

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent of:

Mullor et al.

REQUEST FOR EX PARTE
REEXAMINATION UNDER
35 U.S.C. §302

U.S. Patent No: 6,411,941

Reexamination Request Control No:

Not Yet Assigned

Filed: October 1, 1998

Issued: June 25, 2002

For: METHOD OF RESTRICTING
SOFTWARE OPERATION WITHIN
A LICENSE LIMITATION

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR EX PARTE REEXAMINATION

Dear Sir:

Pursuant to 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510, requester Microsoft Corporation hereby requests *ex parte* reexamination of claims 1-19 of United States Patent No. 6,411,941 ("the '941 patent"), which issued on June 25, 2002, to Miki Mullor and Julian Valiko. The '941 patent was based on an application filed October 1, 1998 and claims priority to an application filed in Israel on May 21, 1998. A copy of the '941 patent is attached to this request as Exhibit A. The '941 patent is currently the subject of pending litigation including *Ancora Technologies, Inc. v. Toshiba America Information Systems, Inc. et al.*, No. SACV 08-0626-AG (C.D. Cal.).¹ The original complaint for the

¹ The lawsuit was recently transferred to the Western District of Washington, and is now captioned as *Ancora Technologies, Inc. v. Toshiba America Information Systems, Inc. et al.*, No. 2:09-cv-00270-MJP (W.D. Wa.)

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suit is attached as Exhibit B. In the pending litigation, the patent owner has proposed an extremely broad claim construction that expands the scope of the patent well beyond the scope that was argued during the original prosecution of the '941 patent. Had the patent owner asserted such scope during the original prosecution, these claims would not have been allowed. Even with the narrower construction that the patent owner originally argued, the '941 patent was anticipated by the references discussed below. Given the current, broad claim construction that patent owner now asserts, the invalidity of the patent's claims is even clearer. An opening Markman brief filed by patent owner (hereinafter "Patent Owner's Markman Brief") is attached to this request as Exhibit C.²

The substantial new questions of patentability raised in this request involve prior art questions that were not considered during prosecution of the application leading to the '941 patent. As detailed below, claims 1-19 of the '941 patent were anticipated under 35 U.S.C. § 102 in view of a patent to Robert Schwartz et al. filed in 1997. Claims 1-19 were also anticipated under § 102 in view of a patent to David Lewis filed in 1994.

During the original prosecution of the '941 patent, patent owner made strong statements distinguishing low-level programs that regularly access the BIOS from operating system level programs such as the claimed system. Amendment for Application No. 09/164,777 filed on February 5, 2002, at 5 (attached as Exhibit D). However, patent owner now asserts that claim 1 of the '941 patent covers any system that verifies a program (i.e. any set of instructions that can be executed by a computer) using information stored in a non-volatile memory area of the BIOS of a computer. Patent Owner's Markman Brief at 14-21. Thus, patent owner's arguments during prosecution are clearly no longer operative. Requestors respectfully assert that this changing story should be considered when evaluating the substantial new question of patentability and in any resulting reexamination.

The prior art references cited in this request raise substantial new questions of patentability that were not considered during prosecution of the application leading to

² 37 C.F.R. § 1.104(c)(3) (2007) ("In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability").

the '941 patent and more closely match the claimed limitations than the references previously considered by the PTO in connection with the '941 patent.

The prior art references on which this request is based, all of which pre-date the May 21, 1998 priority date of the '941 patent, are as follows:

- U.S. Patent No. 6,153,835, "System and Method for an Electronic Postage Scale with Variable Function Keys and Window Screens," issued to Schwartz et al. on November 28, 2000, based on an application filed June 7, 1995 and claiming priority to an application filed October 14, 1993 ("Schwartz '835") (attached as Exhibit E);
- U.S. Patent No. 5,734,819, "Method and Apparatus for Validating System Operation," issued to David Otto Lewis on March 31, 1998, based on an application filed October 12, 1994 ("Lewis '819") (attached as Exhibit F);

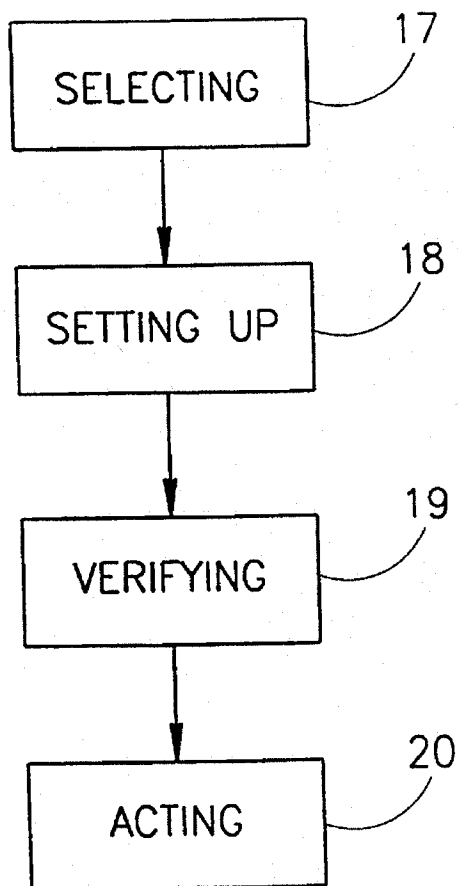
The remainder of this request is organized as follows. Section I provides an overview of the '941 patent. Section II provides an overview of the prior art cited in this request. Section III summarizes the substantial new questions of patentability introduced by this request. Section IV explains how that art compares to the claims at issue (detailed claim charts appear in Exhibit I). Section V concludes with a request that this request be granted and that the claims at issue be rejected.

I. OVERVIEW OF THE '941 PATENT

The '941 patent is directed to a method for enforcing a license restriction on a software program. '941 Patent at Abstract. The system uses a verification structure in a non-volatile memory area of the BIOS of a computer to verify that the computer is licensed to run the software program. *Id.* at C6:59-67. The specification of the '941 patent does not define "BIOS"; however, the term is well-known in the computer industry. According to the IBM Dictionary of Computing (excerpts attached as Exhibit G), the Basic Input/Output System (BIOS) is "[c]ode that controls basic hardware operations, such as interactions with diskette drives, hard disk drives, and the keyboard. IBM Dictionary 56, 65. As described in the '941 patent's specification, the BIOS may include both a read-only memory (ROM) section and an electrically erasable programmable read-only memory (EEPROM) section. In addition, during prosecution patent owner distinguished the claims over a prior art reference that stored license

information in persistent storage on a hard drive or magnetic disk drive. Amendment for Application No. 09/164,777 filed on February 5, 2002, at 5-7. Thus, "BIOS", as used in the '941 patent, apparently refers to a memory area in a computer that encompasses multiple non-volatile memory components but does not include a hard drive. The purported inventive aspect of the method is that it uses a writeable portion of the BIOS to store a verification structure for the software program. *Id.*

Figure 2 below shows the basic process for executing the method of the '941 patent. As shown in the figure, the process is a simple sequence of *selecting* a software program, *setting up* a verification structure in the BIOS, *verifying* the program using the verification structure, and *acting* on the verification. '941 patent at C6:4-52. During the setup phase, the system creates a verification structure and stores the structure in a non-volatile area of the BIOS. *Id.* at C6:18-28. During the verification phase, the system verifies the license using the stored verification structure. *Id.* at C6:29-39. After the verification phase, the system acts on the program based on the verification. *Id.* at C6:40-52.



Claim 1 is directed to exactly this process.³ Claim 1 reads as follows:

1. A method of restricting software operation within a license for use with a computer including an erasable, non-volatile memory area of a BIOS of the computer, and a volatile memory area; the method comprising the steps of:

selecting a program residing in the volatile memory,

using an agent to set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record,

³ In the context of reexamination, the “broadest reasonable interpretation” standard provided in MPEP §2111 for claim interpretation during patent examination is used, and the statutory presumption of validity for issued patents does not apply. MPEP §2258(I)(G). The standard applied by a court during litigation may or may not overlap with MPEP §2111. The requester expressly reserves the right to argue a claim construction in the pending litigation that is different from a claim interpretation in this request.

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