Shah.

Substantial New Question

The substantial new question of patentability (SNQ) has been raised based on patents and/or printed publication not considered in an earlier concluded examination of the patent being reexamined. In the present instance, Requester asserts an SNQ to be raised by Fischer, alone, or the combination of Goldstein and Shah, which were not applied or discussed in rejecting any claim during the prosecution of the '447 Patent.

Re. Ground #1: Fischer

It is generally agreed that the consideration of Fischer, alone, proposed by Third Party requester raises a substantial new question of patentability as to claims 1-24 of the '447 Patent.

As pointed out on pages 15-17 & 17-18 of the Request, Fischer discloses a computer system security using a set of authorities and/or restrictions referred to as "program authorization information" or "PAI" ('717, 2:16-30). The PAI is assigned to a program to be executed, "to thereby delineate the types of resources and functions that the program is allowed to utilize." See id. This PAI for the program may be combined, as appropriate,

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with PAI associated with a calling program ('717, 19: 40-54). "The PAI defines the range of operations that a program may execute and/or defines those operations that a program cannot perform" ('717, 2: 34-36). As illustrated in at least Figure 3C of Fischer, the program can include an object-oriented data structure ('717, Fig. 3C; 7: 49 – 8: 2).

Therefore, Fischer discloses establishing an association between one or more protection domains, *i.e.*, PAI, and one or more classes of one or more objects, *i.e.*, a class represented by the object-oriented data structure, as recited in independent claims 1, 10, and 19 of the '447 patent. Fischer also discloses establishing an association between one or more protection domains and one or more sources of code, as recited in independent claims 7 and 16 of the '447 patent. For example, according to Fischer, the PAI can be associated with a signer of a digital certificate ('717, 6: 25-35; Fig. 2) or a manufacturer of a program ('717, 9: 3-8; 16: 12-25). See claim chart, Exhibit 8.

Fischer's teachings were considered on an IDS, but not used in the prosecution of the '439 Application which became the '447 Patent. Further, there is a substantial likelihood that a reasonable Examiner would consider these teachings important in deciding whether or not independent claims 1, 7, 10, 16, and 19 are patentable. The significant new question of patentability raised by Fischer has not been decided in a previous examination of the '447 Patent. Additionally, it is found that Fischer raises a substantial new question of patentability on all dependent claims, claims 2-6, 8-9, 11-15, 17-18 and 20-24.

Re. Ground #2: Goldstein in view of Shah

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It is generally agreed that the consideration of Goldstein, taken with Shah, proposed by Third Party requester, raises a substantial new question of patentability as to Claims 1-24 of the '447 Patent.

Goldstein describes a "Gateway" extension to the Java security model, for use in the Java Electronic Commerce Framework ("JECF") (Goldstein, p. 1). According to Goldstein, an application called a "cassette" is associated with a set of permissions (i.e., a protection domain) represented by "Roles" (Goldstein, p. 7-8, 10, 13-14, and Figs. 1 and 5-6). The Roles may be defined on a per-package basis so that any class that is part of the package (e.g., a cassette package) is necessarily associated with the protection domain (Goldstein, p. 10). All classes in a package have access to package-private data members and methods (Goldstein, p. 10). Goldstein also discloses establishing an association between the protection domain of a user's cassette with a class corresponding to a protected resource such as a JECF database (Goldstein, p. 11-12). As would have been recognized by a person of ordinary skill in the art reviewing Goldstein, the Roles are objects that represent and/or contain the specific authorizations (e.g., permissions) for a particular cassette as well as a digital signature (based on a public/private key pair) corresponding to the creator of the cassette (Goldstein, p. 13).

Shah, in support of Goldstein's teachings related to JECF, further explains (p. 3), "[R]oles dictate the available resources and security levels and control [the] program's interface to the JECF code. A local database contains these access control lists and role

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information. Each... cassette with its specific roles must be signed by a trusted authority before use to guarantee the identity of the originator." Shah clarifies that these Roles inherently include objects that represent and/or contain specific authorizations for a set of code, as well as a digital signature corresponding to the creator of the code.

Therefore, Goldstein, in view of Shah, discloses providing computer system security, which includes associating protection domains with object-oriented program structures, such as classes of objects and sources of code, as recited in the claims of the '447 patent.

Decision Granting the Order

A substantial new question of patentability affecting claims 1-24 of USPN 6,125,447 to Gong is raised by the request for reexamination. In view of the above, the request for reexamination is **GRANTED**. Claims 1-24 of USPN 6,125,447 to Gong will be reexamined.

Office Action on the Merits

An Office action on the merits will be provided in due course.

Ongoing Duty to Disclose

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 the patent under reexamination throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly appraise

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the Office of any such activity or proceeding throughout the course of this reexamination proceeding.

Requester has identified the following litigation:

US District Court Civil Docket US District - California Northern
(San Francisco) 3:10CV3561 Oracle America, Inc v. Google Inc.

Extensions of Time

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 concluded with special dispatch" (37 CFR 1.555(a)).

Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Patent Owner Amendment

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof

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of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement: Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Conclusion

Any paper filed with the USPTO, i.e., any submission made, by either the Patent Owner or the Third Party Requester must be served on every other party in the reexamination proceeding, including any other third party requester that is part of the proceeding due to merger of the reexamination proceedings. As proof of service, the party submitting the paper to the Office must attach a Certificate of Service to the paper, which sets forth the name and address of the party served and the method of service. Papers filed without the required Certificate of Service may be denied consideration. 37 CFR 1.903; MPEP 2666.06.

After the filing of a request for reexamination by a 3rd party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550 (f).

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

By Mail to: Mail Stop *Ex Parte* Reexam

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Central Reexamination Unit

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By FAX to: (571) 273-9900

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By hand: Customer Service Window

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Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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 should be directed to Mary Steelman at telephone number 571-272-3704.

/Mary Steelman/

Mary Steelman, Primary Examiner

Central Reexamination Unit 3992

Conferees:

EBK
ATK