

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS D. POTTER

Appeal No. 2006-1963
Application No. 09/951,321
Technology Center 3700

ON BRIEF

Before CRAWFORD, NAPPI and FETTING, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 28 through 47. For the reasons stated *infra* we affirm the examiner's rejection of these claims.

Invention

The invention relates to an incentive based method for training over a communication network wherein the trainees are also tested. See pages 6 and 7 of the appellant's specification. Claim 28 is representative of the invention and reproduced below:

28. A method of administering an incentive-based training program using a central processing station which communicates with a training program participant, said method comprising:
- (a) presenting training materials to said training program participant;
 - (b) presenting a test comprising a subset of a plurality of test questions and soliciting answers from said participant;
 - (c) determining a percentage score based on said answers which were answered correctly; and
 - (1) if said percentage score is at least a pre-determined percentage, awarding points to said participant; and
 - (2) if said percentage score is less than a pre-determined percentage, then:
 - (i) retesting said participant using a different subset of said plurality of test questions, wherein said different subset is selected on a basis independent of said answers which were answered incorrectly; and
 - (ii) scoring retest answers from said participant

References

The references relied upon by the examiner are:

Lee	6,064,856	May 16, 2000
Lotvin	5,907,831	May 25, 1999

Rejections at Issue

Claims 28 through 37 stand rejected under 35 U.S.C. § 112 first paragraph as being based upon a disclosure that is non-enabling. The examiner's rejection is set forth on page 4 the answer. Claims 28 through 47 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lee in view of Lotvin. The examiner's rejection is set forth on pages 4 and 5 of the answer.¹ Throughout the opinion we make reference to the briefs, the answer and the Office action for the respective details thereof.

¹ We note that the final rejection dated 12/30/2004 also contains a rejection based upon 35 U.S.C. § 112 second paragraph and 35 U.S.C. § 101. However, on page 3 of the answer, the examiner states that these rejections have been withdrawn.

Opinion

We have considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of lack of enablement and obviousness relied upon by the examiner in support of the rejections. We have likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we will not sustain the examiner's rejection of claims 28 through 37 under 35 U.S.C. § 112 first paragraph, however we will sustain the examiner's rejections of claims 28 through 48 under 35 U.S.C. § 103(a).

Rejection of claims 28 through 37 under 35 U.S.C. § 112 first paragraph.

Appellant argues, on page 12 of the brief, that the specification discloses that in order to prevent the participant of the test from retaking the same test, questions for the retest are drawn randomly from a pool of questions. Thus, appellant argues on page 13 of the brief that there is no skewing of the questions towards incorrectly answered material, and it would not require undue experimentation to select test questions independent of the incorrect answers given. Appellant presents similar arguments on pages 1 and 2 of the reply brief.

On pages 6 and 7 of the answer, the examiner responds to appellant's arguments concerning the rejection under 35 U.S.C. § 112 first paragraph. The examiner states on pages 6 and 7 of the answer:

In appellant's claim language they specifically recite that the selection is not based upon incorrectly answered questions. This limitation recites specific features, which are to be used in the selection, and adds a specific purpose to the selection, thereby removing the complete randomness of the selection as described in

appellant's specification. The appellant has not shown how a selection of questions, which are not skewed towards those questions, previously answered incorrectly, is guaranteed, nor does the specification as originally filed show that the applicant has possession of the claimed feature at the time of filing. The limitation as claimed constitutes a negative limitation. There is no teaching in the specification as originally filed that shows the explicit exclusion of selections based upon incorrectly answered questions. The only positive teaching in the specification is that the user is not to be presented with the exact same subset of questions and that this is achieved through a random number generator.

We disagree with the examiner's rationale. The test for enablement under the first paragraph of 35 U.S.C. § 112, is whether one reasonably skilled in the art could make or use the claimed invention from the disclosed subject matter together with information in the art, without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert denied*, 490 U.S. 1046 (1989). A disclosure can be enabling even though some experimentation is necessary. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert denied*, 480 U.S. 947 (1987). As appellant asserts, we find that appellant's originally filed specification, on page 23 discusses randomly selecting the questions of the retest. As the examiner finds, random means "lacking a definite plan or pattern." Thus, we find that one skilled in the art would recognize that randomly selecting the questions means that the questions are selected independent of any pattern or criteria. As such we hold that appellant's specification would enable one skilled in the art to perform a method wherein the retest questions are "selected on a basis independent of said answers which were answered incorrectly" as a random selection is such an independent selection. Accordingly, we will not sustain the examiner's rejection of claims 28 through 37 under 35 U.S.C. § 112 first paragraph.

Rejection of claims 28 and the claims dependent thereupon.

Appellant argues on page 16 of the brief, that the prior art cited by the examiner does not teach the claim 28 limitation of “retesting said participant using a different subset of said plurality of these questions, wherein said different subset is selected on a basis independent of said answers which were answered incorrectly.” Appellant asserts on pages 16 and 17 of the brief:

Lee discloses an educational system where students are presented with subject matter and they answer "a series of questions retrieved from a database of questions associated with the particular lesson segment for the student." See column 7, lines 10-12. Lee also discloses that after "playing this remedial material, the same or different questions as those previously answered incorrectly will again be displayed and answered." See column 7, line 35-38 (emphasis added). Therefore, Lee discloses selecting new questions based on the wrong answers provided by the student and redisplaying questions previously answered correctly. As such, Lee fails to disclose Appellants [sic] explicitly recited limitation.

Appellant presents similar arguments on pages 2 and 3 of the reply brief.

We disagree with appellant’s characterization of Lee. Lee discloses a teaching system where material is presented to a student and when the material is presented to the student a quiz is given to the student. See steps 153, 154 and 180 of figure 3 and discussion in column 6, lines 15 through 26. Lee teaches that questions are retrieved from a database of questions and are presented to the student. See column 7, lines 10 through 17. Lee teaches that if the student does not answer all of the questions correctly the material relating to the questions (remedial material) is presented to the student. See column 7, lines 23 through 30. Alternatively, the remedial material may be presented if the student’s score on the quiz is below a threshold amount. Lee states “ [a]fter playing this remedial material, the same or different questions as those previously answered incorrectly will again be displayed and answered.” Thus, Lee teaches that there are two types of re-quiz(es) which can be given a) using the same questions as previously

answered incorrectly; or b) using different questions. We note that there is some ambiguity in Lee as to whether the same questions previously answered incorrectly refers to the same group of questions as used in the quiz the student did not pass or whether it refers to the individual questions. Nonetheless, there is no ambiguity in that Lee's reference to different questions being selected for the retest teaches that the questions in the retest are not the same as those previously presented. Further, as appellant's argument seem to imply that the newly selected different questions are based upon the individual questions answered incorrectly; we find no teaching in Lee that suggests that the different questions used in the retest are selected based upon the questions incorrectly answered in a previous test. Thus, appellant's arguments have not convinced us of error in the examiner's rejection of claim 28 or the claims 29 through 35 and 39 which depend upon claim 28.

Rejection of independent claim 38 and the claims dependent thereupon.

Appellant argues, on page 17 of the brief, that the prior art cited by the examiner does not teach the claim 38 limitation of "if said [participant's] percentage score is less than a pre-determined percentage, then [performing the step of] displaying said training materials." Appellant asserts that this limitation requires that a participant who does not achieve a satisfactory score is presented all of the training materials. Appellant argues that Lee teaches a system that retrieves and replays only materials relating to those questions which were missed and that the replayed material is part of a different presentation which corresponds to the lesson segment. Appellant presents similar arguments on page 3 of the reply brief.

Appellant's arguments have not persuaded of error in the examiner's rejection. Independent claim 38 recites "presenting training materials to said training program participant" and "if said percentage score is less then a pre-determined percentage, then: (i) displaying said training materials." We note that neither of the limitations which discuss the training materials recite that all of the training materials are presented or

displayed. Further, we note that appellant's specification, on pages 21 and 22, describe the training materials as a web site with links to other web pages. The user selects a link to select the material they wish to review. Thus, appellant's specification, while discussing the availability of all of the training material does not automatically present or display all of the training materials as appellant argues is the proper interpretation of claim 38. We consider the scope of the claim limitation "presenting training materials" to include a step of making available to a user a set of information, "training materials", we do not consider the claim to be limited to the amount of the training materials which are viewed by the training program participant. We consider the scope of the claim limitation "displaying said training materials" to include a step where information, training materials, are displayed for the training program participant to view, we do not find that the limitation necessarily requires that information displayed to be the same as may have been viewed by the participant in the step of "presenting" (i.e., we consider the scope of the claim to include that the material displayed in the step of "displaying" to include a subset of the information made available in the step of "presenting", however we do not consider the claim to require that all of the information made available in the step of "presenting" is displayed in the step of "displaying.")

As the examiner identifies in the answer, Lee teaches several scenarios for presenting training materials prior to retest. In one embodiment Lee states, in column 7, lines 24 through 28:

If the student has incorrectly answered some [of the] questions, the process flows back to block **153** of FIG. **3** and the program retrieves and replays only material relating to those questions which were missed. This replayed material could be excerpted from the original presentation or it could be new material.

Thus, Lee teaches that the information presented to the student after the test, may be a subset of the information presented prior to the test. As discussed above, the scope of claim 38 includes that the information displayed after the test is a subset of the

information made available prior to the test. We find that Lee's step of initially displaying the training materials, meets the claimed "presenting training materials" and Lee's teaching of displaying materials related to the questions answered incorrectly to meet the appellant's claimed step of "displaying said training materials." Thus, appellant's arguments have not persuaded us of error in the examiner's rejection and we find ample evidence to support the examiner's rejection of claim 38 and the claims dependent thereupon, claims 39 through 47. Accordingly, we will sustain the examiner's rejection of claims 38 through 47 under 35 U.S.C. §103.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellant (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

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Conclusion

In summary, we will not sustain the examiner's rejection of claims 28 through 37 under 35 U.S.C. § 112 first paragraph, however we will sustain the examiner's rejections of claims 28 through 48 under 35 U.S.C. § 103(a). The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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