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EXAMINER
SORRELL, ERON J

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

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

November 22, 2022

FISCH SIGLER LLP
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WASHINGTON, DC 20015

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019109
PATENT NO. : 7233978
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 Request For Ex Parte Reexamination	Control No. 90/019,109	Patent Under Reexamination 7233978	
	Examiner ERON J SORRELL	Art Unit 3992	AIA (FITF) Status No

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

The request for *ex parte* reexamination filed 08/31/2022 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: _____

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.

/ERON J SORRELL/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-471G(Rev. 01-13)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20220919

Decision

A Third-Party Requester, Amazon Web Service, Inc., has filed a Request for *Ex Parte* reexamination of claims 17, 23, 24, and 30, of U.S. Patent No. 7,233,978 to Overton et al. ("the '978 Patent"). The Request was granted a filing date of August 31, 2022.

MPEP 2240 recites in part,

37 C.F.R. 1.515 Determination of the request for ex parte reexamination.

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. A statement and any accompanying information submitted pursuant to § 1.501(a)(2) will not be considered by the examiner when making a determination on the request. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be given or mailed to the patent owner at the address provided for in § 1.33(c) and to the person requesting reexamination.

The Request is found to raise at least one Substantial New Question of Patentability (SNQ), therefore the Request is hereby, GRANTED.

Listing of Prior Art

The Request alleges the existence of at least one SNQ based on the following patents and/or printed publications:

- i. Oracle Names Administrator's Guide, Release 2.0 (Oracle Corp., Redwood City, CA), published 1996 ("ONAG");
- ii. U.S. Patent No. 6,122,664 to Marcel Boukobza, filed on June 27, 1997, issued September 19, 2000 ("Boukobza");
- iii. Joseph B. Greene, Oracle8 Server Unleashed, 1st ed. (Sams Publishing, Indianapolis, Ind.), ISBN: 0672306816, published October 1, 1995 ("OracleUnleashed");
- iv. U.S. Patent No. 5,617,568 to Michael B. Ault, filed on December 14, 1994, issued April 1, 1997 ("Ault"); and
- v. U.S. Patent No. 6,230,183 to Peter B. Yocum, filed on March 11, 1998, issued May 8, 2001 ("Yocum").

Of the five (5) references listed above, Boukobza, OracleUnleashed, Ault, and Yocum are newly cited with the Request, while ONAG was cited in a prior examination of the '978 Patent.

Third Party Requester's Position

The Request alleges the following SNQs which have been grouped/re-organized for discussion purposes:

SNQ I: ONAG in view of Boukobza to raise SNQs over claims 17, 23, 24, and 30. This group of SNQs is based on proposed rejections of claims 17, 23, 24, and 30 under 35 USC § 103(a) as being obvious over ONAG in view of Boukobza.

SNQ II: ONAG in view of OracleUnleashed to raise SNQs over claims 17, 23, 24, and 30. This group of SNQs is based on proposed rejections of claims 17, 23, 24, and 30 under 35 USC § 103(a) as being obvious over ONAG in view of OracleUnleashed.

SNQ III: Ault in view of Yocum and Boukobza to raise SNQs over claims 17, 23, 24, and 30. This group of proposed SNQs is based on proposed rejections of claims 17, 23, 24, and 30 under 35 USC § 103(a) as being obvious over Ault in view of Yocum and further in view of Boukobza.

Analysis of the '978 Patent

The '978 Patent issued on June 19, 2007, maturing from U.S. Patent application No. 09/872,736 filed June 1, 2001 as a continuation-in-part of application no. 09/661,222 filed on September 13, 2000, now U.S. Patent No. 7,103,640, and a continuation-in-part of application no. 09/503,441 filed on February 14, 2000, now abandoned, and a continuation-in-part of application no. 09/367,461, filed August 13, 1999, now

abandoned, and a continuation-in-part of application no.

09/111,896, filed June 8, 1998, now abandoned. The '978

Application also claims priority to provisional application no.

60/277,408, filed Mar. 19, 2001, and provisional application no.

60/209,070, filed June 2, 2000.

The '978 Patent has expired. Per MPEP 2240 (emphasis added),

"In making the determination of whether to order reexamination, the Office will determine the proper meaning of the patent claims by giving the claims their broadest reasonable interpretation consistent with the specification (see *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984)), except in the case of an expired patent (in a reexamination involving claims of an expired patent, claim construction is pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention, see *Ex parte Papst-Motoren*, 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986))."

The challenged claims of the '978 Patent are toward a method for scaling the capacity or transaction rate of a location server in a system of location servers. Claim 17 (reproduced below), is the only independent claim in the Request and is considered representative. Claims 23, 24, and 30 all depend directly from claim 17.

17. A method of scaling at least one of capacity and transaction rate capability in a location server in a system having a plurality of location servers for storing and

retrieving location information, wherein each of the plurality of location servers stores unique set of location information of an aggregate set of location information, the method comprising:

providing a transfer protocol configured to transport identifier and location information, the location information specifying the location of information related to the identifier;

storing location information formatted according to the transfer protocol at a first location server;

receiving an identifier and a location relevant to the identifier at the first location server;

storing the received location in a location store at the first data location server, the location store comprising a plurality of identifiers, each identifier associated with at least one location, wherein the received location is associated with the received identifier in the location store; and

transferring a portion of the identifiers and associated locations to a second data location server when a performance criterion of the first location server reaches a predetermined performance limit.

Review of Prosecution History

Original Prosecution

Reviewing the original prosecution of the of the '736 application which matured into the '978 Patent, the Examiner finds that claims 1, 4, 6-8, 10, 12, 15-37 and 45 were allowed in a Notice of Allowance mailed 2/13/2007 and subsequently renumbered as claims 1-31. In that action, the Examiner provided the following reasons for allowance:

However, the prior art of record fails to teach or suggest individually or in combination a system in which a location query requests from multiple servers location information, separate from the data objects to which the location information pertains, to be returned to the requestor. The Examiner finds the applicant's arguments in page 10, lines 9-27 of the amendment filed November 1, 2006 to be persuasive. The applicant argued in substance that Lumelsky does not teach a system and method for management of location information separate from the data to which the location information pertains, but instead relates to manipulation of the actual data (multimedia objects in Lumelsky) rather than just the location information for that data.

After issuance, claims 1, 3, 6, 10, 14, 17, 23, 34, 30, and 31 were later challenged in *Inter Partes* Review IPR2020-00276 filed December 12, 2019 and *Ex Parte* Reexamination proceeding 90/019,034 filed November 19, 2021.

Prior IPR Proceeding

Claims 1, 3, 6, 10, 14, 17, 23, 24, 30, and 31 of the '978 Patent were challenged in IPR2020-00276 citing RFC1034, US Patent No. 5,542,087 to Neimat, and "Load Management in Distributed Video Servers" by Venkatasubramanian. The Patent Trial and Appeal Board (PTAB) denied institution finding the petitioner did not demonstrate a reasonable likelihood of prevailing in their challenge of the claims.

Concurrent *Ex Parte* Proceeding

Claims 1,3,6,10,14,17,23,24,30, and 31 were also challenged in *Ex Parte* Reexamination proceeding 90/019,034, citing ONAG, Oracle DBA Survival Guide (OSG), U.S. Patent 5,777,989 to McGarvey, U.S. Patent No. 5,301,286 to Rajani.

In a non-final Office action mailed 6/28/22, independent claim 17 was confirmed as patentable. The Examiner in that proceeding provided the following statement of Reasons of Patentability/Confirmation,

12) Claims 17, 23, 24, and 30 are confirmed over the prior art that was explained in the request and determined to raise a substantial new question of patentability in the order granting reexamination because the art of record does not teach:

transferring a portion of the identifiers and associated locations to a second data location server when a performance criterion of the first location server reaches a predetermined performance limit. (as found in claim 17)

With that, if a new reference or combination of references teaches, **transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit**, then that new reference or combination of references would raise a SNQ.

Substantial New Questions of Patentability

SNQ I: The Request alleges ONAG in view of Boukobza raises SNQs over claims 17, 23, 24, and 30. Upon review, and for the reasons discussed below, the Examiner agrees. ONAG in view of Boukobza raises SNQs over claims 17, 23, 24, and 30.

ONAG

ONAG is a book documenting version 2.0 of "Oracle Names" which is a product supporting Oracle7 release 7.3 and SQL*Net release 2.3 which makes network addresses and database link information available to all nodes in the network via a Names Server. Each database server's network address is stored with a name used to identify it in the Names Server. Client applications can request a connection to a database using a name instead of a long address. See ONAG at 1-2. The Names Server can also store database link definitions, V1 connect strings, and other name server names and addresses. See *Id.*, page 1-5.

The purpose of the Names Server is to resolve client-initiated name requests. The following events, shown illustratively at figure 3-11 (reproduced below), occur when a

client initiates a name request.

Figure 3 – 11 shows a client requesting access to a Names Server named POULTRY and a Names Server providing the answer. A flat naming model is assumed.

Note: The service name is the same as the global object name. For example, a global database name might be POULTRY.WORLD, which is also the service name.

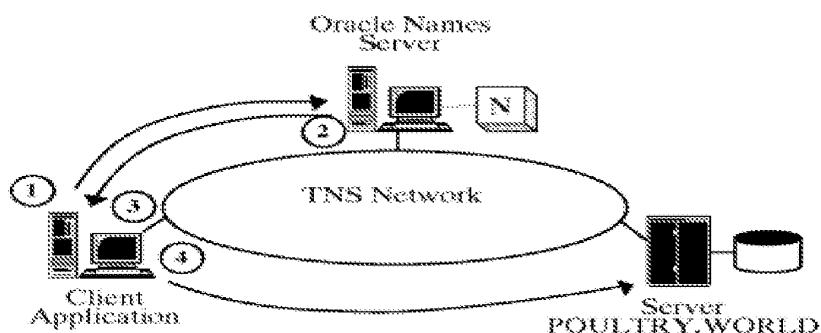


Figure 3 – 11. Client-Server Connection

The sequence of events is as follows:

1. The client application issues a connection request to SQL*Net of the form:
`sqlplus scott/tiger@POULTRY`

where POULTRY is a database service name defined in the Oracle Names Server.

SQL*Net determines from the client configuration in the SQLNETORA file that the client's default domain is WORLD and the preferred Names Server is the one shown. SQL*Net sends the Names Server a request to resolve the name POULTRY.WORLD.

2. The Names Server receives the request, looks it up in the cache, then sends the response back to the client.
3. The client receives the answer and substitutes the address in place of the initial name POULTRY.
4. The client contacts POULTRY and establishes a standard SQL*Net client-server connection.

Only step 1 and the acknowledgement of Step 4 are seen by the user, unless an error occurs.

In a more complex example, the Names Server may be distributed across a plurality of physical servers that service different administrative regions, whereby names must be resolved

across different administrative regions. ONAG discloses that finding an authoritative name server in such an environment might require iteration as shown in figure C-4 (reproduced below).

Figure C - 4 shows this process and the sequence of events assuming that no data has been previously cached.

1. The client sends request to preferred Names Server in its local region (DR1).
2. The preferred Names Server in DR1 issues request for the Names Servers authoritative for the destination server (in region DR2.1).

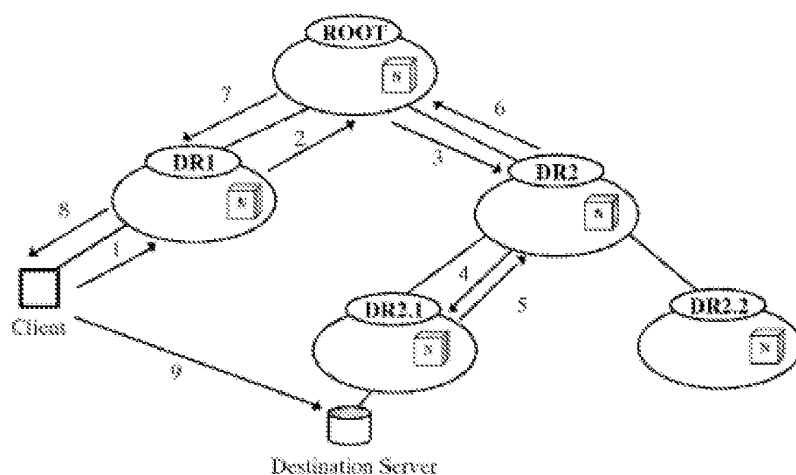


Figure C - 4 Network Messages in a Multi-Level Foreign Name Resolution

3. The root Names Server does not have the answer (because root only knows about its direct child regions), but forwards the request to a Names Server in region DR2.
4. The receiving server in DR2 forwards the request to a Names Server in region DR2.1.
5. The name is retrieved from its authoritative Names Server in DR2.1.
6. The names Server in region DR2 caches the answer and returns it to the root.
7. The root caches the answer and returns it to the preferred Names Server in region DR1.
8. The preferred Names Server caches the answer and returns it to the client.
9. The client establishes a connection to the destination server.

ONAG also discusses ways in which the name resolution process can be optimized including having multiple names servers in an administrative region and caching information learned through answering queries. See *Id.*, page C-18, C-21.

ONAG qualifies as prior art under 35 USC 102(b).

Boukobza

Boukobza teaches a method and system for monitoring a plurality of object types of a plurality of nodes including a management node. See Boukobza, Abstract. Boukobza's system makes use of autonomous agents in each node which measure specific parameters of each application, test for conditions on these parameters relative to certain thresholds, and then execute actions in order to warn of a problem or to reconfigure or to correct. The collected measurements relate to all types of

objects to be monitored including Oracle databases. See *Id.*, lines 39-65 of column 2. The corrective actions are completely configurable by the administrator and may include actions such as adding a server if the cpu utilization point reaches a predetermined threshold. See *Id.*, columns 14, lines 40-58 of column 14. Moreover, Boukobza teaches it is possible to measure, among other things, cpu time, disk space, I/O, the storage, the exchange rate, the number of users, etc. See *Id.*, lines 43-51 of column 34.

In a specific example, Boukobza teaches monitoring the Oracle parameter "ORA_FRAGMENT_TS" in which the measurement consists of verifying the condition which corresponds to the case in which the largest of the extents ("MAX_EXTENTS") of the tables of the table space ("Tablespace") is smaller than the largest hole of the table space, and if true, sending an action proposition window which indicates the "Tablespace" must be reorganized to make the "Tablespace" larger or through requesting a standard "export_operation_tables/import" to be executed. See *Id.*, lines 18-32 of column 15. Thus, Boukobza expressly discloses the claimed limitation in claim 17 of "transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit" which was the limitation indicated as being patentable over the

art of record in concurrent *Ex Parte* Reexamination proceeding
90/019,034.

Boukobza qualifies as prior art under 35 USC 102(e).

SNQ I Analysis:

As shown above, the combination of ONAG and Boukobza can be reasonably interpreted as disclosing subject matter relevant to the limitations found patentable in a prior examination of the '978 Patent. ONAG was considered in determining the patentability of claim 17 of the '978 Patent, however it was not considered in combination with Boukobza. Boukabza is newly cited with respect to the '978 Patent and its teachings are significant as it expressly discloses the limitation found patentable in concurrent EP proceeding 90/019,034. ONAG in view of Boukobza is a new combination of references. Moreover, there is a substantial likelihood that a reasonable Examiner would consider these teachings from this new reference combination to be important in deciding the patentability of claim 17, therefore ONAG in view of Boukobza is seen as raising a SNQ over claim 17, which question having not been decided in a prior examination of the '978 Patent. Since dependent claims carry with them each of the limitations of the claim(s) from which it depends, for the same reasons as mentioned above, ONAG in view

of Boukobza is seen as raising a SNQ over dependent claims 18-30.

SNQ II: The Request alleges ONAG in view of OracleUnleashed raises SNQs over claims 17, 23, 24, and 30. Upon review and for the reasons discussed below, the Examiner agrees. ONAG in view of OracleUnleashed raises SNQs over claims 17, 23, 24, and 30.

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ONAG is a book documenting version 2.0 of "Oracle Names" which is a product supporting Oracle7 release 7.3 and SQL*Net release 2.3 which makes network addresses and database link information available to all nodes in the network via a Names Server. Each database server's network address is stored with a name used to identify it in the Names Server. Client applications can request a connection to a database using a name instead of a long address. See ONAG at 1-2. The Names Server can also store database link definitions, V1 connect strings, and other name server names and addresses. See *Id.*, page 1-5.

The purpose of the Names Server is to resolve, or assist in resolving client-initiated name requests. In operation, the following events, shown illustratively at figure 3-11 (reproduced below), occur when a client initiates a name request.

Figure 3 – 11 shows a client requesting access to a Names Server named POULTRY and a Names Server providing the answer. A flat naming model is assumed.

Note: The service name is the same as the global object name. For example, a global database name might be POULTRY.WORLD, which is also the service name.

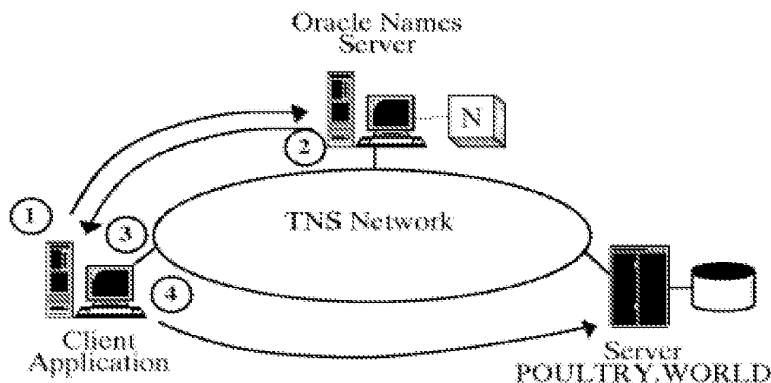


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The sequence of events is as follows:

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sqlplus scott/tiger@POULTRY
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where POULTRY is a database service name defined in the Oracle Names Server.

SQL*Net determines from the client configuration in the SQLNET.ORA file that the client's default domain is WORLD and the preferred Names Server is the one shown. SQL*Net sends the Names Server a request to resolve the name POULTRY.WORLD.

2. The Names Server receives the request, looks it up in the cache, then sends the response back to the client.
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Only step 1 and the acknowledgement of Step 4 are seen by the user, unless an error occurs.

In a more complex example, the Names Server may be distributed across a plurality of physical servers that service

different administrative regions, whereby names must be resolved across different administrative regions. ONAG discloses that finding an authoritative name server in such an environment might require iteration as shown in figure C-4 (reproduced below).

Figure C - 4 shows this process and the sequence of events assuming that no data has been previously cached.

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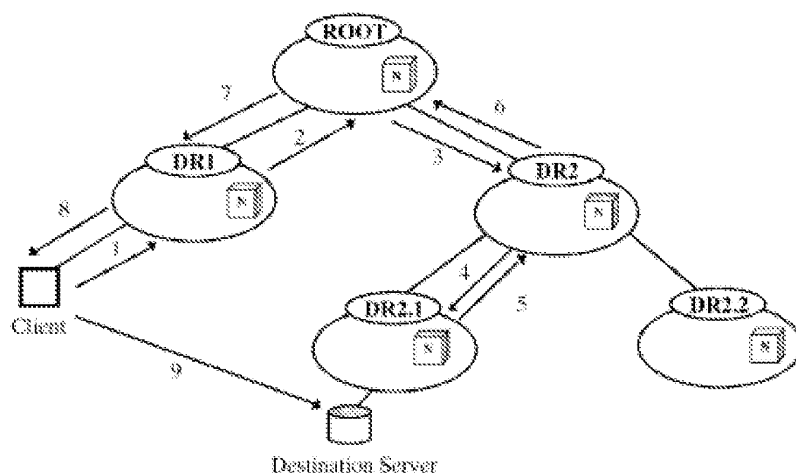


Figure C - 4 Network Messages in a Multi-Level Foreign Name Resolution

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7. The root caches the answer and returns it to the preferred Names Server in region DR1.
8. The preferred Names Server caches the answer and returns it to the client.
9. The client establishes a connection to the destination server.

ONAG also discusses ways in which the name resolution process can be optimized including having multiple names servers in an administrative region and caching information learned through answering queries. See *Id.*, page C-18, C-21.

ONAG qualifies as prior art under 35 USC 102(b).

OracleUnleashed

OracleUnleashed is a book detailing version 8 of the Oracle database management system ("Oracle8"). OracleUnleashed describes Oracle8 as a "significant upgrade" to the Oracle database management system. See OracleUnleashed, page 8. Some of the key enhancements include parallel processing made possible through the use of partitioned tables; incremental backups where only updated parts of the tablespace or database are backed up instead of the entire tablespace or database; and improved

replication. See *Id.*, page 11. Table partitioning is performed by dividing a table into multiple sections based on some logical index value and each section can be stored on a different disk. See *Id.*, page 12.

OracleUnleashed provides an overview of the administrative requirements of Oracle 8, including concepts related to tablespace maintenance and performance tuning. OracleUnleashed states that performance can be monitored and adjusted for a variety of means and that partitioning greatly enhances database performance. The administration and tuning are simplified via features that make the partitions easy to create, move, split, and so on. See *Id.*, pages 424-425. In Oracle8, the units of data are the partitions rather than the tables as in earlier versions. As the tables get bigger however, the partition size does not increase rather the number of partitions increases. The use of partitions is what allows parts of the table to be relocated to a different device. See *Id.*, pages 840. With that teaching, OracleUnleashed expressly discloses the claimed limitation in claim 17 of "transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit" which was the limitation indicated as being patentable over the art of record in concurrent *Ex Parte* Reexamination proceeding 90/019,034.

OracleUnleashed OU qualifies as prior art under 35 USC
102(b).

SNQ II Analysis:

As shown above, the combination of ONAG and OracleUnleashed can be reasonably interpreted as disclosing subject matter relevant to the limitations found patentable in a prior examination of the '978 Patent. ONAG was considered in determining the patentability of claim 17 of the '978 Patent, however it was not considered in combination with OracleUnleashed. OracleUnleashed is newly cited and its teachings are significant because it expressly discloses the limitation found patentable in concurrent *Ex Parte* Reexamination proceeding 90/019,034. ONAG in view of OracleUnleashed is a new combination of references. Moreover, there is a substantial likelihood that a reasonable Examiner would consider these teachings from this new reference combination to be important in deciding the patentability of claim 17, therefore ONAG (ONAG) in view of OracleUnleashed is seen as raising a SNQ over claim 17, which question having not been decided in a prior examination of the '978 Patent. Since dependent claims carry with them each of the limitations of the claim(s) from which it depends, for the same reasons as mentioned above, ONAG in view of OracleUnleashed is seen as raising a SNQ over dependent claims 18-30.

SNQ III: The Request alleges Ault in view of Yocum and Boukobza raises SNQs over claims 17, 23, 24, and 30. Upon review and for the reasons discussed below, the Examiner agrees. Ault in view of Yocum and Boukobza raises SNQs over claims 17, 23, 24, and 30.

Ault

Ault discloses concepts related to a distributed computing environment (DCE) and in particular a distributed file system (DFS) of the DCE. The DFS provides a database storing the location of all the files in the file system. When files move, the DFS automatically updates the database of the new locations. See Ault, lines 32-43 of column 2. According to Ault, a central component of the DCE is a directory service which provides a way for users to name and locate objects. See *Id.*, lines 2-4 of column 3. Ault discloses that by integrating the DFS with the directory service, the user able to access files in a consistent manner from different workstations in a distributed environment. Further, the directory service ensures each resource is identified by a unique and consistent name including computers, application services, and files. As shown in figure 4 (reproduced below), a file located anywhere in a worldwide DCE

can be readily located using the directory service. See *Id.*,
line 55 of column 4 to line 8 of column 5.

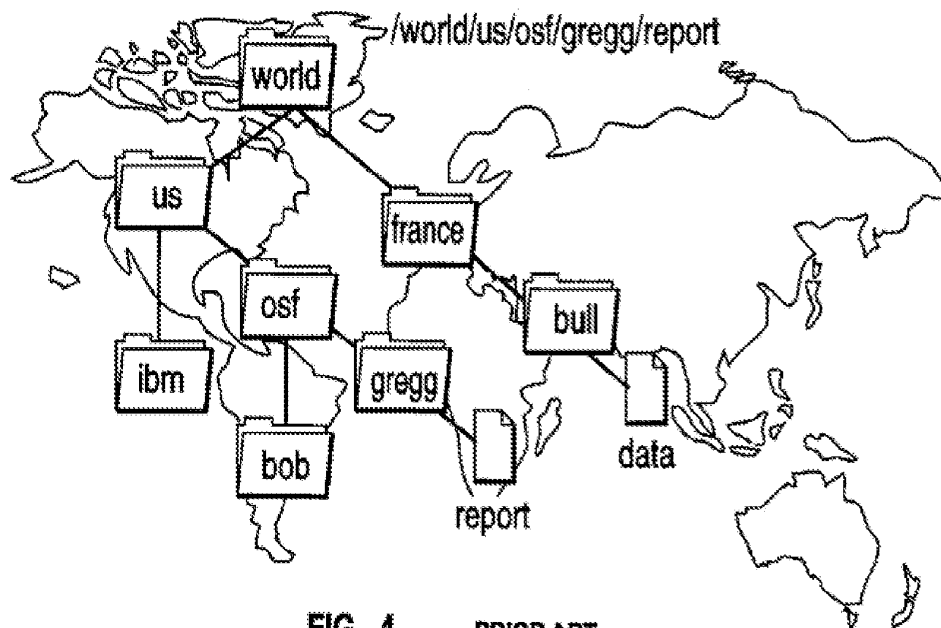
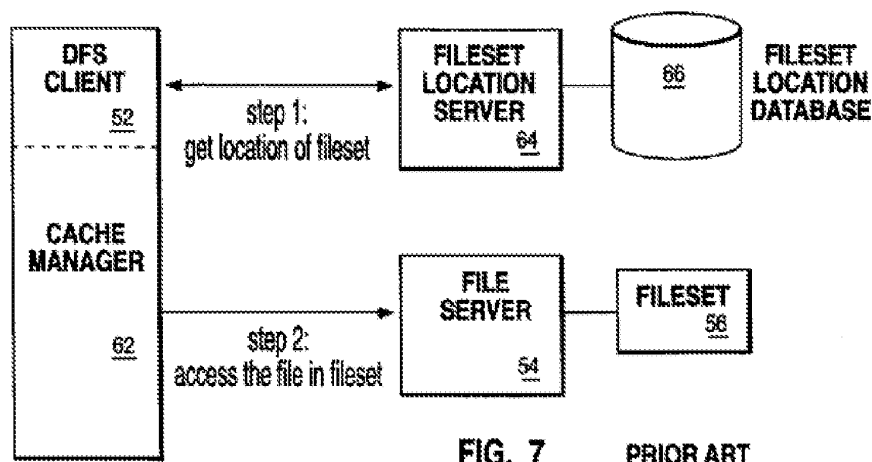


FIG. 4 **PRIOR ART**

In a particular embodiment, shown in figure 7 (reproduced below), Ault describes a file set location server which maintains a database of all the file sets. The database is used to keep track of the physical locations where the file sets are stored.



A client that requires access to one of the file sets, first sends a request to the file set location server/database for the physical location of the file set. After receiving the location, the client contacts the particular DFS file server storing the particular file set. A server wishing to export files sets must register their exported file sets at the file set location server. See *Id.*, line 62 of column 5 to line 9 of column 6.

Ault qualifies as prior art under 35 USC 102(b).

Yocum

Yocum teaches a method and system that allows for managing the number of servers assigned to different service classes based on performance goals for each service class. Tradeoffs between classes are made that consider the impact of adding or removing servers from competing classes. See Yocum, lines 28-34

of column 2. Yocum discloses multiple work queues can be allocated for each service class, wherein the multiple work queues are independently managed by changing the location of the data. See *Id.*, lines 32-43 of column 8. Yocum teaches performing calculations when determining to add servers such that the number of servers added is large enough to make the change worthwhile, but not so large as to make the value of the additional servers marginal. See *Id.*, lines 37-57 of column 10.

Yocum qualifies as prior art under 35 USC 102(e).

Boukobza

Boukobza teaches a method and system for monitoring a plurality of object types of a plurality of nodes including a management node. See Boukobza, Abstract. Boukobza's system makes use of autonomous agents in each node which measure specific parameters of each application, test for conditions on these parameters relative to certain thresholds, and then execute actions in order to warn of a problem or to reconfigure or to correct. The collected measurements relate to all types of objects to be monitored including Oracle databases. See *Id.*, lines 39-65 of column 2. The corrective actions are completely configurable by the administrator and may include actions such as adding a server if the cpu utilization point reaches a predetermined threshold. See *Id.*, columns 14, lines 40-58 of

column 14. Moreover, Boukobza teaches it is possible to measure, among other things, cpu time, disk space, I/O, the storage, the exchange rate, the number of users, etc. See *Id.*, lines 43-51 of column 34.

In a specific example, Boukobza teaches monitoring the Oracle parameter "ORA_FRAGMENT_TS" in which the measurement consists of verifying the condition which corresponds to the case in which the largest of the extents ("MAX_EXTENTS") of the tables of the table space ("Tablespace") is smaller than the largest hole of the table space, and if true, sending an action proposition window which indicates the "Tablespace" must be reorganized to make the "Tablespace" larger or through requesting a standard "export_operation_tables/import" to be executed. See *Id.*, lines 18-32 of column 15. Thus, Boukobza expressly discloses the claimed limitation in claim 17 of "transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit" which was the limitation indicated as being patentable over the art of record in concurrent EP proceeding 90/019,034.

Boukobza qualifies as prior art under 35 USC 102(e).

SNQ III Analysis:

As shown above, the combination of Ault, Yocum, and Boukobza can be reasonably interpreted as disclosing subject matter relevant to the limitations found patentable in a prior examination of the '978 Patent. Ault, Yocum, and Boukobza are all newly cited with the instant Request and have never been considered in determining the patentability of the '978 Patent. Boukabza teachings are significant as it expressly discloses the limitation found patentable in concurrent EP proceeding 90/019,034. Moreover, there is a substantial likelihood that a reasonable Examiner would consider these teachings from this new reference combination to be important in deciding the patentability of claim 17, therefore Ault in view of Yocum and Boukobza is seen as raising a SNQ over claim 17, which question having not been decided in a prior examination of the '978 Patent. Since dependent claims carry with them each of the limitations of the claim(s) from which it depends, for the same reasons as mentioned above, Ault in view of Yocum and Boukobza is seen as raising a SNQ over dependent claims 18-30.

Summary of the Proposed SNQs

The Examiner agrees with the following groups of proposed SNQs:

SNQ I: ONAG in view of Boukobza to raise SNQs over claims 17, 23, 24, and 30;

SNQ II: ONAG in view of OracleUnleashed to raise SNQs over claims 17, 23, 24, and 30;

SNQ III: Ault in view of Yocum and Boukobza to raise SNQs over claims 17, 23, 24, and 30.

35 USC 325(d)

A review of the post grant history of the '978 patent indicates that the patent was the subject of two prior post grant challenges.

On December 12, 2019, Petitioner Amazon Web Services filed a petition (IPR2020-00276) seeking *inter partes* review claims 1, 3, 6, 10, 14, 17, 23, 24 30 and 31 of the '978 patent. The petition presented the following grounds as raising a reasonable likelihood in prevailing (RLP):

RLP 1: Claims 1, 3, 6, 10, 14 and 31 as anticipated by RFC 1034.

RLP 2: Claim 6 as being obvious over RFC 1034.

RLP 3: Claims 17, 23 and 30 as being obvious over RFC 1034 in view of Neimat.

RLP 4: Claim 24 as being obvious over RFC 1034 in view of Neimat and Venkatasubramanian.

On June 16, 2020, the Board issued decision denying institution of *inter partes* review holding that the petition failed to adequately explain how the "host" and "domain name" in RFC 1034

satisfied the requirement of the claimed "identifier" in independent claims 1 and 17.

On November 19, 2021, third party requester Amazon Web Services filed a request for *ex parte* reexamination (90/019,034) of claims 1, 3, 6, 10, 14, 17, 23, 34 30 and 31 of the '978 patent. The request presented the following grounds as raising a substantial new question of patentability (SNQ):

SNQ 1: Claims 1, 17, 23, 24, 30 and 31 and being obvious over ONAG in view of OSG

SNQ 2: Claims 3, 10 and 14 as being obvious over ONAG in view of OSG and McGarvey

SNQ 3: Claim 6 being obvious over ONAG in view of OSG and further in view of Rajani.

On January 12, 2022, *ex parte* reexamination was ordered and on June 28, 2022, the examiner issued a non-final Office action which indicated that claims 1, 3, 6, 10 and 14 were unpatentable over the cited prior art, but that claims 17, 23, 24 and 30 were allowable over the prior art combination of ONAG in view of OSG. In the June 28, 2022 first action on the merits, the examiner indicated that combination of ONAG and OSG failed to disclose the claimed limitation of "transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit" (See independent claim 17). On October 27, 2022, a final rejection was issued which finally

rejected claims 1 and 31 and confirmed claims 3, 6, 10, 14, 17, 23, 24 and 30.

A comparison between the instant request for *ex parte* reexamination of the '978 patent as compared to the prior denied petition for *inter partes* review (IPR2020-00276) and the pending *ex parte* reexamination proceeding (90/019,034) indicates that the request is not based on same or substantially the same prior art or arguments as previously presented.

In particular, with respect to the prior denied IPR petition (IPR2020-00276), none of the prior art presented in the instant request for reexamination overlaps with prior art presented in the petition. As indicated above, the examiner has determined newly presented prior art references of Boukobza and Oracle both disclose teachings which meet the claimed limitation in independent claim 17 of an "identifier". This teaching was determined by the Board not be present in the grounds asserted in the denied IPR. Thus, because the grounds apply new prior art and art discloses limitations missing from the prior art presented in the IPR petition, both prior art and arguments presented in instant reexamination request are not the same or substantially the same as those previously presented in the IPR2020-00276 petition.

Further, with respect to the prior pending *ex parte* reexamination proceeding (90/019,034), while two of the grounds

asserted as raising a substantial new question of patentability (SNQ) rely on the ONAG prior art reference which was previously presented in the 90/019,034, these two grounds also rely on newly presented secondary references Boukobza (SNQ 1) and OracleUnleased (SNQ 2). Still further as stated above, both newly presented Boukobza and OracleUnleased expressly disclose teachings meeting the claimed limitation in claim 17 of "transferring a portion of identifiers and associated locations to a second location server when a performance criterion of the first location server reaches a predetermined performance limit". This limitation was indicated as being patentable over the art of record in concurrent pending *ex parte* reexamination proceeding (90/019,034). Thus, because the grounds presented in the reexamination request apply new prior art and the art discloses limitations the Examiner determined were missing from the prior art grounds asserted in the prior pending reexamination proceeding (90/019,034), both prior art and arguments presented in instant reexamination request are not the same or substantially the same as those previously presented in the 90/019,034.

Accordingly, because the grounds presented in the instant request for *ex parte* reexamination of the '978 patent are not based on the same or substantially the same prior art or arguments, a discretionary denial pursuant to 35 USC 325(d) is

not implicated and reexamination is ordered based on the Examiner's determination that the prior art presented raising a substantial new question of patentability of the requested claims.

On October 6, 2022, Patent Owner filed a petition under 37 CFR 1.181, 1.182 and 1.183 seeking waiver of the rules and consideration of Patent Owner's petition under 1.181 addressing the applicability of 35 USC 325(d). On October 27, 2022, Third Party Requester filed an Opposition to Patent Owner's October 6, 2022 petition. On November 12, 2022, Patent Owner filed a petition seeking to have the Director expunge Third Party Requester's October 27, 2022 Opposition.

On November 21, 2022, the Office issued a decision which:

- 1.) granted Patent Owner's 1.183 petition by waiving 37 CFR 1.530(a) and 37 CFR 1.540 to permit entry and consideration of any information regarding § 325(d) issues set forth in the Patent Owner's October 6, 2022,
- 2.) indicated that Requester's October 27, 2022 opposition has a right of entry and *sua sponte* waived the provisions of 37 CFR 1.535 and 37 CFR 1.540 to the extent necessary to permit entry and consideration of any information regarding § 325(d) issues set forth in the requester's October 27, 2022 opposition,
- 3.) expunged Patent Owner's November 12, 2022 expungement petition as an improper paper, and
- 4.) forwarded the proceeding to the CRU for consideration of Par the 35 U.S.C. 325(d) information presented in Patent Owner's October 6, 2022 combined petition and requester's October 27, 2022 opposition.

The following discussion addresses Patent Owner's arguments as set forth in their October 6, 2022 petition as to why the facts warrant a discretionary denial and termination of reexamination pursuant to 35 USC 325(d).

Becton Dickinson and Advanced Bionics factors

Patent Owner's arguments regarding the factors identified by the PTAB in Becton Dickinson and clarified by the PTAB in Advanced Bionics are not persuasive. See IPR2017-01586, Paper No. 8 (PTAB Dec. 15, 2017) (Becton) and IPR2019-01469, Paper No. 6 (PTAB Feb. 13, 2020) (Advanced Bionics). An *ex parte* reexamination proceeding is not a trial proceeding. The Becton factors were specifically formulated to apply to AIA trial proceedings, not to *ex parte* reexamination proceedings. The PTAB's Trial Practice Guide expressly states, in reference to the Becton factors (emphasis added): "The above-listed factors are considered by the Board when determining whether to institute a trial. When determining whether to order *ex parte* reexamination, however, the Office may not necessarily consider these factors. An *ex parte* reexamination proceeding is not a trial proceeding, and the considerations with respect to issues involving 35 U.S.C. § 325(d) may differ due to the different nature of an *ex parte* reexamination proceeding." See Patent Trial and Appeal Board Consolidated Trial Practice Guide

(November 2019), page 63. Moreover, even if the Office were to consider the Advanced Bionics/Becton factors in this instance, the Office has determined that the grounds presented in the instant request that raise an SNQ are not the same or substantially the same as the prior art or arguments relied upon in the prior IPR proceeding or prior *ex parte* reexamination proceeding involving the '978 patent as set forth [above].

Roadmapping

Patent Owner repeatedly asserts that discretion under 35 U.S.C. 325(d) is warranted because requester uses the prior decisions on its previous challenges "as a roadmap in an attempt to overcome those prior deficiencies." Even assuming, *arguendo*, that requester is using the PTAB's and examiner's analyses from the prior proceedings as a "roadmap" for the instant request, the language of § 325(d) does not prohibit a requester from addressing, in a subsequent reexamination request, deficiencies that were identified with respect to a prior IPR petition or *ex parte* reexamination request. Concerns regarding curing deficiencies in a previously filed IPR petition are more prominent in the PTAB's analysis under § 314(a) for discretionary denials of serial IPR petitions to ensure the efficient use of the IPR review process as opposed to under § 325(d) (second sentence), which focuses on the presence of the

same or substantially the same prior art or arguments. See, e.g., *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 (PTAB Sept. 6, 2017), p. 17 (In discussing General Plastic "factor 3" (i.e., whether at the time of filing of the second petition the petitioner already received the Patent Owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition) the PTAB states that "[t]he absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review."). Further, to the extent Patent Owner relies on earlier PTAB decisions that pre-date the PTAB's section 325(d) decisions in *Advanced Bionics* and *Becton Dickinson* to support its argument that "roadmapping" is a section 325(d) consideration, such reliance is inapt because in its earlier PTAB decisions, the PTAB conflated its analyses under 35 U.S.C. 314(a) and 35 U.S.C. 325(d) (second sentence) and has since separated the analyses.

In re Vivint

To the extent Patent Owner is relying on Vivint as supporting termination of the present reexamination proceeding as

"abusive," such argument is not persuasive. The present reexamination proceeding is distinguishable from *Vivint*. *Vivint* held that it was arbitrary and capricious for the Office to subsequently order reexamination on a patent after denying institution of a prior IPR on the same patent where the decision to deny institution of the prior IPR relied on § 325(d) "for its core analysis" to conclude that the IPR was "a case of undesirable, incremental petitioning." *Vivint*, 14 F.4th at 1353. Patent Owner's expansive interpretation of *Vivint* is contrary to the Federal Circuit's own characterization of its ruling in *Vivint* as "narrow" and "limited." *Vivint*, 14 F.4th at 1354 (stating, "Our holding today is narrow. Section 325(d) applies to both IPR petitions and requests for *ex parte* reexamination. Thus, the Patent Office, when applying § 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive."). Unlike *Vivint*, there are no prior proceedings involving the '978 patent that were denied on the basis of undesirable, incremental or abusive petitioning under § 325(d). Unlike the fact pattern in *Vivint*, in the requester's first challenge involving the '978 patent, the Office denied institution of IPR2020-00276 because requester failed to demonstrate a reasonable likelihood that it would prevail in establishing the unpatentability of at least one challenged

claim of the '978 patent. in the requester's second challenge involving the '978 patent, the Office granted the request and ordered the 90/019,034 reexamination, which proceeding has progressed to the point where the examiner has confirmed the patentability of the claims being challenged in the present reexamination proceeding. Accordingly, Patent Owner's reliance on Vivint as supporting termination of the present reexamination proceeding is inapt.

Argument that Requester could have raised the art in the previous proceedings

Patent Owner's argument that discretion under 35 U.S.C. 325(d) is warranted because requester failed to demonstrate that Boukobza, OracleUnleashed, Ault, or Yocum request "was previously unknown or unavailable to it" is not persuasive. What the requester presented in a prior proceeding, not what the requester could have presented in a prior proceeding, is the relevant consideration under § 325(d), as set forth above. Whether the art or arguments presented in a reexamination request could have been presented in a prior proceeding is not a consideration for exercising discretion § 325(d), rather it is a consideration evaluated by the PTAB with respect to discretionary denials of serial petitions under 35 U.S.C. 314(a). See General Plastic Industrial Co., Ltd. v. Canon

Kabushiki Kaisha, IPR2016-01357, Paper No. 19 (PTAB Sept. 6, 2017), p. 9 (“[W]hen exercising discretion to deny institution of an *inter partes* review, [the PTAB] may consider ... 2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it...”). What a petitioner “raised or reasonably could have raised” is also a consideration under the estoppel provisions of 35 U.S.C. 315(e) and 35 U.S.C. 325(e).

Accordingly, Patent Owner’s arguments that the Request should be terminated under 325(d) are not persuasive.

In conclusion, as stated above, in view of the facts that the prior art and arguments presented in the instant request for *ex parte* reexamination are not the same or substantially the same as those previously presented in the prior denied IPR petition and in the pending *ex parte* reexamination proceeding, a discretionary denial of reexamination pursuant to 35 USC 325(d) is not indicated and reexamination is Ordered based on the determination above that the cited prior art raises an SNQ to the claims of the ‘978 patent

Scope of the Proceeding

Claims 17-30 of U.S. Patent No. 7,233,978 are subject to reexamination. Claims 18-22 and 25-29 were not challenged in the

Request but are being included by the Examiner *sua sponte* as they all depend from claim 17.

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Conclusion

ALL correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

Please mail any communications to:

Attn: Mail Stop "*Ex Parte Reexam*"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450 Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

By EFS-Web

Registered users of EFS-Web may alternatively submit such correspondence via electronic filing system EFS-Web, at

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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/ERON J SORRELL/
Primary Examiner, Art Unit 3992

Conferees: /JOSEPH R POKRZYWA/
 Primary Examiner, Art Unit 3992

/MICHAEL FUELLING/
Supervisory Patent Examiner, Art Unit 3992