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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/29/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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Date: **MAILED**  
**SEP 29 2011**  
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011198  
PATENT NO. : 5787449  
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)).

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(For Requester)

MAILED

SEP 29 2011

CENTRAL REEXAMINATION UNIT

In re Vulpe *et alia*  
Reexamination Proceeding  
Control No. 90/011,198  
For: U.S. Patent No. 5,787,449

: DECISION DENYING  
: PETITION UNDER  
: 37 CFR 1.181 AND  
: 37 CFR 1.515(c)

This is a decision on the December 27, 2010 paper entitled "Petition To Reconsider The Examiner's Decision To Deny Reexamination Pursuant To 37 CFR 1.515(c) and 37 CFR 1.181". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DENIED** for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. Patent No. 5,787,449 (hereinafter, the '449 patent) issued on July 28, 1998 to Vulpe *et alia*.
2. On August 31, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 14-20 of the '449 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,198 (hereinafter, the '11198 proceeding).
3. An order denying the request for *ex parte* reexamination was mailed on November 24, 2010.
4. On December 27, 2010, the present petition was filed.

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## DECISION

### I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11198 reexamination proceeding has petitioned seeking relief from the examiner's November 24, 2010 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*.

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the August 31, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '449 patent filed in the '11198 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

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## II. De Novo Review of the Request for Reexamination - Findings and Analysis

The '449 patent matured from application number 08/253,263 (the '263 application). During prosecution of the '263 application, the office applied teachings from Rosenbaum (US Patent Number 5,404,435), Mizuta *et alia* (US Patent Number 5,280,574), and Kugimiya (US Patent Number 5,587,449) to various features in the method claims 14-19 and 21 that would be renumbered claims 14-20 at allowance. Of particular note are the applied teachings of Kugimiya and the distinguishing features.

The interview summary of December 10, 1997 states that the claim language was discussed as compared to Kugimiya and references the claim terms "metacode menus" and "distinct storage". Applicant's response of December 15, 1997 states,

"We seemed to reach agreement that the reference does not teach providing a "menu of metacodes" or a persistent storage for the metacode map... Contrast this with the Kugimiya reference which, like many other references, teaches the use of only temporary storage of metacodes while the program is doing its processing. When the program is finished, the document continues to be stored permanently with the metacodes intermixed with the content."

The '263 application was then allowed without further comments. Therefore, the record indicates that the examiner concluded that Kugimiya taught most of the claim limitations, but did not teach "providing a menu of metacodes" and the "distinct map storage means" limitations. It is noted that "providing a menu of metacodes" appears in independent claim 14 and the "distinct map storage means" limitation appears in independent claims 14 and 20.

Stated another way, during prosecution of the '263 application, the office had before them the Kugimiya reference and the technological teachings therein to reject hypothetical claims as follows:

Claim H1. A method for producing a first map of metacodes and their addresses of use in association with mapped content, the method comprising:

providing the mapped content to mapped content storage means;

compiling a map of the metacodes, by locating, detecting and addressing the metacodes; and

providing the document as the content of the document and the metacode map of the document.

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Claim H2. A method for producing from a document made up of metacodes and content, a map of metacodes and their addresses of use in association with mapped content of the document, the method comprising:

- (a) reading the content of the document until a metacode is found;
- (b) copying the content and storing the copied content in a mapped content storage;
- (c) noting in the map the found metacode and its position in the content;
- (d) repeating the processing of (a)-(c) until the entire document has been processed; and then
- (e) providing the document as the content of the document separately from the metacode map of the document.

Therefore, any discussion of how Kugimiya, or other cumulative references, teach the above features is not germane as to whether an SNQ is raised by the '11198 request as such teachings are not "new" to the office. Furthermore, continued reconsideration of previous arguments that Kugimiya, or other cumulative references, allegedly teach the other features in claims 14 and 20 would not be a "new" question. To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:

This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.

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Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:

[The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.

*Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

The '449 patent was also subject to a previous reexamination, control number 90/010,347 (the '10347 proceeding). The requester provided new references to Cowan (RITA) and DeRose (US Patent Number 6,101,512) which raised an SNQ as to claims 14-20 of the '449 patent. Both Cowan and DeRose teach tree based systems. The pointers in those systems were considered by the examiner to not meet the addresses of use limitation as the pointers do not identify the place in the content at which the metacode is to exert its effect. The examiner also discussed an alternative manner of viewing the entire tree structure as meeting the "addresses of use" limitation; however, such a reading would not meet the limitation in context of additional claimed elements as the "tree" could not be considered the requisite "unique identifier" and the "address of use" would contain the metacodes themselves. The teachings from Cowan and DeRose are, at best, cumulative, and in many cases less on point than the teachings of Kugimiya with respect to most claim limitations (including all those in hypothetical claims H1 and H2 above).

Many claim terms are explicitly defined in the specification of the '449 patent. Specifically, column 4, lines 14-20 and lines 36-41 disclose:

A metacode, which includes but is not limited to a descriptive code, is an individual instruction which controls the interpretation of the content of the data, i.e., it differentiates the content. A metacode map is a multiplicity of metacodes and their addresses associated with mapped content. An address is the place in the content at which the metacode is to exert its effect.

By "detecting" is meant recognizing, identifying or differentiating a metacode from content; by "locating" is meant finding the position of a metacode in and relative to an input content stream; and by "addressing" is meant forming a

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unique identifier which defines the position of a metacode relative to the mapped content stream.

These explicit definitions limit the scope of the claim language and mirror the district court's construction of the terms. It is noted that requester points to a perceived difference in the definition of the claim term "addresses of use" in the reasons for confirmation in the '10347 proceeding and the explicit definitions, which carry into the court's claim construction.

The court's claim construction reads, "a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect". The reasons for confirmation in the '10347 proceeding reads, "a unique identifier which defines the position of a metacode relative to a mapped content stream which clearly identifies the place in the content at which the metacode is to exert its effect".

So, the office in the '10347 proceeding has more broadly interpreted the claim term. The office's construction has "a unique identifier which defines the position ... which clearly identifies the place in the content..." That is, the unique identifier "defines the position" but only "clearly identifies the place". Whereas the court's construction has "a unique identifier which defines the position... and the place in the content..." (i.e. the unique identifier defines both the position and the place).

Requester's position that "defining" the place is broader than merely "clearly identifying" the place is not well taken or understood. That is, one can identify a place without defining it, but if one has defined a place, they have clearly identified it. However, the broader definition given in the '10347 proceeding is arguably at odds with the explicit definition in the specification, so the office will now favor a narrower construction of addresses of use defined as "a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect".

Two other terms do not have explicit definitions. Specifically, the "providing a menu of metacodes" and "distinct map storage means" limitations (variously in the limitations "a first map of metacodes and their addresses of use in association with mapped content and stored in distinct map storage means" and "compiling a map of the metacodes in the distinct storage means, by locating, detecting and addressing the metacodes", "a map of metacodes and their addresses of use in association with mapped content of the document and stored in distinct map storage means") are not explicitly defined.

The '449 patent discloses that the processing system (134) "produces a menu of metacodes to select from using the instructions provided in Box 136". Although the step of selecting is not required in the claims, "providing a menu of metacodes" must be read more narrowly than asserting that the existence of metacodes implies "providing a menu of metacodes".



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The examiner of the '263 application viewed Kugimiya's map of metacodes in buffer F (Fig. 13) to not meet the claim limitations regarding the map stored in a distinct storage means. The contents of buffer F are added into buffer B (see Fig. 16) during step S17 of Fig. 10 after they were only initially read to buffer F in steps S12 or S14.

Requester does not proffer a new teaching in Kugimiya to address the distinct storage means limitations. Requester relies on the old teachings in Kugimiya and asserts that they are "In A New Light In View Of The Patentee's Admissions In the Litigation". However, requester does not provide a statement by patent owner that Kugimiya teaches the distinct storage means limitations. Requester appears to want the office to reconsider the argument already decided by the office in the '263 application. However, the reexam statute guards against simply repeating a prior examination on the same issues and arguments.

Regarding "providing a menu of metacodes", requester asserts "the Applicants also argued that Kugimiya does not teach a "menu of metacodes," claim 20 has no such limitation, and, as explained, herein, the Patentee admitted that the was simply an SGML DTD, and that this was known in all markup languages." Providing a menu of metacodes (in claim 14) can not be read as broadly as SGML has metacodes, which could be provided as a menu. In arguendo, if the claim limitation could be read that broadly, then the existence of metacodes in SGML is not a new technological teaching as the SGML standard (and the existence of metacodes in SGML) is admitted and discussed as prior art in the background sections of both the '449 patent and Kugimiya.

On page 77, requester asserts Kugimiya in view of Fukumochi raises an SNQ to meet the "distinct storage means" limitations:

"Plainly, Kugimiya teaches keeping the metacode map and mapped content separate long enough to run a translation process, and during that process the content may expand or shrink since Japanese-English would never be expected a literal word-for-word or character-for-character translation. (See e.g., Fukumochi, col. 1, lines 42-62)."

Fukumochi, col. 1, lines 42-62, reads, as follows:

For example, when the English sentence "Time flies like an arrow" is input, some Japanese equivalents are provided depending on the interpretation of the part of speech of each word. That is, "Time" may be interpreted as a noun or a verb, "flies" may be interpreted as a noun or a verb, "like" may be interpreted as a noun or a preposition. The resulting Japanese equivalents are as follows:

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1. " "(ya-no-youna-jikan-bae) (meaning that "arrow-analogous flies (insects) called as time")
2. " "(ya-no-youni-hae-wo-hakare) (meaning that "Measure flies as if an arrow moves through air")
3. " "(ya-no-youna-hae-wo-hakare) (meaning that "Measure arrow-analogous flies")
4. " "(jikan-bae-wa-ya-wo-konomu) (meaning that "Flies called as time are fond of an arrow")
5. " "(jikan-wa-ya-noyouni-tobu) (meaning that "Time passes as if an arrow moves through air")

A selection of a proper Japanese equivalent from these Japanese equivalent candidates depends on an operator's judgment.

Requester's position is not well taken. A generic teaching of translating Japanese is already present in Kugimiya, a reasonable examiner would not consider this further teaching in Fukumochi important in determining the patentability of the claims.

Requester's position that DeRose alone raises an SNQ reiterates the reason DeRose raised an SNQ in the '10347. However, this is not a new question in the present request. Then, requester argues against the reasons for confirming the claims over DeRose alone. However, the SNQ requirement protects patent owners from having to respond to, or participate in unjustified reexaminations and bars reconsideration of any argument already decided by the Office, whether during the original examination or an earlier reexamination. Thus the statute guards against simply repeating the prior examination on the same issues and arguments.

Requester then proposes the combination of DeRose in view of Kugimiya raises an SNQ. A position that requester did not set forth in the '10347 request. Requester alleges that the combination presents these references in a new light. Requester presents a modification of DeRose's table on page 127 of the request to include both the information from DeRose, Fig. 6 and additional information they allege to be similar to what appears in Kugimiya.

The table on page 127 of the request is inaccurate. The column that requester arbitrarily labeled "Tag" represents nodes in the tree structure of Fig. 5. Although there is a tag for book, and there are separate tags for book and front matter, there is no tag "BOOK, FM". Furthermore, there is no tag "#TEXT" as this represents the actual text in the tree structure of Fig. 5.

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Requester seems to alter what they consider a tag to suit their current argument. However, these changing definitions are internally inconsistent within the request. For example, on page 9 of the request, requester asserts that “[e]nd-tags are also considered complete metacodes, as indicated by “next code”.” Requester cites to column 9, lines 28-31 of the ‘449 patent to support that assertion:

```
read characters until code reads to <Chapter> which is a complete code.  
raw content =  
character position = 0  
metacode map = 1 is <Chapter> at character position 0  
map elements = 1  
read characters until code reads to <Title> which is the next code.
```

However, the section cited refers to start tags for Chapter and Title. Reading until the next code is found does not necessarily mean that the next code is an end code and, in the portion that requester refers to, it is not the end tag. Furthermore, these tags have nothing to do with the nodes in the tree structure of DeRose (Fig. 5) presented in a table form (Fig. 6).

Requester is forcing the term tag to take on an unsupportable meaning to attempt to combine the references in a manner that would contain a new teaching. The combination of DeRose and Kugimiya presented by requester is untenable and would not result in the table shown on page 127. Therefore, the combination set forth by requester does not contain any new teaching that a reasonable examiner would consider important in determining the patentability of the claims.

Requester asserts that Borgendale (incorporating Hesse) and/or Hesse raise an SNQ. Hesse, Fig. 2, starts with an alphanumeric string that includes tags. Hesse creates a table which includes the tags as well as their position within the alphanumeric string. This teaching is inferior to the teachings of Kugimiya considered during prosecution of the ‘263 application because the location of the tags within an alphanumeric string is not the location at which the tag exerts its influence. Additionally, Hesse teaches the use of a buffer and the generic teaching of SGML which are the same as the teachings from Kugimiya. So, the teachings from Borgendale (incorporating Hesse) and/or Hesse are the same as or less on point than the teachings of Kugimiya that were already considered during prosecution of the ‘263 application.

## SUMMARY AND CONCLUSION

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1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 5,787,449 has been presented in the corrected request filed August 31, 2010 by requester for the reasons set forth above.
2. The petition is **DENIED**.
3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.



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Irem Yucel, Director  
Central Reexamination Unit

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<p><b>R.C.N.:</b> 90/011,198 <b>In re U.S. Patent No:</b> 5,787,449 <b>Issued:</b> July 28, 1998 <b>Filed:</b> June 2, 1994 <b>Applicant:</b> Vulpe, et al. <b>Title:</b> Method And System For Manipulating The Architecture And Content Of A Document Separately From Each Other</p>	<p><b>Examiner:</b> Kiss, Eric <b>Art Unit:</b> 3992 <b>CERTIFICATE OF EFS-Web TRANSMISSION</b> I hereby certify that this paper and any documents referred to as being attached or submitted herewith are being filed with the United States Patent and Trademark Office via the Electronic Filing System (EFS)-Web on the date shown below, as of the submitter's local time. Filed by: <u>Xavier A. Clark/</u> Date E-filed: <u>December 27, 2010</u> Submitter's City/State: <u>Portland, Oregon</u></p>
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**Petition To Reconsider The Examiner's Decision To Deny Reexamination  
Pursuant To 37 CFR 1.515(c) and 37 CFR 1.181**

Mail Stop "Ex Parte Reexamination"  
Attn: Central Reexamination Unit  
P.O. BOX 1450  
Alexandria, VA 22313-1450

On August 31, 2010, the undersigned filed a 2<sup>nd</sup> Request for Reexamination of the '449 Patent (hereinafter the "Request").

Requester respectfully asks that the Director review the decision of the Examiner in this proceeding (Re-examination Control Number 90/011,198, hereinafter "the '198 Proceeding") denying the request for reexamination filed August 31, 2010 and that the Director order re-examination of U.S. Patent No. 5,787,449 (hereinafter, "the '449 Patent").<sup>1</sup>

This petition is presented pursuant to 37 CFR 1.515(c) and 37 CFR 1.181 as explained below. The petition fee set forth by 37 CRF 1.17(f) has been paid by electronic submission. Should it be determined that additional fees are necessary for the consideration of these issues, please debit deposit account 02-4550.

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<sup>1</sup> The Examiner's decision was mailed November 24, 2010 (hereinafter "the Denial"). Since December 24, 2010 is an official Federal holiday in the District of Columbia, this petition is timely filed on the next business day: Monday, December 27, 2010. MPEP § 505.

## **I. INTRODUCTION**

Over a century ago, the Supreme Court established that a patentee cannot simultaneously benefit from a broad interpretation of patent claims to capture an accused infringer and a narrow interpretation to avoid the prior art. *White v. Dunbar*, 119 U.S. 47, 51 (1886) (holding that a patentee cannot treat the patent claims as a “nose of wax;” interpreted broadly to allege infringement, but narrowly so as to avoid invalidating prior art). As a decision of the Supreme Court, this directive takes precedence over *all* Federal Circuit decisions regarding claim interpretation.

As explained below, the Examiner committed numerous errors that require reversal of his decision to deny reexamination, including:

- 1) adopting too narrow an interpretation for “addresses of use” in evaluating Hesse, Fig. 2; an interpretation that would exclude the accused Microsoft Word software (as well as the Patentee’s “commercial embodiments” relied upon in the Litigation) from the scope of the claims, thus plainly violating Supreme Court precedent;
- 2) failing to evaluate the teaching of the prior art from the perspective of the person having ordinary skill in the art<sup>2</sup> by limiting the scope of the claims to the single embodiment disclosed in the ’449 Patent, which is contrary to Federal Circuit law and the Patentee’s assertions in the Litigation;
- 3) ignoring the Patentee’s repudiation of the reasons for allowance of the claims over Kugimiya as an independent basis for considering Kugimiya in a “new light”
- 4) holding that the patentee’s trial admissions regarding Kugimiya do not extend to “addresses of use” even though the District Court construction and trial testimony plainly indicate that “addresses of use” are integral to the meaning of “metacode map;”
- 5) dismissing the teaching of the references individually rather than by considering the combined teaching presented by each combination; and
- 6) failing to consider trial testimony by the Patentee that was not of record in the prior reexamination, that rebuts the prior examiner’s claim interpretation, and that is responsive to the questions raised by the prior examiner in the NIRC (*e.g.*, regarding why DeRose’s element directory contained addresses of use).

## **II. LEGAL AUTHORITY**

37 CFR 1.151 states, in pertinent part, that:

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<sup>2</sup> More specifically, in view of the SGML standard that is the common framework for the ’449 Patent as well as Kugimiya, DeRose, and Borgendale/Hesse. *See e.g.*, ’449 Patent, col. 4, lines 64-65.

(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

37 CFR 1.181 states, in pertinent part, that:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; . . .

(3) To invoke the supervisory authority of the Director in appropriate circumstances . . .

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

### **III. STATEMENT OF FACTS (37 CFR 1.181)**

#### **A. Facts Regarding The Concurrent Litigation**

The '449 Patent is the subject of co-pending litigation styled *i4i Limited Partnership v. Microsoft Corporation, et al.*, No. 6:07-CV-113-LED in the United States District Court for the Eastern District of Texas (hereinafter “the Litigation”). On November 29, 2010, the United States Supreme Court granted review of Microsoft’s appeal in the concurrent Litigation.

During the course of the Litigation, the District Court entered a claim construction order that included a construction for the terms “metacode map” and “address[es] of use.” (Request, Exh. 11, “Markman Order,” p. 31, excerpts below). As seen below, the District Court expressly defined the “metacode map” as including the “addresses of use” that correspond to the “mapped content.”

4	map of metacodes / metacode map (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a data structure that contains a plurality of metacodes and their addresses of use corresponding to a mapped content
2	address[es] of use (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect

The District Court further held that the claims did not require that the “metacode map” had to be “persistently stored” or held in “persistent storage” – based on the Patentee’s proposed construction despite its prior contrary representation to the Patent Office in the original prosecution that the “metacode map” must be persistently stored. (Request, pp. 13-14; *see also* 17-19).

The exemplary embodiment described in the ’449 Patent processes an SGML file containing metacode tags (and delimiters) intermixed with text “content” extracts all of the metacode tags and delimiters to create “raw content” – an extreme version of “mapped content.” The District Court held that extraction is not required, rather some or all of the metacode information could be part of the “mapped content.” (Markman Order, pp. 9-10; *also* Exh. 19, Trial Tr., p. A334).

In the Litigation, the issue of infringement was tried to a jury in May 2009.

At trial, the Patentee alleged that it had implemented two “commercial embodiments” of the ’449 Patent claims, referred to herein as the Pre-June 2004 x4o product and the Post-June 2004 x4o product. (*See e.g.*, Request, pp. 22-28; *also* Exh. 9, pp. 1, 4-6). In both of these embodiments, the metacode information remains in the “mapped content” data structure.

Since the construction of “mapped content” was not limited to “raw content,” the Patentee was able to allege at trial that Microsoft Word infringed the claims of the ’449 Patent. (Request, Exh. 22, 24, respectively Rhyne14, Rhyne20). Specifically, the Patentee’s expert testified that a “metacode map” includes the “addresses of use” element, and that the “addresses of use” element is satisfied by storing the location of the start-tag [placeholder] and the end-tag [placeholder] in the MS Word content buffer. (*See e.g.*, Rhyne14, p. 3). In the MS Word product, the “addresses of use” for consecutive start-tags did NOT resolve to the location of succeeding text in the way that the Examiner interpreted the term in the Denial. (*Id.*; *also* p. 7).

Thus, the Examiner’s interpretation of “addresses of use” (as he applied it to the teaching of Borgendale/Hesse, Fig. 2) excludes the accused Microsoft Word software.



At trial, the Patentee testified that Kugimiya discloses a metacode map within the District Court’s interpretation of the claims, thus admitting that Kugimiya’s metacode map included “addresses of use.” (See testimony of Dr. Rhyne and Mr. Vulpe, Request, pp. 17-19).

Again, the Court defined “metacode map” as including “addresses of use.”

4	map of metacodes / metacode map  (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a data structure that contains a plurality of metacodes and their addresses of use corresponding to a mapped content
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**B. Facts Regarding The Prior Reexamination**

Prior to trial, reexamination of claims 14-20 of the ’449 Patent was requested on the basis of DeRose and Cowan on November 21, 2008. Reexamination was ordered and the proceeding was assigned RCN 90/010,347 (hereinafter “the ’347 Reexam”). In an interview held in the ’347 Reexam in September 2009, the Patentee represented to the Patent Office that the “metacode map” (including the “addresses of use” element) was an original innovation of the inventors, in spite of the contrary testimony at trial a few months earlier. (Request, p. 17; discussing Rhyne Decl., ¶ 35 versus his May 2009 testimony).

While the Kugimiya reference was used in the rejection of claims in the original prosecution, Kugimiya was not considered or discussed by the Patent Office during the ’347 Reexam. Thus, the Patent Office did not consider whether the alleged deficiency in DeRose and Cowan was remedied by the teaching of Kugimiya. (Request, p. 16).

On May 11, 2010, the examiner re-mailed a Notice of Intent to Issue Reexamination Certificate in the ’347 Reexam. In the NIRC, the examiner:

- Adopted the following construction for “map of metacodes,” (NIRC, p. 7)

<p>“Map of metacodes” – A multiplicity of metacodes and their addresses associated with mapped content (’449 Patent, col. 4 lines 7-9 and 17-19)</p>
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- Adopted a construction of the term “addresses of use” that is narrower than the District Court’s construction because it adds the “clearly identifies” language, (NIRC, p. 7); and

<p>“Addresses of use” – A unique identifier which defines the position of a metacode relative to the mapped content stream which clearly identifies the place in the content at which the associated metacode exerts its effect (’449 Patent, col. 4 lines 19-20 and lines 40-42, Rhyne declaration, page 15)</p>
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- posed several questions regarding the teaching of DeRose, specifically, under what circumstances could DeRose’s element directory be considered to have “addresses of use” before concluding that neither DeRose nor Cowan taught “addresses of use” in view of Dr. Rhyne’s declaration. (NIRC, pp. 7-9).

There is no record that trial transcripts, exhibits, and/or demonstratives used at trial by the Patentee were made available to the Patent Office during the pendency of the ’347 Reexam by the Patentee, even though numerous representations were made to the Patent Office by the Patentee and Dr. Rhyne that conflict with its own trial testimony.

Accordingly, this information was not considered by the examiner in the ’347 Reexam.

**C. The Patentee’s Repudiation Of The Reasons For Allowance Over Kugimiya**

During the original prosecution, the Applicants argued that claim 1 of the ’449 Patent was patentable over Kugimiya by alleging that Kugimiya did not teach “persistent storage” of the metacode map and the “menu of metacodes” elements. (Request, pp. 13-14, 20-21).

While claim 1 was amended to recite a “resolving” step at that time, claims 14, 18, and 20 do not recite this “resolving” step. (’449 Patent, claims 14, 18, 20).

Thus, the basis for allowing claims 14 and 18 was presumably the alleged lack of persistent storage of the metacode map and the alleged lack of the “menu of metacodes” limitations, as no other distinctions other Kugimiya had been presented to the Patent Office.

Independent claim 20 of the ’449 Patent does not recite a “menu of metacodes” limitation. Thus, the only apparent basis for allowing claim 20 was the “persistent storage” of the metacode map that the Applicants alleged was required by the claims but missing from Kugimiya.

During the Litigation, the Patentees told the District Court that the “menu of metacodes” limitation was satisfied by a SGML document type definition (“DTD”). DTD declarations may be a part of an SGML file itself or supplied as a separate file, but are nevertheless inherent in an SGML-based system to define the grammar of the markup declarations. (Markman Tr., p. 16, 45; Request, pp. 20-21).

Kugimiya plainly discloses a system for use with SGML, the metacode language of the preferred embodiment of the ’449 Patent. (*Compare* Kugimiya, col. 1, lines 46-55 *with* ’449 Patent, col. 4, lines 63-64). Therefore, the “menu of metacodes” specified by the DTD is inherent in the teaching of Kugimiya.

Thus, the Patentees repudiated the reasons for the original allowance of claims 14, 18 and 20 over Kugimiya.<sup>3</sup>

When the 1<sup>st</sup> Request for Reexamination was filed in Sept. 2008, the Patentee had not yet made the *trial admission* (in May 2009) that Kugimiya's metacode map satisfied the District Court's construction of the claims. (*See* Request, pp. 17-19).

Thus, the issue of the Patentee's repudiation of the reasons for allowance in the original prosecution was not ripe for presentation to the Patent Office when the 1<sup>st</sup> Request was filed.

Again, there is no record that trial transcripts, exhibits, and/or demonstratives used at trial by the Patentee were made available to the Patent Office during the pendency of the '347 Reexam by the Patentee, even though numerous representations were made to the Patent Office by the Patentee and Dr. Rhyne that conflict with its own trial testimony. This information has been provided to the Patent Office by the Requester in the 2<sup>nd</sup> Request.

**D. Facts Regarding The 2<sup>nd</sup> Request For Reexamination**

On August 31, 2010, the undersigned filed a 2<sup>nd</sup> Request for Reexamination of the '449 Patent. The primary prior art references cited in the Request included Kugimiya, DeRose, and certain new references that had never been previously considered by the Patent Office, particularly Borgendale/Hesse.

The 2<sup>nd</sup> Request includes several sections that respond to questions raised by the prior examiner in the NIRC (*e.g.*, a discussion of inconsistency between Dr. Rhyne's Declaration (upon which the prior examiner relied) and Dr. Rhyne's trial testimony regarding "addresses of use" in relation to the accused product, the Patentee's commercial embodiments, and Kugimiya).

On November 24, 2010, Examiner Kiss mailed a communication denying the Request.

In the Denial, Examiner Kiss stated that the Patentee's trial admissions regarding "metacode map" did not extend to the "addresses of use" limitation even though both the District Court's interpretation and the prior examiner's interpretation of "metacode map" expressly recite that the "metacode map" includes "addresses of use," and the trial witness expressly confirmed that his admission was based on his review of the District Court's construction. (Denial, p. 7-8).

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<sup>3</sup> There is no "menu of metacodes" limitation in claim 20, thus the Patentee's repudiation of "persistent storage" removed the only reason for the allowance of this claim over Kugimiya.

In the Denial, Examiner Kiss did not discuss the Patentee's repudiation of the reasons for allowance in the original prosecution, but simply stated that the claims had been allowed over Kugimiya. (Denial, p. 6).

In the Denial, Examiner Kiss dismissed the teaching of the primary references individually, rather than by considering whether the combined teaching of the references constituted a "new technological teaching" against the claims. (Denial, pp. 6-9).

In the Denial, Examiner Kiss did not address the Requester's challenge that the reasons for allowance in the '347 Reexam were flawed because the prior examiner's claim construction was narrower than the District Court's and thus contrary to Supreme Court precedent.

Since the Patentee's trial admissions were not made of record in the '347 Reexam, the teaching of Kugimiya in view of the Patentee's repudiation of the reasons of allowance in the original prosecution has never been resolved in a prior examination of the '449 Patent.

The combined teaching of Kugimiya and DeRose against the claims of the '449 Patent has never been resolved in a prior examination. (Request, p. 16)

The teaching of Borgendale/Hess (alone or in combination with other art) has never been considered, discussed or resolved in a prior examination of the '449 Patent.

A reasonable examiner cannot adopt an interpretation of patent claims that conflicts with Supreme Court precedent (e.g., *White v Dunbar* as discussed below).

#### **IV. POINTS TO BE REVIEWED (37 CFR 1.181)**

The petition presents the following points of error for resolution by the Director.

- Whether the Examiner erred by not using the broadest reasonable interpretation standard in evaluating the Request, particularly the teaching of Borgendale/Hesse
- Whether the Examiner erred by ignoring the basis on which Kugimiya had been distinguished during the original prosecution
- Whether the Examiner erred by limiting the Patent Owner's admissions regarding metacode map (even though the District Court's interpretation of the term necessarily includes the "addresses of use" element)
- Whether the Examiner erred by not considering the combined teaching of the references – e.g., Kugimiya and DeRose – in combinations that have never been previously considered by the Patent Office,

- Whether the Examiner erred by accepting the prior examiner's claim interpretation and reasons for allowance, even though the former conflicts with Supreme Court precedent.

## V. **RELIEF REQUESTED (37 CFR 1.181)**

For the reasons stated herein, Requester asks that the Director issue an order finding:

- 1) that the claim interpretation used by the examiner in the prior '347 Reexam was narrower than the interpretation given by the District Court, and therefore was not the broadest reasonable interpretation for the claims as a matter of law,
- 2) that the prior examiner's failure to use the broadest reasonable interpretation negates the "reasons for allowance" given at the conclusion of the '347 Reexam,
- 3) that the examiner has improperly dismissed the primary references cited in the current Request by considering the references individually, rather than by evaluating the individual and combined teaching for each proposed rejection set forth in the Request;
- 4) that the Director order re-examination of the '449 Patent because there is at least one substantial new question of patentability raised against each of claims 14, 18 and 20 by the prior art as it has been cited by the Requester in the Request; and
- 5) that re-examination be conducted in view of all available prior art, as specifically directed by 37 CFR 1.550.<sup>4</sup>

## VI. **ARGUMENT**

The Examiner erred in his analysis on several grounds as discussed in detail below.

### A. **The Examiner Erred By Not Using The Broadest Reasonable Interpretation Standard In Evaluating The Teaching Of Borgendale/Hesse**

In the Denial, the Examiner states that Borgendale/Hesse does not raise a substantial new question of patentability because (in the Examiner's view) the reference teaches mapping the "location" of the metacode rather than where the metacode "exerts its effect." (Denial, p. 9, below).

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<sup>4</sup> MPEP 2248 similarly states that a requester cannot request review of a petition granting reexamination on a single ground or a ground not specifically advanced in the Request because the review of the claims will be conducted on the basis of all available art.

DeRose or Cowan.” (*Id.*) However, the metacode map cited in *Hesse* does not identify the place in the content at which the metacode is to exert its effect. Instead, table 94 in *Hesse* stores the location of the tags themselves. In the example illustrated in Fig. 2 of *Hesse*, the 'I' and 'O' tags would exert their effect in the same place in the content, beginning with the first capital 'T' in structured document text 93. Because *Borgendale* and *Hesse* fail to teach a metacode map meeting the “addresses of use” requirement of the claims, the request has not shown that there is a substantial likelihood that a reasonable examiner would consider either *Hesse* or *Borgendale* important in deciding whether or not claim 14, 18, or 20 is patentable.

The Examiner appears to interpret the claim such that the place where a metacode “exerts its effect” is the location of the non-tag text in *Hesse*, Fig. 2, but the Examiner does not explain the basis for his assertion that the <I> and <O> metacodes should point to the character position (i.e., the first capital “T”). As explained in the Request (and discussed herein), this is not the broadest reasonable interpretation of “addresses of use,” and such an interpretation excludes the product accused in the Litigation as well as the Patentee’s commercial embodiments upon which it relied at trial.

This Examiner erred on this point for several independent reasons.

First, the Examiner’s interpretation of *Borgendale/Hesse* is not the way that the person having ordinary skill would understand the teaching of the reference. As demonstrated below, the place where a metacode “exerts its effect” is dependent on its location in the text document. By definition, the District Court stated that the “addresses of use correspond[] to a mapped content.” (Markman Order, p. 31). Thus, the actual values for the “addresses of use” depend on how the “mapped content” is stored, as well as what information is stored in the “mapped content,” particularly whether metacode information is retained in the “mapped content.” In fact, Dr. Rhyne’s testimony in the Litigation identified “addresses of use” as values that pointed to certain metacode placeholders in the mapped content, not the printable text in the document.

Second, the Examiner’s interpretation excludes the product accused of infringing the claims in the Litigation (as testified to by Dr. Rhyne). Thus, the Examiner’s interpretation allows the Patentee to benefit from a broad construction in Litigation to capture an alleged infringer while permitting the claims to escape invalidating prior art that teaches substantially the identical “addresses of use” limitation; a result that conflicts with Supreme Court precedent.

Third, the Examiner's interpretation would expressly exclude the Patentee's own alleged commercial embodiments (upon which the Patentee relied at trial). In the x4o products, the "addresses of use" in the x4o "metacode map" did not skip over consecutive metacodes to identify the "text content" as the place where a metacode exerts its effect, instead the commercial embodiment, like Borgendale/Hesse, stores the location of the metacode.

Fourth, the Examiner's finding is incorrect because his interpretation limits the scope of the claim to the single embodiment in the '449 Patent, and is not the broadest reasonable interpretation of the scope of the claim. At best, the '449 Patent contains a description of a metacode map for an embodiment in which the "metacodes" are completely extracted from the "mapped content," but there is no exemplar showing a metacode map when the "metacodes" remain embedded in the "mapped content."

1. **Under the Broadest Reasonable Interpretation, "Addresses Of Use" Are Dependent On The "Mapped Content" And This Includes The Location Of The "Metacodes"**

In the Denial, the Examiner did not give a specific reason for his conclusion that the <I> and <O> tags "exert their effect" beginning at the "T" in Hesse, Fig. 2, rather than the location of the start and end tags as defined by the SGML specification. But, his conclusion appears to be based on an interpretation of "addresses of use" that is limited to the preferred embodiment (i.e., the "raw content" example discussed in the '449 Patent).

The Examiner erred in his analysis by not applying the broadest reasonable interpretation of the claims. The Examiner essentially states that the "location" of the start-tag and end-tag can *never* be the place where the metacode "exerts its effect." However, nowhere in a prior prosecution of the patent (or even in the Litigation) has the Patentee expressly defined this term or disclaimed such scope. Rather, in the broadest reasonable interpretation of the claim scope (and particular in view of the '449 Patent specification), the "location" of the "start-tag" and "end-tag" are exactly what defines where the metacode "exerts its effect." Indeed, as explained below, the Rhyne Declaration (filed in the '347 Reexam) supports this reading.

Under the District Court's construction, the "addresses of use" are dependent on the structure of the "mapped content." (Markman Order, p. 31).

2	address[es] of use  (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect
4	map of metacodes / metacode map  (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a data structure that contains a plurality of metacodes and their addresses of use corresponding to a mapped content

Accordingly, the “addresses of use” in the “metacode map” are directly dependent on the data storage structure of the “mapped content.” If the metacode tags are completely extracted from the content, then the remaining “mapped content” may be called “raw content.” (Markman Order, p. 9, excerpt below).

The specification differentiates between “mapped content” and “raw content” and states “[r]aw content is an extreme example of mapped content wherein the latter is totally unstructured and has no embedded metacodes in the data stream.” *Id.* at col. 4:10–13. This unclear sentence conveys that raw content is a subset of mapped content.

Thus, the District Court determined that the claims do not limit how the mapped content is structured. It expressly held that the metacode tags did not have to be extracted from the source, thus, the mapped content could be the same as the SGML source file. In fact, the District Court expressly excluded a claim interpretation requiring extraction of the metacodes. (Markman Order, p. 10, excerpt below).

During prosecution, the applicant stated that the claimed invention extracts metacodes from an existing document and that the invention separates metacodes from the content. Microsoft’s Claim Construction Brief, Ex. B, at FH0076, FH0078, FH0092, FH0119, and FH0134. The applicant’s statements do not unequivocally disavow claim scope, as the statements do not require the invention to remove the metacodes and thereby alter a document and do not require the invention to separate all metacodes from the mapped content. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003)(“[W]e have . . . consistently rejected prosecution statements too vague or ambiguous to qualify as a disavowal of claim scope . . . . Rather, we have required the alleged disavowing statements to be both so clear as to show reasonable clarity and deliberateness, and so unmistakable as to be unambiguous evidence of disclaimer.”) (citations omitted).

In total, the intrinsic record does not rebut the presumption that “mapped content” and “raw content” have different meanings. Further, the intrinsic record indicates “raw content” is a subset of “mapped content,” and “mapped content” does not need to be free of all metacodes.



For this discussion, two forms of mapped content are discussed: the “extreme” “raw content” example that is disclosed by the ’449 Patent (and the Rhyne Declaration), and “mapped content” that retains some or all metacode tags and/or other characters (which is illustrated by the Patentee’s own commercial embodiments, the accused product in the Litigation (Microsoft Word), and Borgendale/Hesse).

## **2. The Accused Product Is Outside The Examiner’s Interpretation**

The Examiner’s interpretation of “addresses of use” (particularly with reference to Hesse, Fig. 2) is too narrow because it would exclude the version of Microsoft Word that the Patentee accused of infringement in the Litigation.

The source document for the infringement analysis is substantially identical to that illustrated in the Rhyne Declaration, ¶ 29 (below). This document was also imported into the “commercial embodiments” discussed later.

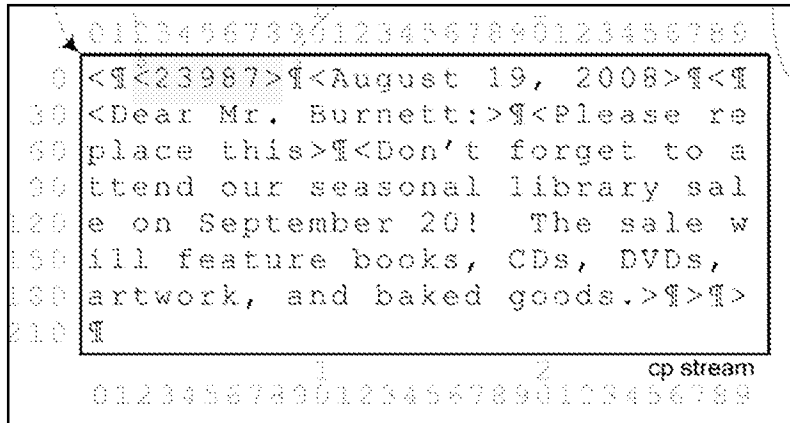
```
<?xml version="1.0" encoding="UTF-8"?>
<Letter xmlns="http://example.com/44ims/letter">
  <MemberID>23987</MemberID>
  <Date>August 19, 2008</Date>
  <LetterBody>
    <Salutation>Dear Mr. Burnett:</Salutation>
    <Content>Please replace this</Content>
    <Postscript>Don't forget to attend our seasonal library sale on
September 20! The sale will feature books, CDs, DVDs, artwork, and
baked goods.</Postscript>
  </LetterBody>
</Letter>
```

At trial, Dr. Rhyne testified that MS Word infringed claims 14, 18 and 20 of the ’449 Patent. As discussed in the Request (§ IV.E.10), he alleged that as many as seven different data structures constituted the “metacode map” containing the “addresses of use”. (*See e.g.*, Request, Exh. 22, Plt. Slides Rhyne14).<sup>5</sup> Dr. Rhyne further specifically testified that the “addresses of use” limitation was satisfied by two values, representing the location of the start-tag (i.e., the position of the left angle bracket, not the text) and the location of the end-tag (the position after the right angle bracket, not the last character position of the affected text). (See “cpstream” below).

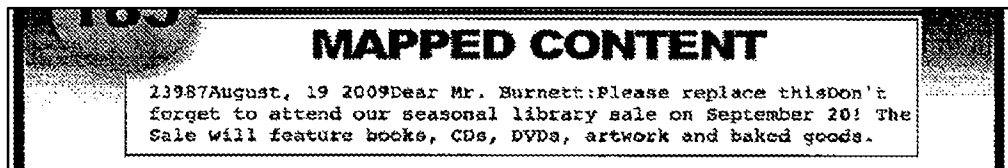
The diagram on page 3 of the Rhyne14 slides was entered into evidence as PX537. Dr. Rhyne testified that the “cpstream” buffer in MS Word was the “mapped content” element of the claims.

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<sup>5</sup> Microsoft contested that this constituted a “metacode map.”



As seen above, cpstream is not “raw content.” Indeed, Dr. Rhyne alleged that the exemplary algorithm of the ’449 Patent would produce “mapped content” that did not have any placeholders or paragraph marks (i.e., “raw content”) as excerpted below. (Rhyne Decl., ¶ 64).



By comparison, the cpstream buffer in the MS Word product contains non-printable paragraph marks and placeholders (e.g., the angle brackets). Further, cpstream is not simply the source text with the mark-up text (e.g., “LetterBody”) removed.

To illustrate, if only tag-text was removed, then there would be matched pairs of angle brackets in each location where tag text had been located. If that were the case, then the text buffer would look more like the following, rather than the cpstream buffer illustrated in PX537:

**<><>23987<><>August 19, 2008<><><>Dear Mr. Burnett:<>**

Now that the structure of the “mapped content” is known, the resulting “metacode map” with the required “addresses of use” can be compared to the Examiner’s interpretation.

Based on the description of Hesse Fig. 2 by Examiner Kiss in the Denial, the two metacodes “<LetterBody>” and “<Salutation>” should both “exert an effect” at the identical location, and the resulting metacode map should store the identical starting value for each of these two metacodes, specifically at character position 31.

However, that’s not what the accused product did. Rather, as explained below, the Patentee alleged that the values in the MS Word product constituted “addresses of use” via an *ad hoc* amalgamation of many different data structures (everything else in PX537 as illustrated in Request, Exh. 22, p. 3, which was “merged for display purposes” by the Patentee).

First, Dr. Rhyme testified that the “cpFirst” values identify the place where the code begins to exert its effect (i.e., he equated the actual location of the placeholder for the tag as where the position where metacode exerts its effect, not the subsequent text). Second, Dr. Rhyme testified that the “cpLimit” values identify the location where the effect of a metacode ends. (Rhyme14, p. 7, excerpt below).

### Court's Claim Construction

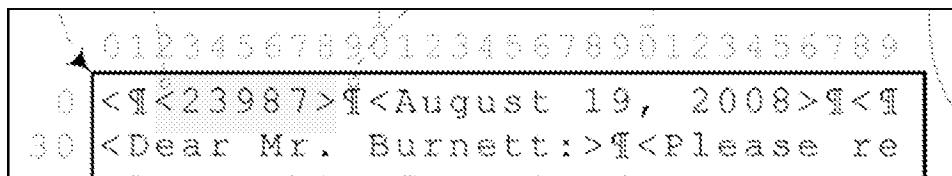
**Address of Use** means “a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect.”

**Map of Metacodes**

cpFirst	cpLimit	endInfo
0	210	
2	6	
10	27	
28	208	
30	48	
50	71	
72	205	

Merged addresses for display purposes

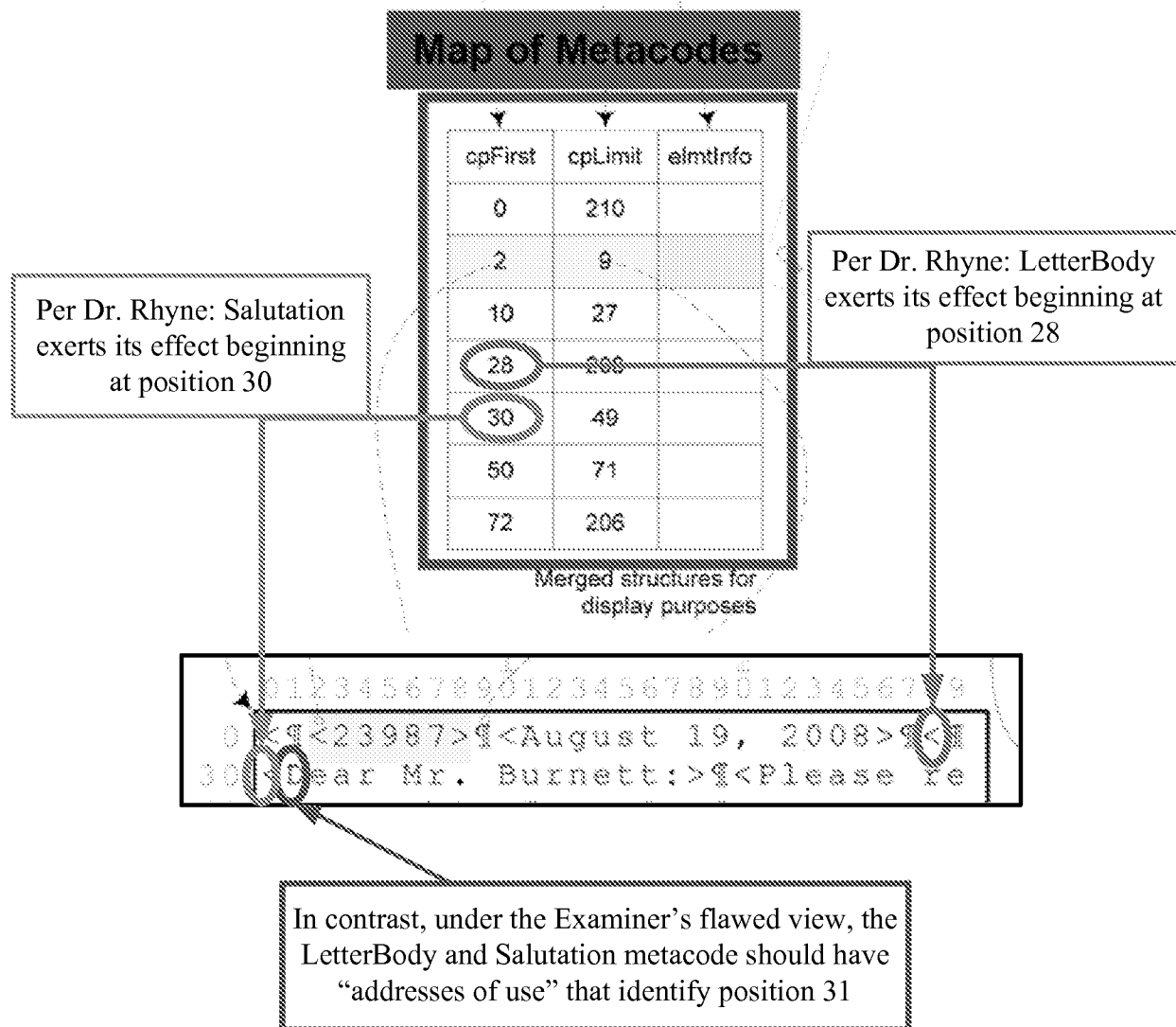
Now, the first text character that appears after the LetterBody and Salutation start-tags is located at character position 31 (i.e., the capital “D” in Dear).



But, the alleged metacode map in the accused product does not contain “addresses of use” that point to character position 31. Again, as illustrated above, Dr. Rhyme testified that the “addresses of use” for a single metacode tag can be satisfied by two values: a starting location and an ending location. In other words, the locations of the tags define where the metacode “exerts its effect” (which is exactly what the SGML specification indicates as discussed in Section VI.A.3).

In the MS Word product, the cpFirst value is the location of the placeholder bracket for the start-tag that remains in the cpstream buffer. The cpLimit value is *one character past* the location of the end-tag placeholder (i.e., the right angle bracket “>”). That is, even the values for cpLimit do not conform to the Examiner’s logic.

The conflict between the Examiner’s conclusory interpretation of “addresses of use” and Dr. Rhyme’s trial testimony is illustrated by analyzing the excerpts from Dr. Rhyme’s trial presentation (below).



To summarize, at trial, the Patentee alleged that Microsoft Word stored a “metacode map” that contained “addresses of use” and that the “addresses of use” element was satisfied by recording the location of the start-tag holder and the location of the end-tag placeholder in the “mapped content.”

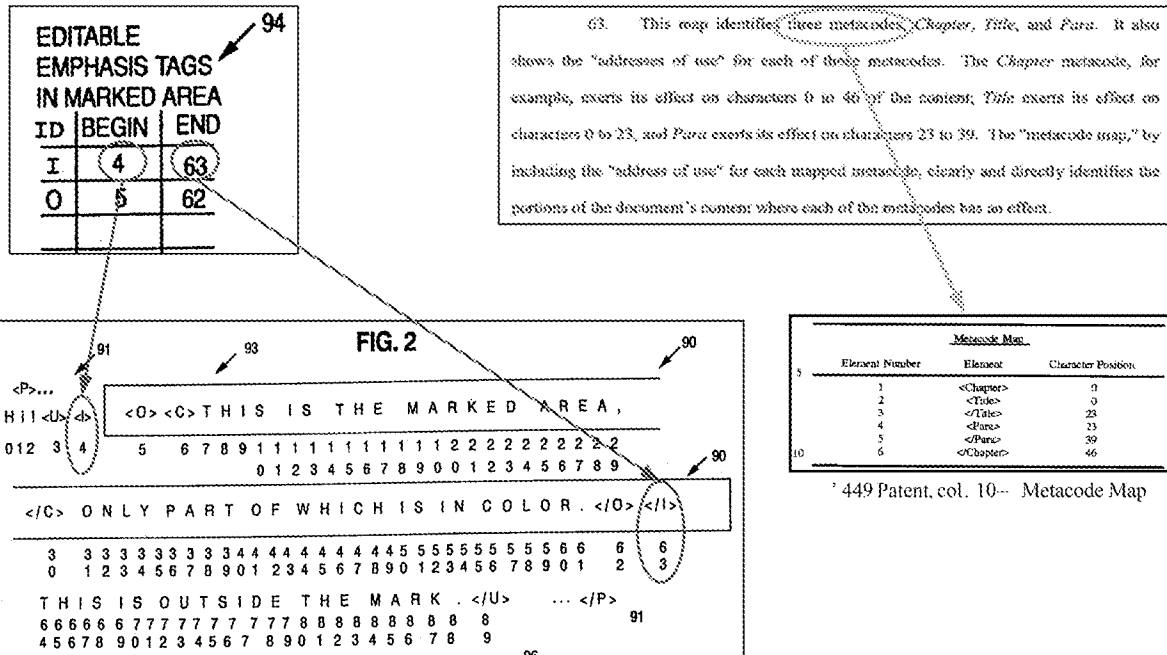
Hesse Fig. 2 *teaches the same thing*: addresses of use that are exemplified by the location of the start-tag and end-tag placeholders in the “mapped content.” (Request, Exh 22., p. 19, below).<sup>6</sup>

<sup>6</sup> Note: In Dr. Rhyne’s analysis of “cpLimit” in the accused MS Word product, the end-tags actually point to the character after the angle bracket. While Dr. Rhyne testified that the MS Word implementation was insubstantially different from the claims, the important factor is that

**Hesse Discloses A Metacode Map With “Addresses of Use”**  
 (Even Under Rhyne’s Narrower View That A “Metacode Start-tag and Stop Tag”)

Hesse: <I>+</I>=I

Rhyne ¶63: <Chapter>+</Chapter>=Chapter



Hesse, Fig. 2

Indeed, the data structure disclosed in Hesse, Fig. 2 is far more straight-forward than the Patentee’s infringement allegation set forth in PX537 (i.e., Rhyne14, p. 3) and does not require an *ad hoc* amalgamation of data structures.

The Examiner’s interpretation of metacode map/addresses of use *excludes* the accused product, and therefore cannot be the broadest reasonable interpretation as a matter of law. To hold otherwise would be a clear abrogation of the Supreme Court’s admonition that a patentee cannot benefit from the treatment of the patent claims as a “nose of wax;” interpreted broadly to allege infringement, but narrowly so as to avoid invalidating prior art. *White v. Dunbar*, 119 U.S. 47, 51 (1886).

Because Hesse Fig. 2 plainly discloses a data structure that conforms to the Patentee’s infringement allegation at trial, the teaching of Hesse plainly is important to a reasonable examiner in determining the patentability of the claims. Therefore, the Examiner’s denial should be reversed, and reexamination should be ordered.

the teaching of Borgendale/Hesse conforms to Dr. Rhyne’s description of the claim scope *better* than the accused product does.

3. **The Place Where A “Metacode” Exerts Its Effect Includes All Content Between The Start-Tag And End-Tag, Even Other Metacodes**

The Examiner erred in interpreting the claims and the prior art from the perspective of the person having ordinary skill in the art.

The '449 Patent does not explain what it means for a metacode to “exert its effect.” Rather, the '449 Patent states that SGML is the preferred “metacode language” of the alleged invention. ('449 Patent, col. 4, lines 63-64). Assuming that a “metacode” encompasses an SGML start-tag and an end-tag as asserted by the Patentee (Request, p. 22), then it is the location of these two tags in the source text that indicate where the metacode “exerts its effect.”

By definition, the SGML specification states that a start tag “identifies the start of an element” and its corresponding end-tag “identifies the end of an element.” (Request, Exh. 7, SGML Spec., § 4.306 and 4.119).

**4.306 start-tag:** Descriptive markup that identifies the start of an element and specifies its generic identifier and attributes.

**4.119 end-tag:** Descriptive markup that identifies the end of an element.

Further, the SGML specification states that the “content” for the element (i.e., metacode) is *everything* that falls between the start-tag and end-tag, which can include “**other markup**” (e.g. additional “metacodes”). (SGML Spec., § 4.53).

**4.53 content:** Characters that occur between the start-tag and end-tag of an element in a document instance. They can be interpreted as data, proper subelements, included subelements, other markup, or a mixture of them.

In other words, the “metacode” exerts its effect on *everything* that is contained between the start-tag and the end-tag (without regard to whether the markup is stored in-line or separately as the SGML specification expressly permits).<sup>7</sup>

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<sup>7</sup> Contrary to the Patentee’s claim that separation of “markup” (i.e. metacodes) from the non-markup content was an innovation of the applicants, the SGML specification itself envisioned separate storage: “SGML accommodates such uses by providing the following capabilities: -- Element content can be stored separately from the markup.” (SGML Spec., p. 3).

Thus, the values stored in the “metacode map” that represent the “addresses of use” will be dependent on the storage structure of the “mapped content” and what information is retained in the mapped content (i.e., whether the “mapped content” retains metacode information, whitespace, placeholders, etc. or not).

In the “extreme” example of “mapped content,” all metacode information is completely eliminated from the “mapped content” buffer, resulting in “raw content.”<sup>8</sup> This is the only exemplar that is formally illustrated by the ’449 Patent, and as the Patentee repeatedly stressed during Litigation, the claim scope should not be limited to the preferred embodiment. (See e.g., Exh. 19, Trial Tr., pp. A270-271; A317; A334 below).<sup>9</sup>

4 THE COURT: Mr. White, can you point me to a single  
5 embodiment that has metacodes in the mapped content?  
6 MR. WHITE: We do not describe it in the  
7 specification, Your Honor, no. It is clear that the examples  
8 that we gave of an SGML encoded document started off with  
9 tags, and they were extracted leaving you with raw content.  
10 We made that very clear. This is an example of a situation,  
11 Your Honor, where an applicant is entitled based on his  
12 enabling disclosure to claim the invention broader than any  
13 particular preferred embodiment. So when you look -- and I  
14 pointed out to the Court the preamble of the claim uses the  
15 term "mapped content." It didn't use the term "raw content."  
16 But the specification makes it clear raw content has  
17 no embedded metacodes in the content. What is the opposite of  
18 none? It would be some; all. We don't know because it  
19 clearly is teaching that you could have mapped content that  
20 had -- that left the actual metacodes in it. Because, Your

<sup>8</sup> Of course, this form of storage was not novel. The SGML Specification itself (cited by the ’449 Patent col. 2, lines 41-43 and relied upon as prior art in the 2<sup>nd</sup> Request) states that the markup can be stored separately from the data as mentioned in footnote 1 above. (SGML, p. 3).

<sup>9</sup> See MPEP § 2111.01 II citing *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).

In raw content, the locations of consecutive metacodes collapse into duplicate values (pointing to the same location in the mapped content). (See e.g., Rhyne Decl., ¶ 64,72; also excerpt from '449 Patent below).

<u>Metacode Map</u>		
Element Number	Element	Character Position
1	<Chapter>	0
2	<Title>	0
3	</Title>	23

In other words, the character positions occupied by the metacodes in the original SGML file don't get counted when calculating the "addresses of use" because all tag information is completely removed leaving only the "extreme" version of "mapped content."

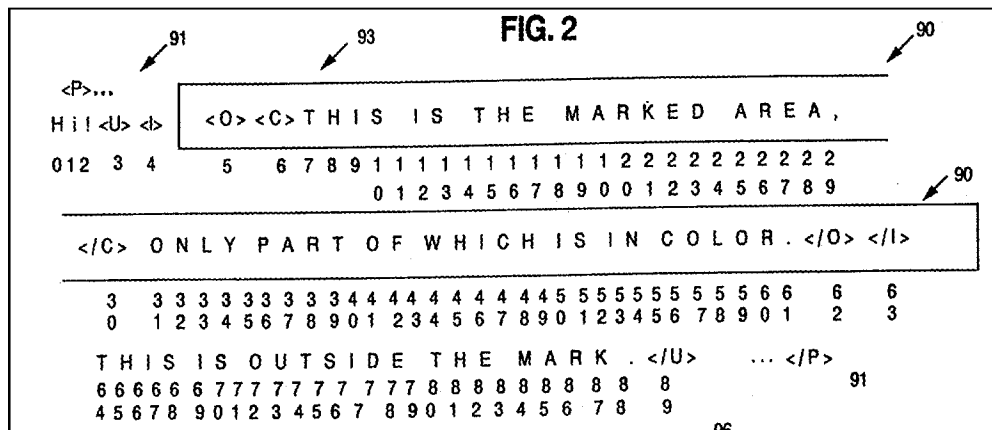
If the tags, placeholders, or even non-printable characters are allowed to remain in the mapped content, then the exemplary algorithm in the '449 Patent will not produce a "metacode map" in which the "addresses of use" for consecutive metacodes collapse (*i.e.*, point at the same location in the raw content). Indeed, as the Patentee admitted, the '449 Patent does not teach what a metacode map would look like if "some" or "all" tag information remains in the mapped content because the Patent only presents an example for "raw content" (See Trial Tr. A334 above).

As discussed in the Request and reiterated herein, the Patentee's alleged commercial embodiments (*i.e.*, the x4o product) illustrate "mapped content" in which the metacode tag information remains embedded in the "mapped content." (See e.g., Request, Exh. 9, pp. 1, 4-6). As a result, the metacode maps containing the "addresses of use" do not resolve to the text blocks (*e.g.*, the capital "D" in Dear for LetterBody and Salutation), and therefore, the Patentee's own alleged commercial embodiment falls outside the claim scope under the Examiner's interpretation.

Similarly, the accused product does not remove all tag information from the mapped content. Rather, placeholders are left in the buffer that the Patentee identified as the "mapped content" (*i.e.*, "some" metacode information, as in Trial Tr., A334), and as a result, the alleged "addresses of use" in the accused product would also be outside the scope of the claims.



In the Borgendale/Hesse example, the “mapped content” also retains start-tag and end-tag information.<sup>10</sup> (Hesse, Fig. 2 below).



In accordance with the SGML specification, the above diagram illustrates that the <Italic> metacode “exerts its effect” on everything between position 4 (shown as “<I>”) and position 63 (illustrated as “</I>”). It is plainly irrelevant that other start-tags and end-tags may also be within the “region of influence” as the SGML specification states that the “content” region may contain additional markup. (SGML Spec., § 4.53). As discussed below, the metacode maps in both versions of the x4o product show the same characteristic taught by Borgendale/Hesse.

To the extent that the Examiner is attempting to distinguish the prior art by limiting the concept of a metacode empirically (i.e., the way a human looks at the specific rendering of an effect for a particular tag in a document, rather than the way the applicable SGML standard defines the location of the effect), his approach is subjective rather than objective, and the result conflicts with an objective interpretation of the person having ordinary skill in the art.

For example, suppose that content is added between the <I> and <O> in Hesse, Fig. 2. Under the SGML standard, the new text plainly would be affected by the <Italic> directive, but not the <Overstrike> directive. In other words, the logical position in the document where the metacode exerts its effect is unchanged (that is, the position relative to the structure does not

<sup>10</sup> The Borgendale/Hesse example is demonstrative rather than literal. For example, the “<I>” is shorthand for “<Italic>” and does not occupy a single character position or byte.

change); the affected content is exactly what the SGML definition says in § 4.53, everything between the start-tag and the end-tag.<sup>11</sup>

Indeed, Dr. Rhyne's own declaration reflects this view. According to Dr. Rhyne, an "address of use" is defined by two values: 1) "the place where the start tag indicates the starting position where that metacode becomes active within the mapped content," and 2) "the character position of the end-tag which indicates the place in the unified content at which the metacode ceases to have its effect." (Rhyne Decl., ¶ 72).

72. As explained above, an "address of use" must clearly identify the place in the content at which the associated metacode exerts its effect." In the '449 Patent that function is accomplished using two values for each "address of use", the character position within the mapped content where each metacode's start tag indicates the starting position where that metacode becomes active relative to the mapped content, and the character position of the end tag which indicates the ending place in the unified content at which the metacode ceases to exert its effect. Conversely, the pointers used by DeRose in the element map of his Figure 6 are simply single-valued memory addresses; those pointers do not identify a region of influence. Hence, DeRose's pointers are not the "addresses of use" required by claim 14, meaning that the DeRose element directory is not a "metacode map."

But, SGML tags do not contain any position information in the declaration. For example, a start tag (*e.g.*, <Chapter>) does not contain any internal parameter information that points to content elsewhere (*e.g.*, after the <Title> tag). Rather, as defined by the SGML specification, the place where the code exerts an effect includes everything between the start-tag and the end-tag. (SGML Spec. § 4.53).

This interpretation is consistent with Dr. Rhyne's testimony, the SGML specification, and the accused product: the place where a metacode (using Dr. Rhyne's definition that a metacode is defined by a start-tag and an end-tag) exerts its effect begins immediately after the closing delimiter of the start tag and ceases at the first delimiter of the end-tag.

By comparison, the Examiner's unduly narrow interpretation would exclude both the Patentee's alleged commercial embodiments *and, importantly, the accused product.*

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<sup>11</sup> In contrast, under the Examiner's view, the structural interpretation of the content would vary simply by adding (or removing text) between tags.

**4. The '449 Patent Algorithm Could Not Produce The Same Raw Content Metacode Map If The Tags Are Left In The Mapped Content**

The '449 Patent contains a description of a metacode map for an embodiment in which the “metacodes” are completely extracted from the “mapped content,” but there is no exemplar showing a metacode map when the “metacodes” remain embedding in the “mapped content.”

Because the tags are completely extracted (and the '449 Patent does not illustrate leaving any placeholders at all in the mapped content), the resulting metacode map shows tags that do not have any other content between them as being the same location. In the resulting metacode map, the character position for consecutive tags is deprecated (they collapse to the same character position). Thus, the start of the Chapter and Title elements collapses to the start of the buffer (i.e., character position zero).

<u>Metacode Map</u>		
Element Number	Element	Character Position
1	<Chapter>	0
2	<Title>	0
3	</Title>	23

However, the '449 Patent does not illustrate an exemplary metacode map for “mapped content” that retains metacodes, metacode delimiters, or even non-printable characters (e.g., carriage return, new line, etc.). (Trial Tr., A334). Rather, the Examiner appears to have assumed that the resulting metacode map would have the same property as the “raw content” version even when the SGML tags were left in the mapped content. This is incorrect.

If the tags are not extracted (i.e., similar to the x40 product and Borgendale/Hesse), then the “mapped content” could be identical to the original SGML document. In case of the '449 Patent exemplar, the “mapped content” would be identical to the source (shown below):

<Chapter><Title>The secret life of data</Title><Para>Data is hostile</Para>The End<Chapter>
--

For illustration purposes, the character positions of the initial text have been numbered in the chart below:

0	1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18
<	C	h	a	p	t	e	r	>	<	T	i	t	l	e	>	T	h	e

Of course, when the exemplary algorithm of the '449 Patent is applied (but the tags not extracted) then the resulting map might look like this:<sup>12</sup>

Element #	Element	Position
1	<Chapter>	9
2	<Title>	16

Of greatest importance, the metacode map (containing the “addresses of use”) in the Patentee’s alleged commercial embodiments and the accused product (as illustrated by the Patentee) do not resemble the Examiner’s interpretation at all. Indeed, under the Examiner’s interpretation, the accused Microsoft Word product would not meet the “metacode map” limitation.

**5. The Rhyme Declaration Was Directed To “Raw Content” Rather Than “Mapped Content” With “Some” or “All” Metacode Information Embedded**

In the prior re-examination, the Patentee presented the following sample document and allegedly applied the exemplary algorithm in the '449 Patent to this sample. (Rhyme Decl., ¶ 29).

```
<?xml version="1.0" encoding="UTF-8"?>
<Letter xmlns="http://example.com/i4ims/letter">
  <MemberID>23987</MemberID>
  <Date>August 19, 2008</Date>
  <LetterBody>
    <Salutation>Dear Mr. Burnett:</Salutation>
    <Content>Please replace this</Content>
    <Postscript>Don't forget to attend our seasonal library sale on
September 20! The sale will feature books, CDs, DVDs, artwork, and
baked goods.</Postscript>
  </LetterBody>
</Letter>
```

However, Dr. Rhyme limited his presentation to an analysis of the “extreme version” of the mapped content (*i.e.*, in which the SGML tags are completely extracted from the “mapped content” storage). Thus, he alleged that the resulting metacode map would look like this:

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<sup>12</sup> The '449 Patent offers no express direction how to modify the algorithm when metacode information remains in the mapped content, but the resulting “addresses of use” could not be the same as found in the “raw content” map. Again, the Patentee admitted in the Litigation that the '449 Patent does disclose how such an embodiment would work or look. (Trial Tr., A334).



As can plainly be seen, when the metacode tags are not extracted from the text, the resulting character string is more than the 185 characters of “raw content” illustrated in the Rhyne Declaration at ¶ 64.

Based upon the Examiner’s discussion in the Denial, the three elements <LetterBody> <Salutation>, and <P> should all exert their effect beginning at the same location – character position 196. Indeed, Hesse, Fig. 2, has three consecutive start tags: <I> <O> <C>, just like the above snippet.

However, as illustrated in the Request and explained in further detail below, none of the examples of “addresses of use” have values that correspond to the Examiner’s narrow view of “exerts it effect.” Rather, the “addresses of use” in these two products refer to the location of the metacode start-tags and end-tags in the mapped content.

**a) The Pre-June 2004 Embodiment**

As the Patentee testified at trial, the alleged “addresses of use” in the “metacode map” of the Patentee’s Pre-June 2004 x4o software were nothing more than **length** fields for the character strings in the source file (Request, pp. 22-26; also Exh. 9, p. 4, below):

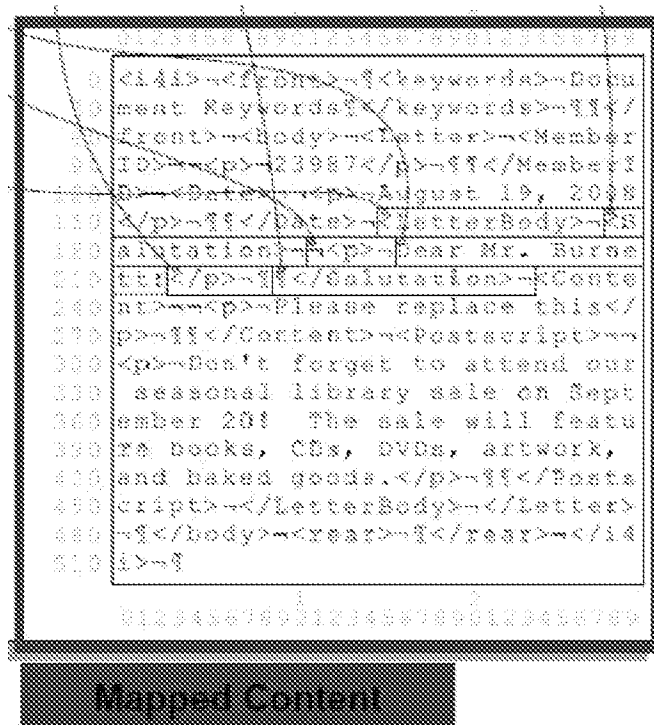
Memory Address	S4/Desktop ID	Sibling Memory Address	Child Memory Address	Type	Tag name	Length
4660	12	4cc0	46c0	Element	LetterBody	13
46c0	13	4ca0	4720	Element	Salutation	13
4720	14	4840	4780	Element	Content	7
4780	15	47e0		Content		17
47e0	14			End tag	p	6
4840	13			End tag	Salutation	13

**Metacode Map**

**x4o data structure prior to June 15, 2004 (No “offset” field)  
Durot Dep. 72:18-73:12**

The alleged “addresses of use” in this figure do not correspond to any algorithm in the ’449 Patent. Remember, the Patentee told the District Court that the ’449 Patent did not discuss embodiments other than “raw content.” (Trial Tr., A334). Certainly, these are not “absolute” character positions (i.e., relative to the start of the document). Further, these length parameters do not reconcile with the Examiner’s belief that consecutive tags will point to the same block of text. In fact, in the Patentee’s description, the length parameters segment the content as

illustrated below (reproduced from Dr. Rhyne’s trial presentation). (Request, pp. 22-26; *also* Exh. 9, p. 1, 4-6).



Plainly, the “addresses of use” do not all point to the text block “Dear Mr. Burnett:” at character position 196, and thus, the embodiment would not be within the scope of the Examiner’s interpretation of the claim.

**b) The Post-June 2004 Embodiment**

At trial, the Patentee also presented its Post-June 2004 x4o product as a commercial embodiment of the claims. (Request, pp. 22-26; Exh. 9, p. 1, 4-6). In this embodiment, the “offset” column was added as an “optimization” as Mr. Durot testified at his deposition.

x4o			
Type	Tag name	Offset	Length
Element	LetterBody	165	231
Element	Salutation	172	23
Element	p	191	7
Content		196	7
End tag	p	211	6
End tag	Salutation	212	3

**x4o data structure after June 15, 2004  
(Durot Dep. 72:18-73:12)**





Patentee's infringement allegation against Microsoft Word and even the Patentee's own products, Borgendale/Hesse would be important to any reasonable examiner in deciding the patentability of the claims. All proposed rejections citing this reference in the Request are supported by this new teaching, and re-examination should be ordered.

**B. The Examiner Erred By Ignoring The "New Light" In Which Kugimiya Was Presented In The Request.**

In the Denial, the Examiner erred by failing to consider the Patentee's repudiation of the original reasons for allowance of the claims of Kugimiya. The Patentee's repudiation places Kugimiya in a new light (*i.e.*, the claims were rejected but for the arguments that the Patentee repudiated in the Litigation, and therefore would not have been allowed).

While the Examiner recited an overview of the original prosecution he simply glossed over the reasons for allowance: "the examiner subsequently withdrew the rejection based on the applicants' response." (Denial, p. 6). He specifically did not address Requester's argument in the Request that the Patentee had repudiated all of the reasons for allowance of the claims over Kugimiya in the original prosecution. Further, he did not address at all the specifics of claim 20, which lacks claim elements that were used to distinguish (now invalid) claim 1.

As recited in the Statement of Facts (and argued in the Request), there were only two proffered reasons for the allowance of the claims that applied to claims 14 and 18: persistent storage of the metacode map and the "menu of metacodes" (with only the former applying to claim 20).

The Patentee's repudiation of these reasons for allowance in the Litigation *alone* presents Kugimiya in a new light. To hold otherwise is an open door for all patent applicants to renege on arguments made for patentability.

To the extent the Examiner has relied on a recent update the MPEP to impose a "new technological teaching" requirement, such a requirement is plainly arbitrary, capricious, and contrary to law. The revised MPEP does not cite any authority for the "new technological teaching" standard, and this revision directly conflicts with the Patent Law. 35 U.S.C. § 303(a) specifies that: "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." (Emphases added). This amendment to § 303(a) specifically overruled the case of In re Portola Packaging, 110 F.3d 786 (1997), which the Office previously had relied upon to avoid

reconsideration of “old art.” The “new technological teaching” standard conflicts with § 303(a), therefore, it is arbitrary, capricious and contrary to law.

Further, the “new technological teaching” requirement expressly conflicts with other guidance from the MPEP.

By definition, “old art” can never present a “new technological teaching” because the disclosure in the “old art” does not change over time. Indeed, § 303(a) was expressly amended to avoid the view that “old art” *by itself* could not support a reexamination.

For the reason, the MPEP states:

For example, a *substantial new question of patentability* may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier *examination(s)*, in view of a material new argument or interpretation presented in the request.

This phrase alone encompasses four separate possibilities (due to the conjunctive “or”), and none of these require a new technological teaching. For example, a substantial new question of patentability may be presented when:

1. the old art is viewed in a “new light,”
2. the old art is presented “in a different way,”
3. the old art is presented in view of a material new argument, or
4. the old art is presented in view of a material new interpretation.

In the Request, Kugimiya was presented both alone and in conjunction with other prior art (e.g., DeRose). Due to various factors, Kugimiya meets all of these factors.

First, Kugimiya is presented in a “new light,” specifically, the Patentee’s repudiation of its own arguments for patentability. As stated in the Request, the Examiner allowed the claims over Kugimiya based upon two representations by the Patentee: 1) that there the claims require “persistent storage” of the metacode map, and 2) that Kugimiya did not teach a “menu of metacodes.” (Request, p. 13-15).

However, in the Litigation, the Patentee repudiated both of these limitations: 1) the Patentee indisputably stated that “persistent storage” was NOT a requirement of the claims in the trial testimony of Mr. Vulpe and Dr. Rhyne (Request, pp. 17-19), while arguing that the SGML document type definition file (part and parcel of every SGML derived language) constitutes the “menu of metacodes” from which SGML documents are created (Request, p. 20).

This repudiation of the only reasons for the allowance of claims 14, 18 and 20 over Kugimiya constitutes the “new light” for the reconsideration of Kugmiya as a standalone reference.

The question of patentability over Kugimiya (standing alone) has never been resolved against the claims using a claim interpretation that does not require persistent storage. Thus, the Patentee’s admission *solely by reference to the Patentee’s repudiation of the “persistent storage” of the metacode map in the original prosecution* is sufficient to present Kugimiya in a new light and/or in view of a “material new interpretation.”

The Examiner did not discuss this issue in the Denial at all, other than to note that the claims had been allowed. Rather, the Examiner skipped over this issue entirely to discuss the whether the “metacode map” admission included “addresses of use.” As discussed later, the Examiner’s evaluation was also in error, but more importantly, as a threshold issue, this aspect of the Patentee’s admission is not required for a finding the Kugimiya is being presented in a “new light.”

The fact that the Patentee repudiated its arguments for patentability over Kugimiya during the course of the Litigation presents the reference in a new light.

**C. The Examiner Erred By Limiting The Patent Owner’s Admissions Regarding Metacode Map (Even Though The District Court’s Interpretation Of The Term Necessarily Includes The “Addresses Of Use” Element)**

In the Denial, the Examiner stated that the Patentee’s admission regarding “metacode map” did not raise a substantial new question of patentability as to Kugimiya because the admission did not concern the “addresses of use” element. (Denial, p. 7).

However, the alleged admissions relied upon in the request appear to be limited to a metacode map and do not go as far as a metacode map meeting the “addresses of use” requirement of the claims. Nor does the request point to a new technological teaching in *Kugimiya*, not previously

Here, the Examiner erred because the Patentee’s admission necessarily includes the “addresses of use” element. Indeed, both the District Court and the prior examiner adopted an interpretation of “metacode map” that necessarily includes “address of use.”

First, the claim construction for metacode map expressly includes the “addresses of use” element. The “addresses of use” element, while having a separate definition, is nevertheless part and parcel to the definition of “metacode map:” (Markman Order, p. 31).

2	address{es} of use  (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect
4	map of metacodes / metacode map  (claims 1, 2, 3, 5, 6, 9, 10, 12, 13, 14, 15, 16, 17, 18, 20)	a data structure that contains a plurality of metacodes and their addresses of use corresponding to a mapped content

In the ‘347 Reexam, the prior examiner left off the “of use” in his formal definition, but nevertheless, discussed DeRose and Cowan as not having “addresses of use.”<sup>13</sup>

“Map of metacodes” – A multiplicity of metacodes and their addresses associated with mapped content (‘449 Patent, col. 4 lines 7-9 and 17-19)

“Addresses of use” – A unique identifier which defines the position of a metacode relative to the mapped content stream which clearly identifies the place in the content at which the associated metacode exerts its effect (‘449 Patent, col. 4 lines 19-20 and lines 40-42, Rhyne declaration, page 15)

As detailed in the Request, Dr. Rhyne (the Patentee’s expert witness) expressly confirmed in his testimony that he had closely read the district court’s construction for “metacode map” (which plainly includes the “addresses of use” element). (Request, pp. 17-19, excerpt below).

A. [Dr. Rhyne] **It meets -- it meets the Court's construction**, but, again, the claim limitations of Claims 14 and 20 set the metacode map in a broader context.

Therefore, the Examiner plainly erred in finding that the Patentee’s admission for the metacode map did not extend to the “addresses of use.”

Second, the Patentee did not distinguish Kugimiya on the basis on the “addresses of use” element. As explained in the Request, Kugmiya plainly teaches the “addresses of use” element, and, as reiterated above, the Patentee’s admission covers this element.

<sup>13</sup> To the extent that this definition is narrower than the District Court, it is improper in view of *White* as discussed in the Request.

During the original prosecution, the Patentee distinguished Kugimiya as not teaching “persistent storage” of the metacode map. On this point, the Patentee’s repudiation of this is clear” in the claim construction sought and received from the District Court, the confirmation of the claim construction by the Federal Circuit, and the Patentee’s admission. (Request, pp. 13-19).

To the extent that the Examiner might have been willing to grant the Request on the basis of Kugimiya, but for the belief that the Patentee’s admission must also include the “addresses of use,” the Examiner does not appear to have considered that the Patentee’s admission reflected the entirety of the District Court’s construction. Based on Dr. Rhyne’s testimony, the “addresses of use” element is within the scope of the Patentee’s admission.

Thus, the Examiner erred in finding that Kugimiya was not presented in a new light.

The result of the Patentee’s admission is that Kugimiya anticipates the claims as detailed in the Request, and presents Kugimiya in view of a material new argument, specifically, the Patentee’s admission that extends to the “addresses of use.”

Accordingly, Kugimiya (standing alone) presents a substantial new question of patentability that has not been resolved in a prior examination of the ’449 Patent.

**D. The Examiner Erred By Not Considering The Combined Teaching Of Kugimiya And Deroose – A Combination That Has Never Been Previously Considered By The Patent Office**

In the Denial, the Examiner dismissed the applicability of Kugimiya, DeRose, and Borgendale/Hesse by attacking the references individually, however, the Examiner did not consider whether the combined teaching the various references, nevertheless raised a substantial new question of patentability under the proper standard. (Denial, pp. 6-10).

In the Request, Kugimiya is presented in view of other art and thus is presented in a different way and/or in view of a material new argument that it was considered in the prior prosecution (*i.e.*, in combination with other references), and the resulting combination

For example, in the Request, Kugimiya is presented in combination with DeRose to invalidate the claims. The combination of Kugimiya and DeRose has never been considered in a prior examination of the patent. In the Request, the teaching of Kugimiya responds to the arguments that were made by the Patentee in the ’347 Reexam. In contrast, the teaching of DeRose responds to the Patentee’s argument(s) that were made in the original prosecution.

Thus, the Request presents both the Kugimiya and DeRose references in a substantially different way that they have been considered in a prior examination of the '449 Patent. In fact, even if one ignores the Patentee's repudiation of its File History arguments, it is plain that the Patentee has attempted to distinguish two references for different reasons, as seen in the summary chart below for claim 14 (an "X" indicates an element that has not been distinguished by the Patentee).

Claim Language	Kugimiya : 449 FH	DeRose: 347 Reexam
14: A method for producing a first map of metacodes and their addresses of use in association with mapped content and stored in distinct map storage means, the method comprising:	X	According to Dr. Rhyne, DeRose does not teach a metacode map containing "addresses of use"
providing the mapped content to mapped content storage means;	X	X
providing a menu of metacodes; and	"We seemed to reach agreement that the reference does not teach providing a <b>menu of metacodes.</b> "	X
compiling a map of the metacodes in the distinct storage means, by locating, detecting and addressing the metacodes; and	"We seemed to reach agreement that the reference does not teach providing . . . <b>persistent storage</b> for the metacode map. <b>Claim 1</b> has been further modified to make it more clear that <u>the metacode map is persistently stored separately and distinctly from the content</u> . . . Contrast this with the Kugimiya reference which, like many other references, teaches the use of only <b>temporary storage</b> of metacodes while the program is doing its processing . . .	Dr. Rhyne again focused on the "metacode map" as having "addresses of "use"
providing the document as the content of the document and the metacode map of the document.	X	X

It is well established that a Patentee cannot overcome a rejection for obviousness by arguing against the references individually.<sup>14</sup> It makes no sense that the Examiner can refuse consideration of the combined teaching of the prior art by dismissing the prior art references individually (i.e., first dismissing Kugimiya as an individual reference in the Denial at pp. 7-8, then DeRose at pp. 8-9, etc.).

Such an outcome goes against the clear intent of Congress (which overturned the deleterious effects of *Portola Packaging*) and improperly rewards applicants/patentees: they can argue against references individually during prosecution, safe in the knowledge that the Patent Office will bar the combination of such references in a subsequent re-examination.

Accordingly, the Examiner erred by dismissing the various combinations of the prior art that were formulated by the Request, by attacking the references individually.

**E. The Examiner Erred By Accepting The Prior Examiner's Claim Interpretation And Reasons For Allowance**

In the Denial, the Examiner set forth the reasons for allowance that had been entered in the '347 Reexam, and but did not address whether the interpretation given by the examiner for the "addresses of use" in the '347 Reexam was contrary to law because it was narrower than that given by the District Court, and thus in violation of *White*.

Subsequently, he dismissed the Requester's arguments regarding DeRose as mere disagreement with the Examiner's judgment in evaluating the Rhyne Declaration.

However, the Request did not simply pose a disagreement with the prior examiner's conclusions. Rather, the 2<sup>nd</sup> Request challenged the fact that the prior examiner's reasons for allowance had been premised on the use of an improper claim interpretation that was narrower than the claim interpretation used in the District Court. (Request, pp. 39, 63). The Request further responded to the questions specifically posed by the prior examiner regarding DeRose and "addresses of use" by presenting evidence: Dr. Rhyne and the Patentee's contradictory trial testimony, the Patentee's trial testimony regarding its own embodiments and the accused product, which was not made of record during the '347 Reexam by the Patentee, and therefore

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<sup>14</sup> MPEP 2145: One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

could not have been considered by the examiner. This new evidence places the element directory of DeRose in context; if the x4o “metacode map” (a tree structure) contains “addresses of use,” then DeRose can be no different. Had the Patentee provided this information in the ’347 Reexam, then there is no reason to believe that the claims would have been allowed over DeRose.

Accordingly, the prior examiner’s evaluation could not have been made with all the facts before him, and thus, the Request does more than merely challenge his judgment.

If an examiner acts contrary to the law *in any way*, then it is perfectly acceptable to reconsider the examiner’s prior decision. Indeed, Congress created the reexamination process to allow the Patent Office to correct mistakes made previously without the need to resort to litigation. The Examiner did not address or acknowledge whether the prior examiner’s construction of the claim terms was proper in view of Supreme Court precedent. Further, the Patentee’s trial testimony regarding its allegations of infringement (and based on that broader construction) was not before the prior examiner, therefore, the prior examiner could not have considered the implications of this testimony on his analysis.

Any claim interpretation that does not comport with *White*, regardless of whether the examiner purports to use an interpretation consistent with *Philips*, *Yamamoto*, or other Federal Circuit opinion is plainly contrary to law.

Accordingly, the Examiner plainly erred by ignoring Supreme Court precedent on the issue of claim interpretation, specifically, *White v. Dunbar*, 119 U.S. 47, 51 (1886) in view of the Patentee’s infringement contentions. (*See* Rhyne14, Rhyne18).

As to the prior examiner’s evaluation of the teaching of DeRose, that examiner again did not have Dr. Rhyne’s contradictory trial testimony before him when he made his evaluation, nor did he have the testimony regarding the accused product and the Patentee’s x4o product.

In the Denial, the Examiner also appears to require a “new technological teaching” before he will consider if DeRose has been presented in a materially different way. However, he does not explain how the teaching of DeRose is substantially different from the x4o product discussed in the Request.

The Request explains that Dr. Rhyne testified that the Patentee’s own commercial products possessed “metacode maps” with “addresses of use” (*e.g.*, pp. 22-26), and none of this testimony was before the examiner in the ’347 Reexam (nor could have Requester provided this



evidence in context in that proceeding, since the trial occurred long after the 1<sup>st</sup> Request was filed). It is further explained how the teaching of DeRose is virtually indistinguishable from the Patentee's testimony regarding its commercial embodiments. This information concerning the x4o products was not considered or discussed by the prior examiner in the '347 Reexam.

Plainly, if either version of the x4o software is encompassed by the claims (the Patentee testified in the Litigation that both were) and the teaching of DeRose is insubstantially different from one or both of the x4o Products, then the claims are invalid.

It is indisputable that the Patent Office has never viewed DeRose through the lens of the Patentee's trial testimony regarding the x4o products, (which are graphically summarized in the Request, Exh. 9). Thus, Dr. Rhyne's testimony regarding x4o product places the teaching of DeRose in a new light (in part by discrediting his prior declaration but also by clarifying the scope of the claim element "addresses of use" upon which the confirmation of the claims was premised) and raises questions that have not been previously considered by the Office.

Further, the teaching of Kugimiya remedies all of the deficiencies alleged by the examiner in the '347 Reexam, and therefore, it presents DeRose in a new light as discussed above.

Finally, Borgendale/Hesse (as explained previously) plainly discloses a metacode map (including the "addresses of use") limitation that also remedies the alleged deficiencies of DeRose. This combination also provides a "new technological teaching" that invalidates the claims. Therefore, the Examiner erred, and reexamination should be ordered.

## **VII. CONCLUSION**

For the reasons above, Requester asks that the Director vacate the order denying re-examination, and that he issue and order:

- 1) that the claim interpretation used by the examiner in the prior '347 Reexam was narrower than the interpretation that the given by the District Court, and therefore was not the broadest reasonable interpretation for the claims as a matter of law,
- 2) that the prior examiner's failure to use the broadest reasonable interpretation negates the "reasons for allowance" given at the conclusion of the '347 Reexam,
- 3) that Examiner Kiss has improperly dismissed the primary references cited in the current request by considering the references individually, rather than by evaluating the individual and combined teaching for each proposed rejection set forth in the Request;

- 4) that re-examination of the 449 Patent is required because there is at least one substantial new question of patentability raised against each of claims 14, 18 and 20 by the prior art as it has been cited by the Requester in the Request; and
- 5) that re-examination be conducted in view of all available prior art as specifically directed by 37 CFR 1.550.

Respectfully submitted,

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