

EXHIBIT 8



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NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,513.

PATENT NO. 6638313.

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)).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,513	04/23/2009	6638313	8157.012.RXUS00	1322

7590 06/02/2009

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/02/2009

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



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Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/010,513	Patent Under Reexamination 6638313	
	Examiner Christopher E. Lee	Art Unit 3992	

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

The request for *ex parte* reexamination filed 23 April 2009 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)).

/Christopher E. Lee/ Primary Examiner, Art Unit 3992		
cc:Requester (if third party requester)		

DECISION***Response to Request for Ex Parte Reexamination***

1. A substantial new question of patentability affecting claims 1-4 and 9-11 of United States Patent Number 6,638,313 B1 (hereinafter '313 Patent) 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).

2. A prior art patent or printed publication raises a substantial new question of patentability where there is:

(A) 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, MPEP §2242 (I) and,

(B) the same question of patentability as to the claim has not been decided in a previous or pending proceeding or in a final holding of invalidity by a federal court. See MPEP §2242 (III).

3. The '313 Patent is currently assigned to: MIRROR WORLDS, LLC of TYLER, TEXAS.

The '313 Patent was issued from the U.S. Patent Application No. 09/398,611 (hereinafter '611 Application) filed on 17th of September 1999, which is a continuation of the U.S. Patent Application No. 08/673,255 (hereinafter '255 Application) filed on 28th of June 1996.

4. In the request for reexamination, the Requester alleges that the '313 Patent claims 1-4 and 9-11 are unpatentable over the following references:

a) Mander et al. [US 6,243,724 A] "Method and Apparatus for Organizing Information in a Computer System," issued on 5th of June 2001 (hereinafter "Mander").

b) Lucas et al. [US 5,499,330 A] "Document Display System for Organizing and Displaying Documents as Screen Objects organized along Strand Paths," issued on 12th of March 1996 (hereinafter "Lucas").

c) User's Guide, "Retrospect User's Guide," version 3 first edition, published by Dantz Development Corp., 1989-1995 (hereinafter "Retrospect").

d) Tutorial Reference, "Magellan Explorer's Guide," published by Lotus Development Corp., 1989 (hereinafter "Magellan Explorer's Guide").

e) David P. Gobel, "Using Lotus Magellan," published by QUE Corp., 1989 (hereinafter "Using Lotus Magellan").

5 Of the above references, except "Mander" which is cited on the face of the '313 Patent, the rest of the references are not of record in the file of '313 Patent, and are not cumulative to the art of record in the original file. However, a review of the prosecution history of the '611 Application reveals that even though "Mander" cited on IDS filed on 2nd of July 2003 was considered by the Examiner, but was not referred to anticipate and/or render obvious the claims
10 during the prosecution of the '313 Patent.

Scope of Reexamination

5. Since requester did not request reexamination of claims 5-8 and did not assert the existence of a substantial new question of patentability (SNQ) 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
15 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
20 reexamination had specifically been requested. The Court stated:

25 "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, 35 U.S.C. §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."

30 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
35

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 5-8 will not be reexamined in this *Ex Parte* Reexamination proceeding.

Substantial New Questions of Patentability Raised by the Requester

6. In the request for reexamination, the request sets forth that Requester considers that:
- a) Claims 1-4 and 9-11 of the '313 Patent are unpatentable over Mander taken with Retrospect.
 - b) Claims 1-3 and 9-11 of the '313 Patent are unpatentable over Lucas taken with Using Lotus Magellan and further taken with Magellan Explorer's Guide.

Prosecution History of the '313 Patent

7. The '313 Patent issued from the '611 Application, which is a continuation of '255 Application. The '313 Patent is generally directed to an operating system in which documents are stored in chronologically ordered "streams" instead of in the familiar hierarchical folder structure typical of many operating systems.

The Examiner of record issued a non-final Office action on 30th of December 2002 and rejected claims 28-40 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 16, 20, and 22 of Freeman [US 6,006,227 A].

In response to the Examiner's claim rejection mailed on 3rd of January 2003, the Patentee submitted an executed Terminal Disclaimer in order to overcome the obviousness-type double patenting rejection.

The Examiner of record issued a notice of allowability on 7th of April 2003 indicating the prior art in the record did not teach or fairly suggest automatically associating time-based indicators with the documents, and a supplemental notice of allowability on 27th of August 2003 in response to Amendment filed on 7th of April 2003.

The '611 Application ultimately issued as the '313 Patent on 28th of October 2003.

Analysis of Substantial New Questions of Patentability

8. It is generally agreed that the consideration of Mander in combination of Retrospect proposed by Requester raises a substantial new question of patentability as to Claims 1-4 and 9-11 of the '313 Patent.

5 As pointed out on pages 23-25 of the request, Mander discloses a method of utilizing a document stream operating system (i.e., a method for organizing information in a computer filing system; See Mander, Abstract, Fig. 15 and col. 24, lines 8-18). Each document is received and displayed in said document stream operating system (i.e., said computer filing system; See Mander, col. 8, lines 14-16, col. 5, lines 58-62, and col. 9, line 54 through col. 10, line 1) which
10 includes indexed data information (See Mander, col. 5, line 42 through col. 6, line 4, and col. 25, lines 21-37). Further, each document is associated with a timestamp (i.e., date and time), which is either selected by the system or by the user, and recorded in a date line field of the document or is recorded by the file system (See Mander, col. 33, lines 34-43), and the documents may further be sorted into categories based on date (See Mander, col. 23, lines 39-5 and col. 33, lines 35-36). But, Mander does not expressly teach automatically archiving the received
15 documents of Claims 1 and 9.

In other words, just as in the '313 Patent, Mander suggests automatically associating time-based indicators with the documents (i.e., order by date of organizing piles), which was not present in the prosecution of the '611 Application which became the '313 Patent. Furthermore,
20 there is a substantial likelihood that a reasonable Examiner would consider this teaching important in deciding whether or not the claim is patentable. In addition, Retrospect teaches automatically archiving the received documents (See Retrospect, pages 21, 81-87, 104, 143, 151, and 155). Accordingly, Mander, as modified by Retrospect, raises substantial new questions of patentability as to Claims 1 and 9, which questions have not been decided in a
25 previously examination of the '313 Patent.

As shown above, Mander, as modified by Retrospect, raises substantial new questions of patentability as to the respective claims 1 and 9. Therefore, at least, since the claims 2-4 are dependent claims of the claim 1, and the claims 10 and 11 are dependent claims of the claim 9, Mander, as modified by Retrospect, raises substantial new questions of patentability as to the
30 claims 2-4, 10, and 11, as well.

9. It is **not agreed** that the consideration of Lucas in combination with Using Lotus Magellan and Magellan Explorer's Guide proposed by Requester raises a substantial new question of patentability as to Claims 1-3 and 9-11 of the '313 Patent.

5 The reference Lucas discloses a document display system for organizing and displaying documents (See Abstract), and all of the claimed limitations of the respective independent claims 1 and 9 (See Claim Chart CC-B). Therefore, there is no rationale for combing Lucas with other references Using Lotus Magellan and Magellan Explorer's Guide to establish a *prima facie* case of obviousness. The Examiner doubts why Lucas is necessary to be modified by Using Lotus Magellan and Magellan Explorer's Guide in order to show the obviousness of the claimed
10 invention because the primary reference Lucas teaches all the claimed limitations of the respective independent claims 1 and 9.

Accordingly, Lucas in combination with Using Lotus Magellan and Magellan Explorer's Guide does not raise the substantial new questions of patentability as to Claims 1-4 and 9-11 of the '313 Patent.

15 However, as discussed above, the reference Lucas alone seems to teach the claimed invention in the respective independent claims 1 and 9 including automatically associating time-based indicators (i.e., information sticker) with the documents (See Lucas, col. 4, lines 46-48 and col. 20, lines 54-58), which was not present in the prosecution of the '611 Application which became the '313 Patent. Furthermore, there is a substantial likelihood that a reasonable
20 Examiner would consider this teaching important in deciding whether or not at least the respective independent claims 1 and 9 is patentable. This substantial new question of patentability has not been suggested by the Requester.

Conclusion

25 10. Claims 1-4 and 9-11 of the '313 Patent will be reexamined.

11. 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).

30 After filing of a request for *ex parte* 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 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the 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
5 inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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

10 By EFS: Registered users may submit via the electronic filing system EFS-Web, at <http://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

By Mail to: Mail Stop *Ex Parte* Reexam
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15 Commissioner for Patents
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20 By FAX to: (571) 273-9900
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For EFS-Web transmissions, 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
30 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 or earlier communications from the
35 Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Application/Control Number: 90/010,513

Page 8

Art Unit: 3992

Ex Parte REX Order Decision

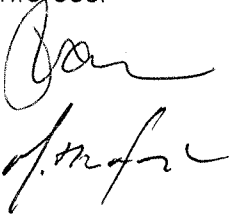
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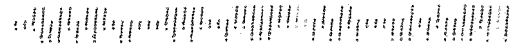
/Christopher E. Lee/

Primary Patent Examiner (Reexamination)
Central Reexamination Unit / Art Unit 3992

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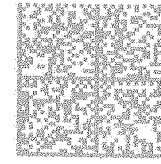
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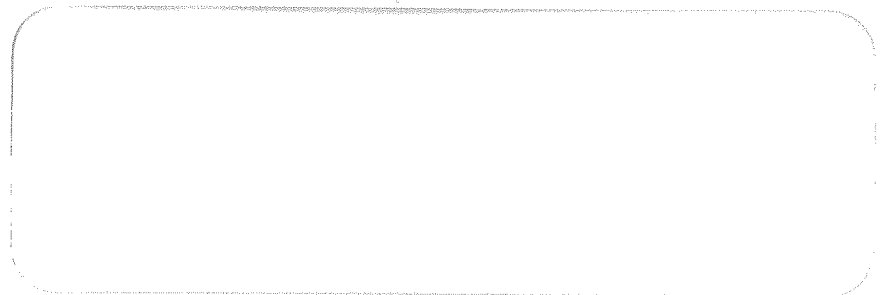
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