

# Exhibit “D2”



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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MAILED

SEP 28 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)).

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

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

- a  Responsive to the communication(s) filed on \_\_\_\_\_ .      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. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08. | 4. <input type="checkbox"/> _____.                      |

**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*

An Ex Parte Reexamination has been granted for claims 1-20 of U.S. Patent No. 5,490,216 (hereinafter "the '216 patent"). See Order, mailed 9 April 2010.

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).

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.

#### ***Information Disclosure Statements***

The Information Disclosure Statements filed on 21 May 2010 and 31 August 2010 have been fully considered. Correspondences to and from the U.S. and Foreign Patent and Copyright Offices have been considered, but have been crossed out on the Forms 1449 because they are not prior art. Items NPL13 and NPL20 on the IDS filed 31 August 2010 have been crossed out because it is not clear that they were publicly available publications. Item NPL 18 has been crossed out because the date in the citation is not clear.

***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).

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).

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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."

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

As per claim 1, Hellman discloses a system including local licensee unique ID (see column 10, lines 14-18) and remote licensee unique ID generation (see column 6, line 62 to column 7, line 2), said system further including mode switching means (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 generation 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



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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 7, lines 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.

Hellman discloses several algorithms for local licensee unique ID and remote licensee unique ID generation, but none of them could possibly be performed using just the summer disclosed in the '216 patent's specification for local licensee unique ID generating means and remote licensee unique ID generating means, discussed above.

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). One skilled in the art would recognize that the use of a checksum in producing a unique ID would be advantageous because it is easier to implement.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify Hellman to use Grundy's checksum for ID generation, because it is easier to implement.

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).

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).

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 and 27-

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32); and wherein said registration system is replicated at a registration authority (see column 10, lines 27-32) 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, 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 18, lines 25-33). One skilled in the art would recognize that this would be advantageous by supporting licensing on a per-user basis rather than a per-platform basis.

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, to support licensing on a per-user basis and to prevent data entry errors.

As per claim 13, Hellman discloses the use of a random number, R, 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).

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, 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,

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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; 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 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 the generation of a checksum, which is used as a registration key, that is derived at least in part from the user data (see column 18, lines 25-33). One skilled in the art would recognize that this would be advantageous by supporting licensing on a per-user basis rather than a per-platform basis.

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, to support licensing on a per-user basis.

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).

As per claim 19, Hellman discloses a system including local licensee unique ID generation (see column 10, lines 14-18), said system further including mode switching means operable on said platform (a comparator, 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 generation has matched a licensee unique ID generated by said remote licensee unique ID generation (see column 6, line 62 to column 7, line 2); 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 14-18).

Hellman discloses several algorithms for local licensee unique ID and remote licensee unique ID generation, but none of them could possibly be performed using just the summer disclosed in the '216 patent's specification for local licensee unique ID generating means and remote licensee unique ID generating means, discussed above.

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). One skilled in

the art would recognize that the use of a checksum in producing a unique ID would be advantageous because it is easier to implement.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify Hellman to use Grundy's checksum for ID generation, because it is easier to implement.

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 generation (see column 10, lines 14-18) and remote licensee unique ID generation (see 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, 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).

Hellman discloses several algorithms for local licensee unique ID and remote licensee unique ID generation, but none of them could possibly be performed using just

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the summer disclosed in the '216 patent's specification for local licensee unique ID generating means and remote licensee unique ID generating means, discussed above.

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). One skilled in the art would recognize that the use of a checksum in producing a unique ID would be advantageous because it is easier to implement.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify Hellman to use Grundy's checksum for ID generation, because it is easier to implement.



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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