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LEXMARK INTERNATIONAL, INC.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER ALAN ADKINS,
TIMOTHY P. CRAIG, STEPHEN KELLY CUNNAGIN,
TIMOTHY LOWELL STRUNK, and MICHAEL SHAYNE WILSON

Appeal 2016-004174
Application 13/275,560¹
Technology Center 3600

Before JOSEPH A. FISCHETTI, MICHAEL C. ASTORINO, 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 7–11. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appellants identify Lexmark International, Inc. as the real party in interest. Appeal Br. 2.

ILLUSTRATIVE CLAIM

7. A method for licensing a customer after an initial transaction of said customer purchasing a current supply item in a multi-pack plurality of supply items for use in an imaging apparatus, the current supply item having a memory attached thereto, comprising:

prompting said customer to acquire on a computing device a usage license for said current supply item, said current supply item containing an ink or toner imaging substance to form a visible image on a print media in said imaging apparatus and said usage license of said current supply item corresponding to an amount of ink or toner imaging substance that is half or less than an entirety of said ink or toner imaging substance in said current supply item such that an initial amount of ink or toner imaging substance in said current supply item is at least two times greater than said amount of ink or toner imaging substance corresponding to the usage license so that any single supply item of the multi-pack of supply items can accommodate one or more license renewals by the customer before depletion of the initial amount of said ink or toner imaging substance while the customer retains in their possession said any single supply item, the memory recording depletion of the initial amount of said ink or toner imaging substance over a lifetime of the current supply item;

determining whether said amount of ink or toner imaging substance corresponding to the usage license is nearer to depletion or not;

if said amount of ink or toner imaging substance of the usage license is said nearer to depletion, notifying said customer to obtain another usage license for an additional amount of ink or toner imaging substance in said current supply item, whereby said additional amount of ink or toner imaging substance is at least as much as said initial amount of ink or toner imaging substance in said current supply item less the amount of ink or toner imaging substance corresponding to the usage license, the memory recording the another usage license if obtained by the customer; and

prompting said customer to obtain a second usage license for a second supply item of said purchased multi-pack plurality of supply items.

REJECTIONS

I. Claims 7–11 are rejected under 35 U.S.C. § 101 as ineligible subject matter.

II. Claims 7–11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Nagata (US 2002/0077979 A1, pub. June 20, 2002).

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

Subject-Matter Eligibility

According to the rejection, applying the first step of the methodology delineated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), the claims are directed to an abstract idea, described variously as “checking whether a printer or toner cartridge is running low, and when it is running low telling the user to buy a new cartridge and use it to replace the old cartridge” (Final Action 7) and “noticing that resources have been modified which allow a human being to make changes based on the modifications” (Answer 2). Regarding the second *Alice* step, the rejection further states that, aside from the identified abstract idea itself, the recited elements, individually or in combination, amount to no more than instructions to implement the abstract idea on a computer and/or generic computer functionality performing well-understood, routine, and conventional activities. Final Action 7. *See also* Answer 2 (“The steps

appear to be directed towards the computer merely assisting human activity.”).

Asserting error in the rejection, the Appellants argue claims 7–11 as a group. Appeal Br. 6–7. We select claim 7 for analysis herein, in accord with 37 C.F.R. § 41.37(c)(1)(iv).

Without alleging a specific error in the Examiner’s characterization of the abstract idea, the Appellants contend that “[t]here exists no ‘pen and paper’ counterpart to” the method of claim 7. Appeal Br. 7. Although courts have regarded subject matter that “can be performed in the human mind, or by a human using a pen and paper” as an abstract idea, *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011), this is not the sole test for making such a determination. Indeed, “[t]he Supreme Court has not established a definitive rule to determine what constitutes an ‘abstract idea.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016). Rather, the Supreme Court and the Federal Circuit have identified various categories of subject matter as abstract ideas. *See* MPEP § 2106.04(a)(2) (9th ed., Rev. 8, Jan. 2018) (collecting cases). Therefore, the Appellants’ contention that claim 7 cannot be performed with pen and paper, is not persuasive of error in the rejection.

In addition, the Appellants, with respect to the second *Alice* step, contend that claim 7 is patent-eligible, because the recited claim elements do not “represent mere computer structure that performs ‘well-understood, routine and conventional activities’ in the art,” as set forth in the rejection, because the Examiner presents no anticipatory prior art. Appeal Br. 7 (quoting Final Action 7). Rather, “[t]he claims sufficiently define themselves over the unpatentable subject-matter types noted in *Alice* . . . and

Bilski v. Kappos, 561 U.S. 593 (2010).” *Id.* These assertions also are not persuasive of error in the rejection, as they conflate subject-matter eligibility and novelty. Yet, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981). “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013).

In view of the foregoing, the Appellants’ arguments do not persuade us of error in the rejection of claim 7 — or of claims 8–11, per 37 C.F.R. § 41.37(c)(1)(iv). Therefore, we sustain the rejection of claims 7–11 under 35 U.S.C. § 101.

Obviousness

The Appellants contend that independent claim 7 was rejected erroneously, because Nagata fails to teach or suggest the recited “**execution of two or more licenses (initial usage license and renewal license) by the customer before depletion of the initial amount of ink or toner in the single, same exact, current supply item.” Appeal Br. 9.**

The language of claim 7 that describes this feature recites: “a usage license for said current supply item . . . corresponding to an amount of ink or toner imaging substance” and “notifying said customer to obtain another usage license for an additional amount of ink or toner imaging substance in said current supply item.”

The rejection regards Nagata's disclosure of replacing an original cartridge with another cartridge as a "renewal license." Answer 3 (citing Nagata ¶¶ 780, 960). However, such disclosure in Nagata does not satisfy of claim 7's recitation that the "another usage license" is "for an additional amount of ink or toner imaging substance *in said current supply item.*" (Emphasis added). As the Appellants explain, "Nagata gives licenses to toner in cartridges, **but only gives one license per one cartridge.**" Appeal Br. 8. Indeed, Nagata states that "service provider **10** replaces the toner cartridge **60** with *a new one* which is provided as a spare." Nagata ¶ 780 (emphasis added).

Further, the rejection states that claim 7's "recitation 'such that . . . so that . . . can accommodate . . . [] while the customer retains . . . current supply item' does not serve to further distinguish from the prior art"; "the recitation does not have weight as it merely describes a result or intended use of the 'prompting' step." Answer 3. However, the portion of claim 7, thus identified in the rejection, does not correspond to the feature of claim 7 that the Appellants recognize as the basis for the asserted deficiency of Nagata.

Therefore, the Appellants' argument persuades us of error in the rejection of claim 7. Accordingly, we do not sustain the rejection of independent claim 7, and claims 8–11 depending therefrom, under 35 U.S.C. § 103(a).

DECISION

We AFFIRM the Examiner's decision rejecting claims 7–11 under 35 U.S.C. § 101.

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We REVERSE the Examiner's decision rejecting claims 7–11 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