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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/10/2007

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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,997.

PATENT NO. 6513042.

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)).

Office Action in Ex Parte Reexamination	Control No. 90/007,997	Patent Under Reexamination 6513042	
	Examiner Majid A. Banankhan	Art Unit 3992	

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

- a Responsive to the communication(s) filed on 05 April 2006. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO/SB/08. 4. _____.

Part II SUMMARY OF ACTION

- 1a. Claims 1-16 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1-16 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____.
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

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DETAILED ACTION

Reexamination

1. This is an *ex parte* reexamination of U.S. Patent No. 6,513,042. Claims 1 – 16 are pending. The references discussed herein are as follows:

On Tour Media Press Release, On Tour IntraLearn Delivers First Internet-based Training and Testing Solution for Online Certification, Nov. 16, 1998, (hereinafter, the “Press Release”).

On Tour Media Inc., IntraLearn Web-based Certification Training and Management System, Administrator Guide, 1998 (hereinafter, the “Administrator Guide”).

On Tour Media Inc., IntraLearn Web-based Certification Training and Management System, Student Manual, 1998 (hereinafter, the “Student Manual”).

Note: the above references are of record, but the initialed PTO-1449 mailed with the order of May 17, 2006 is not in the file. To complete the record, the references have been added to a PTO-892. Additional copies of these references will not be attached to the present office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Administrator Guide in view of Press Release.

4. With respect to claim 1, Administrator Guide discloses **a method of making a test and posting the test on-line for potential test-takers, said method comprising the steps of:**

providing a host system and a plurality of remote terminals operatively coupled to the Internet (page 5, figure showing IntraLearn application host and Web Browsers on terminals/PCs);

inputting questions at one of the remote terminals (pages 51 – 54, administrator can add tests and test questions; see also page 5, the administrator accesses the system from a remote Web Browser terminal.);

compiling the questions at the host system to make a compiled test (see pages 4, “For an administrator, instructor or course developer, IntraLearn works by letting the insert, modify or delete information on a particular subject matter; see also pages 51-54);

posting the test on-line for potential test-takers (see pages 1-2, “The basic premise of IntraLearn is to give students access to knowledge, immediate assessment of their assimilation, certification of what they have learned ...”, “A student also puts information into the database when they complete a test ...”).

Administrator Guide also discloses registration of a test-taker to enroll in a class that includes the compiled test (pages 38-42). However, Administrator Guide does not specifically disclose that the test-taker is required to pay to take the compiled test. Press Release discloses that On Tour media, the company that developed IntraLearn, offered hosting license and a small

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royalty percentage per student registration as one of two pricing models (Press Release, page 3, Pricing and Availability; see also Declaration of Jerry Goguen executed on April 5th, 2006) disclosing the following limitations:

wherein a test-taker is required to pay to take the compiled test; and
wherein the test-maker and the proprietor of the host system share the revenues generated by the test-taker taking the test.

It also would have been obvious to one of ordinary skill in the art, having the teachings of Administrator Guide and Press Release before him at the time the invention was made, to adopt the pricing model offered by On Tour, to be able to offer on-line courses to paying students.

5. With respect to claim 2, the method includes **the steps of providing a home page that is accessible to both potential test-makers and test-takers and that allows users to cast themselves as either a test-maker or a test-taker** (Administrator Guide, page 7, the Welcome screen shows student registration login link and the administrator link).
6. With respect to claim 3, **method as set forth in claim 1 wherein the test-maker is required to input an identifier** (page 8, Administrator login screen).
7. With respect to claim 4, the method **further including the steps of editing a compiled test** (page 51, Modify Test page).

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8. With respect to claim 5, **the step of posting the step includes placing the compiled test in a directory for access by potential test-takers** (page 52, Add Test page; see also page 2, “Course developers put information into the system in pre-defined areas for students to get at.”).

9. With respect to claim 6, **the directory has a plurality of categories corresponding to different types of tests and wherein the compiled test is placed in the appropriate category** (page 42, Add Course, page 44, Add Lesson, and page 51, Add Test; A course contains lessons which in turn contain tests, categorizing different tests into lessons and courses and placing them appropriately.).

10. With respect to claim 7, **the step of placing the compiled test in a directory includes the steps of placing a just-made test into a temporary category, reviewing the test to determine the appropriate category, and then placing the test into the appropriate category** (As discussed above, IntraLearn system allows an administrator to add and modify courses, lessons and tests. Thus, if a test is created in an inappropriate lesson, i.e., temporary category, the administrator can review it and place it in the appropriate lesson.).

11. With respect to claim 8, the method comprises **the step of receiving input from the test-maker as to the appropriate category** (test maker determines in which lesson the test belongs).

12. With respect to claim 9, **the test-taker chooses a test from the directory** (the test-taker chooses the test when the test-taker takes the course and a lesson associated with the test).

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13. With respect to claim 10, **the test-taker is allowed to preview the test chosen from the directory** (This is inherent in any test as at least one test question must be previewed before answering. The Examiner notes that the claim language does not require previewing the entire set of test questions. Therefore, “previewing” any portion of the test prior to answering any question reads on the claim language.).

14. With respect to claim 11, **the compiled test is placed in a restricted directory and the test-taker must have know [sic] a password to access the compiled test** (Press Release, page 2, “With powerful security measures for student identification and authentication, ...”; password is a notoriously well known means of authentication).

15. With respect to claim 12, Administrator Guide and Press Release disclose a **method of posting a test on-line for potential test-takers, said method comprising the steps of:**

providing a host system and a plurality of remote terminals operatively coupled to the Internet (see rejection of claim 1 above):

placing a test in a restricted directory for potential test-takers (see rejection of claim 6 above):

requiring a test-taker to input a password to have access to the restricted directory (see rejection of claim 11 above):

wherein the restricted directory includes academic practice tests (see rejection of claim 6 above; academic practice test is “a test” that is placed in the restricted directory and there

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is no patentable distinction between a test and an “academic practice test” as this distinction depends on how an instructor/course designer chooses to designate a test, that is if an instructor intends a test to be a practice test then any test becomes a practice test),

wherein a school enrolls students at a set cost per school year (Press Release, page 3, “Annual license fee for unlimited courses and user access to the customer server”)

16. With respect to claim 13, the main difference between this claim and claim 1 is the following limitation:

the second computer operative to allow a user to take the test and received results.

Administrator Guide discloses the second computer on page 5. As discussed above, Administrator Guide also discloses making a test available for a test taker. Receiving test results is not a novel concept for anyone who has ever taken a test. Virtually all test takers receive results of tests they have taken, as the purpose of a typical test is to assess the test taker’s knowledge, skill, or progress, and feedback/result is an essential element of test taking.

17. With respect to claims 14 and 15, see rejection of claim 1 above.

18. With respect to claim 16, **the host system includes a procedure for opening an account for a test-taker** (Administrator Guide, pages 7, 38 and 39).

19. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Administrator Guide in view of Press Release and further in view of Student Guide.

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20. With respect to claim 11, **the compiled test is placed in a restricted directory and the test-taker must have know a password to access the compiled test** (Press Release, page 2, “With powerful security measures for student identification and authentication, ...”; password is a notoriously well known means of authentication). In addition, Student Guide, which is a companion book to the Administrator Guide, specifically confirms that a password is used to access the lessons that contain tests (Student Guide, page 11). It would have been obvious to one of ordinary skill in the art, having the teachings of Administrator Guide and Student Guide before him at the time the invention was made, to require a password to access tests to limit the accessibility for security reasons.

21. With respect to claim 13, Administrator Guide discloses a **system for generating and posting an on-line test, comprising:**

a first computer operatively coupled to the Internet, the first computer including software means for generating the test and software means for posting the test on the Internet (see rejection of claim 1 above); **and**

a second computer operatively coupled to the Internet, the second computer operative to allow a user to take the test (see rejection of claim 1 above). Although it can be inferred that the taker would receive test results, Administrator Guide does not specifically disclose that the system allows a user to **receive test results**. However, this limitation is expressly taught by Student Guide (Student Guide, page 18), which is a companion document to Administrator Guide. It would have been obvious to one of ordinary skill in the art, having the

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teachings of Administrator Guide and Student Guide before him at the time the invention was made, to display the test results when a student takes a test.

Administrator Guide also discloses registration of a test-taker to enroll in a class that includes the compiled test (pages 38-42). However, Administrator Guide and Student Guide do not specifically disclose that the test-taker is required to pay to take the compiled test. Press Release discloses that On Tour media, the company that developed IntraLearn, offered hosting license and a small royalty percentage per student registration as one of two pricing models (Press Release, page 3, Pricing and Availability; see also Declaration of Jerry Goguen executed on April 5th, 2006) disclosing the following limitations:

wherein a test-taker is required to pay to take the compiled test; and

wherein the test-maker and the proprietor of the host system share the revenues generated by the test-taker taking the test.

It also would have been obvious to one of ordinary skill in the art, having the teachings of Administrator Guide and Press Release before him at the time the invention was made, to adopt the pricing model offered by On Tour, to be able to offer on-line courses to paying students.

Amendment in Reexamination Proceedings

22. Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

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In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced. See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Service of Papers

23. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

Extensions of Time

24. 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).

Litigation Reminder

25. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,118,124 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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NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

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

By U.S. Postal Service Mail to:

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

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

By hand to: Customer Service Window
Randolph Building
401 Dulany St.
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.



Majid A. Banankhan
Primary Examiner
Central Reexamination Unit 3992

ESK
wlc