EXHIBIT 8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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FEB 22 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,426*.

PATENT NO. *5893120*.

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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/011,426	5893120	
	Examiner	Art Unit	
	ANDREW L. NALVEN	3992	

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

The request for *ex parte* reexamination filed *10 January 2011* 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: *Decision on Request*

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 GRANTING EX PARTE REEXAMINATION

A substantial new question of patentability affecting claims 1-8 of United States Patent Number 5,893,120 issued to Nemes (hereafter "the '120 patent") is raised by the request for *ex parte* reexamination submitted on January 10, 2011.

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).

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985 to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '120 patent 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.

PROSECUTION HISTORY

The '120 patent was issued on April 6, 1999 from an application filed January 2, 1997. During prosecution, claims 1-8 were initially rejected under the doctrine of double patenting in view of US Patents 5,121,495 and 5,287,499. Claims 1-8 were further rejected under §103 as being unpatentable over US Patent 5,287,499 and Shackelford. The Applicant argued against the rejections on record stating that the cited references did not address on the fly deletion of at least some record from a linked list based on automatic expiration of data.

Following the Applicant's arguments, the Examiner issued a notice of allowance. The Examiner stated his reasons for allowance by stating "[t]he prior art does not teach or fairly suggest a method and apparatus for on-the-fly deletion of records in linked lists based on automatic expiration of data as claimed." The application then issued as the '120 patent.

A first request for reexamination of the '120 patent was received on February 9, 2010 and was assigned control number 90/010,856 ("the '10856 proceeding"). Reexamination was ordered as to claims 1-8 in view of the Morrison, Thatte, Dirks, and Morris references. Following a non-final rejection of claims 1-8 on July 23, 2010, the Patent Owner responded by amending claims 3 and 7 and adding claims 9-12 while arguing that the references failed to show equivalent structure to the means plus function claim limitations presented in claims 1-8 and 9-12.

Following the claim amendments and remarks, a notice of intent to issue a reexamination certificate (NIRC) was mailed on January 14, 2011. The NIRC allowed or confirmed claims 1-12 and noting that the prior art cited in the request failed to show claim 1's 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. The NIRC provided similar rationale for claims 3, 5, and 7. As of the time of this order, the reexamination certificate has not yet been issued.

Accordingly, a submitted prior art patent or publication may raise an SNQ if it is new and non-cumulative to the teachings previously considered and if it would have been important to a reasonable examiner in determining the patentability of the claims. If a new and non-cumulative references addresses the features deemed distinguishing during the '10856 proceeding and during prosecution such as the claimed means for accessing a linked list while at the same time removing expired records of the linked list that reference will raise a substantial new question.

PROPOSED SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Third Party Requester ("Requester") requested reexamination of claims 1-8 of the '120 patent based upon the following prior art patents and publications:

1. "The Complexity of Hashing with Lazy Deletion" by Christopher Van Wyk et al that was published in 1986 (hereafter "Van Wyk").
2. US Patent No. 5,121,495 issued to Nemes on June 9, 1992 (hereafter "Nemes '495") that was cited in an earlier examination. Nemes '495 qualifies as prior art under §102(b).

3. US Patent No. 5,287,499 issued to Nemes on February 15, 1994 (hereafter "Nemes '499") that was cited in earlier reexamination. Nemes '499 qualifies as prior art under §102(b).
4. US Patent No. 4,695,949 issued to Thatte et al on September 22, 1987 (hereafter "Thatte") that was cited in earlier reexamination. Thatte qualifies as prior art under §102(b).
5. US Patent No. 6,119,214 issued to Dirks September 12, 2000 (hereafter "Dirks") that was cited in earlier reexamination. Dirks qualifies as prior art under §102(e).
6. US Patent No. 5,724,538 issued to Morris et al on March 3, 1998 (hereafter "Morris") that was cited in earlier reexamination. Morris qualifies as prior art under §102(e).

Requestor has alleged a substantial new question of patentability in light of the proposed rejections:

Issue 1 – Requestor alleges that Claims 1-8 are anticipated by Van Wyk under 35 U.S.C. §102(b).

Issue 2 - Requestor alleges that Claims 1, 3, 5, and 7 are rendered obvious by the combination of Nemes '495 in view of Nemes '499 under 35 U.S.C. 103(a).

Issue 3 - Requestor alleges that Claims 1-8 are anticipated by Thatte under 35 U.S.C. §102(b).

Issue 4 - Requestor alleges that Claims 1-8 are rendered obvious by the combination of Thatte in view of Dirks under 35 U.S.C. 103(a).

Issue 5 - Requestor alleges that Claims 1-8 are rendered obvious by the combination of Dirks in view of Morris under 35 U.S.C. 103(a).

ANALYSIS OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Summary

Requestor has shown a substantial new question of patentability with regards to claims 1-8.

Analysis

A substantial new question of patentability is raised by a cited patent or printed publication when there is 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. A substantial new question of patentability is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. In re Recreative Technologies, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

The instant request for reexamination is the second request for reexamination on the '120 patent. Accordingly, MPEP provisions on second or subsequent requests for ex parte reexamination apply. MPEP § 2240 states:

"If a second or subsequent request for ex parte reexamination is filed (by any party) while a first ex parte reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different from that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied."

Van Wyk Reference

Van Wyk fails to raise a substantial new question of patentability regarding claims 1-8 because Van Wyk does not provide any new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims.

Van Wyk discloses a system of lazy deletion that *inserts a new record* while searching for and removing expired records (*Van Wyk, Page 19).* However, this teaching of lazy deletion is cumulative to at least the teachings of Morrison considered in the '10856 proceeding. The Morrison reference similarly discussed the system of lazy deletion that i*nserts a new record* while searching for and removing expired records. The two references are discussing the same lazy deletion system. In fact, Christopher Van Wyk is a co-writer of the Morrison reference.

Morrison initially was applied against claims 1-8 either under §102 or under §103 in combination with Dirks or Thatte. Following Patent Owner arguments and submissions of declarations under §1.132, all rejections under Morrison were withdrawn and the Examiner found that Morrison failed to teach the record search means as claimed. Specifically, the Examiner found persuasive the Patent Owner's argument that Morrison failed to teach both searching for a *target record* while identifying expired records (*see '10865 proceeding, NIRC)*. The Morrison reference instead taught inserting a new record and while doing so checking for and removing expired records.

Third Party Requester has submitted a declaration by Michael Kogan that asserts that Van Wyk discloses searching and identifying. However, the declaration makes clear that Van Wyk is similarly disclosing inserting a new record while concurrently checking for and removing expired records (*Declaration under §1.132 by Michael Kogan, Pages 4-5*). The question of whether Morrison and Van Wyk's lazy deletion system teaches the claimed record search means has already been considered.

Accordingly, Van Wyk does not raise a substantial new question of patentability as to claims 1-8.

Nemes '495 and Nemes '499 References

Nemes '495 and Nemes '499 fails to raise a substantial new question of patentability regarding claims 1-8 because neither reference provides a new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims. Both the Nemes '495 and Nemes '499 references were considered by the Examiner during prosecution

of the '120 patent. Both references were specifically noted as being considered and distinguished from the claims of the '120 patent in the notice of allowance mailed on September 29, 1998. Further, the teachings of the Nemes references have not been presented in a new light. Third Party Requester asserts that a new light is presented because the references are presented together. However, a new combination of references does not in itself give rise to a SNQ. A reference itself must present a new and non-cumulative technological teaching that would be important to a reasonable Examiner. In this case, both references have been previously considered and are thus cumulative to the teachings already on record.

Accordingly, Nemes '495 and Nemes '499 do not raise a substantial new question of patentability as to claims 1-8.

Thatte Reference

Thatte raises a substantial new question of patentability regarding claims 1-8 as presented in Issues 3 and 4. The Request cites new and non-cumulative teachings of Thatte that a reasonable examiner would consider important in determining patentability of the claims that raise a substantial new question.

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.* The instant Request has presented Thatte in a new light. For example, Thatte discloses a system using a reference count table that can be implemented as a hash table bucket with corresponding linked lists that allows insertion of new records (*Thatte, column 8 lines 39-62, column 7 lines 27-*

36, Figure 6). When inserting a new record, a check is performed to determine if there is available space and if not, a reconciliation operation is performed to remove expired records (*Thatte, Figure 6*). In the '10856 proceeding, Thatte was considered and was found to not teach the distinguishing features of the claimed record search means because Thatte allegedly did not teach the removal of records when the linked list was accessed because the insertion of records operation is suspended while reconciliation/removal is performed (*'10856 Proceeding, Notice of Intent to Issue Reexamination Certificate*).

In this instant Reexamination, the Request has set presented Thatte in a new light and cited further portions of Thatte that suggesting an alternative interpretation whereby the reference count filter is inherently accessed while reconciliation/removal is taking place (*see Thatte, Figure 6 – Boxes 67 and 69, see also Declaration under §1.132 by Michael Kogan – Exhibit D*). These cited teachings are new and non-cumulative and are relevant to the reasons for confirmation of claims in the '10856 proceeding. Accordingly, they would be important to a reasonable Examiner in determining the patentability of the claims.

Dirks Reference

Dirks raises a substantial new question of patentability regarding claims 1-8 as presented in Issues 4 and 5. The Request cites new and non-cumulative teachings of Dirks that a reasonable examiner would consider important in determining patentability of the claims that raise a substantial new question.

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.* The instant Request has presented Dirks in a new light. For example, Dirks discloses a system of lazy deletion that can delete records while a list is being accessed (*Dirks, column 6 lines 24-34 and 49-44).* In the '10856 proceeding, Dirks was considered and was found to not teach the distinguishing features of the claimed record search means because Dirks allegedly did not teach the claimed linked lists and Dirks was found to not be combinable with Morris (*'10856 Proceeding, Notice of Intent to Issue Reexamination Certificate; see also Declaration under §1.132 by Lawrence Pileggi, Page 3*).

In this instant Reexamination, the Request has set presented Dirks in a new light and cited further portions of Dirks that suggest that a linked list may be inherently taught or that it may at least not be incompatible to combine Dirks with a reference teaching a similar system employing linked lists (*see Dirks, column 9 lines 35-57, see also Declaration under §1.132 by Michael Kogan – Exhibit E*). These cited teachings are new and non-cumulative and are relevant to the reasons for confirmation of claims in the '10856 proceeding. Accordingly, they would be important to a reasonable Examiner in determining the patentability of the claims.

Morris Reference

Morris fails to raise a substantial new question of patentability regarding claims 1-8 because Morris does not provide any new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims. Morris was previously considered in the '10856 proceeding and is accordingly not new and non-cumulative

unless it is presented in a new light. However, the present Request fails to present Morris in a new light.

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.* To support a finding of a SNQ, the Request asserts that Morris is being presented in a new light in view of the submitted Declarations by Dr. Kogan. It is important to note that a SNQ can only arise in view of a patent or printed publication. The Declarations of Dr. Kogan are not printed and publications that can give rise to a SNQ; however, they may be considered in a reexamination.

In the present case, Morris is not presented in a new light because the same portions of Morris are presented for consideration as in the '10856 proceeding and no new and important teachings are presented. For example, in discussing the feature of a record search means, the '10856 proceeding relies upon Morris at column 3 line 54 through column 4 line 24 and column 6 lines 47 through 65 (*see '10856 Proceeding, Claim Chart F, Pages 2-10).* Similarly, the instant Request relies upon Morris at column 3 line 54 through column 4 line 24 and column 6 lines 47 through 65 (*see Request, Claim Chart E, Pages 1-9; see also Declaration under §1.132 by Michael Kogan – Exhibit E).* Thus, Morris has not been presented in a different way as compared to its use in the earlier reexamination. On the contrary, Morris has been presented in exactly the same way utilizing the same portions of Morris in both Requests. The proposed combination of Morris with Dirks may be presented in a new manner with regards to the new information of Dirks, but with regards to Morris the presentation is cumulative to the teachings

previously on record. Accordingly, Morris does not raise a substantial new question of patentability as to claims 1-8.

CORRESPONDENCE

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
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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 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 Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Andrew Nalven/

Andrew Nalven
CRU Examiner
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Conferee: ESK

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