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

7590 01/25/2007

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2007

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SOFTWARE FREEDOM LAW CENTER

1995 BROADWAY

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NEW YORK, NY 10023-5882

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008330

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 replly has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/008,330	Patent Under Reexamination 6988138	
	Examiner Roland G. Foster	Art Unit 3992	

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

The request for *ex parte* reexamination filed *17 November 2006* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO/SB/08, c)☒ Other: *See the Decision.*

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

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

Roland G. Foster
Primary Examiner
Art Unit: 3992

cc:Requester (if third party requester)

DECISION

A substantial new question of patentability affecting claims 1-44 of United States Patent No. 6,988,138 B1 to Alcorn et al. (hereinafter "Alcorn") is raised by the request for *ex parte* reexamination, filed on November 17, 2006 (hereinafter the "Request").

Pages 1 and 2 of the Request identifies the following printed publications as providing teachings relevant to the claims of the Alcorn patent:

1. TopClass Version 1.2.2b Administrator's Guide (Ireland: WBT Systems, October 1997) (hereinafter "TopClass").

2. "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) (hereinafter "Galt").

3. "Enhancing Teaching Using the Internet: Report of the Working Group on 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) (hereinafter "Hartley").

4. U.S. Patent No. 5,002,491 to Abrahamson et al. (hereinafter "Abrahamson").

A reasonable examiner would consider the above prior references important in making a decision as to the patentability of claims 1-44 of the Alcorn patent.

Identification of Every Claim for Which Reexamination is Requested

Every claim for which reexamination has been requested has been identified in the Request. For example, see pages 1 and 2 of the Request.

Statement Pointing Out Each Substantial New Question of Patentability

The Request points out each substantial new question of patentability. See pages 1 and 2 of the Request. The above-cited references were not of record in the prosecution of U.S. Application No. 09/608,208 (later issuing as the Alcorn patent for which reexamination is requested) (hereinafter the '208 Application). Thus, each question raised in the request is also a new question.

During the prosecution of the '208 Application, the examiner gave the following reasons for allowing claims 1, 3-36, and 38-46 (later renumbered and issuing as claims 1-44) in the Notice of Allowance, mailed August 18, 2005:

> The following is an examiner's statement of reasons for allowance: None of the prior art teach or suggest a course...based system for providing to... an educational community of users access to a plurality of online courses, comprising: a plurality of user computers, with each user computer being associated with a user of the system and with each user being capable of having predefined characteristics indicative of multiple predetermined roles in the system, each role providing a level of access to a plurality of data files associated with the course, with the multiple predetermined user roles comprising at least two user's predetermined roles selected from the group consisting of a student role in one or more course associated with a student user, an instructor role in one or more courses associated with an instructor user and an administrator role associated with an administrator user.

Therefore, all prior art references applied in the Request that, alone or in combination, purport to teach the features described above would be better (i.e., not cumulative) to references previously considered by the examiner.

Detailed Explanation of How the Cited Prior Art Is Applied to Every Claim for Which Reexamination Is Requested

The above-cited publications are separately discussed regarding how they apply to claims 1-44 of the Alcorn patent. For example, see pages 4-18 of the Request.

The TopClass Publication

In view of the examiner's reasons for allowing all claims in the '208 application (later maturing as the Alcorn patent) as discussed above, a reasonable examiner would consider the TopClass publication important in making a decision as to the patentability of all claims in the Alcorn patent. 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 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.

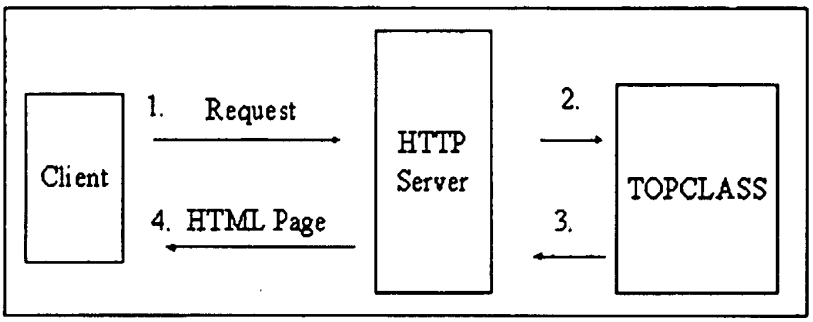

Figure 1. TopClass, HTTP Server and Client

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." 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).

See also pages 4-18 of the Request, especially pages 4 and 5, which address representative, independent claim 1.

The TopClass publication was not previously discussed by the examiner nor applied to claims in the prior examination of the patent as discussed above.

There was also no final holding of invalidity by the Federal Courts regarding the Alcorn patent.

Thus, a reasonable examiner would view the teachings of the TopClass publication important in deciding to allow the claims being considered, thus raising a substantial new question of patentability regarding claims 1-44 of the Alcorn patent.

The Galt, Hartley, Abrahamson Publications

A reasonable examiner would consider the Galt, Hartley, and Abrahamson publications important in making a decision as to the patentability of claims 1-44 of the Alcorn patent. The Request proposes using said publications as secondary teaching references in combination with the TopClass publication in order to raise a substantial new question regarding certain dependent claims, specifically claims 8, 10, 22, 23, 35, 41, 42, and 44. See pages 1 and 2 of the Request. The TopClass publication however was determined by itself to raise a substantial new question of patentability as to claims 1-44 of the Alcorn patent, as discussed above. Thus, all proposed combination of references based on Alcorn, such as the ones described in the Request involving Galt, Hartley, and Abrahamson, also raise a substantial new question of patentability at least for similar reasons. For additional reasons, such as a detailed explanation of how said combinations are proposed to be applied to said dependent claims, see pages 7, 8, 10, 11, 14, 17, and 18 of the Request .

The Galt, Hartley, and Abrahamson publications were not previously discussed by the examiner nor applied to claims in the prior examination of the patent as discussed above.

There was also no final holding of invalidity by the Federal Courts regarding the Alcorn patent.

Thus, a reasonable examiner would consider Galt, Hartley, and Abrahamson important in deciding to allow the claims being considered, thus raising a substantial new question of patentability regarding claims 1-44 of the Alcorn patent.

Conclusion

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).

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 the Alcorn patent throughout the course of this reexamination proceeding. The requester is also reminded of the ability to similarly appraise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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.

Signed:

Roland G. Foster
Central Reexamination Unit, Primary Examiner
Electrical Art Unit 3992
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