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18
 19 UNITED STATES DISTRICT COURT
 20 NORTHERN DISTRICT OF CALIFORNIA
 21 SAN FRANCISCO DIVISION

22 ORACLE AMERICA, INC.

23 Plaintiff,

24 v.

25 GOOGLE INC.

26 Defendant.
 27

Case No. CV 10-03561 WHA

**UPDATE ON REEXAMINATION OF
'702 PATENT**

Dept.: Courtroom 9, 19th Floor
 Judge: Honorable William H. Alsup

1 Oracle America, Inc. submits this update on the PTO's progress in reexamining the
2 asserted claims of the '702 patent. On April 19, 2012, the PTO mailed a Notice of Intent to Issue
3 Ex Parte Reexamination Certificate confirming the patentability of all the asserted claims of the
4 '702 patent. Attached hereto is a copy of the PTO's notice.

5
6 Dated: April 22, 2012

MORRISON & FOERSTER LLP

7 By: /s/ Michael A. Jacobs

8
9 *Attorneys for Plaintiff*
ORACLE AMERICA, INC.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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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

25226 7590 04/19/2012
MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/19/2012

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



DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KING & SPALDING LLP

1180 Peachtree Street

Atlanta, Georgia 30309

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,492.

PATENT NO. 5,966,702.

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)).

**Notice of Intent to Issue
Ex Parte Reexamination Certificate**

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 --

1. Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
 - (a) Patent owner's communication(s) filed: 04/09/2012.
 - (b) Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
 - (c) Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - (d) The decision on appeal by the Board of Patent Appeals and Interferences Court dated _____
 - (e) Other: _____.
2. The Reexamination Certificate will indicate the following:
 - (a) Change in the Specification: Yes No
 - (b) Change in the Drawing(s): Yes No
 - (c) Status of the Claim(s):
 - (1) Patent claim(s) confirmed: 1,5-7,11-13,15 and 16.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
 - (3) Patent claim(s) canceled: _____.
 - (4) Newly presented claim(s) patentable: _____.
 - (5) Newly presented canceled claims: _____.
 - (6) Patent claim(s) previously currently disclaimed: _____
 - (7) Patent claim(s) not subject to reexamination: 2-4, 8-10, 14, and 17-23.
3. Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
4. Note attached NOTICE OF REFERENCES CITED (PTO-892).
5. Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
6. The drawing correction request filed on _____ is: approved disapproved.
7. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some* c) None of the certified copies have
 - been received.
 - not been received.
 - been filed in Application No. _____.
 - been filed in reexamination Control No. _____.
 - been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.
8. Note attached Examiner's Amendment.
9. Note attached Interview Summary (PTO-474).
10. Other: _____

All correspondence relating to this 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.

/Mary Steelman/
Primary Examiner
Art Unit: 3992

cc: Requester (if third party requester)

Art Unit: 3992

NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE

Per Request received 02/15/2011, regarding USPN 5,966,702 to Fresko et al., claims 1, 5-7, 11-13, and 15-16 are under reexamination. This office action is in response to Patent Owner's After Final Remarks and Exhibit A, Supplemental Declaration of Dr. Goldberg, received 04/09/2012. The Supplemental Declaration of Professor Benjamin Goldberg has been entered, considered, and weighed.

Non Patent Literature

The Java Virtual Machine Specification, Chapter 9, Tim Lindholm and Frank Yellin, pp. 329-428, Sept. 1996, first edition (Exhibit B, received 04/09/2012) is entered into prosecution. Patent Owner asserts that, in response to Examiner comments, this reference is necessary to evidence the reading of Tock's recoding of bytecodes in a quick instruction format as remaining machine- or platform-independent. Quick instructions, resulting from quickening the original bytecodes, do not appear in class files: "the *_quick* pseudo- instructions are not part of the Java Virtual Machine specification and do not appear in class files." (The Java Virtual Machine Specification, by Tim Lindholm and Frank Yellin, Chapter 9, pages 389-390, Sept. 1996, first edition)

A Summary of Patent Owner and Declarant Remarks

Patent Owner cites to the '702 specification: "[c]lass files contain bytecode instructions," and that bytecode instructions include code and data in a machine-independent format. ('702 Patent,

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1:34, "classfiles contain bytecode instructions"; 2:62-3:1, "Java classes are compiled into machine independent bytecode class files...platform-independent format called the class file format").

See '702, 8: 61-9: 7, "Embodiments of the invention examine the constant pool table for each class in a set of classes to determine where duplicate information exists...[duplicate] string constant may be removed from each class file structure and placed in a shared constant pool table..." An embodiment of a "multi-class file" is defined in the '702 Patent (9: 8-65) as comprising a shared pool count, a shared pool, a memory allocation requirement; a classfile count, and classfiles. See also '702, 9: 1-54 (mclass embodiments described); 10:25-51 ("...the class files are consolidated in a single multi-class file...").

In contrast to Tock ('718, 6: 41-44, "...bytecodes using a non-quick instruction format that symbolically reference methods are recoded in a quick instruction format that references the methods directly") which recodes bytecodes of the initially platform independent class files, transforming them into code with specific memory layout (platform specific), Fresko does not recode bytecodes of the platform-independent class files.

Tock's invention results in a device specific output module of preloaded classes (memory representation of loaded class/ identifies the internal memory layout of a specific target device).

See Tock '718, 5:29-50, "the offline class loader performs additional processing to tailor the

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class files that were originally structured for dynamic loading for a preloaded class environment"; 6:37-44, recoding bytecode instructions; 7:36-8:13, "Once the class data structures are allocated, pointers to the location of each of these structures is included in the class block."

As evidenced by The Java Virtual Machine Specification, pp. 389-390, Tock's recoded bytecodes ("the *_quick* pseudo- instructions") do not appear in class files.

Patent Owner asserts that the specification, without exception, describes the "multi-class file" as being platform-independent, and therefore the broadest reasonable interpretation, *consistent with the specification*, of "multi-class file" necessarily must include such platform-independence.

Tock copies (Tock, 10: 37-41) "all methods and data that must be resident in random access memory during execution to the random access memory locations assigned to them by the linker." (emphasis added) However, Tock is silent regarding the loading of a multiclass file as recited in claim 16, as that term has been construed above.

Examiner additionally notes that the Fresko '702 invention determines memory allocation (4: 67-5:1), and in contrast the Tock '718 invention (4: 29; 5: 53-54; 8: 8-12) determines memory layout (which is machine specific). In view of the discussion relating to Tock, Examiner finds

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Patent Owner and Declarant arguments persuasive. The prior 35 USC 102(e) rejections of claims 1, 5-7, 11-13, 15, and 16 are hereby withdrawn.

Examiner's Statement of Reasons for Patentability

Tock fails to teach:

(limitation of claim 1, and similarly recited in independent claims 7, 11, and 13)

“forming a multi-class file comprising said plurality of reduced class files and said shared table.”

(limitation of claim 16)

“said class loader configured to obtain and load said multi-class file into said runtime data area.”

As noted in the Final Office Action (02/07/2012, pp. 14-15) Palay fails to teach class files as defined by the Fresko '702 specification. Palay's invention operates to merge and link object files, and thus fails to teach a "plurality of class files" or "a plurality of reduced class files," as recited in claim language.

Confirmed Claims

Claims 1, 5-7, 11-13, and 15-16 are confirmed over prior art presented in this reexamination.

Any comments considered necessary by the Patent Owner regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the Patent Owner should be labeled: “Comments on Statement of Reasons for Patentability and/or Confirmation: and will be placed in the reexamination file.

Conclusion Extensions of Time

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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 reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in ex parte reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not affect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

Notification of Other Proceedings

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 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 apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §2686 and 2686.04.

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at

<https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop Ex Partes Reexam

Attn: Central Reexamination Unit

Commissioner for Patents

Application/Control Number: 90/011,492

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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 or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Mary Steelman/

Conferees: /EBK/

Primary Examiner

Alexander Kosowski
Supervisor
Art Unit 3992

Central Reexamination Unit 3992

(571) 272-3704

AK

Notice of References Cited	Application/Control No. 90/011,492	Applicant(s)/Patent Under Reexamination 5,966,702	
	Examiner MARY STEELMAN	Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-			
B	US-			
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
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FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
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T					

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U The Java Virtual Machine Specification, by Tim Lindholm and Frank Yellin, Chapter 9, pp. 329-428, Sept. 1996, first edition
V	
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



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Bib Data Sheet

CONFIRMATION NO. 8223

SERIAL NUMBER 90/011,492	FILING OR 371(c) DATE 02/15/2011 RULE	CLASS 707	GROUP ART UNIT 3992	ATTORNEY DOCKET NO. 13557.112021
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APPLICANTS
 5,966,702, Residence Not Provided;
 SUN MICROSYSTEMS, INC. (OWNER), PALO-ALTO, CA;
~~KING & SPALDING (3RD.PTY.REQ.), ATLANTA, GA;~~
~~KING & SPALDING, ATLANTA, GA~~
 Oracle America, Inc

**** CONTINUING DATA *******
 This application is a REX of 08/961,874 10/31/1997 PAT 5,966,702


**** FOREIGN APPLICATIONS *******

Foreign Priority claimed <input type="checkbox"/> yes <input checked="" type="checkbox"/> no	STATE OR COUNTRY	SHEETS DRAWING	TOTAL CLAIMS 23	INDEPENDENT CLAIMS 4
35 USC 119 (a-d) conditions met <input type="checkbox"/> yes <input checked="" type="checkbox"/> no <input type="checkbox"/> Met after Allowance				
Verified and Acknowledged <u>/Mary Steelman/</u> Examiner's Signature Initials				

ADDRESS
 22804

TITLE
 METHOD AND APPARATUS FOR PRE-PROCESSING AND PACKAGING CLASS FILES

FILING FEE RECEIVED 2520	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit
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Reexamination 	Application/Control No. 90/011,492	Applicant(s)/Patent Under Reexamination 5,966,702
	Certificate Date	Certificate Number C1

Requester Correspondence Address: <input type="checkbox"/> Patent Owner <input checked="" type="checkbox"/> Third Party
KING & SPALDING LLP 1180 Peachtree Street Atlanta, Georgia 30309

LITIGATION REVIEW <input checked="" type="checkbox"/>	ms <small>(examiner initials)</small>	01/26/2012 <small>(date)</small>
Case Name		Director Initials
USDistCt-CA N (San Francisco)3:10cv3561 Oracle America, Inc v. Google Inc OPEN		ARK P. BY
USDistCt-CA N(Oakland)4:10cv3561 Oracle America, Inc v. Google Inc OPEN		↓

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. No copending office proceedings found.	
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Search Notes



Application/Control No.

90/011,492

Examiner

MARY STEELMAN

Applicant(s)/Patent under Reexamination

5,966,702


Art Unit

3992

SEARCHED			
Class	Subclass	Date	Examiner

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
Prosecution history	03/07/2011	MS

Issue Classification 	Application/Control No.	Applicant(s)/Patent under Reexamination	
	90/011,492	5,966,702	
Examiner	MARY STEELMAN	Art Unit	3992

ISSUE CLASSIFICATION											
ORIGINAL					CROSS REFERENCE(S)						
CLASS	SUBCLASS				CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)					
707	692				707	1	2	8	10	102	
INTERNATIONAL CLASSIFICATION											
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N/A (Assistant Examiner) (Date)					/Mary Steelman/ 04/12/2012 (Primary Examiner) (Date)					Total Claims Allowed: 9	
<i>Sham S. Hope</i> 4/12/12 (Legal Instruments Examiner) (Date)										O.G. Print Claim(s) 1	
										O.G. Print Fig. 1	

<input checked="" type="checkbox"/> Claims renumbered in the same order as presented by applicant										<input type="checkbox"/> CPA		<input type="checkbox"/> T.D.		<input type="checkbox"/> R.1.47		
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