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

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001560

PATENT NO. : 7426720

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

ORDER GRANTING/DENYING REQUEST FOR INTER PARTES REEXAMINATION	Control No. 95/001,560	Patent Under Reexamination 7426720	
	Examiner MARY STEELMAN	Art Unit 3992	

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☐ PTO-892   ☐ PTO/SB/08   ☐ Other: _____

1. ☒ The request for *inter partes* reexamination is GRANTED.

   ☒ An Office action is attached with this order.

   ☐ An Office action will follow in due course.

2. ☐ The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No. 95/001,560	Patent Under Reexamination 7426720	
	Examiner MARY STEELMAN	Art Unit 3992	

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INTER PARTES REEXAMINATION COMMUNICATION	Control No. 95/001,560	Patent Under Reexamination 7426720	
	Examiner MARY STEELMAN	Art Unit 3992	

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

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ☒ 1 MONTH(S) ☐ THIRTY DAYS FROM THE MAILING DATE OF THIS LETTER. EXTENSIONS OF TIME FOR PATENT OWNER ARE GOVERNED BY 37 CFR 1.956.

Each time the patent owner responds to this Office action, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it <u>cannot</u> be extended. See also 37 CFR 1.947.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

DETAILED ACTION

The instant request for *inter partes* reexamination alleges a substantial new question of

patentability affecting claims 1-8, 10-17, and 19-22 of USPN 7,426,720 B1 to Fresko.

Current Litigation

U.S. District Court for the Northern District of California - Oracle America, Inc. v. Google, Inc.,

Civil Action No.: 3:10-cv-03561

Scope of Reexamination

On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section

13105, part (a) of the Act revised the reexamination statute by adding the following new last

sentence to 35 U.S.C. 303(a) and 312(a):

The existence of a substantial new question of patentability is not precluded by the fact that a

patent or printed publication was previously cited by or to the Office or considered by the

Office. For any reexamination ordered on or after November 2, 2002, the effective date of the

statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily

preclude the existence of a substantial new question of patentability (SNQ) that is based

exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance

shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the instant request for reexamination the examiner has considered old art taken in a new

combination (viewed in a new light) and new art that was not before the previous examiner at the

time of allowance.

Background

Application Control Number 10/745,023 (file date 12/22/2003), issued as USPN 7,426,720 B1

(09/16/2008) to Fresko. A terminal disclosure was filed (07/10/2007) and accepted (09/20/2007)

over Application control number 10/745,022, now USPN 7,293,267, where similar subject

matter was claimed by the same inventor.

A non final office action (04/27/2009) rejected claims 1-24 as obvious over USPN 6,823,509 B2

to Webb, in view of US Pub No. 2003/0088604 A1 to Kuck. It was noted that Web did not

disclose a runtime environment to clone the memory space as a child runtime system process

responsive to a process request and to execute the child runtime system process. However Kuck

disclosed the missing teaching. The non final office action also provided a provisional

nonstatutory double patenting rejection of claims 1, 6-12, and 17-24 over claims 1, 8-14, and 21-

28 of copending Application 10/745,022. Applicant's Response (07/10/2007) amended claims 1,

12, and 24 to clarify that the invention sets operating system level resource management

parameters on the child runtime system processes, and asserted that Webb / Kuck did not teach

the existence of a resource controller that sets operating system level resource management

parameters on a child runtime system process. Applicant cancelled dependent claims 9 and 20.

A final office action (10/18/2007) maintained the rejection and responded to the Applicant's

argument noting that Kuck is relied upon for teaching the existence of a resource controller to set

operating system level resource management parameter on the child runtime system process at

paragraph [0064]. An interview (12/17/2007), discussing Applicant's claim amendments after

final (12/18/2007) (amended claims 1, 12, and 24, canceled claims 7 and 18, added new claims

25 and 26), was followed by an Advisory Action (01/23/2008) denying entry of claim

amendments, as they changed the scope of the claims. Subsequent to an RCE (01/31/2008),

incorporating the amendments of 12/18/2007, a Notice of Allowance (05/20/2008) was issued.

Claims 1-6, 8, 10-17, 19, and 21-26 were allowed. Applicant's argued that the present invention

reduces both the allocation overhead and the memory space usage of virtual machines by using

copy-on-write cloning, so that referenced segments are lazily copied at modification time, thus

reducing the time and space needed to initialize and execute the child runtime system. Applicant

argued that nothing in Webb or Kuck discloses reducing memory usage for virtual machines by

using copy-on-writing cloning. An Examiner's Amendment added the terms "a processor; a

memory" to claims 1 and 24. The Examiner noted that the prior art of record failed to teach: "a

runtime environment to clone the memory space as a child runtime system process responsive to

a process request and to execute the child runtime system process and a copy-on-write process

cloning mechanism to instantiate the child runtime system process by copying references to the

memory space of the master runtime system process into a separate memory space for the child

runtime system process, and to defer copying of the memory space of the master runtime system

process until the child runtime system process needs to modify the referenced memory space of

the master runtime system process as recited in independent claims."

Overview of USPN 7,426,720 B1 to Fresko

The '720 patent relates to a method and system for the "dynamic preloading of classes through memory space cloning of a master runtime system process" relying in all the claims on a copy-on-write process cloning mechanism. *See* '720 patent, Claims 1, 10, and 20. The '720 patent recites the cloning of a master runtime process into one or more child runtime processes to support the spawning of multiple and independent isolated user applications. *See* '720 patent 2:44-48. Each of the independent claims of the '720 patent rely on a copy-on-write process cloning mechanism to instantiate the child runtime system process. *See id.* at Claims 1, 10, and 20.

The '720 specification acknowledges that a well-known process cloning mechanism in the prior art was the fork( ) system call of the Unix and/or Linux operating systems: "an example of a process cloning mechanism suitable for use in the present invention is the fork () system call provided by the Unix or Linux operating systems, such as described in [the prior art reference] M. J. Bach, 'The Design of the Unix Operating System,' Ch. 7, Bell Tele. Labs., Inc. (1986)." *See* '720 patent at 4:54-5:6 (citing Chapter 7 of the APA-Bach reference). When implementing the fork( ) system call, use of the copy-on-write process allows for the operating system to create a copy of the context of the parent process into the memory space of the child process by copying only references to the memory space, deferring the actual copying of the individual memory space segments until, and if, the child process attempts to modify the referenced data of the parent process context. *See id.* at 4:63-5:3. The '720 patent then describes a "copy on-write variant" of this fork( ) system call "[i]n a copy-on-write variant of the fork( ) system call, the operating system only copies references to the memory space and defers actually copying

individual memory space segments until, and if, the child process attempts to modify the

referenced data of the parent process context." *See id.* at 4:66-5:3. The '720 patent lists the

reduced impact on system memory as a primary benefit of the combination of a fork( ) system

call with copy-on-write. *See* '720 patent at 3:21-40. The '720 patent incorporates by reference

only Chapters 2 and 7 of the APA-Bach reference, which the Applicant relied on for discussion

of the fork( ) system call.

Prior Art

Third Party Requester proposes a substantial new question of patentability to be raised based on

the teachings disclosed by the following prior art references:

1. USPN 6,823,509 to Webb, "Virtual Machine with Reinitialization," published on Dec. 12, 2001, issued on Nov. 23, 2004 ("Webb"), Exhibit 6, qualifies as a 102(b) reference.

2. US Patent Publication No. 2003/0088604 A1 to Kuck, "Process Attachable Virtual Machines," published on May 8, 2003 (hereinafter "Kuck"), Exhibit 7, qualifies as a 102(e) reference.

3. M.J. Bach, The Design of the Unix Operating System, Bell Telephone Labs., Inc. (1986); excerpts ("APA-Bach"), Exhibit 8, qualifies as a 102(b) reference.

4. Jeff Dike, "A user-mode port of the linux kernel," Proceeding ALS '00 Proceedings of the 4th annual Linux Showcase & Conference - Volume 4, USENIX Association Berkeley, CA, USA (2000) ("Dike"), Exhibit 9, qualifies as a 102(b) reference.

5. Udo Steinberg, "Fiasco u-Kernel User-Mode Port," Dresden University of Technology, Institute of System Architecture (Dec. 19, 2002) ("Steinberg"), Exhibit 10, qualifies as a 102(b) reference.

6. USPN 6,405,367 to Bryant et al., "Apparatus and Method for Increasing the Performance of Java Programs Running on a Server," issued on June 11, 2002 ("Bryant"), Exhibit 11, qualifies as a 102(b) reference.

7. US Patent Application Pub. No. 2004/001,787 to Traut et al., "Method for Forking or Migrating a Virtual Machine," filed on Jul. 11, 2002, published on Jan. 15, 2004, and issued as a United States Patent on Dec. 25, 2007 ("Traut"), Exhibit 12, qualifies as a 102(b) reference.

8. Sriram Srinivasan, Advanced Perl Programming, O'Reilly & Associates, Inc. (August 1997) ("Srinivasan"), Exhibit 13, qualifies as a 102(b) reference.

9. USPN 6,854,114 to Sexton, "Using a virtual machine instance as the basic unit of user execution in a server environment," filed on Feb. 25, 2000, issued on Feb. 8, 2005 ("Sexton"), Exhibit 14, qualifies as a

102(b) reference.

10. USPN 6,075,938 to Bugnion et al., "Virtual Machine Monitors for Scalable Multiprocessors," filed on June 10, 1998, issued on June 13, 2000 ("Bugnion"), Exhibit 15, qualifies as a 102(b) reference.

11. USPN 6,330,709 to Johnson et al., "Virtual Machine Implementation for Shared Persistent Objects," filed on Feb. 25, 2000, issued on Dec. 11,2001 ("Johnson"), Exhibit 16, qualifies as a 102(b) reference.

Webb and Kuck were considered in the prosecution of the '023 Application, but their teachings were not combined with the complete APA teachings of Bach, which was incorporated by reference into the '023 Application (USPN 7,426,720 B1 to Fresko, 4: 56-58). APA-Bach, Chapter 9 was not previously considered by the Examiner or listed in an IDS statement. Thus, the combination, with new citations, presents teachings in a new light.

Proposed SNQs

The Requester has alleged substantial new questions of patentability as follows:

SNQ 1: The requester proposes that the APA-Bach teachings (Request 03/01/2011, pp. 20-25 & Claim Chart Exhibit 17) taken in combination with Webb and Kuck, raises a substantial new question of patentability regarding claims 1-8, 10-17, and 19-22.

Analysis: The combination of Webb, Kuck, and APA-Bach are viewed in a new light and provide teachings non-cumulative to the prior art considered by the Patent Office during the prosecution of the '720 patent.

Webb / Kuck provide relevant teachings of cloning the master runtime system process along with the motivation to reduce memory usage and overhead when instantiating and executing virtual machines. Webb teaches a computer system including a memory and a processor. *See* Webb at

3:56-4:2. Webb implements a class pre-loader: "[a]t run-time objects are created as instantiations

of these class files, and indeed the class files themselves are effectively loaded as objects." *See*

Webb at 1:22-38. Webb's disclosure of a master runtime system process to interpret and to

instantiate the representation as a class definition in a memory space of the master runtime

system process is clear in Fig. 3, which Webb explains is the "initialization of a loaded class

(step 350), which represents calling the static initialization method (or methods) of the class . . .

this application must be performed once and only once before the first active use of a class"

which then allows for "[t]he new application class [to load the application classes into the JVM

(step 410), and involves the steps shown in Fig. 3 for all the application classes." *See* Webb at

6:59-65 & 7:34-39. Kuck discloses a runtime environment to clone the memory space as a child

runtime system process responsive to a process request and to execute the child runtime system

process. *See* Kuck at ¶¶ [0064]-[0065].

Requester proposes that the APA-Bach reference appears to teach the very feature that was

believed to distinguish the claimed invention over the previous prior art, notably: "[t]he *copy-on-*

write bit, used in the *fork* system call, indicates that the kernel must create a new copy of the

page when a process modifies its contents." *See* APA-Bach at 287. And, even more specifically,

APA-Bach discloses: "As explained in Section 7.1, the kernel duplicates every region of the

parent process during the fork system call and attaches it to the child process. Traditionally, the

kernel of a swapping system makes a physical copy of the parent's address space, usually a

wasteful operation, because processes often call exec soon after the fork call and immediately

free the memory just copied. On the System V paging system, the kernel avoids copying the page

by manipulating the region tables, page table entries, and pfdata table entries: It simply

increments the region reference count of shared regions .... The page can now be referenced

through both regions, which share the page until a process writes to it. The kernel then copies the

page so that each region has a private version. To do this, the kernel turns on the 'copy on write'

bit for every page table entry in private regions of the parent and child processes during fork. If

either process writes the page, it incurs a protection fault, and in handling the fault, the kernel

makes a new copy of the page for the faulting process. The physical copying of the page is thus

deferred until a process really needs it." *See* APA-Bach at 289-90.

It is agreed that the consideration of APA-Bach, taken in combination with Webb / Kuck, for the

teachings that were not present in the prosecution of the application which became the Fresko

'720 patent, raises a substantial new question of patentability. There is a substantial likelihood

that a reasonable examiner would consider the APA-Bach teachings, taken in combination with

Webb / Kuck, important in deciding whether or not the claims are patentable. Accordingly, it is

agreed that the APA-Bach teachings, in combination with Webb / Kuck, raises a substantial new

question of patentability with respect to claims 1-8, 10-17, and 19-22, which question has not

been decided in a previous examination of the Fresko '120 patent.

SNQ 2: The requester proposes that Dike, with evidentiary support by Steinberg, raises a

substantial new question of patentability regarding claims 1-8, 10-17, and 19-22. (Request

03/01/2011, pp. 7-8, 25-28 & Claim Chart Exhibit 18)

Analysis: The teachings of Dike, as evidenced by Steinberg, are non cumulative to the prior art considered by the Patent Office during the prosecution of the '720 patent.

Dike describes the creation of a Linux virtual machine that runs on Linux, wherein the virtual machine systems are all cloned, using the fork( ) system call, onto the host system (Dike, 2.1, 2.3). Since all of the systems need access to the kernel data, Dike employs a shared data state between the processes, disclosing a copy-on-write mechanism to allow all of the processes to access the kernel data. Dike provides the teaching that was missing from the original examination by explicitly disclosing the underlying cloning process is the Linux fork( ) call, and further noting that the Linux fork( ) cloning is optimized using copy-on-write. Further supporting evidence of the cloning optimization (using copy on write) is provided by Steinberg: "[t]he created child process inherits copies of the parent process data space, heap and stack, which are copied on demand using a copy-on-write mechanism." *See* Steinberg at 21.

It is agreed that the consideration of Dike, supported with evidence by Steinberg, for the teachings that were not present in the prosecution of the application which became the Fresko '720 patent, raises a substantial new question of patentability. There is a substantial likelihood that a reasonable examiner would consider the Dike / Steinberg teachings important in deciding whether or not the claims are patentable. Accordingly, it is agreed that Dike / Steinberg raises a substantial new question of patentability with respect to claims 1-8, 10-17, and 19-22, which question has not been decided in a previous examination of the Fresko '120 patent.

SNQ 3: The requester proposes (Request 03/01/2011, pp. 7-8, pp. 25-28 & Claim Chart Exhibit

18) that the combination of Dike and Steinberg raises a substantial new question of patentability

regarding claims 1-8, 10-17, and 19-22.

Analysis: The teachings of Dike and Steinberg are noted above. To the extent that it is found

that Dike does not anticipate claims 1-8, 10-17 and 19-22 of the 720 patent, then the combination

of Dike and Steinberg teaches all the elements of these claims. Dike discloses process cloning

and explicitly references copy-on-write as the default mechanism for process cloning. Steinberg

provides teachings that define the copy-on-write mechanism.

It is agreed that consideration of Dike, in combination with Steinberg, for the teachings that were

not present in the prosecution of the application which became the Fresko '720 patent, raises a

substantial new question of patentability. There is a substantial likelihood that a reasonable

examiner would consider the Dike / Steinberg teachings important in deciding whether or not the

claims are patentable. Accordingly, it is agreed that an obvious combination of Dike / Steinberg

raises a substantial new question of patentability with respect to claims 1-8, 10-17, and 19-22,

which question has not been decided in a previous examination of the Fresko '120 patent.

SNQ 4: The requester proposes that Bryant, in combination with APA-Bach, raises a

substantial new question of patentability regarding claims 1-8, 10-17, and 19-22. (Request

03/01/2011, pp. 8-9, 28-31 & Bryant in view of APA Bach - Claim Chart Exhibit 19)

Analysis: The teachings of Bryant and APA-Bach, are non cumulative to the prior art

considered by the Patent Office during the prosecution of the '720 patent.

Bryant discloses a method and apparatus useful for increasing the performance of Java programs

by executing a fork command and creating a child java machine. Bryant discloses a Java server

that "invokes the Java virtual machine and preloads all potentially needed object files during

initialization of the Java virtual machine to speed up the actual execution of a particular Java

application. The Java server accomplishes the execution of a particular Java application by

forking itself and then having the child Java server run the Java class files in the already loaded

Java virtual machine for the specific Java CGI-BIN script." *See B*ryant at 2:46-48.

Requester proposes that the APA-Bach reference appears to teach the very feature that was

believed to distinguish the claimed invention over the previous prior art. The APA-Bach

disclosure of the copy-on-write mechanism, teaches the purported point of novelty of reducing

memory usage for virtual machines by using copy-on-write cloning. (Bach, 192, 287-290)

It is agreed that the consideration of APA-Bach, taken in combination with Bryant, for the

teachings that were not present in the prosecution of the application which became the Fresko

'720 patent, raises a substantial new question of patentability. There is a substantial likelihood

that a reasonable examiner would consider the APA-Bach teachings, taken in combination with

Bryant, important in deciding whether or not the claims are patentable. Accordingly, it is agreed

that the APA-Bach teachings, in combination with Bryant, raise a substantial new question of

patentability with respect to claims 1-8, 10-17, and 19-22, which question has not been decided

in a previous examination of the Fresko '120 patent.

SNQ 5: The requester proposes that Bryant in combination with Traut raises a substantial new

question of patentability regarding claims 1-8, 10-17, and 19-22. (Request 03/01/2011, pp. 8-9,

28-31 & Bryant in view of Traut Claim Chart Exhibit 20)

Analysis: The teachings of Bryant and Traut, are non cumulative to the prior art considered by

the Patent Office during the prosecution of the '720 patent.

Bryant's teachings are discussed above. The Traut prior art reference discloses the use of a

copy-on-write process cloning.mechanism while forking a virtual machine, and provides the

suggestion that that the forking process saves memory resources and increases speed. (Traut,

[0012], [0026], [0029], and [0031])

It is agreed that the consideration of Bryant and Traut, for the teachings that were not present in the prosecution of the application which became the Fresko '720 patent, raises a substantial new question of patentability. There is a substantial likelihood that a reasonable examiner would consider the teachings of the combination of Bryant and Traut important in deciding whether or not the claims are patentable. Accordingly, it is agreed that Bryant, in combination with Traut, raises a substantial new question of patentability with respect to claims 1-8, 10-17, and 19-22, which question has not been decided in a previous examination of the Fresko '120 patent.

SNQ 6: The requester proposes that the combination of Srinivasan and APA-Bach raises a substantial new question of patentability regarding claims 1-8, 10-17, and 19-22. (Request 03/01/2011, pp. 31-33, & Claim Chart Exhibit 21)

Analysis: The Srinivasan and notable citations of the APA-Bach reference are non-cumulative to the prior art considered by the Patent Office during prosecution of the '720 patent.

The Srinivasan reference (pp. 193-194), explicitly uses fork( ) to spawn a worker process. The fork system call disclosed by Srinivasan was commonly used with the copy-on-write mechanism to further streamline the impact on system memory, as described by APA-Bach. The APA-Bach discloses copy-on-write with the object-oriented code. Requester proposes that the Srinivasan / APA-Bach combination appears to teach the very feature that was believed to distinguish the claimed invention over the previous prior art.

It is agreed that the consideration of Srinivasan and APA-Bach, for the teachings that were not

present in the prosecution of the application which became the Fresko '720 patent, raises a

substantial new question of patentability. There is a substantial likelihood that a reasonable

examiner would consider the combination of teachings of Srinivasan and APA-Bach important in

deciding whether or not the claims are patentable. Accordingly, it is agreed that Srinivasan, in

combination with APA-Bach, raises a substantial new question of patentability with respect to

claims 1-8, 10-17, and 19-22, which question has not been decided in a previous examination of

the Fresko '120 patent.

SNQ 7: The requester proposes (Request 03/01/2011, pp. 9, 33-36 & Claim Chart Exhibit 22)

that the combination of Sexton and Bugnion raises a substantial new question of patentability

regarding claims 1-8, 10-17, and 19-22.

Analysis: Sexton is directed to reducing memory usage for virtual machines by providing read-

only access to shared data. *See* Sexton at 5: 29-44; 5: 53-57; 8:41-64. Sexton provides the

suggestion for reducing memory by sharing data between multiple ("spawned", '114, 8: 2)

virtual machines and otherwise creating a VM data structure to hold modified data (i.e., fork

process, 8: 1-18; 8: 40-64), for the purpose of resource management. The Bugnion reference

discloses (6: 29-36; 14: 55-64; 15: 66 – 16: 1) a Virtual Machine Monitor ("VMM") layer that

"maintains copy-on-write disks."

Requester proposes that the Sexton / Bunion combination appears to teach the very feature that was believed to distinguish the claimed invention over the previous prior art.

It is agreed that the consideration of Sexton / Bunion, for the teachings that were not present in the prosecution of the application which became the Fresko '720 patent, raises a substantial new question of patentability. There is a substantial likelihood that a reasonable examiner would consider the combination of teachings of Sexton and Bunion important in deciding whether or not the claims are patentable. Accordingly, it is agreed that Sexton, in combination with Bunion, raises a substantial new question of patentability with respect to claims 1-8, 10-17, and 19-22, which question has not been decided in a previous examination of the Fresko '120 patent.

SNQ 8: The requester alleges (Request 03/01/2011, pp. 9, 33-36 & Claim Chart Exhibit 23) that the obvious combination of Sexton and Johnson raises a substantial new question of patentability regarding claims 1-8, 10-17, and 19-22.

Analysis: Sexton's teachings are noted above. The Johnson reference "introduces copy on write storage" used for access to static variables. (Johnson, 18: 34-44) Each JVM has its own copies of any static variables defined for a class of which it has an instance.

Requester proposes that the Sexton / Johnson combination appears to teach the very feature that was believed to distinguish the claimed invention over the previous prior art.

It is agreed that consideration of Sexton / Johnson, for the teachings that were not present in the prosecution of the application which became the Fresko '720 patent, raises a substantial new question of patentability. There is a substantial likelihood that a reasonable examiner would consider the combination of teachings of Sexton and Johnson important in deciding whether or not the claims are patentable. Accordingly, it is agreed that Sexton, in combination with Johnson, raises a substantial new question of patentability with respect to claims 1-8, 10-17, and 19-22, which question has not been decided in a previous examination of the Fresko '120 patent.

Conclusion

An Office action on the merits does not accompany this order for *inter partes* reexamination. An Office action on the merits will be provided in due course.

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

The Patent Owner is reminded 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). Amendments in an *inter partes* reexamination proceeding are made in the same manner that amendments in an *ex parte* reexamination are made. MPEP 2666.01. See MPEP 2250 for guidance as to the manner of making amendments in a reexamination proceeding.

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the instant Patent Under Reexamination or any related patent throughout the course of this reexamination proceeding. The Third Party requester is also reminded of the ability to similarly inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2686 and 2286.04.

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.

All correspondence relating to this *inter partes* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop Inter Partes Reexam

ATTN: Central Reexamination Unit Commissioner for Patents

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

For EFS-Web transmission, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except

for a request for reexamination and a corrected or replacement request for reexamination) will be

considered timely filed if (a) it is transmitted via the Office's electronic filing system in

accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of

correspondence stating the date of transmission, which is prior to the expiration of the set period

of time in the office action.

Any inquiry concerning this communication should be directed to the Central Reexamination

Unit at telephone number (571) 272-3704.

/Mary Steelman/

Conferees:

Reexamination Specialist, Primary Examiner

AU 3992

/William H. Wood/

Examiner, Art Unit 3992