

Exhibit “B”



DO NOT USE IN PALM PRINTER

MAILED

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JAN 18 2011

Kyle Rinehart
Klarquist Sparkman, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,831.

PATENT NO. 5,490,216.

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)).

Office Action in Ex Parte Reexamination	Control No. 90/010,831	Patent Under Reexamination 5,490,216	
	Examiner MATTHEW HENEGHAN	Art Unit 3992	

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

- a Responsive to the communication(s) filed on 29 November 2010. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO/SB/08. 4. _____.

Part II SUMMARY OF ACTION

- 1a. Claims 1-20 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1-20 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____.
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Reexamination

In response to the previous office action, the Patent Owner filed a Request for Reconsideration filed 29 November 2010.

The construction of certain claim terms in claims 1-20 have been reconsidered, prompting new or modified grounds of rejection. As a result, this office action is non-final.

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 Patent No. 5,490,216 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 §§ 2207, 2282 and 2286.

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

Art Unit: 3992

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

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 this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

Claims 1-20 have been examined.

Affidavits

The affidavit under 37 CFR 1.132 filed 29 November 2010 by Ravinda Marwaha is insufficient to overcome the rejection under 35 U.S.C. 103 of claims 1-20 based upon Hellman, either alone or in view of Grundy, because it refers only to the system described in the above referenced application and not to the individual claims of the patent. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

Art Unit: 3992

The affidavit under 37 CFR 1.132 filed 29 November 2010 by Brad Davis is insufficient to overcome the rejection under 35 U.S.C. 103 of claims 1-20 based upon Hellman, either alone or in view of Grundy. The affidavit states that the claimed subject matter solved a problem that was long standing in the art and enjoyed commercial success. However, there is no actual evidence presented that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. Furthermore, no evidence is presented showing a nexus between the claimed invention and the commercial success.

The affidavit under 37 CFR 1.132 filed 29 November 2010 by Ric B. Richardson is insufficient to overcome the rejection under 35 U.S.C. 103 of claims 1-20 based upon Hellman, either alone or in view of Grundy. The affidavit states that the claimed subject matter solved a problem that was long standing in the art and enjoyed commercial success. However, there is no actual evidence presented that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. Furthermore, no evidence is presented showing a nexus between the claimed invention and the commercial success. See MPEP § 716.04.

Art Unit: 3992

The affidavit under 37 CFR 1.132 filed 29 November 2010 by William R. Rosenblatt has been considered and entered into the record. The affidavit is unpersuasive because it entirely consists of opinions regarding the applicability of the cited prior art.

An affidavit under 37 CFR 1.132 was filed on 6 December 2010 without a Certificate of Service that appears to be a duplicate of one of the affidavits filed on 29 November 2010. The affidavit filed on 6 December 2010 is being ignored.

References Submitted by Requester

The following references have been found to establish a substantial new question of patentability. See Order, mailed 9 April 2010:

U.S. Patent No. 5,490,216 to Hellman (hereinafter Hellman), either alone or in view of U.S. Patent No. 4,796,220 to Grundy (hereinafter Grundy) or U.S. Patent No. 5,291,598 to Wolfe (hereinafter Wolfe).

Claim Construction

Claim 7 recites "said platform unique ID" in line 5. It is not clear to what this limitation refers. It is being presumed that this is a field produced by the platform unique ID generating means.

Claim 12 lacks a transitional phrase. It is being presumed that the limitations of the claim comprise all those beginning with "said registration system ..." In line 2 and the limitations have been recited in an open-ended manner.

Means Plus Function Limitations

Several means plus function limitations that are being treated under 35 U.S.C. 112, sixth paragraph appear in the claims of the '216 patent. They are supported by the specification as follows:

local licensee unique ID generating means (claims 1, 19, 20): a hardware summer (see figure 10 and column 12, lines 62-65), including supporting software, with inputs (see column 12, lines 51-61), may be implemented in software, column 13, lines 42-48).

Art Unit: 3992

remote licensee unique ID generating means (claims 1, 19, 20): a remote hardware summer (see figure 10 and column 13, lines 2-10), may be implemented in software, column 13, lines 42-48)

mode switching means (claims 1, 19, 20), mode-switching means (claim 17): two hardware gates and a comparator that determine software flow, controlled by a relay, which is driven by software (see column 13, lines 22-40, may be implemented in software, column 13, lines 42-48).

platform unique ID generating means (claim 7): code for creating the platform unique ID (see column 5, lines 57-64), read from a digital code reading device (see column 12, lines 46-50).

registration key generating means (claim 17): a hardware summer (see figure 10 and column 12, lines 62-65), with inputs (see column 12, lines 51-61), may be implemented in software, column 13, lines 42-48).

The term "third party means of operation" in claim 17 is not being treated as a 35 U.S.C. 112, sixth paragraph limitation because it does not have a function associated with the means, other than the broad term "operation."

Substantial New Question of Patentability

The Patent Owner has traversed the finding that Hellman in view of Grundy establishes a substantial new question of patentability based upon the fact that Grundy

Art Unit: 3992

was cited by the Examiner during the original prosecution. “[T]he Federal Circuit stated that ‘to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose.’ *In re Swanson*, 540 F.3d 1368, 1380 (2008) (concluding that prior art used as a secondary reference in an obviousness rejection was sufficient to establish SNQ when considered as an anticipatory reference)” *Ex Parte Muzzy* (Bd. Pat. App. & Inter. 2010, slip op. at 8). In the original prosecution, Grundy was used as the primary reference in rejections. In the instant office action, Grundy is merely being used as a secondary reference to cure deficiencies in Hellman, which was not considered by the original examiner. The teachings for which Grundy are being relied upon are not teachings that the original examiner found to be absent in Grundy. This is therefore a different issue from that which the original examiner decided and the finding of a substantial new question of patentability is proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3992

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by Hellman.

As per claim 19, Hellman discloses a system including local licensee unique ID generating means (see column 10, lines 14-18, for local generation of C, which is the same as A, which is an ID remotely created that is associated with a request that includes information provided by and specific to a user, such as billing information, see column 5, line 57 to column 6, line 15, making it effectively specific to the licensee; the hash function used to generate the ID produces a number that is so unlikely to be reproduced independently that it is at least as unique that the IDs from the disclosure of the '216 patent, see column 6, lines 31-52. Since the generated ID is unique, is associated with the licensee, is not explicitly excluded by the '216 patent, and is used in the other elements of the claim in the same manner as that of the '216 patent's specification, it is functionally equivalent to the means disclosed in the '216 patent), said system further including mode switching means operable on said platform (a comparator that triggers the updating of usage authorization, i.e. a switching of modes, on the software, see column 10, lines 18-26) which permits use of said digital data in said use mode on said platform only if (see column 10, lines 18-26; in the scenario where the number of authorized uses is previously 0, a failure results in the product not being operable, see column 10, lines 44-54) a licensee unique ID generated by said local licensee unique ID generating means has matched a licensee unique ID generated by said remote licensee unique ID generating means (see column 6, line 62 to column

Art Unit: 3992

7, line 2 and column 10, lines 27-32); and wherein said remote licensee unique ID generating means comprises software executed on a platform which includes the algorithm utilized by said local licensee unique ID generating means to produce said licensee unique ID (see column 10, lines 14-18 and 27-32).

As per claim 20, Hellman discloses a method comprising an intending licensee operating a registration system for licensing execution of digital data in a use mode (see abstract), said digital data executable on a platform, said system including local licensee unique ID generating means (an ID, A, is created that is associated with a request that includes information provided by and specific to a user, such as billing information, see column 5, line 57 to column 6, line 15, making it effectively specific to the licensee; the hash function used to generate the ID produces a number that is so unlikely to be reproduced independently that it is at least as unique that the IDs from the disclosure of the '216 patent, see column 6, lines 31-52. Since the generated ID is unique, is associated with the licensee, is not explicitly excluded by the '216 patent, and is used in the other elements of the claim in the same manner as that of the '216 patent's specification, it is functionally equivalent to the means disclosed in the '216 patent) and remote licensee unique ID generating means (see column 6, lines 16-30 and column 6, line 62 to column 7, line 2), said system further including mode switching means (a comparator, see column 10, lines 18-26) operable on said platform which permits use of said digital data in said use mode on said platform only if a licensee unique ID generated by said local licensee unique ID generating means has matched a licensee unique ID generated by said remote licensee unique ID generation (see column 10,

Art Unit: 3992

lines 18-26; in the scenario where the number of authorized uses is previously 0, a failure results in the product not being operable, see column 10, lines 44-54); and wherein said remote licensee unique ID generation comprises software executed on a platform which includes the algorithm utilized by said local licensee unique ID generation to produce said licensee unique ID (see column 10, lines 27-32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7-11, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellman.

As per claim 1, Hellman discloses a system including local licensee unique ID generating means (see column 10, lines 14-18, for local generation of C, which is the same as A, which is an ID remotely created that is associated with a request that includes information provided by and specific to a user, such as billing information, see column 5, line 57 to column 6, line 15, making it effectively specific to the licensee; the hash function used to generate the ID produces a number that is so unlikely to be reproduced independently that it is at least as unique that the IDs from the disclosure of

Art Unit: 3992

the '216 patent, see column 6, lines 31-52, making it functionally equivalent to the means disclosed in the '216 patent) and remote licensee unique ID generating means (see column 6, lines 16-30 and column 6, line 62 to column 7, line 2), said system further including mode switching means (a comparator that triggers the updating of usage authorization, i.e. a switching of modes, on the software, see column 10, lines 18-26) operable on said platform which permits use of said digital data in said use mode on said platform only if a licensee unique ID first generated by said local licensee unique ID generating means has matched a licensee unique ID generated by said remote licensee unique ID generation (see column 10, lines 18-26; in the scenario where the number of authorized uses is previously 0, a failure results in the product not being operable, see column 10, lines 44-54); and wherein said remote licensee unique ID generation comprises software executed on a platform which includes the algorithm utilized by said local licensee unique ID generating means to produce said licensee unique ID (see column 7, lines 14-18 and 27-32; the program being executed is implicitly part of the process, including the generation of H in figure 2 and column 10, lines 33-43).

Hellman does not disclose that the comparison using the local licensee unique ID should only be against a remote licensee unique ID that has been subsequently generated. However, the generations of these two values are independent of one another and it would be obvious to generate the ID's in either order.

It is unclear whether or not the scope of the terms "local licensee unique ID generating means" and "remote licensee unique ID generating means" encompasses

Art Unit: 3992

implementations that do not include a summer in the algorithm, as per the only embodiment of the '216 patent). If it does not, then it is noted that the numerous cryptographic hash algorithms that comprise summations are well-known in the art, such as MD5 and SHA-1. Hellman stresses that the use of alternative algorithms might be advantageous, particularly an algorithm that could be computed more rapidly (see Hellman, column 7, line 67 to column 8, line 12). Therefore, it would have been obvious to modify the invention of Hellman by using an algorithm using an algorithm having summation that could be computed more rapidly.

As per claims 7-9, Hellman's algorithm for producing a platform ID (A), which comprises the digital data, incorporates the platform unique key, K, which is a type of "other platform information." The software fails if the value of A has changed from its original value (see column 9, lines 50-63).

As per claims 10 and 11, Hellman does not explicitly discuss the architecture of the computer on which the protected software is being executed; however, the use of operating systems for such deployments is nearly universal and it is therefore implicit for such computers to have operating systems upon which such user applications are run.

Regarding claims 19 and 20, over and above the stated rejection under 35 U.S.C. 102 above, it is unclear whether or not the scope of the terms "local licensee unique ID generating means" and "remote licensee unique ID generating means" encompasses implementations that do not include a summer in the algorithm, as per the only embodiment of the '216 patent). If it does not, then it is noted that the numerous cryptographic hash algorithms that comprise summations are well-known in the art,

Art Unit: 3992

such as MD5 and SHA-1. Hellman stresses that the use of alternative algorithms might be advantageous, particularly an algorithm that could be computed more rapidly (see Hellman, column 7, line 67 to column 8, line 12). Therefore, it would have been obvious to modify the invention of Hellman by using an algorithm using an algorithm having summation that could be computed more rapidly.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellman in view of Grundy.

Regarding claim 1, over and above the discussion above, it is unclear whether or not the scope of the terms "local licensee unique ID generating means" and "remote licensee unique ID generating means" encompasses implementations that do not include a summer in the algorithm, as per the only embodiment of the '216 patent). If it does not, then it is noted that Hellman stresses that the use of alternative algorithms might be advantageous, particularly an algorithm that could be computed more rapidly (see Hellman, column 7, line 67 to column 8, line 12).

Grundy discloses an analogous algorithm for unique ID generation, wherein the unique ID, a registration code, is produced by performing a checksum of the user data component fields (see column 15, lines 3-23 and column 18, lines 25-29).

Therefore, it would have been obvious to modify the invention of Hellman by using an algorithm using an algorithm having summation, as taught by Grundy, that could be computed more rapidly.

Art Unit: 3992

As per claim 2, Hellman's unique ID generating algorithm produces an ID that is at least as unique as that of the '216 invention from the four inputs for the party who is being billed, e.g. the user (see column 5, lines 59-63; column 9, lines 10-15; column 10, lines 14-18; column 27, lines 27-32; column 9, lines 58-63). The hash function used to generate the ID produces a number that is so unlikely to be reproduced independently that it is at least as unique that the IDs from the disclosure of the '216 patent, see column 6, lines 31-52).

Although Hellman discloses the association between IDs and user data (e.g. billing information), Hellman does not disclose that the information being combined in the algorithm is uniquely descriptive of an intended licensee, but merely the intended licensee's computer.

Grundy discloses an analogous algorithm for unique ID generation, wherein the unique ID, a registration code, is produced by performing a checksum of uniquely descriptive user data component fields (see column 15, lines 3-23 and column 18, lines 25-29), and further notes a need for developers and distributors of information to harness the user's ability to copy and distribute their product (see column 4, lines 9-18).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hellman by incorporating uniquely descriptive user data into the licensee's ID, because of the need for developers and distributors of information to harness the user's ability to copy and distribute their product.

Art Unit: 3992

Regarding claim 3, subsequent applications of the invention would require the use of the same unique ID in Hellman; therefore, subsequent uses of the algorithm would fail if the number were to change.

As per claims 4 and 5, the software being validated, which is being input into the mode switching means, is used as an input to the unique ID generation system (see column 10, lines 33-43).

As per claim 6, Hellman discloses that a name may be used in the production of the unique ID (H is derived from the name of the software, see column 6, lines 31-61) and that billing information is associated with the unique ID. Grundy discloses the use in the ID of an "owner data checksum" (see column 15, lines 10-13 and 49-68), which is derived from such user-entered fields as name and telephone number (see column 12, lines 36-38).

As per claims 7-9, Hellman's algorithm for producing a platform ID (A), which comprises the digital data, incorporates the platform unique key, K, which is a type of "other platform information." The software fails if the value of A has changed from its original value (see column 9, lines 50-63).

As per claims 10 and 11, Hellman does not explicitly discuss the architecture of the computer on which the protected software is being executed; however, the use of operating systems for such deployments is nearly universal and it is therefore implicit for such computers to have operating systems upon which such user applications are run.

Regarding claim 12, Hellman discloses a registration system generating a security key from information input to said software (see column 10, lines 14-18, for

Art Unit: 3992

local generation of C, which is the same as A, which is a security key); and wherein said registration system is replicated at a registration authority (see column 6, lines 16-30 and column 6, line 62 to column 7, line 2) and used for the purposes of checking by the registration authority that the information unique to the user is correctly entered at the time that the security key is generated by the registration system.

Hellman discloses the generating of a security key from various information and that the information is associated with a user (see column 10, lines 14-18, for local generation of C, which is the same as A, which is a key remotely created that is associated with a request that includes information provided by and specific to a user, such as billing information, see column 5, line 57 to column 6, line 15), but does not disclose that the information input for the security key to said software uniquely identifies an intended registered user of said software on a computer on which said software is to be installed.

Grundy discloses the generation of a checksum, which is used as a security key, that is derived at least in part from the user data (see column 15, lines 3-23 and column 18, lines 25-29) and further notes a need for developers and distributors of information to harness the user's ability to copy and distribute their product (see column 4, lines 9-18).

Hellman also does not disclose the key is used for the purposes of checking by the registration authority that the information unique to the user is correctly entered at the time that the security key is generated by the registration system.

Grundy further discloses a check of entered user information by comparing the checksum from newly entered data to that which was previously generated (see column 15, lines 13-26). One skilled in the art would recognize that this would help prevent data entry errors.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hellman as per Grundy, because of the need for developers and distributors of information to harness the user's ability to copy and distribute their product and to prevent data entry errors.

As per claim 13, Hellman discloses the use of a registration number algorithm in the security key generation (see column 10, lines 14-18).

Regarding claim 14, Hellman further discloses that the key generation further comprises a key K (also SK) derived as part of the algorithm via a table look-up from the platform's serial number (see column 6, lines 16-21).

Regarding claims 15 and 16, although Hellman discloses that the use of demonstration modes is known in the art so that the customer may experiment with the software before making a buying decision (see column 2, lines 14-48), Hellman does not disclose boot checks, including a determination to allow for a demonstration mode after the first boot.

Grundy discloses a boot check (see column 16, lines 39-49 and 64-68) and, if shows a previous use, allows full use mode if authorization is successful and a demonstration mode otherwise (see column 5, lines 37-49) that is based on hardware identification, which is not user-configurable (see column 18, lines 34-44).

Art Unit: 3992

Therefore it would have been obvious to one of ordinary skill in the art at the time was made to yet further modify Hellman as per Grundy, so that the customer may experiment with the software before making a buying decision.

As per claim 17, Hellman discloses a method comprising providing mode-switching means (a comparator that triggers the updating of usage authorization, i.e. a switching of modes, on the software, see column 10, lines 18-26) associated with said software adapted to switch said software between a fully enabled mode and a partly enabled or demonstration mode (although Hellman's preferred embodiment does not use a demonstration mode, Hellman discloses the use of such a scheme in the prior art, so that the customer may experiment with the software before making a buying decision, see column 2, lines 14-48. It would therefore be obvious to one of ordinary skill in the art to use these two modes based on Hellman), said method further comprising providing registration key generation (see column 10, lines 14-18, for local generation of C, which is the same as A, which is a key remotely created that is associated with a request that includes information provided by and specific to a user, such as billing information, see column 5, line 57 to column 6, line 15); said mode-switching means switching said software into fully enabled mode only if an enabling key provided to said mode-switching means by said intending user at the time of registration of said software has matched identically with said registration key (the comparator only allows for use of the fully enabled mode if there is a match); and wherein said enabling key is communicated to said intending user at the time of registration of said software (see column 6, lines 3-8); said enabling key generated by a third party means of

Art Unit: 3992

operation of a duplicate copy of said registration key generation (generated by Authorization and Billing Unit, see column 6, lines 3-8).

Hellman's registration key generation is not a function of information unique to an intending user of the software.

Grundy discloses an analogous algorithm for unique ID generation, a registration code is produced by performing a checksum of uniquely descriptive user data component fields (see column 15, lines 3-23 and column 18, lines 25-29), and further notes a need for developers and distributors of information to harness the user's ability to copy and distribute their product (see column 4, lines 9-18).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hellman by incorporating uniquely descriptive user data into the licensee's ID, because of the need for developers and distributors of information to harness the user's ability to copy and distribute their product.

As per claim 18, Hellman's algorithm for producing a registration key incorporates the platform unique key, K, which is part of the platform's environment (see column 9, lines 50-63).

Regarding claims 19 and 20, over and above the discussion above, it is unclear whether or not the scope of the terms "local licensee unique ID generating means" and "remote licensee unique ID generating means" encompasses implementations that do not include a summer in the algorithm, as per the only embodiment of the '216 patent). If it does not, then it is noted that Hellman stresses that the use of alternative algorithms

Art Unit: 3992

might be advantageous, particularly an algorithm that could be computed more rapidly (see Hellman, column 7, line 67 to column 8, line 12).

Grundy discloses an analogous algorithm for unique ID generation, wherein the unique ID, a registration code, is produced by performing a checksum of the user data component fields (see column 15, lines 3-23 and column 18, lines 25-29).

Therefore, it would have been obvious to modify the invention of Hellman by using an algorithm using an algorithm having summation, as taught by Grundy, that could be computed more rapidly.

Response to Arguments

During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). The Patent Owner is reminded that, since claims of unexpired patents in reexamination are not constructed according to the rationale used by the district courts, there is no deference to those courts. As shown in the grounds of rejection stated above, Hellman, either alone or in view of Grundy, teaches to the broadest reasonable interpretation of the claims.

Regarding the Patent Owner's arguments with respect to secondary considerations indicating non-obviousness, the affidavits that have been provided have not been accompanied by objective evidence that would support the assertions that

Art Unit: 3992

have been made therein. They are therefore ineffective to overcome any rejections made under 35 U.S.C. 103.

Art Unit: 3992

Conclusion

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

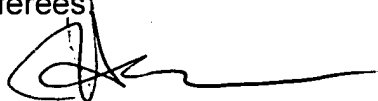
Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to Examiner Matthew Heneghan at telephone number (571)272-3834.

/Matthew Heneghan/

Primary Examiner, USPTO AU 3992

Conferees



JESSICA HARRISON
SUPERVISORY PATENT EXAMINER

