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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT***(Use as many sheets as necessary)***Complete if Known**

Application Number	90/009,457
Filing Date	August 24, 2009
First Named Inventor	Moore et al.
Art Unit	3992
Examiner Name	B. James Peikari
Attorney Docket Number	0081-011D3X4

Sheet 1 of 1

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	AA	U.S. Patent No. 5,809,336, as certified by Ex Parte Reexamination Certificate (7235th) U.S. 5,809,336 C1, issued December 15, 2009, 51 pages.	
	AB	90/008,474 Order Granting / Denying Request For Ex Parte Reexamination dated April 5, 2007, 12 pages.	
	AC	90/008,474 Notice of Intent to Issue Reexamination Certificate (NIRC) mailed September 11, 2009, 72 pages.	
	AD	90/008,474 Request For Ex Parte Reexamination dated January 30, 2007, 85 pages.	
	AE	In re Recreative Technologies Corp., 83 F.3d 1394, 38 USPQ 2.d 1776 (Fed. Cir. 1996), 6 pages.	

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO:****Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Ex Parte Reexamination of U.S. Patent No. 5,809,336

Applicant(s): **Moore (et al.)**

Examiner: **B. James Peikari**

Group Art Unit: **3992**

Serial No.: **90/009,457**

Attorney Docket: **0081-011D3X4**

Filed: **August 24, 2009**

Customer No.: **40972**

Title: **High Performance, Low Cost Microprocessor Architecture**

MS Ex Parte Reexamination

Central Reexamination Unit

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL FOR INFORMATION DISCLOSURE STATEMENT

Enclosed for filing in the above-referenced application are the following:

1. Information Disclosure Statement (9 pages);
2. Forms PTO/SB/08B (1 page);
3. 5 non-United States patent cited references; and
4. Certification of Service (1 page).

Respectfully Submitted,

March 2, 2010

/Larry E. Henneman, Jr./

Date: _____

Larry E. Henneman, Jr., Reg. No. 41,063

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office on the date shown below via EFS-Web.

March 2, 2010

/Larry E. Henneman, Jr./

Date: _____

Larry E. Henneman, Jr.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reexamination of:

U.S. Patent No.: 5,809,336

Reexamination Control No.: 90/009,457
Filed: August 24, 2009For: HIGH PERFORMANCE
MICROPROCESSOR HAVING
VARIABLE SPEED SYSTEM CLOCK

Customer No.: 40972

Examiner: B. James Peikari

Art Unit: 3992

INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98Mail Stop Ex Parte Reexamination
Central Reexamination Unit
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

In accordance with 37 C.F.R. § 1.555, the references cited on the attached forms PTO/SB/08A and PTO/SB/08B and are being called to the attention of the Examiner. Copies of references A - E in compliance with the requirements of 37 CFR §1.98(a)(2) are enclosed.

Related Reexamination Proceedings

In accordance with 37 CFR 1.565(a), Applicants provide the following list of reexamination proceedings involving one or more applications in the family of applications that includes the instant application:

- (1) Control No. 90/008,237, filed November 17, 2006, of U.S. Pat. No. 5,809,336. Reexamination certificate issued December 15, 2009.
- (2) Control No. 90/008,306, filed October 19, 2006, of U.S. Pat. No. 5,809,336. Reexamination certificate issued December 15, 2009.

(3) Control No. 90/008,474, filed January 30, 2007, of U.S. Pat. No. 5,809,336.
Reexamination certificate issued December 15, 2009.

(4) Control No. 90/010,551, filed May 26, 2009, of U.S. Pat. No. 5,809,336.
Request for Ex Parte Reexamination denied July 31, 2009.

RELEVANCE OF REFERENCES

Currently, there is no finding of a substantial new question of patentability (SNQ) with respect to any claims of U.S. Patent No. 5,809,336, as certified by Ex Parte Reexamination Certificate (7235th) U.S. 5,809,336 C1, issued December 15, 2009. The references cited herein are relevant, because they preclude a finding of a SNQ with respect to the current claims.

Issues of patentability that have already been decided by the Office cannot be the basis of a substantial new question of patentability.

The statutory instruction that a new question of patentability must be raised is explicit in 35 U.S.C. §303. Reexamination is barred for questions of patentability that were decided in the original examination. In re Recreative Technologies Corp., 83 F.3d 1394 (RefAE).

However, the issues raised in the pending Reexamination Request *have already been decided* in previous merged reexamination proceedings Control No. 90/008,237; Control No. 90/008,306; and Control No. 90/008,474. As will be discussed, the primary references forming the basis of the present reexamination order, Mostek, Dozier and Richter, were not only before the examiner in the merged reexaminations, but one of the references, Mostek, was a primary reference forming the basis for the reexamination order in Control No. 90/008,474. The alleged “substantial new issue,” an independent I/O clock allegedly found in Mostek, Dozier and Richter but not in the references

considered by the examiner in the merged reexamination, was specifically cited as a basis for the reexamination order in the aforesaid Control No. 90/008,474 proceeding when the examiner therein ordered reexamination of US'336 over Mostek.

The Fish & Richardson request of August 24, 2009 was a refiled request. The first request, filed on April 29, 2009, was vacated because the request failed to point out a substantial new question of patentability regarding Mostek, Richter and Dozier that was not of issue in the merged reexamination proceedings. The August 24, 2009, refiled request did not point out any new issue that was not before the examiner in the merged reexamination. Therefore, the presently cited references are relevant because they show that no substantial new question of patentability exists with respect to any claim in US 5,809,336 C1.

The record in more detail.

On November 14, 2009, in this present reexamination proceeding, the Director ordered re-examination of the original claims 1-10 of US patent number 5,809,336. The order was based upon a substantial new question of patentability of the original claims 1-10 in light of Mostek, Dozier and Richter, but only in light of the prosecution of the original patent in which these references were not of record. The prosecution histories of the co-pending reexamination proceedings were not considered. The order was based upon a request filed by Fish & Richardson (Minneapolis, attorney docket number 24567-0002RX1) in this present reexamination proceeding on August 24, 2009.

On December 15, 2009, the Director issued a re-examination certificate, US 5,809,336 C1 (cited Ref. AA), declaring independent claims 1, 6 and 10 patentable as amended,

dependent claims 2, 7 and 9 patentable as dependent claims, and new claims 11-16 to be patentable.

Claims 3-5 and 8 were canceled. The re-examination certificate was based upon a “merged re-examination” involving Control No. 90/008,306, filed October 19, 2006; Control No. 90/008,237, filed November 17, 2006; and Control No. 90/008,474, filed January 30, 2007.

The primary reference of control number 90/008,474, was the Mostek reference.

See the Reexamination Request filed January 30, 2007 (cited Ref. AD) It formed the basis for the order of re-examination (Ref. AB) mailed April 5, 2007. The Dozier and Richter references were also of record in the merged re-examination proceedings. They were cited by IDS and listed in the re-examination certificate. (Dozier, IDS dated 5/8/2008 and Richter IDS dated 5/13/09.) These references were considered by the examiner, as indicated by the initialed pages attached to the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed September 11, 2009 (cited Ref. AC).

When the Examiner issued the NIRC in the merged reexamination, the examiner was aware of and considered the Fish & Richardson reexamination request of this present reexamination proceeding, which was originally filed on April 29, 2009. See, below (listed as Cite No. D).

PTO/SB/PA/AB (02-08)

Substitute for form 1449P/TO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Application Number	80/008,237, 80/008,306, & 80/008,474
		Filing Date	Nov. 17, 2006, Oct. 19, 2006, & Jan. 30, 2007
		First Named Inventor	
		Art Unit	3952
		Examiner Name	Sam Rimell
Sheet 1 of 1	Attorney Docket Number	0081-01103X2	

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number <small>Number and Date if known</small>	Publication Date <small>MM-DD-YYYY</small>	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document <small>Country Code² Number³ Kind Code⁴ if known</small>	Publication Date <small>MM-DD-YYYY</small>	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁵

NON PATENT LITERATURE DOCUMENTS						
Examiner Initials *	Cite No. ¹	include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.				T ²
<i>h</i>	A	Intel 80386 Programmer's Reference Manual, published by Intel (1986)				
<i>h</i>	B	Fairchild Microcomputers, F83870, F8800, Bit Slice, IC Master 1980, pages 1, 2016-2040 (1980).				
<i>h</i>	C	Mostek Corp., "Mostek 1981 9875F8 Microcomputer Data Book", February 1981, pp. III-76 through III-77, III-100 through III-124, and VI-1 through VI-11.				
<i>h</i>	D	80-066,467 Request for Reexamination dated 04-24-2009, 66 pages				
<i>h</i>	E	80-010,551 Request for Reexamination dated 06-29-2009, 36 pages				
<i>h</i>	F	80-010,520 Request for Reexamination dated 01-29-2009, 106 pages				
<i>h</i>	G	80-010,562 Request for Reexamination dated 05-29-2009, 62 pages				

Examiner Signature	<i>h</i>	Date Considered	7/10/09
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EXAMINER: Initial reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.
¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

** NOT A PATENT OR PRINTED PUBLICATION*

That request, among other things, argued the unpatentability of what are now claims 11-16 over Mostek, Dozier and Richter. Fish & Richardson reexamination request, 4/24/09, Control No.

90/009,457, at 6-7, 62-63 and 87, respectively. The office vacated *sua sponte* the Fish & Richardson request because the office found that , among other reasons, it had not pointed out a substantial new question of patentability in view of the Mostek and other references (with respect to claims 1-10) that were not already being considered or that were cumulative with the issues being considered in the then pending merged reexamination.

In other words, the examiner stated that the prior art references, including Mostek, have been considered, but are not applied because they recite teachings which otherwise already exist, i.e., which are *cumulative*, to the prior art of record. Mostek, therefore, is a *cumulative* technological teaching that was *considered and discussed* on the record during the prosecution of a prior proceeding involving the patent for which reexamination is requested. The requester has failed to explain, for example, what new technological teaching, that is specifically found in Mostek , and that was not considered or discussed in the prosecution of the prior proceeding, is currently being raised as the basis for the substantial new question of patentability (SNQ). The requester has also failed to explain how the Mostek reference is presented in a new light, or in a different way, than was presented in the prosecution of the prior proceeding.³

Decision to vacate, 07/23/09, Control No. 90/009,457, at 4.

Fish & Richardson refiled their request on August 24, 2009. They argued that their request was not “cumulative” of the issues in the pending merged reexamination. They argued, for example, that Kato, the reference used by the examiner in his rejections in the merged reexamination, did not have certain features that Mostek did have, namely, an independent I/O clock. See the Aug. 24, 2009, request at 11. But the very same “missing feature” was argued in the original reexamination request of Jan. 30, 2007, by requestor Public Patent Foundation (cited Ref. AD):

- (e) *and a second clock independent of said ring oscillator variable speed system clock connected to said input/output interface.*

As discussed in section B(1)(e) above, the on-chip input/output interface is connected to and clocked by a second, external clock, and it is inherent that the external clock is independent of the on-chip system clock.

Because every element of claim 1 is disclosed expressly or inherently in *Mostek*, or would have been obvious to one of ordinary skill in the art in 1989, claim 1 is unpatentable. The claim

Public Patent Foundation Reexamination Request of Jan. 30, 2007, Control No. 90/008,474, at 30

The examiner of reexamination Control No. 90/008,474 proceeding ordered reexamination based, in part, on this allegedly “missing feature.”

parameters associated with said integrated circuit substrate. Further *Mostek* can be interpreted as teaching of an on-chip input/output interface [see page III-105], and an external clock, independent of said oscillator, connected to the input/output interface [see pages III-114 and III-115].

Reexamination order, Control No. 90/008,474 (cited Ref. AB), 04/05/07, at 5.

The Fish & Richardson Aug. 24, 2009, “refile” in this present reexamination proceeding also argued that Dozier and Richter were not cumulative because they were not of record at all in the merged reexamination. Refile at 16 and 17. However, at the time of this statement, both references were of record via IDS, one filed in 2008, more than a year earlier. But more importantly, the refile argued that these references were not cumulative because they allegedly showed the same feature that they asserted made *Mostek* non cumulative, namely, a second, independent, I/O clock.

clock is not based on a clock signal received from the first clock. As described above, none of the Magar, Kato, or Ledzious references teaches this functionality of a second clock connected to an I/O port that is completely independent of a system clock.

Refile, at 16.

Clearly, Dozier and Richter were of record in the merged reexamination and are cumulative of Mostek. None present any substantial new question of patentability that, as the presently cited references show, was not considered during the merged reexamination.

The examiner of the merged reexamination proceedings issued a NIRC (cited Ref. AC) on Sept. 11, 2009, three weeks after the Fish & Richardson refile. The examiner was aware of the Fish & Richardson arguments concerning Mostek, Dozier and Richter, because those arguments were disclosed to the Examiner in the above cited IDS. The NIRC confirmed the patentability of both claims 11-16, which had specifically been addressed in the Fish & Richardson reexamination request, and the amended claims 1, 2, 6, 7, 9 and 10, over Mostek, Dozier and Richter.

In summary, the presently cited references are relevant because they show that the issue of patentability of the current claims in view of Mostek, Dozier and Richter has already been decided during the previous prosecution of these claims. The prosecution of the present Reexamination Control No. 90/009,457 was cited to the Examiner in the merged reexamination proceedings, the Examiner considered the patentability of all of the current claims in view of Mostek, Dozier and Richter, and the Examiner confirmed the patentability of all of the current claims over Mostek, Dozier and Richter by issuing Reexamination Certificate U.S. 5,809,336 C1.

As provided for by 37 CFR §1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement.

March 2, 2010

Respectfully submitted,

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