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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,492	02/15/2011	5,966,702	13557.112021	8223

22804 7590 03/23/2011

THE HECKER LAW GROUP
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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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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

KING & SPALDING

1180 PEACHTREE STREET, N.E.

ATLANTA, GA 30309-3521

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011492

PATENT NO. : 5966702

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. 90/011,492	Patent Under Reexamination 5,966,702	
	Examiner MARY STEELMAN	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)).

		/Mary Steelman/ Primary Examiner CRU
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, 5-7, 11-13, 15, and 16 of USPN 5,966,702 to Fresko et al. (hereinafter '702) is raised by the present request for ex partes reexamination filed on 02/15/2011.

Patent Assignment

The '702 Patent is currently assigned to Sun Microsystems, Inc. The '702 Patent was issued from the US Patent Application No. 08/961,874 (hereinafter '874 Application) filed on 10/31/1997.

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 '702 claims 1, 5-7, 11-13, 15, and 16 are unpatentable over the following references, alone or in combination:

USPN 5,815,718 to Tock (file date 05/30/1996, issue date 09/29/1998, hereinafter, the "Tock patent" or '718, qualifies as a 102(e) reference.

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USPN 5,613,120 to Palay, et al., (file date 10/20/1994, issue date 03/18/1997, hereinafter, the "Palay patent" or '120), qualifies as a 102(a) reference.

Prosecution History

The '702 patent issued from the '874 application filed on 10/31/1997.

The '702 patent is generally directed to the elimination of duplicated elements in a plurality of class files to obtain a plurality of reduced class files, and forming a shared table comprising the duplicated elements. Redundant constants in constant pools of the class files are removed and a single instance of the constant is placed in a separate shared table ('702, 9: 21-25; 9: 39-40). A pre-processor determines memory allocation requirements for the class files and packages the shared table, the memory allocation requirements and the reduced class files in a generated multi-class file ('702, 5: 12-17; 9: 35-40).

The '874 application was filed 10/21/1997 with a total of two claims. Prior to the first office action, claims 3-23 were added. An Ex Parte Quayle Action (01/29/1999) issued, objecting to claim 3 for improper dependency and objecting to a submitted computer program listing exceeding eleven pages. Allowable subject matter was indicated: "Independent claims 1, 7, 13 and 20 are allowed for the same reason. In each of these claims, applicant has claimed determining duplicated elements in a plurality of class files and removing the duplicated elements from the plurality of class files to obtain a plurality of reduced class files. Applicant's

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invention differs from the cited prior art in that applicant further forms a shared table comprising the plurality of duplicated elements and forms a multi-class file comprising the plurality of reduced class files and the shared table.” A Notice of Allowability (04/12/1999) was issued allowing claims 1-23. The ‘702 patent issued 10/12/1999.

Reexamination Requester's Position

The Request indicates that the Third Party requester considers:

Ground #1: Claims 1, 5-7, 11-13, 15, and 16 to be unpatentable over Tock.

Ground #2: Claims 1, 5-7, 11-13, 15, and 16 to be unpatentable over Palay.

Substantial New Question

The substantial new question of patentability (SNQ) has been raised based on patents not considered in an earlier concluded examination of the patent being reexamined. In the present instance, Requester asserts an SNQ to be raised by Tock, alone, and by Palay, alone, neither of which were applied or discussed in rejecting any claim during the prosecution of the '702 Patent.

Re. Ground #1: Tock

It is generally agreed that the consideration of Tock, alone, proposed by Third Party requester raises a substantial new question of patentability as to claims 1, 5-7, 11-13, 15, and 16 of the '702 Patent.

As pointed out on pages 10-11 of the Request & Exhibit 4 claim chart, Tock describes an offline

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class loader that produces an executable module with classes preloaded into memory without requiring runtime dynamic loading. The Tock patent discloses each of the three elements identified above that are recited in the '702 patent's independent claims. Tock's class loader eliminates duplicate constants from the constant pools of classes to produce more compact updated class files (a reduced class file) ('718, 5: 29-34; 5: 38-50; 8: 40-46). In connection with eliminating duplicate constants, Tock's class loader creates a combined universal constant pool, (the shared table) ('718, 5: 29-34; 8: 40-55; 9: 27-29). The output of Tock's offline class loader is a universal constant pool, an updated class file containing the class data structures, and the indicators specifying the memory storage requirements, as well a special boot time initiator (FIG. 8B, step 930) ('718, 10: 29-32).

Tock's teachings were not used in the prosecution of the Fresko '874 Application which became the Fresko '702 Patent. Further, there is a substantial likelihood that a reasonable Examiner would consider these teachings important in deciding whether or not claims 1, 5-7, 11-13, 15, and 16 are patentable. The significant new question of patentability raised by Tock has not been decided in a previous examination of the '702 Patent.

Re. Ground #2: Palay

It is generally agreed that the consideration of Palay, taken alone, proposed by Third Party requester, raises a substantial new question of patentability as to Claims 1, 5-7, 11-13, 15, and 16 of the Fresko '702 Patent.

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As pointed out on pages 11-12 of the Request and Exhibit 5, Palay '120 describes techniques for compiling and linking object-oriented computer programs that include methods for merging together class information from object files. Palay describes a pre-processing technique that includes a merging process whereby the linker removes duplicates from the merged class definition tables and the merged class symbol tables ('120, 28: 50-61). To the extent reduced classfiles are not expressly disclosed in Palay, they are a necessary outcome given the merged class information and the removal of duplicate data. One of ordinary skill in the art at the time of the invention could take the teachings of Palay in combination with his own knowledge of the particular art and be in possession of the invention, and specifically, in possession of reduced class files. See *In Re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995). Palay's linker forms a shared table when it merges class information from object files and shared libraries to produce a merged table from which duplicates have been removed ('120, 28: 39-61). After creating the merged tables and completing other pre-processing of the class information, the linker generates a shared library in the form of an object file that corresponds with the multi-classfile recited in the '702 patent ('120, 29: 60-67; 7: 51- 54; 30: 7-10).

Palay's teachings were not used in the prosecution of the Fresko '874 Application which became the Fresko '702 Patent. Further, there is a substantial likelihood that a reasonable Examiner would consider these teachings important in deciding whether or not claims 1, 5-7, 11-13, 15, and 16 are patentable. The significant new question of patentability raised by Palay has not been decided in a previous examination of the '702 Patent.

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Decision Granting the Order

A substantial new question of patentability affecting claims 1, 5-7, 11-13, 15, and 16 of USPN 5,966,702 to Fresko et al. is raised by the request for reexamination. In view of the above, the request for reexamination is **GRANTED**. Claims 1, 5-7, 11-13, 15, and 16 of USPN 5,966,702 to Fresko et al. 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 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

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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 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

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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

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

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

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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

ADK