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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,330	11/17/2006	6988138		3192

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/25/2008

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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008330 95/000,199
PATENT NO. 6,988,138
ART UNI 3993

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)).

INTER PARTES REEXAMINATION COMMUNICATION	Control No.	90/008,330		Patent Under Reexamination
	95/000,199			6988138
	Examiner	ROLAND G. FOSTER		Art Unit 3992

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

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE
 2 MONTH(S) THIRTY DAYS FROM THE MAILING DATE OF THIS LETTER. EXTENSIONS
 OF TIME FOR PATENT OWNER ARE GOVERNED BY 37 CFR 1.956.

Each time the patent owner responds to this Office action, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

**OFFICE ACTION IN INTER PARTES
REEXAMINATION**

Control No.	95/000,199	Patent Under Reexamination	6988138
Examiner	ROLAND G. FOSTER	Art Unit	3992

20/008,330

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

Responsive to the communication(s) filed by:
Patent Owner on _____
Third Party(ies) on 1 December 2006

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Response:

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

For Third Party Requester's Comments on the Patent Owner Response:

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

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

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-44 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims _____ are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-44 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 been received. not been received. been filed in Application/Control No 95000199.
10. Other _____

DETAILED ACTION

I. SUMMARY

This Office action addresses claims 1-44 of United States Patent No. 6,988,138 B1 (hereafter the "Alcorn" patent), for which it has been determined:

- 1) in the 95/000,199 reexamination, regarding the Order mailed February 26, 2007 granting *inter partes* reexamination, that a substantial new question of patentability was raised in the request for *inter partes* reexamination, filed on December 1, 2006 (hereafter the "'199 Request"), and
- 2) in the 90/008,330 reexamination, regarding the Order granting *ex parte* reexamination mailed January 25, 2007, that a substantial new question of patentability was raised in the request for *ex parte* reexamination, filed on November 17, 2006 (hereafter the "'330 Request").

In the notice of merger, mailed March 17, 2008, a decision was made to merge the 95/000,199 and 90/008,330 reexamination proceedings. As a result, a single Office action on the merged proceeding follows.

II. REJECTIONS PROPOSED BY THE REQUESTER

The following ten categories of rejections were proposed on pages 1 and 2 of the Request.

From the 95/000,199 Proceeding (before Merger)

- Issue 1 Whether *Educom/NLII Instructional Management Systems Specification Document*, Ver. 0.5 (April 29, 1998) ("IMS Specification") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.
- Issue 2 Whether Janison Solutions, *Web Training Toolbox Management Guide* (May 1999) ("Janison Web Training Management Guide") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.
- Issue 3 Whether S.D. Benford, et al., *The Design Document for Ceilidh Version 2*, Learning Technology Research Computer Science Department University of Nottingham (Oct. 21, 1996) ("Ceilidh Design Document") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.
- Issue 4 Whether Fred T. Hofstetter, *Serf User and Administrator's Guide Version 1.0*, University of Delaware (Jan. 1998) ("Serf User Guide") anticipates, or when considered alone or in combination

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with other prior art, renders obvious claims 1-44 of the Alcorn patent.

- Issue 5 Whether *Topclass Version 2.0 Instructor's Guide* (March 1998) ("Topclass Instructor's Guide") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.
- Issue 6 Whether Gilbert Paquette, *Modeling the Virtual Campus* (1995) ("Virtual Campus") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.
- Issue 7 Whether various publications and patents disclosing rule based access control, in combination with other prior art, render obvious claims 1-44 of the Alcorn patent.
- Issue 8 Whether various publications and patents disclosing educational software environments, in combination with other prior art, render obvious claims 1-44 of the Alcorn patent.
- Issue 9 Whether the Earliest Effective Filing Date of Claims 1-44 of the Alcorn Patent is June 30, 2000.

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From the 90/008,330 Proceeding (before Merger)

Issue 10 Whether TopClass Version 1.2.2b, Administrator's Guide (Ireland: WBT Systems, October 1997) ("TopClass Version 1.2 Administrator's Guide") anticipates, or when considered alone or in combination with other prior art, renders obvious claims 1-44 of the Alcorn patent.

**III. REJECTIONS PROPOSED IN THE REQUEST AND ADOPTED
(WITH MODIFICATION OR AS PROPOSED)
(ISSUES 1-6 AND 10)**

The proposed rejections identified in Issue 10 are adopted essentially proposed.

The proposed rejections identified in Issues 1-6 are adopted with modification.

The multiplicity of proposed rejections identified in Issues 1-6 and 10 raise an issue as to whether the rejections are cumulative to any particular proposed rejection. For example, all the publications identified in Issues 1-6 and 10 are directed to the implementing a classroom experience in a virtual, computer-networked environment. Nonetheless, said proposed rejections are adopted for the reasons discussed below and specifically regarding the '199 Request, in order to preserve the parties' appeal rights as to such proposed rejections. See MPEP § 2660.III.

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IV. REJECTIONS PROPOSED IN THE REQUEST AND NOT ADOPTED (ISSUES 7-9)

The proposed rejections identified in Issues 7-9 are not adopted. See the claim rejections below for additional details.

V. CLAIM REJECTIONS

Issue 1

Summary of the IMS Specification

The IMS Specification is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, the IMS Specification teaches a course-based system for providing to an educational community of users access to a plurality of online courses (p. 9, section 2.5.1 and page 38, section 3.6.4.3.2, including the figures).

The IMS Specification publication also teaches a plurality of user computers, with each user computer (client) being associated with a user of the system and with each user having predefined characteristics indicative of roles, such as student, instructor, and administrator (content provider) and thus having access to files associated with these differing roles. Specifically, see Figure 1 below, which is reproduced from page 17 of the IMS Specification.

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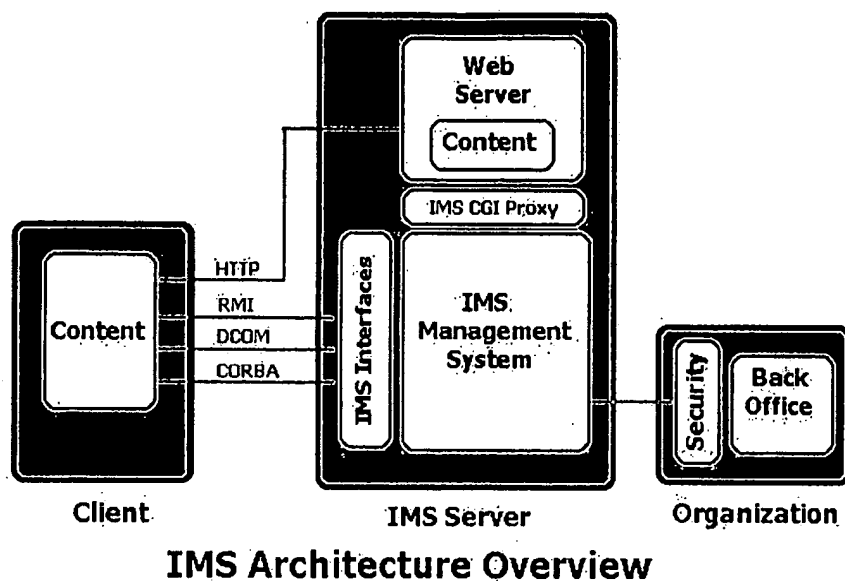


Figure 1. IMS Architecture

Furthermore, the IMS Specification teaches the following at pages 7 and 19 respectively:

There are several stakeholders who will be affected by the IMS. We have defined these stakeholders in terms of the different roles involved in the process of learning. These roles are often performed by the same stakeholder: someone who is a teacher may also play the role of a learner and vice versa; similarly, a content provider may also engage in activities associated with the role of a teacher.

Profiles are mobile, user-controlled collections of personal and educational data. Portfolio information may be stored or referenced within the profile. Preference information such as learning styles, default meta-data selections may be included. An IMS Profile for a user may include both learner-specific and author-specific information since an individual can be both a teacher in one context and a learner in another.

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The Proposed IMS Rejections

The proposed rejection asserts that the IMS Specification anticipates, or renders obvious, in view of various secondary references, claims 1-44 of the Alcorn patent. See pages 1, 9-16, and Appendix "B" to said '199 Request

As discussed above, the IMS Specification is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the IMS Specification is a highly relevant reference.

The Proposed IMS Anticipatory Rejections Are Adopted With Modification

Specifically, the requester asserts that the IMS Specification anticipates claims 1, 2, 7, 9-15, 20, 21, 24, 25, 36, 37, 43, and 44 (page 10 of the '199 Request).

Due to the similarities between the IMS Specification and the Alcorn patent (as discussed above), the proposed anticipatory rejection is adopted with the following modifications. The examiner asserts that the IMS Specification additionally anticipates claims 18 and 19 as consistent with Appendix "B" to said '199 Request. See the claim rejections below for additional details.

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The Proposed IMS Obviousness Rejections Are Not Adopted

The requester also asserts that the IMS Specification renders obvious, by itself or in combination with various secondary references, claims 1-44 (page 10 of the '199 Request). The requester asserts in Appendix "B" however (as discussed above) that the IMS Specification anticipates claims 1, 2, 7, 9-15, 18-21, 24, 25, 36, 37, 43, and 44. Thus, Appendix "B" fails to clearly ascertain the differences between the claimed invention and the prior art. Thus, the proposed rejection fails to set forth a *prima facie* case of obviousness under the *Graham* factors for said claims.

The other proposed obviousness rejections rely upon multiple secondary references teaching similar and overlapping features, rendering the proposed rejections ambiguous as to which secondary reference is actually relied upon.

In addition, the other proposed obviousness rejections rely upon broad and conclusory statements that set forth a legal conclusion of obviousness (see pages 10-16 of the '199 Request). "Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). For example, the requester provides a universal motivation to render multiple claims obvious based on a generalized conclusion of "interoperability." See pages 10 and 11 of the '199 Request. In another example regarding the proposed claim 3 obviousness rejection, the requester argues that "it was

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well known in the art for educational systems, such as IMS, to include announcement files." Said statement does not explicitly set forth an analysis as to why it would have been obvious to combine a teaching, albeit well known, with the base reference.

Thus, the proposed obviousness rejections are not adopted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 9-15, 18-21, 24, 25, 36, 37, 43, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by IMS Specification.

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, those portions of Appendix "B" that relate to claims 1, 2, 7, 9-15, 18-21, 24, 25, 36, 37, 43, and 44 are hereby incorporated by reference.

Issue 2

Summary of the Janison Solutions Management Guide

The Janison Solutions Management Guide is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, the Web Training Management Guide teaches a course-based system for providing to an educational community of users access to a plurality of online courses (page 9).

The Web Training Management Guide publication also teaches a plurality of user computers, with each user computer being associated with a user of the system and with each user having predefined characteristics indicative of roles, such as student, instructor, and administrator, and thus having access to files associated with these differing roles. Specifically, see Figure 2 below, which is reproduced from page 26 of the Web Management Training Guide publication and which illustrates that each user is associated with a computer sufficient to execute a web client browser.

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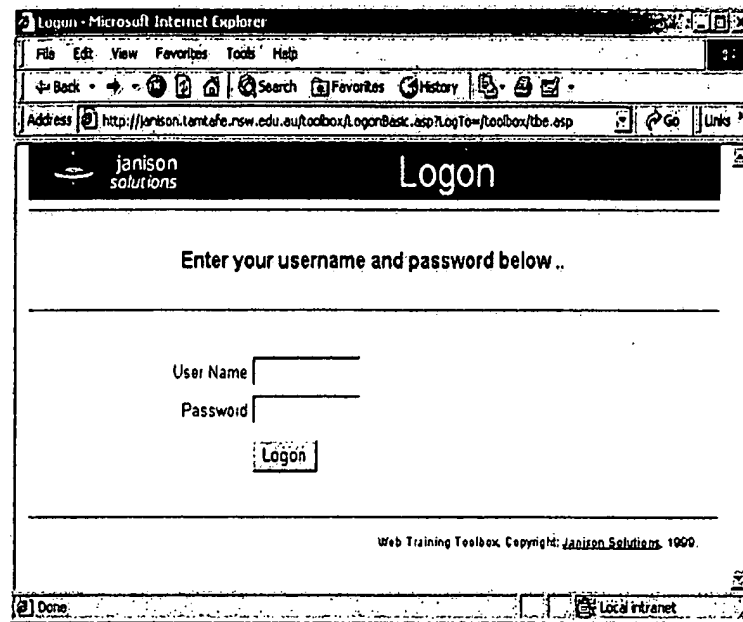


Figure 2. Management Guide Client (Web Browser Running on User Computer)

Regarding predefined roles, the Web Management Training Guide publication further teaches that the users can also be members of a student class, trainers, and administrators (pages 9 and 19) and access files associated with these differing roles (page 7).

The Proposed Janison Rejections

The proposed rejection asserts that the Janison Solutions Management Guide anticipates, or renders obvious, in alone or in combination with other prior art, claims 1-44 of the Alcorn patent. See pages 2, 16 and 17 and Appendix "C" to said '199 Request.

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As discussed above, said Janison publication is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the Janison publication is a highly relevant reference.

The Proposed Janison Anticipatory Rejections Are Not Adopted

The proposed rejection asserts that the Janison Solutions Management Guide anticipates certain claims of the Alcorn patent. See pages 2, 16 and 17 and Appendix "C" to said '199 Request. The Janison Solutions Management Guide is similar to the Alcorn patent as discussed above. The requester however provides no detail on how a single reference, the Janison Solutions Management Guide, anticipates any claims. Indeed Appendix "C" generally relies upon not only the Janison Solutions Management Guide, but also upon Janison Solutions, Web Training Toolbox, Getting Started, June 1999 (hereafter "Janison Web Training Getting Started"). For example, see the proposed claim 1 rejection on pages 1-6 of Appendix "C". Thus, the proposed anticipatory rejection is not adopted.

The Proposed Janison Obviousness Rejections Are Adopted with Modification

The requester also asserts that the Janison Solutions Management Guide renders obvious, by itself or in combination with various secondary references, claims 1-30 and 32-44 of the Alcorn patent (page 17 of the '199 Request).

The proposed 103 rejections however, as formulated in Appendix "C", fail to set forth any reasoning regarding legal conclusions of obviousness (see pages 10-16 of the

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'199 Request). "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Thus, the proposed obviousness rejections are adopted with the following modifications: the examiner adds articulated reasoning to support the legal conclusion of obviousness. See the claim rejections below for additional details.

Claim Rejections - 35 USC § 103

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.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-4, 6-18, 21, 22, 24-30, 32-38, 40, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Solutions, Web Training Toolbox, Getting Started, June 1999 (hereafter "Janison Web Training Getting Started").

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the '199 Request and those pages of Appendix "B" that relate to claims 1-4, 6-18, 21, 22, 24-38, 40, 43, and 44 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison Solutions Management Guide or the Janison Web Training Getting Started publication. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately. This is especially the case since both the Management Guide and the Getting Started publication are both directed to the same system. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, one of ordinary skill in the art, when analyzing the Management Guide base reference, would have looked to a publication describing the same Janison system for additional teachings.

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Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the User Guide to Interactive WWW Ceilidh, Provisional Version 23, September 1996 ("Interactive WWW Ceilidh") and S.D. Benford et al., Installer's Guide to Ceilidh (2.6), Learning Technology Research Computer Science Department University of Nottingham, Revision for Ceilidh 2.6, Jan. 23, 1997 ("Installer's Guide to Ceilidh").

This rejection was proposed by the third party requester in said Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the Request and pages 8 and 9 of Appendix "C" that relate to claim 5 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Ceilidh publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., a file that contains staff information). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology (e.g., making staff information available to

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students using a computer files rather than the older method of posting class staff information in a catalog or public bulletin board). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of computers) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the S.D. Benford et al., Teacher's Guide to Ceilidh 2.7, Learning Technology Research Computer Science Department University of Nottingham, Oct. 16, 1997 ("Teacher's Guide to Ceilidh") and S.D. Benford et al., Student's Guide to Ceilidh Version 2.5, Learning Technology Research Computer Science Department University of Nottingham, September 16, 1997 ("Student's Guide to Ceilidh").

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the '199 Request and pages 14-18 of Appendix "C" that relate to claims 19 and 20 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Ceilidh publications. Thus, the claimed invention is merely a combination of old elements, and in combination each

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element merely would have performed the same functions as it did separately (e.g., making a grade available to a user and the instructor collating and reviewing a plurality of grades). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology (e.g., making grade information available via the World Wide Web rather than the older method of using a grade report card). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of computers) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the S.D. Benford et al., The Design Document for Ceilidh Version 2, Learning Technology Research Computer Science Department University of Nottingham, Oct. 21, 1996 (“Design Document for Ceilidh”).

This rejection was proposed by the third party requester in said ‘199 Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the ‘199

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Request and page 20 of Appendix "C" that relate to claim 23 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Ceilidh publication. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., using a dropbox file to relay information between the student and instructor). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology (e.g., using a dropbox file structure that allows information transfer via the world wide web rather than using an actual dropbox to physically transfer information). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of computers) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the Topclass Instructor's Guide.

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This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 29 of Appendix "C" that relate to claim 31 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Topclass Instructor's Guide. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., selecting a hyperlink that provides a web page comprising data regarding instructors of the course). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology (e.g., selecting hyperlinks to retrieve course information, such as data regarding the instructors rather than the older method of posting class staff information in a course catalog or public bulletin board). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of computers) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

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Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the Design Document for Ceilidh and the Student's Guide to Ceilidh.

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the '199 Request and pages 82 and 83 of Appendix "C" that relate to claim 39 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Ceilidh publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., posting the grade to a file on the server computer accessible to the student). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology (e.g., making grades available to a student via a computer server rather than the older method of sending the student a report card). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of

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computers) that is commonly available and understood in the art and thus obvious.

Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Janison Solutions Management Guide in view of the Janison Web Training Getting Started, and further in view of the Teacher's Guide to Ceilidh and the Student's Guide to Ceilidh.

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 17 of the '199 Request and pages 87, 88 and 90 of Appendix "C" that relate to claims 41 and 42 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by either the Janison publications or the Ceilidh publication. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., the process of assigning grades taking into account statistical data regarding the grades). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relate to implementing a classroom environment using modern technology

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(e.g., assigning grades using statistical information via a computer program rather than the older method of manually grading assignments and then assigning grades after manually calculating statistics for the class). The combination is an adaptation of an old idea (performing typical classroom tasks) using newer technology (computer automation) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Issue 3

Summary of the Ceilidh Design Document

The Ceilidh Design Document is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, the Ceilidh Design Document teaches a course-based system for providing to an educational community of users access to a plurality of online courses. The Ceilidh Design Document teaches on page 1 that:

Ceilidh is a course management system. The main objective of Ceilidh is to support teaching and learning through computer. As a course management system, it also provides some facilities for the course teacher to organize the teaching and to monitor the progress of the students attending the course.

The Ceilidh Design Document publication also teaches a plurality of user computers (page 5), with each user computer being associated with a user of the system and with each user having predefined characteristics indicative of roles, such as student, instructor, and administrator, and thus having access to files associated with these differing roles (page 2).

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The Proposed Ceilidh Rejections

The proposed rejection asserts that the Ceilidh Design Document anticipates, or renders obvious, in alone or in combination with other prior art, claims 1-44 of the Alcorn patent. See pages 2 and 19 of the '199 Request and Appendix "D" to said '199 Request.

As discussed above, said Design Document is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the Design Document is a highly relevant reference.

The Proposed Ceilidh Anticipatory Rejections Are Not Adopted

The proposed rejection asserts that the Ceilidh Design Document anticipates claim 1. See page 19 of the '199 Request and pages 1-11 of Appendix "D" to said '199 Request. The Ceilidh Design Document is similar to the Alcorn patent as discussed above. The requester however provides no detail on how a single reference, the Ceilidh Design Document, anticipates any claims. Indeed, the proposed rejection of claim 1 relies upon other Ceilidh publications to teach certain limitations within the claim (e.g., see page 1 of Appendix "B"). Thus, the proposed anticipatory rejection is not adopted.

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The Proposed Ceilidh Obviousness Rejections Are Adopted with Modification

The requester also asserts that the Ceilidh Design Document renders obvious, by itself or in combination with various Ceilidh related references, claims 1-28 and 36-44 of the Alcorn patent (page 17 of the '199 Request).

The proposed 103 rejections however, as formulated in Appendix "D" (including additional rejections of claims 29-35 not addressed in the '199 Request), fail to set forth sufficient reasoning regarding legal conclusions of obviousness. "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Thus, the proposed obviousness rejections are adopted with the following modifications: the examiner adds articulated reasoning to support the legal conclusion of obviousness. See the claim rejections below for additional details.

Claim Rejections - 35 USC § 103

Claims 1-34 and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Ceilidh Design Document Janison Solutions Management Guide in view of the Janison Solutions, Web Training Toolbox, Getting Started, June 1999 (hereafter "Janison Web Training Getting Started") in view of various other Ceilidh publications specifically identified for each claim rejection on page 19 of the '199 Request and Appendix "D".

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This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, pages 17-20 of the '199 Request and those pages of Appendix "D" that relate to claims 1-34 and 36-44 are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by at least one of the Ceilidh related publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately. This is especially the case since both the Ceilidh publications are both directed to the same system. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, one of ordinary skill in the art, when analyzing the Ceilidh Design Document base reference, would have looked to a publication describing the same Ceilidh system for additional teachings.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Ceilidh Design Document and further in view of Janison Web Training Getting Started.

This rejection was proposed by the third party requester and is adopted with modification for the reasons discussed above. Thus, pages 36-38 of Appendix "D" that relate to claim 35 are hereby incorporated by reference.

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In addition, the examiner further notes that each element of the claimed inventions is taught by either the Ceilidh publications or the Janison publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately (e.g., providing asynchronous communications, e.g., discussion groups or email, or synchronous communications, e.g., real-time chat). Thus, one of ordinary skill in the art would have recognized that the results of the combination were predictable. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, the combination relates to implementing a classroom environment using modern technology (e.g., communicating via asynchronous communications, e.g., discussion groups, or synchronous communications, e.g., real-time chat rather than the older method of students and instructors discussing classroom topics in the classroom). The combination is an adaptation of an old idea (implementing a classroom environment) using newer technology (World Wide Web network of computers supporting various communication modes) that is commonly available and understood in the art and thus obvious. Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Issue 4

Summary of the Serf User Guide

The Serf User Guide is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, the Serf User Guide teaches a course-based

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system for providing to an educational community of users access to a plurality of online courses. The Serf User Guide teaches on page 99 that:

Serf is an acronym that stands for Server-side educational records facilitator. It's your servant on the Internet; hence the name Serf. Serf provides an environment for delivering courses anywhere in the world, using the World Wide Web as a distance education medium.

Thus, the Serf User Guide publication also teaches a plurality of computer associated with the user's World Wide Web access.

The Serf User Guide publication also teaches that each user has predefined characteristics indicative of roles, such as student, instructor, and administrator, and thus having access to files associated with these differing roles. For example, the Serf User Guide teaches on page 99 that:

Serf provides support for students, teaching assistants, instructors, and administrators. The administrators use Serf to create courses and enroll students. Instructors use Serf to create their course syllabus, which consists of an ordered list of instructional events, assignments, and multimedia resources. Teaching assistants help the instructor provide services to students, and may assist in the grading of the assignments. The beneficiary is you, the student, who partakes in a learning environment rich in multimedia resources and Internet services.

The Proposed Serf Rejections

The proposed rejection asserts that the Serf User Guide anticipates, or renders obvious, in alone or in combination with other prior art, claims 1-44 of the Alcorn patent. See pages 2 and 20 of the '199 Request and Appendix "E" to said '199 Request.

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As discussed above, said Serf User Guide is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the Serf User Guide is a highly relevant reference.

The Proposed Serf Anticipatory Rejections Are Not Adopted

The proposed rejection asserts that the Serf User Guide anticipates claims 1-3, 7, 8, 10-12, 18-20, 22-30, 32-34, 37-42 and 44. See page 20 of the '199 Request and Appendix "E" to said '199 Request. The Serf User Guide is similar to the Alcorn patent as discussed above. The requester however provides no detail on how a single reference, the Serf User Guide, anticipates any claims. Indeed, the proposed rejection of claim 1 relies upon other Serf publications to teach certain limitations within the claim (e.g., see page 8 of Appendix "E"). Thus, the proposed anticipatory rejection is not adopted.

The Proposed Serf Obviousness Rejections Are Adopted with Modification

The requester also asserts that the Serf User Guide renders obvious, by itself or in combination with various Ceilidh related references, claims 1-44 of the Alcorn patent (page 21 of the '199 Request).

The proposed 103 rejections however, as formulated in Appendix "E" fail to set forth sufficient reasoning regarding legal conclusions of obviousness. "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741

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(2007). In addition, the proposed rejection asserts that the Serf User Guide renders obvious by itself claims 1-3, 7, 8, 10-12, 18-20, 22-30, 32-34, 37-42 and 44. See page 21 of the '199 Request and Appendix "E" to said '199 Request. The requester however provides no detail on how a single reference, the Serf User Guide, renders obvious any claims. Indeed, the proposed rejection of claim 1 relies upon other Serf publications to teach certain limitations within the claim (e.g., see page 8 of Appendix "E"). Thus, the proposed obviousness rejection based on the Serf User Guide alone is not adopted. However, modifying the 103 rejections based on Serf to rely not only upon the Serf User guide, but also the other two Serf related publications, which are also applied to every claim rejection in Appendix "E", would remedy this situation.

Thus, the proposed obviousness rejections are adopted with the following modifications: claims 1-44 are rejected based upon the combination of all three Serf related publications, which is also consistent with Appendix "E". The examiner also adds articulated reasoning to support the legal conclusion of obviousness. See the claim rejections below for additional details.

Claim Rejections - 35 USC § 103

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Serf User Guide in view of F. Hofstetter, Virtual Learning Environments, Serf's Up: Teaching and Learning with Serf, Your Servant on the Internet ("Serf's Up") and F.

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Hofstetter, Three Waves of the Serf Web-Based Teaching and Learning Environment,
May 19, 1999 ("Three Waves of Serf").

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 21 and Appendix "D" are hereby incorporated by reference.

In addition, the examiner further notes that each element of the claimed inventions is taught by at least one of the Serf related publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately. This is especially the case since all Serf publications are both directed to the same system. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, one of ordinary skill in the art, when analyzing the Serf User Guide base reference, would have looked to a publication describing the same Serf system for additional teachings.

Issue 5

Summary of Topclass Version 2.0 Instructor's Guide

The Topclass Version 2.0 Instructor's Guide is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, TopClass

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teaches a course-based system for providing to an educational community of users access to a plurality of online courses. Specifically, TopClass teaches a "learning environment that distributes course materials" and "allow[s] on-line communication between instructors and students." TopClass, pp. 1 and 4. "Students are users who are taking courses" and instructors assist students taking courses. TopClass, p. 4. Student users are assigned to one or more classes, each having a specific set of course material; instructors are assigned to one or more classes, and for each class they have a number of students assigned to them. TopClass, p. 74.

The TopClass Publication also teaches a plurality of user computers, with each user computer being associated with a user of the system and with each user having predefined characteristics indicative of roles, such as student, instructor, and administrator. Specifically, TopClass teaches that each user has a computer (http client) associated with the TopClass server, as illustrated in Figure 1, which is reproduced as Figure 3 below.

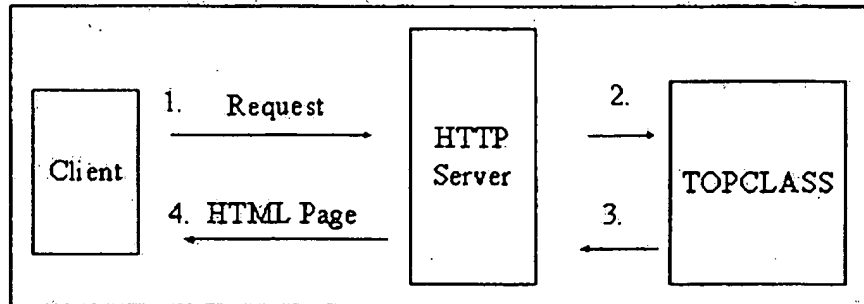


Figure 1. TopClass, HTTP Server and Client

1. The Client sends a TopClass HTTP request to the server.
2. The HTTP Server passes the request directly to TopClass.
3. TopClass generates the appropriate HTML page and returns it to the HTTP server.
4. The HTTP server sends the page and any associated media files to the client.

Figure 3. TopClass, HTTP Server and Client

Furthermore, TopClass teaches a course-based system with three predefined categories of user: student, instructors, and administrators. TopClass, pp. 4-6, 19, 23-24, and 74-81. "[A]dministrators always have access to the entire TopClass server." TopClass, p. 74. Students have limited access to system files (they are not given any of the security privileges described in TopClass at pp. 78-80). Instructors' access to create and edit files depends on the configuration of security privileges for each instructor, which determines the degree to which an instructor can edit course files, modify individual student coursework, create and edit class announcements, and delete messages posted to class discussion lists. TopClass, pp. 78-80. See also TopClass, p. 32 (illustrated "Access Preferences" page can be used by administrator to "specify default access rights for various system objects," including checkboxes for administrators, instructors, and

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students that can be used to determine whether a particular predefined user category can, for example, view, edit, or delete messages and course unit material).

The Proposed Topclass Rejections

The proposed rejection asserts that the Topclass Instruction Guide anticipates, or renders obvious, in alone or in combination with other prior art, claims 1-44 of the Alcorn patent. See pages 2 and 21 of the '199 Request and Appendix "F" to said '199 Request.

As discussed above, said Topclass Instruction Guide is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the Topclass Instruction Guide is a highly relevant reference.

The Proposed Topclass Rejections Are Not Adopted

The proposed rejection asserts that the Topclass Instruction Guide anticipates certain claims of the Alcorn patent. See page 21 of the '199 Request and Appendix "F" to said '199 Request. The Topclass publication is similar to the Alcorn patent as discussed above. The requester however provides no detail on how a single reference, the Topclass Instruction Guide, anticipates any claims. Indeed, the proposed rejection of claim 1 relies upon other Topclass publications to teach certain limitations within the claim (e.g., see pages 1-11 of Appendix "F"). Thus, the proposed anticipatory rejection is not adopted.

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The Proposed Topclass Obviousness Rejections Are Adopted with Modification

The requester also asserts that the Topclass Instruction Guide renders obvious, by itself or in combination with various Topclass related references, claims 1-44 of the Alcorn patent (page 21 of the '199 Request).

The proposed 103 rejections however, as formulated in Appendix "F" fail to set forth sufficient reasoning regarding legal conclusions of obviousness. "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The requester however provides no detail on how a single reference, e.g., the Topclass Instruction Guide, renders obvious any claims. Indeed, the proposed rejection of claim 1 relies upon another Topclass publication, The Topclass Administrator's Guide, to teach certain limitations within the claim (e.g., see pages 1-11 of Appendix "F"). Thus, the proposed obviousness rejection based on the Topclass Installation Guide is not adopted. However, modifying the 103 rejections based on Topclass to rely not only upon the Topclass Installation guide, but also the Topclass Administrator's Guide, which was also applied to almost every claim rejection in Appendix "F", would remedy this situation.

The other proposed obviousness rejections (e.g., claims 10, 20, 28-35, 42, and 44) rely upon multiple secondary references teaching similar and overlapping features, rendering the proposed rejections ambiguous as to which secondary reference is actually

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relied upon. Furthermore, the proposed 103 rejections however, as formulated in Appendix "E" fail to set forth sufficient reasoning regarding legal conclusions of obviousness. "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Thus, the proposed obviousness rejections are adopted with the following modifications: claims 1-9, 11-19, 21-27, 36-41, and 43 are rejected based upon the combination of both Topclass publications, which is also consistent with Appendix "F". The examiner also adds articulated reasoning to support the legal conclusion of obviousness. See the claim rejections below for additional details.

Claim Rejections - 35 USC § 103

Claims 1-9, 11-19, 21-27, 36-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Topclass Instructor's Guide in view of the Topclass Version 2.0.0 Administrator's Guide, March 1998 ("Topclass Administrator's Guide').

This rejection was proposed by the third party requester in said '199 Request and is adopted with modification for the reasons discussed above. Thus, page 21 and those portions of Appendix "F" that relate claims 1-9, 11-19, 21-27, 36-41, and 43 are hereby incorporated by reference.

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In addition, the examiner further notes that each element of the claimed inventions is taught by at least one of the Topclass related publications. Thus, the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same functions as it did separately. This is especially the case since all Topclass publications are both directed to the same system. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” KSR Intern. Co. V. Teleflex Inc., 127 S.Ct. 1727, 1749 (2007). In addition, one of ordinary skill in the art, when analyzing the Topclass Instructor’s Guide base reference, would have looked to a publication describing the same Topclass system for additional teachings.

Issue 6

Summary of the Virtual Campus Publication

The Virtual Campus publication is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, the Virtual Campus publication teaches a course-based system for providing to an educational community of users access to a plurality of online courses. For example, the Virtual Campus publication teaches on page 4 that:

The Virtual Campus rests on the interaction of different actors with resources on a network. These actors meet to participate in learning events: curriculum programs, courses, learning units, or single learning activities.

The Virtual Campus publication also teaches a plurality of user computers, with each user computer being associated with a user of the system and with each user having

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predefined characteristics indicative of roles, such as student, instructor, and administrator (content provider) and thus having access to files associated with these differing roles. Specifically, see Figure 4 below, which is reproduced from page 17, Figure 1 of the Virtual Campus publication.

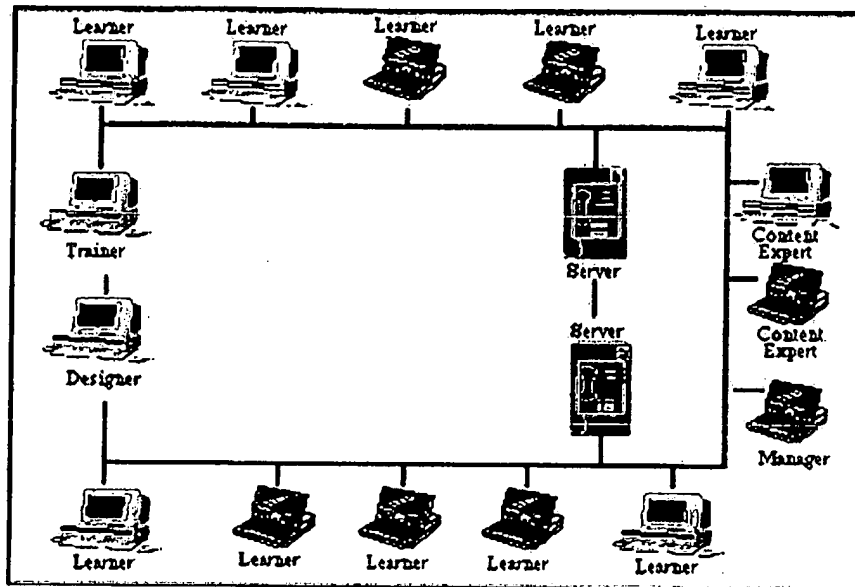


Figure 4. Actors Networked in the Virtual Campus

Regarding predefined roles, the Virtual Campus publication further teaches that the users can also be members of a student class (learners), instructor (trainers), and administrators (managers) and access files associated with these differing roles (page 5).

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The Proposed Virtual Campus Rejections

The proposed rejection asserts that the Virtual Campus publication anticipates, or renders obvious, in view of various secondary references, claims 1-44 of the Alcorn patent. See pages 2, 22, 23, and Appendix "G" to said '199 Request

As discussed above, the Virtual Campus publication is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the Virtual Camps publication is a highly relevant reference.

The Proposed Virtual Campus Anticipatory Rejections Are Adopted as Proposed

Specifically, the requester asserts that the Virtual Campus publication anticipates claims 1, 2, 6, 7, 9-11, 13, 14, 36, 37, 43, and 44 (page 22 of the '199 Request) as is also consistent with the proposed rejections formulated in Appendix "G."

Due to the similarities between the Virtual Campus publication and the Alcorn patent (as discussed above), the proposed anticipatory rejection is adopted as proposed.

The Proposed Virtual Campus Obviousness Rejections Are Not Adopted

The requester also asserts that the Virtual Campus publication renders obvious, by itself or in combination with various secondary references, claims 1-44 (page 22 of the '199 Request). The requester asserts in Appendix "G" however (as discussed above) that the Virtual Campus publication anticipates claims 1, 2, 6, 7, 9-11, 13, 14, 36, 37, 43, and

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44. Thus, Appendix "G" fails to clearly ascertain the differences between the claimed invention and the prior art. Thus, the proposed rejection fails to set forth a *prima facie* case of obviousness under the *Graham* factors for said claims. In addition, these proposed 103 rejections however, as formulated in Appendix "G", fail to set forth sufficient reasoning regarding legal conclusions of obviousness. "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Thus, the proposed obviousness rejections are not adopted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 7, 9-11, 13, 14, 36, 37, 43, and 44 are rejected under 35

U.S.C. 102(b) as being anticipated by the Virtual Campus publication.

This rejection was proposed by the third party requester in said '199 Request and is adopted as proposed. Thus, pages 22 and 23 of the '199 Request and those pages of Appendix "G" that relate to claims 1, 2, 6, 7, 9-11, 13, 14, 36, 37, 43, and 44 are hereby incorporated by reference.

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Issue 7

The proposed rejection asserts that claims 1-44 of the Alcorn patent are rendered obvious by various publications and patents disclosing rule based access control, considered in combination with other prior art. See pages 23-29 of the '199 Request. The proposed rejections however fail to include even a minimal claim by claim analysis comparing limitations from the Alcorn patent claims to elements of the prior art and thus fails to ascertain the differences between the claimed invention and the prior art. Thus, the proposed rejection fails to set forth a *prima facie* case of obviousness under the *Graham* factors for said claims. Thus, the proposed rejections are not adopted.

Issue 8

The proposed rejection asserts that claims 1-44 of the Alcorn patent are rendered obvious by various publications describing educational software environments, considered in combination with other prior art. See pages 29-34 of the '199 Request and Appendix "H". The proposed rejections however fail to include even a minimal claim by claim analysis comparing limitations from the Alcorn patent claims to element of the prior art and thus fails to ascertain the differences between the claimed invention and the prior art. Thus, the proposed rejection fails to set forth a *prima facie* case of obviousness under the *Graham* factors for said claims. Thus, the proposed rejections are not adopted.

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Issue 9**Whether the Earliest Effective Filing Date of Claims 1-44
of the Alcorn Patent is June 30, 2000.**

MPEP § 2658.I.C, citing to 2258.I.C, states that rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. No intervening patents or printed publications (i.e., prior art with an effective date before the filing data of the Alcorn patent, but after the filing date of the earlier U.S. provisional applications whose priority is sought) were applied in this Office action. Thus, the issue of the earliest effective date of claims 1-44 of the Alcorn patent will not be addressed and rejections based on a lack of priority will not be adopted at this time.

Issue 10**Summary of Topclass Version 1.2 Administrator's Guide**

The Topclass Version 1.2 Administrator's Guide is substantially similar to the invention taught in the Alcorn patent under reexamination. For example, For example, TopClass teaches a course-based system for providing to an educational community of users access to a plurality of online courses. Specifically, TopClass teaches a "learning environment that distributes course materials" and "allow[s] on-line communication between instructors and students." TopClass, pp. 1 and 4. "Students are users who are taking courses" and instructors assist students taking courses. TopClass, p. 4. Student

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users are assigned to one or more classes, each having a specific set of course material; instructors are assigned to one or more classes, and for each class they have a number of students assigned to them. .TopClass, p. 74.

The TopClass publication also teaches a plurality of user computers, with each user computer being associated with a user of the system and with each user having predefined characteristics indicative of roles, such as student, instructor, and administrator. Specifically, TopClass teaches that each user has a computer (http client) associated with the TopClass server, as illustrated in Fig. 1, and as reproduced below.

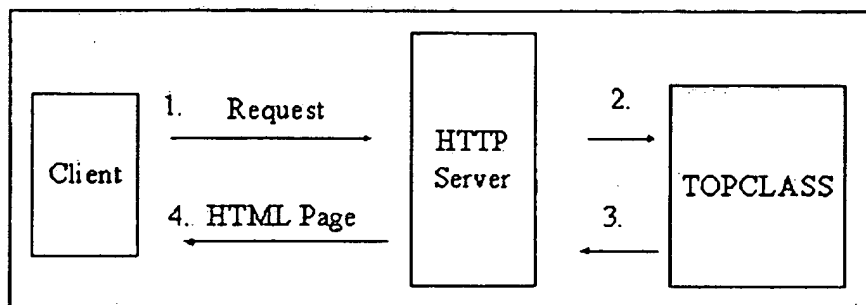


Figure 1. TopClass, HTTP Server and Client

1. The Client sends a TopClass HTTP request to the server.
2. The HTTP Server passes the request directly to TopClass.
3. TopClass generates the appropriate HTML page and returns it to the HTTP server.
4. The HTTP server sends the page and any associated media files to the client.

Furthermore, TopClass teaches a course-based system with three predefined categories of user: student, instructors, and administrators. TopClass, pp. 4-6, 19, 23-24, and 74-81. "[A]dministrators always have access to the entire TopClass server."

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TopClass, p. 74. Students have limited access to system files (they are not given any of the security privileges described in TopClass at pp. 78-80). Instructors' access to create and edit files depends on the configuration of security privileges for each instructor, which determines the degree to which an instructor can edit course files, modify individual student coursework, create and edit class announcements, and delete messages posted to class discussion lists. TopClass, pp. 78-80. See also TopClass, p. 32 (illustrated "Access Preferences" page can be used by administrator to "specify default access rights for various system objects," including checkboxes for administrators, instructors, and students that can be used to determine whether a particular predefined user category can, for example, view, edit, or delete messages and course unit material).

The Proposed Topclass Version 1.2 Administrator's Guide Rejections

The proposed rejection asserts that the Topclass Version 1.2 publication anticipates, or renders obvious, in view of various secondary references, claims 1-44 of the Alcorn patent. See pages 1, 9-16, and Appendix "B" to said '199 Request

As discussed above, the IMS Specification is substantially similar to the invention taught in the specification of the Alcorn patent under reexamination. Thus, the IMS Specification is a highly relevant reference.

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The Proposed Topclass Version 1.2 Administrator's Guide
Anticipatory Rejections Are Adopted as Proposed

Specifically, the requester asserts that the Topclass Version 1.2 Administrator's Guide anticipates claims 1-7, 9, 11-21, 24-34, 36-40, and 43 (page 1 of the '330 Request).

Due to the similarities between the Topclass Version 1.2 Administrator's Guide and the Alcorn patent (as discussed above), the proposed anticipatory rejection is adopted as proposed.

The Proposed Topclass Version 1.2 Administrator's Guide
Obviousness Rejections Are Adopted with Modification

The requester also asserts that the Topclass publication renders obvious, by itself or in combination with various secondary references, claims 1-44 (page 10 of the '330 Request). The requester asserts on page 1 however (as discussed above) that the Topclass publication anticipates claims 1-7, 9, 11-21, 24-34, 36-40, and 43. Thus, the '330 Request fails to clearly ascertain the differences between the claimed invention and the prior art. Thus, the proposed rejection fails to set forth a *prima facie* case of obviousness under the *Graham* factors for said claims.

The other proposed obviousness rejections however clearly set forth a *prima facie* case of obviousness and thus are adopted as proposed.

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Claim Rejections - 35 USC § 102

Claims 1-7, 9, 11-21, 24-34, 36-40, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by the Toplcass Version 1.2 Administrator's Guide publication.

This rejection was proposed by the third party requester in said '330 Request and is adopted as proposed. Thus, pages 4-18 of the '330 Request (claim rejection chart) that that relate to claims 1-7, 9, 11-21, 24-34, 36-40, and 43 are hereby incorporated by reference.

Claim Rejections - 35 USC § 103

Claims 8, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Toplcass Version 1.2 Administrator's Guide publication, and further in view of Galt et al., "Information Sharing: Collaborating Across the Networks," Proceedings of the 11th Annual International Conference on Systems Documentation, (Waterloo, Ontario, Canada, 1993), 361-362 (New York: ACM Press, 1993) ("Galt").

This rejection was proposed by the third party requester in said '330 Request and is adopted as proposed. Thus, pages 4-18 of the '330 Request (claim rejection chart) that that relate to claims 8, 22, and 23 are hereby incorporated by reference.

Claims 10, 35, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Toplcass Version 1.2 Administrator's Guide publication, and further in view of Hartley et al., "Enhancing Teaching Using the Internet: Report of the Working Group on

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the World Wide Web as an Interactive Teaching Resource," Proceedings of the 1st Conference on Integrating Technology into Computer Science Education (Barcelona, June 2-6, 1996) 218-228 (New York: ACM Press, 1996) ("Hartley").

This rejection was proposed by the third party requester in said '330 Request and is adopted as proposed. Thus, pages 4-18 of the '330 Request (claim rejection chart) that that relate to claims 10, 35, and 44 are hereby incorporated by reference.

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Topclass Version 1.2 Administrator's Guide publication, and further in view of U.S. Patent No. 5,002,491 ("Abrahamson").

This rejection was proposed by the third party requester in said '330 Request and is adopted as proposed. Thus, pages 4-18 of the '330 Request (claim rejection chart) that that relate to claims 41 and 42 are hereby incorporated by reference.

VI. Conclusion

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 an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116, which will be strictly enforced.

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. 35 U.S.C. 314(b)(3).

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.985(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the Benoit patent (U.S. Patent No. 6,988,138 B1) 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 through the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

Art Unit: 3992

All correspondence relating to this inter partes reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop *Inter Partes* 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 examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:




Roland G. Foster
Primary Examiner
Central Reexamination Unit 3992

Conferees:




ERIC S. KEASEL
CRU SPE-AU 3992

Reexamination 	Application/Control No. 95000199 90/009,330	Applicant(s)/Patent Under Reexamination 6988138
	Certificate Date	Certificate Number

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LITIGATION REVIEW <input checked="" type="checkbox"/>	rgf (examiner initials)	03/07/2008 (date)
Case Name		Director Initials
Blackboard, Inc. V. Desire2Learn, Inc., E.D.Tex., CV No. 9:06		<i>Eui</i> <i>Travis</i> <i>Er</i> <i>LMM</i>

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TYPE OF PROCEEDING	NUMBER
1. Ex Parte	90008330