

# **EXHIBIT A**



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/010,831

01/22/2010

5,490,216

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2214

26111

7590

08/05/2011

EXAMINER

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

ART UNIT

PAPER NUMBER

DATE MAILED: 08/05/2011

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**MAILED**

**AUG 05 2011**

**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)).

**Notice of Intent to Issue  
Ex Parte Reexamination Certificate**

<b>Control No.</b> 90/010,831	<b>Patent Under Reexamination</b> 5,490,216	
<b>Examiner</b> MATTHEW HENEGHAN	<b>Art Unit</b> 3992	

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

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
  - (a)  Patent owner's communication(s) filed: 18 March 2011.
  - (b)  Patent owner's late response filed: \_\_\_\_\_.
  - (c)  Patent owner's failure to file an appropriate response to the Office action mailed: \_\_\_\_\_.
  - (d)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (e)  Other: \_\_\_\_\_.

Status of *Ex Parte* Reexamination:

  - (f) Change in the Specification:  Yes  No
  - (g) Change in the Drawing(s):  Yes  No
  - (h) Status of the Claim(s):
    - (1) Patent claim(s) confirmed: 1-20.
    - (2) Patent claim(s) amended (including dependent on amended claim(s)): \_\_\_\_\_
    - (3) Patent claim(s) canceled: \_\_\_\_\_.
    - (4) Newly presented claim(s) patentable: \_\_\_\_\_.
    - (5) Newly presented canceled claims: \_\_\_\_\_.
    - (6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_
    - (7) Patent claim(s) not subject to reexamination: \_\_\_\_\_.
  
2.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
  
3.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
  
4.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
  
5.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
  
6.  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
    - been received.
    - not been received.
    - been filed in Application No. \_\_\_\_\_.
    - been filed in reexamination Control No. \_\_\_\_\_.
    - been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.
  
7.  Note attached Examiner's Amendment.
  
8.  Note attached Interview Summary (PTO-474).
  
9.  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 on 18 March 2011.

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

Claims 1-20 have been examined.

### ***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).

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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."

***Allowable Subject Matter***

Claims 1-20 are confirmed.

**STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

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)). Where there exists a final decision by the Court of Appeals for the Federal Circuit regarding the construction of claims, an interpretation is not reasonable where it is inconsistent with that decision. The Patent Owner has persuasively argued that, based on such decisions regarding the '216 patent, Hellman cannot be reasonably construed as teaching to a local licensee unique ID generating means or a remote licensee unique ID generating means.

The licensee unique ID generated by the means recited in each of the claims must be derived from at least piece of information that is specific to the user, such as name, billing information, or product information unique to the instantiation entered by the user. The information cannot be specific to the computer or independently generated by the computer. Hellman's ID has four inputs: a computer-specific key (SK), a number of uses requested (N), a random number generated by the computer (R), and a hash of a code for the type of software package, which is general to all installations of that package (H). Since none of these are user-specific, Hellman's algorithm does not generated the claimed licensee unique ID.



It is also noted that the means itself must be an algorithm that, at least to some extent, must comprise a summation. The means provided by Hellman for combining the fields is DES, an encryption algorithm that does not involve summation; alternatively, Hellman suggests that digital signatures may be used (see Hellman, column 11, lines 42-47). Hellman further stresses that faster cryptographic alternatives could also be used (see column 7, line 67 to column 8, line 12). Given that there were a finite number of such algorithms available at the time of the Patent Owner's invention, it would have been obvious at that time to try any recognized alternative in the implementation of Hellman. As the Federal Circuit has pointed out, the MD5 algorithm (described in RFC 1321, attached to this action) could be such a means.

Of the other art of record, the only<sup>one</sup> that suggests that use of user-specific information in the computation of fields is Grundy. The Patent Owner has persuasively argued that the summation disclosed by Grundy is used in the context of merely verifying the correctness of information related to the user and is not being used to generate an ID per se. Since the information is not being used for the same purpose, one skilled in the art therefore would not use the algorithm of Grundy as part of the generation of the claimed licensee unique ID.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

### ***Declarations***

The declaration under 37 CFR 1.132 filed 18 March 2011 by Dr. Udo Pooch is sufficient to overcome the rejection of claims 1-20 based upon Dr. Pooch's argument that it would be improper to combine the references in the manner of the claimed invention.

The declaration under 37 CFR 1.132 filed 18 March 2011 by Dr. William R. Rosenblatt, in which secondary considerations for non-obviousness have been asserted, has been considered. However, we need not reach the issues raised in that declaration because the other evidence discussed above sufficiently supports a finding of non-obviousness.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 18 March 2011, with respect to the rejections under 35 U.S.C. 102 and 103 have been fully considered and are persuasive. The rejections of the claims have been withdrawn.

**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:

/EBK/

  
JESSICA HARRISON  
SUPERVISORY PATENT EXAMINER