

# EXHIBIT A

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
TYLER DIVISION**

Bedrock Computer Technologies, LLC,

Plaintiff,

v.

SoftLayer Technologies, Inc. et al,

Defendants.

Civil Action No. 6:09-cv-269-LED

**EXPERT REPORT OF NICHOLAS P. GODICI**

**I. INTRODUCTION**

1. I, Nicholas P. Godici, have been retained by counsel for defendants SoftLayer Technologies, Amazon.com, Yahoo Inc., MySpace Inc., and AOL INC in connection with the above-referenced matter. I have been asked to provide expert testimony on rules, practices, and procedures before the United States Patent and Trademark Office (“USPTO”), including those related to patent prosecution and reexamination proceedings. I have also been asked to opine on the application of those rules, practices, and procedures to the facts in this case and particularly with respect to

the reexamination proceedings related to U.S. Patent No. 5,893,120 (“the ‘120 patent”), the patent-in-suit.

2. I reserve the right to give opinions on facts and matters that may be pled and rebuttal to any matter raised by the parties or their experts, either prior to or during any hearing or trial in this action.

**A. Qualifications**

3. I am currently the Executive Advisor for the intellectual property law firm of Birch, Stewart, Kolasch and Birch, LLP located in Falls Church, Virginia.

4. I have over 38 years of experience in the patent field. I spent my entire career, until my retirement in March 2005, at the USPTO. During my time at the USPTO, I examined approximately 7,000 patent applications, and conducted reexamination proceedings. Most recently, I served as the Commissioner for Patents at the USPTO from March 2000 to March 2005. I also served as the Acting Undersecretary of Commerce for Intellectual Property and Director of the USPTO from January to December 2001. In July 2009 I accepted a temporary assignment at the USPTO, at the request of the Secretary of Commerce, to act as an expert advisor to the Secretary and Acting Under Secretary, prior to Senate confirmation of the new Under Secretary nominated by President Obama. I have testified before both the United States House and Senate on various USPTO issues.

5. I began my career at the USPTO in 1972 as a patent examiner, and held the positions of Supervisory Patent Examiner (“SPE”), Group Director, Deputy Assistant

Commissioner for Patents, and Acting Assistant Commissioner for Patents before being named Commissioner for Patents by the Secretary of Commerce on March 29, 2000. As Commissioner for Patents, I was responsible for all aspects of patent-related operations at the USPTO, including a budget of over \$750 million and a staff of over 5,000 employees that included the entire patent examining corps.

6. As Acting Undersecretary of Commerce for Intellectual Property and Director of the USPTO, I reported to and advised the Secretary of Commerce on all intellectual property matters and was responsible for all managerial aspects of the USPTO.

7. I hold a Bachelor of Science degree in Engineering Mechanics from Pennsylvania State University, awarded in 1972, and a Certificate of Advanced Public Management from The Maxwell School of Citizenship and Public Affairs, Syracuse University, in 1999. My *curriculum vitae* is attached as **Exhibit A** to this report. I may testify with respect to my responsibilities and experiences relating to the information listed in **Exhibit A**.

**B. Previous Testimony**

8. **Exhibit B** lists those cases in which I have served as an expert witness in the past four years.

**C. Materials Considered**

9. In rendering my opinions, I have reviewed and considered the materials listed in **Exhibit C** to this report in addition to the materials expressly referenced herein. This report may be supplemented should additional materials be produced in this matter.

**D. Compensation**

10. Birch, Stewart, Kolasch & Birch, LLP is being compensated at the rate of \$700 per hour for my time in this case. The compensation received from this case is not contingent upon my opinions or performance, the outcome of the case, or any issues involved in or related to the case.

**E. Scope of My Opinions**

11. I expect to testify on USPTO policies and procedures, on the rules and procedural requirements governing the filing and prosecution of patent applications in the USPTO and the grant of U.S. patents by the USPTO and on the rules and procedures governing reexamination proceedings in the USPTO.

12. I also expect to testify about the contents of the reexamination file histories of the '120 patent and the significance of various documents filed by the reexamination requester and patent owner and actions by the USPTO during the reexamination proceedings related to the '120 patent.

13. The opinions stated in this report are based on information currently available to me and the current pleadings in this case. I reserve the right to continue my investigation and study, which may include a review of documents, expert reports, or

other information that may yet be produced, as well as any testimony from depositions for which transcripts are not yet available and that may yet be taken in this case. Therefore, I reserve the right to expand or modify this report as my investigations and studies continue, as the pleadings may be amended, and to supplement my opinions in response to any additional information that becomes available to me, to any matters raised by the parties, and/or other opinions provided by the parties' expert(s).

## II. REEXAMINATION PROCEEDINGS IN THE USPTO

14. "Reexamination" is a process whereby anyone (including the patent owner) may request that the USPTO reexamine an issued patent to determine if the subject matter claimed is patentable in light of a substantial new question of patentability raised in a request for reexamination.

15. There are two types of reexamination procedures available—*ex parte* and *inter partes*. *Ex parte* reexamination is much like prosecution of a patent application in that the proceedings are limited to communications between the USPTO and the patent owner. Third party requester participation in the proceedings is not permitted beyond the initial reexamination request.<sup>1</sup> On the other hand, in *inter partes* reexamination, after the requesting party submits its reexamination request, the requester may participate in the proceedings (and any appeals) by filings comments to responses made by the patent

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<sup>1</sup> In limited situations the third party requester may file a one-time response to a patent owner statement filed under 37 CFR 1.530 however very few patent owner's file such a statement. When the patent owner does not file such a statement, the third party requester cannot file a response.

owner.<sup>2</sup> While *ex parte* reexamination is available to all patents, *inter partes* reexamination is only available to patents that were filed on or after November 29, 1999.<sup>3</sup> The two reexamination requests of the '120 patent that I will address in this report are *ex parte* reexamination requests.

16. To request a reexamination, the requesting party must pay a fee and submit a statement that describes how prior art patents and/or printed publications raise a “substantial new question of patentability” with respect to the claims of the patent.<sup>4</sup> If the USPTO agrees that there is a substantial new question of patentability, then the USPTO orders or grants a reexamination.

17. If a request for reexamination is granted, the USPTO’s decision granting the request will conclude that a substantial new question of patentability has been raised by (a) identifying all claims and issues, (b) identifying the prior art patents and/or printed publications relied on, and (c) providing a brief statement of the rationale supporting each new question.<sup>5</sup>

18. After the USPTO determines that there is a substantial new question of patentability and orders reexamination, the claims of the patent are subjected to another examination similar to the examination conducted during the prosecution of the original patent application that lead to the issuance of the patent. The examiner will issue an Office Action in which the patent claims may be rejected in light of the new questions of

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<sup>2</sup> See 37 CFR 1.947.

<sup>3</sup> See MPEP 2611.

<sup>4</sup> See 37 CFR 1.510.

<sup>5</sup> See MPEP 2246.

patentability raised by the reexamination request. Claims may also be confirmed as patentable if the examiner determines that claims are allowable over the prior art.

19. As in normal patent prosecution, a patent owner may reply to rejections set forth in an Office Action during reexamination by filing a response pointing out what the patent owner believes are errors in the examiner's Action.<sup>6</sup> The reply must be reduced to writing which distinctly and specifically points out the supposed errors in the examiner's Action and must reply to every ground of rejection. In a reply to a rejection in reexamination, the patent owner may also narrow or cancel the rejected claims. Alternatively, the patent owner may also submit new claims, provided that the new claims are narrower than the rejected claims of the patent. At this stage the reexamination requester may not participate or comment on the proceedings with the patent owner.

20. As with normal patent prosecution, the examiner then reviews any amendments and/or arguments submitted by the patent owner to determine if the conditions for patentability are met. The examiner can either confirm (allow) the claims or issue a new Office Action if rejections remain. If the claims continue to be rejected, normally the examiner's second Action is made final.<sup>7</sup> At that point, the patent owner may appeal the decision of the examiner to the USPTO Board of Patent Appeals and Interferences (and ultimately to the Federal courts).

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<sup>6</sup> See 37 CFR 1.111.

<sup>7</sup> See MPEP 2271.



21. Once the reexamination has concluded (including all available appeals), a “certificate of reexamination” is issued. The certificate sets forth the results of the reexamination proceeding and the content of the patent following the reexamination proceeding.<sup>8</sup>

22. Typically the primary source of prior art in a reexamination proceeding will be the patents and printed publications cited in the reexamination request. A full prior art search is not routinely made by the examiner.<sup>9</sup> However the examiner may also consider patents and printed publications cited by the patent owner under the duty of disclosure, 37 CFR 1.555, that are in compliance with 37 CFR 1.9837. CFR 1.98(a)(2) requires that a copy of each publication submitted must be provided. Additionally, once a Notice of Intent to Issue the Reexamination Certificate (NIRC) has been mailed, prior art submitted by the applicant must be accompanied by a petition in order to be considered. Once the reexamination proceeding enters the Reexamination Certificate printing cycle it will generally not be pulled from that process to consider prior art without a statement from the patent owner that at least one claim is unpatentable.<sup>10</sup>

23. The reexamination file should clearly indicate which prior art patents and printed publications the examiner has considered during the *ex parte* reexamination proceeding. Therefore, when prior art patents and/or printed publications are submitted in an Information Disclosure Statement (IDS) during reexamination, the examiner must indicate whether the prior art has been considered by so indicating on the form listing the

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<sup>8</sup> See 37 CFR 1.570.

<sup>9</sup> See MPEP 2254.

<sup>10</sup> See MPEP 2256.

prior art. This indication can take the form of placement of the examiner's initials next to the prior art references considered on the form or entry of a statement that unless crossed through the prior art listed on the form had been considered.<sup>11</sup> If the prior art listed on the form is neither initialed (nor noted as considered) nor crossed through, that is an indication the examiner has not reviewed the IDS submission.

24. As stated above, during reexamination, the examiner will examine the patents and printed publications cited in the request for *ex parte* reexamination and cited by the patent owner and from other sources.<sup>12</sup> However, the degree of consideration that the examiner gives to the prior art provided by the requester and patent owner is limited by the degree to which the party filing the reference has explained 1) the content, and 2) relevance of the information, as described in the MPEP:

Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, **the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information.** The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above.

(MPEP 2256 (emphasis added))

25. Multiple requests for reexamination are permitted, however each reexamination request must present a substantial new question of patentability to be

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<sup>11</sup> See MPEP 609-609.08

<sup>12</sup> See MPEP 2256.

granted. If a second request for reexamination is granted during the pendency of a prior reexamination preceding for the same patent the reexamination proceedings may be merged. However, if the initial reexamination proceeding has been terminated prior to consideration of the second request for reexamination the proceedings will generally not be merged.<sup>13</sup>

26. If the USPTO has issued a Notice of Intent to Issue a Reexamination Certificate by the time a second request for reexamination has been filed, the first reexamination is considered to be terminated, and the two reexaminations cannot be merged.<sup>14</sup>

### **III. MY ANALYSIS AND OPINIONS**

#### **A. The “First” Reexamination Proceeding**

27. I have been asked to review the file history of the initial or first reexamination proceeding of the ‘120 patent as well as the expert report of Dr. Mark Jones and to determine if certain information submitted by the patent owner was considered by the USPTO during that proceeding and whether certain statements made by Dr. Jones in his report were accurate.

28. The initial *ex parte* reexamination request of the ‘120 patent was filed on February 9, 2010. The reexamination request was assigned control number 90/010,856 (the “first” reexamination).

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<sup>13</sup> See MPEP 2283.

<sup>14</sup> See MPEP 2283, 2287.

29. On June 24, 2010 the patent owner filed an Information Disclosure Statement (“IDS”) listing several patents and printed publications for consideration by the examiner on a PTO-1449 form. The PTO-1449 form consisted of four sheets. Additionally, on June 24, 2010 a separate correspondence under 37 CFR 1.555/1.565 was filed. This correspondence indicated that the following litigation materials were attached, however, these submissions and some of the prior art referenced in these submissions were *not* listed on a PTO-1449 form.

- Defendants’ Amended Joint Invalidation Contentions and Production of Documents Pursuant to patent Rules 3-3 and 3-4(b) w/Exhibits A-C5 dated 02/08/10.
- Defendants’ Joint Invalidation Contentions and Production of Documents Pursuant to Patent Rules 3-3 and 3-4(b) w/Exhibits dated 01/08/10.
- Plaintiff Red Hat, Inc.’s Invalidation Contentions and Production of documents Pursuant to Patent Rules 3-3 and 3-4(b) w/Exhibits A-E dated 05/14/10.

Additionally, copies of some of the prior art publications referenced in the invalidity contentions were not submitted as required by 37 CFR 1.98.

30. On July 23, 2010 the USPTO mailed the first Office Action in the reexamination proceeding. The Office Action rejected all of the claims in the ‘120 patent. There is no indication that the examiner considered the IDS or the litigation materials submitted on June 24, 2010 when issuing this first Office Action.

31. On November 11, 2010 the patent owner filed a response to the first Office Action.

32. On December 14, 2010 the patent owner filed a second IDS listing additional prior art patents and publications on a second PTO-1449 form that included two sheets.

33. On January 14, 2011 the USPTO mailed a NIRC, informing the patent owner and the public that the reexamination proceeding has been concluded or terminated.<sup>15</sup> This correspondence includes copies of the PTO-1449 forms submitted on June 24, 2010 on which the examiner indicated that the listed references had been considered but does *not* include copies of the PTO-1449 submitted by the patent owner on December 14, 2010 or any indication that the IDS of December 14, 2010 was considered. Additionally, there is no indication that the USPTO considered the separate litigation materials submitted on June 24, 2010.

34. My review of the reexamination file history indicates that Examiner Alexander Kosowski entered a notation on the bottom of each of the four pages of the PTO-1449 form submitted with the IDS of June 24, 2010 which stated:

“All references considered except where lined through. /AK/”

Examiner Kosowski signed the first sheet of the PTO-1449 form submitted on June 24, 2010 and dated it 01/05/2011. This indicates that Examiner Kosowski was aware of the procedures to be followed when considering information submitted in an IDS. I note that none of the references listed on the PTO-1449 were lined through indicating that the prior art listed on the PTO-1449 form submitted in the IDS of June 24, 2010 was considered by

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<sup>15</sup> See MPEP 2287.

Examiner Kosowski on 01/05/2011. However, the January 14, 2011 Office Action does not include copies of the PTO-1449 submitted in the IDS of December 14, 2010 or any indication that the references submitted on December 14, 2010 were considered. Additionally, the Office Action does not include any indication that the litigation materials separately submitted on June 24, 2010 but not listed on the PTO-1449 were considered.

35. On January 21, 2011 the reexamination file was forwarded to the Office of Publications.

36. On February 22, 2011 a Notice of Concurrent Proceedings was filed indicating that a second request for reexamination of the '120 patent had been filed. On March 23, 2011 the transaction history of the reexamination file history includes the entry "Input Issue Number and Issue Date for Reexamination" indicating that the reexamination certificate will be published shortly after March 23, 2011. The reexamination certificate issued on April 12, 2011.

#### **The IDS of December 14, 2010 Was Not Considered by the USPTO**

37. I have been asked to consider whether the prior art listed in the IDS filed on December 14, 2010 was reviewed and considered by the examiner in the reexamination proceeding. *Based on my experience and USPTO procedures it is my opinion that the IDS filed on December 14, 2010 was not considered by the examiner in the reexamination proceeding.* As explained above when prior art is listed in an IDS the

file should indicate which prior art patents and printed publication have been considered. A copy of the PTO-1449 form on which the prior art is listed in the IDS of December 14, 2010 was not included with the correspondence of January 14, 2011. There is no copy of this PTO-1449 in the file indicating that examiner Kosowski or any other examiner considered the references listed in the December 14, 2010. If the prior art listed on the PTO-1449 form submitted on December 14, 2010 had been considered, the examiner would have so indicated on the form and returned a copy of the form to the patent owner and placed a copy of the initialed form in the file. The file history of the proceeding does not include any indication that the prior art listed in the IDS of December 14, 2010 was considered. Based on USPTO procedures and my experience this indicates that the examiner has not considered or evaluated the prior art listed in the IDS of December 14, 2010. My opinion is based on my review of the contents of the reexamination file at the time of my report.

38. I further note that the transaction history of the '856 reexamination proceeding found on the USPTO PAIR system<sup>16</sup> lists the IDS filed on December 14, 2010 out of chronological order and after the January 21, 2011 entry indicating the file had been forwarded to the Office of Publications perhaps indicting the IDS of December 14, 2010 was not associated with the file history at the time the examiner issued the NIRC on January 14, 2011. One explanation for this may be that the prior art submitted with the IDS was submitted in paper form. Under normal USPTO procedure, the paper

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<sup>16</sup> Reexamination proceedings are public and the USPTO provides the public access to the reexamination proceeding through an on-line system called PAIR.

documents would have to be scanned into the electronic file history before the Examiner would have access to the references submitted with the IDS. Based on the chronological listing of the contents of the file history it is likely that the prior art was not available to the examiner when the NIRC was issued.

39. Examiners are trained to initial or indicate when prior art submitted by the patent owner has been considered. While I cannot know the thought process of this particular Examiner, it is my opinion that if he had considered the prior art listed on the IDS that was submitted on December 14, 2010, he would have initialed the form and returned a copy to the patent owner according to USPTO procedures.<sup>17</sup>

**There is No Indication that the Litigation Materials (Claim Charts) Submitted on June 24, 2010 were Considered by the USPTO**

40. Further, I have reviewed the rebuttal expert report of Dr. Mark Jones dated February 1, 2011. I note that on page 24 of his report he states the following:

"I have also reviewed the re-examination file history (to date) for the '120 patent. From my review, Bedrock submitted the Defendants' invalidity contentions, including contentions for the asserted prior art that Dr. Jeffay and Mr. Williams opine invalidate the patent. The re-examiner, **who is deemed to have considered these charts**, has nonetheless affirmed the validity of the claims of the '120 patent." (emphasis added)

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<sup>17</sup> I also note that the IDS of December 14, 2010 listed a large volume of materials (such as source code) without any explanation of relevancy or indication which was most significant. MPEP 2004 ("13. It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance.").



I disagree with Dr. Jones' statement above. I understand that the invalidity contentions and "charts" referenced in Dr. Jones' statement are the invalidity contentions submitted on June 24, 2010. As explained above the invalidity contentions were not listed on the PTO-1449 submitted on June 24, 2010 by the patent owner. While Examiner Kosowski indicated he did consider the references listed on the PTO-1449 of June 24, 2010 he did *not* indicate he considered the separately submitted litigation materials, which included invalidity contentions and claim charts. Therefore I disagree with Dr. Jones' statement that the examiner has "...**deemed to have considered these charts**". There is no indication in the reexamination file history that the charts referenced by Dr. Jones have been considered.

41. Further, the invalidity charts themselves are not prior art. The portions of or links to references contained within the invalidity charts, including the footnotes, are not proper submissions under 37 CFR 1.98, which requires that a copy of the prior art publication be submitted for consideration by the examiner. Also, in the IDSs that the patent owner submitted, the patent owner chose to submit only some of the references in the invalidity charts. For example, the patent owner chose not to submit the NRL IPV6 prior art. Since the invalidity contentions are not themselves prior art and copies of some of the publications referenced were not submitted, this further illustrates why the examiner did not indicate that he considered the invalidity contentions or any prior art not in compliance with 37 CFR 1.98. The Examiner is not required to consider materials not in compliance with 37 CFR 1.98.

## The “Second” Reexamination Proceeding

42. I have been asked to review the file history of the second reexamination proceeding for the ‘120 patent and consider whether the two reexamination proceedings of the ‘120 patent were merged by the USPTO and whether the substantial new question of patentability addressed in the second reexamination proceeding is related to the patentability issues addressed in the first reexamination.

43. The second reexamination request for the ‘120 patent was filed on January 10, 2011 and assigned control number 90/011426 (the “second” reexamination).

44. On February 22, 2011 the USPTO mailed the Order granting the second request for reexamination of the ‘120 patent. In this Order the examiner, Examiner Andrew Nalven,<sup>18</sup> acknowledged that the NIRC had been mailed in the first reexamination on January 14, 2011 confirming claims 1-12. He further indicated that the NIRC in the first reexamination proceeding indicted that the prior art failed to show the limitation of a “storage and retrieval system comprising means utilizing record search means for accessing a linked list and, at the same time, removing at least some of the expired ones of the records in the linked list, in combination with the remaining elements or features of the claimed invention.” This statement, known as a reasons for allowance, indicates the reason the claims in the first reexamination proceeding were confirmed or allowed.

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<sup>18</sup> I note that the second reexamination proceeding is being conducted by an examiner different from the examiner in the first reexamination proceeding. This is USPTO policy. See MPEP 2236.

45. In the February 22, 2011 Order, Examiner Nalven further indicated that the Thatte and Dirks references, although considered in the first reexamination, raised a substantial new question of patentability because the second reexamination request presented Thatte and Dirks *in a new light* suggesting that a linked list may be present or inherently taught (Dirks) or the count filter is inherently accessed while reconciliation/removal is taking place (Thatte).

**The First and Second Reexamination Proceedings of the '120 Patent were not Merged**

46. I have been asked to determine whether the first and second reexamination proceedings were merged by the USPTO. *They were not.* Based on my experience and USPTO policy, the reason the two proceedings were not merged was one of timing.

47. Generally, if a second reexamination request is granted while a first reexamination proceeding is pending, the proceedings will be merged by the USPTO. However, if the first reexamination proceeding has been concluded or terminated prior to grant of the second reexamination the USPTO will generally not merge the proceedings. Since reexamination proceedings are to be conducted with “special dispatch” the USPTO will not delay the publication of the reexamination certificate in a first reexamination proceeding that has been concluded so as to merge the proceeding with a subsequently

filed reexamination.<sup>19</sup> That is the situation found in relation to the two reexamination proceedings of the ‘120 patent.

48. The second reexamination request was filed on January 10, 2011. Just four days later, on January 14, 2011, the USPTO mailed the NIRC in the first reexamination proceeding terminating that proceeding. The Order granting the second reexamination was not mailed until February 22, 2011. USPTO policy states that no decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request.<sup>20</sup> Therefore, the first reexamination had been terminated, the NIRC mailed, and the reexamination forwarded to the Office of Publications *before* the Order granting the second reexamination had been mailed. Based on this timing the first reexamination was not delayed and was allowed to proceed through the publication process and the proceedings were *not merged*.

**The Substantial New Question of Patentability to be Addressed in the Second Reexamination of the ‘120 Patent is Related to the Patentability Issues Addressed in the First Reexamination**

49. As indicted above, Examiner Nalven has stated that the Thatte and Dirks references have been presented *in a new light* in the second reexamination request.<sup>21</sup>

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<sup>19</sup> See MPEP 2283.

<sup>20</sup> See MPEP 2283.

<sup>21</sup> “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.” 35 U.S.C. § 303(a) and § 312(a). “For a reexamination that was ordered on or after November 2, 2002 (the date of enactment of Public Law 107-273; see Section 13105, of the Patent and Trademark Office Authorization

Based on this new interpretation of Thatte and Dirks, Examiner Nalven has stated that the very feature(s) found to be allowable or absent in the prior art during the first reexamination proceeding may be taught or inherent in Thatte and Dirks. Based on my experience and review of the file histories of the two reexamination proceedings, the second reexamination of the '120 patent will reevaluate the reasoning in the first reexamination proceeding surrounding the allowance or confirmation of the claims. This second evaluation will be made by a different examiner, Examiner Nalven, as per USPTO policy and be based on different interpretation or new interpretation of the teachings of Dirks and Thatte. It is my opinion that the issues to be addressed in the second reexamination are interrelated with the patentability issues evaluated in the first reexamination proceeding.

Respectfully submitted,

Dated: 4/20/11

By:   
Nicholas P. Godici

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Act of 2002), reliance solely on old art (as the basis for a rejection) does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. 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. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.” MPEP 2258.01.

## **Exhibit A**

**Nicholas P. Godici**  
**Executive Advisor**  
**Birch, Stewart, Kolasch, & Birch, LLP**

### **Professional Experience**

**Birch, Stewart, Kolasch & Birch, LLP, Falls Church, VA.**

**Executive Advisor (April 2005-present)**

Responsibilities include business development, public relations, expert witness, and IP consulting.

**United States Patent and Trademark Office, Department of Commerce, Washington D.C.**

**Commissioner for Patents (March 2000-March 2005)**

Appointed by the Secretary of Commerce to a five-year term as Commissioner for Patents in 2000. Direct report to the Under Secretary Of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. Served as the Chief Operating Officer for all aspects of patent related operations with the mission to properly implement the patent laws and regulations of the United States. Oversaw a budget of over \$750 million dollars and a staff of over 5000 employees. Areas of responsibility included strategic planning, budget formulation and execution, information technology systems, staffing, employee development, labor management relations, customer outreach, congressional relations, public advisory committee relations, and patent policy formulation. Testified before the United States House and Senate on various intellectual property matters.

**Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (January 2001-December 2001)**

Served as Acting Under Secretary during the change in Administration in 2001. As the head of the Agency, chief executive officer and a direct report to the Secretary of Commerce, was responsible for all aspects of intellectual property policy and operations for the Administration. Represented the United States in international meetings at the World Intellectual Property Organization (WIPO) and with other national IP offices. Lead the "heads of office" meeting with the President of the European Patent Organization (EPO) and the Commissioner of the Japan Patent Office (JPO). Interacted with Congress, other agencies within the Administration, and major IP bar and trade associations on legal issues, operations of the USPTO, and national security.

### **Expert Advisor at the USPTO (July-September 2009)**

At the request of the Secretary of Commerce I accepted a temporary assignment as an expert advisor to the Secretary and the Under Secretary of Commerce to strengthen the management structure of the USPTO and provide an up-to-date assessment of the challenges facing the agency.

### **Various Positions Within the USPTO (June 1972-March 2000)**

Held various positions with the USPTO starting with patent examiner in the mechanical arts, Supervisory Patent Examiner, Group Director, Deputy Assistant Commissioner for Patents, and Acting Assistant Commissioner for Patents. Lectured in the Patent Academy for many years. Responsibilities included oversight for Patent Cooperation Treaty (PCT) operations which included the processing of all international applications. Assumed responsibility for the entire patent examining corps as Deputy Assistant Commissioner for Patents in 1997.

### **Education**

B.S., Pennsylvania State University, Engineering Mechanics, 1972

Certificate of Advanced Public Management, The Maxwell School of Citizenship and Public Affairs, Syracuse University, 1999.

### **Professional Affiliations and Awards**

Elected fellow of the National Academy of Public Administration (NAPA) 2001.

Outstanding Engineering Alumni, Pennsylvania State University, 2002

Member of the Industrial and Professional Advisory Committee for the College of Engineering at Pennsylvania State University. 2001-2003.

Named "One of the most important people in intellectual property today" by Legal Times Magazine in 2001.

Registered to Practice before the United States Patent and Trademark Office

### **Publications**

"Supporting a Knowledge Based Economy, Software Patents", Managing Intellectual Property Magazine, Innovation and Invention Focus 2004.

"Adequately Funding the USPTO: A Critical Problem that Must be Solved", Medical Innovation & Business, Summer 2010-Volume 2- Issue 2

## Exhibit B

### List of Cases in Which Nicholas P. Godici Has Served as an Expert Witness Within the Last Four Years

*ConnecTel LLC v Cisco Systems, Inc.*, United States District Court for the Eastern District of Texas, Civil Action 2:24-cv-00396-LED

Certain Flash Memory Devices and Components Thereof, and Products Containing Such Devices and Components, United States International Trade Commission, Investigation No. 337-TA-552 (Hynix v Toshiba)

*Forgent Networks, Inc. v EchoStar Technologies, Inc., Scientific-Atlanta, Inc., Motorola, Inc., and Digeo, Inc.*, United States District Court For The Eastern District Of Texas, Consolidated Civil Action No. 6:06-cv-208

*New York University v AutoDesk, Inc.*, United States District Court For The Southern District Of New York, Civil Action No. 06-cv-5274 (JSR) (MHD)

*Trading Technologies Int'l, Inc. v eSpeed, Inc., eSpeed International, Ltd., Ecco LLC, and EccoWare, Ltd.*, United States District Court For The Northern District of Illinois, Civil Action 2:06-CV-156

*Rackable Systems Inc. v Supermicro Computer*, United States District Court for the Northern District of California, Case No. C 05-03561 PHJ

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\* I served as an expert witness for the underlined party

## **Exhibit C**

### **List of Materials Considered**

U. S. Patent no. 5,893,120 and its file history

Reexamination control no. 90/010,856 and its file history

Reexamination control no. 90/011,426 and its file history

Rebuttal Report of Dr. Mark Jones dated February 1, 2011

The Manual of Patent Examination Procedures (MPEP)