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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
11/748,952 05/15/2007 Keith O'Loughlin 50398-00006 7346

25231 7590 11/23/2016
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Table with 1 column: EXAMINER

YIP, JACK

Table with 2 columns: ART UNIT, PAPER NUMBER

3715

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

11/23/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KEITH O'LOUGHLIN, DAVID HARRISON,  
NIALL DARBY, PADRAIG CUMMINS, and LORRAINE MOORE

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Appeal 2014-005124  
Application 11/748,952<sup>1</sup>  
Technology Center 3700

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Before ANTON W. FETTING, BART A. GERSTEBLITH, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–4, 7, 8, 11–17, 19, 21, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to the Appellants, the real party in interest is Intuition Publishing Limited. Appeal Br. 1.

### ILLUSTRATIVE CLAIM

Claims 1 and 14 are the independent claims on appeal. Claim 1 is illustrative of the subject matter on appeal and is reproduced below.

1. A sharable content object reference model (SCORM) compliant e-learning system, the system being operative to intermittently configure with independently operable standalone SCORM compliant courseware applications defining a plurality of designated tasks, a plurality of remote handheld devices associated with respective users, the system including:

a central server configured to communicate intermittently with the handheld devices over a wireless network, the central server having provided thereon a management module and a datastore configured to store a plurality of standalone SCORM compliant courseware applications, the management module being configured to selectively transmit the standalone SCORM compliant courseware applications from the datastore to selected ones of the handheld devices over the wireless network for execution thereon,

a software application deployed over the wireless network in a series of computer executable files and locally stored and executable on each handheld device of the remote user for facilitating execution of the transmitted standalone SCORM compliant courseware on the respective handheld devices, the software application being configured to enable an interface of the handheld device with the central server over the wireless network to obtain intermittent downloads from the central server to the respective handheld devices, the software application being separate from the courseware and wherein subsequent to execution of the application on the respective handheld devices personalized courseware is distributed to the respective handheld devices from the central server,

a SCORM compliant tracking module configured to ensure that information transmitted by the tracking module is SCORM compliant, the tracking module having software components residing on each of the central server and the handheld devices that communicate with each other via the

network for performing a tracking function, the tracking module software component on the handheld devices being configured to track the adequate completion of the designated tasks on the handheld devices and to periodically provide that information to the corresponding tracking module software component on the central server, thereby selectively triggering the transmission of a further standalone SCORM compliant courseware application from the datastore over the wireless network to the selected handheld device after confirmation being received at the central server that the designated tasks of the previous standalone SCORM compliant courseware application on the handheld devices have been adequately completed.

#### CITED REFERENCES

The Examiner relies upon the following references:

Donahue	US 2003/0039948 A1	Feb. 27, 2003
Riggs	US 2003/0073065 A1	Apr. 17, 2003
Berger et al. (hereinafter "Berger")	US 2003/0087219 A1	May 8, 2003
Doty	US 2003/0152904 A1	Aug. 14, 2003
Crowhurst et al. (hereinafter "Crowhurst")	US 2005/0026130 A1	Feb. 3, 2005
Allen et al. (hereinafter "Allen")	US 2005/0202392 A1	Sept. 15, 2005
Morrison	US 2006/0188860 A1	Aug. 24, 2006

#### REJECTIONS

- I. Claims 1, 11, 12, 14, 17, 21, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue and Crowhurst.
- II. Claims 2–4, 7, 8, 13, 15, 16, and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue, Crowhurst, and Riggs.

III. Claims 1, 11, 12, 14, 17, 21, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, Doty, and Crowhurst.

IV. Claims 2–4, 8, 13, 15, and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, Doty, Crowhurst, and Berger.

V. Claims 7 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, Doty, Crowhurst, Berger, and Allen.

#### FINDINGS OF FACT

We rely upon and adopt the Examiner’s findings stated in the Final Office Action at pages 2–35 and the Answer at pages 2–46. Additional findings of fact may appear in the Analysis below.

#### ANALYSIS

##### ***Rejections I and II***

Between Rejections I and II, all claims on appeal — claims 1–4, 7, 8, 11–17, 19, 21, and 22 — stand rejected under 35 U.S.C. § 103(a) as unpatentable over Donahue combined with one or more other references.

The Appellants contend that the Examiner erred in rejecting claim 1 because Donahue fails to teach or suggest the features of the claimed “software application” and “tracking module” and because the Examiner purportedly relied upon impermissible hindsight. Appeal Br. 9–13.

As to the “software application,” the Appellants argue (*id.* at 9–10) that Donahue lacks the following features:

“the software application being configured to enable an interface of the handheld device with the central server over the wireless network to obtain intermittent downloads from the central server to the respective handheld devices”;

and

“the software application being separate from the courseware and wherein subsequent to execution of the application on the respective handheld devices personalized courseware is distributed to the respective handheld devices from the central server.”

The Appellants contend that these features are interrelated because “[s]eparating courseware and the software required to run the courseware does not require a continuous or synchronous link between the client and server as in the case of lesson elements being presented using the system of Donahue.” *Id.* at 10.

As to the “tracking module,” the Appellants contend that claim 1 provides, and Donahue lacks, functionality to track “the adequate completion of the designated tasks on the handheld devices and to periodically provide that information to the corresponding tracking module software component on the central server.” *Id.* On account of the claimed “tracking module,” the Appellants explain, “the distributed locally accessible coursework is monitored and tracked locally without requiring a connection to the server as the user is completing the coursework.” *Id.*

Further, the Appellants contend, “it is only with the benefit of hindsight and Appellants’ specification that one could appreciate the deficiencies of Donahue with respect to delivering courseware to devices which were able to execute code without being in constant contact with a server, but where that server nonetheless had to deliver material to such devices in as rationalized a manner as possible.” *Id.* at 13.

However, the Final Office Action relies upon Crowhurst — not Donahue — for the teaching of a “software application” that is “deployed over the wireless network in a series of computer executable files and locally

stored and executable on each handheld device of the remote user.” Answer 34; Final Action 11.

Further, the Examiner correctly finds that the claimed “software application being separate from the courseware” and the related attributes of not requiring a continuous link between the client and server (*see* Appeal Br. 10) are taught by Donahue (Answer 35; Final Action 4–5). Indeed, Donahue states:

In the embodiments of this invention which employ a link between the user(s) and a remote system server **138**, such as an Internet connection (block **136** is **FIG. 5**, for example), the system and method **10** of this invention is operative to allow the user to study offline at least at times. Lesson elements can be downloaded into the memory at the workstation or computer of the user from the remote server **138**, during which time the user may disconnect his or her link via the Internet to the computer system. This is especially advantageous considering continuous use of an Internet connection occupies a telephone or DSL line, and inadvertent disconnects with the Internet are quite common which could interrupt the session of a user and perhaps result in lost data. If the user proceeds with a lesson to the point of the system adaptively formulating a new or second subset of lesson elements, and all or some of the new lesson elements are not present in the memory of the user’s computer, the system **10** is operative to re-establish a connection to the remote server **138** via the Internet or other telecommunications network and obtain additional content from the lesson element database.

Donahue ¶ 81. Although the Examiner identified this teaching of Donahue in the Final Office Action (at pages 4–5), the Appellants did not address the corresponding portion of Donahue in the Appeal Brief.

Similarly, with regard to the claimed “tracking module,” the Examiner correctly finds that Donahue teaches such functionality. Final Action 5–6;

Answer 37. The Appellants do not address the Examiner's citations to Donahue (*see* Final Action 5–6) in support of this finding.

As to the Appellants' argument that the rejection of claim 1 relies upon impermissible hindsight (Appeal Br. 12–13), the Examiner properly finds that Crowhurst's teaching of plugins to add functionality to a computer-based testing system provides an adequate reason for combining the references relied upon. Final Action 12 (citing Crowhurst ¶¶ 72–73); Answer 40–41 (citing Crowhurst ¶¶ 72–73). A reference may provide a motivation to combine prior art teachings. *See In re Kahn*, 441 F.3d 977, 987–88 (Fed. Cir. 2006).

In view of the foregoing analysis, the Appellants' arguments are not persuasive of error by the Examiner in rejecting claim 1 based on a combination of Donahue and Crowhurst.

As to the other claims on appeal that are also rejected in Rejections I and II, the Appellants rely upon the arguments presented for claim 1. Appeal Br. 13–14.

Accordingly, we sustain Examiner's rejection of claims 1–4, 7, 8, 11–17, 19, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Donahue combined with one or more other references, in Rejections I and II.

***Rejections III, IV, and V***

Among Rejections III, IV, and V, all claims on appeal — claims 1–4, 7, 8, 11–17, 19, 21, and 22 — stand rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison combined with other references.

The Appellants contend that the Examiner erred in rejecting claim 1 because Morrison fails to teach or suggest the features of the claimed

“software application” and because the Examiner purportedly relied upon impermissible hindsight. Appeal Br. 15.

Specifically, the Appellants argue that Morrison does not disclose claim 1’s “software application being separate from the courseware and wherein subsequent to execution of the application on the respective handheld devices personalized courseware is distributed to the respective handheld devices from the central server.” *Id.*

However, the Examiner’s Answer points out that the Final Office Action relies upon Doty — not Morrison — for teaching claim 1’s “software application being separate from the courseware.” Answer 42–43 (citing Final Action 24). Furthermore, the Examiner relies on Crowhurst — not Morrison — to teach the “personalized courseware is distributed to the respective handheld devices from the central server.” Answer 43.

Therefore, the Appellants’ argument about alleged deficiencies of Morrison is unpersuasive, because one cannot show non-obviousness by attacking references individually where a rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

The Appellants do not cite any evidence to support the allegation that the combination of Morrison with Doty and Crowhurst relies upon impermissible hindsight. Appeal Br. 15. In any event, the Examiner properly finds that the Doty and Crowhurst references provide bases for combining the references. Answer 44–45.

In view of the foregoing analysis, the Appellants’ arguments are not persuasive of error by the Examiner in rejecting claim 1 based on a combination of Morrison, Doty, and Crowhurst.

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As to the other claims on appeal that are also rejected in Rejections III, IV, and V, the Appellants rely upon the arguments presented for claim 1. Appeal Br. 13–14.

Accordingly, we sustain the Examiner’s rejection of claims 1–4, 7, 8, 11–17, 19, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Morrison combined with the other references relied upon in Rejections III, IV, and V.

#### DECISION

We AFFIRM the Examiner’s decision rejecting claims 1–4, 7, 8, 11–17, 19, 21, and 22 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED