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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/250,959	09/30/2011	David Andrew Dresner	066301-430496	9864
24030	7590	07/30/2018	EXAMINER	
POL SINELLI PC 900 West 48th Place Suite 900 KANSAS CITY, MO 64112-1895			STROUD, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3688	
			NOTIFICATION DATE	DELIVERY MODE
			07/30/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID ANDREW DRESNER

Appeal 2017-002528
Application 13/250,959
Technology Center 3600

Before ELENI MANTIS MERCADER, LINZY T. McCARTNEY, and
JOHN D. HAMANN, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks review under 35 U.S.C. § 134 of the Examiner's rejections of claims 3–15, 20–22, and 25–36. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED INVENTION

Claims 25 and 36 are independent. Claim 36 illustrates the claimed subject matter:

36. A method for delivering targeted information to a consumer comprising:

obtaining, at a computing device associated with a printer, programming to print on a beverage sleeve, the beverage sleeve comprising an inner surface and an outer surface, the inner surface comprising a fluted insulating portion and the outer surface, the fluted insulating portion defining fluting on all portions of the inner surface, the fluted insulating portion including a first pressed end portion adhered to a second pressed end portion to form a truncated conical cylinder with a substantially seamless boundary across the adhesion between the first pressed end portion and the second pressed end portion, the first pressed end portion and the second pressed end portion defining compressed fluting of the fluted insulating portion at each end such that the substantially seamless boundary defines a substantially uniform thickness around a circumference of the beverage sleeve;

contemporaneously with a consumer receiving a product, printing the programming on the outer surface of the beverage sleeve for distribution to the consumer with the product.

REJECTIONS

Claims Rejected	Basis	Reference(s)
3-15, 20-22, 25-36	§ 112	N/A
30	§ 112	N/A
3-15, 30, 36	§ 101	N/A
3-15, 20-22, 25-36	§ 103	One or more of Cesmedziev, ¹

¹ Cesmedziev (US 2009/0287568 A1; Nov. 19, 2009).

Claims Rejected	Basis	Reference(s)
		Rawlings, ² Cook, ³ and Sadlier, ⁴ Kanevsky, ⁵ De Wet, ⁶ Silverbrook, ⁷ Angell ⁸ Phillips, ⁹ Kedem, ¹⁰ and Solomon ¹¹

DISCUSSION

§ 112 Rejections

The Examiner rejected claims 3–15, 20–22, and 25–36 as indefinite because the claims recite “a substantially seamless boundary” and “a substantially uniform thickness.” Non-Final Act. 2–3. The Examiner also rejected claim 35 as indefinite because the claim recites an uncompressed portion of the fluted insulated portion is “about equal to” a second thickness of an overlapped portion of the first pressed end portion and the second pressed end portion. Non-Final Act. 3. The Examiner found these claims indefinite because, for each of these terms, the Examiner determined neither the claims nor the written description provides “a standard for ascertaining the requisite degree.” Non-Final Act. 2–3.

² Rawlings et al. (US 2009/0060606 A1; Mar. 5, 2009).

³ Cook (US 6,863,644 B1; Mar. 8, 2005).

⁴ Sadlier (US 2006/0144915 A1; July 6, 2006).

⁵ Kanevsky et al. (US 6,334,109 B1; Dec. 25, 2001).

⁶ De Wet (WO 2010/049826 A1; May 6, 2010).

⁷ Silverbrook et al. (US 2009/0014515 A1; Jan. 15, 2009).

⁸ Angell (US 2009/0249195 A1; Oct. 1, 2009).

⁹ Phillips et al. (US 7,019,859 B2; Mar. 28, 2006).

¹⁰ Kedem et al. (US 2010/0185726 A1; July 22, 2010).

¹¹ Solomon (US 2010/0018984 A1; Jan. 28, 2010).

Appellant argues that one of ordinary skill in the art could ascertain the scope of these claims in light of the drawings and the written description. App. Br. 6–8 (discussing Figure 7 and paragraph 39 of the written description).

We agree with Appellant. Claims must be “definite,” that is, claims must “particularly point[] out and distinctly claim[] the subject matter which the inventor . . . regards as the invention.” 35 U.S.C. § 112(b). During prosecution, “[a] claim is indefinite when it contains words or phrases whose meaning is unclear.” Manual of Patent Examining Procedure § 2173.05(e). A claim is indefinite, for instance, if the claim is “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention,” *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014), or if it is “is amenable to two or more plausible claim constructions,” *Ex Parte Miyazaki*, 89 USPQ.2d 1207, 1211 (BPAI 2008) (precedential).

Terms of degree like “substantially” and “about” do not necessarily render claims indefinite. *See, e.g., Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1359 (Fed. Cir. 2012) (“This court has repeatedly confirmed that relative terms such as ‘substantially’ do not render patent claims so unclear as to prevent a person of skill in the art from ascertaining the scope of the claim.”). These terms are sufficiently definite when, for example, the associated specification provides a standard for measuring the degree. *See, e.g., Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984). Mathematical precision is not required; the specification must simply provide sufficient certainty to one of ordinary skill in the art. *See Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014).

Appellant’s specification satisfies this standard. The written description discloses compressing part of the beverage sleeve so that when the sleeve is folded “the seam has a lower profile as compared with other sleeves” and the “smooth and flat surface areas of the beverage sleeve are increased and maximized relative to a sleeve formed in other manners.” Spec. ¶ 39. Figure 7 depicts a generally smooth and flat beverage sleeve, with the thickness of the uncompressed fluting roughly equal to the thickness of the overlapping joined sleeve ends. *See Spec., Fig. 7.* In light of these disclosures, we agree with Appellant that these claims are sufficiently definite.

The Examiner also rejected claim 30 “as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends.” Non-Final Act. 3. The Examiner found claim 30 improperly depends from claim 36 because claim 36 includes all the limitations recited in claim 30. Non-Final Act. 3. Appellant has not challenged this rejection. We therefore summarily affirm this rejection.

§ 101 Rejection

Under § 101 of the Patent Act, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. “[T]his provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court has set forth the following two-step test for determining whether a patent claim falls within one of these exceptions:

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. We have described step two of this analysis as a search for an “inventive concept”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice, 134 S. Ct. at 2355 (citations omitted) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–79 (2012)).

Applying this test, the Examiner concluded claim 36 is directed to the abstract idea of “obtaining programming to print and printing the programming contemporaneously with receiving a product.” Non-Final Act. 4. The Examiner then determined that the elements recited in the claim, considered individually or as a combination, do not recite significantly more than an abstract idea because the claim recites the elements “at a high level of generality” and the elements “only perform generic functions.” Non-Final Act. 4–5.

Appellant argues the Examiner has not established claim 36 is directed to an abstract idea because the Examiner provided conclusory statements in support of this determination. App. Br. 12–13. Appellant asserts claim 36 is not directed to an abstract idea because the recited method “is hardly a long prevalent, fundamental economic principle that is a building block of modern human activities.” App. Br. 14. According to Appellant, the recited method “provides specific applications and improvements to technologies in the marketplace and is not so manifestly

abstract as to override the broad statutory categories of patent eligible subject matter.” App. Br. 14.

We find Appellant’s arguments unpersuasive. As explained by the Examiner, claim 36 is similar to other claims the Federal Circuit has determined are directed to an abstract idea. Ans. 10–11. For example, in *Electric Power Group, LLC v. Alstom S.A.*, the Federal Circuit determined that claims focused on, among other things, collecting and presenting information are directed to an abstract idea. 830 F.3d 1350, 1353 (Fed. Cir. 2016). Like the claims at issue in *Electric Power Group*, claim 36 recites a method that involves collecting and presenting information. In particular, the recited method obtains information (known as “programming”) and prints that information on a beverage sleeve that has specified characteristics. App. Br. v–vi (claims appendix); Spec. ¶ 48 (“The various types of different information that may be presented in a channel may collectively be referred to herein as ‘programming.’”). The similarities between claim 36 and the *Electric Power Group* claims provide adequate support for the Examiner’s determination that claim 1 is directed to an abstract idea. *Amdocs (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that when determining whether a claim is directed to an abstract idea “the decisional mechanism courts now apply is to examine earlier cases”).

Even if claim 36 were meaningfully different from the claims discussed in *Electric Power Group*, we would still agree with the Examiner that claim 1 is directed to an abstract idea. The Federal Circuit has determined that claims that recite “result-based functional language” and do not “sufficiently describe how to achieve [the recited] results in a non-abstract way” are directed to an abstract idea. *See, e.g., Two-Way Media*

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Ltd. v. Comcast Cable Commc'ns, LLC, 874 F.3d 1329, 1337 (Fed. Cir. 2017). Here, claim 36 uses broad functional language to recite two results: obtaining information and printing the information on a particular beverage sleeve. But claim 36 does not recite *how* to achieve these results. The claim does not recite how the claimed computing device obtains the information. Nor does the claim recite who or what contemporaneously prints the programming, much less recite how the method accomplishes the claimed contemporaneous printing.

Because we agree with the Examiner that claim 36 is directed to an abstract idea, we next consider whether the claim recites an “inventive concept.” Appellant argues claim 36 recites an inventive concept because “[c]laim 36 requires *significantly* more than a generic computer. For example, claim 36 requires a printer, a beverage sleeve, programming to print, and a computing device associated with a printer.” App. Br. 14. Appellant also asserts that claim 36 recites an inventive concept because the claims recites “operations [that] are not simply conventional steps, specified at a high level of generality.” App. Br. 14.

We find Appellant’s arguments unpersuasive. Limiting an abstract idea to a particular environment does not make the abstract idea patent eligible. *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (“Lastly, although the claims limit the abstract idea to a particular environment—a mobile telephone system—that does not make the claims any less abstract for the step 1 analysis.”). Thus, even if the claimed method is limited to printing information on a particular beverage sleeve, that fact does not transform the method into patent-eligible subject matter.

Moreover, most of the elements Appellant relies upon to show an inventive concept either encompass a generic component or constitute an

abstract idea. For instance, claim 36 recites “a computing device associated with a printer” App. Br. v (claims appendix). Appellant’s written description makes clear the recited computing device and associated printer encompass generic technology. The written description explains, for example, that computing device 27 may be “a smart phone tablet, etc.,” Spec. ¶ 35, while computing device 28 may consist of “a personal computer, laptop, tablet, smart phone, or the like,” Spec. ¶ 40. The written description also discloses that sleeve printer 22 “may be any form of printer suitable to print on a coffee sleeve, coaster, pizza box[,] or the like.” Spec. ¶ 36. The Federal Circuit has concluded that generic elements like these do not provide an inventive concept. *See, e.g., TLI Commc’ns*, 823 F.3d at 614 (“These steps fall squarely within our precedent finding generic computer components insufficient to add an inventive concept to an otherwise abstract idea.”).

With respect to the recited “programming to print,” the written description states that “[t]he various types of different information that may be presented in a channel may collectively be referred to herein as ‘programming.’” Spec. ¶ 48. The “various types of different information” encompassed by the recited “programming” falls in the abstract idea rubric and therefore cannot provide an inventive concept. *See, e.g., Elec. Power Grp.*, 830 F.3d at 1353–54 (explaining that information falls “within the realm of abstract ideas”). Accordingly, none of these elements, considered alone or together, indicates claim 36 recites an inventive concept.

As for Appellant’s argument that claim 36 does not recite “simply conventional steps, specified at a high level of generality,” as discussed above, the claimed limitations use broad functional language to recite results without reciting how the method achieves those results. And even if the

claimed method were nonobvious—and as explained in the next section, it is not—nonobviousness does not make the claim less abstract. A nonobvious abstract idea is still an abstract idea. *See, e.g., SAP Am., Inc. v. Investpic, LLC*, 890 F.3d 1016, 1018 (Fed. Cir. 2018) (“Nor is it enough for subject-matter eligibility that claimed techniques be novel and nonobvious in light of prior art, passing muster under 35 U.S.C. §§ 102 and 103.”).

At bottom, the claimed method recites obtaining information and printing that information on a particular beverage sleeve contemporaneously with a consumer receiving a product. Appellant’s written description acknowledges that “[i]t has been recognized that information, messages, advertisements, warnings, bar codes, and the like can be printed on sleeves.” Spec. ¶ 3. The written description also makes clear the recited “computing device associated with a printer” encompasses generic technology. *See, e.g.,* Spec. ¶¶ 35–36, 40. Using generic technology to perform a known action on a particular beverage sleeve contemporaneously with a consumer receiving a product does not supply the requisite inventive concept. Accordingly, we sustain the Examiner’s rejection of claim 36 under 35 U.S.C. § 101. Because Appellant has not presented separate, persuasive patentability arguments for claims 3–15 and 30, we also sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

§ 103 Rejections

Claim 25 recites in part

a beverage sleeve comprising, a first side with a fluted insulating portion and a second side with a first station and a second station, the fluted insulating portion *defining fluting on all portions of the first side*, the fluted insulating portion including a first pressed end portion adhered to a second pressed end portion to form a truncated conical cylinder with a substantially seamless boundary across the adhesion between the

first station and the second station and between the first pressed end portion and the second pressed end portion, *the first pressed end portion and the second pressed end portion defining compressed fluting of the fluted insulating portion at each end such that the substantially seamless boundary defines a substantially uniform thickness around a circumference of the beverage sleeve.*

App. Br. iii–iv (claims appendix) (emphases added). Claim 36 recites similar limitations. App. Br. v (claims appendix).

With respect to claims 25 and 36, Appellant argues the Examiner’s combination of Cook and Sadlier does not teach or suggest the recited beverage sleeve. According to Appellant, “if Cook is modified in view of Sadlier to include a uniform thickness profile at the adhesion between the two ends of the sleeve, Cook’s corrugation would have to be removed as taught by Sadlier, thereby not disclosing all elements of claim 25.” App. Br. 10; *see also* App. Br. 17 (making the same argument about claim 36). Appellant argues “the teachings of Cook and Sadlier teach that in order to reduce the thickness at the adhesion between the ends of the sleeve, the corrugation should be **removed** such that the corrugations are not actually adhered together.” App. Br. 10; *see also* App. Br. 17 (making the same argument about claim 36).

We find Appellant’s arguments unpersuasive. The Examiner found that Cook discloses creating a beverage sleeve that satisfies the “beverage sleeve” limitation recited in claims 25 and 36. Ans. 8 (“[F]igures 14–21 of Cook . . . show[] the construction of a beverage sleeve matching the features of the claims.”). In particular, the Examiner found Cook discloses a beverage sleeve that has fluting along one side. Ans. 8; *see also* Cook Figs. 14–17. The Examiner found Cook discloses applying pressure to the sleeve’s overlapping flaps to flatten the beverage sleeve. Ans. 8 (citing

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Cook 13:5–20). The Examiner reasoned that because Cook’s process produces a flat beverage sleeve, the Cook’s sleeve has “a substantially seamless boundary” and “a substantially uniform thickness” as required by the claims. App. Br. 8. Appellant has not persuasively challenged these findings.

The Examiner also determined that even if Cook did not teach or suggest a beverage sleeve that has the recited “substantially seamless boundary” and “substantially uniform thickness,” Sadlier teaches a beverage sleeve with these characteristics. Ans. 8–9. The Examiner determined it would have been obvious to modify Cook’s sleeve to have these characteristics by “continu[ing] the process already being used [to flatten the beverage sleeve] until the sleeve reached a level to satisfy the ‘substantially seamless boundary’ and ‘substantially uniform thickness’ displayed in Sadlier.” App. Br. 8. Thus, the Examiner’s combination does not require removing Cook’s corrugation as argued by Appellant.

For the above reasons, we sustain the Examiner’s rejections of claims 25 and 36 under 35 U.S.C. § 103. Because Appellant has not presented separate arguments for claims 3–15, 20–22, and 26–35 on these grounds, we also sustain the Examiner’s rejections of these claims.

CONCLUSION

Claims Rejected	Basis	Affirmed	Reversed
3-15, 20-22, 25-36	§ 112		3-15, 20-22, 25-36
30	§ 112	30	
3-15, 30, 36	§ 101	3-15, 30, 36	
3-15, 20-22, and 25-36	§ 103	3-15, 20-22, and 25-36	
Summary		3-15, 20-22, and 25-36	

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision. *See* 37 C.F.R. § 41.50(a)(1). No time 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