(Also referred to as FORM PTO-1465)

REQUEST FOR *EX PARTE* REEXAMINATION TRANSMITTAL FORM

Address to:
Mail Stop *Ex Parte* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attorney Docket No.: _____

Date: 05-11-2018 _____

1. [✓] This is a request for *ex parte* reexamination pursuant to 37 CFR 1.510 of patent number 9021602 _____
   issued 04-28-2015 _____. The request is made by:

   [ ] patent owner.   [✓] third party requester.

2. [✓] The name and address of the person requesting reexamination is:

   Fisch Sigler LLP _____

   5301 Wisconsin Avenue, NW, Fourth Floor _____

   Washington, DC 20015 _____

3.   Requester asserts [ ] small entity status (37 CFR 1.27) or [ ] certifies micro entity status (37 CFR 1.29). Only a patent owner requester can certify micro entity status. Form PTO/SB/15A or B must be attached to certify micro entity status.

4. [ ] a. A check in the amount of $_____ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(1);

   [ ] b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(1)
   to Deposit Account No. _____;

   [✓] c. Payment by credit card. Form PTO-2038 is attached; **or**

   [✓] d. Payment made via EFS-Web.

5. [✓] Any refund should be made by [✓] check or [ ] credit to Deposit Account No. _____.
   37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.

6. [✓] A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.510(b)(4).

7. [ ] CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table

        [ ] Landscape Table on CD

8. [ ] Nucleotide and/or Amino Acid Sequence Submission
   If applicable, items a. – c. are required.

   a. [ ] Computer Readable Form (CRF)

   b. Specification Sequence Listing on:

        i. [ ] CD-ROM (2 copies) or CD-R (2 copies); **or**

        ii. [ ] paper

   c. [ ] Statements verifying identity of above copies

9. [ ] A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.

10. [✓] Reexamination of claim(s) 1, 2, 3, 4, 5, 8, 10, and 12 _____ is requested.

11. [✓] A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.

12. [ ] An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

PTO/SB/57 (09-16)
Approved for use through 09/30/2018. OMB 0651-0064
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

13. [✓] The attached detailed request includes at least the following items:

    a. A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.510(b)(1).

    b. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.510(b)(2).

14. [ ] A proposed amendment is included (only where the patent owner is the requester). 37 CFR 1.510(e).

15. [✓] It is certified that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit requester from filing this *ex parte* reexamination request. 37 CFR 1.510(b)(6).

16. [✓] a. It is certified that a copy of this request (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).
The name and address of the party served and the date of service are:

Wistaria Trading LTD

Clarendon House, 2 Church Street, Hamilton HM 11, Bermuda

Date of Service: May 11, 2018 ; or

    [ ] b. A duplicate copy is enclosed since service on patent owner was not possible. An explanation of the efforts made to serve patent owner **is attached**. See MPEP 2220.

17. Correspondence Address: Direct all communication about the reexamination to:

[ ] The address associated with Customer Number:

OR

[✓] Firm or Individual Name   Fisch Sigler, LLP

Address

City Washington	State DC	Zip 20015
Country United States		
Telephone (202) 362-3524	Email Joe.Edell@fischllp.com	

18. [✓] The patent is currently the subject of the following concurrent proceeding(s):

    [ ] a. Copending reissue Application No. _____
    [ ] b. Copending reexamination Control No. _____
    [ ] c. Copending Interference No. _____
    [✓] d. Copending litigation styled:
    Blue Spike, LLC v. Juniper Networks, Inc., 6:17-cv-00016-KNM (ED. Tex. 2017)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

/Joseph F. Edell/   05-11-2018
Authorized Signature   Date

Joseph F. Edell   67,625   [ ] For Patent Owner Requester
Typed/Printed Name   Registration No.   [✓] For Third Party Requester

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Scott A. Moskowitz

U.S. Patent No.:   9,021,602

Issue Date: April 28, 2015

Appl. No.:   13/794,584

Filing Date: March 11, 2013

Title: DATA PROTECTION METHOD AND DEVICE

Control No.:   To be assigned

Mail Stop Ex Parte Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION OF
U.S. PATENT NO. 9,021,602

Dear Sir or Madam,

Pursuant to 35 U.S.C. § 302 and 37 C.F.R. § 1.510, *ex parte* reexamination is requested

for claims 1, 2, 3, 4, 5, 8, 10, and 12 of United States Patent No. 9,021,602 ("the '602 Patent,"

Exhibit 1), issued on April 28, 2015. The '602 Patent is currently assigned to Wistaria Trading

Ltd. and remains in force.

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              3.   Beetcher Anticipates Dependent Claim 5. 39

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              5.   Beetcher Anticipates Independent Claim 10. 42

              6.   Beetcher Anticipates Dependent Claim 12. 44

        B.   SNQ-2: Claims 3 and 4 are Rendered Obvious by the Combination of Beetcher
              and Rhoads Under 35 U.S.C. § 103(a). 45

        C.   SNQ-3: Claims 1, 2, 5, 8, 10, and 12 are Anticipated by Beetcher '072 Under 35
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              1.   Beetcher '072 Anticipates Independent Claim 1. 49

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TABLE OF EXHIBITS

Exhibit No.	Description
Exhibit 1	U.S. Patent No. 9,021,602 to Moskowitz ("the '602 Patent")
Exhibit 2	Prosecution History of the '602 Patent
Exhibit 3	U.S. Patent No. 5,933,497 ("Beetcher")
Exhibit 4	Japanese Patent Application Publication No. H05334072 ("Beetcher '072")
Exhibit 5	English Translation of Beetcher '072
Exhibit 6	PCT Application Publication No. WO 97/26732 ("Cooperman")
Exhibit 7	U.S. Patent No. 5,982,892 ("Hicks")
Exhibit 8	U.S. Patent No. 5,745,604 ("Rhoads")
Exhibit 9	Declaration of Dr. Claudio Silva ("Silva Declaration")
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Exhibit 11	Plaintiff Blue Spike LLC's Proposed Terms for Construction, Pursuant to Patent Rule (P.R.) 4-2 in *Blue Spike, LLC v. Juniper Networks, Inc.*, Case No. 6:17-cv-16-KNM (E.D. Tex.)

I.   INTRODUCTION

The '602 Patent claims computer software that includes a license key. As the patent explains, the function of the key is to discourage consumers from making unauthorized copies of the software. During the original prosecution of the '602 Patent, the Examiner only allowed the claims to issue based on Patent Owner's arguments that the prior art did not disclose the claimed license key. The Examiner stated that the prior art did not include "the limitation of storing in a personalization data resource, both computer configuration information of said computer and a license code which is used to generate a proper decoding key."[1] When he rendered this conclusion, however, the Examiner was not aware of the prior art references that indeed disclose this limitation, as well as the remaining limitations of claims 1-5, 8, 10, and 12 of the '602 Patent. These prior art references—Beetcher, Beetcher '072, Cooperman, Hicks, and Rhoads— establish that independent claims 1 and 10 are invalid as anticipated and that dependent claims 2- 5, 8, and 12 are anticipated or obvious. In light of the substantial new questions of patentability that these references raise, as explained in further detail below, Requester respectfully seeks *ex parte* reexamination.

II.   CLAIMS FOR WHICH REEXAMINATION IS REQUESTED

In accordance with 35 U.S.C. § 302 and 37 C.F.R. § 1.510, Requester seeks reexamination of claims 1, 2, 3, 4, 5, 8, 10, and 12 of the '602 Patent in view of the prior art patents and publications discussed herein.

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[1] Ex. 2, Prosecution History at 308 (*Notice of Allowance* (filed Jan. 13, 2015)).

III. **IDENTIFICATION OF PATENTS AND PRINTED PUBLICATIONS PRESENTED TO SHOW SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY**

The following five prior art patents and printed publications establish substantial new questions of patentability of claims 1, 2, 3, 4, 5, 8, 10, and 12 of the '602 Patent:

1. U.S. Patent No. 5,933,497 ("Beetcher" (Ex. 3)));

2. Japanese Patent Application Publication No. H05334072 ("Beetcher '072" (Ex. 4));

3. PCT Application Publication No. WO 97/26732 ("Cooperman" (Ex. 6));

4. U.S. Patent No. 5,982,892 ("Hicks" (Ex. 7)); and

5. U.S. Patent No. 5,745,604 ("Rhoads" (Ex. 8)).

Beetcher, Beetcher '072, Hicks, and Rhoads were not cited in the '602 Patent itself, nor were they identified as being considered by the Examiner during prosecution. The '602 Patent lists Cooperman in its References Cited section,[2] but Cooperman was not subject to any rejection or prior art discussion during the original prosecution. And as detailed in Section IX., this request presents Cooperman in a new light and a different way that escaped review during earlier examination.

IV. **CO-PENDING LITIGATION**

Requester is currently engaged in pending litigation concerning the '602 Patent in *Blue Spike, LLC v. Juniper Networks, Inc.*, Case No. 6:17-cv-16-KNM (E.D. Tex.).

The '602 Patent claims to be a continuation of the application that issued as U.S. Patent No. 9,104,842. Requester intends to file an *ex parte* reexamination request for the '842 Patent.

Requester is unaware of any pending prosecution concerning the '602 Patent.

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[2] '602 Patent at page 2.

V.   ESTOPPEL

The statutory estoppel provisions of 35 U.S.C. § 315(e)(1) and 35 U.S.C. § 325(e)(1) do not prohibit Requester from filing this *ex parte* reexamination request.

VI.   OVERVIEW OF THE ORIGINAL PROSECUTION HISTORY

The '602 Patent's claims 1-5, 8, 10, and 12 recite a method and computer program product for generating a decoding key to access a code resource included in the computer's software.[3] The '602 Patent was subject to two preliminary amendments, one rejection, two post-allowance amendments, and one post-issuance amendment. The Examiner allowed the '602 Patent upon the Patent Owner adding "storing . . . both computer configuration information . . . and license code" to each independent claim.

More specifically, the application for the '602 Patent was filed on March 11, 2013 with 57 claims.[4] With the initial filing, Patent Owner requested preliminary amendments to update the priority claim from January 17, 1996 to March 28, 1998.[5] Patent Owner then requested another preliminary amendment soon thereafter, canceling all previous claims and introducing 20 new claims.[6]

The Examiner's first Office action rejected all claims on prior art and written description grounds.[7] In particular, the Examiner rejected all proposed claims 58-77 under 35 U.S.C. § 112 as failing to comply with the written description requirement.[8] The Examiner concluded that the

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[3] *Id.* at claims 1-5, 8, 10, and 12.

[4] Ex. 2, Prosecution History at 29-36 (*Claims* (filed Mar. 11, 2013)).

[5] *Id.* at 3-6 (*Preliminary Amendments* (filed Mar. 11, 2013)).

[6] *Id.* at 56-60 (*Preliminary Amendments* (filed Mar. 15, 2013)).

[7] *Id.* at 137-43 (*Non-Final Rejection* (filed May 9, 2014)).

[8] *Id.* at 139-40.

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specification did not provide support for the claim elements "storing computer configuration of a computer in non-transient memory of the computer" and "the license code is used to generate the proper decoding key for accessing essential code resources" for independent claims 58, 69, and 74.[9] The Examiner further rejected claims 58-77 under 35 U.S.C. § 103 as being unpatentable over Holmes (U.S. Patent No. 5,287,407) in view of Eyres (U.S. Patent 6,324,649).[10] Holmes discloses a computer based method for accessing functionality provided by an application software.[11] Eyres discloses a method for prompting a user for a license code during installation or use.[12]

In response to these rejections, Patent Owner amended and added new claims and provided arguments.[13] In response to the § 112 rejection, Patent Owner argued that the specification did not need to literally recite the claim language.[14] Instead, Patent Owner argued that the specification disclosed the claimed concepts and therefore met the written description requirements.[15] Nonetheless, to traverse the rejection, Patent Owner amended the claims and added new dependent claims 78-80 to include the missing concepts at issue.[16] Patent Owner further argued that Holmes in view of Eyres did not render the claims obvious.[17] Patent Owner

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[9] *Id.*

[10] *Id.* at 140-43.

[11] U.S. Patent No. 5,287,407 to Holmes (filed May 23, 1991).

[12] U.S. Patent No. 6,324,649 to Eyres et al. (filed Mar. 2, 1998).

[13] Ex. 2, Prosecution History at 220-27 (*Amendment/Request for Reconsideration After Non-Final Rejection* (filed Oct. 22, 2014)).

[14] *Id.* at 225.

[15] *Id.*

[16] *Id.*

[17] *Id.* at 225-27.

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argued that both Holmes and Eyres do not disclose a personalization data resource that stores both configuration and license code.[18] Patent Owner amended the independent claims to include the element of storing "both computer configuration information . . . and license code."[19]

In response to the amended and new claims and arguments, the Examiner issued a notice of allowance that included an Examiner's amendment adding "said application software in said computer generating a proper decoding key, said generating comprising using said license code" to each independent claim.[20] The Examiner stated in the notice that the prior art of record did not disclose "the limitation of storing in a personalization data resource, both computer configuration information of said computer and a license code which is used to generate a proper decoding key."[21] Original claims 58-62, 67, 69, and 72 correspond to issued claims 1-5, 8, 10, and 12, respectively.

After the notice of allowance, Patent Owner requested amendments to original claims 67, 69, 71, 72, 73, and 75 to clarify issues relating to antecedent basis.[22] The patent issued on April 28, 2015.[23] Later, the PTO issued a certificate of correction to correct errors in issued claims 8, 10, 11, 12, 13, 14, and 15 based on Patent Owner's request filed June 18, 2015.[24]

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[18] *Id.*

[19] *Id.* at 221-27.

[20] *Id.* at 301-88 (*Notice of Allowance* (filed Jan. 13, 2015)).

[21] *Id.* at 308.

[22] *Id.* at 389-94 (*Amendment After Allowance* (filed Feb. 3, 2015)).

[23] U.S. Patent No. 9,021,602 to Moskowitz (filed Mar. 11, 2013).

[24] Ex. 2, Prosecution History at 420-23 (*Request for Certificate of Correction* (filed June 18, 2015)); *id.* at 429 (*Certificate of Correction* (issued Sept. 29, 2015)).

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VII. THE PRIORITY DATE OF THE '602 PATENT

The '602 Patent lists on its face that it is a continuation of four applications.[25] Of those

four applications, Application No. 09/046,627 was filed the earliest in time on March 24, 1998.[26]

Requester does not concede that the '602 Patent is entitled to claim priority to the filing

dates of any of these four applications but assumes for purposes of this proceeding only that the

earliest possible priority date for the '602 Patent is March 24, 1998.

VIII. CLAIM CONSTRUCTION

During reexamination of an unexpired patent, claims are given their "broadest reasonable

interpretation" consistent with the specification.[27] During reexamination of an expired patent,

claims are interpreted pursuant to the principle set forth in *Phillips v. AWH Corp.*, 415 F.3d

1303, 1316 (Fed. Cir. 2005): words of a claim "are generally given their ordinary and customary

meaning" as understood by a person of ordinary skill in the art in question at the time of the

invention.[28]

The '608 Patent claims to be a continuation application to an application filed March 24,

1998.[29] The patent does not appear to be subject to any patent term adjustment under 35 U.S.C. §

154(b).[30] Based on this March 24, 1998 priority date, the '602 Patent expired on March 24,

2018.[31] Thus, the patent's claims should be interpreted pursuant to the *Phillips* standard.

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[25] '602 Patent at [Related U.S. Application Data].

[26] *Id.*

[27] MPEP 2258(G) (citing *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984)).

[28] MPEP 2258(G) (citing *Ex parte Papst-Motoren*, 1 U.S.P.Q.2d 1655 (B.P.A.I. 1986)).

[29] '602 Patent at [Related U.S. Application Data].

[30] *Id.* at [Notice].

[31] 35 U.S.C. § 154(a)(2); MPEP 2701.

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"code resource" (claims 1-5, 10, 12): This term is unclear, and the intrinsic evidence fails to provide any boundaries for it, thus rendering it indefinite. But, because an *ex parte* reexamination request may not challenge a claim based on indefiniteness,[32] Requester uses Patent Owner's construction for this term proposed in the litigation, namely, that this term is subject to its plain and ordinary meaning.[33] The '602 Patents refers to sub-objects, a memory scheduler, and data as examples of code resources.[34]

"data resource" (claims 1, 2, 4, 5, 12): This term is unclear, and the intrinsic evidence fails to provide any boundaries for it, thus rendering it indefinite. But, because an *ex parte* reexamination request may not challenge a claim based on indefiniteness,[35] Requester uses Patent Owner's construction for this term proposed in the litigation, namely, that this term is subject to its plain and ordinary meaning.[36]

"personalization data resource" (claims 1, 10): This term is unclear, and the intrinsic evidence fails to provide any boundaries for it, thus rendering it indefinite. But, because an *ex parte* reexamination request may not challenge a claim based on indefiniteness,[37] Requester uses Patent Owner's construction for this term proposed in the litigation, namely, "serialization data resource."[38]

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[32] MPEP 2258.

[33] Ex. 10, Blue Spike Proposed Constructions at 57-58.

[34] '602 Patent at 11:55-12:4, 15:36-42.

[35] MPEP 2258.

[36] Ex. 10, Blue Spike Proposed Constructions at 58.

[37] MPEP 2258.

[38] Ex. 10, Blue Spike Proposed Constructions at 57-58.

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If Patent Owner establishes that the '602 Patent is unexpired, the above claim

interpretations would nevertheless be the "broadest reasonable interpretation" for the relevant

terms.

IX. THE PRIOR ART PROVIDES NEW, NON-CUMULATIVE TECHNICAL TEACHINGS.

The Patent Office did not consider Beetcher, Beetcher '072, Hicks, and Rhoads

individually or in combination during the original prosecution of the '602 Patent. And the Patent

Office did not consider Cooperman in the new light presented herein. As such, these five

references provide new, non-cumulative teachings that warrant a reexamination of the '602

Patent.

Beetcher was issued on August 3, 1999 based on a U.S. application filed January 29,

1993, which in turn was a continuation application to a U.S. application filed December 14,

1990.[39] Beetcher is a patent granted on a U.S. application by another before the earliest possible

priority date for the '602 Patent and is thus prior art under at least pre-AIA 35 U.S.C. § 102(a)

and § 102(e). As explained in more detail below, Beetcher discloses an apparatus and method of

key-protected software distributed separately from an encrypted entitlement key that enables

execution of the software.[40] Beetcher further discloses storing, in a personalization data resource,

computer configuration information and a license code which is used to generate a proper

decoding key, which the Examiner found was missing from the prior art of record during the

original prosecution.[41] Beetcher's disclosures raise substantial questions as to the validity of

claims 1-5, 8, 10, and 12 of the '602 Patent.

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[39] Beetcher at Date of Patent [45], Filed [22], Related U.S. Application Data [63].

[40] *Id.* at Abstract, 4:3-46.

[41] Ex. 2, Prosecution History at 1944-47 (*Patent Board Decision* (filed Mar. 12, 2015)).

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Beetcher '072 is a Japanese Patent Application Publication published on December 17, 1993.[42] Beetcher '072 is a printed publication published more than one year prior to the earliest possible priority date for the '602 Patent and is thus prior art under at least pre-AIA 35 U.S.C. § 102(a) and § 102(b). Beetcher '072 claims priority to the U.S. application No. 07/629,295,[43] which is the parent application to the Beetcher reference discussed above. This Request refers to Beetcher '072's Japanese disclosures as well as to the corresponding translation of those Japanese disclosures, Ex. 5.[44] As explained in more detail below, Beetcher '072 discloses an apparatus and method of key-protected software distributed separately from an encrypted entitlement key that enables execution of the software.[45] Beetcher '072 further discloses storing, in a personalization data resource, computer configuration information and a license code which is used to generate a proper decoding key, which the Examiner found was missing from the prior art of record during the original prosecution.[46]

Beetcher '072's disclosures raise substantial questions as to the validity of claims 1-5, 8, 10, and 12 of the '602 Patent. These questions are non-cumulative of Beetcher because Beetcher '072 was published more than one year before the earliest potential priority date of the '602 Patent. Thus, it will not be possible for Patent Owner to attempt to ante-date Beetcher '072 by

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[42] Beetcher '072 at Publication Date (43).

[43] *Id.* at Related Application Data (31), (32), (33).

[44] Ex. 5 is a machine translation of Beetcher '072 available at https://www19.j-platpat.inpit.go.jp/PA1/cgi-bin/PA1DETAIL?MaxCount=1000&PageCount=1000&SearchType=0&TempName=w--adaa&MaxPage=1&DispPage=1+1000&HitCount=31&ResultId=I00333004701&CookieId=2&DetailPage=9&Language=ENG&Reserve1=DetailPaging&Reserve2=j60EUdc54_KVb6a06Ieg&Reserve3=/ (last visited April 18, 2018).

[45] Beetcher '072 at Abstract, ¶ 0022.

[46] Ex. 2, Prosecution History at 1944-47 (*Patent Board Decision* (filed Mar. 12, 2015)).

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arguing the named inventor conceived and diligently reduced to practice the invention claimed in the '602 Patent prior to the publication date of Beetcher '072.

Hicks was issued on November 9, 1999 based on a U.S. application filed December 22, 1997.[47] Hicks is a patent granted on a U.S. application by another before the earliest possible priority date for the '602 Patent and is thus prior art under at least pre-AIA 35 U.S.C. § 102(a) and § 102(e). Hicks discloses using an embedded verification key to control unauthorized access to application software, as explained in more detail below.[48] Hicks further discloses storing, in a personalization data resource, computer configuration information and a license code which is used to generate a proper decoding key, which the Examiner found was missing from the prior art of record during the original prosecution.[49] Thus, Hicks' disclosures raise substantial questions as to the validity of claims 1-5, 8, 10, and 12 of the '602 Patent.

Cooperman was published on July 24, 1997[50] and is prior art under at least pre-AIA 35 U.S.C. § 102(a). Cooperman lists on its face inventors Marc Cooperman and Scott Moskowitz. As such, the Cooperman reference is a printed publication "by others," as set forth in pre-AIA § 102(a). This is because the entities identified as the inventors of this reference differ from those of the '602 Patent by at least one person, namely Mr. Cooperman.[51]

While Patent Owner listed Cooperman among the 672 documents provided to the Examiner during the original prosecution,[52] Cooperman presents a substantial new question of

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[47] Hicks at Date of Patent [45], Filed [22].

[48] *Id.* at Abstract, 1:28-64.

[49] Ex. 2, Prosecution History at 1944-47 (*Patent Board Decision* (filed Mar. 12, 2015)).

[50] Cooperman at 1.

[51] MPEP 2132, 2136.

[52] '602 Patent at page 5.

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patentability because this Request presents it in a new light. As set forth in MPEP 2216, a

substantial new question of patentability exists when the pertinent publication raises:

> [Q]uestions of patentability [that] are substantially different from those raised in
> the previous examination of the patent.... The substantial new question of
> patentability may be based on art previously considered by the Office if the
> reference is presented in a new light or a different way that escaped review during
> earlier examination.[53]

During the original prosecution of the '602 Patent, none of the rejections or prior art discussions

refer to Cooperman. The Board has routinely affirmed that a prior art reference cited on the face

of a patent but neither relied upon to reject any claims during the prosecution nor discussed in

the statement of reason for allowance of that patent should not preclude the existence of a

substantial new question of patentability.[54] Here, Cooperman is presented in a new light because

the question of whether Cooperman anticipates claims 1-5, 8, 10, and 12 was not addressed or

resolved during the original prosecution, thus raising a substantial new question regarding

patentability. Accordingly, SNQ-5 in Section X.E. presents a limitation-by-limitation discussion

of Cooperman's teachings that is new and non-cumulative to the original prosecution's record.

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[53] *See also* 35 U.S.C. § 303(a) ("The existence of a substantial new question of patentability is
not precluded by the fact that a patent or printed publication was previously cited by or to the
Office or considered by the Office."); *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008)
("The appropriate test to determine whether a 'substantial new question of patentability' exists
should not merely look at the number of references or whether they were previously considered
or cited but their combination in the appropriate context of a new light as it bears on the question
of the validity of the patent" (quoting H.R. Rep. No. 107-120, at 3)).

[54] *See, e.g.*, *Ex parte Civix DDI LLC*, 2011 WL 4007697, at *12 (B.P.A.I. Sept. 7, 2011) ("[T]he
record reveals that Examiner did engage in a fact-specific inquiry and correctly determined that
the "old art" of Tornetta raises an SNQ. Among other things, the Examiner stated that 'a review
of the prosecution history of application 08/920,044 Reveals that ... 'Tornetta' even though
considered by the Examiner [was] not relied upon to reject any claims during the prosecution of
the '307 patent, nor was it discussed by the examiner of record in the statement of reason for
allowance of that patent.'"); *Ex parte Allied Mach. & Eng'g Corp.*, 2015 WL 5719730, at *6
(P.T.A.B. Sept. 25, 2015) (similar).

Large portions of Cooperman's disclosure are identical to portions of the '602 specification.[55] During the original prosecution, Patent Owner admitted that these portions common to the '602 Patent and Cooperman teach limitations recited in independent claims 1 and 10 of the '602 Patent.[56]

More specifically, Cooperman discloses a method that ensures licensing information is preserved in copies of an original works, including application software, as explained in more detail below.[57] Cooperman further discloses storing, in a personalization data resource, computer configuration information and a license code which is used to generate a proper decoding key, which the Examiner found was missing from the prior art of record during the original prosecution.[58]

Moreover, the prosecution history indicates that the Examiner limited his EAST prior art search using application filing date limiters, as shown and annotated below (dashed box).[59] Such limiters would result in excluding the application and publications dates for PCT application publications like Cooperman. This is because it appears that the Derwent, EPO, IBM, and FPRS databases do not populate the "ad" and "rlad" search fields for PCT application publications.[60] As such, Cooperman would have escaped the Examiner's prior art search.

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[55] *E.g.*, *compare* Cooperman at 11:9-12:2 *with* '608 Patent at 13:45-14:6.

[56] Ex. 2, Prosecution History at 225-26 (original claims 58 and 69 issued as claims 1 and 10, respectively).

[57] Cooperman at Abstract, 5:25-6:9.

[58] Ex. 2, Prosecution History at 1944-47 (*Patent Board Decision* (filed Mar. 12, 2015)).

[59] *Id.* at 448-57, 547-57, 863-69 (*Examiner Search Strategies and Results* (filed Apr. 1, 2011, Sept. 20, 2011, June 4, 2015)).

[60] The "@ad" term refers to application filing date, and "@rlad" term refers to related application filing date.

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EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S16	2673	g06f21/121.g06f21/16.cpc.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	AND	ON	2014/04/30 14:25
S17	377	g06f21/121.g06f21/16.cpc. and (@ad<"19980324" or @rlad<"19980324")	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	AND	ON	2014/04/30 14:27
S18	24	g06f21/121.g06f21/16.cpc. and (license near3 key) and (@ad<"19980324" or @rlad<"19980324")	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	AND	ON	2014/04/30 14:28
S19	2	g06f21/121.g06f21/16.cpc. and (license with watermark) and (@ad<"19980324" or @rlad<"19980324")	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO; DERWENT; IBM_TDB	AND	ON	2014/04/30 14:41

Thus, Cooperman's disclosures raise substantial questions as to the validity of claims 1-5, 8, 10, and 12 of the '602 Patent.

Rhoads was issued on April 28, 1998 based on a U.S. application filed March 15, 1996.[61] Rhoads is a patent granted on a U.S. application by another before the earliest possible priority date for the '602 Patent, and is thus prior art under at least pre-AIA 35 U.S.C. § 102(a) and § 102(e). Rhoads discloses encoding software data using a steganographic technique, as explained in more detail below.[62] As such, Rhoads' disclosures raise a substantial question as to validity of claims 3 and 4 of the '602 Patent.

During the original prosecution of the '602 Patent, no consideration was given as to whether Beetcher, Beetcher '072, Hicks, or Cooperman anticipates claims 1-5, 8, 10, and 12,

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[61] Rhoads at Date of Patent [45], Filed [22].

[62] *Id.* at Abstract, 2:43-3:5, claim 1.

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including storing, in a personalization data resource, computer configuration information and a

license code used to generate a proper decoding key, which the Examiner found missing from the

prior art of record during the original prosecution. And no consideration was given to the

combination of Rhoads and any of the other references during the original prosecution, which

renders obvious claims 3 and 4.

Each of Beetcher, Beetcher '072, and Hicks anticipates all elements of claims 1, 2, 5, 8,

10, and 12, including storing, in a personalization data resource, computer configuration

information and a license code which is used to generate a proper decoding key. And Cooperman

anticipates all elements of claims 1-5, 8, 10, and 12, including storing, in a personalization data

resource, computer configuration information and a license code which is used to generate a

proper decoding key.

Moreover, the combination of Beetcher and Rhoads renders obvious claims 3 and 4.

Similarly, the combination of Beetcher '072 and Rhoads renders obvious claims 3 and 4. And the

combination of Hicks and Rhoads renders obvious claims 3 and 4.

The substantial new questions of patentability under 37 C.F.R. § 1.510(b)(1) presented in

this Request are listed below and based on the five prior art references Beetcher, Beetcher '072,

Hicks, Cooperman, and Rhoads that were not the subject of any final decision by the Patent

Office or court:

No.	Substantial New Questions of Patentability of the '602 Patent
1	Claims 1, 2, 5, 8, 10, and 12 are anticipated by Beetcher under pre-AIA 35 U.S.C. §§ 102(a), (e).
2	Claims 3 and 4 are rendered obvious by the combination of Beetcher and Rhoads under pre-AIA 35 U.S.C. § 103(a).
3	Claims 11, 12, 13, and 14 are anticipated by Beetcher '072 under pre-AIA 35 U.S.C. §§ 102(a), (b).

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4	Claims 3 and 4 are rendered obvious by the combination of Beetcher '072 and Rhoads under pre-AIA 35 U.S.C. § 103(a).
5	Claims 11, 12, 13, and 14 are anticipated by Cooperman under pre-AIA 35 U.S.C. § 102(a).
6	Claims 1-5, 8, 10, and 12 are anticipated by Hicks under pre-AIA 35 U.S.C. §§ 102(a), (e).
7	Claims 3 and 4 are rendered obvious by the combination of Hicks and Rhoads under pre-AIA 35 U.S.C. § 103(a).

X.   DETAILED EXPLANATION UNDER 37 C.F.R. 1.510(b)(2)

A.   SNQ-1: Claims 1, 2, 5, 8, 10, and 12 are Anticipated by Beetcher Under 35 U.S.C. §§ 102(a), (e).

Beetcher anticipates claims 1, 2, 5, 8, 10, and 12 under 35 U.S.C. §§ 102(a), (e).

1.   Beetcher Anticipates Independent Claim 1.

a)   *Preamble*: "A computer based method for accessing functionality provided by an application software comprising"

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless, Beetcher discloses claim 1's preamble. Specifically, Beetcher describes a method for accessing an application's functionality using an encrypted entitlement key 111.[63] Beetcher, for instance, explains that the application software is accessible using the key:

> A customer enters entitlement key 111 into computer system 101 via console 109 at step 901. If this is an initial installation, install input routine 440 interacts with the operator to receive the input; otherwise general input routine 441 receives the input. The entitlement key is passed to unlock routine 430, which handles the decoding process.[64]

Beetcher illustrates the initial access of the encoded application software in Figure 9a, shown below:

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[63] Beetcher at 9:39-43, 9:51-56, Figs. 1, 9a.

[64] *Id.* at 9:51-56.

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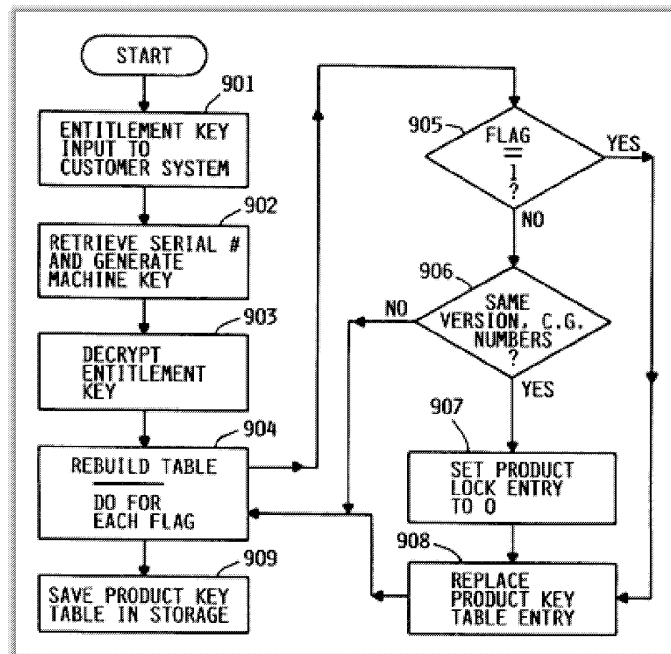
Input of Beetcher's entitlement key results in the decryption of the key for storage in the

computer system's product key table 450/460.[65] Once the key has been stored in the system's

product key table, the system uses the key to decode a series of entitlement triggering

instructions 301 encoded in code resources[66] controlling the software's functionality:

> For support of such a traditional compilation path where the object code format is
> known by customers, additional barriers to patching of the object code to nullify or
> alter the entitlement triggering instructions may be appropriate. One such additional
> barrier would be to define the entitlement triggering instruction to simultaneously
> perform some other function. In this case, it is critical that the alternative function
> performed by the triggering instruction can not be performed by any other simple
> instruction. The alternative function must be so selected that any compiled software
> module will be reasonably certain of containing a number of instructions
> performing the function. If these criteria are met, the compiler can automatically
> generate the object code to perform the alternative function (and simultaneously,

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[65] *E.g., Id.* at 9:57-10:19.

[66] Requester interprets the term "code resources" as best understood based on the '602 Patent and prosecution history.

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the entitlement verification trigger) as part of its normal compilation procedure. This definition would provide a significant barrier to patching of the object code to nullify the entitlement triggering instructions.[67]

Beetcher further explains that "the triggering instruction is also a direct instruction to perform some other useful work …. [E]xecution of the triggering instruction causes system 101 to perform some other operation simultaneous with the entitlement verification."[68] Moreover, Beetcher's Figure 10 shows the process of executing application functions based on confirmation of the correct entitlement key for the application:[69]

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[67] Beetcher at 11:10-28; *see also id.* at Abstract, 3:14-18, 4:25-33, 11:11-39.

[68] *Id.* at 6:58-65 (Beetcher specifies that these functions are those "which do not require that an operand for the action be specified in the instruction.").

[69] *Id.* at 10:48-11:3.
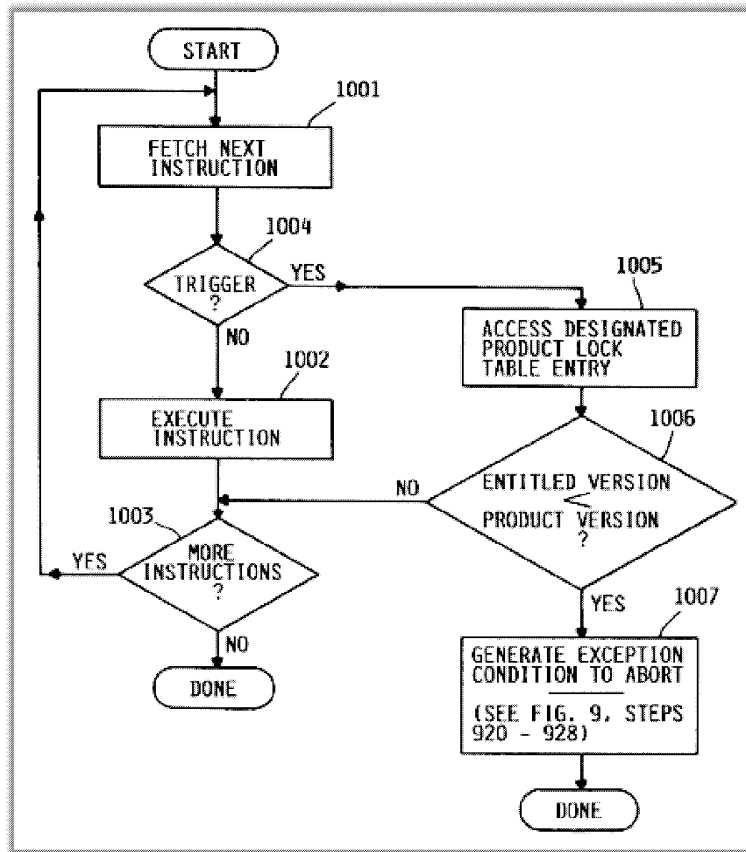
21

As such, Beetcher teaches this preamble.

    b)   ***Element 1.1***: **"storing said application software in non transient memory of a computer"**

Beetcher discloses element 1.1. Beetcher describes that the customer initially receives the protected application software on an optical disk 112.[70] As shown below in annotated Figure 1, the customer inserts disk 112 into reader 110 (dashed oval) and stores the software on storage devices 106-108 (dashed box):[71]

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[70] *Id.* at 6:7-15; *see also id.* at Abstract, 3:48-50, 9:51-55, Fig. 1, claim 6.

[71] *Id.* at 5:17-26, 6:7-15, Fig. 1.

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FIG. I
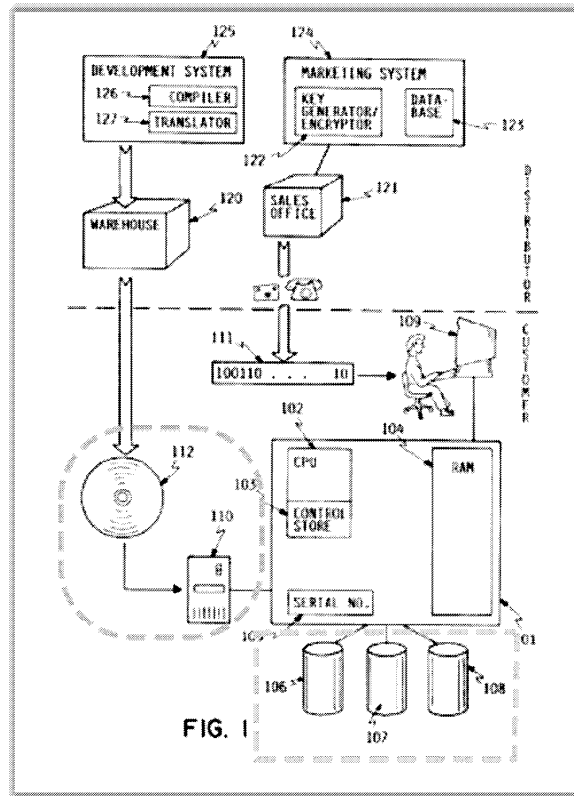
Beetcher specifies that storage devices 106-108 may be "rotating magnetic disk drive storage

units."[72] A POSITA would have understood that Beetcher's storage devices are non-transient

memory of the computer because, as expert Dr. Silva explains in his declaration (Ex. 9), such

storage devices necessarily include non-transient memory.[73]

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[72] *Id.* at 5:25-28.

[73] Silva Declaration at ¶¶ 45-46.

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      c)   ***Element 1.2*: "said application software in said computer prompting a user to enter into said computer personalization information"**

Beetcher discloses element 1.2. Beetcher describes its customer's computer as having an operator console 109 shown with a monitor and keyboard that "can receive input from an operator."[74] And Beetcher explains that its application software includes user interface routine for the customer to input a license key into the computer before the product can be used.[75] For instance, Beetcher explains that the software product prompts the user to input the key:

> This operation system support at **virtual machine level 404 contains two user interface routines needed to support input of the entitlement key**. General input routine 441 is used to handle input during normal operations. In addition, **special install input routine 440 is required to input the key during initial installation of the operating system.** This is required because that part of the operating system above machine interface level 405 is treated for purposes of this invention as any other program product; it will have a product number and its object code will be infected with entitlement verification triggers.[76]

Beetcher further explains that the software's "install input routine 440 interacts with the operator to receive the input" of the customer's license information during the software's initial installation.[77] Accordingly, a POSITA would have understood Beetcher's application software prompts a user to enter the key into the computer.[78]

Moreover, Beetcher discloses that its entitlement key 111 includes information relating to the customer's personal information and computer's serial number.[79] Beetcher, for instance,

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[74] Beetcher at 3:25-28, Fig. 1.

[75] *Id.* at 7:66-8:8; *see also id.* at 3:25-28.

[76] *Id.* at 7:66-8:8.

[77] *Id.* at 9:51-55; *see also id.* at Fig. 4 (reference number 440), claim 6.

[78] Silva Declaration at ¶¶ 49-50.

[79] Beetcher at 5:43-50, 9:30-42; *see also id.* at 4:4-13, 6:20-40.

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explains that the software distributor has "an entitlement key generator/encryptor 122 and a

database 123 containing customer information."[80] Beetcher further details:

> Upon receipt of the customer's order, key generator/encryptor 122 executing on System 124 would access database 123 containing information about the customer, particularly the serial number and processor type of his machine, at step 802. This information is used to generate charge group field 201 and machine serial number field 204 of the unencrypted entitlement key 200. The remaining fields are generated by reference to the customer order and a database of possible product number offerings, building the complete unencrypted key at step 803. Key generator/encryptor 122 then encrypts the key … at step 804.[81]

The key includes the customer's charge group 505 indicating the customer's machine tier and

tier pricing.[82] Figure 8 illustrates the generation of the customer's entitlement key based on the
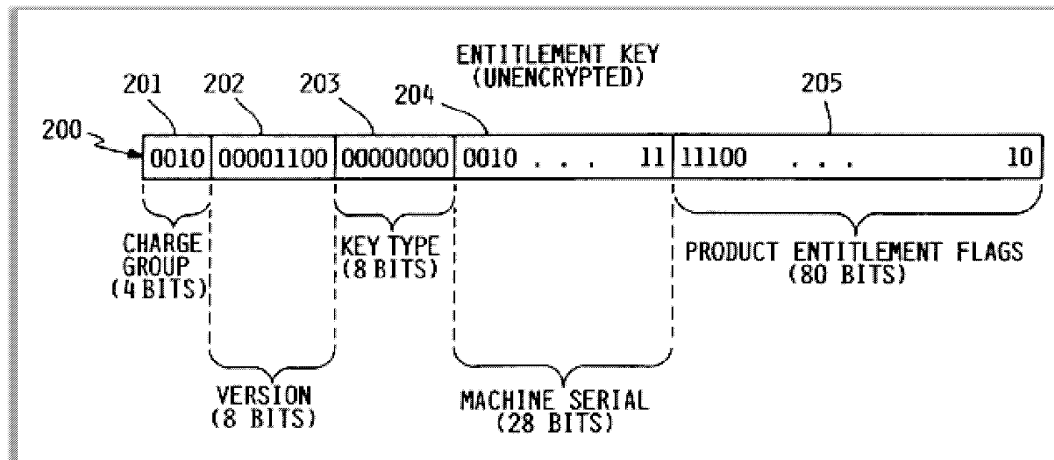
customer's personalization information:

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[80] *Id.* at 5:45-46.

[81] *Id.* at 9:30-42.

[82] *Id.* at 6:24-27, 8:28-36.

25
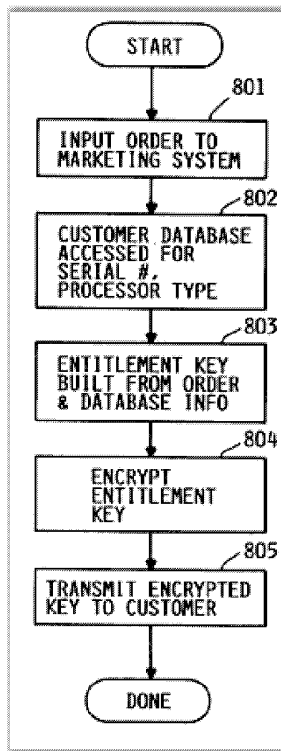
Beetcher's Figure 2 further details the parts of the customer's entitlement key including

the personalization information relating to the customer's machine serial number and the

customer's charge group and accessible software versions and product numbers:

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Accordingly, a POSITA would have understood that Beetcher's key, entered into the computer by the customer, contains computer personalization information.[83]

        d)   *Element 1.3*: **"said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting"**

Beetcher discloses element 1.3. Beetcher's entitlement key 111/200 includes information detailing which software version and product numbers the customer's entitled to access,[84] as discussed regarding element 1.2. And in Figure 2, Beetcher illustrates that the key includes license information corresponding to license code information stored in the application software:

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[83] Silva Declaration at ¶¶ 51-54.
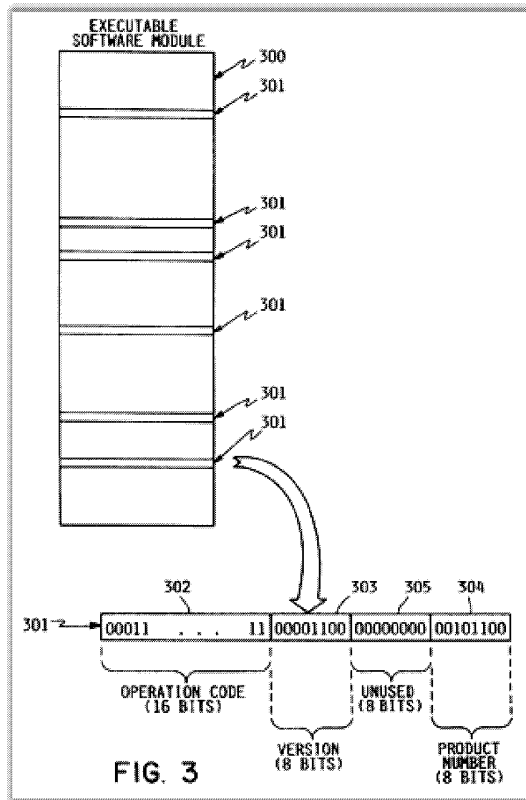
[84] Beetcher at 6:22-40.
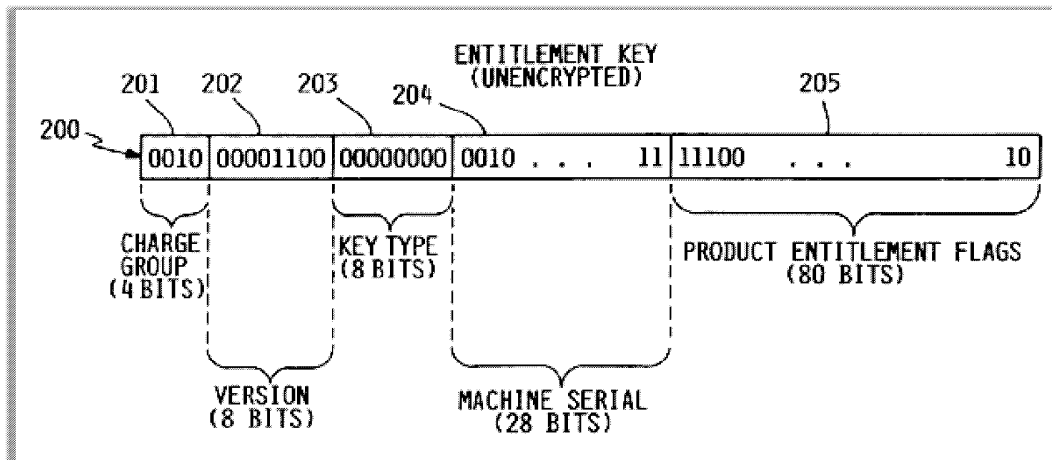
Regarding the license information in the application software, Beetcher explains that its software includes data resources[85] that correspond to the software's functions.[86] And Beetcher describes a series of entitlement triggering instructions 301 located in the software that must be verified to access software functions.[87] These triggering instructions each contains license code information that aligns with the entitlement key entered by the customer when prompted. Each triggering instruction 301 includes fields, for example, version 303 and product number 304, as shown in Figure 3 provided below:

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[85] Requester interprets the term "data resources" as best understood based on the '602 Patent and prosecution history.

[86] Beetcher at 6:58-65, 11:10-39; *see also id.* at Abstract, 3:14-18, 4:25-33.

[87] *Id.* at 6:41-58, 11:4-39; *see also id.* at 4:14-23, 8:5-22, 8:56-9:20; Silva Declaration at ¶¶ 57-58.

FIG. 3

Specifically, each triggering instruction 301 begins with operation code field 302 ("the verb portion of the object code instruction, identifying the operation to be performed").[88] This field is followed by version level field 303 and product number field 304 that uniquely identify the customer's entitled versions and product numbers of the software.[89] A POSITA would have thus understood the uniquely identifying information to be a serialization data resource, which corresponds to the claimed "personalization data resource," as that term is best understood.[90]

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[88] Beetcher at 6:48-52.

[89] *Id.* at 6:48-55.

[90] Silva Declaration at ¶¶ 57-59.

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Beetcher further discloses that triggering instruction 301 includes computer configuration information to control software functionality separate from entitlement verification:

> For support of such a traditional compilation path where the object code format is known by customers, additional barriers to patching of the object code to nullify or alter the entitlement triggering instructions may be appropriate. **One such additional barrier would be to define the entitlement triggering instruction to simultaneously perform some other function. In this case, it is critical that the alternative function performed by the triggering instruction can not be performed by any other simple instruction.** The alternative function must be so selected that any compiled software module will be reasonably certain of containing a number of instructions performing the function. If these criteria are met, the compiler can automatically generate the object code to perform the alternative function (and simultaneously, the entitlement verification trigger) as part of its normal compilation procedure. This definition would provide a significant barrier to patching of the object code to nullify the entitlement triggering instructions.[91]

Beetcher also specifies the triggering instruction is "a direct instruction to perform some other useful work (from among those instructions which do not require that an operand for the action be specified in the instruction).... [E]xecution of the triggering instruction causes system 101 to perform some other operation simultaneous with the entitlement verification."[92] A POSITA would have understood that the computer's information for the "direct instruction to perform...useful work" includes computer configuration information as this information guarantees the software only works for the licensed computer.[93]

As such, a POSITA would have understood that Beetcher's software includes a personalization data resource with a license code (certain triggering instruction and entitlement key fields) and computer configuration information (functionality information).[94] And as described with respect to elements 1.1 and 1.2, Beetcher's software is stored in non-transient

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[91] Beetcher at 11:10-28; *see also id.* at Abstract, 3:14-18, 4:25-33, 6:58-65, 11:11-39.

[92] *Id.* at 6:58-65.

[93] Silva Declaration at ¶¶ 60-61.

[94] *Id.* at ¶ 62.

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memory, and the key corresponding to the triggering instruction is entered in response to the

computer's prompting.

e) *Element 1.4*: "said application software in said computer
generating a proper decoding key, said generating comprising
using said license code"

Beetcher discloses element 1.4. As discussed with respect to element 1.3, Beetcher

explains its application software includes triggering instructions 301 that contain license code

information.[95] These triggering instructions are part of the executable software module, as shown

in Figure 3 provided below:

FIG. 3

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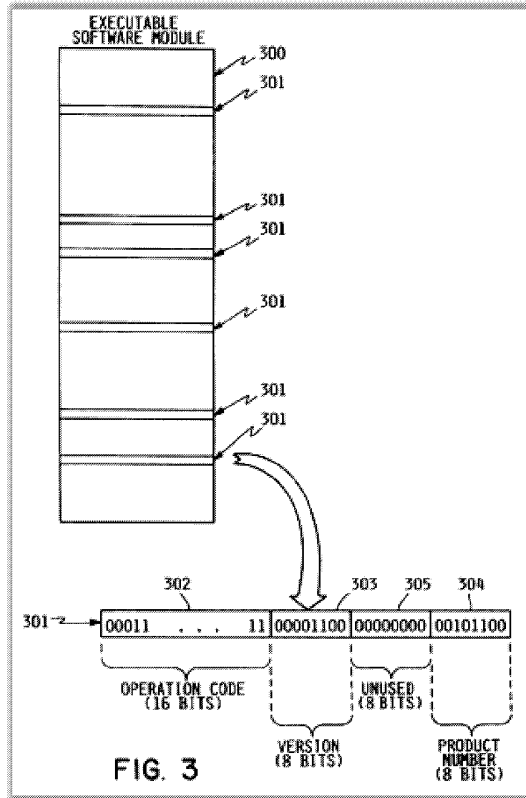
[95] Beetcher at 6:41-58, 11:4-39; *see also id.* at 4:14-23, 8:5-22, 8:56-9:20.

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Beetcher details that the customer enters entitlement key 111 in response to the prompt initiated by install input routine 440.[96] After entering that key, Beetcher teaches that the customer's computer generates a decode key to initiate unlock routine 430 to decode license code information in the entitlement key.[97] Beetcher shows the decoded entitlement key in Figure 2. And Beetcher's Figures 4 and 9a, which are provided below, illustrate the decoding of the entitlement key and populating tables with license code information contained in the decoded entitlement key. For instance, annotated Figure 4 illustrates that the install input routine 440 starts unlock routine 430 once the customer inputs key 111 into the computer.[98] And "[u]nlock routine 430 uses the unique machine key to decode[] entitlement key 111" (dashed perimeter):[99]

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[96] *Id.* at 7:66-8:8; *see also id.* at 9:51-55, Figs. 1, 4, claim 6.

[97] *Id.* at 7:39-42, 9:49-60; *see also id.* at 6:66-7:5, 8:60-62 Figs. 4, 9a.

[98] *Id.* at 8:3-13, 9:52-60.

[99] *Id.* at 7:39-42; *see also id.* at 8:62-62; 10:27-36.

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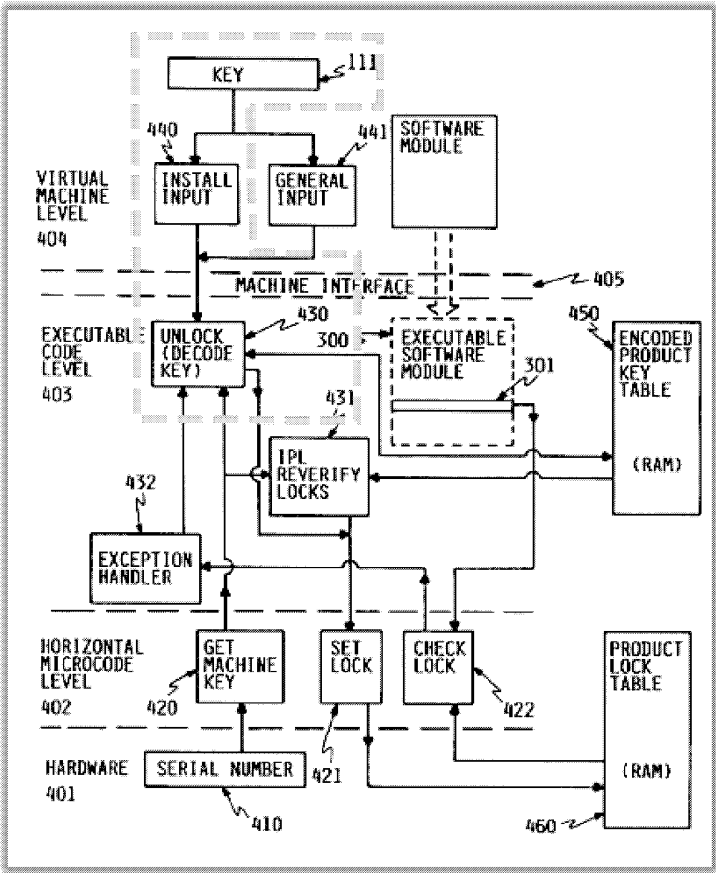
Beetcher details that unlock routine 430 "handles the decoding process," which is illustrated in Figure 9a's steps 902-909: "Unlock routine 430 causes get machine key function 420 to retrieve the machine serial number and generate the machine key at 902. Unlock routine 430 then uses the machine key to decode the entitlement key 111 at step 903."[100] Beetcher's unlock routine 430 will complete the decoding process by building an encoded product key table

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[100] *Id.* at 9:57-60.

(step 904), populating the key table for the relevant software product (steps 905-908), and saving

the key table (step 909),[101] as shown in Figure 9a:
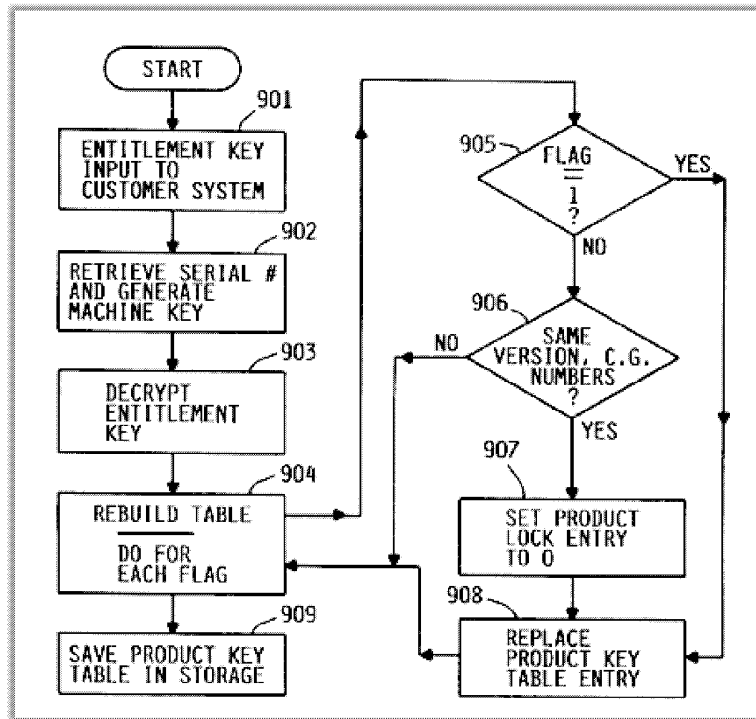
Based on unlock routine 430, Beetcher's decoding process populates key table 450 with

license code information unique to the customer's entitled software products.[102] And Beetcher

discloses that the customer's RAM includes table 460 for storing and identifying the products for

which the customer has entered entitlement keys.[103] Beetcher explains that its software uses

tables 450 and 460 when the software encounters one of the triggering instructions 301, which

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[101] *Id.* at 9:60-10:19.

[102] *Id.* at 10:2-19, 10:22-39.

[103] *Id.* at 7:42-44, 8:43-52, 10:20-47, Fig. 6, Fig. 9a.

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then requires verification of the license code information.[104] As Beetcher details, the system

checks the execution privileges whenever the software encounters a triggering instruction and

either confirms tables 450/460 includes the proper licensing information or aborts if that

information is missing from the tables.[105] And to avoid illicit software patches, Beetcher explains

each triggering instruction includes instructions for performing additional software functionality

that cannot be performed by other instructions.[106] As such, a POSITA would have understood

that Beetcher's system uses its license code to generate a decoding key and that the triggering

instruction's control over additional software functionality includes generating such a decoding

key.[107]

> f)   *Element 1.5*: **"wherein said application software, in said
> computer, cannot access at least one encoded code resource of
> said application software, unless said license code is stored in
> said personalization data resource"**

Beetcher discloses element 1.5. As explained with respect to element 1.3, Beetcher

specifies that the software cannot access certain functionalities unless the computer has stored

the license code information contained in the triggering instruction:

> For support of such a traditional compilation path where the object code format is
> known by customers, additional barriers to patching of the object code to nullify or
> alter the entitlement triggering instructions may be appropriate. **One such
> additional barrier would be to define the entitlement triggering instruction to
> simultaneously perform some other function. In this case, it is critical that the
> alternative function performed by the triggering instruction can not be
> performed by any other simple instruction.** The alternative function must be so
> selected that any compiled software module will be reasonably certain of containing
> a number of instructions performing the function. If these criteria are met, the
> compiler can automatically generate the object code to perform the alternative
> function (and simultaneously, the entitlement verification trigger) as part of its

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[104] *Id.* at 10:48-11:39; *see also id.* at Abstract, 8:14-22, 8:53-9:20, Fig. 10.

[105] *Id.* at 10:48-11:39, 8:53-9:20, Fig. 10.

[106] *Id.* at 11:11-19.

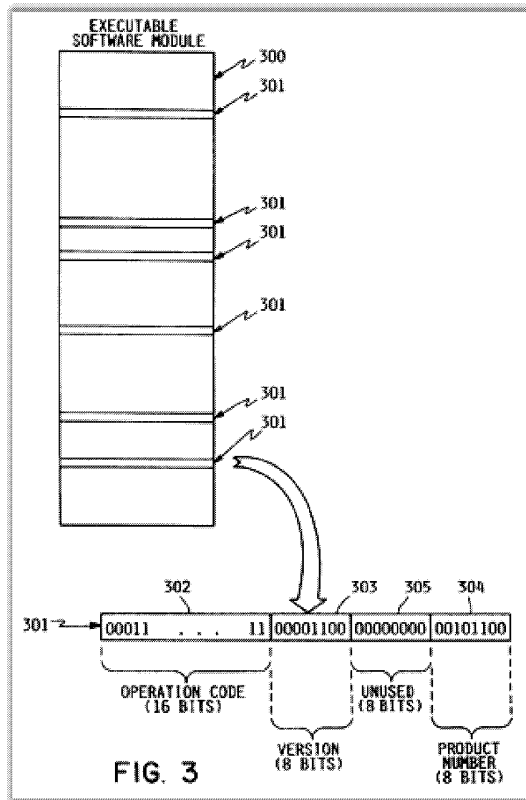[107] Silva Declaration at ¶¶ 65-69.

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normal compilation procedure. This definition would provide a significant barrier
to patching of the object code to nullify the entitlement triggering instructions.[108]

Beetcher also specifies the triggering instruction is "a direct instruction to perform some other

useful work (from among those instructions which do not require that an operand for the action

be specified in the instruction).... [E]xecution of the triggering instruction causes system 101 to

perform some other operation simultaneous with the entitlement verification."[109] And as

explained with respect to element 1.4, the triggering instructions are included in the software

product. Figure 3 illustrates encoded code resources[110] of an executable software module, which

include the series of triggering instructions 301 that contain the license code information:

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[108] Beetcher at 11:10-28; *see also id.* at Abstract, 3:14-18, 4:25-33, 6:58-65, 11:11-39.

[109] *Id.* at 6:58-65.

[110] Requester interprets the term "code resources" as best understood based on the '602 Patent
and prosecution history.

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FIG. 3

As such, a POSITA would have understood that Beetcher's software installed in the customer's computer cannot access at least one encoded code resource unless the license code is stored in the personalization data resource.[111]

Accordingly, Beetcher discloses claim 1.

2. Beetcher Anticipates Dependent Claim 2.

Beetcher discloses "*wherein said encoded code resource is encoded in at least one data resource*," as recited in claim 2.[112] Beetcher describes embedding the triggering instructions 301

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[111] Silva Declaration at ¶¶ 72-74

[112] Claim 2 depends upon claim 1.

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into the software object code: "[A] number of entitlement verification triggering instructions 301 are embedded in the object code... [T]he triggering instruction is also a direct instruction to perform some other useful work … [E]xecution of the triggering instruction causes system 101 to perform some other operation simultaneous with the entitlement verification."[113] And Beetcher teaches storing license code information in tables 450 and 460 based on the entitlement key 111.[114]

Beetcher also describes multiple data resources in the software, namely, executable software modules, like the module shown below in annotated Figure 3. Beetcher's Figure 4 also shows the software modules 300. A POSITA would have understood that Beetcher's tables 450/460 identify code resources to be recovered and the corresponding keys to decrypt the software.[115] And overall, a POSITA would have understood that the inclusion of the triggering instructions into the software corresponds to encoding a code resource in a data resource.[116]

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[113] Beetcher at 6:45-65.

[114] *Id.* at 9:49-10:19.

[115] Silva Declaration at ¶¶ 77-78.

[116] *Id.* at ¶ 78. Requester interprets the terms "code resource" and "data resources" as best understood based on the '602 Patent and prosecution history.

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FIG. 3
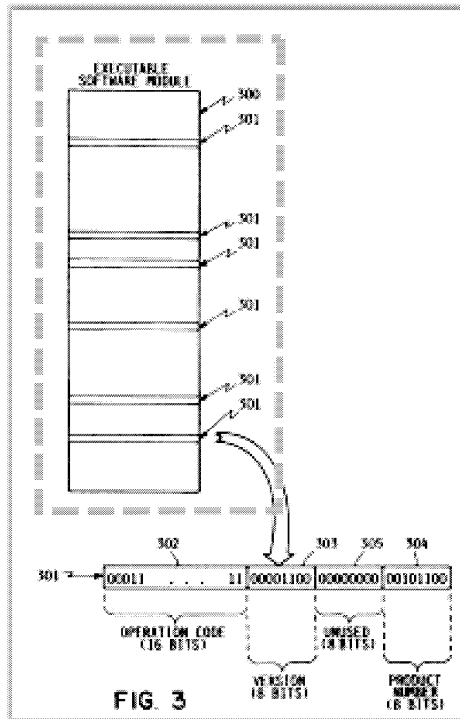
Accordingly, Beetcher discloses claim 2.

3.   **Beetcher Anticipates Dependent Claim 5.**

Beetcher discloses "*wherein said computer configuration information is stored in a*

data resource," as recited in claim 5.[117] As discussed with respect to element 1.3, Beetcher's

data resource includes computer configuration information. For instance, Beetcher explains that

the triggering instruction can be "a direct instruction to perform some other useful work (from

among those instructions which do not require that an operand for the action be specified in the

instruction).... [E]xecution of the triggering instruction causes system 101 to perform some other

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[117] Claim 5 depends upon claim 1.

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operation simultaneous with the entitlement verification."[118] A POSITA would have understood

that the computer's information for the "direct instruction to perform...useful work" includes

computer configuration information.[119] And Beetcher details that the triggering information,

which includes the computer configuration information, is compiled and translated into the

software, as shown below in Figure 3.[120] As such, a POSITA would have understood this process

stores the computer configuration information in the data resource.[121]

FIG. 3

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[118] Beetcher at 6:58-65.

[119] Silva Declaration at ¶ 81.

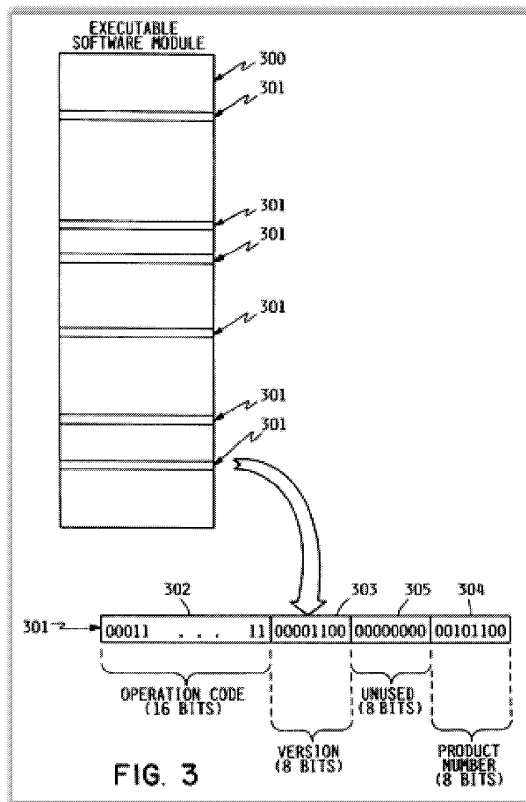[120] Beetcher at 9:1-20, 11:10-28.

[121] Silva Declaration at ¶ 81.

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Accordingly, Beetcher discloses claim 5.

4. Beetcher Anticipates Dependent Claim 8.

Beetcher discloses "*wherein said computer comprises a processor and said application software using said processor in said prompting and said [application software][122] storing,*" as recited in claim 8.[123] Specifically, Beetcher teaches that its computer has a processor 102 used by the computer's application software.[124] Beetcher's Figure 1 illustrates this processor 102 (dashed box) used by the software when prompted via console 109 and for storage in device 106-108:
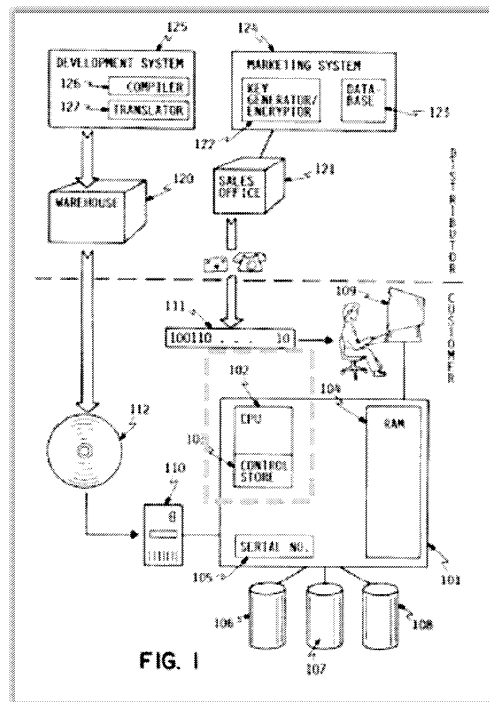
FIG. 1

Accordingly, Beetcher discloses claim 8.

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[122] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[123] Claim 8 depends upon claim 1.

[124] Beetcher at 5:14-21, Fig. 1.

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5.   Beetcher Anticipates Independent Claim 10.

  a) *Preamble*: **"A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising"**

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless, Beetcher discloses claim 10's preamble. Beetcher describes application software code that is a computer program.[125] And this code is stored in a non-transitory storage media, such as optical disk 112.[126] When run by customer's computer 101, the computer will access the software production's functionality if the proper license key has been entered.[127]

The customer's system configuration is illustrated in Beetcher's Figure 1, annotated below:

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[125] *Id.* at 5:65-6:7, 9:1-20.

[126] *Id.* at 6:7-15; *see also id.* at Abstract, 3:48-50, 9:51-55, Fig. 1, claim 6.

[127] *Id.* at 8:53-67, 10:22-38; Silva Declaration at ¶ 88.
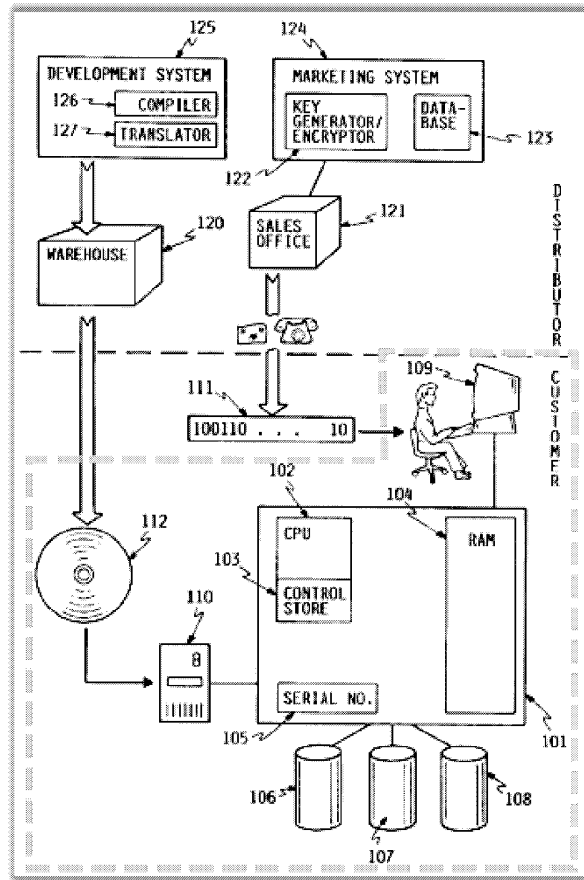
42

As such, Beetcher teaches this preamble.

    b)   **Element 10.1: "storing said application software code in non transient memory of [said][128] computer system"**

Element 10.1 is substantially similar to element 1.1. As explained above, Beetcher

discloses each limitation of element 1.1. For the same reasons, Beetcher teaches element 10.1.

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[128] Ex. 2, Prosecution History at 429 (Certificate of Correction).

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      c)   **Element 10.2: "said application software code in said computer system prompting a user to enter into said computer system personalization information"**

Element 10.2 is substantially similar to element 1.2. As explained above, Beetcher

discloses each limitation of element 1.2. For the same reasons, Beetcher teaches element 10.2.

      d)   **Element 10.3: "said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting"**

Element 10.3 is substantially similar to element 1.3. As explained above, Beetcher

discloses each limitation of element 1.3. For the same reasons, Beetcher teaches element 10.3.

      e)   **Element 10.4: "said application software code in said computer system generating a proper decoding key, said generating comprising using said license code"**

Element 10.4 is substantially similar to element 1.4. As explained above, Beetcher

discloses each limitation of element 1.4. For the same reasons, Beetcher teaches element 10.4.

      f)   **Element 10.5: "wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource"**

Element 10.5 is substantially similar to element 1.5. As explained above, Beetcher

discloses each limitation of element 1.5. For the same reasons, Beetcher teaches element 10.5.

Accordingly, Beetcher discloses claim 10.[129]

      6.   Beetcher Anticipates Dependent Claim 12.

Beetcher discloses "*wherein said computer program product causes storing of said*

encoded code resource in a data resource in non transient memory of said computer

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[129] Silva Declaration at ¶ 101; *see also id.* at ¶¶ 91-100.

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[system],"[130] as recited in claim 12.[131] Beetcher describes embedding the triggering instructions

301 into the software object code: "[A] number of entitlement verification triggering instructions

301 are embedded in the object code… [T]he triggering instruction is also a direct instruction to

perform some other useful work … [E]xecution of the triggering instruction causes system 101

to perform some other operation simultaneous with the entitlement verification."[132] And

Beetcher teaches storing license code information in tables 450 and 460 based on the entitlement

key 111.[133]

Accordingly, a POSITA would have understood that the inclusion of the triggering

instructions in the software corresponds to encoding a code resource in a data resource.[134] As

described with respect to elements 1.1 and 10.1, Beetcher's software code is stored in non-

transient memory of the customer's computer.

Accordingly, Beetcher discloses claim 12.

B.   **SNQ-2: Claims 3 and 4 are Rendered Obvious by the Combination of
        Beetcher and Rhoads Under 35 U.S.C. § 103(a).**

The combination of Beetcher and Rhoads renders obvious claims 3 and 4 under 35

U.S.C. § 103(a). Specifically, Beetcher in view of Rhoads renders obvious:

- Claim 3: "The method of claim 1 wherein said encoded code resource is
  steganographically encoded."

- Claim 4: "The method of claim 3 wherein said encoded code resource is encoded
  in a data resource."

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[130] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[131] Claim 12 depends upon claim 10.

[132] Beetcher at 6:45-65.

[133] *Id.* at 9:49-10:19.

[134] Silva Declaration at ¶¶ 103-04.

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As explained with respect to claim 2, Beetcher describes encoding the code resource in at least one data resource. While Beetcher teaches encoding a code resource, it does not expressly describe encoding the code resource using steganographic encoding. But this type of encoding was known in the art and would have been obvious to use in Beetcher's system.

Specifically, Rhoads describes encoding licensing information into software using steganographic encoding. For instance, Rhoads teaches generating a software component, like an image or graphic, encoded steganographically to include a 16-bit main identification number.[135] And Rhoads teaches that this steganographic encoding technique embeds identification information into a data source, such as an image, without a perceptible decrease in fidelity.[136]

Rhoads explains this method of steganographic encoding in its claim 1:

In a method of image processing that includes processing an input image to steganographically encode a multi-bit message code therein, thereby yielding an encoded output image, and thereafter processing suspect data corresponding to said encoded output image to decode the message code therefrom, an improvement including:

encoding the message code redundantly through the image data...; and

decoding the message code from said suspect data without reference to said input image, ... and analyzing said transformed data.[137]

Moreover, Rhoads details the use of steganographic encoding in applications that use an identification key to determine whether to execute a particular code resource such as word processor applications:

[S]ome applications can utilize a universal set of individual embedded code signals, i.e., codes which remain the same for all instances of distributed material, This type of requirement would be seen by systems which wish to hide the N-bit identification word itself, yet have standardized equipment be able to read that word. This can be used in systems which make go/no go decisions at point-of-read locations.... Use

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[135] Rhoads at 6:62-67, 7:45-51, 8:44-9:4, claim 1; *see also id.* at 11:45-62, Figs 2-3.

[136] *Id.* at 2:49-59, 5:31-39.

[137] *Id.* at claim 1; *see also id.* at claims 2, 8, 12.

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of the Invention in ... Documents ... and Other Material Where Global Embedded Codes Can Be Imprinted."[138]

In view of Rhoads' teachings, a POSITA would have found it obvious to use a form of steganographic encoding when encoding Beetcher's encoded code resource.[139] For instance, a POSITA would have found it obvious to encode steganographic license information into one of the graphics used in Beetcher's software applications.[140] A POSITA would have been motivated to do so because Rhoads teaches steganographically encoding identification information into a data source, such as an image, without a perceptible decrease in the quality of the data resource.[141]

Moreover, using steganographic encoding to encode Beetcher's code resource would simply be a matter of design choice selected from a finite number of predictable encoding solutions with a reasonable expectation of success.[142] A POSITA would have recognized the number of predictable solutions to encode Beetcher's code resource to include steganographic encoding. For instance, the '602 Patent specifies that steganographically encoding was known in the art:

> As described in previous disclosures, "Steganographic Method and Device" and "Human Assisted Random Key Generation and Application for Digital Watermark System," watermarks are particularly suitable to the identification, metering, distributing and authenticating digitized content such as pictures, audio, video and derivatives thereof under the description of" multimedia content." Methods have been described for combining both cryptographic methods, and steganography, or hiding something in plain view.[143]

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[138] *Id.* at 14:26-33, 14:40-43.

[139] Silva Declaration at ¶¶ 108-12.

[140] *Id.* at ¶ 112.

[141] Rhoads at 2:49-59, 5:31-39; Silva Declaration at ¶ 112.

[142] Silva Declaration at ¶ 113.

[143] '602 Patent at 3:14-23; *see also id.* at 6:15-40, 8:35-40, 12:29-31, 14:25-30.

Similarly, Cooperman details that using steganographic encoding to encode a code resource was known in the art:

> These keys make it impossible for a party to find the watermark without having the key. In addition, the encoding method can be enhanced to force a party to cause damage to a watermarked data stream when trying to erase a random-key watermark. Digital watermarks are described in "Steganographic Method and Device" - The DICE Company, Serial No. 08/489,172, the disclosure of which is hereby incorporated by reference.[144]

This demonstrates that steganographic encoding of code resources was known in the art since Application No. 08/489,172 issued as U.S. Patent No. 5,613,004 on March 18, 1997, which is more than one year before the earliest possible priority date for the '602 Patent. As such, a POSITA would have found it obvious to steganographically encode a code resource into one of Beetcher's data resources such that the code resource could not be removed without making the application inoperable.[145]

With respect to claim 4, Beetcher teaches its encoded code resource is encoded in a data resource. This is described with respect to claim 2, which recites this limitation. As such, the combination of Beetcher and Rhoads renders obvious claim 4, since it depends upon obvious claim 3.[146]

Accordingly, Beetcher in view of Rhoads renders obvious claims 3 and 4.

C.   SNQ-3: Claims 1, 2, 5, 8, 10, and 12 are Anticipated by Beetcher '072 Under 35 U.S.C. §§ 102(a), (b).

Beetcher '072 anticipates claims 1, 2, 5, 8, 10, and 12 under 35 U.S.C. §§ 102(a), (b).

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[144] *E.g.*, Cooperman at 2:30-37.

[145] Silva Declaration at ¶ 113.

[146] *Id.* at ¶ 114.

1.   **Beetcher '072 Anticipates Independent Claim 1.**

a)   *Preamble*: **"A computer based method for accessing
functionality provided by an application software comprising"**

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless,

Beetcher '072 discloses claim 1's preamble. Specifically, Beetcher '072 describes a method for

accessing an application's functionality using an encrypted entitlement key 111.[147] Beetcher

'072, for instance, explains that the application software is accessible using the key:

> At Step 901, a customer inputs the qualification grant key 111 into the computer
> systems 101 via the console 109. When this is initial introduction, the installation
> input routine 440 has a dialog with an operator, and receives an input. When that is
> not right, the general input routine 441 receives an input. A qualification grant key
> is passed to the lock release routine 430 which processes a decoding process.[148]

Beetcher '072 illustrates the initial access of the encoded application software in Figure

9a, shown below:

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[147] Beetcher '072 at ¶¶ 0039, 0040, Figs. 1, 9a.

[148] *Id.* at ¶ 0040.
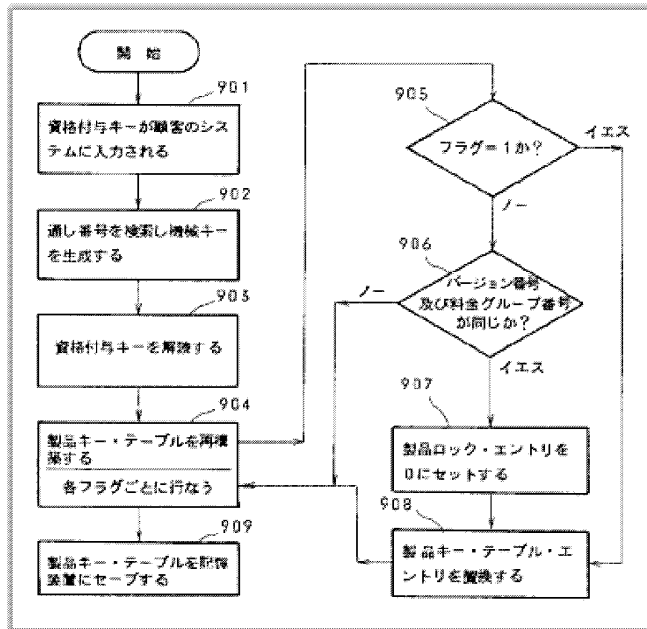
Input of Beetcher '072's entitlement key results in the decryption of the key for storage in the computer system's product key table 450/460.[149] Once the key has been stored in the system's product key table, the system uses the key to decode a series of entitlement triggering instructions 301, which are encoded in code resources[150] for controlling the software's functionality:

> [I]nvalidating a qualification verification trigger, in order that the format of a target code may support the compile course of the conventional type known by the customer] - - or it may become suitable to add the barrier to 'patching' of a target code which is changed. One of such the additional barriers is defining a qualification verification trigger, as other functions of a certain are performed simultaneously. In this case, it is important that the alternate function carried out by the qualification verification trigger cannot carry out with other simple commands. This alternate function must be selected so that any compiled software modules may include some commands which perform that function quite reliably.

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[149] *E.g., id.* at ¶ 0040.

[150] Requester interprets the term "code resources" as best understood based on the '602 Patent and prosecution history.

> When having coincided in these criteria, the compiler can generate automatically the target code which performs the alternate function (it is also a qualification verification trigger simultaneously with it) as a part of the usual compilation order. This definition should bring about the important barrier to 'patching' of a target code which invalidates a qualification verification trigger.[151]

Beetcher '072 further explains that "a qualification verification trigger is also the direct instruction ... which performs other useful work of a certain.... [I]f a trigger command is executed, the system 101 will perform other operations of a certain simultaneously with qualification verification."[152] Moreover, Beetcher '072's Figure 10 shows the process of executing application functions based on confirmation of the correct entitlement key for the application:[153]

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[151] Beetcher '072 at ¶ 0044; *see also id.* at Abstract, ¶¶ 0009, 0021, 0044.

[152] *Id.* at ¶ 0029 (Beetcher '072 specifies that these functions are those "which does not need to divide, does not need to be ordering the operand for the processing and does not need to be specified").

[153] *Id.* at ¶ 0043.
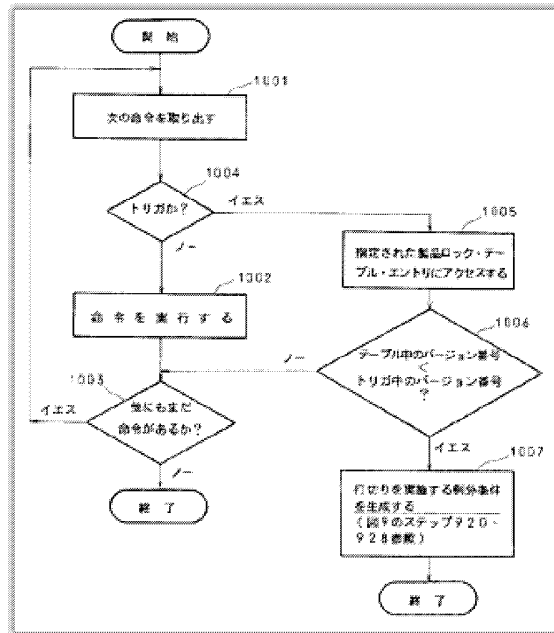
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As such, Beetcher '072 teaches this preamble.

    b)   **Element 1.1: "storing said application software in non transient memory of a computer"**

Beetcher '072 discloses element 1.1. Beetcher '072 describes that the customer initially receives the protected application software on an optical disk 112.[154] As shown below in annotated Figure 1, the customer inserts disk 112 into reader 110 (dashed oval) and stores the software on storage devices 106-108 (dashed box):[155]

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[154] *Id.* at ¶ 0027; *see also id.* at Abstract, ¶¶ 0014, 0040, Fig. 1, claim 6.
[155] *Id.* at ¶¶ 0023, 0025, Fig. 1.

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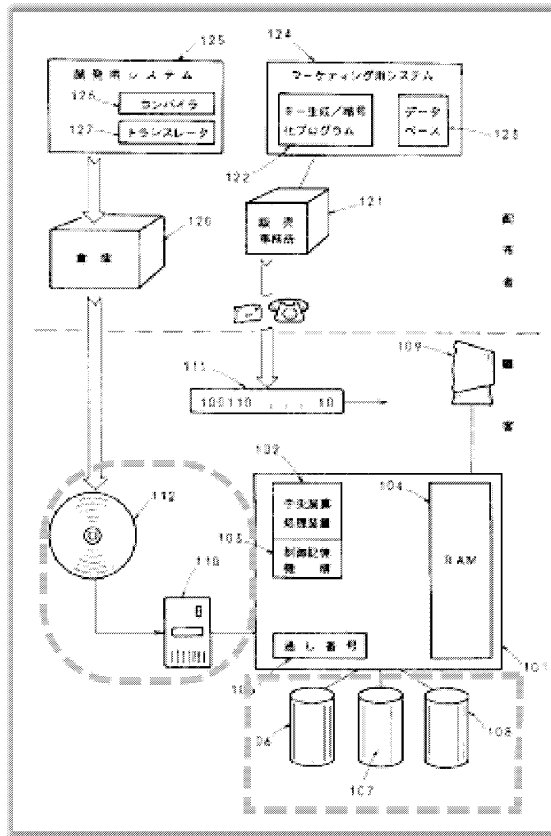
Beetcher '072 specifies that storage devices 106-108 may be "rotating magnetic disk drive storage units."[156] A POSITA would have understood that Beetcher '072's storage devices are non-transient memory of the computer because, as expert Dr. Silva explains, such storage devices necessarily include non-transient memory.[157]

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[156] *Id.* at ¶ 0023.

[157] Silva Declaration at ¶¶ 123-24.

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     c)   *Element 1.2*: **"said application software in said computer
prompting a user to enter into said computer personalization
information"**

Beetcher '072 discloses element 1.2. Beetcher '072 describes its customer's computer as

having an operator console 109 shown with a monitor and keyboard that can "receive the input

from an operator."[158] And Beetcher '072 explains that its application software includes user

interface routine for the customer to input a license key into the computer before the product can

be used.[159] For instance, Beetcher '072 explains that the software product prompts the user to

input the key:

> The support of this operation system contains **two user interface routines
> required to support the input of a qualification grant key on the virtual-
> machine level 404**. The general input routine 441 is used for processing an input
> in normal operation. The **installation input routine 440 special to inputting a
> qualification grant key is required during the initial introduction of an
> operation system**. The thing which needs this is because the portion of an upper
> level operating system is treated as other program products by the present invention
> from the machine interface level 405. Namely, such a portion has product number
> and the target code is subject to the influence of a qualification verification
> trigger.[160]

Beetcher '072 further explains that the software's "installation input routine 440 has a dialog

with an operator, and receives an input" of the customer's license information during the

software's initial installation.[161] Accordingly, a POSITA would have understood Beetcher '072's

application software prompts a user to enter the key into the computer.[162]

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[158] Beetcher '072 at ¶ 0010, Fig. 1.

[159] *Id.* at ¶ 0033; *see also id.* at ¶ 0010.

[160] *Id.* at ¶ 0033.

[161] *Id.* at ¶ 0040; *see also id.* at Fig. 4 (reference number 440), claim 6.

[162] Silva Declaration at ¶¶ 127-28.

Moreover, Beetcher '072 discloses that its entitlement key 111 includes information relating to the customer's personal information and the computer's serial number.[163] Beetcher '072, for instance, explains that the software distributor has "generation/enciphered program 122 of a qualification grant key, and the data base 123 containing customer data."[164] Beetcher '072 further details:

> If a customer's order is received, the key generation/enciphered program 122 under execution will access the database 123 including the consecutive numbers of the information about a customer, specifically a machine, and the information on processor form by the system 124 at Step 802. The charge group field 201 and the machine consecutive-numbers field 204 of the qualification grant key 200 which are not enciphered are generated using this information. At Step 803, the remaining fields are generated by a customer's order and the reference to the database of possible product number offer, and the qualification grant key of a perfect non-code form is built by them. Subsequently, key generation/enciphered program 122 enciphers a qualification grant key at Step 804 ....[165]

And the key includes the customer's charge group 505 indicating the customer's machine tier and tier pricing.[166] Figure 8 illustrates the generation of the customer's entitlement key based on the customer's personalization information:

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[163] Beetcher '072 at ¶¶ 0024, 0039; *see also id.* at ¶¶ 0020, 0028.

[164] *Id.* at ¶ 0024.

[165] *Id.* at ¶ 0039.

[166] *Id.* at ¶¶ 0028, 0035.
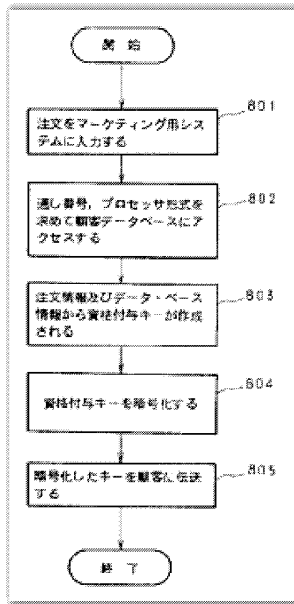
Beetcher '072's Figure 2 further details the parts of the customer's entitlement key

including the personalization information relating to the customer's machine serial number and

the customer's charge group and accessible software versions and product numbers:

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Accordingly, a POSITA would have understood that Beetcher '072's key entered into the

computer by the customer is personalization information.[167]

       d)   *Element 1.3*: **"said application software storing, in said non
transient memory, in a personalization data resource, both
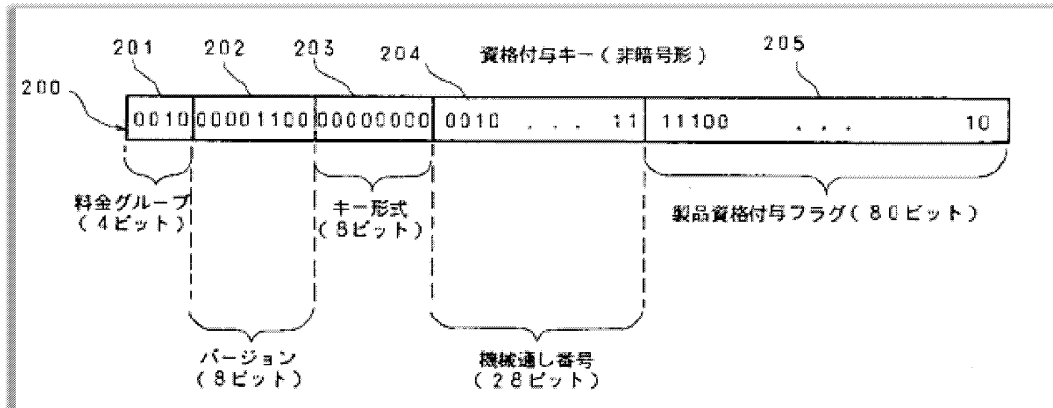computer configuration information of said computer, and a
license code entered in response to said prompting"**

Beetcher '072 discloses element 1.3. Beetcher '072's entitlement key 111/200 includes

information detailing which software version and product numbers the customer is entitled to

access,[168] as discussed regarding element 1.2. And in Figure 2, Beetcher '072 illustrates that the

key includes license information which correspond to license code information stored in the

application software:

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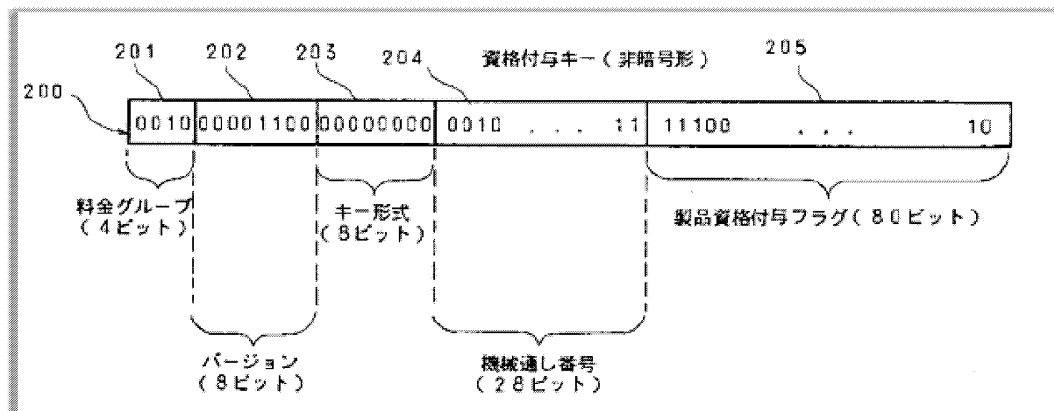
[167] Silva Declaration at ¶¶ 129-32

[168] Beetcher '072 at ¶ 0028.

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Regarding the license information in the application software, Beetcher '072 explains that

its software includes data resources[169] that correspond to the software's functions.[170] And

Beetcher '072 describes a series of entitlement triggering instructions 301 located in the software

that must be verified in order to access software functions.[171] These triggering instructions each

contains license code information that aligns with the entitlement key entered by the customer

when prompted. Each triggering instruction 301 includes fields, for example, version 303 and

product number 304, as shown in Figure 3 provided below:

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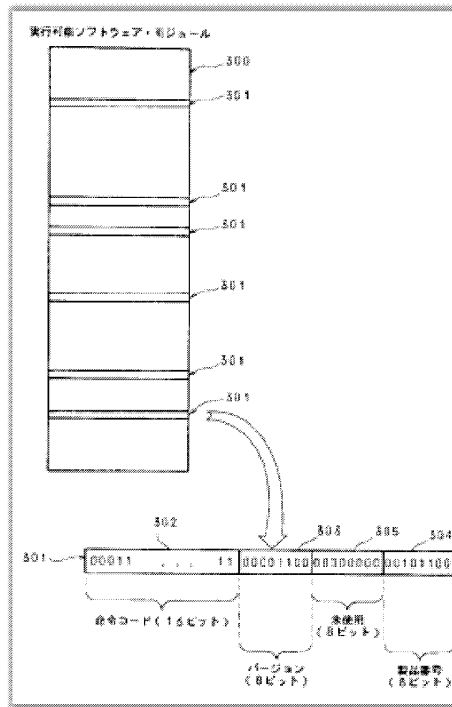
[169] Requester interprets the term "data resources" as best understood based on the '602 Patent and prosecution history.

[170] Beetcher '072 at ¶¶ 0029, 0044; *see also id.* at Abstract, ¶¶ 0009, 0021.

[171] *Id.* at ¶¶ 0029, 0044; *see also id.* at ¶¶ 0021, 0033-34, 0037-38; Silva Declaration at ¶¶ 135-36

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Specifically, each triggering instruction 301 begins with operation code field 302 ("verb

portion of the target code command which identifies the operation which should be

performed").[172] This field is followed by version field 303 and product number field 304

identifying uniquely the entitled versions and product numbers of the software.[173] A POSITA

would have thus understood this uniquely identifying data to be a serialization data resource,

which corresponds to the claimed "personalization data resource," as that term is best

understood.[174]

Beetcher '072 further discloses that triggering instructions 301 include computer

configuration information to control software functionality separate from entitlement

verification:

> [I]nvalidating a qualification verification trigger, in order that the format of a target
> code may support the compile course of the conventional type known by the
> customer] - - or it may become suitable to add the barrier to 'patching' of a target
> code which is changed. **One of such the additional barriers is defining a
> qualification verification trigger, as other functions of a certain are performed
> simultaneously. In this case, it is important that the alternate function carried
> out by the qualification verification trigger cannot carry out with other simple
> commands.** This alternate function must be selected so that any compiled software
> modules may include some commands which perform that function quite reliably.
> When having coincided in these criteria, the compiler can generate automatically
> the target code which performs the alternate function (it is also a qualification
> verification trigger simultaneously with it) as a part of the usual compilation order.
> This definition should bring about the important barrier to 'patching' of a target
> code which invalidates a qualification verification trigger.[175]

Beetcher '072 also specifies the triggering instruction is "also the direct instruction

(command which does not need to divide, does not need to be ordering the operand for the

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[172] Beetcher '072 at ¶ 0029.

[173] *Id.* at ¶ 0029.

[174] Silva Declaration at ¶ 137.

[175] Beetcher '072 at ¶ 0044; *see also id.* at Abstract, ¶¶ 0009, 0021, 0029.

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processing and does not need to be specified) which performs other useful work of a certain…

[I]f a trigger command is executed, the system 101 will perform other operations of a certain simultaneously with qualification verification."[176] A POSITA would have understood that the computer's "direct instruction … which performs other useful work" includes computer configuration information as this information guarantees the software only works for the licensed computer.[177]

As such, a POSITA would have understood that Beetcher '072's software includes a personalization data resource with a license code (certain triggering instruction and entitlement key fields) and computer configuration information (functionality information).[178] And as described with respect to elements 1.1 and 1.2, Beetcher '072's software is stored in non-transient memory and the key corresponding to the triggering instruction is entered in response to the computer's prompting.

e) **_Element 1.4_: "said application software in said computer generating a proper decoding key, said generating comprising using said license code"**

Beetcher '072 discloses element 1.4. As discussed with respect to element 1.3, Beetcher '072 explains its application software includes triggering instructions 301 that contain license code information.[179] These triggering instructions are part of the executable software module, as shown in Figure 3 provided below:

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[176] *Id.* at ¶ 0029.

[177] Silva Declaration at ¶¶ 138-39.

[178] *Id.* at ¶ 140.

[179] Beetcher '072 at ¶¶ 0029, 0044; *see also id.* at ¶¶ 0021, 0033-34, 0037-38.

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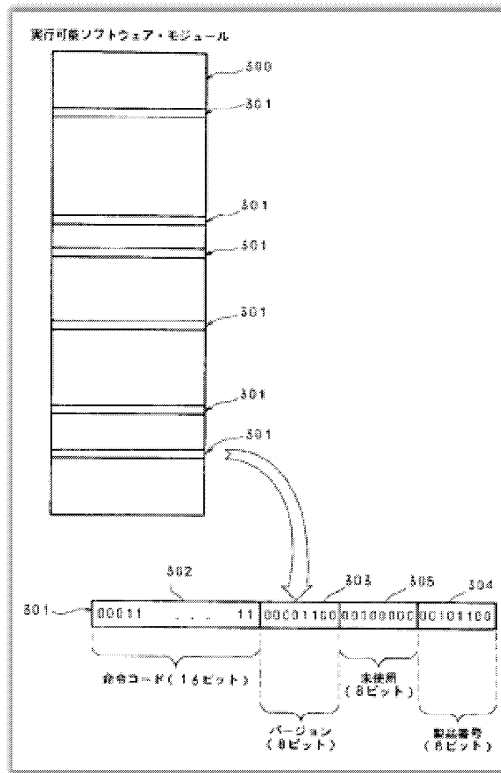
Beetcher '072 details that the customer enters entitlement key 111 in response to the

prompt initiated by install input routine 440.[180] After entering that key, Beetcher '072 teaches

that the customer's computer generates a decode key to initiate unlock routine 430 to decode

license code information in the entitlement key.[181] Beetcher '072 shows the decoded entitlement

key in Figure 2. And Beetcher '072's Figures 4 and 9a, which are provided below, illustrate the

decoding of the entitlement key and populating tables with license code information contained in

the decoded entitlement key. For instance, annotated Figure 4 illustrates that the install input

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[180] *Id.* at ¶ 0033; *see also id.* at ¶ 0040, Figs. 1, 4, claim 6.

[181] *Id.* at ¶¶ 0032, 0040; *see also id.* at ¶¶ 0030, 0037, Figs. 4, 9a.

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routine 440 starts unlock routine 430 once the customer inputs key 111 into the computer.[182] And

"[u]nlock routine 430 uses the unique machine key to decode[] entitlement key 111" (dashed

perimeter):[183]
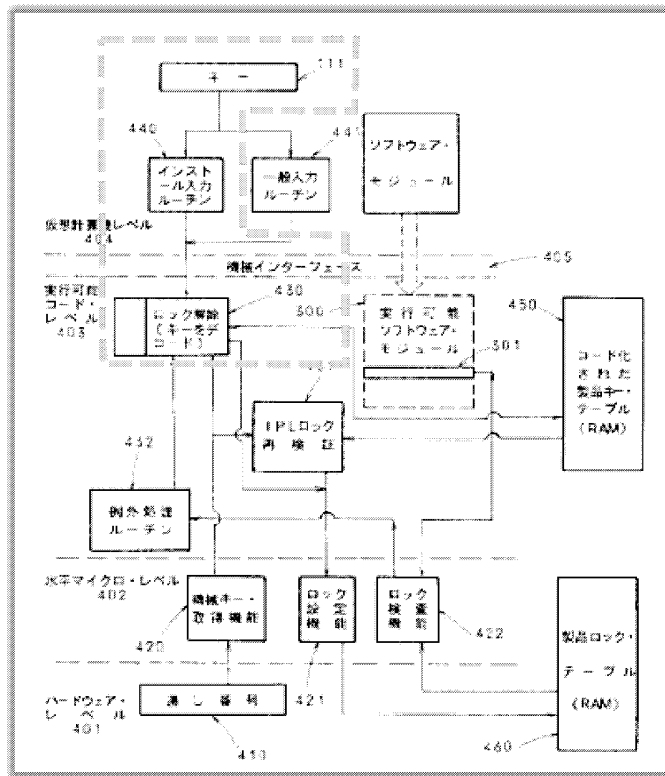
Beetcher '072 details that unlock routine 430 "handles the decoding process," which is

illustrated in Figure 9a's steps 902-909: "The lock release routine 430 makes the machine-key

acquisition function 420 search machine consecutive numbers with Step 902, and makes it

generate a machine key at it. Subsequently, the lock release routine 430 decodes the qualification

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[182] *Id.* at ¶¶ 0033, 0040.

[183] *Id.* at ¶ 0032; *see also id.* at ¶¶ 0037, 0041.

grant key 111 at Step 903 using a machine key."[184] Beetcher '072's unlock routine 430 will

complete the decoding process by building an encoded product key table (step 904), populating

the key table for the relevant software product (steps 905-908), and saving the key table (step

909),[185] as shown in Figure 9a:
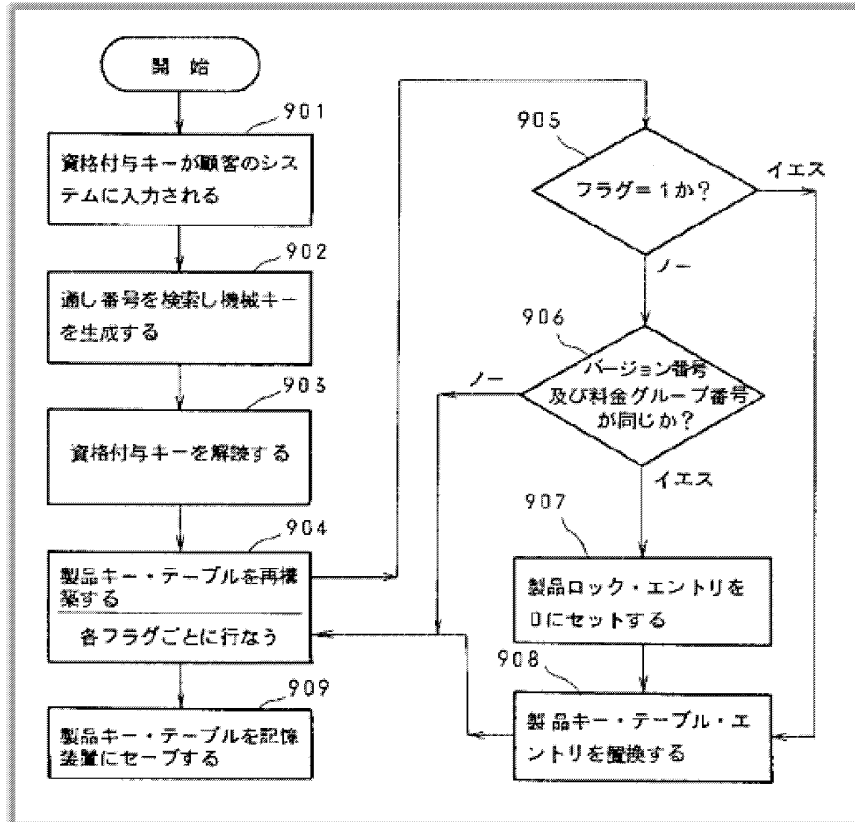
Based on unlock routine 430, Beetcher '072's decoding process populates key table 450

with license code information unique to the customer's entitled software products.[186] And

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[184] *Id.* at ¶ 0040.

[185] *Id.* at ¶ 0040.

[186] *Id.* at ¶¶ 0040-41.

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Beetcher '072 discloses that the customer's RAM includes table 460 for storing and identifying

the products for which the customer has entered entitlement keys.[187] As Beetcher '072 details,

the system checks the execution privileges whenever the software encounters a triggering

instruction and either confirms tables 450/460 includes the proper licensing information or aborts

if that information is missing from the tables.[188] And to avoid illicit software patches, Beetcher

'072 explains each triggering instruction includes instructions for performing additional software

functionality that cannot be performed by other instructions.[189] As such, a POSITA would have

understood that Beetcher '072's system uses its license code to generate a decoding key and that

the triggering instruction's control over additional software functionality includes generating

such a decoding key.[190]

> f) *Element 1.5*: **"wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource"**

Beetcher '072 discloses element 1.5. As explained with respect to element 1.3, Beetcher

'072 specifies that the software cannot access certain functionalities unless the computer has

stored the license code information contained in the triggering instruction:

> [I]nvalidating a qualification verification trigger, in order that the format of a target code may support the compile course of the conventional type known by the customer] - - or it may become suitable to add the barrier to 'patching' of a target code which is changed. **One of such the additional barriers is defining a qualification verification trigger, as other functions of a certain are performed simultaneously. In this case, it is important that the alternate function carried out by the qualification verification trigger cannot carry out with other simple commands.** This alternate function must be selected so that any compiled software modules may include some commands which perform that function quite reliably.

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[187] *Id.* at ¶¶ 0032, 0036, 0041-42, Fig. 6, Fig. 9a.

[188] *Id.* at ¶¶ 0037-38, 0043-44, Fig. 10.

[189] *Id.* at ¶ 0044.

[190] Silva Declaration at ¶¶ 143-47.

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> When having coincided in these criteria, the compiler can generate automatically the target code which performs the alternate function (it is also a qualification verification trigger simultaneously with it) as a part of the usual compilation order. This definition should bring about the important barrier to 'patching' of a target code which invalidates a qualification verification trigger.[191]

Beetcher '072 also specifies the triggering instruction includes "the direct instruction (command which does not need to divide, does not need to be ordering the operand for the processing and does not need to be specified).... [I]f a trigger command is executed, the system 101 will perform other operations of a certain simultaneously with qualification verification."[192] And as explained with respect to element 1.4, the triggering instructions are included in the software product. Figure 3 illustrates the encoded code resources[193] of an executable software module, which include the series of triggering instructions 301 that contain the license code information:

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[191] Beetcher '072 at ¶ 0044; *see also id.* at Abstract, ¶¶ 0009, 0021, 0029.

[192] *Id.* at ¶ 0029.

[193] Requester interprets the term "code resources" as best understood based on the '602 Patent and prosecution history.

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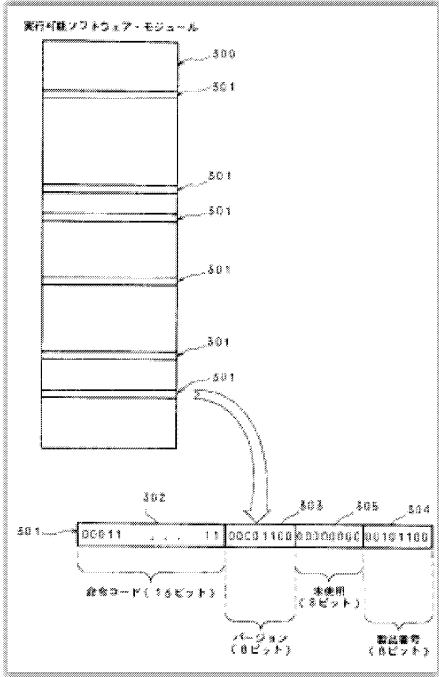
As such, a POSITA would have understood that Beetcher '072's software installed in the customer's computer cannot access at least one encoded code resource unless the license code is stored in the personalization data resource.[194]

Accordingly, Beetcher '072 discloses claim 1.

2. Beetcher '072 Anticipates Dependent Claim 2.

Beetcher '072 discloses "*wherein said encoded code resource is encoded in at least one data resource*," as recited in claim 2.[195] Beetcher '072 describes embedding the triggering instructions 301 into the software object code: "[S]ome qualification verification trigger commands ... 301 are included in the target code.... [A] qualification verification trigger is also

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[194] Silva Declaration at ¶¶ 150-52.

[195] Claim 2 depends upon claim 1.

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the direct instruction ... which performs other useful work of a certain.... [I]f a trigger command

is executed, the system 101 will perform other operations of a certain simultaneously with

qualification verification."[196] And Beetcher '072 teaches storing license code information in

tables 450 and 460 based on the entitlement key 111.[197]

Beetcher '072 also describes multiple data resources in the software, namely, executable

software modules, like the module shown below in annotated Figure 3. Beetcher '072's Figure 4

also shows the software modules 300. A POSITA would have understood that Beetcher '072's

tables 450/460 identify code resources to be recovered and the corresponding keys to decrypt the

software.[198] And overall, POSITA would have understood that the inclusion of the triggering

instruction into the software corresponds to encoding a code resource in a data resource.[199]

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[196] Beetcher '072 at ¶ 0029.

[197] *Id.* at ¶ 0040.

[198] Silva Declaration at ¶¶ 155-56.

[199] *Id.* at ¶ 156. Requester interprets the terms "code resource" and "data resources" as best
understood based on the '602 Patent and prosecution history.

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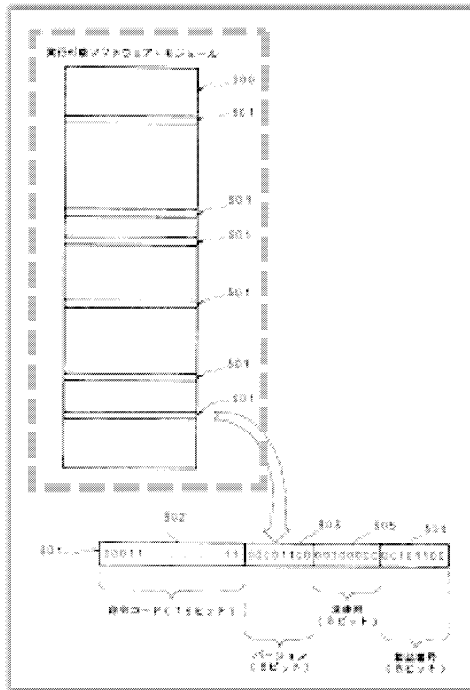
Accordingly, Beetcher '072 discloses claim 2.

3. Beetcher '072 Anticipates Dependent Claim 5.

Beetcher '072 discloses "*wherein said computer configuration information is stored in a data resource*," as recited in claim 5.[200] As discussed with respect to element 1.3, Beetcher '072's data resource includes computer configuration information. For instance, Beetcher '072 explains that the triggering instruction can be:

> [T]he direct instruction (command which does not need to divide, does not need to be ordering the operand for the processing and does not need to be specified) which performs other useful work of a certain.... [I]f a trigger command is executed, the system 101 will perform other operations of a certain simultaneously with qualification verification.[201]

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[200] Claim 5 depends upon claim 1.

[201] Beetcher '072 at ¶ 0029.

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A POSITA would have understood that the computer's information for the "direct instruction ...

which performs other useful work" includes computer configuration information.[202] And

Beetcher '072 details that the triggering information, which includes the computer configuration

information, is compiled and translated into the software, as shown below in Figure 3.[203] As

such, a POSITA would have understood this process stores the computer configuration

information in the data resource.[204]
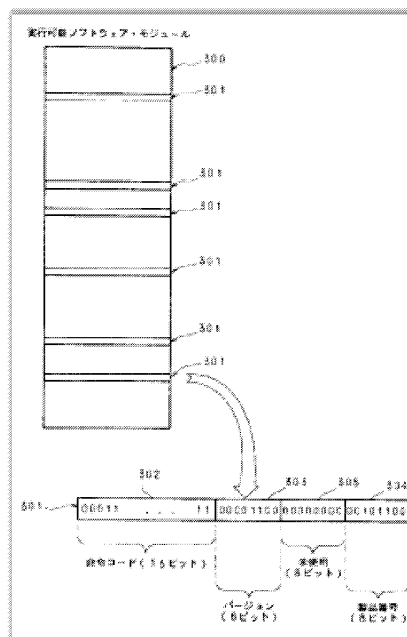
Accordingly, Beetcher '072 discloses claim 5.

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[202] Silva Declaration at ¶¶ 159-60.

[203] Beetcher '072 at ¶¶ 0038, 0044.

[204] Silva Declaration at ¶ 160.

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4. Beetcher '072 Anticipates Dependent Claim 8.

Beetcher '072 discloses *"wherein said computer comprises a processor and said application software using said processor in said prompting and said [application software][205] storing,"* as recited in claim 8.[206] Specifically, Beetcher '072 teaches that its computer has a processor 102 used by the computer's application software.[207] Beetcher '072's Figure 1 illustrates this processor 102 (dashed box) used by the software when prompted via console 109 and for storage in device 106-108:
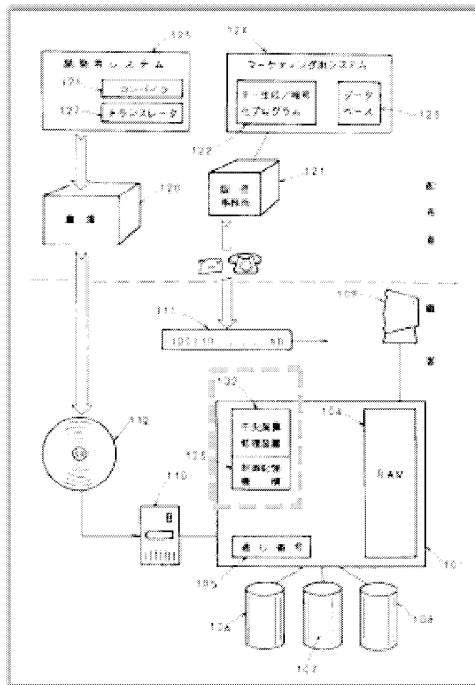
Accordingly, Beetcher '072 discloses claim 8.

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[205] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[206] Claim 8 depends upon claim 1.

[207] Beetcher '072 at ¶ 0023, Fig. 1.

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5.   **Beetcher '072 Anticipates Independent Claim 10.**

   a)   *Preamble*: **"A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising"**

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless, Beetcher '072 discloses claim 10's preamble. Beetcher '072 describes application software code that is a computer program.[208] And this code is stored in a non-transitory storage media, such as optical disk 112.[209] When run by customer's computer 101, the computer will access the software production's functionality if the proper license key has been entered.[210]

The customer's system configuration is illustrated in Beetcher '072's Figure 1, annotated below:

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[208] *Id.* at ¶¶ 0026, 0038.

[209] *Id.* at ¶ 0027; *see also id.* at Abstract, ¶¶ 0014, 0040, Fig. 1, claim 6.

[210] *Id.* at ¶¶ 0037, 0041; Silva Declaration at ¶¶ 167-69.
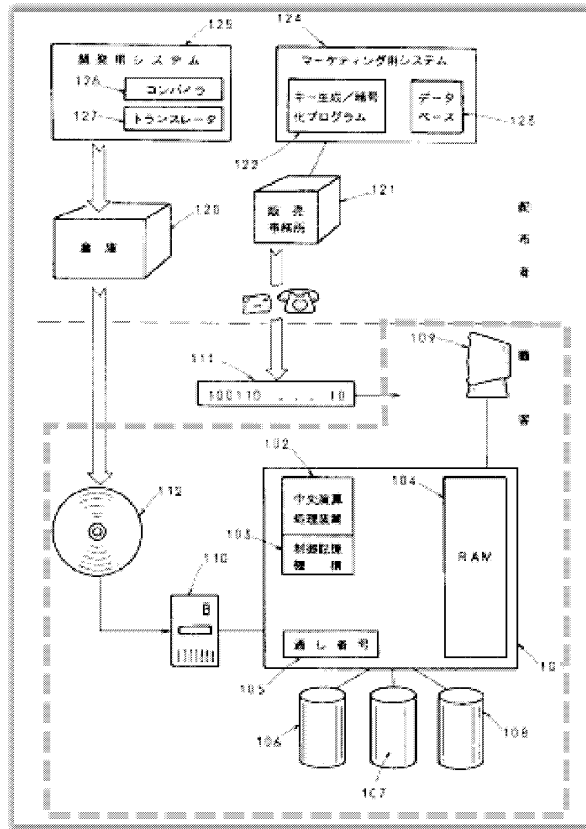
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As such, Beetcher '072 teaches this preamble.

    b)   ***Element 10.1***: **"storing said application software code in non transient memory of [said][211] computer system"**

Element 10.1 is substantially similar to element 1.1. As explained above, Beetcher '072 discloses each limitation of element 1.1. For the same reasons, Beetcher '072 teaches element 10.1.

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[211] Ex. 2, Prosecution History at 429 (Certificate of Correction).

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    c)   **Element 10.2: "said application software code in said computer system prompting a user to enter into said computer system personalization information"**

Element 10.2 is substantially similar to element 1.2. As explained above, Beetcher '072 discloses each limitation of element 1.2. For the same reasons, Beetcher '072 teaches element 10.2.

    d)   **Element 10.3: "said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting"**

Element 10.3 is substantially similar to element 1.3. As explained above, Beetcher '072 discloses each limitation of element 1.3. For the same reasons, Beetcher '072 teaches element 10.3.

    e)   **Element 10.4: "said application software code in said computer system generating a proper decoding key, said generating comprising using said license code"**

Element 10.5 is substantially similar to element 1.5. As explained above, Beetcher '072 discloses each limitation of element 1.5. For the same reasons, Beetcher '072 teaches element 10.5.

    f)   **Element 10.5: "wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource"**

Element 10.5 is substantially similar to element 1.5. As explained above, Beetcher '072 discloses each limitation of element 1.5. For the same reasons, Beetcher '072 teaches element 10.5.

Accordingly, Beetcher '072 discloses claim 10.[212]

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[212] Silva Declaration at ¶ 180; *see also id.* at ¶¶ 170-79.

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6.   Beetcher '072 Anticipates Dependent Claim 12.

Beetcher '072 discloses "*wherein said computer program product causes storing of said encoded code resource in a data resource in non transient memory of said computer [system]*,"[213] as recited in claim 12.[214] Beetcher '072 describes embedding the triggering instructions 301 into the software object code: "[S]ome qualification verification trigger commands ... 301 are included in the target code.... [A] qualification verification trigger is also the direct instruction ... which performs other useful work of a certain.... [I]f a trigger command is executed, the system 101 will perform other operations of a certain simultaneously with qualification verification."[215] And Beetcher '072 teaches storing license code information in tables 450 and 460 based on the entitlement key 111.[216]

Accordingly, a POSITA would have understood that the inclusion of the triggering instruction into the software corresponds to encoding a code resource in a data resource.[217] As described with respect to elements 1.1 and 10.1, Beetcher '072's software code is stored in non-transient memory of the customer's computer.

Accordingly, Beetcher '072 discloses claim 12.

D.   SNQ-4: Claims 3 and 4 are Rendered Obvious by the Combination of Beetcher '072 and Rhoads Under 35 U.S.C. § 103(a).

The combination of Beetcher '072 and Rhoads renders obvious claims 3 and 4 under 35 U.S.C. § 103(a). Specifically, Beetcher in view of Rhoads renders obvious:

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[213] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[214] Claim 12 depends upon claim 10.

[215] Beetcher '072 at ¶ 0029.

[216] *Id.* at ¶ 0040.

[217] Silva Declaration at ¶¶ 182-83.

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- Claim 3: "The method of claim 1 wherein said encoded code resource is steganographically encoded."
- Claim 4: "The method of claim 3 wherein said encoded code resource is encoded in a data resource."

As explained with respect to claim 2, Beetcher '072 describes encoding the code resource in at least one data resource. While Beetcher '072 teaches encoding a code resource, it does not expressly describe encoding the code resource using steganographic encoding. But this type of encoding was known in the art and would have been obvious to use in Beetcher's system.

Specifically, Rhoads describes encoding licensing information into software using steganographic encoding. For instance, Rhoads teaches generating a software component like an image or graphic encoded steganographically to include a 16-bit main identification number.[218] And Rhoads teaches that this steganographic encoding technique embeds identification information into a data source, such as an image, without a perceptible decrease in fidelity.[219]

Rhoads explains this method of steganographic encoding in its claim 1:

In a method of image processing that includes processing an input image to steganographically encode a multi-bit message code therein, thereby yielding an encoded output image, and thereafter processing suspect data corresponding to said encoded output image to decode the message code therefrom, an improvement including:

encoding the message code redundantly through the image data…; and

decoding the message code from said suspect data without reference to said input image, … and analyzing said transformed data.[220]

Moreover, Rhoads details the use of steganographic encoding in applications that use an identification key to determine whether to execute a particular code resource such as word processor applications:

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[218] Rhoads at 6:62-67, 7:45-51, 8:44-9:4, claim 1; *see also id.* at 11:45-62, Figs 2-3.

[219] *Id.* at 2:49-59, 5:31-39.

[220] *Id.* at claim 1; *see also id.* at claims 2, 8, 12.

[S]ome applications can utilize a universal set of individual embedded code signals, i.e., codes which remain the same for all instances of distributed material, This type of requirement would be seen by systems which wish to hide the N-bit identification word itself, yet have standardized equipment be able to read that word. This can be used in systems which make go/no go decisions at point-of-read locations.... Use of the Invention in ... Documents ... and Other Material Where Global Embedded Codes Can Be Imprinted."[221]

In view of Rhoads' teachings, a POSITA would have found it obvious to use a form of steganographic encoding when encoding Beetcher '072's encoded code resource.[222] For instance, a POSITA would have found it obvious to encode steganographic license information into one of the graphics used in Beetcher '072's software applications.[223] A POSITA would have been motivated to do so because Rhoads teaches steganographically encoding identification information into a data source, such as an image, without a perceptible decrease in the quality of the data resource.[224]

Moreover, using steganographic encoding to encode Beetcher '072's code resource would simply be a matter of design choice selected from a finite number of predictable encoding solutions with a reasonable expectation of success.[225] A POSITA would have recognized the number of predictable solutions to encode Beetcher '072's code resource to include steganographic encoding. For instance, the '602 Patent specifies that steganographically encoding was known in the art:

As described in previous disclosures, "Steganographic Method and Device" and "Human Assisted Random Key Generation and Application for Digital Watermark System," watermarks are particularly suitable to the identification, metering, distributing and authenticating digitized content such as pictures, audio, video and

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[221] *Id.* at 14:26-33, 14:40-43.

[222] Silva Declaration at ¶¶ 187-91.

[223] *Id.* at ¶ 191.

[224] Rhoads at 2:49-59, 5:31-39; Silva Declaration at ¶ 191.

[225] Silva Declaration at ¶ 192.

derivatives thereof under the description of" multimedia content." Methods have
been described for combining both cryptographic methods, and steganography, or
hiding something in plain view.[226]

Similarly, Cooperman details that using steganographic encoding to encode a code resource was

known in that art:

> These keys make it impossible for a party to find the watermark without having the
> key. In addition, the encoding method can be enhanced to force a party to cause
> damage to a watermarked data stream when trying to erase a random-key
> watermark. Digital watermarks are described in "Steganographic Method and
> Device" - The DICE Company, Serial No. 08/489,172, the disclosure of which is
> hereby incorporated by reference.[227]

This demonstrates that steganographic encoding code resources was known in the art since

Application No. 08/489,172 issued as U.S. Patent No. 5,613,004 on March 18, 1997, which is

more than one year before the earliest possible priority date for the '602 Patent. As such, a

POSITA would have found it obvious to steganographically encode a code resource into one of

Beetcher '072's data resources such that the code resource could not be removed without making

the application inoperable.[228]

With respect to claim 4, Beetcher '072 teaches its encoded code resource is encoded in a

data resource. This is described with respect to claim 2, which recites this limitation. As such, the

combination of Beetcher '072 and Rhoads renders obvious claim 4 since it depends upon

obvious claim 3.[229]

Accordingly, Beetcher '072 in view of Rhoads renders obvious claims 3 and 4.

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[226] '602 Patent at 3:14-23; *see also id.* at 6:15-40, 8:35-40, 12:29-31, 14:25-30.

[227] *E.g.*, Cooperman at 2:30-37.

[228] Silva Declaration at ¶ 192.

[229] *Id.* at ¶ 193.

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E.   SNQ-5: Claims 1, 2, 3, 4, 5, 8, 10, and 12 are Anticipated by Cooperman Under 35 U.S.C. § 102(a).

Cooperman anticipates claims 1, 2, 3, 4, 5, 8, 10, and 12 under 35 U.S.C. § 102(a).

1.   Cooperman Anticipates Independent Claim 1.

a)   *Preamble*: "A computer based method for accessing functionality provided by an application software comprising"

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless, Cooperman discloses claim 1's preamble. Specifically, Cooperman describes a method for accessing an application's functionality using a license code or key.[230] Cooperman, for instance, states that "[o]nce [the application] has the license code, it can then generate the proper decoding key to access the essential code resources."[231] And Cooperman explains that "the present invention, [discloses] the software itself is a set of commands, compiled by software engineer, which can be configured in such a manner as to tie underlying functionality to the license or authorization of the copy in possession by the user."[232]

As such, Cooperman teaches this preamble.

b)   *Element 1.1*: "storing said application software in non transient memory of a computer"

Cooperman discloses element 1.1. Cooperman describes techniques for randomizing the location of application software stored in memory.[233] And Cooperman explains that this randomization makes the software more resistant to patching and memory capture analysis.[234] As

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[230] Cooperman at 5:35-6:5, 11:24-33; *see also id.* at 3:24-31, 11:34-37, 12:13-35, claim 2.

[231] *Id.* at 11:31-33.

[232] *Id.* at 5:35-6:5.

[233] *Id.* at 3:32-37; *see also id.* at 4:1-6, 6:5-9, 13:23-46, 14:4-9. Cooperman defines "application" as "an executable computer program." *Id.* at 6:12-15.

[234] *Id.* at 3:13-16, 14:37-15:18, claim 7.

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such, a POSITA would have understood that these techniques are used for software stored in memory.[235]

Cooperman further explains that its application software is compiled and assembled: "When code and data resources are compiled and assembled into a precursor of an executable program the next step is to use a utility application for final assembly of the executable application."[236] A POSITA would have understood that Cooperman's compiled and assembled software is stored in non-transient memory because, as expert Dr. Silva explains, storage of such executable programs are necessarily non-transient memory.[237]

And Cooperman describes the memory as: "It is also desirable to randomly reorganize program memory structure."[238] Cooperman also teaches the storage of computer configuration information: "This can include a particular computer configuration; 2) it stores this information in a personalization data resource."[239]

During the original prosecution, Patent Owner confirmed that such teachings disclosed by Cooperman meets element 1.1. For instance, Patent Owner's October 22, 2014 Remarks state that "memory that is non-transient" is taught by the patent's description that "[i]t is also desirable to randomly reorganize program memory structure."[240] And these same remarks state that storing computer configuration information is taught by: "This can include a particular computer

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[235] Silva Declaration at ¶ 199.

[236] Cooperman at 10:8-11; *see also id.* at 7:1-21.

[237] Silva Declaration at ¶ 200.

[238] Cooperman at 3:32-33.

[239] *Id.* at 11:27-30; Silva Declaration at ¶ 201.

[240] Ex. 2, Prosecution History at 225 (original claim 58 issued as claim 1).

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configuration; 2) it stores this information in a personalization data resource."[241] Cooperman

includes these same teachings, and thus discloses element 1.1.

> c) ***Element 1.2***: "said application software in said computer prompting a user to enter into said computer personalization information"

Cooperman discloses element 1.2. Cooperman explains that its application software

requests that the user enter personalization information, such as a license key, into the computer

before the product can be used.[242] For instance, Cooperman explains that the software installed

on the computer prompts the user to enter personalization information: "1) when it is run for the

first time, after installation, it asks the user for personalization information, which includes the

license code. This can include a particular computer configuration."[243] And Cooperman specifies

that such license codes are entered by the user "when prompted at start-up."[244] Accordingly, a

POSITA would have understood this request corresponds to the software prompting a user to

enter personalization information into the computer.[245]

> d) ***Element 1.3***: "said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting"

Cooperman discloses element 1.3. Cooperman explains that its application software

includes data resources, which correspond to the functions of the software.[246] And Cooperman

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[241] Ex. 2, Prosecution History at 225 (original claim 58 issued as claim 1).

[242] Cooperman 11:24-33; *see also id.* at Abstract, 3:24-28, 5:35-6:5, 11:6-8, 12:10-16, claims 2 and 6.

[243] *Id.* at 11:25-28.

[244] *Id.* at 1:25-28.

[245] Silva Declaration at ¶ 205.

[246] Cooperman at 6:15-30, 10:8-11, 12:32-35; *see also id.* at 5:35-6:5, 9:22-27, claim 6.

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encodes its license code (personalization information) into certain data resources using a stega-

cipher process.[247] As discussed regarding element 1.1, Cooperman's application software is

stored in non-transient memory. Cooperman further specifies that the data resources, such as

sub-objects of the application, are stored in non-transient memory.[248]

Cooperman details that the application software stores configuration information and the

user-entered license code in a "personalization data resource."[249] For instance, Cooperman states:

"when [the application] is run for the first time, after installation, it asks the user for

personalization information, which includes the license code. This can include a particular

computer configuration; [and] it stores this information in a personalization data resource."[250]

e) ***Element 1.4***: **"said application software in said computer
generating a proper decoding key, said generating comprising
using said license code"**

Cooperman discloses element 1.4. Cooperman specifies that its software application

generates a decoding key using the license code: "Once [the application] has the license code, it

can then generate the proper decoding key to access the essential code resources."[251] And

Cooperman further details that the software decodes the encoded first code resource by using the

license code: "Note further that the application contains a code resource which performs the

function of decoding an encoded code resource from a data resource."[252]

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[247] *Id.* at 8:25-29, 9:22-27, 10:13-20; *see also id.* at Abstract, 11:11-24, claim 6.

[248] *Id.* at 7:1-26, 10:8-11; *see also id.* at 3:32-4:6, 6:5-9, 13:23-46, 14:4-9; Silva Declaration at ¶ 208.

[249] Cooperman at 11:24-33, claim 6.

[250] *Id.* at 11:24-33; Silva Declaration at ¶ 209.

[251] Cooperman at 11:31-33.

[252] *Id.* at 11:17-20, claim 6; *see also id.* at 11:31-33, claim 5; Silva Declaration at ¶ 212.

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f)   **Element 1.5: "wherein said application software, in said
computer, cannot access at least one encoded code resource of
said application software, unless said license code is stored in
said personalization data resource"**

Cooperman discloses element 1.5. Cooperman explains that its application software can

only access the encoded code resources once the correct license code is entered.[253] For instance,

Cooperman states that "the application...must contain the license code issued to the licensed

owner, to access its essential code resources."[254] And Cooperman discloses that the license code

is stored in the "personalization data resource": "[t]he application...asks the user for

personalization information, which includes the license code. This can include a particular

computer configuration; [and] it stores this information in a personalization data resource.[255]

Accordingly, Cooperman discloses claim 1.

2.   Cooperman Anticipates Dependent Claim 2.

Cooperman discloses "*wherein said encoded code resource is encoded in at least one*

data resource," as recited in claim 2.[256] Cooperman describes encoding a code resource in a data

resource using a stega-cipher process.[257] For instance, Cooperman describes this process as:

> When code and data resources are compiled and assembled into a precursor of an
> executable program the next step is to use a utility application for final assembly of
> the executable application. The programmer marks several essential code resources
> in a list displayed by the utility. The utility will choose one or several essential code
> resources, and encode them into one or several data resources using the stega-cipher
> process. The end result will be that these essential code resources are not stored in
> their own partition, but rather stored as encoded information in data resources.[258]

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[253] Cooperman at 10:16-20, 11:17-37; *see also id.* at 11:6-8, 12:13-21, claim 6.

[254] *Id.* at 11:34-37.

[255] *Id.* at 11:24-33; *see also id.* at claim 6; Silva Declaration at ¶ 215.

[256] Claim 2 depends upon claim 1.

[257] Cooperman at 9:22-34, 10:8-31, 11:11-22, claim 6.

[258] *Id.* at 10:8-19.

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And Cooperman specifies that "[e]xactly which code resources are encoded into which data resource may be determined in a random or pseudo random manner."[259]

Accordingly, Cooperman discloses claim 2.

3. Cooperman Anticipates Dependent Claim 3.

Cooperman discloses "*wherein said encoded code resource is steganographically encoded*," as recited in claim 3.[260] As explained with respect to claim 2, Cooperman describes encoding a code resource using a stega-cipher process.[261] Cooperman also refers to this process as digital watermarking, as described in U.S. Patent Application No. 08/489,172 entitled "Steganographic Method and Device."[262] This demonstrates that steganographic encoding of code resources was known in the art since Application No. 08/489,172 issued as U.S. Patent No. 5,613,004 on March 18, 1997, which is more than one year before the earliest possible priority date for the '602 Patent. A POSITA would have understood that encoding a code resource using a steganographic method corresponds to steganographic encoding.[263]

Accordingly, Cooperman discloses claim 3.

4. Cooperman Anticipates Dependent Claim 4.

Cooperman discloses "*wherein said encoded code resource is encoded in a data resource*," as recited in claim 4.[264] As explained with respect to claim 2, Cooperman describes

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[259] *Id.* at 11:15-17; Silva Declaration at ¶ 218.

[260] Claim 3 depends upon claim 1.

[261] Cooperman at 9:22-34, 10:8-31, 11:11-22.

[262] *Id.* at 2:34-37, 4:7-17, 8:25-29; *see also id.* at 4:35-5:9, 9:22-27, 10:13-31.

[263] Silva Declaration at ¶ 221.

[264] Claim 4 depends upon claim 3.

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encoding a code resource using a stega-cipher process.[265] And as explained with respect to claim

3, Cooperman's code resource is steganographically encoded in a data resource.

Accordingly, Cooperman discloses claim 4.

5. Cooperman Anticipates Dependent Claim 5.

Cooperman discloses "*wherein said computer configuration information is stored in a*

data resource," as recited in claim 5.[266] Specifically, Cooperman states that the personalization

information (e.g., a license code) "can include a particular computer configuration."[267] And

Cooperman details that such information is stored in a data resource of the application.[268]

Accordingly, Cooperman discloses claim 5.

6. Cooperman Anticipates Dependent Claim 8.

Cooperman discloses "*wherein said computer comprises a processor and said*

application software using said processor in said prompting and said [application software][269]

storing," as recited in claim 8.[270] Specifically, Cooperman teaches that its computer has a

processor used by the computer's application software. Cooperman initially recognizes that "[a]

computer application seeks to provide a user with certain utilities or tools, that is, users interact

with a computer or similar device to accomplish various tasks and applications provide the

relevant interface."[271] And Cooperman discloses loading software object code into "computer

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[265] Cooperman at 9:22-34, 10:8-31; *see also id.* at 2:34-37, 4:7-17, 4:35-5:9.

[266] Claim 5 depends upon claim 1.

[267] Cooperman at 11:26-28; *see also id.* at 5:35-6:5.

[268] *Id.* at 9:22-34, 10:8-31, 11:11-22; *see also id.* at Abstract, claim 6; Silva Declaration at ¶ 227.

[269] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[270] Claim 8 depends upon claim 1.

[271] Cooperman at 3:16-20.

memory for the purpose of execution"[272] and accessing the loaded software by entering a key

"when prompted at start-up."[273]

Cooperman further discusses that its software includes functions made from executable

object code whose "order in the computer memory is of vital importance."[274] And Cooperman

explains that the computer may "process[] a digital sample stream for the purpose of modifying

it or playing the digital sample stream."[275] Accordingly, a POSITA would have understood that

Cooperman's computer includes a processor and memory for executing the stored software and

the user prompt. As expert Dr. Silva explains, Cooperman's computer would necessarily include

a processor and memory in order to function.[276]

Accordingly, Cooperman discloses claim 8.

7. Cooperman Anticipates Independent Claim 10.

a) *Preamble*: "A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising"

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless,

Cooperman discloses claim 10's preamble. Cooperman describes application software code that

is a computer program.[277] Cooperman, for instance, teaches its software code is encoded with

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[272] *Id.* at claim 5; *see also id.* at 13:31-36, claim 7.

[273] *Id.* at 1:25-28; *see also id.* at 11:25-28.

[274] *Id.* at 7:1-5.

[275] *Id.* at claim 4; *see also id.* at claims 5, 6 (processing digital sample stream and a map list).

[276] Silva Declaration at ¶¶ 230-31.

[277] Cooperman at Abstract, 5:25-6:5, 6:22-30, 11:10-33; *see also id.* at claims 1 and 4; Silva Declaration at ¶ 235.

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personalization information to digitally watermark the application program.[278] And as detailed

with respect to element 1.1, Cooperman's software code is stored in non-transient memory (i.e.,

storage media).

As detailed with respect to claim 1's preamble, Cooperman further states that the

software code causes the system to perform a series of steps to access application

functionalities.[279] Cooperman, for instance, states that "[o]nce [the application] has the license

code, it can then generate the proper decoding key to access the essential code resources."[280] And

Cooperman explains that "the present invention, [discloses] the software itself is a set of

commands, compiled by software engineer, which can be configured in such a manner as to tie

underlying functionality to the license or authorization of the copy in possession by the user."[281]

As such, Cooperman teaches this preamble.

b) **Element 10.1: "storing said application software code in non
transient memory of [said][282] computer system"**

Element 10.1 is substantially similar to element 1.1. As explained above, Cooperman

discloses each limitation of element 1.1. For the same reasons, Cooperman teaches element 10.1.

c) **Element 10.2: "said application software code in said computer
system prompting a user to enter into said computer system
personalization information"**

Element 10.2 is substantially similar to element 1.2. As explained above, Cooperman

discloses each limitation of element 1.2. For the same reasons, Cooperman teaches element 10.2.

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[278] Cooperman at 11:24-33.

[279] *Id.* at 5:35-6:5, 11:24-33; *see also id.* at 3:24-31, 11:34-37, 12:13-35, claim 2.

[280] *Id.* at 11:31-33.

[281] *Id.* at 5:35-6:5; Silva Declaration at ¶¶ 235-36.

[282] Ex. 2, Prosecution History at 429 (Certificate of Correction).

> d) **Element 10.3: "said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting"**

Element 10.3 is substantially similar to element 1.3. As explained above, Cooperman

discloses each limitation of element 1.3. For the same reasons, Cooperman teaches element 10.3.

> e) **Element 10.4: "said application software code in said computer system generating a proper decoding key, said generating comprising using said license code"**

Element 10.5 is substantially similar to element 1.5. As explained above, Cooperman

discloses each limitation of element 1.5. For the same reasons, Cooperman teaches element 10.5.

> f) **Element 10.5: "wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource"**

Element 10.5 is substantially similar to element 1.5. As explained above, Cooperman

discloses each limitation of element 1.5. For the same reasons, Cooperman teaches element 10.5.

Accordingly, Cooperman discloses claim 10.[283]

8. Cooperman Anticipates Dependent Claim 12.

Cooperman discloses "*wherein said computer program product causes storing of said*

encoded code resource in a data resource in non transient memory of said computer

[system],"[284] as recited in claim 12.[285] As discussed with respect to elements 1.2 and 1.3,

Cooperman explains that its application program includes encoded information and that "it stores

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[283] Silva Declaration at ¶ 248; *see also id.* at ¶¶ 238-47.

[284] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[285] Claim 12 depends upon claim 10.

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this information in a personalization data resource."[286] Specifically, Cooperman encodes the

personalization information into certain data resources using a stega-cipher process.[287]

Moreover, as discussed with respect to element 1.1, Cooperman teaches that the

application program is stored in non-transient memory of the computer system. Cooperman, for

instance, explains that its application program is compiled and assembled: "When code and data

resources are compiled and assembled into a precursor of an executable program the next step is

to use a utility application for final assembly of the executable application."[288] A POSITA would

have understood that Cooperman's compiled and assembled software is stored in non-transient

memory.[289]

Accordingly, Cooperman discloses claim 12.

**F.   SNQ-6: Claims 1, 2, 5, 8, 10, and 12 are Anticipated by Hicks Under 35
U.S.C. §§ 102(a), (e).**

Hicks anticipates claims 1, 2, 5, 8, 10, and 12 under 35 U.S.C. §§ 102(a), (e).

1.   Hicks Anticipates Independent Claim 1.

**a)   *Preamble*: "A computer based method for accessing
functionality provided by an application software comprising"**

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless,

Hicks discloses claim 1's preamble. Specifically, Hicks describes a method for controlling access

to software distributed to a user by a vendor in which a verification key is generated by a product

key generator.[290] Hicks, for instance, explains that the application software is accessible using

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[286] Cooperman at 11:27-30.

[287] *Id.* at 8:25-29, 9:22-27, 10:13-20; *see also id.* at Abstract, 11:11-24, claim 6.

[288] *Id.* at 10:8-11; *see also id.* at 7:1-21.

[289] Silva Declaration at ¶¶ 250-51.

[290] Hicks at Abstract.

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the key, which is either embedded in the software prior to distribution or packaged with the

software as a self-installing package.[291] The user then uses the verification key to access certain

functionality provided by the application software:

> Using the verification key, a user key verifier verifies a relationship between the
> user key and the user identifying information to determine an access level to the
> protected software. The system verifies the relationship between the user key and
> the user identifying information every time the software is run to ensure continued
> protection of the software after installation.[292]

> Hicks illustrates the use key verification process for accessing portions of the software in

Figure 3a and 3b, shown below:
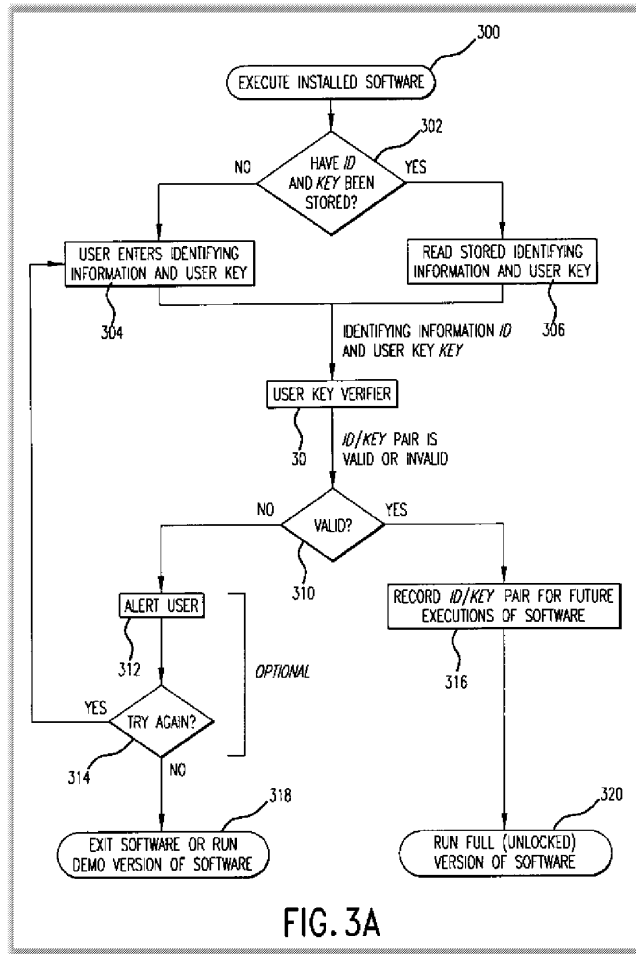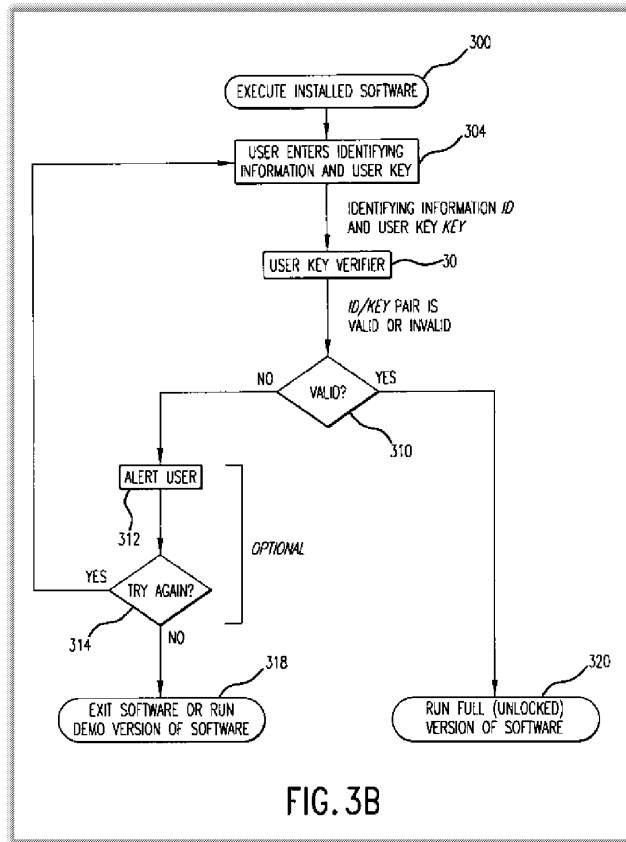
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[291] *Id.*

[292] *Id.*

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FIG. 3A

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FIG. 3B

In Hicks, access to locked portions of the application (step 320), is not granted to the user until a valid ID or key is entered (step 310).[293]

As such, Hicks teaches this preamble.[294]

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[293] *Id.* at 4:10-34, Figs. 3A and 3B.

[294] Silva Declaration at ¶¶ 255-58.

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      b)   ***Element 1.1*: "storing said application software in non transient memory of a computer"**

Hicks discloses element 1.1. Hicks states that the "user installs the software on a user computer system as protected software."[295] As shown below in Hicks' Figure 6, the user typically installs the software onto the user's system 29 comprising a primary storage device 604, or alternatively, the software may be run from the user's system CD-ROM drive 606.

FIG.6
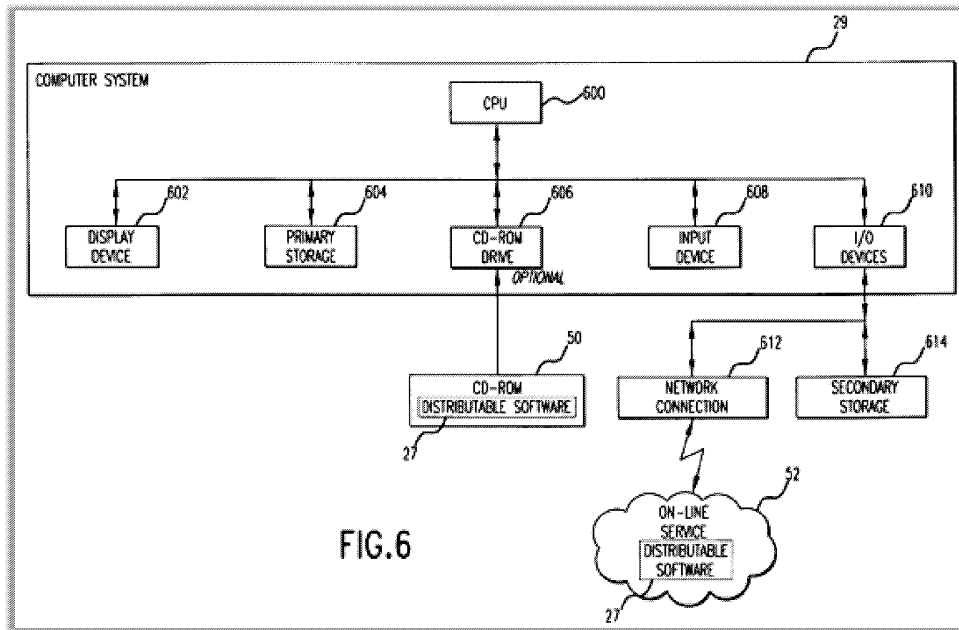
Hicks specifies that "the distributable software 27 may be used on the user's system" and "[t]he user's system would typically include a central processing unit 600, an input device 608, input/output devices 610, a display device 602 and a primary storage device 604."[296] Further, "the software might be run directly from a CD-ROM drive 606, or moved from CD-ROM 50, the

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[295] Hicks at Abstract. *See also id.* at Figs. 3A and 3B ("installed software 300"), 3:56-57 ("FIGS. 3A and 3B summarize execution 300 of the protected software 90 on the user's system.")

[296] *Id.* at 5:28-32.

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network connection 612 or secondary storage device 614 to the primary storage device 604 and

run from there."[297]

Hicks further teaches that the software may also be transmitted "from location to location

electronically, between on-line services, users, and so on" and is installed 10 on a computer

system 29.[298]

As such, A POSITA would have understood that Hicks' storage devices are non-transient

memory of the computer.[299]

    c) ***Element 1.2*: "said application software in said computer
         prompting a user to enter into said computer personalization
         information"**

Hicks discloses element 1.2. Hicks describes a key verification process that includes the

step of "the software prompts 312 the user to enter" the ID and key.[300] Hicks explains that the

software checks if a valid ID and key are stored. If a valid ID and key are not found, it prompts

the user to enter the necessary ID and key in order to access locked portions of the software:

> **In FIG. 3A, the software checks to see if an ID and key for the product were
> stored 302 on the system. If an ID and key were not stored, then the user enters
> 304 identifying information and a user key.** If an ID and key were stored, then
> the software reads 306 the ID and key and passes this information to the user key
> verifier 30. The user key verifier 30 determines whether or not the ID and key are
> valid 310.

> **If the ID and key were invalid 310, then the software prompts 312 the user to
> enter them.** The software may allow the user only a limited number of entry
> attempts. If the user chooses to try again 314, and such entry is allowed, then the
> user enters identifying information and a user key 304 and the new ID and key are
> passed to the user key verifier 30. If the user does not try again 314, then the
> software determines that it is not unlocked and it exits or runs 318 a version of the
> program that is consistent with what the license agreement allows for, given that

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[297] *Id.* at 5:32-37.

[298] *Id.* at 5:25-27. *See also id.* at Figs. 4A and 4B.

[299] Silva Declaration at ¶¶ 260-63.

[300] Hicks at 3:65-66.

the ID and key have not been verified. Typically the software either exits or runs
318 a demo version of itself.[301]

The prompt to a user to enter a valid ID and key is clearly shown in Figure 3A and 3B at

step 312 "Alert User":

FIG. 3A

[301] *Id.* at 3:56-4:9.

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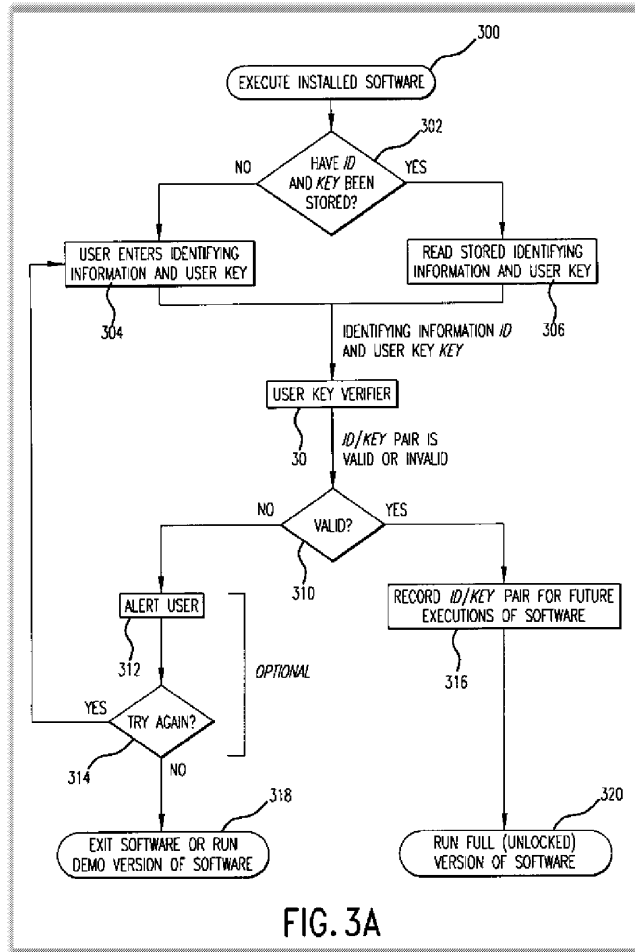
FIG. 3B

Moreover, Hicks describes the ID as identifying information that may include the

information unique to the user and the user's system:

> The distributable software c is then distributed 60 to users. The user installs 10 the software on his computer system 29, if necessary, and executes the protected software. The following user key verification stages may, but need not, occur during installation.

> **The user then provides 74 his identifying information to the software vendor or its agent 22.** As illustrated in FIG. 2B, the user may provide this information by way of the software. **This identifying information may include information identifying the user, his computer system, and/or licensing information, such as a time limit, expiration date, number of concurrent licenses, etc.**[302]

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[302] *Id.* at 6:54-65.

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FIG.2B
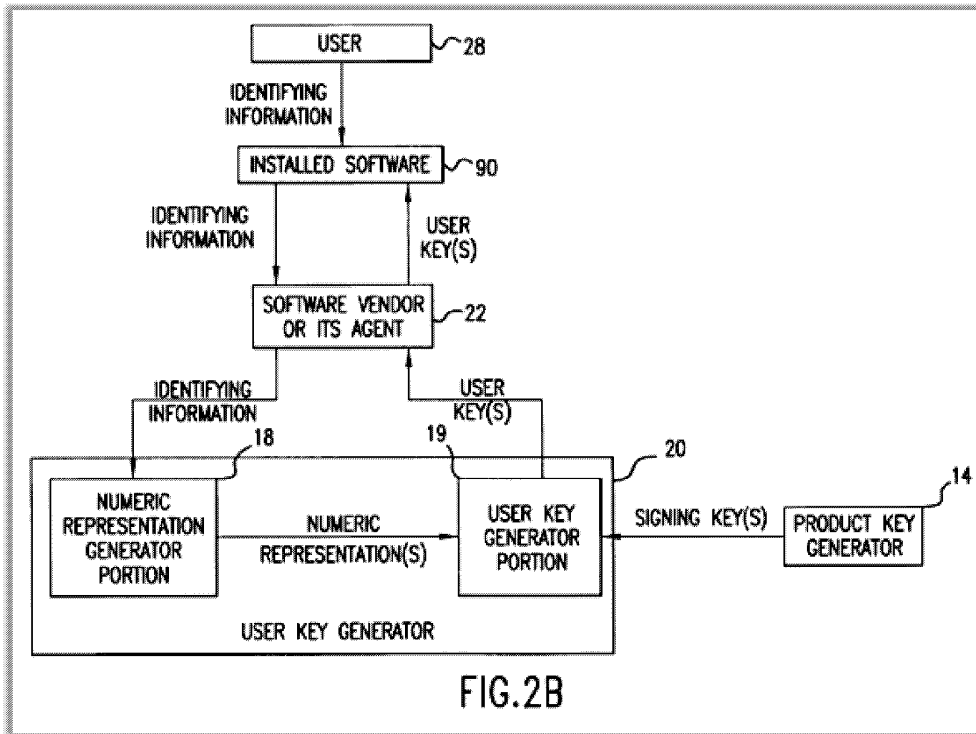
Accordingly, a POSITA would have understood that the ID and key entered into the

computer by the user, as disclosed by Hicks, contains personalization information.[303]

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[303] Silva Declaration at ¶¶ 266-69.

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    d)   ***Element 1.3*: "said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting"**

Hicks discloses element 1.3. Hicks explains that its application software includes data resources,[304] for storing a license code entered in response to a prompt by the software and computer configuration information of the user's computer.[305]

For example, Hicks describes a process where the installed software application prompts the user to enter a valid ID and key. After receiving said valid ID and key input from the user, the software application stores said ID and key:

> FIGS. 3A and 3B summarize execution 300 of the protected software 90 on the user's system. **In FIG. 3A, the software checks to see if an ID and key for the product were stored 302 on the system. If an ID and key were not stored, then the user enters 304 identifying information and a user key.** If an ID and key were stored, then the software reads 306 the ID and key and passes this information to the user key verifier 30. The user key verifier 30 determines whether or not the ID and key are valid 310.

> **If the ID and key were invalid 310, then the software prompts 312 the user to enter them.** The software may allow the user only a limited number of entry attempts. If the user chooses to try again 314, and such entry is allowed, then the user enters identifying information and a user key 304 and the new ID and key are passed to the user key verifier 30. If the user does not try again 314, then the software determines that it is not unlocked and it exits or runs 318 a version of the program that is consistent with what the license agreement allows for, given that the ID and key have not been verified. Typically the software either exits or runs 318 a demo version of itself.

> **When a valid ID and key combination reach the user key verifier 30, the ID and key are stored 316**, so that subsequent executions of the software will not require the ID and key to be reentered, and the full, unlocked version of the software is run 320.[306]

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[304] Requester interprets the term "data resources" as best understood based on the '602 Patent and prosecution history.

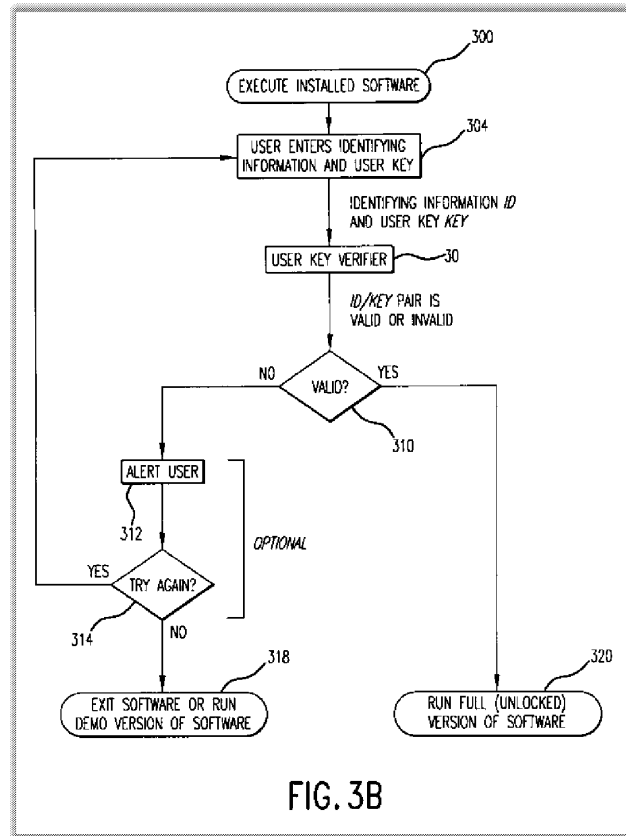[305] Hicks at 3:56-4:14, 6:54-65.

[306] *Id.* at 3:56-4:14.

FIG. 3A
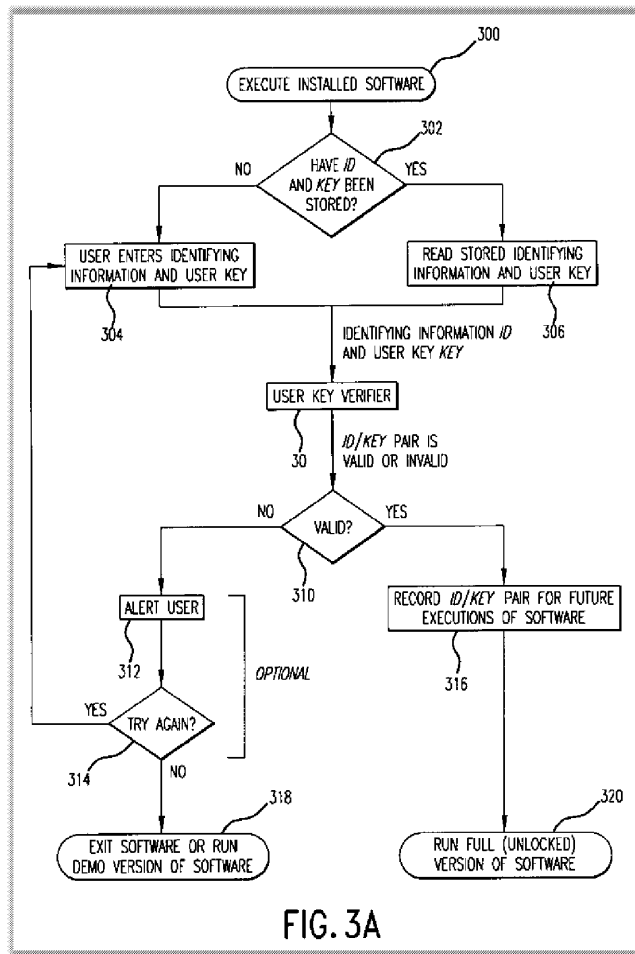
Moreover, Hicks describes the stored user ID as identifying information that may include

the information unique to the user and the user's system:

> The distributable software c is then distributed 60 to users. The user installs 10 the software on his computer system 29, if necessary, and executes the protected software. The following user key verification stages may, but need not, occur during installation.
>
> **The user then provides 74 his identifying information to the software vendor or its agent 22.** As illustrated in FIG. 2B, the user may provide this information by way of the software. **This identifying information may include information**

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**identifying the user, his computer system, and/or licensing information, such
as a time limit, expiration date, number of concurrent licenses, etc.[307]**

FIG.2B

As such, a POSITA would have understood that Hicks discloses software that includes a

personalization data resource used to store a license code (user key) and computer configuration

information (ID information that may include computer system identification information).[308]

And as described with respect to elements 1.1 and 1.2, Hicks' software is stored in non-transient

memory and the user ID and key are entered in response to the software application's prompting.

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[307] *Id.* at 6:54-65.

[308] Silva Declaration at ¶¶ 272-75.

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e)   *Element 1.4*: **"said application software in said computer
generating a proper decoding key, said generating comprising
using said license code"**

Hicks discloses element 1.4. Hicks specifically discloses that a verification key is

generated by a product key generator either embedded in the software prior to distribution or

packaged with the software as a self-installing package:

> A system and method for controlling unauthorized access to software distributed to
> a user by a vendor in which **a verification key is generated by a product key
> generator** and either embedded in the software prior to distribution or packaged
> with the software as a self-installing package. **The verification key includes a
> private signing key and a public verification key. The combination of the
> software and the verification key create distributable software which is
> distributed to a user.** The user installs the software on a user computer system as
> protected software. To obtain a user key, the user inputs user identifying
> information which is sent to a user key generator. The user key generator converts
> the user identifying information to a numeric representation and then generates, by
> signing the numeric representation with the private signing key, a user key, which
> is returned to the user. **Using the verification key, a user key verifier verifies a
> relationship between the user key and the user identifying information to
> determine an access level to the protected software**. The system verifies the
> relationship between the user key and the user identifying information every time
> the software is run to ensure continued protection of the software after
> installation.[309]

Hicks further teaches that the user key is created with licensing information:[310]

> FIGS. 2A and 2B show how the user obtains a key. In FIG. 2A, the user 28 passes
> an ID which might be his name, machine ID, credit card number or other piece of
> unique identifying information, to the software vendor or a third-party agent 22.
> The ID and the signing keys for the product are passed into the user key generator
> 20. A numeric representation generator portion 18 converts the ID and signing keys
> into a numeric representation. **A user key generator portion 19 uses the numeric
> representation to generate a user key for the user.** This key is returned to the
> software vendor or third-party agent 22, who in turn passes it on to the user 28.

> **Of note is that the identifying information on which the numeric
> representation is based may include licensing information**. This licensing
> information may or may not be passed from the user to the vendor. For example,

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[309] Hicks at Abstract.

[310] *Id.* at 3:29-47, 6:54-7:20.

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the user may be able to specify a number of concurrent licenses. If not, the vendor
will pass the additional information back to the user (or software).[311]

FIG.2A
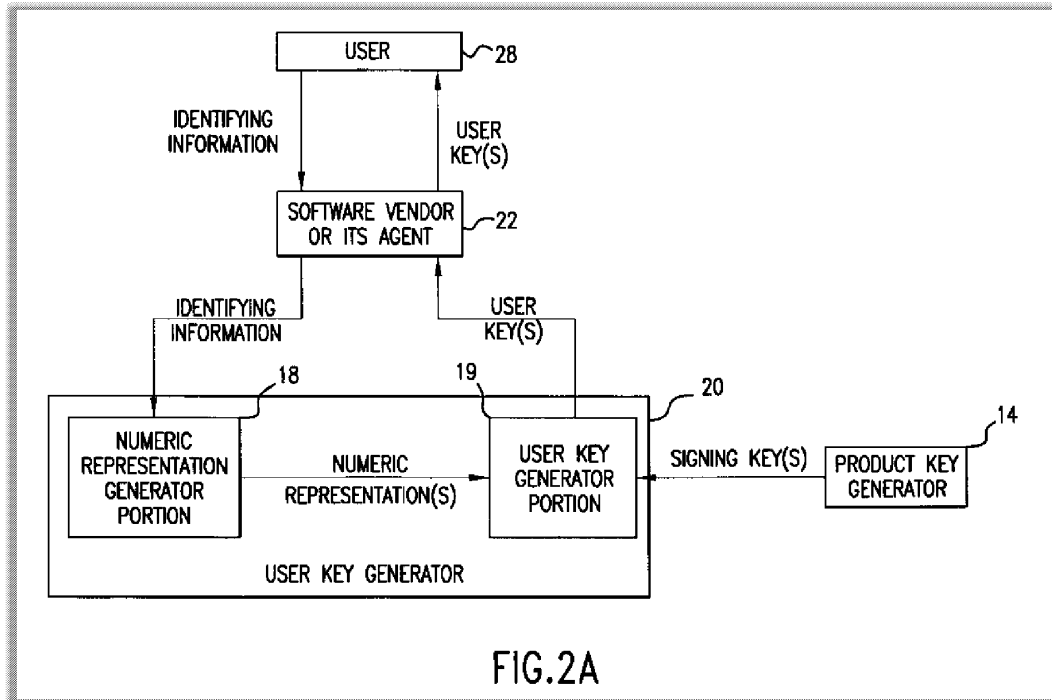
As such, a POSITA would have understood that application software disclosed in Hicks

generates a proper decoding key (user key) using a license code (licensing information)[312].

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[311] *Id.* at 3:29-47.

[312] Silva Declaration at ¶¶ 278-80.

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    f)   *Element 1.5*: **"wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource"**

Hicks discloses element 1.5. As explained with respect to element 1.3, Hicks specifies that the software cannot access certain functionalities unless the license code corresponding to the prompt is stored on the user's system:[313]

> FIGS. 3A and 3B summarize execution 300 of the protected software 90 on the user's system. **In FIG. 3A, the software checks to see if an ID and key for the product were stored 302 on the system. If an ID and key were not stored, then the user enters 304 identifying information and a user key.** If an ID and key were stored, then the software reads 306 the ID and key and passes this information to the user key verifier 30. The user key verifier 30 determines whether or not the ID and key are valid 310.
>
> **If the ID and key were invalid 310, then the software prompts 312 the user to enter them.** The software may allow the user only a limited number of entry attempts. If the user chooses to try again 314, and such entry is allowed, then the user enters identifying information and a user key 304 and the new ID and key are passed to the user key verifier 30. If the user does not try again 314, then the software determines that it is not unlocked and it exits or runs 318 a version of the program that is consistent with what the license agreement allows for, given that the ID and key have not been verified. Typically the software either exits or runs 318 a demo version of itself.
>
> **When a valid ID and key combination reach the user key verifier 30, the ID and key are stored 316, so that subsequent executions of the software will not require the ID and key to be reentered, and the full, unlocked version of the software is run 320.**[314]

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[313] Hicks at 3:56-4:14, Figure 3A; *see also id.* at 11:53-12:6, Figs.10A-10B.

[314] *Id.* at 3:56-4:14.

FIG. 3A
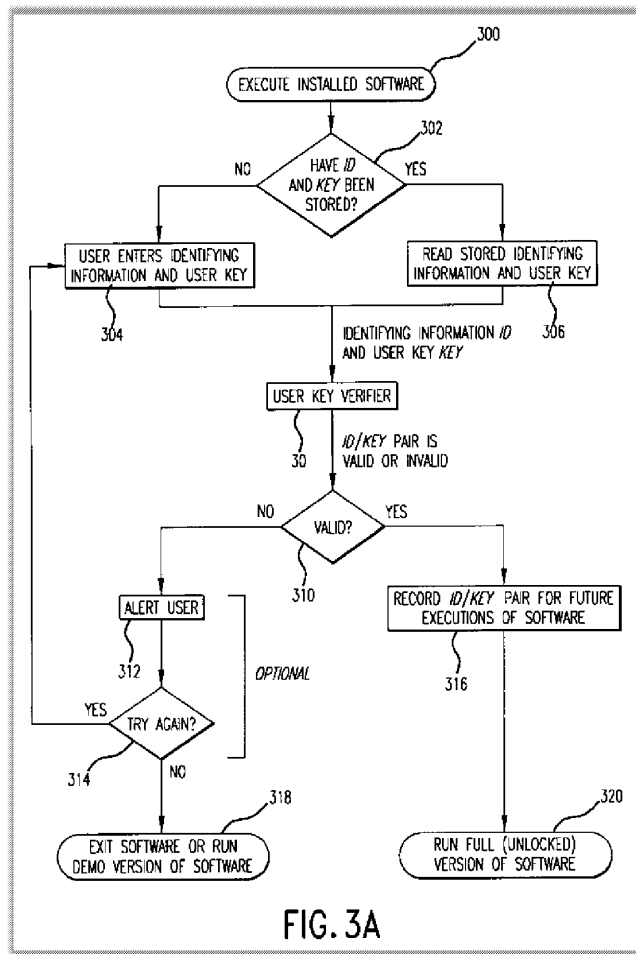
As such, a POSITA would have understood that Hicks teaches a software installed in the customer's computer cannot access at least one encoded code resource unless the license code is stored in the personalization data resource.[315]

Accordingly, Hicks discloses claim 1.

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[315] Silva Declaration at ¶ 283.

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2.   **Hicks Anticipates Dependent Claim 2.**

Hicks discloses "*wherein said encoded code resource is encoded in at least one data*

resource," as recited in claim 2.[316] Hicks describes embedding the generated verification key in

the software: "A system and method for controlling unauthorized access to software distributed

to a user by a vendor in which a verification key is generated by a product key generator and

either embedded in the software prior to distribution or packaged with the software as a self-

installing package."[317] The embedding or integrating of said user key verifier and verification

keys into the distributable software is further detailed at length in Hicks.[318] For example, Figures

4A, 9B, and 10B show various methods of embedding verification components into the software:

FIG.4A

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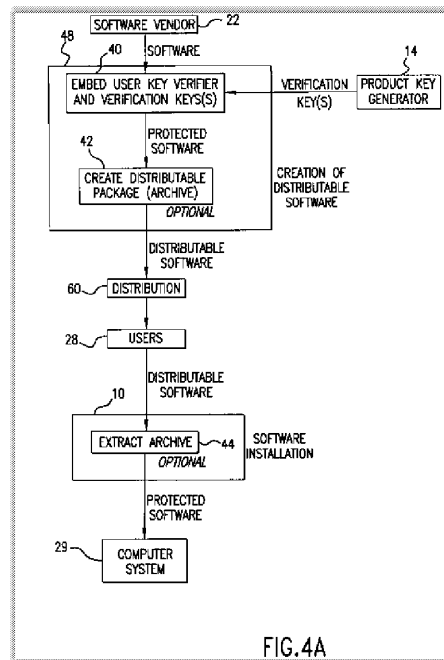
[316] Claim 2 depends upon claim 1.

[317] Hicks at Abstract. *See also id.* at 4:42-48, 10:11-12:40, Figs. 4A, 9A-9B.

[318] *Id.* at 10:11-12:40, Figs. 4A, 9A-9B.
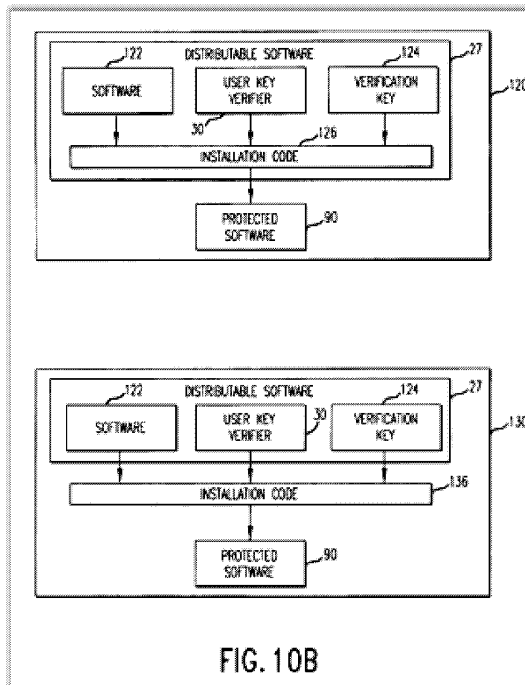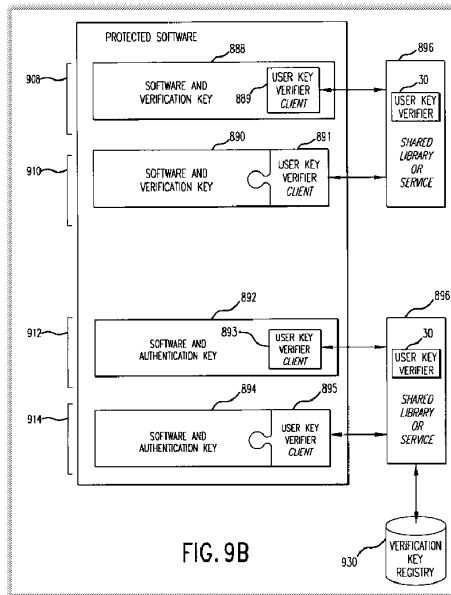
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FIG. 9B

FIG. 10B

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A POSITA would have understood that adding verification components into the software corresponds to encoding a code resource in a data resource.[319]

Accordingly, Hicks discloses claim 2.

3. Hicks Anticipates Dependent Claim 5.

Hicks discloses "*wherein said computer configuration information is stored in a data resource.*"[320] Hicks discloses a method of producing protected software, including the embedding of certain components, such as computer configuration information, in the software.[321] For example:

> FIGS. 9A and 9B illustrate some combinations of software, laser key verifiers, and verification keys which produce protected software 90, including the embedding of components in the software. Two items are required for the protected software: the verification keys and the user key verifier.

> In FIG. 9A, protected software 90 shows the normal model, in which the protected software contains or links to its own user key verifier. As shown in section 900, the verification key 880 may be actually contained in the software 881.[322]

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[319] Silva Declaration at ¶¶ 286-87. Requester interprets the terms "code resource" and "data resources" as best understood based on the '602 Patent and prosecution history.

[320] Claim 5 depends upon claim 1.

[321] Hicks at 10:11-45.

[322] *Id.* at 10:11-21.
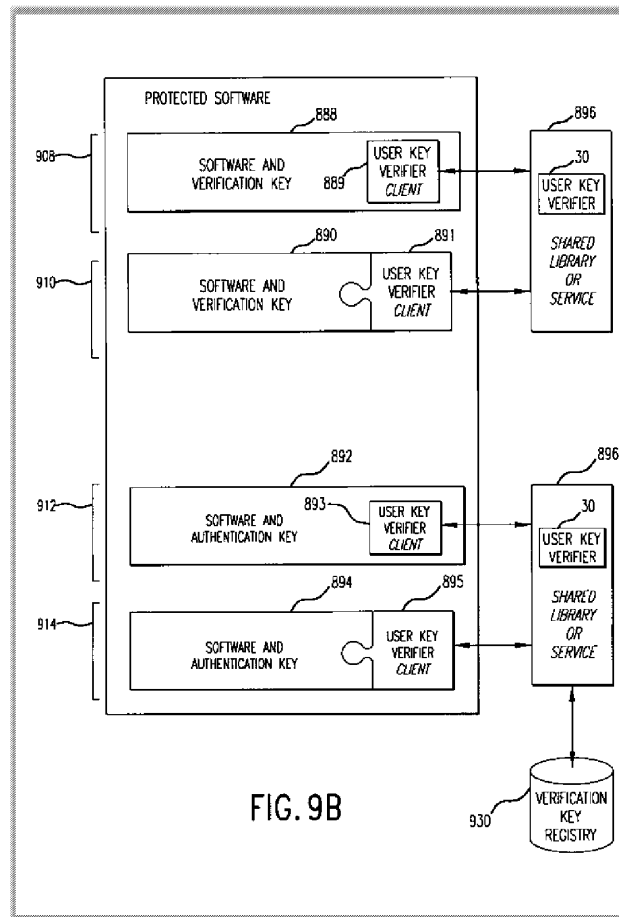
FIG. 9B

The stored verification key, as Hicks teaches, is generated based on certain types of data, such as

computer configuration information:

> The distributable software c is then distributed 60 to users. The user installs 10 the
> software on his computer system 29, if necessary, and executes the protected
> software. The following user key verification stages may, but need not, occur
> during installation.
>
> **The user then provides 74 his identifying information to the software vendor
> or its agent 22**. As illustrated in FIG. 2B, the user may provide this information by
> way of the software. **This identifying information may include information**

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user enters identifying information and a user key 304 and the new ID and key are passed to the user key verifier 30. If the user does not try again 314, then the software determines that it is not unlocked and it exits or runs 318 a version of the program that is consistent with what the license agreement allows for, given that the ID and key have not been verified. Typically the software either exits or runs 318 a demo version of itself.

When a valid ID and key combination reach the user key verifier 30, the ID and key are stored 316, so that subsequent executions of the software will not require the ID and key to be reentered, and the full, unlocked version of the software is run 320.[324]

FIG. 3A

[324] *Id.* at 3:56-4:14.

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A POSITA would have understood the storing of the computer configuration information

(verification key and ID) both within the software and on the user's system corresponds to

computer configuration information stored in a data resource.[325]

4.   Hicks Anticipates Dependent Claim 8.

Hicks discloses *"wherein said computer comprises a processor and said application*

software using said processor in said prompting and said [application software][326] storing," as

recited in claim 8.[327] Specifically, Hicks teaches that its computer (user system) has a processor

(CPU 600) used by the computer's application software for storage and execution of the software

application.[328] Hicks discloses that "[t]he user's system would typically include a central

processing unit 600, an input device 608, input/output devices 610, a display device 602 and a

primary storage device 604."[329] Hicks' Figure 1 illustrates this processor 600 used by the

software:

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[325] Silva Declaration at ¶¶ 290-93.

[326] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[327] Claim 8 depends upon claim 1.

[328] Hicks at 5:28-38, Fig. 6.

[329] *Id.* at 5:29-32.

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FIG.6
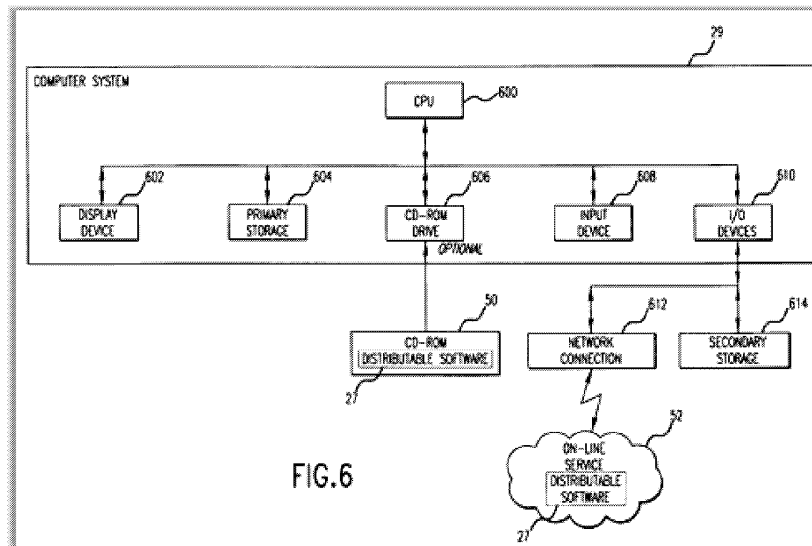
Further, as explained above in element 1.3, if a valid ID and key is not found, the

software, using the computer's processor, prompts the user to enter the necessary ID and key in

order to access locked portions of the software.[330]

Accordingly, Hicks discloses claim 8.[331]

5. Hicks Anticipates Independent Claim 10.

a)   *Preamble*: "A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising"

Under the broadest reasonable construction, the preamble is non-limiting. Nevertheless,

Hicks discloses claim 10's preamble. The preamble of claim 10 is substantially similar to the

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[330] *Id.* at 3:56-4:9, Figs. 3A-3B.

[331] Silva Declaration at ¶¶ 296-97.

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preamble of claim 1 and element 1.1. As explained above, Hicks discloses each limitation of the

preamble of claim 1 and each limitation of element 1.1. For the same reasons, Hicks teaches the

preamble of claim 10.[332]

> b)   *Element 10.1*: **"storing said application software code in non transient memory of [said][333] computer system"**

Element 10.1 is substantially similar to element 1.1. As explained above, Hicks discloses

each limitation of element 1.1. For the same reasons, Hicks teaches element 10.1.

> c)   *Element 10.2*: **"said application software code in said computer system prompting a user to enter into said computer system personalization information"**

Element 10.2 is substantially similar to element 1.2. As explained above, Hicks discloses

each limitation of element 1.2. For the same reasons, Hicks teaches element 10.2.

> d)   *Element 10.3*: **"said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting"**

Element 10.3 is substantially similar to element 1.3. As explained above, Hicks discloses

each limitation of element 1.3. For the same reasons, Hicks teaches element 10.3.

> e)   *Element 10.4*: **"said application software code in said computer system generating a proper decoding key, said generating comprising using said license code"**

Element 10.5 is substantially similar to element 1.5. As explained above, Hicks discloses

each limitation of element 1.5. For the same reasons, Hicks teaches element 10.5.

---

[332] Silva Declaration at ¶¶ 301-13.

[333] Ex. 2, Prosecution History at 429 (Certificate of Correction).

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    f)   ***Element 10.5*: "wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource"**

Element 10.5 is substantially similar to element 1.5. As explained above, Hicks discloses each limitation of element 1.5. For the same reasons, Hicks teaches element 10.5.

Accordingly, Hicks discloses claim 10.[334]

    6.   **Hicks Anticipates Dependent Claim 12.**

Hicks discloses "*wherein said computer program product causes storing of said encoded code resource in a data resource in non transient memory of said computer [system]*,"[335] as recited in claim 12.[336] Hicks describes a process where the installed software application prompts the user to enter a valid ID and key for storage:

> FIGS. 3A and 3B summarize execution 300 of the protected software 90 on the user's system. **In FIG. 3A, the software checks to see if an ID and key for the product were stored 302 on the system. If an ID and key were not stored, then the user enters 304 identifying information and a user key.** If an ID and key were stored, then the software reads 306 the ID and key and passes this information to the user key verifier 30. The user key verifier 30 determines whether or not the ID and key are valid 310.
>
> **If the ID and key were invalid 310, then the software prompts 312 the user to enter them.** The software may allow the user only a limited number of entry attempts. If the user chooses to try again 314, and such entry is allowed, then the user enters identifying information and a user key 304 and the new ID and key are passed to the user key verifier 30. If the user does not try again 314, then the software determines that it is not unlocked and it exits or runs 318 a version of the program that is consistent with what the license agreement allows for, given that the ID and key have not been verified. Typically the software either exits or runs 318 a demo version of itself.
>
> **When a valid ID and key combination reach the user key verifier 30, the ID and key are stored 316**, so that subsequent executions of the software will not

---

[334] Silva Declaration at ¶ 313; *see also id.* at ¶¶ 303-12.

[335] Ex. 2, Prosecution History at 429 (Certificate of Correction).

[336] Claim 12 depends upon claim 10.

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require the ID and key to be reentered, and the full, unlocked version of the software is run 320.[337]
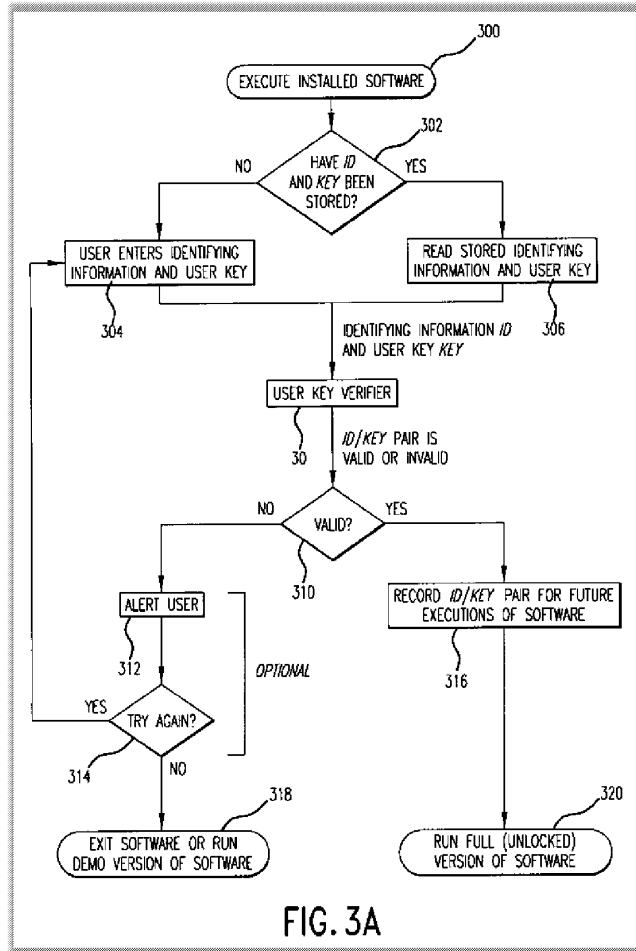
FIG. 3A

Hicks further discloses that, in addition to storing the verification key and ID onto the user's computer, certain verification components, such as the verifying key generator, may also be stored on the user's system:

FIGS. 9A and 9B illustrate some combinations of software, laser key verifiers, and verification keys which produce protected software 90, including the embedding of

---

[337] Hicks at 3:56-4:14.

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components in the software. Two items are required for the protected software: the verification keys and the user key verifier.

In FIG. 9A, protected software 90 shows the normal model, in which the protected software contains or links to its own user key verifier. As shown in section 900, the verification key 880 may be actually contained in the software 881.[338]
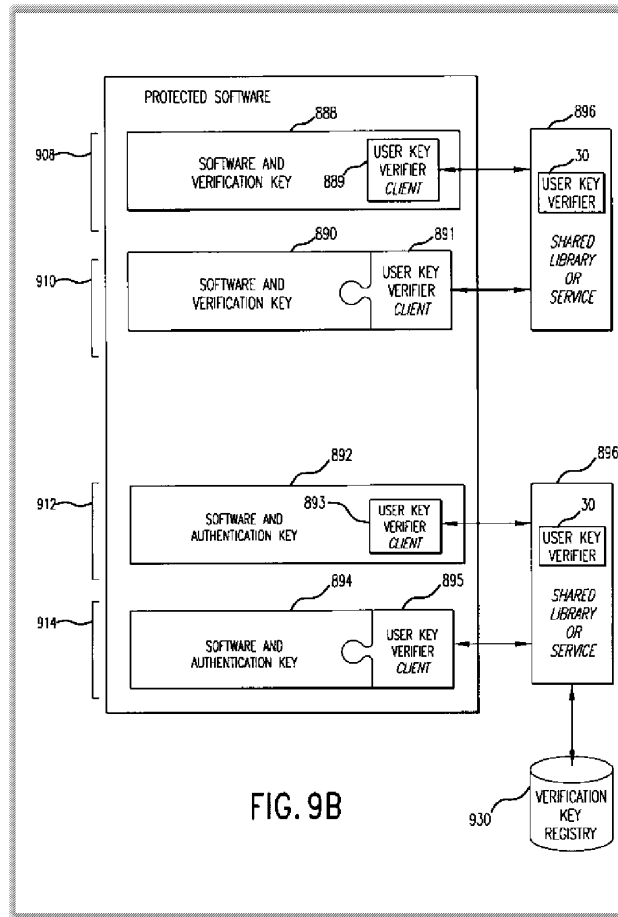
FIG. 9B

Hicks discloses that its encoded code resources (verification components and ID) are stored on the non-transient memory of the user's computer: "the distributable software 27 may be used on the user's system" and "[t]he user's system would typically include a central

---

[338] *Id.* at 10:11-21.

processing unit 600, an input device 608, input/output devices 610, a display device 602 and a

primary storage device 604."[339]
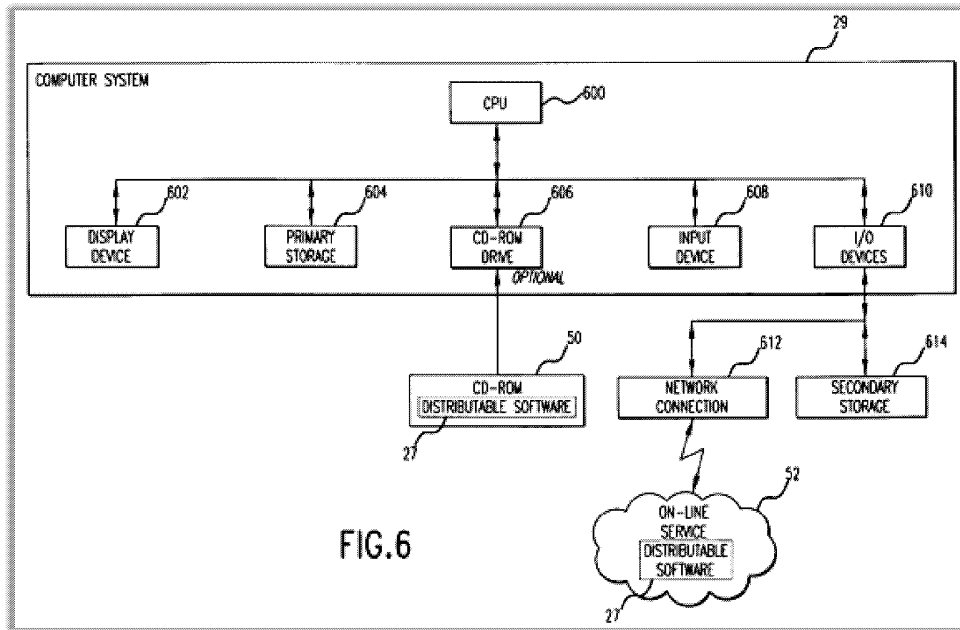
FIG.6

A POSITA would have understood that adding verification components into the software

corresponds to encoding a code resource in a data resource.[340] As described with respect to

elements 1.1 and 10.1, Hicks' software code is stored in non-transient memory of the user's

computer.

Accordingly, Hicks discloses claim 12.

---

[339] *Id.* at 5:28-32.

[340] Silva Declaration at ¶¶ 315-18.

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G.   SNQ-7: Claims 3 and 4 are Rendered Obvious by the Combination of Hicks and Rhoads Under 35 U.S.C. § 103(a).

The combination of Hicks and Rhoads renders obvious claims 3 and 4 under 35 U.S.C. § 103(a). Specifically, Hicks in view of Rhoads renders obvious:

- Claim 3: "The method of claim 1 wherein said encoded code resource is steganographically encoded."

- Claim 4: "The method of claim 3 wherein said encoded code resource is encoded in a data resource."

As explained with respect to claim 2, Hicks describes encoding the code resource in at least one data resource. While Hicks teaches encoding a code resource, it does not expressly describe encoding the code resource using steganographic encoding. But this type of encoding was known in the art and would have been obvious to use in Hicks' system.

Specifically, Rhoads describes encoding licensing information into software using steganographic encoding. For instance, Rhoads teaches generating a software component like an image or graphic encoded steganographically to include a 16-bit main identification number.[341] And Rhoads teaches that this steganographic encoding technique embeds identification information into a data source, such as an image, without a perceptible decrease in fidelity.[342]

Rhoads explains this method of steganographic encoding in its claim 1:

In a method of image processing that includes processing an input image to steganographically encode a multi-bit message code therein, thereby yielding an encoded output image, and thereafter processing suspect data corresponding to said encoded output image to decode the message code therefrom, an improvement including:

encoding the message code redundantly through the image data…; and

decoding the message code from said suspect data without reference to said input image, … and analyzing said transformed data.[343]

---

[341] Rhoads at 6:62-67, 7:45-51, 8:44-9:4, claim 1; *see also id.* at 11:45-62, Figs 2-3.

[342] *Id.* at 2:49-59, 5:31-39.

[343] *Id.* at claim 1; *see also id.* at claims 2, 8, 12.

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Moreover, Rhoads details the use of steganographic encoding in applications that use an

identification key to determine whether to execute a particular code resource such as word

processor applications:

> [S]ome applications can utilize a universal set of individual embedded code signals,
> i.e., codes which remain the same for all instances of distributed material, This type
> of requirement would be seen by systems which wish to hide the N-bit identification
> word itself, yet have standardized equipment be able to read that word. This can be
> used in systems which make go/no go decisions at point-of-read locations.... Use
> of the Invention in ... Documents ... and Other Material Where Global Embedded
> Codes Can Be Imprinted."[344]

In view of Rhoads' teachings, a POSITA would have found it obvious to use a form of

steganographic encoding when encoding Hicks' encoded code resource.[345] For instance, a

POSITA would have found it obvious to encode steganographic license information into one of

the graphics used in Hicks' software applications.[346] A POSITA would have been motivated to

do so because Rhoads teaches steganographically encoding identification information into a data

source, such as an image, without a perceptible decrease in the quality of the data resource.[347]

Moreover, using steganographic encoding to encode Hicks' code resource would simply

be a matter of design choice selected from a finite number of predictable encoding solutions with

a reasonable expectation of success.[348] A POSITA would have recognized the number of

predictable solutions to encode Hicks' code resource to include steganographic encoding. For

instance, the '602 Patent specifies that steganographically encoding was known in the art:

> As described in previous disclosures, "Steganographic Method and Device" and
> "Human Assisted Random Key Generation and Application for Digital Watermark

---

[344] *Id.* at 14:26-33, 14:40-43.

[345] Silva Declaration at ¶¶ 321-26.

[346] *Id.* at ¶ 326.

[347] Rhoads at 2:49-59, 5:31-39; Silva Declaration at ¶ 326.

[348] Silva Declaration at ¶ 327.

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System," watermarks are particularly suitable to the identification, metering, distributing and authenticating digitized content such as pictures, audio, video and derivatives thereof under the description of" multimedia content." Methods have been described for combining both cryptographic methods, and steganography, or hiding something in plain view.[349]

Similarly, Cooperman details that using steganographic encoding to encode a code resource was known in that art:

> These keys make it impossible for a party to find the watermark without having the key. In addition, the encoding method can be enhanced to force a party to cause damage to a watermarked data stream when trying to erase a random-key watermark. Digital watermarks are described in "Steganographic Method and Device" - The DICE Company, Serial No. 08/489,172, the disclosure of which is hereby incorporated by reference.[350]

This demonstrates that steganographic encoding code resources was known in the art since Application No. 08/489,172 issued as U.S. Patent No. 5,613,004 on March 18, 1997, which is more than one year before the earliest possible priority date for the '602 Patent. As such, a POSITA would have found it obvious to steganographically encode a code resource into one of Hicks' data resources such that the code resource could not be removed without making the application inoperable.[351]

With respect to claim 4, Hicks teaches its encoded code resource is encoded in a data resource. This is described with respect to claim 2, which recites this limitation. As such, the combination of Hicks and Rhoads renders obvious claim 4 since it depends upon obvious claim 3.[352]

Accordingly, Hicks in view of Rhoads renders obvious claims 3 and 4.

---

[349] '602 Patent at 3:14-23; *see also id.* at 6:15-40, 8:35-40, 12:29-31, 14:25-30.

[350] *E.g.*, Cooperman at 2:30-37.

[351] Silva Declaration at ¶ 327.

[352] *Id.* at ¶ 328.

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XI.   CONCLUSION

As shown above, the prior art references establish that independent claims 1 and 10 are invalid as anticipated and that dependent claims 2-5, 8, and 12 are invalid as anticipated or obvious. In light of the substantial new questions of patentability raised by these references, Requester respectfully seeks *ex parte* reexamination of claims 1-5, 8, 10, and 12 of the '602 Patent.

As identified in the attached Certificate of Service and in accordance with 37 C.F.R. §§ 1.33(c) and 1.510(b)(5), a copy of the present Request, in its entirety, is being served to the address of the attorney of record reflected in the publicly available records of the United States Patent & Trademark Office's Patent Application Information Retrieval system.

Please direct all correspondence in this matter to the undersigned.

Dated: May 11, 2018   By: /Joseph F. Edell/
                                      Joseph F. Edell
                                      Reg. No. 67,625
                                      Counsel for Requester

                                      Fisch Sigler LLP
                                      5301 Wisconsin Avenue NW
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                                      Fax: (202) 362-3501

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602		6880

31518   7590   05/16/2018
NEIFELD IP LAW, PC
5400 Shawnee Road
Suite 310
ALEXANDRIA, VA 22312-2300

EXAMINER
WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
05/16/2018	PAPER

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

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FISCH SIGLER LLP
5301 WISCONSIN AVENUE, NW
FOURTH FLOOR
WASHINGTON, DC 20015

Date: **MAY 1 6 2018**

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014137
PATENT NO. : 9021602
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)).

	Control No.	Patent For Which Reexamination is Requested
Ex Parte Reexamination Interview Summary – Pilot Program for Waiver of Patent Owner's Statement	90/014,137	9,021,602
	Examiner	Art Unit
	WOOD	3992

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

All participants (USPTO official and patent owner):

(1) MANUEL SALDANA, CRU   (3)

(2) BRUCE MARGULIES, REG. NO. 64,175   (4)

Date of Telephonic Interview: 05/15/2018.

The USPTO official requested waiver of the patent owner's statement pursuant to the pilot program for waiver of patent owner's statement in *ex parte* reexamination proceedings.*

☐ The patent owner **agreed** to waive its right to file a patent owner's statement under 35 U.S.C. 304 in the event reexamination is ordered for the above-identified patent.

☐ The patent owner **did not agree** to waive its right to file a patent owner's statement under 35 U.S.C. 304 at this time.

The patent owner is <u>not</u> required to file a written statement of this telephone communication under 37 CFR 1.560(b) or otherwise. However, any disagreement as to this interview summary must be brought to the immediate attention of the USPTO, and no later than one month from the mailing date of this interview summary. Extensions of time are governed by 37 CFR 1.550(c).

*For more information regarding this pilot program, see *Pilot Program for Waiver of Patent Owner's Statement in Ex Parte Reexamination Proceedings*, 75 *Fed. Reg.* 47269 (August 5, 2010), available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

☒ USPTO personnel were unable to reach the patent owner.

The patent owner may contact the USPTO personnel at the telephone number provided below if the patent owner decides to waive the right to file a patent owner's statement under 35 U.S.C. 304.

/MANUEL SALDANA/   571-272-7740
Signature and telephone number of the USPTO official who contacted or attempted to contact the patent owner.

cc: Requester (if third party requester)

U.S. Patent and Trademark Office   Paper No.
PTOL-2292 (08-10)   *Ex Parte Reexamination Interview Summary – Pilot Program for Waiver of Patent Owner's Statement*

1

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	90/014137
Filing Date	May 11, 2018
First Named Inventor	Scott A. Moskowitz
Art Unit	3992
Examiner Name	William H. Wood
Total Number of Pages in This Submission	5
Attorney Docket Number	

ENCLOSURES (Check all that apply)

Column 1	Column 2	Column 3
☐ Fee Transmittal Form	☐ Drawing(s)	☐ After Allowance Communication to TC
☐ Fee Attached	☐ Licensing-related Papers	☐ Appeal Communication to Board of Appeals and Interferences
☐ Amendment/Reply	☐ Petition	☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
☐ After Final	☐ Petition to Convert to a Provisional Application	☐ Proprietary Information
☐ Affidavits/declaration(s)	☐ Power of Attorney, Revocation Change of Correspondence Address	☐ Status Letter
☐ Extension of Time Request	☐ Terminal Disclaimer	☑ Other Enclosure(s) (please identify below):
☐ Express Abandonment Request	☐ Request for Refund	Requester's Procedural Matter Inquiry
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☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Fisch Sigler LLP
Signature	/Joseph F. Edell/
Printed name	Joseph F. Edell
Date	06/06/2018	Reg. No.	67,625

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	/Joseph F. Edell/
Typed or printed name	Joseph F. Edell	Date	06/06/2018

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Scott A. Moskowitz
Control No.:	90/014,137
U.S. Patent No.:	9,021,602
Issue Date:	April 28, 2015
Appl. No.:	13/794,584
Filing Date:	May 11, 2018
Examiner:	William H. Wood
Title:	DATA PROTECTION METHOD AND DEVICE

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUESTER'S PROCEDURAL MATTER INQUIRY

Dear Examiner Wood:

After filing its request for *ex parte* reexamination on May 11, 2018, Requester identified two typographical errors in the Substantial New Question (SNQ) table on pages 18-19 of the request. SNQ-3 should state that claims *1, 2, 5, 8, 10, and 12* are anticipated by Beetcher '072. SNQ-5 should state that claims *1-5, 8, 10, and 12* are anticipated by Cooperman. The remainder of the request correctly identifies the claims at issue in SNQ-3 and SNQ-5.

As set forth in MPEP 2212.01, Requester requests referral to the TC Quality Assurance Specialist or CRU Supervisory Patent Reexamination Specialist to address Requester's inquiry whether it is permissible to file an addendum to the May 11, 2018 *ex parte* reexamination request that corrects the above-mentioned typographical errors in the SNQ table.

Sincerely,

Dated: June 6, 2018   By: /Joseph F. Edell/
                                      Joseph F. Edell
                                      Reg. No. 67,625
                                      Counsel for Requester

                                      Fisch Sigler LLP
                                      5301 Wisconsin Avenue NW
                                      Fourth Floor
                                      Washington, DC 20015
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                                      Fax: (202) 362-3501

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518 7590 06/18/2018 NEIFELD IP LAW, PC 5400 Shawnee Road Suite 310 ALEXANDRIA, VA 22312-2300	EXAMINER WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
06/18/2018	PAPER

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

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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FISCH SIGLER LLP

5301 WISCONSIN AVENUE, NW

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WASHINGTON, DC 20015

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/014,137*.

PATENT NO. *9,021,602* .

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)).

PTOL-465 (Rev.07-04)

The present application is being examined under the pre-AIA first to invent

provisions.

DECISION ON REQUEST FOR REEXAMINATION

Reexamination (*Ex Parte*) has been requested by a third party for claims 1-5, 8,

10, and 12 of US 9,021,602 B2 to Moskowitz which issued on 04/28/2015 and was filed

on 03/11/2013 (herein Moskowitz).

A substantial new question of patentability affecting claims 1-5, 8, 10, and 12 of

US 9,021,602 B2 to Moskowitz is raised by the request for *Ex Parte* reexamination filed

05/11/2018. As such the filed request for reexamination is granted.

Prosecution History Summary

US 9,021,602 B2 (Moskowitz) issued from U.S. Application 13/794,584 which

was filed on 03/11/2013 and which claims priority to 03/24/1998. The following is a

summary of the relevant portions of the corresponding prosecution history.

The prosecution claims 58-77 were rejected in the Non-Final Office action of

05/09/2014 as being obvious. The response filed 10/22/2014 amended independent

claim 58 to include "storing, in said non transient memory, in a personalization data

resource, both computer configuration information of said computer, and a license code

entered in response to said prompting". Independent claims 69 and 74 were similarly

amended.

The Examiner's Amendment of the Notice of Allowance of 01/13/2015 further

amended each of the independent prosecution claims 58, 69, and 74 to include the

following or similar language, "said application software in said computer generating a

proper decoding key, said generating comprising using said license code". The attached

statement of reasons for allowance stated: "[t]he primary reason for allowance of the

claims is the limitation of storing in a personalization data source, both computer

configuration of said computer and a license code which is used to generate a proper

decoding key". Therefore, at least the limitations regarding "storing, in said non transient

memory, in a personalization data resource, both computer configuration information of

said computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" were important to allowance of the

application into the patent. Prosecution claims 58, 69, and 74 became issued claims 1,

10, and 14

References of the Request

The request asserts the following patents and/or printed publications provide

teachings relevant to the claims of US 9,021,602 B2 (Moskowitz).

US Patent 5,933,497 to Beetcher et al.

Beetcher '497, was not cited during the original prosecution. The request asserts

the reference is eligible for application under at least 35 U.S.C. 102(a) and 102(e). The

request asserts the reference teaches "storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" (Request: pages 12, 27-35) in at least

column 6, lines 48-65, column 9, lines 49-63, and figures 4 and 9a.

Japanese Patent Application Publication H05334072 to Beetcher et al.

Beetcher '072, was not cited during the original prosecution. The request asserts

the reference is eligible for application under at least 35 U.S.C. 102(a) and 102(b). The

request asserts the reference teaches "storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" (Request: pages 13, 57-64) in at least

paragraphs 0029 and 0040, and figures 4 and 9a.

PCT Application Publication WO 97/26732 to Cooperman et al.

Cooperman, was cited, but not applied, during the original prosecution and the

request asserts the reference is eligible for application under at least 35 U.S.C 102(a).

The request asserts the reference teaches "storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" (Request: pages 14-17, 80-81) in at

least page 11, lines 9-33.

US Patent 5,982,892 to Hicks et al.

Hicks, was not cited during the original prosecution and the request asserts the

reference is eligible for application under at least 35 U.S.C 102(a) and 102(e). The

request asserts the reference teaches "storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" (Request: pages 14, 97-101) in at least

column 3, line 29 to column 4, line 14, column 6, lines 54-65, and figures 2B and 3A.

US Patent 5,745,604 to Rhoads

Rhoads, was not cited during the original prosecution and the request asserts the

reference is eligible for application under at least 35 U.S.C 102(a) and 102(e). The

request asserts the reference teaches "storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting" and "said

application software in said computer generating a proper decoding key, said

generating comprising using said license code" when applied with other references

(Request: pages 17, 45-48, 74-77, and 117-119).

Substantial New Question of the Request

The request asserts a substantial new question of patentability with respect to

issued claims of US 9,021,602 B2 (Moskowitz).

Issue 1 (SNQ-1)

Claims 1, 2, 5, 8, 10, and 12 are proposed as anticipated by Beetcher '497 under

35 USC 102(a) and 102(e).

As shown above, the disclosure of Beetcher '497 constitutes teachings pertinent

to claim limitations: "storing, in said non transient memory, in a personalization data

resource, both computer configuration information of said computer, and a license code

entered in response to said prompting" and "said application software in said computer

generating a proper decoding key, said generating comprising using said license code".

As revealed in the above "Prosecution History Summary", these limitations were

important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Beetcher '497 is found to provide new prior art

teachings that would be considered important to a reasonable examiner in evaluating

the patentability of claims 1, 2, 5, 8, 10, and 12. These teachings were not previously

considered as now presented. Beetcher '497 is not merely cumulative to prior art

already considered by the Office. Accordingly, Beetcher '497 raises a substantial new

question of patentability with respect to claims 1, 2, 5, 8, 10, and 12.

Issue 2 (SNQ-2)

Claims 3 and 4 are proposed as unpatentable over Beetcher '497 in view of

Rhoads under 35 USC 103(a).

As shown above, the disclosure of Beetcher '497 constitutes teachings pertinent

to claim limitations: "storing, in said non transient memory, in a personalization data

resource, both computer configuration information of said computer, and a license code

entered in response to said prompting" and "said application software in said computer

generating a proper decoding key, said generating comprising using said license code".

As revealed in the above "Prosecution History Summary", these limitations were

important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Beetcher '497 in view of Rhoads is found to provide

new prior art teachings that would be considered important to a reasonable examiner in

evaluating the patentability of claims 3 and 4. These teachings were not previously

considered as now presented. Beetcher '497 in view of Rhoads is not merely cumulative

to prior art already considered by the Office. Accordingly, Beetcher '497 in view of

Rhoads raises a substantial new question of patentability with respect to claims 3 and 4.

Issue 3 (SNQ-3)

Claims 1, 2, 5, 8, 10, and 12 are proposed as anticipated by Beetcher '072 under 35 USC 102(a) and 102(b).

As shown above, the disclosure of Beetcher '072 constitutes teachings pertinent to claim limitations: "storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting" and "said application software in said computer generating a proper decoding key, said generating comprising using said license code". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Beetcher '072 is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1, 2, 5, 8, 10, and 12. These teachings were not previously considered as now presented. Beetcher '072 is not merely cumulative to prior art already considered by the Office. Accordingly, Beetcher '072 raises a substantial new question of patentability with respect to claims 1, 2, 5, 8, 10, and 12.

Issue 4 (SNQ-4)

Claims 3 and 4 are proposed as unpatentable over Beetcher '072 in view of Rhoads under 35 USC 103(a).

As shown above, the disclosure of Beetcher '072 constitutes teachings pertinent to claim limitations: "storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code

entered in response to said prompting" and "said application software in said computer

generating a proper decoding key, said generating comprising using said license code".

As revealed in the above "Prosecution History Summary", these limitations were

important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Beetcher '072 in view of Rhoads is found to provide

new prior art teachings that would be considered important to a reasonable examiner in

evaluating the patentability of claims 3 and 4. These teachings were not previously

considered as now presented. Beetcher '072 in view of Rhoads is not merely cumulative

to prior art already considered by the Office. Accordingly, Beetcher '072 in view of

Rhoads raises a substantial new question of patentability with respect to claims 3 and 4.

Issue 5 (SNQ-5)

Claims 1-5, 8, 10, and 12 are proposed as anticipated by Cooperman under 35

USC 102(a).

As shown above, the disclosure of Cooperman constitutes teachings pertinent to

claim limitations: "storing, in said non transient memory, in a personalization data

resource, both computer configuration information of said computer, and a license code

entered in response to said prompting" and "said application software in said computer

generating a proper decoding key, said generating comprising using said license code".

As revealed in the above "Prosecution History Summary", these limitations were

important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Cooperman is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1-5, 8, 10, and 12. These teachings were not previously considered as now presented and are viewed in a new light. Cooperman is not merely cumulative to prior art already considered by the Office. Accordingly, Beetcher '072 raises a substantial new question of patentability with respect to claims 1-5, 8, 10, and 12.

Issue 6 (SNQ-6)

Claims 1, 2, 5, 8, 10, and 12 are proposed as anticipated by Hicks under 35 USC 102(a) and 102(e).

As shown above, the disclosure of Hicks constitutes teachings pertinent to claim limitations: "storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting" and "said application software in said computer generating a proper decoding key, said generating comprising using said license code". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Hicks is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1, 2, 5, 8, 10, and 12. These teachings were not previously considered as now presented. Hicks is not merely cumulative to prior art already considered by the Office.

Accordingly, Hicks raises a substantial new question of patentability with respect to claims 1, 2, 5, 8, 10, and 12.

Issue 7 (SNQ-7)

Claims 3 and 4 are proposed as unpatentable over Hicks in view of Rhoads under 35 USC 103(a).

As shown above, the disclosure of Hicks constitutes teachings pertinent to claim limitations: "storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting" and "said application software in said computer generating a proper decoding key, said generating comprising using said license code". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance US 9,021,602 B2 (Moskowitz).

In light of these teachings, Hicks in view of Rhoads is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 3 and 4. These teachings were not previously considered as now presented. Hicks in view of Rhoads is not merely cumulative to prior art already considered by the Office. Accordingly, Hicks in view of Rhoads raises a substantial new question of patentability with respect to claims 3 and 4.

Correspondence Information

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

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding should be directed to the Central Reexamination Unit at telephone number (571)272-7705.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see http://pair-direct.uspto.gov. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/WILLIAM H WOOD/
Primary Examiner, Art Unit 3992
06/01/2018

Conferees:

/RSD/

/ALEXANDER KOSOWSKI/

Supervisory Patent Examiner, Art Unit 3992

	Control No.	Patent Under Reexamination
Order Granting Request For Ex Parte Reexamination	90/014,137	9021602
	Examiner	Art Unit
	WILLIAM H. WOOD	3992

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

The request for *ex parte* reexamination filed <u>11 May 2018</u> 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.

/WILLIAM H WOOD/ Primary Examiner, Art Unit 3992		

cc:Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-471G(Rev. 01-13)   **Office Action in *Ex Parte* Reexamination**   Part of Paper No. 20180601

Reexamination	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90014137	9021602
	Certificate Date	**Certificate Number**

Requester Correspondence Address:	☐ **Patent Owner**	☒ **Third Party**

FISCH SIGLER LLP
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WASHINGTON, DC 20015

LITIGATION REVIEW ☒	/WHW/ (examiner initials)	06/01/2018 (date)
Case Name		Director Initials
6:17cv16 (open)		
6:18cv174 (open)		
6:18cv181 (open)		
6:18cv195 (open)		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	**NUMBER**
1. NA	

ATTACHMENT 5

RE: US Patent 9021602

37 CFR 1.324 Petition to Correct Inventorship in Issued US Patent 9021602

Pursuant to 35 USC 355 and 37 CFR 1.323, MPEP 1481, and MPEP 1412.04, and MPEP 1481.02, the applicant petitions to correct the inventorship in this patent, as follows.

On the cover page, replace:

"(72)   Inventor: Scott A. Moskowitz, Sunny Isles Beach, FL (US)"

with

"(72)   Inventors: Scott A. Moskowitz, Sunny Isles Beach, FL (US); Marc Cooperman, Short Hills, NJ (US)"

That is, the patent owner petitions to add Mr. Cooperman as a named inventor.

Pursuant to MPEP 1412.04: (A) the only change being made in the patent is to correct the inventorship; and (B) all parties are in agreement and the inventorship issue is not contested. MPEP 1481.02 identifies "all parties" to be the originally named inventors and assignees, noting "Correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, *i.e., originally named inventors and assignees*."

The assignee of record is "WISTARIA TRADING LTD" as shown by the abstract of title indexed at reel/frame: 036342/0953. The named inventor is Scott Moskowitz, as shown on the face of the patent. Scott Moskowitz is authorized to act on behalf of WISTARIA TRADING LTD.

Attached find an "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship" signed by Scott Moskowitz showing that the assignee and original inventor agree to the change.

37 CFR 1.324(b)(1) requires this request to include: "A statement from each person who is being added as an inventor ... either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change. On May 17, 2018, Mr. Cooperman testified that he contributed to the conception of claim 1 of USP9021602. (See Attachment 3, the Cooperman deposition transcript, at page 183, line 22 to page 184, line 1 "It appears to be, as we mentioned previously, similar to this prior patent No. 26.") Accordingly, Mr. Cooperman has no disagreement with the change.

37 CFR 1.324(b)(1) also requires this request to include "A statement from each person who is "is currently named as an inventor" agreeing to the change. The attached "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship" shows that agreement.

37 CFR 1.324(b)(2) requires a "statement from all assignees of the parties submitting a statement under paragraph(b)(1) of this section agreeing to the change of inventorship." The attached "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship"

ATTACHMENT 5

shows that agreement.

37 CFR 1.324(b)(2) also requires that this statement "must comply with the requirements of § 3.73(c) of this chapter." 3.73(c)(1) states that "Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted." "WISTARIA TRADING LTD"'s ownership is established by the assignment from Mr. Moskowitz recorded reel/frame: 036342/0953, as the assignee of USP9021602.

The attached settlement agreement dated 2002, sections 2.1 and 2.4, and Exhibit 1, shows that Mr. Cooperman assigned his entire right, title, and interest in inventions **disclosed in**, inter alia, in USP5745569 and WO/9726732, to Wistaria and it successors and assigns. The attached claim chart, attachment 8, shows that all claims of USP 9021602 are disclosed by USP5745569. Attachment 9 is the Abstract of Title for USP5745569, which shows that all rights to USP5745569 are now owned by WISTARIA TRADING LTD, via a chain of assignments. Accordingly, WISTARIA TRADING LTD. is the assignee and owner of all rights in USP9021602.

37 CFR 1.324(c) required payment of the fee specified in 1.20(b). That fee is currently $150. See fee code 1816, on
https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule.

Truly,
/RichardNeifeld/
RICHARD NEIFELD, REG. NO. 35,299
ATTORNEY OF RECORD

Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\Drafts\Attachment5_Petition_Inventorship_9021602.wpd

Reexamination Control Number: 90014137
Confirmation No: 6880
RE: US Patent 9021602

Patent Owner's Statement

I.   Summary of Patent Owner Statement
This is a Patent Owner (PO) statement in response to the order dated June 18, 2018, granting reexamination of USP9021602.

The Order, at page 2, found a substantial new question (SNQ) affecting claims 1-5, 8, 10, and 12. The Order was based upon the grounds specified in the reexamination request.

The PO submits that the claims are not unpatentable over the specified grounds. The PO summarizes two reasons why two claims are not unpatentable, below.

First, the grounds that depend upon the Beetcher references, or Beetcher in view of Rhoads (first four grounds) fail to disclose or suggest storing computer configuration information in a "**data resource**," as claimed.

Second, the grounds that depend upon Cooperman or Hicks (grounds 5-7) fail because these references are not prior art. Claim 1 of USP9021602, for example, is supported by application 08/597,943, filed **1/17/1996**, which issued as USP5745569. 1/17/1996 antedates the prior art dates of Cooperman and Hicks. The claims of USP902160 and USP5745569 were invented by the same inventive entity. Accordingly, the invention defined by the claims of USP9021602 pre-existed Cooperman and Hicks.

Mr. Cooperman recently testified that he contributed to the conception of claim 1 of USP9021602 while working with Mr. Moskowitz. Accordingly, Mr. Cooperman is joint inventor of USP9021602, which means the inventorship of USP5745569, which issued from application 08/597,943 filed 1/17/1996 is the same as the inventorship of USP9021602. Consequently, application 08/597,943, filed 1/17/1996 is proof that the invention defined by claim 1 was invented prior to the Cooperman and Hicks references.

The patent owner has filed a Petition to Correct Inventorship of USP9021602 to name Mr. Cooperman as a joint inventor, consistent with Mr. Cooperman's recent testimony. See Attachment 5; Attachment 6.

II.   Documents and Service
Attachments to this Patent Owner Statement, and filed herewith and served on the reexam requestor, are the following documents:

Certificate of Service (1 page), showing service of:
This Patent Owner Statement (8 pages)
Attachment 1, Pages 1-28 from the file history of application 08/587,793 (issued as USP5745569) (27 Pages)
Attachment 2, USP5745569 (6 pages)
Attachment 3, Pages 1-12 and 172-192 of the transcript of the deposition of Marc S. Cooperman, May 17, 2018, in Blue Spike LLC v. Juniper Networks, Inc., civil case 6:17-cv-00016-KNM. (33 Pages)

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Attachment 4, Comparison of Disclosures of US application 08/587,943; WO 97/26732; USP5,745,569; USP9021602; and USP9104842. (5 pages)

Attachment 5, 37 CFR 1.324 Petition to Correct Inventorship in Issued US Patent 9021602. (2 pages)

Attachment 6, Agreement of Assignee of Record and Original Inventor to Correction of Inventorship (1 page)

Attachment 7, 2002 Settlement Agreement (37 pages)

Attachment 8, Claim chart showing that USP5,745,569 and US application 08/587,943 supports the claims of US Patent 9021602. (7 pages)

Attachment 9, Title Abstract for application, 08587943, now USP5745569. (2 Pages)

III. Response to Grounds 1-4 (Beetcher and Rhoads References)

Grounds 1-4:

Claims 1, 2, 5, 8,10, and 12: 102, Beetcher '497;

Claims 3 and 4: 103, Beetcher497 and Rhoads;

Claims 1, 2, 5, 8, 10, and 12: 102, Beetcher '072; and

Claims 3 and 4: 103, Beetcher '072 and Rhoads.

Claim 1 defines "1. A computer based method ... comprising:...said application software storing ... in a personalization **data resource**, both **computer configuration information** of said computer, **and a license code** entered in response to said prompting."

Beetcher '497 does not disclose storing computer configuration information in a **data resource**. Therefore, Beetcher '497 does not anticipate claim 1.

Rhoads does not suggest modifying Beetcher to store computer configuration information in a **data resource**. Therefore, Beetcher and Rhoads do not suggest claim 1.

USP9021602 makes it clear that a "data resource" is distinct from executable object code. USP9021602 col. 11:17-23; col 12:56 to col. 13:8. For example, stating:

> ...These sub-objects can be packaged into what are referred to in certain systems as "code resources," which may be stored separately from the application, or shared with other applications, although not necessarily. Within an application there are *also data objects*, which *consist of some data to be operated on by the executable code*. These data objects **are not executable**. That is, they do not consist of executable instructions. The data objects can be referred to in certain systems as **"resources."** [USP9021602 col. 11:63 to col. 8:4; bold, italics, underlining added for emphasis.]

Thus, the specification defines a data resource as non executable, and distinct from, not included in, code resources.

The specification also clarifies that code resources refer to object code.

> An executable computer program is variously referred to as an application, from the point of view of a user, or executable object code from the point of view of the engineer. A collection of smaller, atomic (or indivisible) chunks of object code typically comprise the complete executable object code.... [USP9021602 col.

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These indivisible portions of object code correspond with the programmers' function or procedure implementations in higher level languages ... Within a function or procedure, however, the order of individual language constructs, which correspond to particular machine instructions is important, and so functions or procedures are considered indivisible for purposes of this discussion. ... When a program is compiled, then, it consists of a collection of these sub-objects ... The memory address of the first instruction in one of these sub-objects is called the "entry point" of the function or procedure. The rest of the instructions comprising that subobject immediately follow from the entry point. ... These sub-objects can be packaged into what are referred to in certain systems as "code resources," .... [USP9021602 col. 11:23 -64.]

So the specification makes clear that "code resources" are object code, and that "data resources" are non executable, that is not computer code in any form, and are distinct from object code. So the specification defines that data resources not executable instructions and do not include object code.

All the specification need to is distinguish the claimed term from the allegedly corresponding element in the asserted prior art. *See Trustees of Columbia Univ. v. Symantec,* 2015-1146, 811 F. 3d 1359, 1364 (Fed. Cir. 2016):

> Thus, we reject Columbia's argument that the presumption of plain and ordinary meaning "can be overcome in only two circumstances: [when] the patentee has expressly defined a term or has expressly disavowed the full scope of the claim in the specification and the prosecution history." Appellant's Br. at 26 (emphasis added). As our en banc opinion in *Phillips* made clear, "a claim term may be clearly redefined without an explicit statement of redefinition" and "[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." 415 F.3d at 1320-21 (citing and quoting *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.,* 262 F.3d 1258, 1268 (Fed. Cir. 2001), and *Irdeto Access, Inc. v. Echostar Satellite Corp.,* 383 F.3d 1295, 1300 (Fed. Cir. 2004)). [Underlining added for emphasis.]

The claimed "data resource" is distinct from Beetcher '497's object code in of which triggering instruction 301 forms one instruction in a sequence of instructions. In fact, Beetcher '497's abstract refers to the trigger as a "machine instruction **in the object code;**" bold supplied for emphasis. And that the trigger "is encountered during execution." This "during execution" also means that the trigger is an instruction in object code.

In fact, Beetcher497's brief description of Fig. 3 is that "FIG. 3 shows the contents of a **typical executable software module** ...". Beetcher497 col. 4:54-56. And, Beetcher497 Fig. 3 shows instruction 301 to be part of that executable software module. As explained by

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Beetcher497, executable software modules are compiled object code capable of executing on the installed computer system 101:

> In the preferred embodiment, software modules are distributed as **compiled object code**. A typical software module 300 is shown in FIG. 3. The software module comprises a plurality of **object code instructions capable of executing on computer system 101**. According to this invention, a number of entitlement verification **triggering instructions 301 are embedded in the object code**. [Beetcher497 col. 6:41-47.]

The "instructions 301 embedded" clearly means those instructions are in sequence with other instructions in the compiled object code; the software module 300.

This passage (Beetcher497 col. 6:41-47) refers to the "preferred embodiment" only in the sense that the triggering instructions 301 contains *only* the unlock instruction. Beetcher497 makes this clear by identifying in the summary of the invention section and elsewhere, the *alternative* embodiment, where the triggering contains *both the unlock instruction and some other instruction* that results in executing some software module function.

Beetcher497 states in this respect, that:

> In an alternative embodiment, the triggering instruction also performs some useful work necessary for the software module to properly execute. This renders the software even more difficult to "patch", and further reduces the impact to performance of such verification triggers. [Beetcher497 col. 4:28-33.]

and that:

> In an alternative embodiment, the triggering instruction is also a direct instruction to perform some other useful work (from among those instructions which do not require that an operand for the action be specified in the instruction). In this alternative embodiment, execution of the triggering instruction causes system 101 to perform some other operation simultaneous with the entitlement verification. [Beetcher497 col. 6:58-65.]

Moreover, Beetcher497 expressly discloses that verification code 301 is an executable code instruction, stating:

> The executable code contains entitlement verification triggering instructions 301 (only one shown), **which are executed by horizontal microcode check lock function 422**. [Beetcher497, col. 8:18-22.]

Thus, Beetcher497 discloses that triggering instruction 301 is an executable instruction in a sequence of executable instructions within an executable software module consisting of compiled object code. This executable software module consisting of compiled object code is not a "data resource," as defined by the '602 patent.

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The reexam request erroneously relied upon the claimed "data resource" and the claimed "personalization data resource," as being indefinite, in order to justify a contention that Beetcher '497 anticipated. See reexam request, claim construction section VIII, page 11. In contrast, Beetcher '497's triggering instruction 301 is one executable instruction in a stack of executable instructions, that is object code. Therefore, Beetcher '497's triggering instruction 301 is not stored in a **data resource**, and is not computer configuration information stored in a **data resource**, as required by claim 1.

As Mr. Cooperman recently testified, when deposed in the corresponding patent infringement litigation, he understood a "data resource" as recited in the subject patent, to mean things that are not code, like pictures and icons. See the Cooperman deposition transcript, Attachment 3, page numbered 175. Mr. Cooperman is arguably adverse to the assignee, Wistaria Trading Ltd, and arguably adverse to the current named inventor, Mr. Moskowitz, as indicated by their legal dispute involving these very same patent rights, shown by their settlement agreement from 2002, which is Attachment 7. This same Attachment 7 indicates that the settlement conferred all of Mr. Cooperman's patent rights on inventions disclosed in patents in that dispute, including the USP5745569 patent's disclosure, on Wistaria and its successors. And Attachment 8 shows that all claims in the USP9021602 are supported by USP5745569's disclosure. Accordingly, (even if Mr. Cooperman understood the legal significance of his testimony on the issues now raised in this reexamination), he would have had no pecuniary interest to sway his testimony in favor of the patent owner.

Mr. Cooperman is however at least one of ordinary skill in the field, as indicated for example by the many patent naming him as an inventor in this field, and originally assigned to the DICE or Wistaria, based upon this search of the USPTO database: "in/Cooperman and in/Marc and (an/dice or an/wistaria)", which shows the following 29 hits:

PAT. NO. Title
1 8,549,305 Full-Text Steganographic method and device
2 8,467,525 Full-Text Steganographic method and device
3 8,307,213 Full-Text Method and system for digital watermarking
4 8,238,553 Full-Text Steganographic method and device
5 8,225,099 Full-Text Linear predictive coding implementation of digital watermarks
6 8,175,330 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
7 8,161,286 Full-Text Method and system for digital watermarking
8 8,121,343 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
9 8,046,841 Full-Text Steganographic method and device
10 7,870,393 Full-Text Steganographic method and device
11 7,844,074 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
12 7,779,261 Full-Text Method and system for digital watermarking
13 7,770,017 Full-Text Method and system for digital watermarking
14 7,761,712 Full-Text Steganographic method and device
15 7,730,317 Full-Text Linear predictive coding implementation of digital watermarks
16 7,568,100 Full-Text Steganographic method and device

Page 5 of 8

17 7,409,073 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
18 7,343,492 Full-Text Method and system for digital watermarking
19 7,152,162 Full-Text Z-transform implementation of digital watermarks
20 7,095,874 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
21 7,007,166 Full-Text Method and system for digital watermarking
22 6,853,726 Full-Text Z-transform implementation of digital watermarks
23 6,522,767 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
24 5,905,800 Full-Text Method and system for digital watermarking
25 5,889,868 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
26 5,822,432 Full-Text Method for human-assisted random key generation and application for digital watermark system
27 5,745,569 Full-Text Method for stega-cipher protection of computer code
28 5,687,236 Full-Text Steganographic method and device
29 5,613,004 Full-Text Steganographic method and device

Accordingly, Mr. Cooperman's sworn testimony is entitled to weight on the meaning of the claimed "data resource." And his testimony is consistent with the specification distinguishing data resources from code resources. The reexam request's argument and evidence is, in contrast, not consistent with the specification's limitations on the meaning of "data resource." Consequently, the reexam request is wrong, and Beetcher does not disclose storing computer configuration information in a "data resource," as defined by claim 1.

Independent Claim 10 defines the same distinguishing limitation as claim 1: "said application software code storing, ... in a personalization **data resource**, both **computer configuration information** of said computer system, **and a license code** entered in response to said prompting." Claim 10 is patentable over the Beetcher '497 and Rhoads references for the same reasons as claim 1.

Beetcher '072 is merely a Japanese version of Beetcher '497 and provides no additional information. Beetcher '072 and Rhoads do not anticipate or suggest any claim for the same reasons just noted.

IV.   Response to Grounds 5-7 (Cooperman and Hicks References)
Grounds 5-7 are:
Claims 1-5, 8, 10, and 12: 102, Cooperman;
Claims 1, 2, 5, 8, 10, and 12: 102, Hicks; and
Claims 3 and 4: 103, Hicks and Rhoads.

These references are not prior art. Application 08/587,943, filed **January 17, 1996**, issued as USP5745569 April 28, 1998.

Attachment 8 contains a claim support chart showing support in the disclosure of USP5745569 for all claims in USP9021602.

Attachment 4 shows that there is not substantive difference in the disclosures of US

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application 08/587,943 and USP5745569.

The disclosure of US application 08/587,943 appears at pages 8-27 of Attachment 1. Attachment 1 is the first 27 pages of the file history for US application 08/587,943, retrieved from the file of IPR2017-01061 in which that file history was filed as an exhibit.

Collectively, these documents show that the inventions defined by the claims of the subject patent were invented not later than January 17, 1996.

USP5745569 names both Moskowitz and Cooperman as inventors. Mr. Cooperman testified on May 17, 2018, as recorded in his deposition transcript excerpt, Attachment 3.

Mr. Cooperman's testimony shows that he believes that he was also an inventor of claim 1 of US Patent 9021602; that he contributed to the conception of that claim. That testimony is part of the transcript of his deposition in the district court patent infringement litigation involving this patent. That testimony was under oath; Attachment 3, page 11. Mr. Cooperman testified that he contributed to the conception of all three steps on page 11 of WO 97/26732, at Attachment 3, page numbered 178:20 to 179:6 of his deposition transcript.

Page 11 of WO 97/26732 contains this recitation of three steps:

> The application can then operate as follows:
> 25   1) when it is run for the first time, after
> installation, it asks the user for personalization
> information, which includes the license code. This can
> include a particular computer configuration;
>   2) it stores this information in a personalization
> 30   data resource;
>   3) Once it has the license code, it can then
> generate the proper decoding key to access the essential
> code resources.

That is the same text appearing in the USP5745569, Attachment 2, which Attachment 8 shows to support claim 1 of USP9021602's recitations:

> said application software in said computer prompting a user to enter into
> said computer personalization information; said application software storing, in
> said non transient memory, in a personalization data resource, both computer
> configuration information of said computer, and a license code entered in
> response to said prompting; said application software in said computer generating
> a proper decoding key, said generating comprising using said license code;

Referring directly to claim 1 of USP9021602, Mr. Cooperman admitted that he contributed to the conception of that claim. See Attachment 3, page numbered 183:22 to 184:1 "It appears to be, as we mentioned previously, similar to this prior patent No. 26." Mr. Cooperman's reference to "prior patent No. 26" is a reference to exhibit 26 at his deposition, which was a copy of the 97/26732 Cooperman reference. See Attachment 3, page 172:11-13. That is the reference that Mr. Cooperman indicated he conceived of numbered items 1, 2, and 3 on page 11; the numbered items supporting the quoted portion of claim 1, copied in above.

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Accordingly, Mr. Cooperman admitted that he was an inventor, a person that contributed to the conception, of claim 1 of USP9021602.

The legal consequence of Mr. Cooperman's admissions is that the inventorship for both USP9021602 and USP5745569 are the same, being both Mr. Cooperman and Mr. Moskowitz. Therefore, showing disclosure in USP5745569, of the invention defined by claim 1 of USP9021602, is proof of that invention was made by the same inventive entity as of the filing date of USP5745569. Moreover, Attachment 4 shows that there is no substantive difference between the disclosures of application 08/587,943 filed 1/17/1996 and its subsequently issued patent, USP5745569, confirming that Moskowitz and Cooperman invented that claim not later than 1/17/1996.

The prior art dates of the Cooperman reference and the Hicks reference are subsequent to 1/17/1996 and therefore that do not constitute prior art. Grounds 5-7 therefore fail.

Truly, /RichardNeifeld/
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Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\Drafts\PatentOwnerStatement_USP9021602.wpd

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Reexamination Control Number: 90014137
Confirmation No: 6880
RE: US Patent 9021602

Patent Owner's Statement

I. Summary of Patent Owner Statement

This is a Patent Owner (PO) statement in response to the order dated June 18, 2018, granting reexamination of USP9021602.

The Order, at page 2, found a substantial new question (SNQ) affecting claims 1-5, 8, 10, and 12. The Order was based upon the grounds specified in the reexamination request.

The PO submits that the claims are not unpatentable over the specified grounds. The PO summarizes two reasons why two claims are not unpatentable, below.

First, the grounds that depend upon the Beetcher references, or Beetcher in view of Rhoads (first four grounds) fail to disclose or suggest storing computer configuration information in a "**data resource**," as claimed.

Second, the grounds that depend upon Cooperman or Hicks (grounds 5-7) fail because these references are not prior art. Claim 1 of USP9021602, for example, is supported by application 08/597,943, filed **1/17/1996**, which issued as USP5745569. 1/17/1996 antedates the prior art dates of Cooperman and Hicks. The claims of USP902160 and USP5745569 were invented by the same inventive entity. Accordingly, the invention defined by the claims of USP9021602 pre-existed Cooperman and Hicks.

Mr. Cooperman recently testified that he contributed to the conception of claim 1 of USP9021602 while working with Mr. Moskowitz. Accordingly, Mr. Cooperman is joint inventor of USP9021602, which means the inventorship of USP5745569, which issued from application 08/597,943 filed 1/17/1996 is the same as the inventorship of USP9021602. Consequently, application 08/597,943, filed 1/17/1996 is proof that the invention defined by claim 1 was invented prior to the Cooperman and Hicks references.

The patent owner has filed a Petition to Correct Inventorship of USP9021602 to name Mr. Cooperman as a joint inventor, consistent with Mr. Cooperman's recent testimony. See Attachment 5; Attachment 6.

II. Documents and Service

Attachments to this Patent Owner Statement, and filed herewith and served on the reexam requestor, are the following documents:

Certificate of Service (1 page), showing service of:
This Patent Owner Statement (8 pages)
Attachment 1, Pages 1-28 from the file history of application 08/587,793 (issued as USP5745569) (27 Pages)
Attachment 2, USP5745569 (6 pages)
Attachment 3, Pages 1-12 and 172-192 of the transcript of the deposition of Marc S. Cooperman, May 17, 2018, in Blue Spike LLC v. Juniper Networks, Inc., civil case 6:17-cv-00016-KNM. (33 Pages)

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Attachment 4, Comparison of Disclosures of US application 08/587,943; WO 97/26732; USP5,745,569; USP9021602; and USP9104842. (5 pages)

Attachment 5, 37 CFR 1.324 Petition to Correct Inventorship in Issued US Patent 9021602. (2 pages)

Attachment 6, Agreement of Assignee of Record and Original Inventor to Correction of Inventorship (1 page)

Attachment 7, 2002 Settlement Agreement (37 pages)

Attachment 8, Claim chart showing that USP5,745,569 and US application 08/587,943 supports the claims of US Patent 9021602. (7 pages)

Attachment 9, Title Abstract for application, 08587943, now USP5745569. (2 Pages)

III. Response to Grounds 1-4 (Beetcher and Rhoads References)

Grounds 1-4:

Claims 1, 2, 5, 8,10, and 12: 102, Beetcher '497;

Claims 3 and 4: 103, Beetcher497 and Rhoads;

Claims 1, 2, 5, 8, 10, and 12: 102, Beetcher '072; and

Claims 3 and 4: 103, Beetcher '072 and Rhoads.

Claim 1 defines "1. A computer based method ... comprising:...said application software storing ... in a personalization **data resource**, both **computer configuration information** of said computer, **and a license code** entered in response to said prompting."

Beetcher '497 does not disclose storing computer configuration information in a **data resource**. Therefore, Beetcher '497 does not anticipate claim 1.

Rhoads does not suggest modifying Beetcher to store computer configuration information in a **data resource**. Therefore, Beetcher and Rhoads do not suggest claim 1.

USP9021602 makes it clear that a "data resource" is distinct from executable object code. USP9021602 col. 11:17-23; col 12:56 to col. 13:8. For example, stating:

> ...These sub-objects can be packaged into what are referred to in certain systems as "code resources," which may be stored separately from the application, or shared with other applications, although not necessarily. Within an application there are *__also__ data objects*, which *consist of some data to be **operated on by the** executable code*. These data objects **are not executable**. That is, they do not consist of executable instructions. The data objects can be referred to in certain systems as "**resources**." [USP9021602 col. 11:63 to col. 8:4; bold, italics, underlining added for emphasis.]

Thus, the specification defines a data resource as non executable, and distinct from, not included in, code resources.

The specification also clarifies that code resources refer to object code.

> An executable computer program is variously referred to as an application, from the point of view of a user, or executable object code from the point of view of the engineer. A collection of smaller, atomic (or indivisible) chunks of object code typically comprise the complete executable object code.... [USP9021602 col.

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11:17-21.]

> These indivisible portions of object code correspond with the programmers' function or procedure implementations in higher level languages ... Within a function or procedure, however, the order of individual language constructs, which correspond to particular machine instructions is important, and so functions or procedures are considered indivisible for purposes of this discussion. ... When a program is compiled, then, it consists of a collection of these sub-objects ... The memory address of the first instruction in one of these sub-objects is called the "entry point" of the function or procedure. The rest of the instructions comprising that subobject immediately follow from the entry point. ... These sub-objects can be packaged into what are referred to in certain systems as "code resources," .... [USP9021602 col. 11:23 -64.]

So the specification makes clear that "code resources" are object code, and that "data resources" are non executable, that is not computer code in any form, and are distinct from object code. So the specification defines that data resources not executable instructions and do not include object code.

All the specification need to is distinguish the claimed term from the allegedly corresponding element in the asserted prior art. *See Trustees of Columbia Univ. v. Symantec*, 2015-1146, 811 F. 3d 1359, 1364 (Fed. Cir. 2016):

> Thus, we reject Columbia's argument that the presumption of plain and ordinary meaning "can be overcome in only two circumstances: [when] the patentee has expressly defined a term or has expressly disavowed the full scope of the claim in the specification and the prosecution history." Appellant's Br. at 26 (emphasis added). As our en banc opinion in *Phillips* made clear, "a claim term may be clearly redefined without an explicit statement of redefinition" and "[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." 415 F.3d at 1320-21 (citing and quoting *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001), and *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004)). [Underlining added for emphasis.]

The claimed "data resource" is distinct from Beetcher '497's object code in of which triggering instruction 301 forms one instruction in a sequence of instructions. In fact, Beetcher '497's abstract refers to the trigger as a "machine instruction **in the object code**;" bold supplied for emphasis. And that the trigger "is encountered during execution." This "during execution" also means that the trigger is an instruction in object code.

In fact, Beetcher497's brief description of Fig. 3 is that "FIG. 3 shows the contents of a **typical executable software module** ...". Beetcher497 col. 4:54-56. And, Beetcher497 Fig. 3 shows instruction 301 to be part of that executable software module. As explained by

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Beetcher497, executable software modules are compiled object code capable of executing on the installed computer system 101:

> In the preferred embodiment, software modules are distributed as **compiled object code**. A typical software module 300 is shown in FIG. 3. The software module comprises a plurality of **object code instructions capable of executing on computer system 101**. According to this invention, a number of entitlement verification **triggering instructions 301 are embedded in the object code**. [Beetcher497 col. 6:41-47.]

The "instructions 301 embedded" clearly means those instructions are in sequence with other instructions in the compiled object code; the software module 300.

This passage (Beetcher497 col. 6:41-47) refers to the "preferred embodiment" only in the sense that the triggering instructions 301 contains *only* the unlock instruction. Beetcher497 makes this clear by identifying in the summary of the invention section and elsewhere, the *alternative* embodiment, where the triggering contains *both the unlock instruction and some other instruction* that results in executing some software module function.

Beetcher497 states in this respect, that:

> In an alternative embodiment, the triggering instruction also performs some useful work necessary for the software module to properly execute. This renders the software even more difficult to "patch", and further reduces the impact to performance of such verification triggers. [Beetcher497 col. 4:28-33.]

and that:

> In an alternative embodiment, the triggering instruction is also a direct instruction to perform some other useful work (from among those instructions which do not require that an operand for the action be specified in the instruction). In this alternative embodiment, execution of the triggering instruction causes system 101 to perform some other operation simultaneous with the entitlement verification. [Beetcher497 col. 6:58-65.]

Moreover, Beetcher497 expressly discloses that verification code 301 is an executable code instruction, stating:

> The executable code contains entitlement verification triggering instructions 301 (only one shown), **which are executed by horizontal microcode check lock function 422**. [Beetcher497, col. 8:18-22.]

Thus, Beetcher497 discloses that triggering instruction 301 is an executable instruction in a sequence of executable instructions within an executable software module consisting of compiled object code. This executable software module consisting of compiled object code is not a "data resource," as defined by the '602 patent.

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The reexam request erroneously relied upon the claimed "data resource" and the claimed "personalization data resource," as being indefinite, in order to justify a contention that Beetcher '497 anticipated. See reexam request, claim construction section VIII, page 11. In contrast, Beetcher '497's triggering instruction 301 is one executable instruction in a stack of executable instructions, that is object code. Therefore, Beetcher '497's triggering instruction 301 is not stored in a **data resource**, and is not computer configuration information stored in a **data resource**, as required by claim 1.

As Mr. Cooperman recently testified, when deposed in the corresponding patent infringement litigation, he understood a "data resource" as recited in the subject patent, to mean things that are not code, like pictures and icons. See the Cooperman deposition transcript, Attachment 3, page numbered 175. Mr. Cooperman is arguably adverse to the assignee, Wistaria Trading Ltd, and arguably adverse to the current named inventor, Mr. Moskowitz, as indicated by their legal dispute involving these very same patent rights, shown by their settlement agreement from 2002, which is Attachment 7. This same Attachment 7 indicates that the settlement conferred all of Mr. Cooperman's patent rights on inventions disclosed in patents in that dispute, including the USP5745569 patent's disclosure, on Wistaria and its successors. And Attachment 8 shows that all claims in the USP9021602 are supported by USP5745569's disclosure. Accordingly, (even if Mr. Cooperman understood the legal significance of his testimony on the issues now raised in this reexamination), he would have had no pecuniary interest to sway his testimony in favor of the patent owner.

Mr. Cooperman is however at least one of ordinary skill in the field, as indicated for example by the many patent naming him as an inventor in this field, and originally assigned to the DICE or Wistaria, based upon this search of the USPTO database: "in/Cooperman and in/Marc and (an/dice or an/wistaria)", which shows the following 29 hits:
PAT. NO. Title
1 8,549,305 Full-Text Steganographic method and device
2 8,467,525 Full-Text Steganographic method and device
3 8,307,213 Full-Text Method and system for digital watermarking
4 8,238,553 Full-Text Steganographic method and device
5 8,225,099 Full-Text Linear predictive coding implementation of digital watermarks
6 8,175,330 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
7 8,161,286 Full-Text Method and system for digital watermarking
8 8,121,343 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
9 8,046,841 Full-Text Steganographic method and device
10 7,870,393 Full-Text Steganographic method and device
11 7,844,074 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
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15 7,730,317 Full-Text Linear predictive coding implementation of digital watermarks
16 7,568,100 Full-Text Steganographic method and device

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17 7,409,073 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
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23 6,522,767 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
24 5,905,800 Full-Text Method and system for digital watermarking
25 5,889,868 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
26 5,822,432 Full-Text Method for human-assisted random key generation and application for digital watermark system
27 5,745,569 Full-Text Method for stega-cipher protection of computer code
28 5,687,236 Full-Text Steganographic method and device
29 5,613,004 Full-Text Steganographic method and device

Accordingly, Mr. Cooperman's sworn testimony is entitled to weight on the meaning of the claimed "data resource." And his testimony is consistent with the specification distinguishing data resources from code resources. The reexam request's argument and evidence is, in contrast, not consistent with the specification's limitations on the meaning of "data resource." Consequently, the reexam request is wrong, and Beetcher does not disclose storing computer configuration information in a "data resource," as defined by claim 1.

Independent Claim 10 defines the same distinguishing limitation as claim 1: "said application software code storing, ... in a personalization **data resource**, both **computer configuration information** of said computer system, **and a license code** entered in response to said prompting." Claim 10 is patentable over the Beetcher '497 and Rhoads references for the same reasons as claim 1.

Beetcher '072 is merely a Japanese version of Beetcher '497 and provides no additional information. Beetcher '072 and Rhoads do not anticipate or suggest any claim for the same reasons just noted.

IV.   Response to Grounds 5-7 (Cooperman and Hicks References)
Grounds 5-7 are:
Claims 1-5, 8, 10, and 12: 102, Cooperman;
Claims 1, 2, 5, 8, 10, and 12: 102, Hicks; and
Claims 3 and 4: 103, Hicks and Rhoads.

These references are not prior art. Application 08/587,943, filed **January 17, 1996**, issued as USP5745569 April 28, 1998.

Attachment 8 contains a claim support chart showing support in the disclosure of USP5745569 for all claims in USP9021602.

Attachment 4 shows that there is not substantive difference in the disclosures of US

Page 6 of 8

application 08/587,943 and USP5745569.

The disclosure of US application 08/587,943 appears at pages 8-27 of Attachment 1. Attachment 1 is the first 27 pages of the file history for US application 08/587,943, retrieved from the file of IPR2017-01061 in which that file history was filed as an exhibit.

Collectively, these documents show that the inventions defined by the claims of the subject patent were invented not later than January 17, 1996.

USP5745569 names both Moskowitz and Cooperman as inventors. Mr. Cooperman testified on May 17, 2018, as recorded in his deposition transcript excerpt, Attachment 3.

Mr. Cooperman's testimony shows that he believes that he was also an inventor of claim 1 of US Patent 9021602; that he contributed to the conception of that claim. That testimony is part of the transcript of his deposition in the district court patent infringement litigation involving this patent. That testimony was under oath; Attachment 3, page 11. Mr. Cooperman testified that he contributed to the conception of all three steps on page 11 of WO 97/26732, at Attachment 3, page numbered 178:20 to 179:6 of his deposition transcript.

Page 11 of WO 97/26732 contains this recitation of three steps:

> The application can then operate as follows:
> 25   1) when it is run for the first time, after
> installation, it asks the user for personalization
> information, which includes the license code. This can
> include a particular computer configuration;
>   2) it stores this information in a personalization
> 30   data resource;
>   3) Once it has the license code, it can then
> generate the proper decoding key to access the essential
> code resources.

That is the same text appearing in the USP5745569, Attachment 2, which Attachment 8 shows to support claim 1 of USP9021602's recitations:

> said application software in said computer prompting a user to enter into
> said computer personalization information; said application software storing, in
> said non transient memory, in a personalization data resource, both computer
> configuration information of said computer, and a license code entered in
> response to said prompting; said application software in said computer generating
> a proper decoding key, said generating comprising using said license code;

Referring directly to claim 1 of USP9021602, Mr. Cooperman admitted that he contributed to the conception of that claim. See Attachment 3, page numbered 183:22 to 184:1 "It appears to be, as we mentioned previously, similar to this prior patent No. 26." Mr. Cooperman's reference to "prior patent No. 26" is a reference to exhibit 26 at his deposition, which was a copy of the 97/26732 Cooperman reference. See Attachment 3, page 172:11-13. That is the reference that Mr. Cooperman indicated he conceived of numbered items 1, 2, and 3 on page 11; the numbered items supporting the quoted portion of claim 1, copied in above.

Page 7 of 8

Accordingly, Mr. Cooperman admitted that he was an inventor, a person that contributed to the conception, of claim 1 of USP9021602.

The legal consequence of Mr. Cooperman's admissions is that the inventorship for both USP9021602 and USP5745569 are the same, being both Mr. Cooperman and Mr. Moskowitz. Therefore, showing disclosure in USP5745569, of the invention defined by claim 1 of USP9021602, is proof of that invention was made by the same inventive entity as of the filing date of USP5745569. Moreover, Attachment 4 shows that there is no substantive difference between the disclosures of application 08/587,943 filed 1/17/1996 and its subsequently issued patent, USP5745569, confirming that Moskowitz and Cooperman invented that claim not later than 1/17/1996.

The prior art dates of the Cooperman reference and the Hicks reference are subsequent to 1/17/1996 and therefore that do not constitute prior art. Grounds 5-7 therefore fail.

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Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\Drafts\PatentOwnerStatement_USP9021602.wpd

Page 8 of 8

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518   7590   10/29/2018
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ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
10/29/2018	PAPER

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

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISCH SIGLER LLP
5301 WISCONSIN AVENUE, NW
FOURTH FLOOR
WASHINGTON, DC 20015

Date: **OCT 2 9 2018**

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014137
PATENT NO. : 9021602
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

NEIFELD IP LAW, PC	:		
5400 Shawnee Road	:		
Suite 310	:	Patent Owner	**OCT 2 9 2018**
Alexandria, VA 22312	:		

FISCH SIGLER LLP	:	
5301 WISCONSIN AVENUE, NW	:	
FOURTH FLOOR	:	Third Party Requester
WASHINGTON, DC 20015	:	

In re Application of: Scott Moskowitz	:	DECISION ON PETITION
Appl. No. 90/014,137	:	FOR CORRECTION
Patent No. 9,021,602	:	OF PATENT UNDER
Filed: March 11, 2013	:	37 C.F.R. § 1.324(b)(2)
For: DATA PROTECTION METHOD	:	
AND DEVICE	:	

This is a decision on a petition under 37 C.F.R. § 1.324 filed August 17, 2018 to correct the inventorship of U.S. Patent No. 9,021,602 to add Marc Cooperman as inventor.

The petition is **Denied**.

37 C.F.R. §1.530(l)(1) provides:

When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Director may, on petition of all the parties set forth in §1.324(b)(1)-(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

A petition to correct inventorship as provided by 37 C.F.R. § 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not .

submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b).

This petition does not comply with all requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(I)(1).

37 C.F.R. § 1.324(b)(1) requires a statement from each person who is being added as an inventor.

Regarding this requirement, patent owner has cited to a deposition (Attachment 3 – Page 183) and a settlement agreement (Attachment 7) to meet this requirement. Patent owner has failed to submit a statement from Marc Cooperman agreeing to the change or stating he has no disagreement to the change. It cannot be inferred from the submitted deposition and settlement agreement that the inventor agreed to the change of inventorship or stated that he has no disagreement. It also does not appear that the added inventor had notice of the change since he has not provided the statement or a signature.

37 C.F.R. § 1.324(b)(2) requires a statement from the current named inventors either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change.

Patent Owner has submitted statements under 37 C.F.R. § 1.324(b)(2) by Scott Moskowitz that provide an affirmative statement he agrees with the change to the inventorship (Attachment 6).

37 C.F.R. § 1.324(b)(3) requires a statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 37 C.F.R. § 3.73(b).

Patent Owner has submitted a statement signed by Scott Moskowitz, who is duly authorized to act on behalf of the assignee Wistaria Trading Ltd. In this statement, the assignee affirmatively agreed to the change of inventorship (Attachment 6).

37 C.F.R. § 1.324(b)(3) requires the fee set forth in 37 C.F.R. § 1.20(b).

Patent Owner has submitted the proper fee as set forth in 37 C.F.R. § 1.20(b).

Conclusion

Patent Owner has failed to comply with all formal and procedural requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(I)(1).

Accordingly, Patent Owner's petition for a Correction of Inventorship of US
7,897,372 is **denied.**

/Alexander Kosowski/
Alexander Kosowski
Supervisory Patent Examiner, Art Unit 3992
Central Reexamination Unit
(571) 272-3744

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518   7590   11/30/2018
NEIFELD IP LAW, PC
5400 Shawnee Road
Suite 310
ALEXANDRIA, VA 22312-2300

EXAMINER
WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
11/30/2018	PAPER

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

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FISCH SIGLER LLP
5301 WISCONSIN AVENUE, NW
FOURTH FLOOR
WASHINGTON, DC 20015

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/014,137* .

PATENT UNDER REEXAMINATION *9021602* .

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)).

PTOL-465 (Rev.07-04)

Office Action in Ex Parte Reexamination	Control No. 90/014,137		Patent Under Reexamination 9021602	
	Examiner WILLIAM H WOOD		Art Unit 3992	AIA Status No

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

a. ☑ Responsive to the communication(s) filed on 17 August 2018.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were 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 ☑ Notice of References Cited by Examiner, PTO-892.   3. ☐ Interview Summary, PTO-474.

. 4. ☐ _____.

2 ☐ Information Disclosure Statement, PTO/SB/08.

.

Part II   SUMMARY OF ACTION

1a. ☑ Claims 1-5,8,10 and 12 are subject to reexamination.

1b. ☑ Claims 6-7,9,11 and 13-19 are not subject to reexamination.

2. ☐ Claims _____ have been canceled in the present reexamination proceeding.

3. ☐ Claims _____ are patentable and/or confirmed.

4. ☑ Claims 1-5,8,10 and 12 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)

The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

Reexamination (*Ex Parte*) has been requested by a third party for claims 1, 2, 3, 4, 5, 8, 10, and

12 of U.S. Patent 9,021,602 to Moskowitz which issued on 04/28/2015 and was filed on 03/11/2013.

A substantial new question of patentability affecting claims 1, 2, 3, 4, 5, 8, 10, and 12 of U.S.

Patent 9,021,602 to Moskowitz is raised by the request for *Ex Parte* reexamination filed 05/11/2018.

Claim Rejections – 35 USC § 102 and § 103

The following is a quotation of the appropriate paragraphs of pre-AIA 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 –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article
> 21(2) of such treaty in the English language.

The following is a quotation of pre-AIA 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 negatived by the manner in which the invention was made.

Issue 1 (SNQ-1)

Claims 1, 2, 5, 8, 10, and 12 are proposed rejected, but <u>not applied</u>, as anticipated by *Beetcher* under 35 USC 102(e).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of 05/11/2018 (note: request section X.A), but is not applied as the proposed rejection is unpersuasive in demonstrating an application software storing, in response to prompting, in a personalization data resource, "both computer configuration information of said computer", and a license code entered. Further, the request does not identify the ordinary and customary meaning of "configuration information" of the computer.

Issue 2 (SNQ-2)

Claims 3 and 4 are proposed rejected, but <u>not applied</u>, as unpatentable over *Beetcher* in view of *Rhoads* under 35 USC 103(a).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of 05/11/2018 (note: request section X.B), but is not applied as the proposed rejection is unpersuasive in demonstrating all the limitations of claim 1, on which claims 3 and 4 depend.

Issue 3 (SNQ-3)

Claims 1, 2, 5, 8, 10, and 12 are proposed rejected, but <u>not applied</u>, as anticipated by *Beetcher '072* under 35 USC 102(b).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of 05/11/2018 (note: request section X.C), but is not applied as the proposed rejection is unpersuasive in demonstrating an application software storing, in response to prompting, in a personalization data resource, "both computer configuration information of said computer", and a license code entered.

Further, the request does not identify the ordinary and customary meaning of "configuration

information" of the computer.

Issue 4 (SNQ-4)

Claims 3 and 4 are proposed rejected, but not applied, as unpatentable over **Beetcher '072** in

view of **Rhoads** under 35 USC 103(a).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of

05/11/2018 (note: request section X.D), but is not applied as the proposed rejection is unpersuasive in

demonstrating all the limitations of claim 1, on which claims 3 and 4 depend.

Issue 5 (SNQ-5)

Claims 1, 2, 3, 4, 5, 8, 10, and 12 are rejected as anticipated by **Cooperman** under 35 USC 102(a).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of

05/11/2018 (note: request section X.E) and is applied here and incorporated herein by reference.

Despite what the Request may indicate, the ordinary and customary interpretation of claims is used

herein, not the broadest reasonable interpretation.

Claim 1

Cooperman discloses a computer based method for accessing functionality provided by
an application software *(Cooperman: page 11, lines 9-33)* comprising:

storing said application software in non transient memory of a computer
(Cooperman: page 6, line 12 to page 7, line 36);

said application software in said computer prompting a user to enter into said
computer personalization information *(Cooperman: page 11, lines 24-33)*;

said application software storing, in said non transient memory, in a
personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting *(Cooperman: page 11, lines 24-33)*;

said application software in said computer generating a proper decoding key, said generating comprising using said license code *(Cooperman: page 11, lines 24-33)*; and

wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource *(Cooperman: page 11, lines 9-33)*.

Claim 2

Cooperman discloses the method of claim 1, wherein said encoded code resource is encoded in at least one data resource *(Cooperman: page 11, lines 9-33)*.

Claim 3

Cooperman discloses the method of claim 1 wherein said encoded code resource is steganographically encoded *(Cooperman: page 9, line 22 to page 11, line 8)*.

Claim 4

Cooperman discloses the method of claim 3 wherein said encoded code resource is encoded in a data resource *(Cooperman: page 11, lines 9-33)*.

Claim 5

Cooperman discloses the method of claim 1 wherein said computer configuration information is stored in a data resource *(Cooperman: page 11, lines 9-33)*.

Claim 8

Cooperman discloses the method of claim 1 wherein said computer comprises a processor and said application software using said processor in said prompting and said storing *(Cooperman: page 3, lines 16-20; page 9, line 22 to page 10, line 6)*.

Claim 10

The limitations of claim 10 correspond to the limitations of claim 1 and as such are

rejected in a corresponding manner.

Claim 12

Cooperman discloses the product of claim 10 wherein said computer program product

causes storing of said encoded code resource in a data resource in non transient

memory of said computer *(Cooperman: page 11, lines 9-33)*.

Issue 6 (SNQ-6)

Claims 1, 2, 5, 8, 10, and 12 are rejected as anticipated by **Hicks** under 35 USC 102(e).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of

05/11/2018 (note: request section X.F) and is applied here and incorporated herein by reference.

Despite what the Request may indicate, the ordinary and customary interpretation of claims is used

herein, not the broadest reasonable interpretation.

Claim 1

Hicks discloses a computer based method for accessing functionality provided by an

application software *(Hicks: abstract)* comprising:

storing said application software in non transient memory of a computer *(Hicks:*

figure 6; column 5, lines 8-38);

said application software in said computer prompting a user to enter into said

computer personalization information *(Hicks: column 3, line 56 to column 4, line 9)*;

said application software storing, in said non transient memory, in a

personalization data resource, both computer configuration information of said

computer, and a license code entered in response to said prompting *(Hicks: column 3,*

line 56 to column 4, line 14; column 6, lines 54-65);

said application software in said computer generating a proper decoding key,

said generating comprising using said license code *(Hicks: abstract; and column 3, lines*

29-47 and column 6, line 54 to column 7, line 20); and

wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource *(Hicks: abstract; column 3, line 56 to column 4, line 14; figure 3A)*.

Claim 2

Hicks discloses the method of claim 1, wherein said encoded code resource is encoded in at least one data resource *(Hicks: figures 4A, and 9A-9B; column 4, lines 42-48; column 10, line 11 to column 12, line 40; at least a library is a data resource as they are defined to include code and/or data)*.

Claim 5

Hicks discloses the method of claim 1 wherein said computer configuration information is stored in a data resource *(Hicks: column 3, line 56 to column 4, line 14; column 6, lines 54-65)*.

Claim 8

Hicks discloses the method of claim 1 wherein said computer comprises a processor and said application software using said processor in said prompting and said storing *(Hicks: figure 6, element 600)*.

Claim 10

The limitations of claim 10 correspond to the limitations of claim 1 and as such are rejected in a corresponding manner.

Claim 12

Hicks discloses the product of claim 10 wherein said computer program product causes storing of said encoded code resource in a data resource in non transient memory of said computer *(Hicks: figure 6; column 5, lines 8-38; column 3, line 56 to column 4, line 14; column 6, lines 54-65)*.

Issue 7 (SNQ-7)

Claims 3 and 4 are rejected as unpatentable over **Hicks** in view of **Rhoads** under 35 USC 103(a).

This rejection is proposed by the Third Party Requester in the Request for Reexamination of

05/11/2018 (note: request section X.G) and is applied here and incorporated herein by reference.

Claim 3

To the extent **Hicks** does not explicitly state the method of claim 1 wherein said

encoded code resource is steganographically encoded. **Rhoads** demonstrates that it was

known at the time of invention to encode data or information steganographically

(Rhoads: claim 1; column 1, lines 27-28; column 2, lines 18-62; column 6, lines 49-67;

column 7, lines 45-51; figures 2-3). It would have been obvious to one of ordinary skill in

the art at the time of invention to implement the encoding of *Hicks* with steganographic

encoding as suggested by *Rhoads* teachings. This implementation would have been

obvious because one of ordinary skill in the art would have found: the implementation is

a substitution and application of one known element and technique for another yielding

a predictable result using an acceptable piece of prior art.

Claim 4

Hicks and **Rhoads** disclose the method of claim 3 wherein said encoded code resource is

encoded in a data resource *(Hicks: figures 4A, and 9A-9B; column 4, lines 42-48; column*

10, line 11 to column 12, line 40; at least a library is a data resource as they are defined

to include code and/or data).

Issue 8

Claims 1, 2, 3, 4, 5, 8, 10, and 12 are rejected as anticipated by USPN 5,745,569 *(herein*

Moskowitz et al.) under 35 USC 102(g).

Claim 1

Moskowitz et al. discloses a computer based method for accessing functionality provided by an application software *(Moskowitz et al.: abstract)* comprising:

storing said application software in non transient memory of a computer *(Moskowitz et al.: column 4, lines 18-33)*;

said application software in said computer prompting a user to enter into said computer personalization information *(Moskowitz et al.: column 6, lines 22-26)*;

said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting *(Moskowitz et al.: column 6, lines 27-28)*;

said application software in said computer generating a proper decoding key, said generating comprising using said license code *(Moskowitz et al.: column 6, lines 29-31)*; and

wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource *(Moskowitz et al.: abstract; column 6, lines 38-67)*.

Claim 2

Moskowitz et al. discloses the method of claim 1, wherein said encoded code resource is encoded in at least one data resource *(Moskowitz et al.: column 5, lines 45-48; column 6, lines 18-20 column 8, lines 38-39)*.

Claim 3

Moskowitz et al. discloses the method of claim 1 wherein said encoded code resource is steganographically encoded *(Moskowitz et al.: column 2, line 33 to column 3, line 19; column 5, lines 19-48; column 6, lines 38-67)*.

Claim 4

Moskowitz et al. discloses the method of claim 3 wherein said encoded code resource is encoded in a data resource *(Moskowitz et al.: column 5, lines 45-48; column 6, lines 18-20 column 8, lines 38-39)*.

Claim 5

Moskowitz et al. discloses the method of claim 1 wherein said computer configuration information is stored in a data resource *(Moskowitz et al.: column 6, lines 22-31).*

Claim 8

Moskowitz et al. discloses the method of claim 1 wherein said computer comprises a processor and said application software using said processor in said prompting and said storing *(Moskowitz et al.: column 5, lines 31-39; column 7, lines 30-67; column 9, lines 8-13).*

Claim 10

The limitations of claim 10 correspond to the limitations of claim 1 and as such are rejected in a corresponding manner.

Claim 12

Moskowitz et al. discloses the product of claim 10 wherein said computer program product causes storing of said encoded code resource in a data resource in non-transient memory of said computer *(Moskowitz et al.: column 5, line 40 to column 6, line 67).*

Response to Patent Owner's Statement

Patent Owner's Statement filed 08/17/2018 has been fully considered but is not persuasive: 1) the submitted petition of 08/17/2018 is denied see decision of 10/29/2018; 2) as indicated above, the ordinary and customary interpretation of the claim language is not met by SNQs 1-4, and as such there is no need to reach a conclusion regarding Patent Owner's statements to those SNQs; and 3) *Cooperman* is prior art as it is by a different inventive entity and *Hicks* and *Rhoads* are prior art as they predate the 9,021,602 patent's earliest priority date. Patent Owner has not established common inventorship of the instant patent with *Cooperman* or *Moskowitz et al.* (USPN 5,745,569), nor has Patent Owner submitted an appropriate oath or declaration to establish invention of the subject matter prior to the effective

date of the reference (37 CFR 1.131). Patent Owner's statements asserting the commonality between

the instant claims and the patent 5,745,569 are insufficient.

Important Reexamination Notices

Extensions of Time

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 reexamination proceedings "will be conducted

with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are

provided for in 37 CFR 1.550(c).

Service of Papers

After filing of a request for ex parte reexamination by a third party requester, any document

filed by either the patent owner or the third party requester must be served on the other party (or

parties where-two or more third party requester proceedings are merged) in the reexamination

proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document

may be refused consideration by the Office. See 37 CFR 1.550(f).

Amendment To Reexamination Proceedings

Patent Owner is notified that any proposed amendment to the specification and/or claims in

this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented

pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c). See MPEP

2250.

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 the first

Office Action on the merits (which does not result in a close of prosecution). Submissions after the

second Office Action on the merits, 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. See MPEP 2250 (IV) for examples to assist in the preparation of proper proposed

amendments in reexamination proceedings.

Litigation Reminder

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.

9,021,602 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.

Correspondence Information

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

Any inquiry concerning this communication or earlier communications from the Reexamination Legal
Advisor or Examiner, or as to the status of this proceeding should be directed to the Central Reexamination Unit at
telephone number (571)272-7705.

Information regarding the status of an application may be obtained from the Patent Application
Information Retrieval (PAIR) system. Status information for published applications may be obtained from either
Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR systems, see http://pair-direct.uspto.gov. For questions on access to the
Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William H. Wood/
Primary Examiner, Art Unit 3992

Conferees:

/DENNIS G BONSHOCK/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

RE: US Patent 9021602

<center>37 CFR 1.324 Renewed Petition to Correct Inventorship in Issued US Patent 9021602</center>

I.   Relief Requested

Pursuant to 35 USC 355 and 37 CFR 1.323, MPEP 1481, and MPEP 1412.04, and MPEP 1481.02, the applicant petitions to correct the inventorship in this patent, as follows.

On the cover page, replace:

"(72)   Inventor: Scott A. Moskowitz, Sunny Isles Beach, FL (US)"

with

"(72)   Inventors: Scott A. Moskowitz, Sunny Isles Beach, FL (US); Marc Cooperman, Short Hills, NJ (US)"

That is, the patent owner petitions to add Mr. Cooperman as a named inventor.

II.   Material Facts

1.   The following attachments are submitted with this petition.

Signed 37 CFR 1.324(b)(1) statement from Mr. Marc Cooperman
Copy of Attachment 3 to the patent owner response (Cooperman deposition transcript)
Copy of Attachment 6 to the patent owner response ("Agreement of Assignee of Record and Original Inventor to Correction of Inventorship")
Copy of Attachment 7 to the patent owner response (settlement agreement)
Copy of Attachment 8 to the patent owner response (claim chart)
Copy of attachment 9 to the patent owner response (Abstract of Title for USP5745569)
$150 fee (submitted electronically upon filing this petition)

2.   Pursuant to MPEP 1412.04: (A) the only change being made in the patent is to correct the inventorship; and (B) all parties are in agreement and the inventorship issue is not contested. MPEP 1481.02 identifies "all parties" to be the originally named inventors and assignees, noting "Correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, *i.e., originally named inventors and assignees.*"

3.   The assignee of record is "WISTARIA TRADING LTD" as shown by the abstract of title indexed at reel/frame: 036342/0953. The named inventor is Scott Moskowitz, as shown on the face of the patent. Scott Moskowitz is authorized to act on behalf of WISTARIA TRADING LTD.

<center>Page 1 of 3</center>

4.   On 8/17/2018, the patent owner filed "37 CFR 1.324 Renewed Petition to Correct Inventorship in Issued US Patent 9021602" as part of the patent owner response. See Attachment 5 to the patent owner response.

5.   On 11/2/2018, the PTO issued a decision on the petition denying the petition. That decision stated in relevant part:

6.   37 C.F.R. § 1.324(b)(1) requires a statement from each person who is being added as an inventor. *** Regarding this requirement, patent owner has cited to a deposition (Attachment 3 --Page 183) and a settlement agreement (Attachment 7) to meet this requirement. Patent owner has failed to submit a statement from Marc Cooperman agreeing to the change or stating he has no disagreement to the change. It cannot be inferred from the submitted deposition and settlement agreement that the inventor agreed to the change of inventorship or stated that he has no disagreement. It also does not appear that the added inventor had notice of the change since he has not provided the statement or a signature.

7.   SPE Kosowski signed the decision.

8.   On 11/5/2018, the undersigned spoke by telephone with SPE Kosowski. SPE Kosowski confirmed that the only item missing from the petition was a 37 C.F.R. § 1.324(b)(1) statement signed by Mr. Cooperman.

9.   This renewed petition is accompanied by a 37 C.F.R. § 1.324(b)(1) statement signed by Mr. Cooperman, amongst other document that accompanied the earlier petition.

10.   Attached find a **signed 37 CFR 1.324(b)(1) statement from Mr. Marc Cooperman** stating he has no disagreement with the change, adding his name as a named inventor of the patent.

11.   Attached find a **copy of Attachment 3 to the patent owner response**, which is the Cooperman deposition transcript for his deposition on May 17, 2018. Mr. Cooperman testified that he contributed to the conception of claim 1 of USP9021602. See Attachment 3, at page 183, line 22 to page 184, line 1 ("It appears to be, as we mentioned previously, similar to this prior patent No. 26.")

12.   Attached find a **copy of Attachment 6, "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship" submitted with the patent owner response, and** signed by Scott Moskowitz showing that the assignee and original inventor agree to the change, and previously filed with the patent owner response.

13.   37 CFR 1.324(b)(1) also requires this request to include "A statement from each person who is "is currently named as an inventor" agreeing to the change. The attached "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship" shows that agreement.

Page 2 of 3

14.   37 CFR 1.324(b)(2) requires a "statement from all assignees of the parties submitting a statement under paragraph(b)(1) of this section agreeing to the change of inventorship." The attached "Agreement of Assignee of Record and Original Inventor to Correction of Inventorship" shows that agreement.

15.   37 CFR 1.324(b)(2) also requires that this statement "must comply with the requirements of § 3.73(c) of this chapter." 3.73(c)(1) states that "Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted." To that end, "WISTARIA TRADING LTD"'s ownership is established by the assignment from Mr. Moskowitz recorded reel/frame: 036342/0953, as the assignee of USP9021602.

16.   Attached find a **copy of Attachment 7 to the patent owner response**. This is the settlement agreement dated 2002. Attachment 7, sections 2.1 and 2.4, and Exhibit 1, therein, shows that Mr. Cooperman assigned his entire right, title, and interest in inventions **disclosed in**, inter alia, in USP5745569 and WO/9726732, to Wistaria and it successors and assigns.

17.   Attached find a **copy of Attachment 8 to the patent owner response**, which shows that all claims of USP 9021602 are disclosed by USP5745569.

18.   Attached find a **copy of Attachment 9 to the patent owner response**, which is a copy of the Abstract of Title for USP5745569, which shows that all rights to USP5745569 are now owned by WISTARIA TRADING LTD, via a chain of assignments. Accordingly, WISTARIA TRADING LTD. is the assignee and owner of all rights in USP9021602.

19.   37 CFR 1.324(c) requires payment of the fee specified in 1.20(b). That fee is currently $150. See fee code 1816, on https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule. That fee is being paid electronically upon filing of this petition.

III.   Reasons the Petition Should be Granted

        The patent owner has complied with all regulatory requirements required for grant of the petition. Moreover, this renewed petition addresses the only deficiency identified by SPE Kosowski as the reason the petition was not granted. Accordingly, grant the petition.

        Truly,
        /RichardNeifeld/
        RICHARD NEIFELD, REG. NO. 35,299
        ATTORNEY OF RECORD

Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\RenewedPetition\Renewed_Petition_Inventorship_9021602.wpd

Page 3 of 3

Reexamination Control Number: 90/014,137
Reexamination of US patent 9021602

Statement by Marc Cooperman

I am aware of a decision dated October 29, 2018 titled "DECISION ON PETITION FOR CORRECTION OF PATENT UNDER 37 C.F.R. 1.324(b)(2)" which indicates a petition is "DENIED". I see on the first page that this decision refers to "Appl 90/014,137" and "Patent No. 9021602."

I see on the first page of this decision it states "This is a decision on a petition under 37C.F.R. § 1.324 filed August 17,2018 to correct the inventorship of U.S. Patent No. 9,021,602 to add Marc Cooperman as inventor."

I see on page numbered 2 that this decision states "Patent owner has failed to submit a statement from Marc Cooperman agreeing to the change or stating he has no disagreement to the change."

I state that I have no disagreement with the change to patent 9021602 of adding my name as a named inventor to that patent.

Signed:

Marc Cooperman

Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\Drafts\MarcCoopermanStatement.rtf

Page 1

IN THE UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF TEXAS

TYLER DIVISION

-------------------------------------x

BLUE SPIKE LLC,

               Plaintiff,

       v.

JUNIPER NETWORKS, INC.,

               Defendant.

-------------------------------------x

Case No. 6:17-cv-00016-KNM

-------------------------------------x

May 17, 2018

10:06 a.m.

      Deposition of MARC S. COOPERMAN, taken
by Defendant, pursuant to Notice, dated May 17,
2018, at the offices of Fisch Sigler LLP, 1140
Avenue of the Americas, Ninth Floor, New York,
New York, before Brandon Rainoff, a Federal
Certified Realtime Reporter and Notary Public of
the State of New York.

DIGITAL EVIDENCE GROUP

1730 M Street, NW, Suite 812

Washington, D.C. 20036

(202) 232-0646

```
 1    A P P E A R A N C E S:

 2    APPEARING BY TELEPHONE:

 3    GARTEISER HONEA

 4    Attorneys for Plaintiff

 5            795 Folsom Street

 6            Floor One

 7            San Francisco, California 94107-4226

 8            415.785.3762

 9    BY:     RANDALL GARTEISER, ESQ.

10            rgarteiser@ghiplaw.com

11            CHRISTOPHER HONEA, ESQ.

12            chonea@ghiplaw.com

13

14    APPEARING IN PERSON:

15    FISCH SIGLER LLP

16    Attorneys for Defendant

17            5301 Wisconsin Avenue, N.W.

18            Fourth Floor

19            Washington, D.C. 20015

20            202.362.3500

21    BY:     R. WILLIAM SIGLER, ESQ.

              202.362.3520

22            bill.sigler@fischllp.com
```

ATTACHMENT 3

```
1    A P P E A R A N C E S (continued):

2    THE INGBER LAW FIRM

3    Attorneys for the witness

4              51 JFK Parkway

5              First Floor West

6              Suite 159

7              Short Hills, New Jersey 07078

8              973.921.0080

9    BY:      MARK J. INGBER, ESQ.

10             ingber.law@verizon.net

11

12   ALSO PRESENT:

13   JONATHAN POPHAM, Videographer

14

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ATTACHMENT 3

Page 4

1   I N D E X   O F   E X A M I N A T I O N

2   Witness:

3   Marc S. Cooperman

4

5   Examination:

6   By Mr. Sigler...Page 11

7   Index of Exhibits...Page 4

8   Discovery Request

9   By Mr. Sigler...Page 70

10   Settlement agreement between the Witness and Mr.

11   Moskowitz..Page 70

12

13   I N D E X   O F   E X H I B I T S

14   Cooperman Exhibit 1 ....Page 17

15   Multipage document bearing the heading: Subpoena to

16   Testify at a Deposition in a Civil Action

17   Cooperman Exhibit 2 ....Page 21

18   Multipage LinkedIn printout, bearing on the front

19   page a photograph and the name Marc Cooperman

20   Cooperman Exhibit 3 ....Page 71

21   Multipage document bearing on the first page the

      notations: digital watermark system, Q&A, Bates

22   stamped BLU0196337 through 196346

ATTACHMENT 3

Page 6

Page 8

Page 9

1   I N D E X   O F   E X H I B I T S (Continued)

13

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Page 10

1   P R O C E E D I N G

2   Thursday, May 17, 2018

3   New York, New York

4   10:06 a.m.

5   THE VIDEOGRAPHER: This is media

6   number one of the video deposition of Marc

7   Cooperman, taken by defendant, in the matter of

8   Blue Spike LLC versus Juniper Networks,

9   Incorporated, filed in the United States

10   District Court for the Eastern District of

11   Texas, Tyler Division, Case No.

12   6:17-cv-00016-KNM.

13   This deposition is being held at Fisch

14   Sigler, 1140 Avenue of the Americas, New York,

15   New York, on May 17, 2018. The time on the

16   video screen is 10:06 a.m.

17   My name is Jonathan Popham. I am the

18   legal videographer from Digital Evidence Group.

19   The court reporter is Brad Rainoff in

20   association with Digital Evidence Group.

21   Will counsel please introduce

22   themselves for the record.

Page 11

1   MR. SIGLER: Good morning, I'm Bill

2   Sigler from Fisch Sigler LLP in Washington,

3   D.C., and I'm here representing the defendant

4   Juniper Networks.

5   MR. INGBER: Good morning. I'm Mark

6   Ingber from Short Hills, New Jersey,

7   representing the deponent Marc Cooperman.

8   THE VIDEOGRAPHER: If we could just

9   get counsel on the phone to introduce themselves

10   again, please.

11   MR. GARTEISER: Hello, this is Randall

12   Garteiser representing Blue Spike LLC, and also

13   with me is my colleague, Christopher Honea, last

14   name H-O-N-E-A.

15   THE VIDEOGRAPHER: Will the court

16   reporter please swear in the witness.

17   MARC S. COOPERMAN,

18   having been duly sworn, was examined and

19   testified as follows:

20   EXAMINATION

21   BY MR. SIGLER:

22   Q.   Good morning, Mr. Cooperman.

Page 12

1   A.   Good morning.

2   Q.   Can you just restate your full name,

3   please?

4   A.   Marc Steven Cooperman.

5   Q.   And where do you live, sir?

6   A.   In Short Hills, New Jersey.

7   Q.   And we are here today for this

8   deposition in New York City, right?

9   A.   Yes.

10   Q.   Mr. Cooperman, you were once partners

11   in a business called the DICE Company, is that

12   correct?

13   A.   Yes.

14   Q.   You were partners with a gentleman

15   named Scott Moskowitz, is that correct?

16   A.   Yes.

17   Q.   You are named as an inventor on some

18   patents along with Mr. Moskowitz, right?

19   A.   Yes.

20   Q.   Do you understand that some of those

21   patents are at issue in this lawsuit between

22   Blue Spike and Juniper?

Page 172

1   A.   I don't believe so.

2   Q.   All right. You can put that one

3   aside.

4   (Cooperman Exhibit 26, Multipage

5   document bearing the heading: International

6   Application Published Under the Patent

7   Cooperation Treaty (PCT), International

8   Publication Number WO 97/26732, marked for

9   identification)

10   BY MR. SIGLER:

11   Q.   Passing you Exhibit 26, and for the

12   record, Exhibit 26 is a WIPO publication No.

13   97/26732.

14   Mr. Cooperman, do you see there that

15   the applicant on this application is listed as

16   the DICE Company?

17   A.   Yes.

18   Q.   You and Mr. Moskowitz are listed as

19   the inventors?

20   A.   That's correct.

21   Q.   If you could, please take a look at

22   the abstract that's on the lower portion of the

1   front page there and let me know after you have

2   had a chance to read it.

3   A.   Right.

4   Q.   The abstract there, the first two

5   sentences state: A method for protecting

6   computer code copyrights by encoding the code

7   into a data resource with a digital watermark.

8   The digital watermark contains licensing

9   information interwoven with essential code

10   resources encoded into data resources.

11   Did I read that correctly, sir?

12   A.   You did.

13   Q.   What work did you do in developing

14   this method of encoding licensing information

15   into essential data resources?

16   A.   I was not -- I was focused on the

17   audio applications --

18   MR. HONEA: Objection.

19   A.   Let me know when I'm free to speak.

20   Q.   Yeah, go ahead.

21   A.   I was focused on the audio

22   applications for Argent, so this was not fully

Page 174

1   developed by me.

2   Q.   Did you work on this method at all?

3   MR. HONEA: Objection, asked and

4   answered.

5   A.   No.

6   Q.   Then the abstract continues with the

7   next two sentences -- or, excuse me, the next

8   sentence, which states: The result is that

9   while an application program can be copied in an

10   uninhibited manner, only the licensed user

11   having the license code can access essential

12   code resources to operate the program and any

13   descendent copies bear the required license

14   code.

15   Do you see that, sir?

16   A.   Yeah.

17   Q.   Did you do any work on that element

18   stated there in the abstract?

19   A.   No, but I am familiar with this.

20   Q.   Why are you familiar with it?

21   A.   Because the concepts were developed

22   under the DICE Company.

Page 175

1   Q.   If you could go to page 11, please.

2   Starting at -- there is a few

3   sentences here starting at line 20 that start

4   with: The application.

5   Do you see that, sir?

6   A.   Yes.

7   Q.   In particular, there is the statement:

8   The application must also contain a data

9   resource?

10   A.   Yes.

11   Q.   Which specifies in which data resource

12   a particular code resource is encoded. This

13   data resource is created and added at assembly

14   time at the assembly utility.

15   Do you see that?

16   A.   Yeah.

17   Q.   Do you know what it's referring to

18   there when it says data resources?

19   A.   Yes, typically in some structures of

20   applications, depending on which operating

21   system you are in, there are literally separate

22   parts of files, separately managed pieces of

Page 176

1   files, some of which may be code and others of

2   which may be things like pictures, icons,

3   otherwise known as resources.

4   Q.   It also refers to code resource there.

5   Do you see that?

6   A.   Okay. So there is some essential code

7   actually being encoded as part of that method.

8   MR. HONEA: Objection, form.

9   Q.   What's an example of a code resource?

10   A.   Code resource is literally a chunk of

11   executable code, a series of instructions

12   understood directly by the microprocessor.

13   Q.   Did you contribute to this particular

14   piece of the invention disclosed here in this

15   application?

16   A.   As far as the concept --

17   MR. HONEA: Objection, form.

18   A.   The concept? Yes.

19   Q.   How did you contribute to the concept?

20   A.   This was a scenario that we were able

21   to come up with based on how would one try to

22   accomplish a similar outcome with, you know,

Page 177

1   digital watermarking of content versus what

2   could we do for digital computer programs which

3   are a different ball of wax.

4   Q.   Okay. Then this passage goes on below

5   that to say: The application can then operate

6   as follows.

7   You see there, there is one, two and

8   three elements listed?

9   A.   Yeah.

10   Q.   There is a reference there to

11   personalization information.

12   Do you see that?

13   A.   Yes.

14   Q.   Do you know what that refers to?

15   MR. HONEA: Objection, form.

16   A.   Could be anything. If you want to be

17   more specific --

18   Q.   Can you give me an example of

19   something that would be personalization

20   information?

21   A.   Sure. My name, the license code

22   issued to me by the company who sold me the

Page 178

1   software.

2   Q.   There is also a reference there to a

3   personalization data resource.

4   Do you see that?

5   A.   Yeah.

6   Q.   Can you give me an example of a

7   personalization data resource?

8   A.   I'm just looking for it here.

9   (Pause)

10   A.   That's got to be a place similar to

11   where the prior -- so there is -- I'm sorry, I'm

12   having trouble keeping track of all the terms,

13   but we mentioned a data resource above, there

14   needs to be a different data resource to hold

15   the personalization data.

16   So, again, could be a different

17   picture, could be a different audio recording

18   from a different -- you know, played in a

19   different part of the program.

20   Q.   Did you contribute at all to the three

21   steps labeled as one, two, three in this passage

22   that we are discussing?

Page 179

1   A.   My recollection --

2   MR. HONEA: Real quick, objection,

3   form. Go ahead.

4   A.   Yes, it's my recollection, yes.

5   Q.   How so?

6   A.   This was my conception.

7   Q.   Did you write code that addressed

8   these three steps that we are discussing?

9   A.   I did not produce an application that

10   executed this.

11   Q.   Why not?

12   A.   Limited -- limited resources, time.

13   As mentioned previously, focused on Argent for

14   digital audio.

15   Q.   Continuing on there at line 34, below

16   there is items labeled one, two, three.

17   It says: Note that the application

18   can be copied in an uninhibited manner but must

19   contain the license code issued to the license

20   owner to access its essential code resources.

21   Do you see that, sir?

22   A.   Yes.

Page 180

1   Q.   Was that also your conception?

2   A.   That's the whole -- yeah. It's a key

3   part of code, key part of the code the

4   application can't do much without.

5   Q.   All right.

6   MR. SIGLER: Go ahead and mark the

7   next exhibit. Just keep that handy.

8   THE WITNESS: Okay.

9   MR. SIGLER: I'm going to ask you some

10   questions that concern that, too.

11   (Cooperman Exhibit 27, United States

12   Patent No. 9,021,602 B2, dated April 28, 2015,

13   marked for identification)

14   BY MR. SIGLER:

15   Q.   Pass you Exhibit 27. For the record,

16   Exhibit 27 is U.S. Patent No. 9,021,602.

17   A.   Okay.

18   Q.   Have you ever seen this patent before,

19   sir?

20   A.   No.

21   Q.   You see that the sole inventor is Mr.

22   Moskowitz?

Page 181

1   A.   Yes.

2   Q.   If you could please turn to column 13.

3   A.   Sure.

4   Q.   If you could take a look at line --

5   starting at line 55 and going over to column 14,

6   line 3, please, sir?

7   A.   Yes, I see it.

8   Q.   Is that the same language that we were

9   just looking at in the WIPO application that's

10   Exhibit 26?

11   A.   Yes.

12   Q.   Were you aware that this portion of

13   that WIPO application was copied into the '602

14   patent?

15   A.   No.

16   Q.   If you could go to claim 1, please, of

17   the '602 patent?

18   A.   Okay.

19   Q.   Take a moment to read that, then let

20   me know when you are ready.

21   A.   Okay.

22   Q.   In claim 1 here it says in the

Page 182

1   preamble -- it claims: A computer-based method

2   for accessing functionality provided by an

3   application software.

4   Then it lists some steps, right?

5   A.   Okay.

6   Q.   You see that one of those steps is --

7   I believe it's the third one down. It says:

8   Said application software storing, in said

9   non-transient memory, in a personalization data

10   resource, both computer configuration

11   information of said computer, and a license code

12   entered in response to said prompting.

13   Do you see that, sir?

14   A.   Forgive me but I seem to have lost my

15   spot.

16   MR. INGBER: Page 16, column 6 --

17   BY MR. SIGLER:

18   Q.   I'm sorry, that's my fault.

19   A.   Oh --

20   Q.   Claim 1?

21   A.   -- claim 1, okay.

22   Q.   Column 16, and the third -- there is

Page 183

1   several clauses in there. I'm going to ask you

2   about the third clause.

3   A.   Okay.

4   Q.   I'll read it again. It says: Said

5   application software storing, in said

6   non-transient memory, in a personalization data

7   resource, both computer configuration

8   information of said computer and a license code

9   entered in response to said prompting.

10   Do you see that, sir?

11   A.   Okay, hm-hmm.

12   Q.   Is that a concept that you worked on

13   while you were at DICE?

14   A.   I can't say that it was that

15   comprehensive.

16   Q.   What do you mean by -- when you say

17   you can't say it was that --

18   A.   I can't say exactly which or all of

19   those items were included.

20   Q.   Do you believe that you contributed at

21   all to that concept there in that clause?

22   A.   It appears to be, as we mentioned

Page 184

1   previously, similar to this prior patent No. 26.

2   MR. HONEA: Objection to form on the

3   previous question.

4   Q.   So that appears to be similar to the

5   language we reviewed in the WIPO application --

6   A.   Yeah.

7   Q.   -- that's Exhibit 26?

8   A.   Hm-hmm.

9   MR. HONEA: Objection to form.

10   Q.   The next clause says: Said

11   application software, in said computer

12   generating a proper decoding key, said

13   generating comprising using said license code.

14   Do you see that, sir?

15   A.   Yeah.

16   Q.   Is that a concept you worked on while

17   you were at DICE?

18   A.   Just give me one second on this one

19   because --

20   MR. HONEA: Objection to form.

21   A.   Okay. It doesn't look proper. Hold

22   on.

Page 185

1   This is very confusing language. I

2   can't -- I don't want to speculate on what they

3   meant by this.

4   MR. HONEA: Can you move the phone?

5   We are having a hard time hearing again.

6   MR. SIGLER: It's right in front of

7   him but I moved it a little.

8   THE WITNESS: Here, I'll do this. How

9   is that? Can you hear me now?

10   MR. HONEA: Yes, thank you.

11   THE WITNESS: Sorry about that.

12   MR. HONEA: That's much better.

13   BY MR. SIGLER:

14   Q.   All right. So you can put that -- you

15   can put Exhibit 27 aside.

16   (Cooperman Exhibit 28, United States

17   Patent No. 9,104,842 B2, dated August 11, 2015,

18   marked for identification)

19   BY MR. SIGLER:

20   Q.   Passing you what I marked as Exhibit

21   28, which for the record is U.S. Patent No.

22   9,104,842.

Page 186

1   A.   Yeah.

2   Q.   Have you seen this patent before, sir?

3   A.   No.

4   Q.   Do you see the only named inventor is

5   Mr. Moskowitz?

6   A.   Yes, I do.

7   Q.   If you could please go to column 13?

8   A.   I am there.

9   Q.   All right. And starting at line 54,

10   it says: The application must also contain a

11   data resource.

12   And then continuing over to column 14,

13   line 3.

14   Is that the same language that we saw

15   in the WIPO 732 application, sir?

16   A.   Do you mind if I refer back to that?

17   Q.   Sure.

18   MR. HONEA: Objection, form.

19   A.   I recognize -- I recognize the three

20   cases, and it's talking about a data resource,

21   so it appears similar.

22   Q.   So it's at the very least very similar

Page 187

1   to the language we discussed earlier in the

2   WIPO --

3   A.   Yes.

4   Q.   -- 651?

5   MR. HONEA: Objection to form.

6   Q.   Is that a yes, sir?

7   A.   Yes.

8   Q.   Okay. Thank you.

9   Please go to claim 14 which is in

10   column 18.

11   A.   This is the last claim?

12   Q.   Yes.

13   A.   Okay.

14   Q.   Take a moment to look at claim 14,

15   please.

16   A.   Okay.

17   Q.   The second clause of claim 14, the one

18   that starts with: Wherein said software code.

19   Do you see that?

20   A.   Yeah.

21   Q.   Did you contribute to the idea

22   discussed there in that clause of claim 14?

Page 188

1   A.   I don't recall --

2   MR. HONEA: Objection.

3   A.   I don't recall that one.

4   Q.   Okay. I believe that's all the

5   questions that I have, so I pass the witness.

6   MR. HONEA: This is Christopher Honea

7   on behalf of the plaintiff. We don't have any

8   further questions at this time.

9   MR. SIGLER: All right. Thank you for

10   your time.

11   MR. INGBER: Thank you.

12   THE VIDEOGRAPHER: This concludes the

13   testimony of Marc Cooperman. We are going off

14   the record at 2:49 p.m. This also concludes

15   media three.

16   E N D   O F   P R O C E E D I N G

17   Time noted 2:49 p.m.

18

19

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21

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Page 189

1   C E R T I F I C A T E

2   STATE OF NEW YORK

3   COUNTY OF NEW YORK

4   I, BRANDON RAINOFF, a Federal Certified

5   Realtime Reporter and Notary Public within and for

6   the State of New York, do hereby certify:

7   That MARK S. COOPERMAN, the witness

8   whose deposition is hereinbefore set forth, was duly

9   sworn by me and that such deposition is a true record

10 of the testimony given by the witness.

11   I further certify that I am not related

12 to any of the parties to this action by blood or

13 marriage, and that I am in no way interested in the

14 outcome of this matter.

15   IN WITNESS WHEREOF, I have hereunto set

16 my hand this 17th day of May, 2018.

17

18

19

20

21

                  BRANDON R. RAINOFF, RMR, CRR, RPR, FCRR
22

Page 190

```
1       Marc Cooperman c/o

        THE INGBER LAW FIRM

2       51 JFK Parkway, First Floor West

        Suite 159

2       Short Hills, New Jersey 07078

3

4       Case: Blue Spike LLC, v. Juniper Networks, Inc.

        Date of deposition: May 17, 2018

5       Deponent: Marc Cooperman

6

7       Please be advised that the transcript in the above

8       referenced matter is now complete and ready for signature.

9       The deponent may come to this office to sign the transcript,

10      a copy may be purchased for the witness to review and sign,

11      or the deponent and/or counsel may waive the option of

12      signing. Please advise us of the option selected.

13      Please forward the errata sheet and the original signed

14      signature page to counsel noticing the deposition, noting the

15      applicable time period allowed for such by the governing

16      Rules of Procedure. If you have any questions, please do

17      not hesitate to call our office at (202)-232-0646.

18

19

20      Sincerely,

        Digital Evidence Group

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22      express written consent.
```

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2   Washington, D.C. 20036
     (202) 232-0646
3
4   SIGNATURE PAGE
     Case: Blue Spike LLC, v. Juniper Networks, Inc.
5   Witness Name: Marc Cooperman
     Deposition Date: May 17, 2018
6
7   I do hereby acknowledge that I have read
     and examined the foregoing pages
8   of the transcript of my deposition and that:
9
10   (Check appropriate box):
     ( ) The same is a true, correct and
11   complete transcription of the answers given by
     me to the questions therein recorded.
12   ( ) Except for the changes noted in the
     attached Errata Sheet, the same is a true,
13   correct and complete transcription of the
     answers given by me to the questions therein
14   recorded.
15
16   _____   _____
17   DATE   WITNESS SIGNATURE
18
19
20
21   _____   _____
22   DATE   NOTARY

Page 192

1   Digital Evidence Group, LLC

2   1730 M Street, NW, Suite 812

3   Washington, D.C.   20036

4   (202)232-0646

5

6   ERRATA SHEET

7

8   Case: Blue Spike LLC, v. Juniper Networks, Inc.

9   Witness Name: Marc Cooperman

10   Deposition Date: May 17, 2018

11   Page No.   Line No.   Change

12

13

14

15

16

17

18

19

20

21   _____   _____

22   Signature   Date

23

ATTACHMENT 6

RE: US Patent 9021602

Agreement of Assignee of Record and Original Inventor
to Correction of Inventorship

I am the named inventor, Scott Moskowitz, of USP9021602. I agree to correcting inventorship of the patent by adding Marc Cooperman as a named inventor.

I am also authorized to act on behalf of the assignee of record, WISTARIA TRADING LTD, of USP9021602. The assignment is recorded at reel/frame: 036342/0953.

I agree on behalf of WISTARIA TRADING LTD to correcting inventorship of the patent by adding Marc Cooperman as a named inventor.

Scott Moskowitz,
Manager, WISTARIA TRADING LTD

Y:\Clients\SCOT Scott A Moskowitz and Wistaria Trading, Inc\90014137, USP9021602, SCOT0014-7\Drafts\Attachment6_AgreementAssigneeOriginalInventor.wpd

ATTACHMENT 7

WHITE & CASE
LIMITED LIABILITY PARTNERSHIP

WACHOVIA FINANCIAL CENTER, SUITE 4900
200 SOUTH BISCAYNE BOULEVARD
MIAMI, FLORIDA 33131-2352

TELEPHONE: (1-305) 371-2700
FACSIMILE: (1-305) 358-5744/5766

DIRECT DIAL: (305) 995-6249

FACSIMILE TRANSMISSION

Date:	March 25, 2004	**No. of Pages (including cover):**	2
To:	Scott Moskowitz	**Fax Number:**	305-956-9041
		Contact Number:	
From:	Terrance A. Dee	**Reference No.:**	1504146-0002

no save date (documents not saved) (.2X)
[Document1]

United States District Court

Southern District of Florida

> **NOTICE:** Only certain Judges are E-NOTICING, so continue to provide envelopes for cases before non-participating Judges. Visit the court's website www.fled.uscourts.gov or call the Help Line (305) 523-5212 for an updated listing of participating Judges.

Notice of Orders or Judgments

Date: 10/23/02

To: Marcos Daniel Jimenez-D'Clouet (aty)
          200 S Biscayne Boulevard
          Suite 4900
          Miami, FL 33131

Re: Case Number: 1:00-cv-00049   **Document Number:**   44

NOTE: If you are no longer an attorney in this case, please disregard this notice.
Be sure to promptly notify the Clerk of Court in writing of any changes to your name, address, law firm, or fax number. This notification should be sent for each of your active cases.
If this facsimile cannot be delivered as addressed, or you have ANY problems with this fax transmission, please call the Help Line (305) 523-5212 and the problem will be rectified. Since this transmission originated from the Clerk's Office, JUDGES CHAMBERS SHOULD NOT BE CONTACTED.

Number of pages including cover sheet:

3

ATTACHMENT 7

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

MARC COOPERMAN,	) CASE NO. 00-0049-CIV-UNGARO-BENAGES
	)
Plaintiff,	) MAGISTRATE JUDGE BROWN
	)
vs.	)
	) **PARTIES' JOINT STIPULATION**
SCOTT MOSKOWITZ, THE DICE	) **REGARDING SETTLEMENT**
COMPANY AND BLUE SPIKE	) **AND ORDER**
COMPANY,	)
	)
Defendants.	/

The parties hereby provide notice that they have reached a settlement in the above-styled action, the performance of which will not be completed until a future date, and the parties stipulate that they will notify the Court when the terms of the settlement are effectuated and request that the Court retain jurisdiction to enforce the terms of the settlement and enter any orders the Court deems necessary and proper.

DATED this ___ day of October, 2002.

Respectfully submitted,

STEEL, HECTOR & DAVIS LLP
Attorneys for Defendant Marc Cooperman
200 S. Biscayne Boulevard
Suite 4000
Miami, FL 33131-2398
Telephone: (305) 577-7000
Fax: (305) 577-7001

By: _____
Alvin Davis, Esq.
Florida Bar No. 218073
Catherine Whitfield, Esq.
Florida Bar No. 0132391

WHITE & CASE LLP
Attorneys for Plaintiff
200 South Biscayne Boulevard
Suite 4900
Miami, Florida 33131
Telephone: (305) 371-2700
Fax: (305) 358-5477

By: _____
Marcos D. Jiménez, Esq.
Florida Bar No. 441503
Nicole H. Sulsky, Esq.
Florida Bar No. 371520

MIAMI 390129 v1 (2K)

ATTACHMENT 7

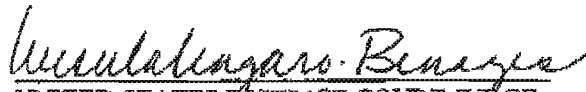CASE NO. 00-0049-CIV-UNGARO-BENAGES

ORDER ON PARTIES' JOINT STIPULATION
REGARDING SETTLEMENT

THIS CAUSE having come before the Court upon the Parties' Joint Stipulation Regarding Settlement dated October 2.2., 2002 (the "Joint Stipulation"), and the Court having reviewed the Joint Stipulation and other matters of record, and having been otherwise fully advised in the premises:

ORDERS AND ADJUDGES as follows:

The Court adopts the terms of the Joint Stipulation. The Court shall retain jurisdiction over the above-styled action in order to enforce the terms of the parties' settlement, and enter any orders the Court deems necessary and proper.

DONE AND ORDERED in Miami, Miami-Dade County, Florida, this 23 day of October, 2002.

UNITED STATES DISTRICT COURT JUDGE
URSULA UNGARO-BENAGES

Copies furnished to:
Marcos D. Jiménez, Esq.
Nicole H. Sulsky, Esq.
  Counsel for Defendants
Alvin Davis, Esq.
Cahterine Whitfield, Esq.
  Counsel for Plaintiff

MIAMI 2001 29 vi (2K)

-2-

ATTACHMENT 7

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

MARC COOPERMAN,   )   CASE NO. 00-0049-CIV-UNGARO-BENAGES

         Plaintiff,   )   MAGISTRATE JUDGE BROWN

vs.   )

SCOTT MOSKOWITZ, THE DICE   )   **PARTIES' JOINT STIPULATION**
COMPANY AND BLUE SPIKE   )   **REGARDING SETTLEMENT**
COMPANY,   )   **AND ORDER**

         Defendants.   /

The parties hereby provide notice that they have reached a settlement in the above-styled action, the performance of which will not be completed until a future date, and the parties stipulate that they will notify the Court when the terms of the settlement are effectuated and request that the Court retain jurisdiction to enforce the terms of the settlement and enter any orders the Court deems necessary and proper.

DATED this 23d day of October, 2002.

Respectfully submitted,

STEEL, HECTOR & DAVIS LLP
Attorneys for Defendant Marc Cooperman
200 S. Biscayne Boulevard
Suite 4000
Miami, FL 33131-2398
Telephone: (305) 577-7000
Fax: (305) 577-7001

By: _____
    Alvin Davis, Esq.
    Florida Bar No. 218073
    Catherine Whitfield, Esq.
    Florida Bar No. 0132391

WHITE & CASE LLP
Attorneys for Plaintiff
200 South Biscayne Boulevard
Suite 4900
Miami, Florida 33131
Telephone: (305) 371-2700
Fax: (305) 358-5477

By: _____
    Marcos D. Jiménez, Esq.
    Florida Bar No. 441503
    Nicole H. Sulsky, Esq.
    Florida Bar No. 371520

ATTACHMENT 7

ORDER ON PARTIES' JOINT STIPULATION
REGARDING SETTLEMENT

THIS CAUSE having come before the Court upon the Parties' Joint Stipulation

Regarding Settlement dated October ____, 2002 (the "Joint Stipulation"), and the Court having

reviewed the Joint Stipulation and other matters of record, and having been otherwise fully

advised in the premises:

ORDERS AND ADJUDGES as follows:

The Court adopts the terms of the Joint Stipulation. The Court shall retain jurisdiction

over the above-styled action in order to enforce the terms of the parties' settlement, and enter any

orders the Court deems necessary and proper.

DONE AND ORDERED in Miami, Miami-Dade County, Florida, this ____ day of

_____, 2002.

_____
UNITED STATES DISTRICT COURT JUDGE

Copies furnished to:
Marcos D. Jiménez, Esq.
Nicole H. Sulsky, Esq.
  Counsel for Defendants
Alvin Davis, Esq.
Cahterine Whitfield, Esq.
  Counsel for Plaintiff

ATTACHMENT 7

IN THE CIRCUIT COURT OF THE
11TH JUDICIAL CIRCUIT IN AND FOR
MIAMI-DADE COUNTY, FLORIDA

GENERAL JURISDICTION DIVISION

WISTARIA TRADING, INC.,)	CASE NO. 01-20633 CA 30
)	
Plaintiff,)	
)	
vs.)	
)	**PARTIES' JOINT STIPULATION**
MARC COOPERMAN and DOES)	**REGARDING SETTLEMENT**
I through X,)	**AND ORDER**
)	
Defendants.)	
/	

The parties hereby provide notice that they have reached a settlement in the above-styled

action, the performance of which will not be completed until a future date, and the parties

stipulate that they will notify the Court when the terms of the settlement are effectuated and

request that the Court retain jurisdiction to enforce the terms of the settlement and enter any

orders the Court deems necessary and proper.

DATED this 22ʳᵈ day of October, 2002.

Respectfully submitted,

STEEL, HECTOR & DAVIS LLP	WHITE & CASE LLP
Attorneys for Defendant Marc Cooperman	Attorneys for Plaintiff
200 S. Biscayne Boulevard	200 South Biscayne Boulevard
Suite 4000	Suite 4900
Miami, FL 33131-2398	Miami, Florida 33131
Telephone: (305) 577-7000	Telephone: (305) 371-2700
Fax: (305) 577-7001	Fax: (305) 358-5477
By: _____	By: _____
Alvin Davis, Esq.	Marcos D. Jiménez, Esq.
Florida Bar No. 218073	Florida Bar No. 441503
Catherine Whitfield, Esq.	Nicole H. Sulsky, Esq.
Florida Bar No. 0132391	Florida Bar No. 371520

MIAMI 189790 (1K)

ATTACHMENT 7

CASE NO. 01-20633 CA 30

ORDER ON PARTIES' JOINT STIPULATION
REGARDING SETTLEMENT

THIS CAUSE having come before the Court upon the Parties' Joint Stipulation

Regarding Settlement dated October ____, 2002 (the "Joint Stipulation"), and the Court having

reviewed the Joint Stipulation and other matters of record, and having been otherwise fully

advised in the premises:

ORDERS AND ADJUDGES as follows:

The Court adopts the terms of the Joint Stipulation. The Court shall retain jurisdiction

over the above-styled action in order to enforce the terms of the parties' settlement, and enter any

orders the Court deems necessary and proper.

DONE AND ORDERED in Miami, Miami-Dade County, Florida, this ____ day of

_____, 2002.

_____
CIRCUIT COURT JUDGE

Copies furnished to:
Marcos D. Jiménez, Esq.
Nicole H. Sulsky, Esq.
  Counsel for Plaintiff
Alvin Davis, Esq.
Cahterine Whitfield, Esq.
  Counsel for Defendant Marc Cooperman

MIAMI 253790 (3E)

ATTACHMENT 7

SETTLEMENT AGREEMENT

THIS SETTLEMENT AGREEMENT ("Settlement Agreement") is made this ___/___ day of August, 2002 (the "Settlement Date"), by and between Wistaria Trading, Inc, ("Wistaria"), Blue Spike Company ("Blue Spike"), Scott Moskowitz ("Moskowitz"), and Marc S. Cooperman ("Cooperman," and together with Wistaria, Blue Spike, and Moskowitz, the "Parties").

WITNESSETH:

WHEREAS, on or about December 13, 1996, Cooperman filed an action in the United States District Court for the District of New Jersey entitled Marc S. Cooperman v. The DICE Company and Scott Moskowitz (No. 96-5775 (AMW)) (the "New Jersey Case"); and

WHEREAS, on January 7, 2000, Cooperman filed an action in the United States District Court for the Southern District of Florida entitled Marc Cooperman vs. Scott Moskowitz, The DICE Company and Blue Spike Company (No. 00-49 CV UNGARO-BENAGES) (the "Florida Federal Case"); and

WHEREAS, on October 27, 2000, Wistaria filed an action in the Superior Court for the State of California in the County of Santa Clara entitled Wistaria Trading, Inc. vs. Marc Cooperman (No. CV793549) (the "California Case"); and

WHEREAS, on August 30, 2001, Wistaria filed an action in the Circuit Court of the 11th Judicial Circuit Court for the State of Florida in the County of Miami-Dade entitled Wistaria Trading, Inc. vs. Marc Cooperman (No. 01-20633 CA 30) (the "Florida State Case," and together with the New Jersey Case, the Florida Federal Case, and the California Case, the "Litigation"), and, on or about September 20, 2001, Cooperman filed a counterclaim therein against Wistaria and Moskowitz; and

WHEREAS, subject to the Court's approval, the Parties desire to amicably resolve all disputes and settle fully and completely all claims of whatever kind, character or description that they may have against each other, including, but not limited to, those claims concerning, relating to, arising out of, or in any way connected with the Litigation pursuant to the terms and provisions of this Settlement Agreement.

NOW, THEREFORE, in consideration of the foregoing and of the mutual promises hereinafter set forth and for other good and valuable consideration, the sufficiency of which is hereby acknowledged, the Parties agree as follows:

Section 1.   Recitals. The Parties acknowledge and agree that the recitals set forth above are true and correct.

Section 2.   Cooperman's Assignments and Obligations.

2.1   Assignment of Certain Patent Rights to Wistaria. Cooperman agrees to execute, contemporaneously with his execution of this Settlement Agreement, an Assignment in the form attached hereto as Exhibit A, assigning to Wistaria, its successors, assigns and legal

representatives, Cooperman's entire right, title and interest in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on the attachment to said Exhibit A, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future.

2.2   Assignment of Certain Patent Rights to Blue Spike. Cooperman agrees to execute, contemporaneously with his execution of this Settlement Agreement, an Assignment in the form attached hereto as Exhibit B, assigning to Blue Spike, its successors, assigns and legal representatives, Cooperman's entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on the attachment to said Exhibit B, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future.

2.3   Assignment of Certain Patent Rights to Moskowitz. Cooperman agrees to execute, contemporaneously with his execution of this Settlement Agreement, an Assignment in the form attached hereto as Exhibit C, assigning to Moskowitz, his successors, assigns and legal representatives, Cooperman's entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on the attachment to said Exhibit C, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future.

2.4   Assignment of Other Intellectual Property Rights to Wistaria. To the extent not covered by Section 2.1 above, Cooperman agrees to execute, contemporaneously with his execution of this Settlement Agreement, an Assignment in the form attached hereto as Exhibit D, assigning to Wistaria, its successors, assigns and legal representatives, Cooperman's entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all intellectual property rights (including inventions, copyrights, trademarks and trade secrets) in and to all items identified on the attachment to said Exhibit D, including any continuation, continuation-in-part, re-issue, reexamination, and derivative applications (based in whole or in part on any inventions, improvements, original works of authorship, and other proprietary information) that may be filed in the future.

2.5   Cooperman's Future Cooperation. At the request of Blue Spike, Wistaria, and/or Moskowitz, and without additional compensation, (1) Cooperman shall promptly execute all assignments, instruments, affidavits, and other documents, and perform such other similar ministerial acts, as the requesting party (including their respective successors, assigns and

-2-

licensees) may reasonably deem necessary or desirable to give effect to Sections 2.1, 2.2, 2.3, and 2.4, and (2) Cooperman shall assist in the preparation and prosecution of all applications for intellectual property protection (including patent applications and applications for the registration of trademarks or copyrights) that may reasonably be deemed necessary or desirable to give effect to Sections 2.1, 2.2, 2.3, and 2.4. Cooperman shall be reimbursed for all reasonable out-of-pocket expenses incurred in connection with the performance of his obligations of this Section 2.5.

      2.6   <u>Return of Wistaria's Property</u>. To the extent Cooperman has in his control, he will make a reasonable effort within six months to return to Wistaria all books, manuals, notebooks, notes, minutes, corporate seals, corporate documents, drawings, blueprints, · photographs, reports, specifications, models, computer programs and software, databases, and other materials (1) supplied by or on behalf of the Dice Company or (2) produced by Cooperman for use during Cooperman's prior working relationship with the Dice Company, or (3) relating to any of the rights identified or described in Sections 2.1, 2.2, 2.3, 2.4, and 2.5 above. If at any time subsequent to settlement, Cooperman discovers that he possesses any of the aforementioned materials, he shall immediately notify Wistaria and return the materials.

      Section 3.   <u>Blue Spike's Obligations</u>. Blue Spike shall pay Cooperman up to, but not exceeding, $200,000 (the "Settlement Amount"), in accordance with the following conditions and terms:

      (a)   If Blue Spike's EBITDA exceeds $500,000 for any fiscal year, then an amount equal to 10% of the EBITDA for that fiscal year will be paid to Cooperman no later than 30 days after the close of such fiscal year, until such Settlement Amount is fully paid;

      (b)   Upon (i) the sale of all or substantially all of Blue Spike's assets and (ii) only after the satisfaction of all Blue Spike debts and obligations existing prior to any such sale, Cooperman will be paid an amount equal to the product of (A) Cooperman's Share (as defined below) and (B) $200,000. Cooperman will share in any such sale proceeds pari passu with Blue Spike's capital-contributing shareholders ("Shareholders"), and Cooperman's share ("Cooperman's Share") shall be a percentage equal to the weighted average of the percentage of each Shareholder's capital that is returned pursuant to such sale.

      (c)   Until the Settlement Amount is fully paid, Blue Spike will permit Cooperman or his representative to visit and examine, under the guidance of officers of Blue Spike, the books of record and accounts of Blue Spike at such reasonable times and intervals during normal business hours and upon reasonable notice and to such reasonable extent as Cooperman may request.

      Section 4.   <u>Continuing Jurisdiction</u>. Pending fulfillment of the Parties' obligations and promises pursuant to the terms of this Settlement Agreement, the Parties agree that the Court

-3-

In the Florida State Case shall retain continuing jurisdiction to enforce the terms of this Settlement Agreement.

Section 5.   Limitations Period. The Parties agree that any limitations period applicable to the subject matter underlying the Litigation that has not already expired shall be tolled pending fulfillment of the Parties' obligations and promises pursuant to the terms of this Settlement Agreement. Wistaria, Blue Spike, and Moskowitz are not aware of any claims against Cooperman other than the Litigation. Cooperman is not aware of any claims against Wistaria, Blue Spike, or Moskowitz other than the Litigation.

Section 6.   Releases. Except for the obligations of the Parties under this Settlement Agreement, the Parties agree to release each other as set forth below:

    (a)   Moskowitz, Blue Spike, and Wistaria, their officers, directors, partners, employees, agents, successors, assigns, shareholders, and legal representatives, if any, hereby release and forever discharge Cooperman, his agents, successors, assigns, partners, heirs, and legal representatives, if any, from any and all manner of past and present claims, debts, demands, damages, liabilities, and causes of action, whether known or unknown, that Moskowitz, Blue Spike, and Wistaria may have had or may presently have against Cooperman arising from any and all transactions between the parties, including, but not limited to, any and all past and present claims by Moskowitz, Blue Spike, and Wistaria against Cooperman pursuant to any matters relating to the Litigation.

    (b)   Cooperman, his agents, successors, assigns, heirs, and legal representatives, if any, hereby releases and forever discharges Moskowitz, Blue Spike, and Wistaria, their officers, directors, partners, employees, agents, successors, assigns, shareholders, and legal representatives, if any, from any and all manner of past and present claims, debts, demands, damages, liabilities, and causes of action, whether known or unknown, that Cooperman may have had or may presently have against Moskowitz, Blue Spike, and Wistaria arising from any and all transactions between the parties, including, but not limited to, any and all past and present claims by Cooperman against Moskowitz, Blue Spike, and Wistaria pursuant to any matters relating to the Litigation.

Section 7.   Dismissal of Actions. Promptly after the execution and delivery of this Settlement Agreement by all Parties and the execution and of the Exhibits referenced in Sections 2.1 through 2.4 herein by Cooperman, the Parties will cause their attorneys to execute and to submit to the appropriate courts for filing in the Florida Federal Case and the Florida State Case Parties' Joint Stipulations Regarding Settlement and Order in the form attached hereto as Exhibits E and F.

Section 8.   Confidentiality. The Parties agree to keep the terms of this Settlement Agreement strictly confidential, and shall not divulge the terms of this Settlement Agreement to anyone other than a legal or tax advisor, or as ordered by a court of law.

Section 9.   Attorneys' Fees and Costs. The Parties agree that they shall each bear their own costs and expenses to date, including attorneys' fees and legal assistants' fees, incurred

-4-

in connection with the Litigation or the negotiation, preparation and execution of this Settlement Agreement and all documents referenced therein. Should the Litigation be reinstituted, Moskowitz can recover fees previously awarded in the New Jersey Case.

Section 10. Benefit of Settlement Agreement. This Settlement Agreement shall be binding upon and inure to the benefit of the Parties hereto, their respective heirs, affiliates, successors and permitted assigns.

Section 11. Liability. The Parties agree that this Settlement Agreement or any act thereunder is not an admission or evidence of liability on the part of any party.

Section 12. Further Assurances. The Parties agree to execute and deliver any and all such further instruments and documents and to take all such further actions as may be reasonably required by the Parties to effectuate the terms and conditions of this Settlement Agreement.

Section 13. Governing Law. This Settlement Agreement shall be governed and construed under and in accordance with the laws of the State of Florida. The Parties agree that any action concerning this Settlement Agreement shall be brought in Miami-Dade County, Florida.

Section 14. Enforcement of Settlement Agreement. If any party hereto commences an action arising out of or to enforce the terms of this Settlement Agreement, the prevailing party in any such action shall be entitled to recover from the non-prevailing party all reasonable attorneys' fees and expenses, including appellate attorneys' fees, incurred in connection with any such action.

Section 15. Entire Agreement. This Settlement Agreement constitutes the entire agreement and understanding between the Parties with respect to the settlement of the Litigation, sets forth all terms and conditions of the Settlement Agreement, and cancels and supersedes any and all prior agreements, representations, and/or understandings, whether written or oral, between the Parties relating to the subject matter of this Settlement Agreement. Further, neither this Settlement Agreement nor any terms hereof may be amended, changed, waived, discharged, or terminated unless such amendment, change, waiver, discharge or termination is in a writing signed by the party against whom enforcement is sought.

Section 16. Advice of Counsel. The Parties acknowledge the benefit of professional advice rendered by independent legal counsel of their own selection prior to entering into this Settlement Agreement. The Parties further acknowledge that they have had a sufficient opportunity to discuss and review this Settlement Agreement with their attorneys and fully understand and agree to the terms set forth herein.

Section 17. Interpretation. The Parties have participated and jointly drafted this Settlement Agreement. No party shall be deemed to be the draftsman of this Settlement Agreement for purposes of construction and interpretation of terms or otherwise.

Section 18. Counterparts. This Settlement Agreement may be executed in counterparts. Each counterpart shall be deemed an original. All counterparts shall constitute a

-5-

single agreement. A facsimile of a signed copy of the Agreement shall serve as an original executed copy for all purposes.

Section 19.   Headings Descriptive. The headings of the several sections and subsections of this Settlement Agreement are inserted for convenience only and shall not in any way affect the meaning or construction of any provision of this Settlement Agreement.

Section 20.   Severability. Any provision of this Settlement Agreement that is unenforceable in any jurisdiction shall, as to such jurisdiction, be ineffective only to the extent of such unenforceability and without invalidating the remaining provisions hereof or affecting the enforceability of such provisions in any other jurisdiction. If any court of competent jurisdiction determines that any provision of this Settlement Agreement is not enforceable in accordance with its terms, then such provision shall be automatically modified so as to apply such provision, as modified, to the protection of the legitimate interest of each of the Parties hereto to the fullest extent legally permissible.

Section 21.   Notice. Any notice required or provided under this Settlement Agreement shall be provided to:

21.1   If to Wistaria, Blue Spike, or Moskowitz by serving: Victor M. Alvarez, Esq., White & Case LLP, 200 South Biscayne Boulevard, Suite 4900, Miami, FL 33131, and Ellen M. King, Esq., White & Case LLP, Five Palo Alto Square, 10th Floor, 3000 El Camino Real, Palo Alto, CA 94306.

21.2   If to Cooperman by serving: Alvin Davis, Esq., Steel Hector & Davis LLP, 200 South Biscayne Boulevard, Suite 4000, Miami, Florida 33131-2398.

Notice shall be effective: (i) immediately upon service if made by facsimile or hand delivery; (ii) as of one day from the date of the notice if made by overnight mail; and (iii) as of three days from the date of the notice if made by U.S. mail.

IN WITNESS WHEREOF, the Parties hereto have signed this Settlement Agreement as of the day and year first written above.

IN WITNESS WHEREOF:

Name:_____

Name:_____

Name:_____

Name: _____

THE PARTIES:

WISTARIA TRADING, INC.

By:_____
Name: _Scott Moskowitz_
Title: _CEO_

BLUE SPIKE COMPANY

By:_____
Name: _Scott Moskowitz_
Title: _CEO_

_____
Scott Moskowitz, Individually

_____
Marc S. Cooperman, Individually

-7-

ATTACHMENT 7

ASSIGNMENT

WHEREAS, I, MARC COOPERMAN residing at ⟨illegible⟩ ⟨illegible⟩ ⟨illegible⟩ ⟨illegible⟩, desire to convey any and all rights, if any, which I may have in and to certain identified patents and/or patent applications, which are more particularly described in the attached EXHIBIT 1, which is herein incorporated by reference in its entirety;

AND, WHEREAS, WISTARIA TRADING, INC., a corporation organized under the laws of the State of Florida, having a place of business located at 16711 Collins Avenue, #2505, Miami Beach, Florida 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the identified patents and/or patent applications described in the attached EXHIBIT 1;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on Exhibit 1, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future, and in and to any and all letters patent, including extensions thereof, of any country which have been or may be granted on any of the aforesaid applications or on said improvements or any parts thereof;

AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including their respective successors, assigns and licensees) may deem (1) necessary or desirable to give effect to this Agreement, or (2) necessary, lawful and proper in the prosecution of said above-referenced applications or in the preparation or prosecution of any continuing, substitute, divisional, renewal, reexamination or reissue application or in any amendments, extensions or interference proceedings related thereto;

AND I hereby covenant for myself and my legal representatives, and agree with said ASSIGNEE, its successors and assigns, that I have granted no right or license to make, use, sell or offer to sell said invention, to anyone except said ASSIGNEE, that prior to the execution of this deed, my right, title and interest in said invention has not been otherwise encumbered, and that I have not and will not execute any instrument in conflict therewith;

ATTACHMENT 7

    AND I do hereby authorize and request the United States Commissioner for Patents to issue any and all letters patent which may be granted upon said United States applications, or upon said invention or any parts thereof when granted, to said ASSIGNEE.

    IN WITNESS WHEREOF, I have hereunto set my hand and seal.

6-SEP-2002
Date   MARC COOPERMAN

County of   )
State of   )

    On this __6__ day of __September__ 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced _USpassport 204090992_ as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public:_____DOLORES MALACHI
My Commission Expires: Notary Public, State of New York
No. 01MA5033596
Qualified in Kings County
Commission Expires Sept. 26, _06_

-2-

ATTACHMENT 7

Exhibit 1
Patent Applications and Patents of Wistaria

ISSUED PATENTS

U.S. Patent No. 5,428,606, "Digital Commodities Exchange"

U.S. Patent No. 5,539,735, "Digital Information Commodities Exchange"

U.S. Patent No. 5,613,004, "Steganographic Method & Device"

U.S. Patent No. 5,687,236, "Steganographic Method & Device"

U.S. Patent No. 5,745,569, "Method for Stega-Protection of Computer Code"

U.S. Patent No. 5,822,432, "Method for Human Assisted Random Key Generation and Application for Digital Watermarking System"

U.S. Patent No. 5,889,868, "Optimization Methods for the Insertion, Protection, and Detection of Digital Watermarks in Digitzed Data"

U.S. Patent No. 5,905,800, "Method & System for Digital Watermarking"

U.S. Patent No. 6,078,664, "Z-Transform Implementation of Digital Watermarks"

PENDING PATENT APPLICATIONS

U.S. Patent Application. No. 08/999,766, filed 7/23/97, "Continuation of Steganographic Method & Device" (continuation of 5,687,236, which itself is a continuation of 5,613,004)

U.S. Patent Application. No. 08/674,726, filed 7/02/96, "Exchange Mechanisms for Digital Exchange"

U.S. Patent Application. No. 09/456,319, filed 12/08/99, "Z-Transform Implementation of Digital Watermarks" (continuation of U.S. Patent No. 6,078,664)

U.S. Patent Application. No. 09/545,589, filed 4/07/00, "Method and System for Digital Watermarking" (claims priority to U.S. Patent No. 5,905,800)

U.S. Patent Application 09/281,279, "Optimization Methods for the Insertion, Protection and Detection of Digital Watermarks in Digitized Data" (continuation of U.S. Patent No. 5,889,868)

EPO APP. 96919405.9, "Steganographic Method and Device"

OTHER PATENT APPLICATIONS

ATTACHMENT 7
CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

PCT/US97/00652, WO 97/26733, "Method for Human Assisted Random Key Generation and Application for Digital Watermarking System"

PCT/US97/00651, WO 97/26732, "Method for Stega-Cipher Protection of Computer Code"

PCT/US96/10257, WO 96/42151, "Steganographic Method and Device"

U.S. Patent Application. No. 08/481,021, "Fraud Detection System for Electronic Networks"

PCT/US96/10096, "Fraud Detection System for Electronic Networks"

PCT/US95/08159, WO 97/01892, "Digital Commodities Exchange"

PCT/US97/11455, WO 98/02864, "Optimization Methods for the Insertion, Protection and Detection of Digital Watermarks in Digitized Data"

ATTACHMENT 7

ASSIGNMENT

WHEREAS, 1, MARC COOPERMAN residing at _____, desire to convey any and all rights, if any, which I may have in and to certain identified patents and/or patent applications, which are more particularly described in the attached **EXHIBIT 1**, which is herein incorporated by reference in its entirety;

AND, WHEREAS, BLUE SPIKE, INC., a corporation organized under the laws of the State of Florida, having a place of business located at 16711 Collins Avenue, #2505, Miami, Florida, 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the identified patents and/or patent applications described in the attached **EXHIBIT 1**;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on **Exhibit 1**, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future, and in and to any and all letters patent, including extensions thereof, of any country which have been or may be granted on any of the aforesaid applications or on said improvements or any parts thereof;

AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including their respective successors, assigns and licensees) may deem (1) necessary or desirable to give effect to this Agreement, or (2) necessary, lawful and proper in the prosecution of said above-referenced applications or in the preparation or prosecution of any continuing, substitute, divisional, renewal, reexamination or reissue application or in any amendments, extensions or interference proceedings related thereto;

AND I hereby covenant for myself and my legal representatives, and agree with said ASSIGNEE, its successors and assigns, that I have granted no right or license to make, use, sell or offer to sell said invention, to anyone except said ASSIGNEE, that prior to the execution of this deed, my right, title and interest in said invention has not been otherwise encumbered, and that I have not and will not execute any instrument in conflict therewith;

ATTACHMENT 7

AND I do hereby authorize and request the United States Commissioner for Patents to issue any and all letters patent which may be granted upon said United States applications, or upon said invention or any parts thereof when granted, to said ASSIGNEE.

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

6-SEP-2002
Date   MARC COOPERMAN

County of   )
State of   )

On this __6__ day of __September__, 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced _____ as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public:_____
My Commission Expires:_____

-2-

ATTACHMENT 7

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Patent Applications and Patents of Blue Spike

PENDING PATENT APPLICATIONS

U.S. Patent Application. No. 09/594,719, "Utilizing Data Reduction in Steganographic and Cryptographic Systems" (claims priority to U.S. Application. No. 60/125,990, filed 3/24/99)

U.S. Patent Application. No. 09/731,040, "Systems, Methods And Devices For Trusted Transactions" (claims priority to U.S. Application. No. 60/169,274, filed 12/7/99)

U.S. Patent Application. No. _____, "A Secure Personal Content Server" (claims priority to PCT/US00/2118, to U.S. Application. No. 60/147,134, and U.S. Application. No. 60/213,489)

U.S. Patent Application. No. 09/657,181, "Method and Device for Monitoring and Analyzing Signals"

U.S. Patent Application. No. 09/671,739, "Method and Device for Monitoring and Analyzing Signals" (claims priority to U.S. Application. No. 09/657,181)

U.S. Patent Application. No. 09/956,262, "Improved Security Based on Subliminal and Supraliminal Channels For Data Objects" (claims priority to U.S. Application. No. 60/234,199)

U.S. Patent Application. No. 09/731,039, "Methods For Open Access And Secured Data Objects"

EPO Application. No. 00 91 9398.8, "Utilizing Data Reduction in Steganographic and Cryptographic Systems"

OTHER PATENT APPLICATIONS

PCT/US00/06522, WO 00/57643, "Utilizing Data Reduction in Steganographic and Cryptographic Systems"

PCT/US00/33126, "Systems, Methods And Devices For Trusted Transactions"

PCT/US00/2118, "A Secure Personal Content Server"

Exhibit C

ASSIGNMENT

WHEREAS, I, MARC COOPERMAN residing at _____ _____, desire to convey any and all rights, if any, which I may have in and to certain identified patents and/or patent applications, which are more particularly described in the attached EXHIBIT 1, which is herein incorporated by reference in its entirety;

AND, WHEREAS, SCOTT MOSKOWITZ, a resident of the State of Florida, residing at 16711 Collins Avenue, #2505, Miami, Florida, 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the identified patents and/or patent applications described in the attached EXHIBIT 1;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, his successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on Exhibit 1, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future, and in and to any and all letters patent, including extensions thereof, of any country which have been or may be granted on any of the aforesaid applications or on said improvements or any parts thereof;

AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including his respective successors, assigns and licensees) may deem (1) necessary or desirable to give effect to this Agreement, or (2) necessary, lawful and proper in the prosecution of said above-referenced applications or in the preparation or prosecution of any continuing, substitute, divisional, renewal, reexamination or reissue application or in any amendments, extensions or interference proceedings related thereto;

AND I hereby covenant for myself and my legal representatives, and agree with said ASSIGNEE, his successors and assigns, that I have granted no right or license to make, use, sell or offer to sell said invention, to anyone except said ASSIGNEE, that prior to the execution of this deed, my right, title and interest in said invention has not been otherwise encumbered, and that I have not and will not execute any instrument in conflict therewith;

ATTACHMENT 7

AND I do hereby authorize and request the United States Commissioner for Patents to issue any and all letters patent which may be granted upon said United States applications, or upon said invention or any parts thereof when granted, to said ASSIGNEE.

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

6-SEP-2002
Date

MARC COOPERMAN

County of   )
State of   )

On this 6 day of September, 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced _____ as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public: _____

My Commission Expires:
DOLORES MALACHI
Notary Public, State of New York
No. 01MA5033596
Qualified in Kings County
Commission Expires Sept. 26, 06

-2-

DISH-Blue Spike-602
Exhibit 1005, Page 0245

ATTACHMENT 7
CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Patent Applications and Patents of Moskowitz

ISSUED PATENTS

U.S. Patent No. 6,205,249, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

PENDING PATENT APPLICATIONS

U.S. Patent Application. No. 09/046,627, filed 3/24/98, "Method for Combining Transfer Function with Predetermined Key Creation"

U.S. Patent Application. No. 09/644,098, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

EPO App. No. 99915224.2, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

Jap. App. No.2000-542907, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

PCT/US00/18411, filed 7/05/00, "Method for Combining Transfer Function with Predetermined Key Creation"

OTHER PATENT APPLICATIONS

PCT/US99/07262, WO 99/52271, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

ATTACHMENT 7

Exhibit A

ASSIGNMENT

WHEREAS, I, MARC COOPERMAN residing at _____ _____, desire to convey any and all rights, if any, which I may have in and to certain identified patents and/or patent applications, which are more particularly described in the attached EXHIBIT 1, which is herein incorporated by reference in its entirety;

AND, WHEREAS, WISTARIA TRADING, INC., a corporation organized under the laws of the State of Florida, having a place of business located at 16711 Collins Avenue, #2505, Miami Beach, Florida 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the identified patents and/or patent applications described in the attached EXHIBIT 1;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all improvements and inventions disclosed in the issued patents, pending patent applications, and abandoned patent applications, identified on Exhibit 1, including any continuation, continuation-in-part, re-issue, and reexamination patent applications (based in whole or in part on said patents and applications, or based in whole or in part on any improvements disclosed in said patents and applications) that may be filed in the future, and in and to any and all letters patent, including extensions thereof, of any country which have been or may be granted on any of the aforesaid applications or on said improvements or any parts thereof;

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ATTACHMENT 7

AND I do hereby authorize and request the United States Commissioner for Patents to issue any and all letters patent which may be granted upon said United States applications, or upon said invention or any parts thereof when granted, to said ASSIGNEE.

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

6-SEP-2002
Date

MARC COOPERMAN

County of   )
State of   )

On this ___6___ day of ___September___ 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced _US0033041+ 304090792_ as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public:_____DOLORES MALACHI
My Commission Expires Public, State of New York
No. 01MA5033596
Qualified in Kings County
Commission Expires Sept. 26, _06_

-2-

ATTACHMENT 7

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Patent Applications and Patents of Wistaria

ISSUED PATENTS

U.S. Patent No. 5,428,606, "Digital Commodities Exchange"

U.S. Patent No. 5,539,735, "Digital Information Commodities Exchange"

U.S. Patent No. 5,613,004, "Steganographic Method & Device"

U.S. Patent No. 5,687,236, "Steganographic Method & Device"

U.S. Patent No. 5,745,569, "Method for Stega-Protection of Computer Code"

U.S. Patent No. 5,822,432, "Method for Human Assisted Random Key Generation and Application for Digital Watermarking System"

U.S. Patent No. 5,889,868, "Optimization Methods for the Insertion, Protection, and Detection of Digital Watermarks in Digitzed Data"

U.S. Patent No. 5,905,800, "Method & System for Digital Watermarking"

U.S. Patent No. 6,078,664, "Z-Transform Implementation of Digital Watermarks"

PENDING PATENT APPLICATIONS

U.S. Patent Application. No. 08/999,766, filed 7/23/97, "Continuation of Steganographic Method & Device" (continuation of 5,687,236, which itself is a continuation of 5,613,004)

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U.S. Patent Application 09/281,279, "Optimization Methods for the Insertion, Protection and Detection of Digital Watermarks in Digitized Data" (continuation of U.S. Patent No. 5,889,868)

EPO APP. 96919405.9, "Steganographic Method and Device"

OTHER PATENT APPLICATIONS

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

ATTACHMENT 7

PCT/US97/00652, WO 97/26733, "Method for Human Assisted Random Key Generation and Application for Digital Watermarking System"

PCT/US97/00651, WO 97/26732, "Method for Stega-Cipher Protection of Computer Code"

PCT/US96/10257, WO 96/42151, "Steganographic Method and Device"

U.S. Patent Application. No. 08/481,021, "Fraud Detection System for Electronic Networks"

PCT/US96/10096, "Fraud Detection System for Electronic Networks"

PCT/US95/08159, WO 97/01892, "Digital Commodities Exchange"

PCT/US97/11455, WO 98/02864, "Optimization Methods for the Insertion, Protection and Detection of Digital Watermarks in Digitized Data"

ATTACHMENT 7

ASSIGNMENT

WHEREAS, I, MARC COOPERMAN residing at ___ 4 LEONARD TER. ___ _____ ASBURY NJ, US _____, desire to convey any and all rights, if any, which I may have in and to certain intellectual property or other property as set forth on the attached **EXHIBIT 1**, which is herein incorporated by reference in its entirety;

AND, WHEREAS, **WISTARIA TRADING, INC.**, a corporation organized under the laws of the State of Florida, having a place of business located at 16711 Collins Avenue, #2505, Miami Beach, Florida 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the intellectual property or other property described in the attached **EXHIBIT 1**;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all intellectual property or other property identified on **Exhibit 1**;

AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including their respective successors, assigns and licensees) may deem necessary or desirable to give effect to this Agreement;

IN WITNESS WHEREOF, I have hereunto set my hand and seal.

___ 6-SEP-2002 ___
Date

MARC COOPERMAN

County of ⟩
State of ⟩

On this __6__ day of September, 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced Passport USA #2004707092 as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public:_____ DOLORES MALACHI
My Commission Expires: Notary Public, State of New York
No. 01MA5033596
Qualified in Kings County
Commission Expires Sept. 26, 06

ATTACHMENT 7

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Other Property of Wistaria

Dice's books and records; Argent software and related source code and executable applications; an Argent sign from The Spotlight Convention; Error Correction source code and documentation work by David Feldmeier; color stylewriter; Sony MiniDisc player and accessories; Apple computer; Seiko disk labeler; Apple Developer Kit and monthly CD-ROM disks from subscription since 1994; Metroworks Code Warrier Developer Kit and supporting documentation; Digidesign Developer Kit; ProTools connections and software; Argent Sonic Quality Test DAT tape; Silicon Valley Bank books (check book and supporting materials); Bank of America books (check book and supporting materials); invoices, receipts and bills paid by the Company; various books including Principles of Digital Audio, Macintosh Audio Bible, Communication Theory, Handbook of Visual Communication Theory; articles boxed and archived since 1995 by Cooperman; and Argent™ t-shirts (collectively the "Dice Property").

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

ATTACHMENT 7

WHITE & CASE
LIMITED LIABILITY PARTNERSHIP

WACHOVIA FINANCIAL CENTER, SUITE 4900
200 SOUTH BISCAYNE BOULEVARD
MIAMI, FLORIDA 33131-2352

TELEPHONE: (1-305) 371-2700
FACSIMILE: (1-305) 358-5744/5766

DIRECT DIAL: (305) 995-5249

FACSIMILE TRANSMISSION

Date:	March 25, 2004	**No. of Pages (including cover):**	37
To:	Scott Moskowitz	**Fax Number:**	305-956-9041
		Contact Number:	
From:	Terrance A. Dee	**Reference No.:**	1504146-0002

PART 2

ATTACHMENT 7

Exhibit C

ASSIGNMENT

WHEREAS, I, **MARC COOPERMAN** residing at ___5 (ξ) Λ,Λ/¹D]¹/²/_____ _____Λ(³)ξ(.Λιξ), ιν ϑ (ϟ] ξ _____, desire to convey any and all rights, if any, which I may have in and to certain identified patents and/or patent applications, which are more particularly described in the attached **EXHIBIT 1**, which is herein incorporated by reference in its entirety;

AND, WHEREAS, **SCOTT MOSKOWITZ**, a resident of the State of Florida, residing at 16711 Collins Avenue, #2505, Miami, Florida, 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the identified patents and/or patent applications described in the attached **EXHIBIT 1**;

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AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including his respective successors, assigns and licensees) may deem (1) necessary or desirable to give effect to this Agreement, or (2) necessary, lawful and proper in the prosecution of said above-referenced applications or in the preparation or prosecution of any continuing, substitute, divisional, renewal, reexamination or reissue application or in any amendments, extensions or interference proceedings related thereto;

AND I hereby covenant for myself and my legal representatives, and agree with said ASSIGNEE, his successors and assigns, that I have granted no right or license to make, use, sell or offer to sell said invention, to anyone except said ASSIGNEE, that prior to the execution of this deed, my right, title and interest in said invention has not been otherwise encumbered, and that I have not and will not execute any instrument in conflict therewith;

ATTACHMENT 7

    AND I do hereby authorize and request the United States Commissioner for Patents to issue any and all letters patent which may be granted upon said United States applications, or upon said invention or any parts thereof when granted, to said ASSIGNEE.

    IN WITNESS WHEREOF, I have hereunto set my hand and seal.

_____6-SEP-2002_____   _____
Date   MARC COOPERMAN

County of   )
State of   )

    On this __6__ day of __September__, 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced __US Passport 200909892__ as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)   _____
                                         Notary Public:_____ DOLORES MALACHI
                                         My Commission Expires Public, State of New York
                                                         No. 01MA5033596
                                                   Qualified in Kings County
                                         Commission Expires Sept. 26, _2006_

-2-

ATTACHMENT 7
CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Patent Applications and Patents of Moskowitz

ISSUED PATENTS

U.S. Patent No. 6,205,249, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

PENDING PATENT APPLICATIONS

U.S. Patent Application. No. 09/046,627, filed 3/24/98, "Method for Combining Transfer Function with Predetermined Key Creation"

U.S. Patent Application. No. 09/644,098, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

EPO App. No. 99915224.2, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

Jap. App. No.2000-542907, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

PCT/US00/18411, filed 7/05/00, "Method for Combining Transfer Function with Predetermined Key Creation"

OTHER PATENT APPLICATIONS

PCT/US99/07262, WO 99/53271, "Multiple Transform Utilization and Application for Secure Digital Watermarking"

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

ATTACHMENT 7

Exhibit D

ASSIGNMENT

WHEREAS, I, MARC COOPERMAN residing at _____ _____, desire to convey any and all rights, if any, which I may have in and to certain intellectual property or other property as set forth on the attached **EXHIBIT 1**, which is herein incorporated by reference in its entirety;

AND, WHEREAS, **WISTARIA TRADING, INC.**, a corporation organized under the laws of the State of Florida, having a place of business located at 16711 Collins Avenue, #2505, Miami Beach, Florida 33160, (hereinafter "ASSIGNEE"), is desirous of acquiring said rights in and to the intellectual property or other property described in the attached **EXHIBIT 1**;

NOW, THEREFORE, in consideration of the sum of One Dollar ($1.00) or the equivalent thereof, and other good and valuable consideration, receipt of which is hereby acknowledged, I do hereby sell, assign and transfer unto said ASSIGNEE, its successors, assigns and legal representatives, my entire right, title and interest, if any, in and throughout the United States of America (including its territories and dependencies) and all countries foreign thereto in and to any and all intellectual property or other property identified on **Exhibit 1**;

AND I hereby agree for myself and my heirs, executors and administrators to execute without further consideration all assignments, instruments, affidavits, and other documents, and to perform such other similar acts, as the ASSIGNEE (including their respective successors, assigns and licensees) may deem necessary or desirable to give effect to this Agreement;

IN WITNESS WHEREOF, I have hereunto set my hand and seal.
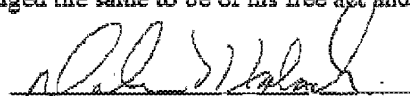
6-SEP-2002
Date

_____
MARC COOPERMAN

County of   )
State of   )

On this __6__ day of Sc/tenber, 2002, before me a Notary Public in and for the County and State aforesaid, personally appeared MARC COOPERMAN, who is personally known to me or who produced Passport of USA H-304090995 as identification, and who signed and sealed the foregoing instrument, and acknowledged the same to be of his free act and deed.

(Seal)

Notary Public:_____
My Commission Expires

DOLORES MALACHI
Notary Public, State of New York
No. 01MAS032596
Qualified in Kings County
Commission Expires Sept. 26, 2002
06

ATTACHMENT 7

CONFIDENTIAL INFORMATION OF BLUE SPIKE, INC.

Exhibit 1
Other Property of Wistaria

Dice's books and records; Argent software and related source code and executable applications; an Argent sign from The Spotlight Convention; Error Correction source code and documentation work by David Feldmeier; color stylewriter; Sony MiniDisc player and accessories; Apple computer; Seiko disk labeler; Apple Developer Kit and monthly CD-ROM disks from subscription since 1994; Metroworks Code Warrier Developer Kit and supporting documentation; Digidesign Developer Kit; ProTools connections and software; Argent Sonic Quality Test DAT tape; Silicon Valley Bank books (check book and supporting materials); Bank of America books (check book and supporting materials); invoices, receipts and bills paid by the Company; various books including Principles of Digital Audio, Macintosh Audio Bible, Communication Theory, Handbook of Visual Communication Theory; articles boxed and archived since 1995 by Cooperman; and Argent™ t-shirts (collectively the "Dice Property").

ATTACHMENT 8

Support for claims of USP 9021602 in USP 5745569.

Claim terms appear in bold and are followed by braces "{}" with showings of support for the claim recitation in USP 5745569. Key phrases in USP 5745569 are also bolded or italicized.

1. A computer based method for accessing functionality provided by an application software comprising: {"One method of the present invention is now discussed. When code and data resources are compiled and assembled into a precursor of an executable program the next step is to use a utility application for final assembly of the executable application. The programmer marks several essential code resources in a list displayed by the utility. The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process. The end result will be that these essential code resources are not stored in their own partition, but rather stored as encoded information in data resources. *They are not accessible at run-time without the key.* Basically, the essential code resources that provide functionality in the final end-product, an executable application or computer program, are no longer easily and recognizably available for manipulation by those seeking to remove the underlying copyright or license, or its equivalent information, or those with skill to substitute alternative code resources to "force" the application program to run as an unauthorized copy. For the encoding of the essential code resources, a "key" is needed. Such a key is similar to those described in U.S. Pat. No. 5,613,004, the "Steganographic Method and Device" patent. The purpose of this scheme is to make a particular licensed copy of an application distinguishable from any other. It is not necessary to distinguish every instance of an application, merely every instance of a license. A licensed user may then wish to install multiple copies of an application, legally or with authorization. This method, then, is to choose the key so that it corresponds, is equal to, or is a function of, a license code or license descriptive information, not just a text file, audio clip or identifying piece of information as desired in digital watermarking schemes extant and typically useful to stand-alone, digitally sampled content. *The key is necessary to access the underlying code, i.e., what the user understands to be the application program.*" Col. 5:40 to 6:8.}

storing said application software in non transient memory of a computer; {"That is, once a function or procedure is compiled, the order of the machine instructions which comprise the executable object code of the function is important and their order **in the computer memory** is of vital importance." and "The **memory address** of the first instruction in one of these sub-objects is called the "entry point" of the function or procedure." Col.4:1-4 and "A preferred embodiment would be implemented in an embedded system, with a minimal **operating system and memory**." Col. 7:1-3.}

said application software in said computer prompting a user to enter into said computer personalization information; {"1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code" Col. 6:23-25.}

said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license

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ATTACHMENT 8

code entered in response to said prompting; {"1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. This can include a particular computer configuration; 2) it stores this information in a personalization data resource; " Col. 6:23-28.}

said application software in said computer generating a proper decoding key, said generating comprising using said license code; {"3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." Col. 6:29-31.}

and wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource. {"The key is necessary to access the underlying code, i.e., what the user understands to be the application program." Col. 6:6-8 and "3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." Col. 6:29-32.}

2. The method of claim 1, wherein said encoded code resource is encoded in at least one data resource. {"A method for protecting computer code copyrights by encoding the code into a data resource with a digital watermark. The digital watermark contains licensing information interwoven with essential code resources encoded into data resources." in the Abstract; "A collection of smaller, atomic (or indivisible) chunks of object code typically comprise the complete executable object code or application which *may also require the presence of certain data resources.*" Col. 3:4750; and "The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process. The end result will be that these essential *code resources* are not stored in their own partition, but rather stored *as encoded information in data resources.*" Col. 5:45-50}

3. The method of claim 1 wherein said encoded code resource is steganographically encoded. {"The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process." Col. 5:45-48.}

4. The method of claim 3 wherein said encoded code resource is encoded in a data resource. {"The utility will choose one or several essential code resources, and encode them into one or several data resources ...." Col. 5:45-47.}

5. The method of claim 1 wherein said computer configuration information is stored in a data resource. {"This can include a particular computer configuration; 2) *it stores this information in a personalization data resource;*" 2) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." Col. 6:25-28.}

6. The method of claim 5 wherein said computer configuration information is stored steganographically in said data resource. {"One method of the present invention is now discussed. When code and data resources are compiled and assembled into a precursor of an executable program the next step is to use a utility application for final assembly of the

Page 2 of 7

executable application. The programmer marks several essential code resources in a list displayed by the utility. *The utility will choose one or several essential code resources, and encode them into one or several data resources using **the stegacipher process***. The end result will be that these essential code resources are not stored in their own partition, but rather stored as encoded information in data resources. They are not accessible at run-time without the key. Basically, the essential code resources that provide functionality in the final end-product, an executable application or computer program, are no longer easily and recognizably available for manipulation by those seeking to remove the underlying copyright or license, or its equivalent information, or those with skill to substitute alternative code resources to "force" the application program to run as an unauthorized copy. *For the encoding of the essential code resources, a "key" is needed. Such a key is similar to those described in U.S. Pat. No. 5,613,004, the **"Steganographic Method and Device" patent.***" Col. 5:40-62.}

7. The method of claim 1 where said license code is a function of said computer configuration information. {"1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. This can include a particular computer configuration;" Col. 6:23-26.}

8. The method of claim 1 wherein said computer comprises a processor and said application software using said processor in said prompting and said storing. {", the present invention concerns itself with any application software that may be used in general computing devices" Col. 7:59-61.}

9. The method of claim 1 wherein said encoded code resource is steganographically encoded in a data resource. {"The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process." Col. 5:45-47}

10. A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising: {"One method of the present invention is now discussed. When code and data resources are compiled and assembled into a precursor of an executable program the next step is to use a utility application for final assembly of the executable application. The programmer marks several essential code resources in a list displayed by the utility. The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process. The end result will be that these essential code resources are not stored in their own partition, but rather stored as encoded information in data resources. *They are not **accessible** at run-time without the key.* Basically, the essential code resources that provide functionality in the final end-product, an executable application or computer program, are no longer easily and recognizably available for manipulation by those seeking to remove the underlying copyright or license, or its equivalent information, or those with skill to substitute alternative code resources to "force" the application program to run as an unauthorized copy. For the encoding of the essential code resources, a "key" is needed. Such a key is similar to those described in U.S. Pat.

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No. 5,613,004, the "Steganographic Method and Device" patent. The purpose of this scheme is to make a particular licensed copy of an application distinguishable from any other. It is not necessary to distinguish every instance of an application, merely every instance of a license. A licensed user may then wish to install multiple copies of an application, legally or with authorization. This method, then, is to choose the key so that it corresponds, is equal to, or is a function of, a license code or license descriptive information, not just a text file, audio clip or identifying piece of information as desired in digital watermarking schemes extant and typically useful to stand-alone, digitally sampled content. *The key is necessary to* **access** *the underlying code, i.e., what the user understands to be the application program.*" Col. 5:40 to 6:8.}

storing said application software code in non transient memory of a computer system; {Same recitation claim 1; see claim 1.}

said application software code in said computer system prompting a user to enter into said computer system personalization information; {Same recitation claim 1; see claim 1.}

said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting; {Same recitation claim 1; see claim 1.}

said application software code in said computer system generating a proper decoding key, said generating comprising using said license code; and {Same recitation claim 1; see claim 1.}

wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource. {Same recitation claim 1; see claim 1.}

11. The product of claim 10 wherein said computer program product causes storing of said computer configuration information steganographically in a data resource in non transient memory of said computer. {"The application can then operate as follows: 1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. This can include a particular computer configuration; 2) *it stores this information in a personalization data resource*; 3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." Col. 6:22-31 and "In U.S. Pat. No. 5,613,004, the "*Steganographic Method and Device, patent*", the possibility of randomization erasure attacks on digital watermarks was discussed. Simply, it is always possible to erase a digital watermark, depending on how much damage you are willing to do to the watermark-bearing content stream. The present invention has the significant advantage that *you must have the watermark to be able to use the code it contains. If you erase the watermark you have lost a key piece of the functionality of the application*, or even the means to access the data

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which bear the watermark." Col. 6:56-67.}

12. The product of claim 10 wherein said computer program product causes storing of said encoded code resource in a data resource in non transient memory of said computer. {Abstract, "A method for protecting computer code copyrights by encoding the code into a data resource with a digital watermark." and "The utility will choose one or several essential code resources, and *encode them into one or several data resources*...." Col. 5:45-46.}

13. The product of claim 10 wherein said computer program product causes storing of said encoded code resource steganographically in a data resource in non transient memory of said computer. {"The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process." Col. 5:4548.}

14. A computer system comprising a processor and memory, said computer system configured by an application software, comprising: {"One method of the present invention is now discussed. When code and data resources are compiled and assembled into a precursor of an executable program the next step is to use a utility application for final assembly of the executable application. The programmer marks several essential code resources in a list displayed by the utility. The utility will choose one or several essential code resources, and encode them into one or several data resources using the stegacipher process. The end result will be that these essential code resources are not stored in their own partition, but rather stored as encoded information in data resources. *They are not accessible at run-time without the key.* Basically, the essential code resources that provide functionality in the final end-product, an executable application or computer program, are no longer easily and recognizably available for manipulation by those seeking to remove the underlying copyright or license, or its equivalent information, or those with skill to substitute alternative code resources to "force" the application program to run as an unauthorized copy. For the encoding of the essential code resources, a "key" is needed. Such a key is similar to those described in U.S. Pat. No. 5,613,004, the "Steganographic Method and Device" patent. The purpose of this scheme is to make a particular licensed copy of an application distinguishable from any other. It is not necessary to distinguish every instance of an application, merely every instance of a license. A licensed user may then wish to install multiple copies of an application, legally or with authorization. This method, then, is to choose the key so that it corresponds, is equal to, or is a function of, a license code or license descriptive information, not just a text file, audio clip or identifying piece of information as desired in digital watermarking schemes extant and typically useful to stand-alone, digitally sampled content. *The key is necessary to access the underlying code, i.e., what the user understands to be the application program.*" Col. 5:40 to col. 6:8.}

      said computer system storing said application software in non transient memory of said computer system; {Same support as for claim 1's storing recitation.}

      said application software in said computer system configuring said computer system to prompt a user to enter into said computer personalization information; {Same support as for claim 1's prompting recitation.}

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said application software in said computer system configuring said computer system to store, in said non transient memory, in a personalization data resource, both computer system configuration information of said computer system, and a license code entered in response to said prompt; {Same support as claim 1's "said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting; " recitation.}

said application software in said computer system generating a proper decoding key, said generating comprising using said license code; and {Same support as claim 1's recitation "said application software in said computer generating a proper decoding key, said generating comprising using said license code;"}

wherein said application software, in said computer system, cannot access at least one encoded code resource of said application software in said computer system, unless said license code is stored in said personalization data resource. {Same support as for claim 1's recitation "wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource."}

15. The computer system of claim 14 wherein said computer system is configured by said application software to store said computer system configuration information in a data resource in non transient memory of said computer. {"1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. This can include a particular computer configuration; 2) it stores this information in a personalization data resource;" Col. 6:23-28.}

16. The computer system of claim 14 wherein said computer system is configured by said application software to store said computer system configuration information steganographically in a data resource in non transient memory of said computer system. {Same support as for claim 11.}

17. The computer system of claim 14 wherein said computer system is configured by said application software to store said encoded code resource in a data resource in non transient memory of said computer system. {Same support as for claim 12.}

18. The method of claim 1 further comprising said application software in said computer using said proper decoding key to access said at least one encoded code resource. {"3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." Col. 6:29-32.}

19. The method of claim 1 wherein said application software in said computer does not prompt a user to enter personalization information if said personalization data resource stores said license code. {"The application can then operate as follows: 1) when it is run for the

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first time, after installation, it asks the user for personalization information ... 3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources. Note that the application can be copied in an uninhibited manner, but must contain the license code issued to the licensed owner, to access its essential code resources. The goal of the invention, copyright protection of computer code and establishment of responsibility for copies, is thus accomplished." Col. 6:22-37.}

/RichardNeifeld/
RICHARD NEIFELD, REG. NO. 35,299

ATTACHMENT 9

USPTO UNITED STATES PATENT AND TRADEMARK OFFICE

Assignment abstract of title for Application 08587943

Invention title/Inventor	Patent	Publication	Application	PCT	International registration
METHOD FOR STEGA-CIPHER PROTECTION OF COMPUTER CODE SCOTT A. MOSKOWITZ, MARC COOPERMAN	5745569 Apr 28, 1998		08587943 Jan 17, 1996		

Assignments (5 of 5 total)

Assignment 5

Reel/frame	Execution date	Date recorded	Properties	Pages
043082/0189	Jul 24, 2017	Jul 24, 2017	10	5

Conveyance
ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors
BLUE SPIKE, LLC

Correspondent
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5400 SHAWNEE ROAD, SUITE 310
ALEXANDRIA, VA 22312

Assignee
WISTARIA TRADING LTD
CLARENDON HOUSE, 2 CHURCH STREET
HAMILTON HM 11
BERMUDA

Assignment 4

Reel/frame	Execution date	Date recorded	Properties	Pages
030465/0479	May 08, 2013	May 22, 2013	1	4

Conveyance
ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors
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ALEXANDRIA, VA 22304

Assignee
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1820 SHILOH ROAD, SUITE 1201C
TYLER, TEXAS 75703

Assignment 3

Reel/frame	Execution date	Date recorded	Properties	Pages
009987/0161	May 12, 1999	Jun 01, 1999	7	7

Conveyance
ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors
DICE COMPANY

Correspondent
WISTARIA TRADING, INC
SCOTT A. MOSKOWITZ, PRESIDENT
16711 COLLINS AVENUE
SUITE 2505

ATTACHMENT 9

MIAMI, FL 33160

Assignee
WISTARIA TRADING, INC
SUITE 2505
16771 COLLINS AVENUE
MIAMI, FLORIDA 33160

Assignment 2

Reel/frame	Execution date	Date recorded	Properties	Pages
009214/0224	Dec 09, 1997	May 21, 1998	9	10

Conveyance
SECURITY AGREEMENT

Assignors
DICE COMPANY, THE

Correspondent
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MICHAEL FORTKORT
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WASHINGTON, DC 20036-5405

Assignee
WISTARIA TRADING INC.

20191 EAST COUNTRY CLUB DR. #TH4
AVENTURA, FLORIDA 33180

Assignment 1

Reel/frame	Execution date	Date recorded	Properties	Pages
007860/0316	Mar 12, 1996	Mar 18, 1996	1	3

Conveyance
ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors
MOSKOWITZ, SCOTT A.
COOPERMAN, MARC

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518   7590   12/12/2018
NEIFELD IP LAW, PC
5400 Shawnee Road
Suite 310
ALEXANDRIA, VA 22312-2300

EXAMINER
WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/12/2018	PAPER

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

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISCH SIGLER LLP
5301 WISCONSIN AVENUE, NW
FOURTH FLOOR
WASHINGTON, DC 20015

Date: December 12, 2018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014137
PATENT NO. : 9021602
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

NEIFELD IP LAW, PC	:	
5400 Shawnee Road	:	
Suite 310	:	Patent Owner
Alexandria, VA 22312	:	

FISCH SIGLER LLP	:	
5301 WISCONSIN AVENUE, NW	:	
FOURTH FLOOR	:	Third Party Requester
WASHINGTON, DC 20015	:	

	:	
In re Application of: Scott Moskowitz	:	DECISION ON PETITION
Appl. No. 90/014,137		FOR CORRECTION
Patent No. 9,021,602		OF PATENT UNDER
Filed: March 11, 2013	:	37 C.F.R. § 1.324(b)
For: DATA PROTECTION METHOD	:	
AND DEVICE	:	

This is a decision on a <u>renewed</u> petition under 37 C.F.R. § 1.324 filed December 4, 2018 to correct the inventorship of U.S. Patent No. 9,021,602 to add Marc Cooperman as inventor.

The petition is **<u>Granted.</u>**

37 C.F.R. §1.530(l)(1) provides:

When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Director may, on petition of all the parties set forth in §1.324(b)(1)-(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

A petition to correct inventorship as provided by 37 C.F.R. § 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b).

This petition complies with all requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(I)(1).

37 C.F.R. § 1.324(b)(1) requires a statement from each person who is being added as an inventor.

Regarding this requirement, patent owner submitted a signed statement from Marc Cooperman that he has no disagreement with the change of adding his name as an inventor of the '602 patent.

37 C.F.R. § 1.324(b)(2) requires a statement from the current named inventors either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change.

Patent Owner has submitted statements under 37 C.F.R. § 1.324(b)(2) by Scott Moskowitz that provide an affirmative statement he agrees with the change to the inventorship.

37 C.F.R. § 1.324(b)(3) requires a statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 37 C.F.R. § 3.73(b).

Patent Owner has submitted a statement signed by Scott Moskowitz, who is duly authorized to act on behalf of the assignee Wistaria Trading Ltd. In this statement, the assignee affirmatively agreed to the change of inventorship.

37 C.F.R. § 1.324(b)(3) requires the fee set forth in 37 C.F.R. § 1.20(b).

Patent Owner has submitted the proper fee as set forth in 37 C.F.R. § 1.20(b).

Conclusion

Patent Owner has complied with all formal and procedural requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(I)(1).

Accordingly, Patent Owner's petition for a Correction of Inventorship of US 7,897,372 is **Granted.**

/Stephen Stein/
Quality Assurance Specialist
Central Reexamination Unit
(571) 272-3744

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518   7590   12/14/2018

NEIFELD IP LAW, PC
5400 Shawnee Road
Suite 310
ALEXANDRIA, VA 22312-2300

EXAMINER
WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/14/2018	PAPER

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PTOL-90A (Rev. 04/07)

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FISCH SIGLER LLP

5301 WISCONSIN AVENUE, NW

FOURTH FLOOR

WASHINGTON, DC 20015

Date: **DEC 1 4 2018**

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014137
PATENT NO. : 9021602
ART UNIT : 3992

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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)).

Decision on Petition for Extension of Time in Reexamination	Application No. 90/014,137	Applicant(s) 9,021,602	
	Examiner William H. Wood	Art Unit 3992	

1. THIS IS A DECISION ON THE PETITION FILED <u>December 12, 2018</u>.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☒ 37 CFR 1.550(c) – The time for taking any action by a patent owner in a third party requested *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☐ 37 CFR 1.550(c) – The time for taking action by a patent owner in a patent owner requested *ex parte* reexamination proceeding will only be extended for more than two months for sufficient cause and for a reasonable time specified.
   C. ☐ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on <u>November 30, 2018</u> which set a <u>two (2) month</u> period for filing a response thereto, be extended by an additional <u>one (1) month.</u>
   A. Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☒ Petition includes authorization to charge a credit card account.
      iii. ☐ Other _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☐ Granted-in-part for _____ because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☒ <u>The petition is moot</u>
      vi. ☒ <u>Other/comment: The basis of the petition for an extension of time is to allow time for the Office to decide the December 4, 2018 petition under 37 CFR 1.324 to correct inventorship. This petition was granted on December 12, 2018 and thus the petition for the extension of time is moot.</u>

5. CONCLUSION: **The response to the Office action mailed November 30, 2018 remains due January 30, 2019.**

6. Telephone inquiries with regard to this decision should be directed to <u>Stephen Stein</u> at <u>571-272-1544</u> in the CRU.

	/Stephen Stein/ Supervisory Patent Reexamination Specialist Central Reexamination Unit

Reexamination Control Number: 90014137
Confirmation No: 6880
RE: USP 9021602

Patent Owner Response to the Non Final Office Action (NFOA) dated 11-30-2018.

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REMARKS

Introduction

  This is a response to the NFOA dated 11-30-2018. The NFOA summary page indicates that claims 1-5, 8, 10, and 12 are subject to reexamination; claims 6-7, 9, 11, and 13-19 are not subject to reexamination; and claims 1-5, 8, 10, and 12 are rejected. The NFOA addresses each issue raised in the reexamination request.

  The patentee previously submitted with a Patent Owner Response attachments1-9. Those attachments and the Patent Owner Response are incorporated herein by reference.

The attachment submitted with the Patent Owner Response are:

  Attachment 1, Pages 1-28 from the file history of application 08/587,793 (issued as USP5745569) (27 Pages)

  Attachment 2, USP5745569 (6 pages)

  Attachment 3, Pages 1-12 and 172-192 of the transcript of the deposition of Marc S. Cooperman, May 17, 2018, in Blue Spike LLC v. Juniper Networks, Inc., civil case 6:17-cv-00016-KNM. (33 Pages)

  Attachment 4, Comparison of Disclosures of US application 08/587,943; WO 97/26732; USP5,745,569; USP9021602; and USP9104842. (5 pages)

  Attachment 5, 37 CFR 1.324 Petition to Correct Inventorship in Issued US Patent 9021602. (2 pages)

  Attachment 6, Agreement of Assignee of Record and Original Inventor to Correction of Inventorship (1 page)

  Attachment 7, 2002 Settlement Agreement (37 pages)

  Attachment 8, Claim chart showing that USP5,745,569 and US application 08/587,943 supports the claims of US Patent 9021602. (7 pages)

  Attachment 9, Title Abstract for application, 08587943, now USP5745569. (2 Pages)

List of Additional Attachments Submitted With This Response

Attachment 10: "Decision on Petition For Correction of Patent Under 37 CFR 1.324(b)", for USP 9021602.

Attachment 11: 37 CFR 1.131 Declaration of Scott Moskowitz.

Attachment 12: (No attachment 12)

Attachment 13: The PAIR Image File Wrapper for application 09046627, as filed.

Attachment 14: The PAIR Image File Wrapper for application 10602777, as filed.

Attachment 15: The PAIR Image File Wrapper for application 11895388, as filed.

Attachment 16: The PAIR Image File Wrapper for application13556420, as filed.

Attachment 17: Claim chart showing support for rejected claims in:

  application 08587793 attachment 1;

  application 09046627, attachment 13 (issued as USP8930719, Attachment 22);

  application 10602777, attachment 14 (issued as USP 7664263 Attachment 21;

  application 11895388, attachment 15 (issued as USP 9104842, Attachment 20);

  application 13556420, attachment 16 (issued as USP8930719, Attachment 19); and

  USP 9021602.

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Attachment 18: Recorded Assignment For USP 9021602.
Attachment 19: Cover page of USP8930719 (issued from 13/556,420 attachment 16).
Attachment 20: Cover page of USP 9104842 (issued from 11/895,388 attachment 15).
Attachment 21: Cover page of USP 7664263 (issued from 10/602,777 attachment 14).
Attachment 22: Cover page of USP 6598162 (issued from 09/046,627 attachment 13).
Attachment 23: Non Disclosure Agreement with Marc Cooperman dated 11-20-1993.
Attachment 24: Page1 of letter from Marc Cooperman dated 11-18-1996.
Attachment 25: Email from Marc Cooperman dated 11-15-95.
Attachment 26: Draft Application Dated 12-22-95.
Attachment 27: Draft Application Dated 01-03-96.

Response to Issues raised in NFOA
　　　　In response, the patentee addresses each issue in this response, for completeness.

Issues 1-4, NFOA Conclusion
　　　　The NFOA concluded that, "2) as indicated above, the ordinary and customary interpretation of the claim language is not met by SNQs 1-4, and as such there is no need to reach a conclusion regarding Patent Owner's statements to those SNQs." NFOA 10:19-21. This response further addresses issues 1-4, for clarity.

Issue 1
　　　　The NFOA states "Claims 1, 2, 5, 8, 10, and 12 are proposed rejected, but not applied, as anticipated by Beetcher under 35 USC 102(e)." NFOA 3:1-2. The Patentee notes that the reexamination request identified issue 1 as alleged anticipation over USP 5993497, naming Beetcher as an inventor. The NFOA found that Claims 1, 2, 5, 8, 10, and 12 are **not** anticipated by USP 5993497.
　　　　The Patentee notes that the NFOA states that "the proposed rejection is **unpersuasive** in demonstrating an application software storing, in response to prompting, in a personalization data resource, "both computer configuration information of said computer", and a license code entered." NFOA 3:4-6.
　　　　The Patentee notes that Mr. Silva (the reexamination requestor's expert witness) declared that the "data resources (as best understood) correspond[]... to the functions of the software." Silva declaration, page 23, ¶58:1-2.
　　　　The Patentee notes that the Patent Owner Statement, page 2:17-35 states:

　　　　　　Claim 1 defines "1. A computer based method ... comprising:...said application software storing ... in a personalization data resource, both computer configuration information of said computer, and a license code entered in response to said prompting." Beetcher '497 does not disclose storing computer configuration information in a data resource. Therefore, Beetcher '497 does not anticipate claim 1. *** USP9021602 makes it clear that a "data resource" is distinct from executable object code. *** Thus, the specification defines a data resource as non executable, and distinct from, not included in, code resources.

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It appears that the patent examiner did not believe Mr. Silva's assertion that "data resources (as best understood) correspond[]... to the functions of the software."

Issue 2

The NFOA states "Claims 3 and 4 are proposed rejected, but not applied, as unpatentable over Beetcher in view of Rhoads under 35 USC 103(a). *** the proposed rejection is unpersuasive in demonstrating all the limitations of claim 1." NFOA 3:11-15. The Patentee notes that this statement needs no explanation.

Issue 3

The NFOA states "Claims 1, 2, 5, 8, 10, and 12 are proposed rejected, but not applied, as anticipated by Beetcher '072 under 35 USC 102(b)." NFOA 3:16-17. The Patentee notes that the reexamination request identified issue 3 as alleged anticipation over Japanese Patent Application Publication No. H05334072 ("Beetcher '072"). The NFOA found that Claims 1, 2, 5, 8, 10, and 12 are not anticipated by Beetcher '072. The patentee notes that the reasoning in the NFOA for Issue 3 parallels the reasoning for Issue 1.

Issue 4

The NFOA states "Claims 3 and 4 are proposed rejected, but not applied, as unpatentable over Beetcher '072 in view of Rhoads under 35 USC 103(a)." NFOA 4:4-5. The Patentee notes that the reexamination request identifies Rhoads as USP 5,745,604, naming Rhoads as an inventor. The NFOA notes that this is because "the proposed rejection is unpersuasive in demonstrating all the limitations of claim 1, on which claims 3 and 4 depend." NFOA 4:6-8. The Patentee notes that this statement needs no explanation.

Issues 5, 6, and 7

These issues are treated together because they all fail for the same reason, which is that the patentee shows that Cooperman and Hicks do not qualify as prior art.

For issue 5, the NFOA states "Claims 1, 2, 3, 4, 5, 8, 10, and 12 are rejected as anticipated by Cooperman under 35 USC 102(a)." NFOA 4:10. The patentee notes that the reexamination request identified Cooperman as PCT Application Publication No. WO 97/26732. The Patentee notes that Cooperman has a 102(a) date of **7/24/1997**.

For issue 6, the NFOA states "Claims 1, 2, 5, 8,10, and 12 are rejected as anticipated by Hicks under 35 USC 102(e)." NFOA 6:8. The Patentee notes that the reexamination request identified Hicks as USP 5982892, naming Hicks as an inventor. The Patentee notes that Hicks has a 102(e) date of **12/22/1997**.

For issue 7, the NFOA states "Claims 3 and 4 are rejected as unpatentable over Hicks in view of Rhoads under 35 USC 103(a)." NFOA 8:2. The patentee notes that the reexamination request identified Rhoads as USP 5745604, which issued 4/28/1998, from an application filed **3/15/1996**.

Issues 5, 6, and 7, and the Patentee's Summary Response

The NFOA concluded that "Patent Owner has not established common inventorship of the instant patent with Cooperman or Moskowitz et al. (USPN 5,745,569)." NFOA 10:23-24. In

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summary response, the PTO added Cooperman as an inventor on 12-12-2018.

The NFOA concluded that "nor has Patent Owner submitted an appropriate oath or declaration to establish invention of the subject matter prior to the effective date of the reference (37 CFR 1.131)." NFOA 10:24-25. In summary response, the patentee submits herewith a 37 CFR 1.131 and further reasoning.

Moreover, the patentee shows continuity of disclosure, inventorship, and pendency, thereby establishing entitlement to benefit of the application 09/046,627, filed 3/24/1998. This entitlement prevents the applied references from being 102(b) statutory bars.

The Patentee's Full Response to Issues 5, 6, and 7

The Patentee Established common inventorship of USP 9021602 and USP 5745569

The NFOA concluded that "Patent Owner has not established common inventorship of the instant patent with Cooperman or Moskowitz et al. (USPN 5,745,569)." NFOA 10:23-24.

In response, note that the PTO added Cooperman as an inventor on 12-12-2018 to USP 9021602. A copy of the petition decision granting the patentee's petition to correct inventorship by adding Marc Cooperman to the inventorship of USP 9021602 is attachment 10, submitted herewith. Accordingly, USP 9021602 and USP 5745569 now have common inventorship.

37 CFR 1.131 declaration establishing invention of the claimed subject matter prior to the effective dates of the references

The NFOA concluded that "nor has Patent Owner submitted an appropriate oath or declaration to establish invention of the subject matter prior to the effective date of the reference (37 CFR 1.131)." NFOA 10:24-25. And the NFOA stated that "Patent Owner's statements asserting the commonality between the instant claims and the patent 5,745,569 are insufficient." NFOA 11:1-2.

In response, the patentee submits herewith a 37 CFR 1.131 declaration of Scott Moskowitz, and additional reasoning, establishing invention prior to the dates of the references.

Mr. Moskowitz's declaration shows that he and Mr. Cooperman invented the inventions defined by the rejected claims not later than 1/16/1996, which is prior to the dates of the Cooperman and Hicks references. This overcomes the rejections relying upon Cooperman and Hicks.

Mr. Moskowitz's declaration complies with the formal requirements for a 37 CFR 1.131 declaration. MPEP 715.04, I(G) specifies that a 131 declaration may be made by the owner of the patent under reexamination. Scott Moskowitz is both a named inventor of USP 9021602, and the representative of the assignee of USP 9021602. This is shown in Attachment 18, page 9, the recorded assignment for USP 9021602, where Mr. Moskowitz signed for the assignee, averring "I am authorized to act on behalf of this entity." Accordingly, Mr. Moskowitz is entitled to make the 131 declaration. MPEP 715.07, I, specifies that a 131 declaration should be supported by exhibits (analogous to evidence) supporting factual assertions in the 131 declaration. Mr. Moskowitz's 131 declaration refers to exhibits in support of facts.

37 CFR 1.131(b) states the substantive test for a 131 declaration:

(b) The showing of facts for an oath or declaration under paragraph (a) of

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this section shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

The relevant text in 131(b) is "to establish reduction to practice." Reduction to practice covers both actual and constructive reduction to practice. Mr. Moskowitz's declaration relies upon constructive reduction to practice. As stated in footnote 16 in *Weil v. Fritz*, 572 F. 2d 856 (1978)

> ... *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288, 297 (CA1 1909) defines "constructive reduction to practice" as the filing of "a complete and allowable application;" therefore, under that view, a prior constructive reduction to practice is a previously-filed "complete and allowable application."

Accordingly, the substantive test for a constructive reduction to practice is whether a filed application is "a complete and allowable application." Mr. Moskowitz's declaration shows that application 08/587,793 filed 1/17/1996 was a complete and allowable application, both for the claims that ultimately issued from that application as USP5745569, attachment 2, and for the rejected claims issued in USP 9021602.

Moreover, there is nothing improper about avoiding losing patent term by not claiming an earliest filing date. See for example *Natural Alternatives International, Inc. v. Iancu*, 2017-1962 (Fed. Cir. 10/1/2018):

> An uncommon but permissible way for patent applicants to avoid losing term on claims that recite new matter is to disclaim the benefit of earlier filing dates. See MPEP §§ 211.02(a)(III). Thus, by deleting the benefit claim in a CIP application, the twenty-year patent term of the patent issuing from that CIP application would extend from the CIP application's filing date instead of the parent application's earlier filing date.

Entitlement to benefit of the application 09/046,627, filed 3/24/1998
The rejected claims are entitled to benefit of application 09/046,627, filed 3/24/1998. The cover page of USP 9021602 shows this benefit. Attachment 17 to this response shows that the claims are supported by application 09/046,627, as filed 3/24/1998, and by each of the other applications to which USP 9021602 claims benefit. Consequently, Cooperman and Hicks are not 102(b) prior art. Consequently, Cooperman and Hicks are antedateable by a suitable showing of prior invention, such as Mr. Moskowitz's 131 declaration submitted herewith.
The following chart shows the chain of benefit applications claimed on the face of the

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subject patent, USP 9021602, their filing date, and their issue date:

Application and corresponding issued patent	Filed	Issued
(13/794,584, filed 3/11/2013, issued as USP 9021602; the subject patent.)	(3/11/2013)	(4/28/2015)
13/556,420, filed 7/24/2012, issued as USP 8930719.	7/24/2012	1/6/2015
11/895,388, filed 8/24/2007, issued as USP 9104842.	8/24/2007	8/11/2015
10/602,777 filed on 6/25/2003, issued as USP 7664263.	6/25/2003	2/16/2010
09/046,627, filed 3/24/1998, issued as USP 6598162.	3/24/1998	7/22/2003

The cover pages of USP 8930719; USP 9104842; USP 7664263; and USP 6598162 are attachments 19-22 respectively and show the filing and issue dates and the named inventors of each of the four benefit applications/patents.

The requirements for a patent claim to be entitled to the benefit of a chain of prior applications are: continuity of pendency; continuity of inventorship; and continuity of disclosure.

Attachments 19-22 and the chart above and show that each application in the benefit chain of USP 9021602 was copending with the former. This shows continuity of copendency.

Attachments 19-22 show that each of these patents identified in the chain shows Scott Moskowitz named as an inventor. This shows continuity of inventorship.

Regarding continuity of disclosure, the relevant disclosure is that disclosure which provides written descriptive support for the claims. See for example _Enocean Gmbh, v. Face International Corporation_ (Fed. Cir. 1/31/2014):

> "To obtain the benefit of the filing date of a parent application, the claims of the later-filed application must be supported by the written description in the parent 'in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.'" Anascape, Ltd. v. Nintendo of Am. Inc., 601 F.3d 1333, 1335 (Fed. Cir. 2010) (citing Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997)). We review de novo the Board's legal conclusions regarding priority. Eaton v. Evans, 204 F.3d 1094, 1097 (Fed. Cir. 2000). [Enocean Gmbh, v. Face International Corporation (Fed. Cir. January 31, 2014).]

The claim support charts in attachment 17 show that claims 1, 2, 3, 4, 5, 8, 10, and 12 of USP 9021602 are each supported by the disclosures in benefit applications: 13/556,420 attachment 16 (issued as USP 8930719); 11/895,388 attachment 15 (issued as USP 9104842); 10/602,777 attachment 14 (issued as USP 7664263); and 09/046,627 attachment 13 (issued as USP 6598162).

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Attachment 17 is incorporated herein by reference and forms part of this response. Attachment 17 shows, among other things, continuity of disclosure of support for the rejected claims back to the 3/24/1998 filing date of 09/046,627. (And in fact showing the same support in these application as in the earlier application 08/587,793. Attachment 17 is signed by counsel, to avoid doubt that it complies with the signature requirements for submissions to the USPTO.

Therefore, the rejected claims are entitled to 120 benefit to 3/24/1998, which is less than one year after the 7/24/1997 102(a) date of Cooperman, and less than one year after the 12/22/1997 102(e) date of Hicks. Accordingly, these references do not bar patentability. Therefore, Mr. Moskowitz's 131 declaration is effective to remove these references form prior art.

Issue 8

The NFOA states "Claims 1, 2, 3, 4, 5, 8, 10, and 12 are rejected as anticipated by USPN 5,745,569 (herein Moskowitz et al.) under 35 USC 102(g)."

In response, the patentee notes that 102(g) is inapplicable to patents having the same inventive entity. After this office action issued, the USPTO corrected the inventorship of the subject patent USP 9021602 so that both USP 9021602 and USP 5745569 define the same inventive entity. See attachment 10 (Decision correcting inventorship). Accordingly, the 102(g) rejection is no longer applicable.

/RichardNeifeld/
Richard Neifeld, Reg. No. 35,299
Attorney for patent owner

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,137	05/11/2018	9021602	90014137	6880

31518   7590   12/12/2018
NEIFELD IP LAW, PC
5400 Shawnee Road
Suite 310
ALEXANDRIA, VA 22312-2300

EXAMINER
WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/12/2018	PAPER

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

The time period for reply, if any, is set in the attached communication.

PTOL-90A Attachment 10 Page 1 of 4

UNITED STATES PATENT AND TRADEMARK OFFICE

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISCH SIGLER LLP
5301 WISCONSIN AVENUE, NW
FOURTH FLOOR
WASHINGTON, DC 20015

Date: December 12, 2018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014137
PATENT NO. : 9021602
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)).

NEIFELD IP LAW, PC	:
5400 Shawnee Road	:
Suite 310	: Patent Owner
Alexandria, VA 22312	:

FISCH SIGLER LLP	:
5301 WISCONSIN AVENUE, NW	:
FOURTH FLOOR	: Third Party Requester
WASHINGTON, DC 20015	:

	:
In re Application of: Scott Moskowitz	: DECISION ON PETITION
Appl. No. 90/014,137	FOR CORRECTION
Patent No. 9,021,602	OF PATENT UNDER
Filed: March 11, 2013	: 37 C.F.R. § 1.324(b)
For: DATA PROTECTION METHOD	:
AND DEVICE	:

This is a decision on a <u>renewed</u> petition under 37 C.F.R. § 1.324 filed December 4, 2018 to correct the inventorship of U.S. Patent No. 9,021,602 to add Marc Cooperman as inventor.

The petition is **<u>Granted.</u>**

37 C.F.R. §1.530(l)(1) provides:

When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Director may, on petition of all the parties set forth in §1.324(b)(1)-(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.997 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

A petition to correct inventorship as provided by 37 C.F.R. § 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b).

Attachment 10 Page 3 of 4

This petition complies with all requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(l)(1).

37 C.F.R. § 1.324(b)(1) requires a statement from each person who is being added as an inventor.

Regarding this requirement, patent owner submitted a signed statement from Marc Cooperman that he has no disagreement with the change of adding his name as an inventor of the '602 patent.

37 C.F.R. § 1.324(b)(2) requires a statement from the current named inventors either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change.

Patent Owner has submitted statements under 37 C.F.R. § 1.324(b)(2) by Scott Moskowitz that provide an affirmative statement he agrees with the change to the inventorship.

37 C.F.R. § 1.324(b)(3) requires a statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 37 C.F.R. § 3.73(b).

Patent Owner has submitted a statement signed by Scott Moskowitz, who is duly authorized to act on behalf of the assignee Wistaria Trading Ltd. In this statement, the assignee affirmatively agreed to the change of inventorship.

37 C.F.R. § 1.324(b)(3) requires the fee set forth in 37 C.F.R. § 1.20(b).

Patent Owner has submitted the proper fee as set forth in 37 C.F.R. § 1.20(b).

Conclusion

Patent Owner has complied with all formal and procedural requirements of 37 C.F.R. § 1.324 and 37 C.F.R. § 1.530(l)(1).

Accordingly, Patent Owner's petition for a Correction of Inventorship of US 7,897,372 is **Granted.**

/Stephen Stein/
Quality Assurance Specialist
Central Reexamination Unit
(571) 272-3744

Attachment 10 Page 4 of 4

37 CFR 1.131 Declaration of Scott Moskowitz, Attachment 11

I.   Introduction

1.   I am a named inventor of the following United States patents, as indicated by a search of the USPTO issued patents database using search query "(IN/scott AND IN/moskowitz)."

PAT. NO.   Title

1 10,110,379 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

2 9,934,408 Full-Text Secure personal content server

3 9,893,888 Full-Text Utilizing data reduction in steganographic and cryptographic systems

4 9,843,445 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

5 9,830,600 Full-Text Systems, methods and devices for trusted transactions

6 9,710,669 Full-Text Secure personal content server

7 9,639,717 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth

8 9,270,859 Full-Text Utilizing data reduction in steganographic and cryptographic systems

9 9,258,116 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

10 9,231,980 Full-Text Secure personal content server

11 9,191,206 Full-Text Multiple transform utilization and application for secure digital watermarking

12 9,191,205 Full-Text Multiple transform utilization and application for secure digital watermarking

13 9,171,136 Full-Text Data protection method and device

14 9,104,842 Full-Text Data protection method and device

15 9,070,151 Full-Text Systems, methods and devices for trusted transactions

16 9,021,602 Full-Text Data protection method and device

17 8,930,719 Full-Text Data protection method and device

18 8,798,268 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

19 8,789,201 Full-Text Secure personal content server

20 8,781,121 Full-Text Utilizing data reduction in steganographic and cryptographic systems

21 8,774,216 Full-Text Exchange mechanisms for digital information packages with bandwidth securitization, multichannel digital watermarks, and key management

22 8,767,962 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

23 8,739,295 Full-Text Secure personal content server

24 8,712,728 Full-Text Method and device for monitoring and analyzing signals

Attachment 11 Page 1 of 16

25 8,706,570 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
26 8,612,765 Full-Text Security based on subliminal and supraliminal channels for data objects
27 8,549,305 Full-Text Steganographic method and device
28 8,542,831 Full-Text Multiple transform utilization and application for secure digital watermarking
29 8,538,011 Full-Text Systems, methods and devices for trusted transactions
30 8,526,611 Full-Text Utilizing data reduction in steganographic and cryptographic systems
31 8,473,746 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
32 RE44,307 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
33 8,467,525 Full-Text Steganographic method and device
34 RE44,222 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
35 8,307,213 Full-Text Method and system for digital watermarking
36 8,281,140 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data
37 8,271,795 Full-Text Security based on subliminal and supraliminal channels for data objects
38 8,265,278 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects
39 8,265,276 Full-Text Method for combining transfer functions and predetermined key creation
40 8,238,553 Full-Text Steganographic method and device
41 8,225,099 Full-Text Linear predictive coding implementation of digital watermarks
42 8,224,705 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
43 8,214,175 Full-Text Method and device for monitoring and analyzing signals
44 8,175,330 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
45 8,171,561 Full-Text Secure personal content server
46 8,161,286 Full-Text Method and system for digital watermarking
47 8,160,249 Full-Text Utilizing data reduction in steganographic and cryptographic system
48 8,121,343 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
49 8,104,079 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
50 8,046,841 Full-Text Steganographic method and device
51 7,991,188 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data
52 7,987,371 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data
53 7,953,981 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data
54 7,949,494 Full-Text Method and device for monitoring and analyzing signals

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55 7,930,545 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data

56 7,913,087 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data

57 7,877,609 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data

58 7,870,393 Full-Text Steganographic method and device

59 7,844,074 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data

60 7,830,915 Full-Text Methods and systems for managing and exchanging digital information packages with bandwidth securitization instruments

61 7,822,197 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data

62 7,813,506 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects

63 7,779,261 Full-Text Method and system for digital watermarking

64 7,770,017 Full-Text Method and system for digital watermarking

65 7,761,712 Full-Text Steganographic method and device

66 7,738,659 Full-Text Multiple transform utilization and application for secure digital watermarking

67 7,730,317 Full-Text Linear predictive coding implementation of digital watermarks

68 7,664,958 Full-Text Optimization methods for the insertion, protection and detection of digital watermarks in digital data

69 7,664,264 Full-Text Utilizing data reduction in steganographic and cryptographic systems

70 7,664,263 Full-Text Method for combining transfer functions with predetermined key creation 71 7,660,700 Full-Text Method and device for monitoring and analyzing signals

72 7,647,503 Full-Text Optimization methods for the insertion, projection, and detection of digital watermarks in digital data

73 7,647,502 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data

74 7,568,100 Full-Text Steganographic method and device

75 7,532,725 Full-Text Systems and methods for permitting open access to data objects and for securing data within the data objects

76 7,530,102 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth

77 7,508,309 Full-Text System for wireless mobile seating platform

78 7,477,153 Full-Text System for wireless mobile seating platform

79 7,475,246 Full-Text Secure personal content server

80 7,457,962 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data

81 7,409,073 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data

82 7,362,775 Full-Text Exchange mechanisms for digital information packages with bandwidth securitization, multichannel digital watermarks, and key management

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83 7,346,472 Full-Text Method and device for monitoring and analyzing signals
84 7,343,492 Full-Text Method and system for digital watermarking
85 7,327,268 Full-Text System for wireless mobile seating platform
86 7,287,275 Full-Text Methods, systems and devices for packet watermarking and efficient provisioning of bandwidth
87 7,177,429 Full-Text System and methods for permitting open access to data objects and for securing data within the data objects
88 7,159,116 Full-Text Systems, methods and devices for trusted transactions
89 7,152,162 Full-Text Z-transform implementation of digital watermarks
90 7,127,615 Full-Text Security based on subliminal and supraliminal channels for data objects
91 7,123,718 Full-Text Utilizing data reduction in stegnographic and cryptographic systems
92 7,107,451 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digital data
93 7,095,874 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
94 7,035,409 Full-Text Multiple transform utilization and applications for secure digital watermarking
95 7,007,166 Full-Text Method and system for digital watermarking
96 6,870,477 Full-Text Method and apparatus for wireless mobile seating platform
97 6,853,726 Full-Text Z-transform implementation of digital watermarks
98 6,598,162 Full-Text Method for combining transfer functions with predetermined key creation 99 (NOT A SCOTT MOSKOWITZ PATENT)
100 6,522,767 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
101 (NOT A SCOTT MOSKOWITZ PATENT)
102 6,205,249 Full-Text Multiple transform utilization and applications for secure digital watermarking
103 6,078,664 Full-Text Z-transform implementation of digital watermarks
104 5,905,800 Full-Text Method and system for digital watermarking
105 5,889,868 Full-Text Optimization methods for the insertion, protection, and detection of digital watermarks in digitized data
106 5,822,432 Full-Text Method for human-assisted random key generation and application for digital watermark system
107 5,745,569 Full-Text Method for stega-cipher protection of computer code
108 5,687,236 Full-Text Steganographic method and device
109 5,613,004 Full-Text Steganographic method and device
110 5,539,735 Full-Text Digital information commodities exchange
111 5,428,606 Full-Text Digital information commodities exchange

2.　　Herein below I refer to attachments. I have reviewed each of the attachment I mention below, in preparation for signing this declaration.

II.　Inventive Activity, Including Conception, up until the Time of Filing Application Number 08/587,943 1/17/1996

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3.   I began working on inventions in fields of digital technology in the early 1990s. In the early 1990s, I was looking for software programmers to code some of my inventions. I was living in Japan at this time.

4.   One of my college buddies suggested I speak with Marc Cooperman because he believed that Marc had some coding ability. Marc was residing in the United States. So Marc and I had to generally correspond long distance instead of face to face.

5.   I initially entered into a non-disclosure agreement with Marc, as shown in Attachment 23. This was in 1993. Later, I entered into a financial agreement with Marc involving co-ownership of the Dice Company for commercializing my inventions. Marc was involving in implementation in code and consequently was named as an inventor on some applications. However, Marc and I had insurmountable business differences. By the end of 1997, Marc and I were in dispute about finances and the direction and control of the Dice Company, as indicated by Attachment 24. Attachment 24 is the first page of a letter Marc sent me dated 11-18-1997. Eventually, we entered into lawsuits, a result of which generally speaking was dissolution of the Dice Company.

6.   During 1995, I correspondence with Marc by email. On 11/11/1995, I sent an email to Marc Cooperman containing some of my inventive ideas. On 11/15/1995, I received an email from Marc restating some of my ideas, and containing an excerpt of my 11/11/1995 email to Marc. A copy of this email is Attachment 25. This email refers to my "note of 11-11-95" relating to "ascii/software steganographic protection." In this email, Marc refers to my ideas, stating:

> Your idea seems to be
> 1) hide essential pieces of the app with an Argent-like scheme
> 2) make the "key/map" to access these resources randomized/individual on a per copy basis
> 3) maybe have the corrected key/map vary from run-to-run or iteration-to-iteration, as you seem to imply when talking about font metrics

7.   On 12/22/1995, I completed a draft of a patent application, a copy of which is Attachment 26. See the bottom of page 3, stating "12-22-95 Scott Moskowitz". The last page of Attachment 26 refers to adding complexity to a hackers job by having the code reorganized between each "break." See the first two lines. The first full paragraph on the last page refers to the "special code resource" which knows where the "memory scheduler is in memory." That is special code resource calls the schedule and randomly moves the scheduler. The second full paragraph provides the alternative of the scheduler being capable of moving itself in memory (copy and then modify the program counter and stack frame). As stated in the last paragraph on the last page, these structures make it hard to analyze and capture memory containing application executable code. The first two pages are to blurry to read, but I believe they were disclosure of the concepts relating to encoding essential resources into data resources shown in my 1/3/1996 draft disclosure, which is next discussed.

8.   On 1/3/1996, I completed a draft disclosure of the same patent application as on 12/22/1995. This 1/3/1996 application is Attachment 27. See "01-03-96 Scott Moskowitz" on the last page. This application notes the goal of providing security to executable code. See page 2. But not by stopping copying, but instead by ensuring the license information is preserved in

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copies of licensed software. And goes on to discuss what is stated in the 12/22/1995 draft, such as randomizing locations in memory of resources (page 2); hiding code resources in digitized sample resources (page 2); data resources (page 3); encoding essential resources into data resources (pages 4-5); and randomly reorganizing program memory structure during runtime (pages 5-6).

III. Reduction to Practice by Filing Application Number 08/587,943 1/17/1996

9.   On 1/17/1996, an application containing this disclosure was filed in the USPTO. The USPTO assigned application number 08/587,943 to this disclosure. Application number 08/587,943 issued as USP 5745569, on 4/28/1998, as shown by Attachment 2 (which is a copy of USP 5745569).

10.   I am told that Attachment 1 is a copy of the official file history of the USPTO, for 08/587,943, as filed. (I vaguely recall some third party providing this in one of the IPR's filed against one of my patents.) On my brief comparison, I note that disclosure in Attachment 1, other than the claims and abstract, are substantially identical to the disclosure of my 1/3/1996 draft disclosure, Attachment 27.

III.A I Understood by 1/16/1996, That the Claims Worked for Their Intended Purpose

11.   Not later than the 1/16/1996 filing date of 08/587,943, I recognized that the subject matter defined by claims 1, 2, 3, 4, 5, 8, 10, and 12 of USP 9021602 worked for their intended purpose.

12.   For example, USP 9021602 independent claim 1 claims the concept of requiring the "license code ... stored in said personalization data resource" in order for the application software to work. (That is, to access an encoded code resource necessary for the application software to provide the functionality the user expects.) This is clear from my enumeration of elements 2 and 3, at Attachment 1, page 11:29-33, that the application stores the personalization information including the "license code" and optionally "particular computer configuration" in a personalization data resource, and that the application must have the license code in order to "generate the proper decoding key to access the essential code resources."

13.   USP 9021602 claim 2 requires the encoded code resource be stored in a data resource. At attachment 1, page 10:16-17, I stated that "The end result will be that these essential code resources are not stored in their own partition, but rather stored as encoded information in data resources." This sentence is part of my discussion of how the application software is compiled. As I state in the next sentence in the application, these essential code resources "are not accessible at run-time without the key." This explains specifically how implementations of claims 1 and 2 function to protect the software, and it shows that I knew that the claimed inventions of claim 1 and claims depending thereon worked for their intended purpose.

14.   Claim 10 is also an independent claim. Claim 10 differs from claim 1 in that claim 10 claims a computer program product, but otherwise covers the same concepts of claim 1. Thus, for the same reasons applicable to claim 1, it is clear from the disclosure of my 08/587,943 application, as filed, that I knew that the claimed inventions of claim 10 and claims depending thereon worked for their intended purpose.

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III.B My 08/587,943 application issued into USP 5745469

15. Furthermore, my 08/587,943 application issued into USP 5745469. Claims 1-3 in this patent read:

> 1. A method for copy protection of computer software, the computer software including executable code and a non-executable digital sample, said method comprising the steps of:
>> identifying a portion of the executable code to be encoded;
>> generating an encoded code resource from the identified portion of the executable code; and
> embedding the encoded code resource in the non-executable digital sample.
>> 2. The method of claim 1, further comprising the step of requiring a predetermined key to decode the encoded code resource prior to execution of the executable code.
>> 3. The method of claim 2, further comprising deriving the predetermined key from licensing information associated with the computer software.

16. These claims of my USP 5745469 show that I pursued to issuance, claims to "embedding" a "code resource" in a "non-executable" digital sample, and requiring a key necessary to access those code resources, and in which the key had to be derived from licensing information. Those claim elements are very similar to the elements of the rejected claims of USP 9021602.

17. Unlike claims 1-3 of USP 5745469, rejected claim 1 of USP 9021602 contains the additional requirement that "computer configuration information" be stored in the "personalization data resource." However, in my 08/587,943 application, I clearly stated that "particular computer configuration" can be stored in the "personalization data resource." See page numbered 11, lines 25-33, of my 08/587,943, Attachment 1, which read:

> 1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. **This can include a particular computer configuration;**
> 2) **it stores this information in a personalization data resource;**
> 3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources.

18. Thus, my 08/587,943 application clearly shows I understood I that this one additional limitation, that one could store "computer configuration information" in the "personalization data resource," was an optional additional feature. This disclosure shows I understood that the subject matter defined by claim 1 of USP 9021602 worked, with this one additional limitation compared to claims issued in USP 5745469, worked for its intended purpose.

III.C Filing Application Number 08/587,943 1/17/1996 My 08/587,943 Was a Constructive Reduction to Practice of the Rejected Claims

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19. I understand that filing an application in the USPTO that discloses a patentable invention and that ultimately issues as a patent is called a constructive reduction to practice. My 08/587,943 application issued into my USP 5745469. My 08/587,943 application discloses the subject matter of rejected claims 1, 2, 3, 4, 5, 8, 10, and 12 of USP 9021602, as I show in the following claim chart. This chart cites the page numbers of the original text of my 08/587,943 application, in Attachment 1, provides the claim recitations in the left column and my explanation and quoted from Attachment 1 in the right column.

Rejected Claim of USP 9021602	Support in my 08/587,943 application, Attachment 1
1. A computer based method for accessing functionality provided by an application software comprising:	Page 18:6-8 "The key is necessary to access the underlying code, i.e., what the user understands to be the application program." This statement follows my explanation at page 17:7 to 18:6 regarding how the software is compiled to encode certain code resources deemed "essential" for the functionality of the software in data resources. Page 11:24 to page 12:2 then explains how a user used the software including the functionality. That is how to perform the method of the preamble of this claim 1.
storing said application software in non transient memory of a computer;	On page 8:37 I refer to the program being "loaded" which means copied from slow memory (like disc) to fast memory (like RAM). Both of those forms (slow and fast) memory are "non transient." I understand that "non transient" were words the USPTO recommended everyone use in reference to memory when some court decision stated that memory might read on a "signal" and might be considered not patentable subject matter. I am told that the USPTO therefore took a "liberal" view of support for "non transient", basically allowing anyone claiming something stored in memory in a patent application that was not disclosing signals as memory, to add "non transient" to avoid adverse court invalidity determinations.

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said application software in said computer prompting a user to enter into said computer personalization information;	On page 1:25-28, I point out that it was well known for computer software to prompt a use for information at startup. At page 11:25-28, I disclose that my software prompts the user to enter personalization information when run for the first time. Page 1:25-28 states "The application can then operate as follows: 1) when it is run for the first time, after installation, it asks the user for personalization information, which includes the license code. This can include a particular computer configuration:."
said application software storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer, and a license code	On page 1:25-28, I continue on the next two lines (29, 30), to state "2) *it* stores *this* information in a personalization data resource;" The "it" is the software. The "this information" refers to the personalization information which lines 27 and 28 state may include both license code and computer configuration.
entered in response to said prompting;	That statement that item "2)" follows immediately after item "1)" in the sentence explaining operation of the software indicates that the storing of this information is in response to the entering of the information by the user.
said application software in said computer generating a proper decoding key.	At page 11, lines 31-33, I state "3) Once it has the license code, it can then generate the proper decoding key to access the essential code resources." This shows generating the proper decoding key.

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said generating comprising using said license code; and	In the very next paragraph, at page 11:34-37, I state "Note that the application can be copied in an uninhibited manner, but must contain the license code issued to the licensed owner, to access its essential code resources." This indicates that the license code is essential to access the code resource, and accessing requires the decoding key, which indicates that the license code is also essential to generating the decoding key. However, I explained the significance of the key and that generating the key requires the license code, back in page 10, when describing how the software is assembled. "This method, then, is to choose the key so that it corresponds, is equal to, or is a function of, a license code or license descriptive information." In other words, I disclosed that generating the decode key may requires the licence code.
wherein said application software, in said computer, cannot access at least one encoded code resource of said application software, unless said license code is stored in said personalization data resource.	At page 10:16-20, I states that "The end result [of compiling the software is that]...these essential code resources... are not accessible at run-time, without the key." This the same thing as stated by this wherein clause in claim 1.
2. The method of claim 1, wherein said encoded code resource is encoded in at least one data resource.	In describing the assembly utility, at page 11:9-15, I state that the assembly utility "encodes one or several essential resources into one or several data resources." At page 10:14-16, I also state that "The utility will chose one or several essential code resources, and encode them into one or several data resources." This discloses that "code resource" are "encoded" and that they are encoded in at least one data resource, as claimed.

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DISH-Blue Spike-602
Exhibit 1005, Page 0296

3. The method of claim 1 wherein said encoded code resource is steganographically encoded.	At page 5:9-10, I explain that "steganography" refers to "hiding something in plain view." At page 8:25-27, I disclose that the first method of my invention "involves hiding necessary 'parts' or code 'resources' in digitized sample resources. At page 3:10-13, I explain that "It is desirable to use a 'stega-cipher' ... process to hide necessary parts of resource of executable object code in the digitized sample resource." At page 10:15-16, I discloses that the encoding may be "using the stegacipher process." I think these support use of the adverb "steganographically" when referring to encoding that uses steganography for hiding the code resources in data resources.
4. The method of claim 3 wherein said encoded code resource is encoded in a data resource.	Claim 4 is the same as claim 2, but depends upon claim 3 instead of claim 1. So my discussion of claim 2 applies here.
5. The method of claim 1 wherein said computer configuration information is stored in a data resource.	In my description of the operation of the software application at page 11:27-30, I stated "This can include a particular computer configuration; 2) it stores *this information* in a personalization *data resource*." That is, I clearly stated that the computer configuration information may be stored in a data resource.

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8. The method of claim 1 wherein said computer comprises a processor and said application software using said processor in said prompting and said storing.	My disclosure in Attachment 1 is replete with references to computers in the context of digital computer which necessarily convey the presence of a processor. For example, in discussing the structure of software, I refer to "the instructions" (page 7:21) which immediately conveys a processor for acting on instruction. Similarly, I refer to "executable code" (page 7:32) which immediately conveys a processor for acting on the code. At page 11, in describing a software application including essential code resources encoded in data resource, I state "The application can then operate as follows: 1) when it is run for the first time...." Runing is a colloquial express for a digital computer executing instructions in a software program. Digital computers necessarily include a processor. Similarly, at pages 12-13, I describe a preferred embodiment as implemented in an embedded system with a minimal operating system. Further, at page 14:25-27, I stated that "the present invention concerns itself with any application software that may be used in general computing devices." The term "general computer devices" immediately conveys a processor for use by application software for both prompting (an I/O function) and storing (a data storage function). Finally, the original claims defined the step of "processing" of data, which discloses a processor. See page 17:4 (claim 4).

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10. A computer program product storing in a non transitory storage media computer application software code for an application software product, which, when run by a computer system, causes said computer system to perform the following for accessing functionality provided by said application software product, comprising:	This is a description of software stored on some physical medium. In the Background section in Attachment 1, I describe that software may be stored on a user's hard drive, when referring to attempts to enforce licencing. That is, at page 2, I state "Further methods include network-based searches of a user's hard drive and comparisons between what is registered to that user and what is actually installed on the user's general computing device." At page 10:36, I refer to "install[ed] ... copies," which refers to installation on a drive. A computer's drive is a product. At page 3:32-33, I refer to storing code in computer memory, stating "It is also desirable to randomly reorganize program memory structure intermittently during program run time." At page 7:2-5, I refer to "the order of the machine instructions. .. In the computer memory." Computer memory is a product.
storing said application software code in non transient memory of a computer system; said application software code in said computer system prompting a user to enter into said computer system personalization information; said application software code storing, in said non transient memory, in a personalization data resource, both computer configuration information of said computer system, and a license code entered in response to said prompting; said application software code in said computer system generating a proper decoding key, said generating comprising using said license code; and wherein said application software code, in said computer system, cannot access at least one encoded code resource of said application software code, unless said license code is stored in said personalization data resource.	This is the same recitation appearing in claim 1. See my discussion of claim 1 herein above.

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12. The product of claim 10 wherein said computer program product causes storing of said encoded code resource in a data resource in non transient memory of said computer.	Claim 12 contains the same recitation ("storing of said encoded code resource in a data resource ") as claim 2. Attachment 1 shows 1 disclosed this feature for the reasons stated for claim 1.

20.   Thus, my application 08/587,943 discloses all of the limitations in the rejected claims.

III.D   The Disclosure of Application Number 08/587,943 1/17/1996 Relied Upon Above for Support for the Rejected Claims Was Identically Carried into My USP 9021602

21.   I have reviewed USP 9021602 and compared its disclosure to the disclosure of 08/587,943. I find that the disclosure of 08/587,943 is entirely included in USP 9021602. The following chart identifies, paragraph by paragraph, the page and line numbers in Attachment 1 (08/587,94), referring to the original page numbers, in the left column, and the column and line numbers of corresponding paragraphs with essentially identical words, in USP 9021602. My review shows that the entirety of the original disclosure of my 08/587,943 application, other than its original claims, is contained in the disclosure of USP 9021602. As a consequence, my showing of support for the rejected claim, in Attachment 1 (08/587,94), means exactly the same support is also present in USP 9021602.

Page and line numbers of paragraph in Attachment 1 (08/587,94)	Column and line numbers of essentially identical text in USP 9021602
1:4-10	1:27-33
1:11-24	1:34-45
1:25 to 2:18	1:46-65
2:19-34	1:66 to 2:13
2:34-37 (incorporating by reference 08/489,172)	2:58-63 (incorporating by reference 08/489,172)
3:1-5	2:13-17
3:6-9	2:18-20
3:10-31	2:21-40
3:32-37	2:41-46
4:1-6	2:47-52
4:7-17	2:53-63

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