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Fish & Richardson, P.C.
60 South Street
Minneapolis, MN 55402

In re *Moore et al.*
Reexamination Proceeding
Control No. 90/009,591
Filed: October 2, 2009
For: U.S. Patent No. 5,784,584

:
: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 4, 2009, styled as "PETITION TO RECONSIDER ORDER DENYING REQUEST FO EX PARTE REEXAMINATION", filed pursuant to 37 CFR 1.181 and 515(c), is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,784,584 (hereinafter, the '584 patent) issued on July 21, 1998.
2. On October 2, 2009, the third party requester deposited a request for *ex parte* reexamination for claim 29 of the '584 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,591 (hereinafter, the '591 proceeding).
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4. On December 4, 2009, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claim 29 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claim 29 of the '584 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability (SNQ) exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,¹ Congress stated:

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efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application.** H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462.” [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office’s conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.² Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be “presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.”^{3,4} This new light must be in terms of how to interpret the state of the “pre-existing technology,” as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a “new light” if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

As previously mentioned, the CRU Director’s review of the reexamination request on petition is *de novo* review of the request dated October 2, 2009.⁵

² This requirement is not applicable to Director ordered reexaminations.

³ See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

⁴ For additional discussion regarding technical teachings viewed “in a new light, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368, 1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

⁵ It is noted that the denial of reexamination in the ‘591 proceedings uses language that echoes the reasoning of *In re Portola*, 110 F.3d 786 (CAFC 1997). However, the 2002 amendments to 35 USC 303(a) indicate that consideration of a reference in a prior prosecution does not necessarily foreclose use of that reference in a later reexamination. To the extent that the denial suggests that a reference initialed by an examiner on an Information Disclosure Statement is presumed to have been fully considered in all aspects, that is an incorrect statement of the law.

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A review of the request reveals that a substantial new question of patentability affecting Claim 29 of United States Patent Number 5,784,584 is raised by the request for reexamination.

Patent '584 Reexamination History

Claim 29 of the '584 patent was previously reexamined in a merged proceeding associated with control numbers 90/008,225 and 90/008,299. An Ex Parte Reexamination Certificate issued on July 21, 2009, determining that claim 29 was patentable as amended. Claim 29 reads, 29. In a microprocessor system including a central processing unit, memory, and an instruction register, a method for providing instructions and literal operands from said memory to said central processing unit comprising the steps of:

providing instruction groups to said instruction register from said memory;
wherein said instruction register is connected to circuits that decode instructions;
wherein each of said instruction groups is structured to comprise a set of locations, including a first location, that contain either instructions or operands or both, said operands comprising either literal operands or variable-length address operands, and said instructions including opcode bits or both opcode bits and address selection bits but not including variable-length address operands; and further

wherein certain of said instruction groups include at least one instruction that, when executed, causes an access to an instruction, or to a literal operand and an instruction, said accessed literal operand or said accessed instruction being located at a predetermined position from a boundary of said instruction groups, said accessed instruction positioned at only the first location of an instruction group;

decoding said at least one instruction to determine at least said predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction;

locating at least said predetermined position; and

supplying said accessed instruction, or said accessed literal operand and said accessed instruction, from said instruction groups to said central processing unit, using at least said predetermined position.

In the Notice of Intent to Issue a Reexamination Certificate, the examiner concluded that, "[T]he prior art of record fails to disclose among other limitations at least the limitation of 'said accessed instruction positioned at only the first location of an instruction group,' and 'predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction.'" (NIRC, 04/21/2009, p. 5.)

Analysis of the Request

The requester has asserted that the following references present new, non-cumulative technical teachings that are not present in any prior art of record, (Request at 7):

- (1) MC68020 32-Bit Microprocessor User's Manual, Motorola, Prentice-Hall, 1984 ("the Motorola reference"); and
- (2) U.S. Pat. No. 5,134,701 to Mueller et al. ("the Mueller reference").

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Although the Motorola reference appears to be substantially identical to a reference cited in the IDS filed April 8, 2008, in the previous merged reexamination proceeding for the '584 patent, the previously-cited version of the Motorola reference was neither applied in a rejection or specifically discussed on the record by the examiner.

The Motorola reference, as presented by the request, raises a substantial new question of patentability.

The request indicates that Requester considers that a substantial new question of patentability is raised as to claim 29 based on the Motorola reference.

Specifically, the requester asserts that the Motorola reference anticipates claim 29, including the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction."

The Motorola reference teaches a long word (32-bits) instruction group in which an instruction may be either in a first location, i.e., on the even word boundary (also known as the long word boundary) or in a second location, i.e., on the odd word boundary. See Motorola at pp. 5-10 and 9-1. Further, the Motorola reference teaches a branch instruction which causes the processor to access an instruction group containing a branch target that may be either in a first location (on an even word boundary) or a second location (on an odd word boundary). See Motorola at p. 9-1. In particular, when the branch target is on an odd word boundary, the prefetched long word will contain first a word that does not contain the branch target followed by a word that does contain the branch target. *Id.* When the branch target is on an even word boundary, the prefetched long word will contain the branch target and either a subsequent instruction or an extension word associated with the branch target instruction. Motorola at pp. 9-1, 2-4. Under the broadest reasonable interpretation, an instruction in the first location of the 32-bit instruction group may be considered "accessed" by a branch operation regardless of whether it is the branch target. Because the Motorola reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Motorola reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Motorola reference provides an independent basis for raising a substantial new question of patentability.

The Mueller Reference, as presented by the request, raises a substantial new question of patentability.

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The request further indicates that Requester considers that a substantial new question of patentability is raised as to claim 29 based on the Mueller reference.

Specifically, the requester asserts that the Mueller reference anticipates claim 29, including the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction."

The cited teachings in the Mueller reference illustrate the same principles associated with the operation of the MC68020 microprocessor as taught by the Motorola reference (discussed above). Specifically, Mueller teaches that the MC68020 microprocessor is, "An example of a processor that retrieves a plurality of instructions on every instruction fetch cycle." Mueller at col. 4, lines 3-5. "[W]hen a jump operation such as 'JMP (a0)' instruction occurs, thirty-two bits of instruction are fetched from the designated address." Id. at col. 4, lines 11-13. "In the case of the MC68020 processor, either the upper sixteen bits [i.e., the second location,] or the lower sixteen bits [i.e., the first location,] of the thirty-two bit word that is retrieved is the instruction that processor 104 will continue execution with." Id. at col. 4, lines 39-42. Similarly to the BRA instruction of the Motorola reference discussed above, either location may reasonably be considered "accessed" by the jump operation of Mueller, regardless of whether it is the jump target.

Because the Mueller reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Mueller reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Mueller reference provides an independent basis for raising a substantial new question of patentability.

Conclusion

Because it is agreed that Motorola and Meuller raise a SNQ with respect to claim 29 of the '584 patent, the Petition is GRANTED. No other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

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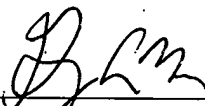
2. Accordingly, the request for *ex parte* reexamination of claim 29 of the '584 patent is GRANTED, and reexamination is hereby ordered.
3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.
4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed under 37 CFR 1.530 by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248.

For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

Where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

5. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449, or in her absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director
Central Reexamination Unit



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- wherein said instruction register is connected to circuits that decode instructions;
- wherein each of said instruction groups is structured to comprise a set of locations, including a first location, that contain either instructions or operands or both, said operands comprising either literal operands or variable-length address operands, and said instructions including opcode bits or both opcode bits and address selection bits but not including variable-length address operands; and further

- wherein certain of said instruction groups include at least one instruction that, when executed, causes an access to an instruction, or to a literal operand and an instruction, said accessed literal operand or said accessed instruction being located at a predetermined position from a boundary of said instruction groups, said accessed instruction positioned at only the first location of an instruction group;

- decoding said at least one instruction to determine at least said predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction;

- locating at least said predetermined position; and
- supplying said accessed instruction, or said accessed literal operand and said accessed instruction, from said instruction groups to said central processing unit, using at least said predetermined position.

In the Notice of Intent to Issue a Reexamination Certificate, the examiner concluded that, "[T]he prior art of record fails to disclose among other limitations at least the limitation of 'said accessed instruction positioned at only the first location of an instruction group,' and 'predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction.'" (NIRC, 04/21/2009, p. 5.)

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The request further indicates that Requester considers that a substantial new question of patentability is raised as to claim 29 based on the Mueller reference.

Specifically, the requester asserts that the Mueller reference anticipates claim 29, including the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction."

The cited teachings in the Mueller reference illustrate the same principles associated with the operation of the MC68020 microprocessor as taught by the Motorola reference (discussed above). Specifically, Mueller teaches that the MC68020 microprocessor is, "An example of a processor that retrieves a plurality of instructions on every instruction fetch cycle." Mueller at col. 4, lines 3-5. "[W]hen a jump operation such as 'JMP (a0)' instruction occurs, thirty-two bits of instruction are fetched from the designated address." Id. at col. 4, lines 11-13. "In the case of the MC68020 processor, either the upper sixteen bits [i.e., the second location,] or the lower sixteen bits [i.e., the first location,] of the thirty-two bit word that is retrieved is the instruction that processor 104 will continue execution with." Id. at col. 4, lines 39-42. Similarly to the BRA instruction of the Motorola reference discussed above, either location may reasonably be considered "accessed" by the jump operation of Mueller, regardless of whether it is the jump target.

Because the Mueller reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Mueller reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Mueller reference provides an independent basis for raising a substantial new question of patentability.

Conclusion

Because it is agreed that Motorola and Meuller raise a SNQ with respect to claim 29 of the '584 patent, the Petition is GRANTED. No other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

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2. Accordingly, the request for *ex parte* reexamination of claim 29 of the '584 patent is GRANTED, and reexamination is hereby ordered.
3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

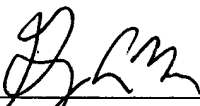
4. RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed under 37 CFR 1.530 by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248.

For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

Where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

5. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449, or in her absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director
Central Reexamination Unit

Attorney Docket No.: 24567-0002RX4

OFFICIAL COMMUNICATION FACSIMILE:

OFFICIAL FAX NO: (571) 273-9900

Number of pages including this page 12

In re Moore, et al.
Reexamination Proceeding
Control No. : 90/009,591
For: U.S. Patent No. 5,784,584

Art Unit : 3992
Examiner : Eric B. Kiss

ATTN: EXAMINER ERIC B. KISS
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

A Petition to Reconsider Order Denying Request for Ex Parte Reexamination dated
December 4, 2009 is attached.

Respectfully submitted,

Date: December 4, 2009

/Greg H. Gardella/
Greg H. Gardella
Reg. No. 46,045

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Moore, et al.)	
Reexamination Proceeding)	
Control No.: 90/009,591)	Examiner: Eric B. Kiss
Filed: Oct. 2, 2009)	Art Unit: 3992
For: U.S. Patent No. 5,784,584)	

Central Reexamination Unit
571-272-7705

PETITION TO RECONSIDER
ORDER DENYING REQUEST FOR EX PARTE REEXAMINATION

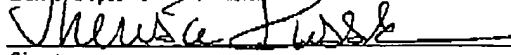
Pursuant to 37 C.F.R. §§ 1.181 and 1.515(c), Requester petitions for reconsideration of the order dated November 4, 2009 denying the request for *ex parte* reexamination of U.S. 5,784,584.

CERTIFICATE OF MAILING BY FACSIMILE TRANSMISSION

I hereby certify under 37 CFR §1.8(a) that this correspondence is being transmitted by facsimile in accordance with 37 CFR § 1.6(d) on the date indicated below.

December 4, 2009

Date of Deposit or Transmission



Signature

Theresa Russek

Typed or Printed Name of Person Signing Certificate

I. INTRODUCTION

A Request was filed on October 2, 2009 relying upon teachings of a reference cited during prior reexamination of the patent for which reexamination is requested, but presenting that reference in a "new light" in accordance with MPEP 2242. The Office denied the Request on the basis that the 1984 Motorola User's Manual (on which the Request is chiefly based) is cumulative of the 1985 Motorola User's Manual that was cited in an IDS during the previous reexamination. Requester does not dispute that the two User's Manuals are probably identical in relevant respect, however, neither the examiner nor the patent owner identified or referenced any portion of the 440 page document that might be relevant to the claim at issue, much less was any portion of either document used in making a claim rejection. In fact, the only specific reference to the Motorola User's Manual – other than the Form 1449 itself – is within another document cited as a reference in an IDS. However, the other document does not cite or discuss the portions or teachings of the Motorola User's Manual that are relied upon to establish an SNQ in this case.

The questions that were first raised by the Request based on these teachings were not only omitted from prior prosecution, they were clearly substantial. In fact, the Request identifies two pages of the Motorola User's Manual that themselves raise substantial questions of patentability for the claimed subject matter, and the Request carefully maps the teachings of those pages to the claimed subject matter. (See pages 18-22 of the Request) As such, this presentation concerning the Motorola reference necessarily satisfies the standard set forth at MPEP 2242: "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." Stated another way, because the 440 page Motorola reference was not specifically considered during the prior reexamination proceeding and the relevant portions of the manual were nowhere cited in the record, the Request *a priori* presents the reference in a "different way as compared with its use in the earlier reexamination." To conclude otherwise would run counter to the clear holding of *Swanson* to the effect that the 2002 amendment to 35 U.S.C. § 303(a) "removes the focus of the new question inquiry from whether the reference

was previously considered, and returns it to whether the particular question of patentability presented by the reference in reexamination was previously evaluated by the PTO." *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008)

Requester notes that the request for reexamination established a substantial new question of patentability even under the more stringent standard that existed prior to the 2002 amendment. MPEP 2258.01 specifies that under this stricter standard "the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form PTO/SB/08A or 08B, or PTO/SB/42... [g]eneralized statements such as the prior art is 'cited to show the state of the art,' 'cited to show the background of the invention,' or 'cited of interest' would not preclude reexamination." Here, the Motorola reference was merely cited and not further discussed or mentioned in any way by the examiner. Accordingly, the Request's detailed arguments concerning the specific teachings from two new pages embedded within the 440 page Motorola reference could not have been properly disregarded as cumulative even under the old *Portola Packaging* test.

II. PROCEDURAL HISTORY

1. On September 21, 2006, a first Request for *Ex Parte* Reexamination under 35 U.S.C. § 302 and 37 C.F.R. § 1.510 of the '584 patent was filed (control no. 90/008,225).
2. On October 19, 2006, a second Request for *Ex Parte* Reexamination under 35 U.S.C. § 302 and 37 C.F.R. § 1.510 of the '584 patent was filed (control no. 90/008,299).
3. On July 1, 2009, a Reexamination Certificate was issued for the resulting merged reexamination proceedings.
4. On October 2, 2009, Requester filed a Request for *Ex Parte* Reexamination under 35 U.S.C. § 302 and 37 C.F.R. § 1.510 for amended claim 29 of the '584 patent.
5. On November 4, 2009, the Examiner issued an Order Denying Request for *Ex Parte* Reexamination.
6. The present petition seeks reconsideration and reversal of that order.

III. THE APPLICABLE STANDARDS

According to MPEP 2216 a "substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination." The key question, therefore, is whether the reference cited in the earlier proceeding is presented in a "new light or different way" in the later request.

The MPEP further provides that the initialing of a Form 1449 signifies only that the examiner considered the document in the same manner as any other document found during a search. MPEP 609 paragraph 7, specifies that "[c]onsideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search." This is consistent with MPEP 2258.01, which provides that "the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a form PTO/SB/08A or 08B, or PTO/SB/42."

Recent actions issued by the Central Reexamination Unit expound on this standard by explaining that only "cursory review" is given references where no explanation of relevance is provided. In one recent action, the Office explained that

the requisite degree of consideration to be given to [IDS submissions] will be limited by the degree to which the patent owner has explained the content and relevance of the information. In instances where no explanation of citations (items of information) is required and none is provided for an information citation, only a cursory review of that information is required. The examiner need only perform a cursory evaluation of each unexplained item of information, to the extent he/she needs in order to determine whether he/she will evaluate the item further. If cursory evaluation reveals the item not to be useful, the examiner may simply stop looking at it. This review may often take the form of considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner, in this proceeding, placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent, without an indication in the record to the contrary, do not signify that the information has been considered by the examiner any

further than to the extent noted above.”

(Emphasis in original).

Furthermore, the Federal Circuit’s holding in *Swanson* makes clear that the 2002 amendment to 35 U.S.C. § 303(a) “removes the focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability presented by the reference in reexamination was previously evaluated by the PTO.” *In re Swanson*, 540 F.3d at 1380. *Swanson* further holds that “under 303(a) as amended, a reference may present a substantial new question even if the examiner considered or cited a reference for one purpose in earlier proceedings.” *Id.* Therefore, in addressing whether an SNQ has been established where the art alleged to establish an SNQ was of record during original prosecution, “the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose.” *Id.*

Additionally, even under the stricter standard that existed prior to November 2, 2002 in compliance with the *Portola Packaging* decision, it was not presumed that a prior art reference cited in an IDS was actually relied upon unless there was some specific basis in the written record to conclude otherwise. MPEP 2258.01 provides that “the Office cannot presume that a prior art reference was previously relied upon or discussed in a prior Office proceeding if there is no basis in the written record to so conclude other than the examiner’s initials or a check mark on a form PTO/SB/08A or 08B, or PTO/SB/42... [g]eneralized statements such as the prior art is ‘cited to show the state of the art,’ ‘cited to show the background of the invention,’ or ‘cited of interest’ would not preclude reexamination.” Even under the previous *Portola Packaging* standard reexamination would not be precluded merely by previous citation of a reference in an information disclosure statement. (See also *OG Notices dated July 1, 2003*)

IV. THE RELEVANT PORTIONS OF THE MOTOROLA REFERENCE WERE NOT PREVIOUSLY CITED OR DISCUSSED

The 1985 Motorola reference was cited along with approximately 70 other references in an IDS submitted by the patent owner on April 8, 2008 during the previous merged reexamination. However, the patent owner did not indicate that the Motorola reference was believed to be relevant. The only document in the record that even mentions the voluminous Motorola reference is one of over 300 documents that were cited in information disclosure statements: a copy of the request for reexamination of U.S. Patent 5,440,749, the parent to the '584 patent. (*Document AZ of IDS submitted April 8, 2008*) That other request for reexamination (hereinafter the "Other Request") discussed different sections of the 1985 Motorola reference which are not relevant to the subject matter recited in claim 29 of the '584 patent. More particularly, the sections of the Motorola manual that are referenced in the Other Request deal with the size of the MC68020 data bus, connections to external devices, dual instruction fetches, and program stacks. (*See Other Request at pages 37-38*) However, the sections of the 1985 Motorola reference relevant to claim 29 of the '584 patent – the sections discussing how dual instruction fetches always occur at an even word address – were not referenced in the Other Request. The teachings concerning dual instruction fetches that occur at an even word address are found at pages 5-14 and 5-10 of the Motorola reference, which are not cited or discussed anywhere in the record. Accordingly, even if the examiner were (improperly) presumed to have carefully read through the Other Request in its entirety (contrary to the standards described above by the USPTO) one could not reasonably conclude that the examiner was alerted to the teachings of the Motorola User's Manual that are relied upon in the instant Request. *See Swanson at 1381* (holding that the "presumption that the [original] examiner had properly discharged his duties and thus had considered all question of patentability raised by any reference before him.") The 440 page Motorola reference was one of over 300 references cited in various IDSs submitted by the Patent Owner and the record contains no indication whatsoever that the examiner had any reason to appreciate the relevance of the specific teachings of the particular passages found at pages 5-10 and 5-14. (*See Request at pages 18-22*)

V. THE MOTOROLA REFERENCE IS PRESENTED IN A NEW LIGHT AND ESTABLISHES A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The Motorola reference is presented in a new light in the request for *ex parte* reexamination of the '584 patent filed October 2, 2009 (control No. 90/009,591) and therefore establishes a substantial new question of patentability since neither the 1984 or 1985 Motorola references had been properly considered by the examiner during the previous merged reexamination proceeding. MPEP 2216 recites: "[t]he substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination." Being as sections of the 1984 Motorola reference which had not been previously considered, addressed, or cited were used to establish unpatentability of amended claim 29 of the '584 patent, the 1984 Motorola reference has been presented in a new light that escaped review during earlier examination and therefore establishes an SNQ.

During the previous merged reexamination proceedings, the Examiner allowed amended claim 29 because "the prior art o[f] record fails to disclose among other limitations at least the limitation of 'said accessed instruction positioned at only the first location of an instruction group.'" (*See Request at pages 1, 7*) In other words, claim 29 was allowed because it was amended to describe an instruction that, when executed, causes an access to a second instruction, where the second instruction is always located at the same position within an instruction group. (*See Request at page 1*) This precise functionality is taught by sections of the 1984 Motorola reference that had not been previously considered or addressed. (*See Request pages 1-2, 16-22*) Motorola discloses a "Branch Always" (BRA) instruction, which when executed causes the system to access an instruction that is part of an instruction group. (*1984 Motorola, pg. B-47*) Furthermore, the accessed instruction is always located in the first location in a set of two locations in the instruction group. (*Id, pg. 5-14*). Additionally, "[t]able 5-5 shows that the processor always prefetches instructions by reading two words from a long word boundary. When the MC68020 prefetches from the instruction stream, it always reads a long word from an even word address (A1/A0=00), regardless of port size or alignment." (*Id, pg.*

5-14). "Note that instructions, and their associated (if any) extension words, are required to fall on word address boundaries" (*Id*, pg. 5-10)

The teachings found on pages 5-14 and 5-10 of the 1984 Motorola reference disclose exactly the functionality thought to be missing from the prior art and therefore are used as a basis for establishing an SNQ of amended claim 29 of the '584 patent. (*See Request pages 1-2, 16-23*) Requester submits that since these sections were not considered or addressed by the examiner during the previous merged reexamination proceeding, the Motorola reference has been presented "in a new light or a different way that escaped review during earlier examination" and therefore establishes a substantial new question of patentability for amended claim 29.

VI. THE MUELLER REFERENCE ALSO ESTABLISHES A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The Mueller reference (U.S. 5,134,701) is not cumulative of previously considered prior art and therefore provides a proper basis for an SNQ. As described above, the relevant portions of the 1985 Motorola reference were not specifically considered or addressed in the previous merged reexamination proceedings for the '584 patent. Requester submits that since those portions of the 1985 Motorola reference which are most relevant to the patentability of amended claim 29 were not previously considered, the portions of the Mueller reference which teach that a two word instruction group is always fetched beginning at a long word boundary cannot properly be disregarded on the basis that they are cumulative of the Motorola reference. (*See order denying reexamination at 5*) As explained in the Request at pages 23-27, the Mueller reference anticipates claim 29 of the '584 patent. The Office should grant the instant petition for reconsideration for this additional, separate and independent reason.

VII. PATENT OWNER STATEMENTS ARE NOT USED TO ESTABLISH A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The Motorola and Mueller references anticipate amended claim 29 under 35 U.S.C. § 102(b) and 35 U.S.C. § 102(e) respectively when viewed alone and the Request does not rely on statements made by the Patent Owner in order to establish an SNQ. As detailed in the request for *ex parte* reexamination filed October 2, 2009, both references fully anticipate each element of amended claim 29. (See *Request pages 18-27*) Statements made by the patent owner during license negotiations were simply presented as evidence that one presumably skilled in the art – the patent owner – does in fact consider the architecture taught in the Motorola and Mueller references to fall within the ambit of amended claim 29. (See *Request pages 22, 26*) However, the Request clearly explains that the references create substantial new questions of patentability independent of any position taken by the patent owner. (See *Request pages 1-3, 18-27*)

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VIII. CONCLUSION

Because the relevant teachings of the Motorola reference and the Mueller reference were not considered during the previous merged reexamination proceeding, the Requester asks that the Order Denying *Ex Parte* Reexamination of the '584 patent be reversed and the reexamination request be granted.

The Director is authorized to charge any fees or credit any overpayments to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12/4/09

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