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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/893,795	09/29/2010	Julie Ward Drew	82264730	4783
56436	7590	11/02/2016	EXAMINER	
Hewlett Packard Enterprise 3404 E. Harmony Road Mail Stop 79 Fort Collins, CO 80528			GILKEY, CARRIE STRODER	
			ART UNIT	PAPER NUMBER
			3689	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JULIE WARD DREW and RUXIAN WANG

Appeal 2014-005296
Application 12/893,795
Technology Center 3600

Before: BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants¹ seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–20 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

¹ The Appellants identify the real party in interest as “Hewlett-Packard Development Company” (App. Br. 2.)

THE INVENTION

The Appellants' claimed invention is directed to utility determinations in product replacement and plan coverage (Spec., para. 9). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computing device comprising:
a processor to:
receive a request to determine an expected net utility attributable to a customer based on a service plan coverage decision and a product replacement decision of the customer for a plurality of corresponding time periods,
recursively determine expected net utility values for each possible coverage decision and each possible product replacement decision in each period of the plurality of time periods, wherein the expected net utility value for each coverage decision is based on an immediate utility value in a current time period and the expected net utility value of the product replacement decision from a next time period, and
determine the expected net utility attributable to the customer over the plurality of time periods using a set of initial values and the determined utility values for each time period.

THE REJECTIONS

The following rejections are before us for review²:

1. Claims 1–20 are rejected under 35 U.S.C. § 112, first paragraph for failure to meet the enablement requirement.
2. Claims 1–20 are rejected under 35 U.S.C. § 112, first paragraph for failure to meet the written description requirement and show possession of the invention.

² The Answer indicates at page 13 that the rejection under 35 U.S.C. § 112, second paragraph has been withdrawn.

3. Claims 9–15 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
4. Claims 1, 9, and 10 are rejected under 35 U.S.C. § 102(b) as anticipated by Steinberg (US 2005/0220280 A1, pub. Oct. 6, 2005).
5. Claims 2–5 and 11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Steinberg.
6. Claims 6, 12–14, and 16–18 are rejected under 35 U.S.C. § 103(a) under Steinberg and Pierce (US 2009/0043596 A1, pub. Feb. 12, 2009).
7. Claims 7, 8, 15, 19, and 20 are rejected under 35 U.S.C. § 103(a) under Steinberg, Pierce, and Greenstein et al. (US 2006/0064304 A1, pub. Mar. 23, 2006, “Greenstein”).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.³

ANALYSIS

Rejections under 35 U.S.C. § 112, first paragraph

Enablement

The PTO bears the initial burden when rejecting claims for lack of enablement. It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (Explaining the general evidentiary standard for proceedings before the Patent Office.).

whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “Enablement is not precluded by the necessity for some experimentation. . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is ‘undue,’ not ‘experimentation.’” *In re Wands*, 858 F.2d at 736–737.

To evaluate whether a disclosure would require undue experimentation, the Federal Circuit has adopted the following factors to be considered:

- (1) The quantity of experimentation needed to make or use the invention based on the content of the disclosure;
- (2) The amount of direction or guidance presented;
- (3) The existence of working examples;
- (4) The nature of the invention;
- (5) The state of the prior art;
- (6) The relative skill of those in the art;
- (7) The level of predictability in the art; and
- (8) The breadth of the claims.

In re Wands, 858 F.2d at 737. The Examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.

Here, that analysis in the Final Rejection (mailed Aug. 21, 2013, “Final Act.”) at pages 2–6, and the Answer (mailed Jan. 31, 2014, “Ans.”) at pages 2–4 has not been sufficiently performed and the rejection under enablement is not sustained.

Written Description

The Examiner has determined that the written description requirement is not met by the following claims: in claim 1, for the term “immediate utility value;” in claim 9 for the term “plurality of utility values;” in claims 12 and 17 for the terms “ u_a^p ” and “ u_a^o ”; and in claim 16 for the term “utility to a customer” (Final Act. 7–11; *see also* Ans. 6–8).

In contrast, the Appellants have argued that these rejections are improper citing to portions of the Specification including paragraphs 37, 41, 58, 61, and 67 (App. Br. 15–17; *see also* Reply Br. 12–20).

We agree with the Appellants. Here, proper support for the terms “immediate utility value” and “plurality of utility values” is provided for instance in the Specification at paragraph 37. Proper support for the terms “ u_a^p ” and “ u_a^o ” is provided for instance in the Specification at paragraph 18. Proper support for the claim term “utility to a customer” is provided for instance in the Specification at paragraph 61. For these reasons, this rejection of record is not sustained.

Rejections under 35 U.S.C. § 101

The Examiner has determined that claim 9 is unpatentable under 35 U.S.C. § 101 because the claim term for a “machine-readable storage medium” is directed to transitory, non-patentable subject matter (Final Act. 10; *see also* Ans. 13).

The Appellants argue that the claim term “machine-readable storage medium” is not directed transitory subject matter (App. Br. 19, 20).

We agree with the Examiner. In the Precedential Decision *ex Parte Mewherter*, App. No. 2012-007692, May 5, 2013, the claim term “machine-

readable storage medium” was determined to be directed to non-statutory subject matter in light of the Specification. Here, the Specification at paragraph 13 states that the machine readable storage medium can be “any electronic, magnetic, optical, or other physical storage device that contains or stores executable instructions.” Here, the cited claim term is broad enough to include a transitory wave and this rejection of record is therefore sustained.

Rejections under 35 U.S.C. § 102(b) and 103(a)

The Appellants have argued that the rejection under 35 U.S.C. § 102(b) of claim 1 is improper because the cited prior art fails to disclose:

recursively determine expected net utility values for each possible coverage decision and each possible product replacement decision in each period of the plurality of time periods, wherein the expected net utility value for each coverage decision is based on an immediate utility value in a current time period and the expected net utility value of the product replacement decision from a next time period.

(App. Br. 20–24; *see also* Reply Br. 21–24).

In contrast, the Examiner has determined that the cited claim limitation above is found in Steinberg at paragraphs 14, 15, 32, 37–44, 54, and 57 (Final Act. 12; *see also* Ans. 14–16).

We agree with the Appellants. Here, the above cited portions of Steinberg fail to disclose the argued claim limitation above. For example, while the citation to Steinberg at paragraph 37 does disclose that user information relating to products and service plans may be compared to achieve rankings, this does not specifically disclose for instance determining “net utility values for each possible coverage decision and each possible product replacement decision in each period” where the net utility value for

each coverage decision “is based on an immediate utility value in a current time period and the expected net utility value of the product replacement decision from a next time period.” The other citations to Steinberg fail to disclose this as well. Claim 9 contains similar language to that addressed above, as well as its dependent claim 10. For these reasons, the rejections under 35 U.S.C. § 102(b) are not sustained for claims 1, 9, and 10.

Turning to the rejections made under 35 U.S.C. § 103(a) for dependent claims 2–8 and 11–15, the same portions of Steinberg have been relied on to disclose the similar above cited claim limitations and the rejection of these claims is therefore not sustained (*see* Ans. 17–24).

Claim 16 contains claim limitations similar to those addressed above. The rejection of claim 16 and its dependent claims under 35 U.S.C. § 103(a) relies on Steinberg at the same above citations to disclose those limitations (Ans. 17–24). As discussed above, these portions of Steinberg fail to disclose those similar limitations and these rejections are likewise not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112 (enablement), 35 U.S.C. § 112 (written description), 35 U.S.C. § 102(b), and 35 U.S.C. § 103(a), as listed in the Rejection section above.

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101 as listed in the Rejection section above.

Appeal 2014-005296
Application 12/893,795

DECISION

The Examiner's rejections of claims 1–20 under 35 U.S.C. §§ 102, 103, and 112 are reversed.

The Examiner's rejection of claims 9–15 under 35 U.S.C. § 101 is affirmed

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