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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,591	10/02/2009	5,784,584	24567-0002RX4	8118
40972	7590	11/04/2009	EXAMINER	
HENNEMAN & ASSOCIATES, PLC 70 N. MAIN ST. THREE RIVERS, MI 49093			ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,591.

PATENT NO. 5,784,584.

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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/009,591	Patent Under Reexamination 5,784,584	
	Examiner ERIC B. KISS	Art Unit 3992	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 02 October 2009 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: PTO-1449

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. 061050, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/Eric B. Kiss/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

DECISION DENYING EX PARTE REEXAMINATION

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

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.

On April 8, 2008, during the previous reexamination of the '584 patent, an Information Disclosure Statement was filed, citing among other documents, Motorola MC680202 32-bit

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Microprocessor User's Manual, 2nd Edition, Rev. 1, Prentice-Hall, 1985. (Information Disclosure Statement, 04/08/2008 (reference AO).) This reference was considered by the examiner, as indicated by the examiner's signature and initials, dated December 4, 2008, on the IDS form.

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").

The Motorola reference, as presented by the request, does not raise 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 in view of positions allegedly taken by the patent holder in confidential license negotiations.

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The Motorola reference appears to be substantially identical to Motorola MC68020 32-Bit Microprocessor User's Manual, 2nd Edition, Rev. 1, Prentice-Hall, 1985, cited in the IDS filed April 8, 2008 in the previous merged reexamination proceeding for the '584 patent and considered by the examiner on December 4, 2008. Thus, the Motorola reference presents only teachings previously considered during prior reexamination of the '584 patent. The request fails to shine a new light on the previously-considered or otherwise cumulative disclosure of the Motorola reference.

The examiner's conclusion that, "[T]he prior art of record," which included the previously cited version of the Motorola reference, "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 (emphasis added)), indicates that the question raised by the request with respect to the Motorola reference is not a new question.

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.

The Mueller Reference, as presented by the request, does not raise a substantial new question of patentability.

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 in view of positions allegedly taken by the patent holder in confidential license negotiations.

The Mueller reference, as presented by the requester, appears to be cumulative to the previously-considered Motorola reference. In the request, the requester asserts that the Mueller reference, “teaches structures included in and processes performed by the Motorola MC68020 microprocessor.” (Request at 23.) Such structures and processes are likewise disclosed throughout the Motorola reference. Regarding the specific teachings of Mueller cited by the requester, the Motorola reference appears to contain the same teachings. See Motorola at 9-1 (when prefetching instructions from external memory, loading two words, which may load two instructions at once; further, when a prefetch falls on an odd word boundary (e.g., due to a branch to an odd word location), the MC68020 will read the even word associated with the long word base address at the same time the odd word is read (for 32-bit memory)). The request fails to shine a new light on the cumulative disclosure of the Mueller reference.

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.

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Conclusion

Because the request for ex parte reexamination fails to raise a substantial new question of patentability, the request is DENIED.

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.

/Eric B. Kiss/
Primary Examiner, Art Unit 3992

Conferees:

Handwritten signatures of conferees, including a signature that appears to be 'Eric B. Kiss' and another signature.