

Exhibit 5

Approved for through 10/31/2002. OMB 0651-0031
 U.S. Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE
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 Attorney Docket No. 39636-176166

| | | |
|---|------------------------|-----------------|
| <p align="center">REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL</p> <p>Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995. See The American Inventors Protection Act of 1999 (AIPA).</p> | Application Number | 09/164,777 |
| | Filing Date | October 1, 1998 |
| | Examiner Name | C. Hewitt, II |
| | First Named Inventor | M. Muller |
| | Group Art Unit | 2161 |
| | Attorney Docket Number | 39636-176166 |

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.
NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14885 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. § 1.114**

a. Previously submitted

i. Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on (Any unentered amendment(s) referred to above will be entered).

ii. Consider the arguments in the Appeal Brief or Reply Brief previously filed on

iii. Other

b. Enclosed

i. Amendment/Reply

ii. Affidavit(s)/Declaration(s)

iii. Information Disclosure Statement (IDS)

iv. Other

2. **Miscellaneous**

a. Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(f) required)

b. Other

3. **Fees** The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

a. The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 22-0261

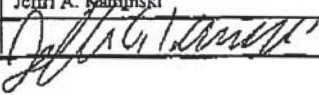
i. RCE fee required under 37 C.F.R. § 1.17(e)

ii. Extension of time fee (37 C.F.R. §§ 1.138 and 1.17)

iii. Other

b. Check in the amount of \$ 570.00 enclosed

c. Payment by credit card (Form PTO-2038 enclosed)

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED | | | |
|---|---|-----------------------------------|-------------------|
| Name (Print /Type) | Jeffri A. Kaminski | Registration No. (Attorney/Agent) | 42,709 |
| Signature |  | Date | November 14, 2001 |

VENABLE
 P.O. Box 34385
 Washington, DC 20043-9988

SEND Fees and Completed Forms to the following address: Commissioner for Patents, Box RCE, Washington, DC 20231.
 PC Docs No. 331636



101203

11/14/01

Venable Filing Number

Filing Date

Atty. Docket No.

39838-176168

Re:

METHOD OF RESTRICTING SOFTWARE OPERATION WITHIN A LICENSED LIMITATION

Application No.:

09/164,777

Filing Date:

October 1, 1998

Patent No.:

Issue Date

Trademark:

Trademark Reg. No.:

Opposition/Cancellation No.:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

| | | | |
|-----------|--|---------------------|-------------------------------|
| <u>XX</u> | RCE Transmittal Sheet | <u>\$370.00</u> | Filing Fee |
| | Issue Fee Part | | Surcharge Fee |
| | Invention Declaration | | Additional Claim Fee |
| | National Stage Application | | Recordation of Assignment Fee |
| | Translation of International Application | | IDS Fee |
| | New U.S. TM Application (___ specimens) | | |
| | Rule 53(d) Continuation or Division Application | | |
| | Rule 53(b) Continuation or Division Application (in Duplicate) (attach copy of specifications, claims, drawings & declaration) | | |
| | Priority Document-Cert. Copy of ___ Appln. # ___ Date ___ | | |
| | Assignment w/Cover Sheet | <u>\$200.00</u> | Extension Fee |
| <u>XX</u> | IDS w/ PTO-1449 (with references) | | Notice of Appeal Fee |
| <u>XX</u> | Amendment (with marked up version) | | Brief on Appeal Fee |
| | Submission of Substitute Specification | | Oral Hearing Request Fee |
| <u>XX</u> | Petition/Request for Extension of Time | | Petition Fee |
| | Notice of Appeal | | Issue Fee (Additional) |
| | Appeal Brief (in triplicate) | | Maintenance Fee |
| | Request for Oral Hearing | | TM Statement of Use |
| | Confirmation of Hearing Petition | | 8 Affidavit Fee |
| | Letter Under 37 CFR 1.28 (c) | | TM Renewal Application Fee |
| | Certificate of Correction | | Notice of Opposition Fee |
| | Maintenance Fee Transmittal | | Terminal Disclaimer |
| | TM Statement of Use | | |
| | Declaration Under 8 | | |
| | Declaration Under 8 and 15 | | |
| | TM renewal Application | | |
| | Notice of Opposition | | |
| | Supplemental Search Report and Annex | | |
| | Postcard | | |
| | Change of Address | | |
| | | Fee: | \$570.00 |
| | | Check Number | _____ |

Official


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12/06/01



#331763

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

| | | | | |
|----------------|---|---|---|---|
| Applicants | : | Miki MULLOR et al. |) | Customer No. |
| | | |) | |
| Appln. No. | : | 09/164,777 |) |  |
| | | |) | 26694 |
| Filed | : | October 1, 1998 |) | PATENT TRADEMARK OFFICE |
| | | |) | |
| For | : | METHOD OF RESTRICTING SOFTWARE OPERATION WITHIN A LICENSED LIMITATION |) | |
| | | |) | |
| Group Art Unit | : | 2161 |) | |
| Examiner | : | J. Trammell |) | |
| | | |) | |
| Atty. Dkt. | : | 39636-176166 |) | |

Assistant Commissioner for Patents
Washington, D.C. 22031

AMENDMENT

Sir:

REQUEST FOR EXTENSION OF TIME

Please extend the period for responding to the Office Action dated June 22, 2001 by two months so that the due date expires November 22, 2001. The requisite extension fee of \$200.00 under 37 C.F.R. 1.17 (a) (1) is attached. Should no check be attached, please charge our Deposit Account 22-0261. Please also deduct any additional fees due or credit any overage to the same account.

Responsive to the Office Action dated June 22, 2001, please amend the application as follows:

Amendment

U.S. Application No.: 09/164,777

IN THE CLAIMS:

Please amended the claims as follows:

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

selecting a program residing in the volatile memory,

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

verifying the program using at least the verification structure from the erasable non-volatile memory of the BIOS, and

acting on the program according to the verification.

3. (Amended) A method according to claim 2, wherein setting up a verification structure further comprising the steps of: establishing, between the computer and the bureau, a two-way data-communications linkage; transferring, from the computer to the bureau, a request-for-license including an identification of the computer and the license-record's contents from the selected program; forming an encrypted license-record at the bureau by encrypting parts of the request-for-license using part of the identification as an encryption key; transferring, from the bureau to the computer, the encrypted license-record; and storing the encrypted license record in the erasable non-volatile memory area of the BIOS.

4. (Amended) A method according to claim 2, wherein verifying the program further comprises the steps of: establishing, between the computer and the bureau, a two-way data-communications linkage; transferring, from the computer to the bureau, a request-for-

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license verification including an identification of the computer, an encrypted license-record for the selected program from the erasable, non-volatile memory area of the BIOS, and the program's license-record; enabling the comparing at the bureau; and transferring, from the bureau to the computer, the result of the comparing.

5. (Amended) A method according to claim 3 wherein the identification of the computer includes the unique key.

6. (Amended) A method according to claim 1 wherein selecting a program includes the steps of: establishing a licensed-software-program in the volatile memory of the computer wherein said licensed-software-program includes contents used to form the license-record.

7. (Amended) A method according to claim 6 wherein using an agent to set up the verification structure includes the steps of: establishing or certifying the existence of a pseudo-unique key in a first non-volatile memory area of the computer; and establishing at least one license-record location in the first nonvolatile memory area or in the erasable, non-volatile memory area of the BIOS.

9. (Amended) A method according to claim 7 wherein verifying the program includes the steps of: encrypting the licensed-software-program's license-record contents from the volatile memory area or decrypting the license-record in the erasable, non-volatile memory area of the BIOS, using the pseudo-unique key; and comparing the encrypted licenses-software-program's license-record contents with the encrypted license-record in the erasable, non-volatile

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memory area of the BIOS, or comparing the license-software-program's license-record contents with the decrypted license-record in erasable non-volatile memory area of the BIOS.

10. (Amended) A method according to claim 9 wherein acting on the program includes the step: restricting the program's operation with predetermined limitations if the comparing yields non-unity or insufficiency.

11. (Amended) A method according to claim 22 wherein the first non-volatile memory area is a ROM section of a BIOS.

12. (Amended) A method according to claim 1 wherein the erasable, non-volatile memory area is a E²PROM section of the BIOS.

16. (Amended) The method of Claim 22, wherein the unique key includes a pseudo-unique key.

17. (Amended) The method according Claim 22, wherein the step of using the agent to set up the verification record, including the license record, includes encrypting a license record data in the program using at least the unique key.

18. (Amended) The method according to Claim 22, wherein the step of verifying the program includes a decrypting the license record data accommodated in the erasable second non-volatile memory area of the BIOS using at least the unique key.

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19. (Amended) The method according to Claim 22, wherein the step of verifying the program includes encrypting the license record that is accommodated in the program using at least the unique key.

20. (Amended) A method for accessing a software program using a pseudo-unique key stored in a first non-erasable non-volatile memory area of a computer, the first non-volatile memory area being unable to be programmatically changed, the method, comprising:

loading a software program residing in a volatile memory area of the computer;

extracting license information from the software program;

encrypting license information using the pseudo-unique key stored in the first non-volatile memory area;

storing the encrypting license information in a second erasable, writable, non volatile memory area of the BIOS of the computer;

subsequently verifying the software program based on the encrypted license information stored in the second erasable, writable, non-volatile memory area of the BIOS; and

acting on the software program based on the verification.

Please add the following new claims:

21. (New) The method of claim 20, wherein the verification comprises:

extracting the license information from the software program;

encrypting the license information using the pseudo-unique key stored in the first non-volatile memory area of the computer to form second encrypted license information; and

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comparing the encrypted license information stored in the second erasable, writable, non-volatile memory area of the BIOS of the computer with the second encrypted license information.

22. (New) The method of claim 1, wherein a unique key is stored in a first non-volatile memory area of the computer.

23. (New) The method according to claim 17, wherein the verification comprises:
extracting the license record from the software program;
encrypting the license record using the unique key stored in the first non-volatile memory area of the computer to form second encrypted license information; and
comparing the encrypted license information stored in the erasable, non-volatile memory area of the BIOS of the computer with the second encrypted license information.

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REMARKS

Claims 1-13 and 16-23 are now pending in this application. New claims 21-23 have been added by this amendment. Each of the pending claims is believed to define an invention which is novel and unobvious over the cited references. Favorable reconsideration of this case is respectfully requested.

Applicant's representative appreciates the Examiner's courtesy in conducting a personnel interview in this case. The claims have been amended as agreed upon during the interview and it is respectfully submitted that this application is now in condition for allowance.

Specifically, claim 1 has been amended to recite that the verification structure is stored in an erasable, non-volatile memory area of the BIOS. This claim amendment overcomes the rejections under 35 U.S.C. 112, first paragraph in sections 3, 4 and 5 of the Final Office Action, as well as the rejection under 35 U.S.C. 112, second paragraph in section 7 of the Final Office Action.

Claim 20 has been amended to correct the informality noted by the Examiner. In view of these amendments, it is respectfully submitted that all pending claims are now in all aspects in compliance with 35 U.S.C. 112, first paragraph and 35 U.S.C. 112, second paragraph. Therefore, the withdrawal of these rejections is respectfully requested.

Claims 1-4, 6 and 10-13 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,892,900 to Ginter et al.

Claims 5 and 7-9, and 16-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. in view of U.S. Patent No. 5,684,951 to Goldman et al.

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Consequently, it is clear that the cited references do not anticipate or render the present claims obvious. Therefore, the withdrawal of this rejection is respectfully requested.

As requested by the Examiner during the interview, a description of a specific embodiment of the invention is attached hereto.

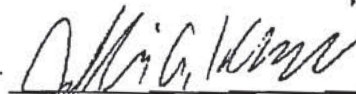
Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

In view of the foregoing, reconsideration and allowance of this application are believed in order, and such action is earnestly solicited.

The Commissioner is authorized to charge any fee necessitated by this Amendment to our Deposit Account No. 22-0261.

Respectfully submitted,

VENABLE, Attorneys at Law



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#331676

Appln. No.: 09/164,777

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amended the claims as follows:

1. (Twice Amended) A method of restricting software operation within a license for use with a computer including an first, non-erasable, non-volatile memory area, a second, non-erasable, non-volatile memory area of a (BIOS) of the computer, and a volatile memory area; the first non-volatile memory accomodates data that includes unique key; the method comprising the steps of:

selecting a program residing in the volatile memory,

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

verifying the program using at least said-the verification structure from the erasable non-volatile memory of the BIOS, and

acting on the program according to the verification.

3. (Amended) A method according to claim 2, wherein setting up a verification structure further comprising the steps of: establishing, between the computer and the bureau, a two-way data-communications linkage; transferring, from the computer to the bureau, a request-for-license including an identification of the computer and the license-record's contents from the selected program; forming an encrypted license-record at the bureau by encrypting parts of the request-for-license using part of the identification as the-an encryption key; and-transferring, from the bureau to the computer, the encrypted license-record; and storing the encrypted license record in the erasable non-volatile memory area of the BIOS.

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4. (Amended) A method according to claim 2, wherein verifying the program further comprising the steps of: establishing, between the computer and the bureau, a two-way data-communications linkage; transferring, from the computer to the bureau, a request-for-license verification including an identification of the computer, ~~the~~ an encrypted license-record for the selected program from the ~~second-erasable, non-volatile memory area of the BIOS,~~ and the ~~license-software-program's license-record-contents;~~ enabling the comparing at the bureau; and transferring, from the bureau to the computer, the result of the comparing.

5. (Amended) A method according to claim 3 wherein the identification of the computer includes the ~~pseudo-unique~~ key.

6. (Amended) A method according to claim 1 wherein selecting a program includes the steps of: establishing a licensed-software-program in the volatile memory of the computer wherein said licensed-software-program includes contents used to form ~~a~~ the license-record.

7. (Amended) A method according to claim ~~1-6~~ wherein using an agent to setting up the verification structure includes the steps of: establishing or certifying the existence of a pseudo-unique key in ~~the~~ a first non-volatile memory area of the computer; and establishing at least one license-record location in the first ~~or the second-nonvolatile memory area~~ or in the erasable, non-volatile memory area of the BIOS.

9. (Amended) A method according to claim ~~7-1~~ wherein verifying the program

Appln. No.: 09/164,777

includes the steps of: encrypting the licensed-software-program's license-record contents from the volatile memory area or decrypting the license-record in the ~~first or the second erasable, non-volatile memory area of the BIOS~~, using the pseudo-unique key; and comparing the encrypted licenses-software-program's license-record contents with the encrypted license-record in the ~~first or the second erasable, non-volatile memory area of the BIOS~~, or comparing the license-software-program's license-record contents with the decrypted license-record in the ~~first or the second erasable non-volatile memory area of the BIOS~~.

10. (Amended) A method according to claim ~~9~~ wherein acting on the program includes the step: restricting the program's operation with predetermined limitations if the comparing yields non-unity or insufficiency.

11. (Amended) A method according to claim ~~22~~ wherein the first non-volatile memory area is a ROM section of a BIOS.

12. (Amended) A method according to claim 1 wherein the ~~second erasable, non-volatile memory area~~ is a E²PROM section of a ~~the~~ BIOS.

16. (Amended) The method of Claim ~~22~~, wherein the unique key includes a pseudo-unique key.

17. (Amended) The method according Claim ~~22~~, wherein ~~said the~~ step of using the agent to setting up a the verification record, including the license record, includes encrypting a license record data in ~~said the~~ program using at least ~~said the~~ unique key.

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18. (Amended) The method according to Claim 221, wherein ~~said the step~~ of verifying the program includes a decrypting the license record data accommodated in ~~said the erasable second non-volatile memory area of the BIOS~~ using at least ~~said the~~ unique key.

19. (Amended) The method according to Claim 221, wherein ~~said the step~~ of verifying the program includes encrypting the license record that is accommodated in ~~said the~~ program using at least ~~said the~~ unique key.

20. (Amended) A method for ~~restricting accessing to a software program using a pseudo-unique key stored in a first non-erasable non-volatile memory area of a computer. the first non-volatile memory area being unable to be programmatically changed. the method,~~ comprising:

~~storing a pseudo-unique key in a first non-volatile memory area of a computer;~~

~~selecting loading a software program residing in a volatile memory area of the computer;~~

extracting license information from the software program;

encrypting license information using the pseudo-unique key stored in the first non-volatile memory area;

storing the encrypting ~~pseudo-unique key license information~~ in a second erasable, writable, non volatile memory area of the BIOS of the computer;

subsequently verifying the software program using based on the encrypted license information stored in the second erasable, writable, non-volatile memory area of the BIOS pseudo-unique key; and

acting on the software program based on the verification.

Appln. No.: 09/164,777

Please add the following new claims:

21. (New) The method of claim 20, wherein the verification comprises:
extracting the license information from the software program;
encrypting the license information using the pseudo-unique key stored in the first non-
volatile memory area of the computer to form second encrypted license information; and
comparing the encrypted license information stored in the second erasable, writable, non-
volatile memory area of the BIOS of the computer with the second encrypted license
information.

22. (New) The method of claim 1, wherein a unique key is stored in a first non-
volatile memory area of the computer.

23. (New) The method according to claim 17, wherein the verification comprises:
extracting the license record from the software program;
encrypting the license record using the unique key stored in the first non-volatile memory
area of the computer to form second encrypted license information; and
comparing the encrypted license information stored in the erasable, non-volatile memory
area of the BIOS of the computer with the second encrypted license information.

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VENABLE

Duplicate

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Miki MULLOR et al.

Appl. No: 09/164,777

Filed: October 1, 1998

For: METHOD OF RESTRICTING
SOFTWARE OPERATION WITHIN
A LICENSED LIMITATION

Art Unit: 2161

Examiner: J. Trammell

Atty. Docket No: 39636-176166

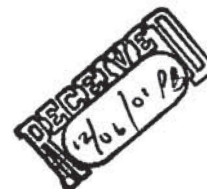
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26694

PATENT TRADEMARK OFFICE

Official



Information Disclosure Statement Under 37 C.F.R. § 1.97(c)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is an Information Disclosure Statement submitted under 37 C.F.R. § 1.97 within the time specified under 37 C.F.R. § 1.97(c)(2).

In order to comply with applicant's duty of disclosure under 37 C.F.R. § 1.56, the U.S. Patent and Trademark Office is notified of the documents which are listed on the attached Form PTO-1449 and which the Examiner may deem relevant to patentability of the claims of the above-identified application. One copy of each of the listed documents is submitted herewith.

The instant Information Disclosure Statement is being a first Office action on the merits, after filing a request for continued examination. Accordingly, pursuant to 37 C.F.R. §1.97(b)(2), no fee is due.

In view of the above, no further translation or statement of relevance is required, and as all requirements of 37 C.F.R. § 1.97 and all official guide lines pertaining to Information

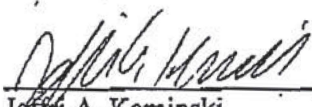
Information Disclosure Statement
U.S. Appln. No.: 09/164,777

Disclosure Statements have been complied with, and it is therefore respectfully requested that the Examiner consider the documents and make them of record.

If no check is attached, please charge any necessary fee or credit any overpayment in connection with this Information Disclosure Statement to Deposit Account No. 22-0261.

Respectfully submitted,

Date: 11/19/01



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