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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000.199	12/01/2006	6988138		7245

20277 7590 03/17/2008

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/17/2008

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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1995 BROADWAY
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NEW YORK, NY 10023-5882

Date:
MAILED

MAR 17 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008330
PATENT NO. : 6988138
ART UNIT : 3900

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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FEB 17 2008
CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

MAILED

MAR 17 2008

CENTRAL REEXAMINATION UNIT

Software Freedom Law Center
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New York, NY 10023-5882

(For *Ex Parte* Requester)

Foley and Lardner LLP
3000 K Street NW
Suite 500
Washington, DC 20007

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

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:
:
: DECISION, *SUA SPONTE*,
: TO MERGE
: REEXAMINATION
: PROCEEDINGS

Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: December 1, 2006
For: U.S. Patent No. 6,988,138

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,988,138 (the '138 patent) issued to Robert L. Alcorn *et al.* on January 17, 2006, and was assigned to Blackboard Inc.

2. A request for *ex parte* reexamination of claims 1-44 of the '138 patent was filed on November 17, 2006, by third party requester Richard E. Fontana, and the request was assigned control number 90/008,330 (the '8330 *ex parte* reexamination proceeding).
3. On January 25, 2007, *ex parte* reexamination was ordered for claims 1-44 of the '138 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability affecting these claims.
4. A request for *inter partes* reexamination of claims 1-44 of the '138 patent was filed on December 1, 2006, by third party requester Desire2Learn, Inc., who is also the real party in interest. The request was assigned control number 95/000,199 (the '0199 *inter partes* reexamination proceeding).
5. On February 26, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8330 *ex parte* reexamination expired after March 25, 2007.¹

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '0199 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

¹ There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from parties.

In accordance with 37 CFR 1.989(a), the 90/008,330 and 95/000,199 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed in this instance.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
 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
 Attn: Central Reexamination Unit
 Randolph Building, Lobby Level
 401 Dulany Street
 Alexandria, VA 22314

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

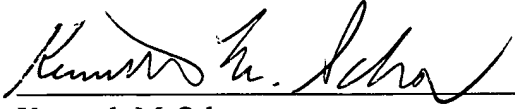
E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,199 and *ex parte* Reexamination Control No. 90/008,330 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.
3. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Mar. 14, 2008

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