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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,997	04/05/2006	6513042	9001	6741

7590 05/17/2006

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/17/2006

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



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5/17/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO 90/007997

PATENT NO. 6,513,042

ART UNI 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b> 90/007,997	<b>Patent Under Reexamination</b> 6513042	
	<b>Examiner</b> Majid A. Banankhah	<b>Art Unit</b> 3992	

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

The request for *ex parte* reexamination filed 05 April 2006 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-1449,      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.

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. \_\_\_\_\_, or  
c)  by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester ( if third party requester )

**Response to Request for *ex parte* Reexamination**

1. Reexamination has been requested for claims 1-16 of U.S. Patent number 6,513,042 ('042 patent).
2. A substantial new question of patentability affecting at least claim 1 of United States Patent number 6,513,042 is raised by the request for *ex parte* reexamination.
3. A prior art patent or printed publication raises a substantial new question of patentability where there is:
  - (A) 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, MPEP §2242 (I) and,
  - (B) the same question of patentability as to the claim has not been decided in a previous or pending proceeding or in a final holding of invalidity by a federal court. See MPEP §2242 (III).
4. The '042 patent is currently assigned to:  
TEST.COM, INC.,  
1300 East Ninth Street,  
Suite 1310, Cleveland OH 44114
5. The '042 patent application filing date was Feb. 11, 1999 and the patent issued on Jan. 28, 2003.
6. In the request for reexamination, the requester alleges that '042 patent claims 1-16 are rendered obvious in light of the following references:
  - November 16, 1998: On Tour IntraLearn Delivers First Internet-based Training and Testing Solution for Online Certification ("*Press Release*")

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- 1998: Intra Learn Web-Based Training and Knowledge Management System-Administrator, Instructor and Course Developer Guide (*“Administrator Guide”*)
- 1998: IntraLearn Web-Based Training and Knowledge Management System-Student Manual (*“Student Manual”*)
- August 2000: U.S. Patent No. 6,112,049 to Sonnenfeld (Priority Date: October 21, 1997) (*“Sonnenfeld patent”*)

7. Of the above references, the “IntraLearn System”, i.e., the “press Release”, “Administrator Guide”, and “Student Manual” are not cited on the face of the ‘042 patent and are not cumulative to the art of record in the original file. However, the U.S. Patent 6,112,049 (‘049) was cited and used by the Examiner in his rejections in three separate office actions. In the non-Final Office Action issued on June 5<sup>th</sup> 2001, claims 1-10, 13-14, and 18-20 were rejected under 35 U.S.C. 102(b) as being anticipated by ‘049, and claims 11-12, and 15-17 were rejected under 35 U.S.C. 103 as being unpatentable over ‘049 in view of U.S. patent 5,903,777. In the Final Office Action issued on April 24, 2002, claims 1-10, 12-13, and 15-21 were rejected under 35 U.S.C. 103 as being unpatentable over ‘049 in view of 5,907,831, and in the non-Final Office Action issued on July 29, 2002, claims 1-10, 13, and 16-21 were rejected under 35 U.S.C. 103 as being unpatentable over ‘049 in view of 5,862,223.

In this reexamination however, the requester argues that claims 1-10 of the U.S. patent ‘042 are rendered obvious over ‘049 in view of the “Press Release”. Therefore, the reference of ‘049 is considered not cumulative to the art of record in the original file.

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8. It is agreed that the "IntraLearn" publications would have been considered important by a reasonable Examiner in deciding whether or not at least claim 1 was patentable, for the reasons discussed *infra*.

U.S. Pat. No. 6,513,042 ("Anderson")	"IntraLearn System"
Claim 1. A method of making a test and posting the test on-line for potential test-takers, said method comprising the steps of:	Administrator Guide at 1 ("The basic premise of IntraLearn is to give students access to knowledge, immediate assessment of their assimilation, certification of what they learned and instructor guidance as required. Students can learn at their own convenience whenever and wherever they are. . . . Course developers or instructors are equipped with an easy to use mechanism to load knowledge into the system. A simple web browser and appropriate access to the IntraLearn system is all that is needed for each of these roles.")
providing a host system and a plurality of remote terminals operatively coupled to the Internet;	Press Release at 2 ("With IntraLearn, students can easily be certified online via a Web browser. . ."); id. ("IntraLearn creates a structured 'virtual' classroom that enables a student to receive training, perform tests, and communicate with others simply from a standard web browser.");  Administrator Guide at 5 (graphic disclosing host system that connects to a plurality of terminals via standard Internet Web browsers).
inputting questions at one of the remote terminals;	See generally Administrator Guide at 1 -2, 5, & 51-54 (e.g., "To install a test, with its questions and answers, the user steps through a series of screens which prompt for the information one question at a time.").
compiling the questions at the host system to make a compiled test;	See generally Administrator Guide at 1-2, 5, & 51-54.
posting the test on-line for potential test-takers;	See generally Administrator Guide at 1, 2, 5, & 51-54.  Press Release at 2 ("IntraLearn creates a structured 'virtual' classroom that enables a student to . . . perform tests . . . simply from a standard web browser.").
wherein a test-taker is required to pay to take the compiled test; and	Press Release at 2 ("With powerful security measures for student identification and authentication, IntraLearn . . ."); id. At 3 (discussing

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	<p>growing market for online testing and certification and disclosing "a small royalty percentage per student registration.").</p> <p>Administrator Guide at 7 ("Registration: Student sign-up for courses), id. at 38-42 (disclosing ability for students to register to take a course, including tests encompassed by the course requirements).</p>
<p>wherein the test-maker and the proprietor of the host system share the revenues generated by the test-taker taking the test.</p>	<p>Press Release at 3 (discussing growing market for online testing and certification and disclosing payment of "a small royalty percentage per student registration" to IntraLearn from the course instructor/test-maker.).</p>

The above discussed teaching was not present during the prosecution of the application which became the '042 patent. Further, there is a substantial likelihood that this teaching would have been important to a reasonable examiner in deciding whether or not the claim is patentable.

### Conclusion

9. All patent claims for U.S. Pat. 6,513,042 are subject to reexamination.
  
10. Extensions of time under 37 C.F.R. §1.136(a) will not be permitted in this proceeding because the provisions of 37 C.F.R. §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 C.F.R. §1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 C.F.R. §1.550(c).
  
11. The Patent Owner is reminded of the continuing responsibility under 37 C.F.R. § 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent

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proceeding, involving Patent number 6,513,042 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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**How to Communicate with the USPTO**

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

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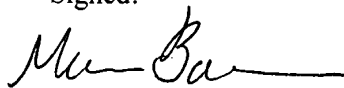
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Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

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:



Majid A. Banankhah  
CRU Examiner  
GAU 3992  
(571) 272-3770

Conferrees:  
M. Reinhart SPRE-CRU

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EXAMINER CRU