

**GOOGLE INC.'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY
OF CLAIM 1 OF U.S. PATENT NO. 5,713,740**

Exhibit B



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,941	04/02/2010	5,713,740	13557.105030	4606

7590 05/13/2010

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/13/2010

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



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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,941.

PATENT NO. 5,713,740.

ART UNIT 3993.

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	
	90/010,941	5,713,740	
	Examiner	Art Unit	
	BEVERLY M. FLANAGAN	3993	

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

The request for *ex parte* reexamination filed 02 April 2010 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 ON REQUEST FOR REEXAMINATION

A substantial new question of patentability affecting claims 1-6 and 11-17 of United States Patent Number 5,713,740 is raised by the request for *ex parte* reexamination.

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 conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Service of Papers

After the filing of a request for reexamination by a third 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 C.F.R. 1.248. See 37 C.F.R. 1.550(f).

Waiver of Right to File Patent Owner Statement

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

Art Unit: 3993

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:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Amendment in Reexamination Proceedings

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

Submissions

In order to ensure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 C.F.R. 1.116, after final rejection and by 37 C.F.R. 41.33 after appeal, which will be strictly enforced.

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 C.F.R. 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving U.S. Patent No. 5,713,740 throughout the course of this reexamination proceeding. Likewise, if present, 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 §§ 2207, 2282 and 2286.

Substantial New Question

A substantial new question of patentability (SNQ) is based on the following newly submitted printed publications:

Church, Kenneth W. and Jonathan Isaac Helfman, *Dotplot: A Program for Exploring Self- Similarity in Millions of Lines of Text and Code*, J. of Computational and Graphical Statistics, Vol. 2, No. 2 (June 1993), pp. 153-174 (hereinafter "Church 1993");

Cina, Jr. et al., U.S. Patent No. 5,510,808 (hereinafter "Cina '808");

Eick, U.S. Patent No. 5,945,998 (hereinafter "Eick '998");

Eick, Stephen G., Joseph L. Steffen and Eric E. Summer, Jr., *Seesoft – A Tool for Visualizing Line Oriented Software Statistics*, IEEE Transactions on Software Eng'g, Vol. 18, No. 11 (Nov. 1992), pp. 957-968 (hereinafter "Eick 1992");

Gould, U.S. Patent No. 5,623,558 (hereinafter "Gould '588");

Art Unit: 3993

Kozima, Hideki, *Text Segmentation Based On Similarity Between Words*, Proceedings of the 31st Annual Meeting of the Association for Computational Linguistics, Columbus, OH (June 1993), pp. 286-288 (hereinafter "Kozima 1993");

Brill, Eric, *A Simple Rule-Based Part of Speech Tagger*, Speech and Natural Language: Proceedings of a workshop held at Harriman, New York, Feb. 23-26, 1992, pp. 112-116 (hereinafter "Brill 1992");

Church, Kenneth Ward, *A Stochastic Parts Program and Noun Phrase Parser for Unrestricted Text*, Proceedings of the Second Conference on Applied Natural Language Processing, Austin, TX, Feb. 9-12, 1988, pp. 136-143 (hereinafter "Church 1988"); and

Church, Kenneth Ward, *Word Association Norms, Mutual Information and Lexicography*, Computational Linguistics, Vol. 16, No. 1 (March 1990), pp. 22-29 (hereinafter "Church 1990").

A discussion of the specifics follows.

The Church 1993 Reference

The Church 1993 reference raises a SNQ with respect to claims 1-3, 6, 11 and 13-17 of U.S. Patent No. 5,713,740. It is agreed that Church 1993 teaches an interactive program for browsing millions of lines of text and source code where the browser shows three views: a global overview, a magnified view of a small portion of the file and a text view (see Fig. 1). Church 1993 teaches, as an example, a dotplot (a graphical representation) of 37 million words of Canadian Hansards (parliamentary

Art Unit: 3993

debates) that are available in both English and French where the program identifies matches between an English text and its French translation (see Fig. 5 – dots in upper right and lower left quadrants of the dotplot). Church 1993 also teaches reducing the portion of text to an illegible size and displaying the reduced text in an uninterrupted format (see Fig. 5). Church 1993 also teaches that no discernable words can be seen in the dotplot (see Fig. 5). Church 1993 also teaches a dotplot comparing the translations of a Microsoft® manual in seven different languages in a single image with multiple textual features (see Fig. 8).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Church 1993 raises a substantial new question of patentability as to claims 1-3, 6, 11 and 13-17, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Cina '808 Reference

The Cina '808 reference raises a SNQ with respect to claims 1-6 and 12-17 of U.S. Patent No. 5,713,740. It is agreed that Cina '808 teaches steps that involve displaying within the scrollbar at least one indicia for indicating a relative location of a feature of interest within the presentation space, where the indicia may take the form of alphanumeric characters, symbols, colors, graphical images, audio information and combinations thereof (see Abstract and Fig. 3). Cina '808 also teaches an embodiment

Art Unit: 3993

with linear graphic symbols indicating the location of features in adjacent text (see col. 5, lines 47-55 and Fig. 3). Cina '808 also teaches creating representations of text, such as selected lines of text in a presentation space, by using various colors and shapes (i.e., without any discernable words of the text) (see col. 3, lines 23-25).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Cina '808 raises a substantial new question of patentability as to claims 1-6 and 12-17, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Eick '998 Reference

The Eick '998 reference raises a SNQ with respect to claims 1-3, 6 and 12-17 of U.S. Patent No. 5,713,740. It is agreed that Eick '998 teaches an apparatus for visually representing characteristics of the contents of a set of files in a display (see col. 2, lines 34-38). Eick '998 also teaches right hand space 217 that contains line characterization column 219 and line characterization column label 220 where column 219 indicates how different values from modification request records 121 are to be displayed in line representations 207 (see col. 6, lines 12-23). Eick '998 also teaches that the time at which a line of code was changed is made visible in display 201 by a shade of color (not a readable or discernable word), which is assigned to each modification request (see col. 6, lines 23-46). Eick '998 also teaches illustrating textual features on a scroll bar

and on a column representing computer code using graphical indicators (see col. 6, lines 23-46 and Fig. 2).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Eick '998 raises a substantial new question of patentability as to claims 1-3, 6 and 12-17, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Eick 1992 Reference

The Eick 1992 reference raises a SNQ with respect to claims 1-3, 6 and 12-17 of U.S. Patent No. 5,713,740. It is agreed that Eick 1992 teaches the Seesoft® software visualization system that allows one to analyze up to 50,000 lines of code simultaneously by mapping each line of code into a thin row (see page 957). Eick 1992 also teaches an example using the Bible, where each book could be represented as a column and each verse as a row (see page 963). Eick 1992 also teaches that the color of each row indicates a statistic of interest (see page 957). Eick 1992 also teaches using various colored rows located within a column to indicate statistics for lines of source code at corresponding locations within a file (see page 958-959).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in

Art Unit: 3993

deciding whether or not the claim is patentable. Accordingly, Eick 1992 raises a substantial new question of patentability as to claims 1-3, 6 and 12-17, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Gould '588 Reference

The Gould '588 reference raises a SNQ with respect to claims 1-6 and 12-15 of U.S. Patent No. 5,713,740. It is agreed that Gould '588 teaches identification of features within a least a portion of the text, such as the salience of selected text or identifying locations in a text that are highlighted. The text can be manipulated such that the highlighted areas become the focus of the text presentation screen (see col. 5, line 65 through col. 6, line 28 and Fig. 11). Gould '588 also teaches the creation of indicators within application scroll bars (see Figs. 7, 9, 10 and 11).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Gould '588 raises a substantial new question of patentability as to claims 1-6 and 12-17, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Kozima 1993 Reference

The Kozima 1993 reference raises a SNQ with respect to claims 1 and 12-15 of U.S. Patent No. 5,713,740. It is agreed that Kozima 1993 teaches the lexical cohesion

Art Unit: 3993

profile (LCP) that locates segment boundaries in a text (see Abstract and Fig. 3).

Kozima 1993 also teaches a method for depicting a feature of a given text, specifically word similarity, in a three dimensional manner that has no readable words (see Fig. 1).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Kozima 1993 raises a substantial new question of patentability as to claims 1 and 12-15, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Brill 1992 Reference

The Brill 1992 reference raises a SNQ with respect to claims 2-6 of U.S. Patent No. 5,713,740. It is agreed that Brill 1992 teaches a computer-based method for tagging words in a text based on the parts of speech of that words, such as noun, verb, noun phrase (*see generally*, Brill 1992).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Brill 1992 raises a substantial new question of patentability as to claims 2-6, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Church 1988 Reference

The Church 1988 reference raises a SNQ with respect to claims 2-6 of U.S. Patent No. 5,713,740. It is agreed that Church 1988 teaches a method for tagging words in a text based on the parts of speech of that word, such as noun, verb, noun phrase, etc. (*see generally*, Church 1988).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Church 1988 raises a substantial new question of patentability as to claims 2-6, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

The Church 1990 Reference

The Church 1990 reference raises a SNQ with respect to claim 15 of U.S. Patent No. 5,713,740. It is agreed that Church 1990 teaches a method for identifying associated words, including words with generally the same definition (such as doctor and dentist (*see page 24*)).

The teachings identified above were not present in the prosecution of the application which became U.S. Patent No. 5,713,740. Further, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claim is patentable. Accordingly, Church 1990 raises a

Art Unit: 3993

substantial new question of patentability as to claim 15, which question has not been decided in a previous examination of U.S. Patent No. 5,713,740.

Scope of Reexamination

Since requester did not request reexamination of claims 7-10 and 18-20 and did not assert the existence of a substantial new question of patentability (SNQP) for such claims (see 35 U.S.C. § 311(b)(2); see also 37 CFR 1.915b and 1.923), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. (Not Reported in F.Supp.2d.) The District Court upheld the Office's discretion to not reexamine claims in an *inter partes* reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

To be sure, a party may seek, and the PTO may grant, *inter partes* review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which *inter partes* review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for *inter partes* review, § 311(b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive.

(Slip copy at page 9.)

Art Unit: 3993

The *Sony* decision's reasoning and statutory interpretation apply analogously to *ex parte* reexamination, as the same relevant statutory language applies to both *inter partes* and *ex parte* reexamination. 35 U.S.C. § 302 provides that the *ex parte* reexamination "request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested" (emphasis added), and 35 U.S.C. § 303 provides that "the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request..." (Emphasis added). These provisions are analogous to the language of 35 U.S.C. § 311(b)(2) and 35 U.S.C. § 312 applied and construed in *Sony*, and would be construed in the same manner. As the Director can decline to reexamine non-requested claims in an *inter partes* reexamination proceeding, the Director can likewise do so in *ex parte* reexamination proceeding. See Notice of Clarification of Office Policy To Exercise Discretion in Reexamining Fewer Than All the Patent Claims (signed Oct. 5, 2006) 1311 OG 197 (Oct. 31, 2006). See also MPEP § 2240, Rev. 5, Aug. 2006.

Therefore, claims 7-10 and 18-20 will not be reexamined in this *ex partes* reexamination proceeding.

Conclusion

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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.


Signed:

/Beverly M. Flanagan/

Beverly M. Flanagan
CRU Examiner
GAU 3993
(571) 272-4766

Conferee /JRJ/

Conferee AK

Reexamination 	Application/Control No. 90/010,941	Applicant(s)/Patent Under Reexamination 5,713,740
	Certificate Date	Certificate Number

Requester Correspondence Address: <input type="checkbox"/> Patent Owner <input checked="" type="checkbox"/> Third Party
King and Spalding 1180 Peachtree Street, N.E. Atlanta, GA 30309-3521

LITIGATION REVIEW <input checked="" type="checkbox"/>	BMF <small>(examiner initials)</small>	5/11/10 <small>(date)</small>
Case Name		Director Initials
Textscape, LLC v. Google, Inc., 5:09cv4552, U.S. Dist. Cr. CA Northern (open)		<i>AK J or GM</i>

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. <i>NONE</i>	
2.	
3.	
4.	