

Exhibit “D1”



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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MAILED

APR 09 2010

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)).

| | | | |
|--|--------------------|-----------------------------------|--|
| Order Granting / Denying Request For Ex Parte Reexamination | Control No. | Patent Under Reexamination | |
| | 90/010,831 | 5,490,216 | |
| | Examiner | Art Unit | |
| | MATTHEW HENEGHAN | 3992 | |

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

The request for *ex parte* reexamination filed 22 January 2010 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc: Requester (if third party requester)

DECISION GRANTING *EX PARTE* EXAMINATION

Reexamination

An Ex Parte Reexamination has been requested by a third party on 22 January 2010 for claims 1-20 of U.S. Patent No. 5,490,216 (hereinafter "the '216 patent"), granted on 6 February 1996.

A substantial new question of patentability affecting claims 1-20 of United States Patent Number 5,490,216 is raised by the request for *ex parte* reexamination.

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

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

References Submitted by Requester

U.S. Patent No. 4,658,093 to Richardson, III (hereinafter Richardson)

U.S. Patent No. 4,796,220 to Grundy (hereinafter Grundy)

U.S. Patent No. 5,291,598 to Wolfe (hereinafter Wolfe)

U.S. Patent No. 5,490,216 to Hellman (hereinafter Hellman)

None of the references cited above were discussed by the Office in a previous examination or reexamination proceeding.

Prosecution History

The '216 patent was originally filed as Application No. 08/124,718 on 21 September 1993, having claims 1-30.

In a non-final rejection mailed by the Office on 24 June 1994, claims 1-30 were rejected. Claims 22-24 and 27-29 were rejected under 35 U.S.C. 101, claims 13-18 and

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27-29 were rejected under 35 U.S.C. 112, second paragraph, and claims 1-30 were rejected under 35 U.S.C. 102(e) over U.S. Patent No. 5,222,133 to Chou et al.

After the Applicant filed an amendment on 27 December 1994 cancelling claims 22-24 and 27-29, the Office mailed a second non-final rejection on 30 March 1995, rejecting claims 1-21, 25, 26, and 30 under 35 U.S.C. 103 over U.S. Patent No. 5,291,598 to Grundy. The rejection under 35 U.S.C. 112, second paragraph of claims 13-18 was not maintained.

In an amendment filed 5 July 1995, the Applicant cancelled claims 1-21, 25, 26, and 30 (i.e. all remaining claims to that point) and added claims 31-50. The Applicant argued that the cited prior art did not teach:

“(a) The ‘Licensee Unique ID’ on which the registration system relies for matching for verification purposes is generated locally, and

(b) The algorithm used to generate locally the ‘Licensee Unique ID’ is replicated remotely for the purposes of remote generation of a separate ‘Licensee Unique ID’ for matching purposes.”

and

“(1) A direct comparison for matching purposes of the licensee unique ID data at the local location, and

(2) A confirmation that the user details provided to the remote location match identically with the user details provided to the software to be protected and from which the unique ID is generated.”

The Office mailed a Notice of Allowance on 8 August 1995 without further comment.

None of the claims of the '216 patent have been subject to a final holding of invalidity by a court.

Claims of the '216 Patent

The following are the 5 independent claims of the '216 patent:

Claim 1:

1. A registration system for licensing execution of digital data in a use mode, said digital data executable on a platform, said system including local licensee unique ID generating means and remote licensee unique ID generating means, said system further including mode switching means 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 subsequently generated by said remote licensee unique ID generating means; 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.

12. A registration system attachable to software to be protected, said registration system generating a security key from information input to said software which uniquely identifies an intended registered user of said software on a computer on which said software is to be installed; and

wherein said registration system is replicated at a registration authority 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.

17. A method of control of distribution of software, said method comprising providing mode-switching means associated with said software adapted to switch said software between a fully enabled mode and a partly enabled or demonstration mode,

said method further comprising providing registration key generating means adapted to generate a registration key which is a function of information unique to an intending user of the software;

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

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time of registration of said software has matched identically with said registration key;

and

wherein said enabling key is communicated to said intending user at the time of registration of said software;

said enabling key generated by a third party means of operation of a duplicate copy of said registration key generating means.

19. A remote registration station incorporating remote licensee unique ID generating means, said station forming part of a registration system for licensing execution of digital data in a use mode, said digital data executable on a platform, said system including

local licensee unique ID generating means,

said system further including mode switching means 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 generating means; 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.

20. A method of registration of digital data so as to enable execution of said digital data in a use mode, said method comprising

an intending licensee operating a registration system for licensing execution of digital data in a use mode,

said digital data executable on a platform,

said system including local licensee unique ID generating means and remote licensee unique ID generating means, said system further including mode switching means 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 generating means; 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.

Substantial New Questions of Patentability (SNQ)

Hellman

Hellman discloses a software authorization system where a locally generated code (C, see column 10, lines 14-18) is compared to a remotely generated code (A, see column 6, lines 3-8) to determine authorization (see column 10, lines 18-26). This was not taught by the art cited during prosecution. It is agreed that a reasonable examiner

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would have found this reference important, either alone or in combination with Grundy, in determining the patentability of claims 1-20.

Grundy

During the original examination, the Examiner relied on Grundy to show a comparison of locally and remotely generated codes by pointing to a comparison between the User Data 301 and the encrypted authorization code 318. The Third Party Requester has pointed out that the Examiner did not note during prosecution the comparison between checksums at step 310 between the user generated checksum 309 and the corresponding value derived at the Manufacture Control Agency (see column 15, lines 10-22). These fields, however, are checksums. Checksums are not unique fields, even if there are at least in part derived from unique data. It is NOT agreed that a reasonable examiner would have found this reference important in determining the patentability of claims 1-20.

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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