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Alexandria, VA 22313-1450, on the date shown below.

Dated: February 15, 2011

Signature: / Robert T. Neufeld /  
Patent Attorney, Reg. No. 48,394

Docket No. 13557.112021  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Reexamination of:

Nedim Fresko, et al.

Control No.: Not yet Assigned

Patent No.: 5,966,702

Examiner: Not Yet Assigned

Issue Date: Oct. 12, 1999

Art Unit: Not Yet Assigned

For: METHOD AND APPRATUS FOR PRE-  
PROCESSING AND PACKAGING CLASS  
FILES

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**REQUEST FOR *EX PARTE* REEXAMINATION UNDER 37 C.F.R. § 1.510**

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

Sir:

King & Spalding, LLP (hereinafter, "Requester") submits, under the provisions of 37 C.F.R. § 1.510 *et seq.*, a Request for Reexamination (hereinafter, "Request") of claims 1, 5-7, 11-13, 15 and 16 of U.S. Patent No. 5,966,702 (hereinafter "the '702 patent") entitled "Method and Apparatus For Pre-Processing and Packaging Class Files," issued to Nedim Fresko and Richard Tuck on October 12, 1999. The '702 patent is provided as Exhibit 1 to the Request.

In support of its request, Requester provides the following:

- The \$2520.00 fee for requesting *ex parte* reexamination set forth in 37 C.F.R. § 1.20(c)(1) (37 C.F.R. § 1.510(a));

- A statement pointing out each substantial new question of patentability based on prior patents and printed publications (37 C.F.R. § 1.510(b)(1));
- An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested (37 C.F.R. § 1.510(b)(2));
- A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) and (b)(2) of 37 C.F.R. § 1.510, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication (37 C.F.R. § 1.510(b)(3));
- A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper ((37 C.F.R. § 1.510(b)(4)) (Exhibit 1); and
- A certification that a copy of the request has been served in its entirety on the patent owner at the address as provided for in 37 C.F.R. § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office ((37 C.F.R. § 1.510(b)(5)).

Pursuant to 35 U.S.C. § 303, the prior art references discussed in this Request raise “substantial new questions of patentability” with respect to claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent.

## TABLE OF CONTENTS

<b>I.</b>	<b>INTRODUCTION .....</b>	<b>4</b>
<b>II.</b>	<b>STATEMENT UNDER 37 C.F.R. § 1.510 (B)(1) POINTING OUT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY .....</b>	<b>5</b>
A.	OVERVIEW OF THE ‘702 PATENT .....	5
B.	ASPECTS OF THE LAW GOVERNING REEXAMINATION.....	7
1.	<i>Citation of prior art.....</i>	7
2.	<i>Claims of the patent are to be broadly construed .....</i>	7
C.	EVIDENTIARY STANDARDS.....	7
D.	PRIOR ART PATENTS RELIED UPON IN THIS REQUEST .....	8
E.	SUPPORTING DOCUMENTS DISCUSSED IN THIS REQUEST .....	8
F.	CURRENT LITIGATION.....	9
G.	IDENTIFICATION OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY .....	9
H.	OVERVIEW OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY .....	9
<b>III.</b>	<b>DETAILED EXPLANATION UNDER 37 C.F.R. § 1.510(B)(2) OF THE PERTINENCY AND MANNER OF APPLYING THE CITED PRIOR ART TO EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED .....</b>	<b>12</b>
A.	REJECTIONS OF CLAIMS .....	13
1.	<i>Claims 1, 5-7, 11-13, 15 and 16 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Tock patent. ....</i>	<i>13</i>
2.	<i>Claims 1, 5-7, 11-13 and 15 are unpatentable under 35 U.S.C. § 102(a) as being anticipated by the Palay patent. ....</i>	<i>13</i>
	<b>CONCLUSION .....</b>	<b>13</b>

## I. INTRODUCTION

Requester requests reexamination of claims 1, 5-7, 11-13, 15 and 16 of U.S. Patent No. 5,966,702 (“the ‘702 patent”) under 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510 *et seq.* The application for the ‘702 patent was filed on October 31, 1997. The ‘702 patent is assigned to Sun Microsystems, Inc.

The claims of the ‘702 patent for which reexamination is requested relate to a technique for pre-processing class files by (1) ***removing duplicate elements*** from a plurality of class files to obtain a plurality of ***reduced class files***; (2) creating a ***shared table*** of the duplicate elements; and (3) then forming a ***multi-class file*** containing the reduced class files and the shared table. As explained in detail below and in the claim charts set forth in the attached exhibits, this pre-processing technique was well-known prior to the filing of the application that resulted in the ‘702 patent.

The Requester has identified herein two (2) prior art patents that individually anticipate claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent. These prior art patents were neither cited to nor considered by the Examiner during prosecution of the ‘702 patent and are not cumulative of information cited to or considered by the Examiner during prosecution of the ‘702 patent. There were no specific prior art patents or publications discussed in the prosecution file history and a Notice of Allowance issued in the ***first substantive Office Action***.

Accordingly, at least in view of these listed prior art references and the substantial new questions of patentability that they raise, the Requester respectfully requests the issuance of an order for reexamination, and further requests that claims 1, 5-7, 11-13, 15 and 16 be canceled.

The Requester respectfully requests that this Request be afforded special dispatch in accordance with 35 U.S.C. § 305 and 37 C.F.R. § 1.550.

The Requester further respectfully requests that the Director provide an order of action dates to accompany the decision ordering reexamination of the '702 patent.

## **II. STATEMENT UNDER 37 C.F.R. § 1.510 (B)(1) POINTING OUT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY**

Substantial new questions of patentability of claims 1, 5-7, 11-13, 15 and 16 of the '702 patent are raised in view of the new prior art references not previously considered by the Examiner. Section II.A provides an overview of the '702 patent. Section II.B summarizes certain aspects of the law regarding reexamination. Section II.C summarizes the evidentiary standards applicable to reexamination. Section II.D provides a list of all prior art patents relied upon in this Request. Section II.E provides a list of other supporting documents discussed in this Request. Section II.F provides a summary of pending litigation involving the '702 patent. Section II.G provides an identification of the substantial new questions of patentability raised in this Request. Section II.H provides an overview of the substantial new questions of patentability raised in this Request.

### **A. Overview of the '702 Patent**

The claims of the '702 patent recite a compression technique for *eliminating 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. The reduced class files and the shared table are then formed into a *multi-class file*. Claim 1 recites a method for performing this compression technique. Claim 7 defines a computer program product with code to perform the

compression technique. Claim 13 is an apparatus claim that recites a processor performing the compression technique.

The Background of the Invention section of the '702 patent describes the problem of duplicated data found in a plurality of files when using a class file format such as the Java class file format. '702 patent, 1:29-40. This duplicated data causes inefficiencies in the storage, transfer and processing of class files. *Id.*, 1:40-42.

One embodiment of the invention is described as a pre-processor that examines each class file in a set of class files to identify duplicated data in the form of redundant constants in a constant pool. *Id.*, 9:17-21. All occurrences of the redundant constant are removed from the constant pools of the individual class files to form reduced class files. *Id.*, 9:23-25, 9:39-40. The redundant constants are collected and placed in a shared table. *Id.*, 9:21-23. The 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 multi-class file. *Id.*, 5:12-17, 9:35-40.

The '702 patent issued from U.S. Patent Application Serial No. 08/961,874, filed October 31, 1997. The claims were *allowed in the first substantive Office Action* mailed on January 29, 1999. In the Office Action, the Examiner did not discuss any of the prior art references and only provided the following brief statement concerning the reasons for allowing the claims:

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 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.

Office Action dated January 29, 1999, p. 3 (emphasis added). No other analysis of the prior art is provided. The Notice of References Cited accompanying the Office Action lists ten U.S. patents and no other foreign patents or publications.

**B. Aspects of the law governing reexamination**

**1. Citation of prior art**

“Any person at any time may file a request for reexamination by the Office of any claim of any patent on the basis of any prior art cited under the provisions of section 301.” 35 U.S.C. § 302. Section 301 limits prior art to “patents or printed publications.” 35 U.S.C. § 301.

MPEP 2128 classifies a reference as a printed publication if it is accessible to the public:

A reference is proven to be a ‘printed publication’ ‘upon a satisfactory showing that such *document* has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’

*In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

**2. Claims of the patent are to be broadly construed**

In a reexamination proceeding, claims are to be given their broadest construction consistent with the specification. *See In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.”).

**C. Evidentiary standards**

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present. *See* MPEP 2242. 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. *Id.* In addition to patents and printed publications, admissions by a patentee may also be used as evidence to establish a substantial new question of patentability in combination with a patent or a printed publication. *See* MPEP 2217. An admission by a patentee may reside in a record created during litigation. *See id.* Such patentee admissions may be relied upon for any matter affecting patentability. 37 C.F.R. § 1.104(c)(3).

#### **D. Prior art patents relied upon in this Request**

In accordance with 37 C.F.R. § 1.510, reexamination of claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent is requested in view of the prior art patents listed below, which raise substantial new questions of patentability. This Request will demonstrate how claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent are anticipated or rendered obvious in view of the following prior art references:

1. U.S. Patent No. 5,815,718 to Tock, issued September 29, 1998 from an application filed May 30, 1996 (hereinafter, the “Tock patent”), provided as Exhibit 2.
2. U.S. Patent No. 5,613,120 to Palay, et al., issued March 18, 1997 from an application filed October 20, 1994 (hereinafter, the “Palay patent”), provided as Exhibit 3.

#### **E. Supporting documents discussed in this Request**

The following documents are provided to assist the Examiner in understanding the Request, including claim charts and references providing background information:

1. Claim Chart based on the Tock patent, provided as Exhibit 4.
2. Claim Chart based on the Palay patent, provided as Exhibit 5.



## **F. Current Litigation**

The Requester is aware of at least one current litigation matter involving the ‘702 patent. On August 12, 2010, Oracle America, Inc. filed a complaint in the U.S. District Court for the Northern District of California alleging that Google Inc. is infringing the ‘702 patent. The case is styled *Oracle America, Inc. v. Google Inc.*, Civil Action No.: 3:10-cv-03561-WHA. A Joint Case Management Statement for the case provides for a claim construction hearing in the case to take place on April 20, 2011. Fact discovery will end July 29, 2011 and dispositive motions are due September 8, 2011.

## **G. Identification of Substantial New Questions of Patentability**

In this Request, substantial new questions of patentability for claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent are identified in accordance with 37 CFR § 1.510(b)(1) as follows:

1. Claims 1, 5-7, 11-13, 15 and 16 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Tock patent.
2. Claims 1, 5-7, 11-13 and 15 are unpatentable under 35 U.S.C. § 102(a) as being anticipated by the Palay patent.

## **H. Overview of Substantial New Questions of Patentability**

The application that matured into the ‘702 patent was filed on October 31, 1997. The claims in the ‘702 patent for which reexamination is requested are claims 1, 5-7, 11-13, 15 and 16. As an example, claim 1 of the ‘702 patent recites a method comprising:

1. *removing duplicated elements* from a plurality of class files to obtain *reduced class files*;
2. forming a *shared table* comprising the duplicated elements; and
3. forming a *multi-class file* comprising the reduced class files and the shared table.

Requester submits that each of these claim elements and the similar claim elements found in the other claims are disclosed by the following prior art references.

### **Tock patent**

U.S. Patent No. 5,815,718 to Tock, issued September 29, 1998 from an application filed May 30, 1996 (hereinafter, the “Tock patent”), provided as Exhibit 2, generally describes a class loader used to modify the class structure of an executable module and eliminate duplicate data in order to produce a more compact representation of the executable module. Because the Tock patent was filed on May 30, 1996, it is prior art under 35 U.S.C § 102(e) given that the earliest possible priority date for the ‘702 patent is October 31, 1997. The Tock patent was not in front of the Patent Office during the prosecution of the application that matured into the ‘702 patent nor is it cumulative of the prior art considered by the Patent Office during the prosecution of the ‘702 patent.

The Tock patent describes an offline 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. First, Tock’s class loader *eliminates duplicate constants* from the constant pools of classes to produce more compact updated class files, i.e., *a reduced class file*. (Tock patent, col. 5, ll.29-34; col. 5, ll.38-50; col. 8, ll.40-46.) Second, in connection with eliminating duplicate constants, Tock’s class loader creates a combined universal constant pool, i.e., *the shared table*. (Tock patent, col. 5, ll. 29-34; col. 8, ll. 40-55; col. 9, ll. 27-29.) Lastly, the output of Tock’s class loader is an optimized and more compact representation of the executable code

comprising the universal constant pool and updated class files, i.e., *the multi-class file*. (Tock patent, col. 10, ll. 29–32.)

A reasonable examiner would have considered the teachings of the Tock patent to be important in determining whether or not the claims of the ‘702 patent were patentable. As set forth in detail in the claim chart in Exhibit 4, the Tock patent anticipates claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent. For this reason, the Tock patent raises a substantial new question of patentability with respect to claims 1, 5-7, 11-13, 15 and 16 of the ‘702 patent.

### **Palay patent**

U.S. Patent No. 5,613,120 to Palay, issued March 18, 1997 from an application filed October 20, 1994 (hereinafter, the “Palay patent”), provided as Exhibit 3, generally describes techniques for compiling and linking object-oriented computer programs that include methods for merging together class information from object files. Because the Palay patent issued on March 18, 1997, it is prior art under 35 U.S.C § 102(a) given that the earliest possible priority date for the ‘702 patent is October 31, 1997. The Palay patent was not in front of the Patent Office during the prosecution of the application that matured into the ‘702 patent nor is it cumulative of the prior art considered by the Patent Office during the prosecution of the ‘702 patent.

The Palay patent discloses each of the three elements identified above that are recited in independent claims 1, 7 and 13 of the ‘702 patent. Specifically, with respect to the first element of the ‘702 patent claims, 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. (Palay patent, col. 28, ll. 50-61.) To the extent *reduced class files*

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).

With respect to the second element, forming a ***shared table***, *Palay*'s linker performs this element when it merges class information from object files and shared libraries to produce a merged table from which duplicates have been removed. (*Palay* patent, col. 28., ll. 39-61.) Third, 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-class file*** recited in the '702 patent. (*Palay* patent, col. 29, ll. 60-67; col. 7, ll. 51-54.)

A reasonable examiner would have considered the teachings of the *Palay* patent to be important in determining whether or not the claims of the '702 patent were patentable. As set forth in detail in the claim chart in Exhibit 5, the *Palay* patent anticipates claims 1, 5-7, 11-13 and 15 of the '702 patent. For this reason, the *Palay* patent raises a substantial new question of patentability with respect to claims 1, 5-7, 11-13 and 15 of the '702 patent.

### **III. DETAILED EXPLANATION UNDER 37 C.F.R. § 1.510(B)(2) OF THE PERTINENCY AND MANNER OF APPLYING THE CITED PRIOR ART TO EVERY CLAIM FOR WHICH REEXAMINATION IS REQUESTED**

The detailed explanation herein under 37 C.F.R. § 1.510(b)(2) references detailed claim charts (Exhibits 4 and 5). The claim charts set forth a detailed explanation describing the

pertinence and manner of applying the prior art references to the claims and each of the claim elements of the '702 patent.

**A. Rejections of Claims**

1. **Claims 1, 5-7, 11-13, 15 and 16 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by the Tock patent.**

The Tock patent issued on September 29, 1998 from an application filed on May 30, 1996. The Tock patent is prior art to the '702 patent under 35 U.S.C. § 102(e). The Tock patent was not in front of the Patent Office during the prosecution of the application that matured into the '702 patent nor is it cumulative of the prior art considered by the Patent Office during the prosecution of the '104 patent. As set forth in detail in the claim chart attached as Exhibit 4, the Tock patent discloses each of the elements of claims 1, 5-7, 11-13, 15 and 16.

2. **Claims 1, 5-7, 11-13 and 15 are unpatentable under 35 U.S.C. § 102(a) as being anticipated by the Palay patent.**

The Palay patent issued on March 18, 1997. Given the October 31, 1997 filing date for the '702 patent, the Palay patent is prior art to the '702 patent under 35 U.S.C. § 102(a). The Palay patent was not in front of the Patent Office during the prosecution of the application that matured into the '702 patent nor is it cumulative of the prior art considered by the Patent Office during the prosecution of the '702 patent. As set forth in detail in the claim chart attached as Exhibit 5, the Palay patent discloses each of the elements of claims 1, 5-7, 11-13 and 15.

**CONCLUSION**

For the reasons provided herein, Requester respectfully submits that the prior art submitted herewith raises substantial new questions of patentability as to claims 1, 5-7, 11-13, 15 and 16 of the '702 patent because, as discussed above, claims 1, 5-7, 11-13, 15 and 16 of the '702 patent are anticipated in view of the prior art patents discussed herein. Accordingly,

reexamination of claims 1, 5-7, 11-13, 15 and 16 of the '702 patent is respectfully requested, finally rejecting these claims.

The undersigned further notes the standards set forth at 37 C.F.R. 1.550(f) wherein the reexamination Requester will be sent copies of Office actions issued during the reexamination proceedings as well as served (by the patent owner) with any document filed in the reexamination proceeding in accordance with 37 C.F.R. 1.248. (*See* MPEP §§ 2264 and 2266.)

If the Patent Office determines that a fee and/or other relief is required, Requester petitions for any required relief including authorizing the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 11-0980** referencing Docket No. 13557.112021.

As identified in the attached Certificate of Service and in accordance with 37 C.F.R. §§ 1.33(c) and 1.510(b)(5), a copy of the present request is being served to the address of the attorney or agent of record.

February 15, 2011

Respectfully submitted,

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