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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DARSHAN TIMBADIA, STEVE HENDERSHOTT, and
KEN BERGER

Appeal 2010-002877
Application 10/712,938
Technology Center 3700

Before STEVEN D. A. MCCARTHY, EDWARD A. BROWN, and
WILLIAM V. SAINDON, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Darshan Timbadia et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the decision of the Examiner rejecting claims 1, 13, and 20. App. Br. 6. Claims 2-12, 14-19, and 21-27 were canceled. *Id.* at 2. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

CLAIMED SUBJECT MATTER

Claims 1, 13, and 20 are independent. Claim 1, reproduced below, is illustrative:

1. A system for administering an examination comprising:
 - one or more testing stations, configured to receive a plurality of test items, to display the test items to a user, to record state information comprising time elapsed from the start of the examination, identification of test items displayed to the user, and user interactions with the testing stations, and to transmit changes to the state information at the same time that the state information is recorded including when the user provides responses to the test items;
 - a first server computer system in communication with the one or more testing stations, wherein the first server computer system is configured to electronically transmit the test items to the one or more testing stations, receive user information and responses to the test items from the one or more testing stations, receive the state information from the one or more testing stations, and electronically store the state information at the same time that the state information is received; and

a second server computer system in communication with the first server computer system, wherein the second server computer system is configured to receive user information and responses to the test items from the first server computer system and to deliver test packages to the first server computer system,

wherein upon failure of the testing station, an initial state object and changed state objects stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred, and wherein the user will not be penalized for the time that questions are not available.

REJECTION

Claims 1, 13, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kershaw (US 5,565,316; iss. Oct. 15, 1996) and Ashley (US 2004/0229199 A1; pub. Nov. 18, 2004).

ANALYSIS

Claims 1 and 13 – Written Description Support

Claim 1 recites the limitations: (1) “wherein upon failure of the testing station, an initial state object and changed state objects stored on the server are used to recreate the examination on the testing station” (“First Feature”) and (2) “wherein the user will not be penalized for the time that questions are not available” (“Second Feature”). Claim 13 recites substantially similar claim features. The Examiner found that Provisional Application 60/425,740 (“the provisional application”), from which Appellants claim priority, does not provide adequate written description support under 35 U.S.C. § 112, first paragraph, for these two features. Final Rej. 2. Thus, the

Examiner determined that claims 1 and 13 are not entitled to the benefit of the filing date of the provisional application (i.e., November 13, 2002), which predates the earliest effective filing date of Ashley (i.e., April 16, 2003). *Id.*

Appellants contend that the invention recited in claims 1 and 13 is entitled to a priority date of the provisional application, and therefore Ashley does not qualify as prior art for the purposes of 35 U.S.C. § 103(a). App. Br. 7.

For claims 1 and 13 of the present, non-provisional application to obtain the benefit of the filing date of the provisional application,

the specification of the *provisional* must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention *claimed* in the *non-provisional* application.

New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002). To satisfy the written description requirement, the specification of Appellants’ provisional application must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed subject matter as of the filing date of the application. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991). Specifically, the specification of Appellants’ provisional application must describe the claimed invention in a manner understandable to a person of ordinary skill in the art and show that the inventor actually invented the claimed invention. *See id.* The claimed invention need not be recited *in haec verba* in the original specification to satisfy the written

description requirement. *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc).

First Feature

The Examiner determined that the provisional application provides support for reconstruction of an examination based upon state objects stored on a server, but that “one of those objects being ‘an initial state object’ is not taught.” Ans. 6. The Examiner found that the initial state object as described in the non-provisional application is created at a central server and transmitted to the testing station, and that this is the exact opposite of the initial state object as described in the provisional application, which is a transmission from the testing station to the server. *Id.* at 7.

Appellants contend that it is irrelevant that the creation of the initial state object is described differently in the non-provisional application than in the provisional application, because claims 1 and 13 do not contain any limitations regarding where the initial state object originates from. Reply Br. 4. Thus, Appellants contend that the Examiner is improperly reading limitations from the Specification into claims 1 and 13. *Id.* at 4-5.

The provisional application describes a method for performing state management in which “the testing station 130a transmits the test state, including an elapsed time which may be zero and the user’s answers if any, at the beginning of the test and periodically thereafter.” Provisional Application Spec., p. 10, ll. 29-31. Appellants contend that a test state transmission with an elapsed time of zero and no user’s answers at the beginning of the test provides support for an “initial state object” as claimed in claims 1 and 13. App. Br. 10-11. The non-provisional application describes a method for performing state management in which “[t]he service

center...creates an initial state object...and stores the initial state object on a data storage device. The initial state object is delivered from the service center to the testing station.” Non-Provisional Application Spec., p. 12, para. [0032].

As noted *supra*, the issue is whether the description provided in the provisional application allows a person of ordinary skill in the art to recognize and reasonably conclude that the inventors had possession of the initial state object as recited in claims 1 and 13. The initial state object as defined in claims 1 and 13 is stored on a server and, upon testing station failure, is used to recreate an exam. The Examiner made no finding that the provisional application fails to provide support for an initial state object having these characteristics. Additionally, Appellants correctly contend that claims 1 and 13 do not recite any limitation as to where the initial state object is created. The Examiner also found that the method of performing state management as shown in Figure 2 of the non-provisional application includes significant modifications as compared to Figure 2 of the provisional application. Ans. 7-8. However, the Examiner did not find that these modifications in the non-provisional application were relied on by Appellants in defining the first feature recited in claims 1 and 13. *See* Reply Br. 4-5.

Accordingly, Appellants’ contention that a person of ordinary skill in the art would read the provisional application as supporting the First Feature as defined in claims 1 and 13 is persuasive.

Second Feature

The Examiner also found that the provisional application lacks support for the Second Feature as recited in claims 1 and 13. Ans. 9. The

Examiner acknowledged that this language in claims 1 and 13 appears word-for-word in the provisional application, but concluded that this disclosure only demonstrates a broad-ranging concept, and does not demonstrate that Appellants had possession of the narrower concept of not penalizing students for time lost during the fault recovery process. *Id.* As support for this conclusion, the Examiner found that the provisional application only describes a specific example of not penalizing a student for time lost due to latency in the transmission of questions to the student during the examination. *Id.*

Appellants contend that the provisional application describes using a test state to recover an exam after testing station failure, the test state including an elapsed test time that takes into consideration any amount of time that a test is unavailable to the user. App. Br. 12. We agree.

The Examiner's interpretation of what the provisional application describes in regard to the Second Feature is unreasonably narrow. The provisional application states that, after testing station failure, the user resumes the test "starting from the state of the test at the time of failure." Provisional Application Spec., p. 10, l. 11. The test state includes an elapsed test time, which takes into account any time the test is unavailable to the user. *Id.* at p. 10, ll. 13-15. A person of ordinary skill in the art reading the provisional application specification, as a whole, would conclude that recreating the test based on the state of the test at the time of a testing station failure would require not penalizing the user for time lost due to this failure. Thus, Appellants' contention that a person of ordinary skill in the art would read the provisional application as also supporting the Second Feature as defined in claims 1 and 13 is persuasive.

We conclude that the subject matter recited in claims 1 and 13 is entitled to a priority date of the provisional application, and therefore Ashley does not qualify as proper prior art. Thus, the rejection of claims 1 and 13 is not sustained.

Claim 20 – Written Description Support

The Examiner found that the provisional application does not provide adequate written description support under 35 U.S.C. § 112, first paragraph for claim 20. Claim 20 recites the feature “restarting the examination following failure of the testing station wherein the initial state object and the changes to the initial state object stored on the server computer are used to recreate the examination on the testing station.” Appellants’ contentions (App. Br. 15-16; Reply Br. 2) and the Examiner’s findings and conclusions (Ans. 5) regarding this feature are the same as those discussed *supra* regarding the First Feature of claims 1 and 13. However, claim 20 defines “an initial state object” differently from claims 1 and 13, and thus, requires different analysis.

Particularly, claim 20 recites the steps of “creating an initial state object on the server computer” and “delivering the initial state object to the one or more testing stations.” As discussed *supra*, the Examiner found that an initial state object created on a server and transmitted to a testing station lacks support in the provisional application, and can only be supported by the non-provisional application. Ans. 6-9. Appellants responded that “[c]laim 1 does not contain any limitations regarding from where the initial state object originates.” Reply Br. 4. However, unlike claim 1, claim 20 requires the initial state object to originate on the server computer. The only part of the provisional application that Appellants cite to as providing

support for the concept of an initial state object describes an initial test transmission *originating from the testing station*. App. Br. 10-11. As such, we conclude that a person of ordinary skill in the art would read the provisional application as not supporting an initial state object as defined in claim 20, and thus that this claim is not entitled to the benefit of the filing date of the provisional application.

Claim 20 – Rejection over Kershaw and Ashley¹

Ashley

The Examiner found that the computer based testing system disclosed in Ashley teaches the feature “delivering changes to the initial state object...at the same time that each user interaction occurs” as recited in claim 20. Ans. 4. Appellants contend that Ashley teaches that the student responses saved on a local disk are simultaneously transmitted to a server, but provides no teaching as to when the student responses are saved to the local disk in relation to when the student responses are provided. App. Br. 14. Appellants conclude that the Examiner is mistaken to assume that, in Ashley, the students’ responses are transmitted to the satellite server at the same time the student provides responses to the test items. *Id.*

The Examiner responds that Appellants are attacking the references individually and disregarding the teachings of Kershaw. Ans. 10. The Examiner found that Kershaw discloses that student responses are recorded

¹ The Examiner’s “Grounds of Rejection” states that claims 1, 13, and 20 are rejected over Kershaw in view of Ashley. Ans. 2-3. However, as discussed *infra*, the Examiner also relied on Official Notice for a claim feature found missing from both Kershaw and Ashley. *Id.* at 4. Accordingly, we treat the rejection as being over the combination of Kershaw, Ashley, and Official Notice.

in a log, and saved in an examinee file simultaneously to them being provided by a user. *Id.* The Examiner found that Kershaw does not transmit these saved logs to a server when they are created, but that Ashley discloses that any time information is stored to a local disk, this information is simultaneously transmitted to a local server. *Id.* at 10-11. Thus, the Examiner concluded that the combined teachings of Kershaw and Ashley suggest the simultaneous transmission feature of claim 20. *Id.* at 11.

Appellants do not apprise us of any error in the Examiner's findings or conclusion regarding what the combined teachings of Kershaw and Ashley would have suggested to a person of ordinary skill in the art, or in the Examiner's rationale for combining these teachings.

Official Notice

The Examiner also found that Kershaw and Ashley fail to disclose the limitation "wherein the user will not be penalized for the time that questions are not available," as recited in claim 20. Ans. 4. The Examiner took Official Notice that this feature is well known in the art of standardized testing, and concluded that it would have been obvious to include this feature within the inventions of Kershaw and Ashley to ensure that the student is given the entirety of the time allotted for completion of the test. *Id.*; Final Rej. 4.

Appellants traverse that Examiner's use of Official Notice. Reply Br. 6. Particularly, Appellants state:

Here, the examiner and applicant are debating the "wherein" clause of claims 1, 13, and 20, both from the standpoint of what the prior art teaches and what applicants' provisional application discloses. The examiner purports to rely upon official notice for a feature, for which the cited

prior art is silent, while contending that applicants' provisional application containing textual support for the feature is insufficient to establish a priority date. The examiner's use of official notice is unquestionably being used as principle evidence in the rejection and, as such, is facially improper.

Reply Br. 8. We understand that the basis of the traversal is that there is an inconsistency in the Examiner taking Official Notice of a claimed feature, while also finding that the provisional application lacked support for the same claimed feature.

An adequate traversal to a finding of Official Notice must “contain adequate information or argument” to create on its face “a reasonable doubt regarding the circumstances justifying the ... notice” of what is well known to an ordinarily skilled artisan. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). To adequately traverse a finding of Official Notice, an applicant must specifically point out the supposed errors in the Examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. *See* Manual of Patent Examining Procedure § 2144.03(C) (Eighth Ed., Rev. 9, Aug. 2012).

Appellants’ traversal does not, however, explain why the noticed fact is not considered to be common knowledge or well-known in the art. Additionally, Appellants have not provided persuasive argument as to why the Examiner’s findings are inconsistent. A claimed feature that is common knowledge in the art must nevertheless have adequate written description support in the specification to demonstrate to a person of ordinary skill in the art that the inventors had possession of the claimed invention at the time of the filing of the application. *See Vas-Cath* at 1562-63. Moreover, we determined *supra* that the Second Feature, which was the subject of the

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Official Notice, was properly supported in the provisional application, thus resolving any alleged inconsistency in the Examiner's positions.

Consequently, we find that Appellants' traversal of the Examiner's use of Official Notice to be non-persuasive.

DECISION

The Examiner's rejection of claim 20 is **AFFIRMED**, and the rejection of claims 1 and 13 is **REVERSED**. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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