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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* AL CHAKRA, LIAM HARPUR,  
MARK KELLY, and JOHN RICE

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Appeal 2018-003885  
Application 13/169,998  
Technology Center 2600

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Before ST. JOHN COURTENAY III, JOHNNY A. KUMAR, and  
JASON J. CHUNG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1–18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

*Invention*

The claimed invention on appeal “relates to workgroup printer management and more particularly to restricting workgroup printing for categorized print jobs.” (Spec. ¶ 2.)

*Representative Claim*

1. A method for workgroup management of categorized print jobs, the method comprising:

receiving from an end user a print job designated for printing in a workgroup printer;

inspecting the print job to determine a context of the print job based upon an application source of the print job indicating either an application associated with a work task so as to determine the print job to be work related or an application associated with a non-work task so as to determine the print job to be non-work related and in response to the inspection, and categorizing the print job as work related or non-work related based upon the determined context of the print job;

determining in reference to a centralized data store of printer resource allocations for all end users of the workgroup printer, a remaining allocation of printer resources established for the end user;

determining whether or not printing the print job on behalf of the end user encroaches within a threshold value of the remaining allocation of printing resources established for the end user; and,

*restricting further processing of the print job when it is determined both that the print job is non-work related and also that the printing of the print job on behalf of the end user encroaches within the threshold value of the remaining allocation of printing resources established for the end user.*

(Emphasis added regarding the contested limitations).

*Rejections*

A. Claims 1–18 are rejected under 35 U.S.C. § 101 as being directed to a judicial exception (i.e., an abstract idea), without significantly more.

- B. Claims 1, 3–7, 9–13, and 15–18 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Dance et al. (US 2008/0068641 A1, pub. Mar. 20, 2008) (“Dance”), in view of Bartley et al. (US 2002/0175208 A1, pub. Nov. 28, 2002) (“Bartley”), in further view of Ruggle et al. (US 2006/0059128 A1, pub. Mar. 16, 2006) (“Ruggle”), and in view of Yoshida (US 2009/0086264 A1, pub. Apr. 2, 2009).
- C. Claims 2, 8, and 14 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Dance, Bartley, Ruggle, and Yoshida, and further in view of Munetomo et al. (US 2010/0014110 A1, pub. Jan. 21, 2010) (“Munetomo”).

### *Grouping of Claims*

Based on Appellants’ arguments, we decide the appeal of all claims rejected under § 103 rejection B on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). We address rejections A and C separately, *infra*.

### ANALYSIS

We have considered all of Appellants’ arguments and any evidence presented.

### *Rejection A of Claims 1–18 under § 101*

#### *Mayo/Alice Analysis*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new

and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57.

If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *See Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972). “Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009) (quoting *Gottschalk*, 409 U.S. at 67). Moreover, if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011).

If the claims are *not directed* to a patent-ineligible concept, *the inquiry ends*. See *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). We consider the question of whether the claims are directed to a *specific improvement* in the capabilities of the computing devices, or, instead, “a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

We, therefore, decide under step two, whether the claims: (a) set forth an *inventive concept* that provides a specific means or method that *improves* the relevant technology, or (b) are directed to a result or effect that itself is the abstract idea, in which the claims merely invoke generic processes and machinery. See *Id.*

#### *The Examiner’s Rejection A under 35 U.S.C. § 101*

Regarding the first step of the *Alice/Mayo* analysis, the Examiner concludes that claims 1–18 are directed to a judicial exception, i.e., an abstract idea of organizing human activity. See Final Act. 5. The Examiner also concludes the claim language can be performed as a series of mental steps. *Id.* The Examiner further explains the basis for the rejection, concluding that the claim language is:

sufficiently broad to read on a human manager receiving a paper copy of a print job from a user, the manager deciding if a particular item is a work related or non-work related item through personal judgment, determining if the person requesting a print has printed more than a certain amount (encroaches on threshold), and preventing the person from printing if so by telling them they are not allowed to use the copier/printer.

The added limitation requiring “inspecting the print job . . .” is merely related to particular criteria for deciding if the print job is work-related or not work related. A human manager could analogously decide whether or not the print job is work or nonwork related by observing the particular source application of the print job. The inclusion of a “centralized data store” with the “printer resource allocations for all end users” is analogous to a human manager keeping track of how much all of the users are allowed to print by pen and paper. Such a method is analogous to the claims found ineligible by the Federal Circuit in *Planet Bingo* involving a mental or pen-and-paper process for managing a Bingo game (See *Planet Bingo, LLC v VKGS LLC*, 576 Fed. Appx. 1005 (Fed. Cir. 2014)).

Final Act. 5–6.

Regarding the second step of the *Mayo/Alice* analysis, the Examiner finds the claims do not include additional elements that amount to significantly more than the judicial exception, because:

The claim language that is separate from the abstract idea includes the "workgroup printer". However, the workgroup printer appears to merely be a related object of the invention and not an active component in the described method/system; print jobs are designated for a particular workgroup printer, *but the workgroup printer does not perform any action or process in the claims*. Consequently, the identified additional elements taken into consideration individually and in combination fail to amount to significantly more than the abstract idea above.

Final Act. 6 (emphasis added).

The Examiner turns to independent system claim 7, and concludes the claim merely includes a processor and a memory that perform “conventional, generic communication with a printer and client computers on a network.” Final Act. 8. The Examiner concludes these limitations appear, in essence, to be adding the words “apply it” to the judicial exception, which are “mere instructions to implement an abstract idea on a computer.” *Id.* The Examiner finds this is “simply appending well-understood, routine and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.”<sup>1</sup>

For the aforementioned reasons, the Examiner concludes that all claims 1–18 on appeal are not patent eligible under 35 U.S.C. § 101.

*Mayo/Alice Analysis — Step 1*

Appellants recite the claim limitations (App. Br. 9–10), point to the support in the Specification (App. Br. 10), and contend, *inter alia*:

Thus, as can be seen, when considering the specific claim elements of independent claim I as a whole in light of the teachings of the specification, and the legal holding of Enfish, McRO and even Electric Power Group LLC v. Alstom S.A. [(830 F.3d 1350 (Fed Cir. 2016))], it is clear that Appellants' claims are directed to a process driven improvement to computer-related technology by allowing computer performance of a junction not

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<sup>1</sup> The patent-eligibility inquiry may contain underlying issues of fact. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016). In particular, “[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

previously performable by a computer. Therefore, under the legal holding of Enfish, McRO and Electric Power Group, it is believed that no further analysis under Mayo part 2 is required and Appellants' claims are indeed directed to patent eligible subject matter as dictated by Enfish and the Deputy Commissioner for Patent Examination Policy of the United States Patent and Trademark Office.

App. Br. 11.

The Examiner disagrees: <sup>2</sup>

the rejection cites *Ultramercial* for the proposition that a series of purely mental steps constitutes an abstract concept (i.e. YES at Step 2A of the two part test). Further, the Examiner notes that the Decision of the Patent Trial and Appeal Board (dated 17 March 2016) cites *CyberSource Corp v. Retail Decisions, Inc.* (654 F.3d 1366, 1375 (Fed. Cir. 2011)) as further precedent that a purely mental process such as the one of the instant invention is unpatentable.

Ans. 17.

The Examiner distinguishes the holdings of *McRo* and *Enfish* from Appellants' claims:

Unlike *McRO*, in which both the specification and claims recited a technological improvement as the steps claimed were uniquely computer specific and enabled a new method of animation not performable by hand, the instant [claims] do not recite anything uniquely technological as the steps could be (and likely frequently are) performed by human managers regularly. *Enfish* is equally not applicable here as the claims in *Enfish* improved the efficiency of the memory and processor inside the computer; nothing in the instant claims could be construed as improving the efficiency of the computer itself.

Ans. 19.

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<sup>2</sup> See *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014).

Abstract ideas have been identified by the courts by way of example, as including fundamental economic practices, *certain methods of organizing human activities, an idea of itself*, and mathematical relationships and/or formulas. *See Alice*, 134 S. Ct. at 2355–56. Under the two-part test articulated by the Supreme Court in *Alice*, “[w]e [must first] determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355. Secondly, “we must examine the elements of the claim to determine whether it contains an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application.” (*Id.* at 2357, internal quotations omitted).

Regarding part one of the two-part test, we agree with the Examiner (Ans. 17–19) that claims 1–18 on appeal broadly encompass abstract *methods of organizing human activities*, where information (e.g., a print job) can be received, categorized, and conditionally processed as a mental activity if the recited two predicate conditions are both satisfied.<sup>3</sup> Although “a workgroup printer” is nominally recited in the claims, we find a person would be capable of performing the recited steps or acts as mental steps, or with the aid of pen and paper, particularly since no step of printing is positively recited. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654

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<sup>3</sup> *See* claim 1 (predicate condition): “*when it is determined both that the print job is non-work related and also that the printing of the print job on behalf of the end user encroaches within the threshold value of the remaining allocation of printing resources established for the end user.*” (Emphasis added). We conclude both prongs of the recited “when” predicate condition of claim 1 may be performed as purely mental steps, under a broad but reasonable interpretation. *See CyberSource*, 654 F.3d at 1373.

F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

Regarding method claims generally, our reviewing court guides: “a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” *CyberSource*, 654 F.3d at 1373. *See also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (“While the Supreme Court has altered the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, we continue to ‘treat[] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.’” (brackets in original) (quoting *Elec. Power Grp.*, 830 F.3d at 1354)).

Here, we conclude claim 1 is directed to an abstract idea because we conclude the steps of claim 1 can be performed by human thought alone. For example, the recited step of “receiving from an end user a print job designated for printing in a workgroup printer” could be performed by a person who receives a digital photo provided by an end user, who has mentally designated the photo for printing (i.e., a “print job” is intended). We emphasize again that method claim 1 does not recite positively any requirement to actually print anything.

Regarding Appellants’ arguments analogizing the subject claim in *Enfish* to the claims before us on appeal (App. Br. 11), we note the *Enfish* court concluded “the claims at issue in this appeal are not directed to an abstract idea within the meaning of *Alice*. Rather, they are directed to a

*specific improvement to the way computers operate, embodied in the self-referential table.” Enfish, 822 F.3d at 1336 (emphasis added).*

Thus, the *Enfish* court concluded the self-referential logical table was a specific type of data structure designed to *improve the way a computer stores and retrieves data in memory*. *Id.* at 1339. Because the analysis stops if there is no abstract idea under *Alice* step 1, the *Enfish* court concluded the subject claims were patent eligible. *Id.*

Here, Appellants have not shown persuasively that any features of the claimed invention *improve* the way the recited generic computer components store and retrieve data in a manner analogous to that found by the court in *Enfish*. Moreover, Appellants’ claims 1–18 are silent regarding any mention of a database, much less a self-referential database table similar to the specific type of logical table arrangement the *Enfish* court found was designed to improve the way a computer stores and retrieves data in memory. *See Enfish, 822 F.3d at 1336.*

Therefore, we are not persuaded that Appellants’ claimed invention improves the functionality or efficiency of the recited generic computer components, or otherwise changes the way the computer components function, at least in the sense contemplated by the Federal Circuit in *Enfish*.

Nor do we find persuasive Appellants’ attempt to analogize the claims to the subject claims considered by the court in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). App. Br. 27.

We note the subject claim considered by the *McRO* court concerned a method for automatically animating lip synchronization and facial expressions. *McRO, 837 F.3d at 1303*. The *McRO* court concluded the subject claims did not recite an abstract idea because the computer animation

*improved* the prior art through the use of *rules*, rather than artists, to set morph weights and transitions between phonemes. *Id.* at 1308. Thus, the claimed invention in *McRO* allowed for computer performance of animation steps that previously had to be performed by human animators. *Id.* at 1309. The subject claims in *McRO* used “limited *rules* in a process specifically designed to achieve an improved technological result” over “existing, manual 3-D animation techniques.” *Id.* at 1316 (emphasis added).

Here, Appellants claimed invention does not apply positively recited *rules, per se*. The invention under appeal merely adapts to a technological setting (e.g., a generic workgroup printer, a plurality of client computers, and a computer communication network) the broad concept of restricting further processing of a print job, specifically when *both* of two recited conditions occur: (1) the print job is non-work related, and (2) a threshold value of remaining printing resources is encroached. *See* independent claims 1, and independent claims 7 and 13, which recite similar language of commensurate scope.

Thus, it is our view that Appellants’ claims merely implement generic computer components to perform the recited functions. We emphasize that *McRO* (837 F.3d at 1312) guides that “[t]he abstract idea exception prevents patenting a *result* where ‘it matters not by what process or machinery the result is accomplished.’” (Quoting *O’Reilly v. Morse*, 56 U.S. 62, 113 (1854). Emphasis added.

For at least these reasons, we are not persuaded the Examiner erred in concluding that each of claims 1–18 on appeal is directed at least to the abstract idea of *a method of organizing human activities*, similar to the

abstract ideas identified by our reviewing courts (as discussed above) that could additionally be performed as mental steps. *See* Final Act. 5.

Appellants provide no further substantive arguments regarding *Alice* step 1. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Therefore, we proceed to *Alice* step 2.

*Mayo/Alice Analysis — Step 2*

Because we conclude the claims are directed to an abstract idea for essentially the same reasons articulated by the Examiner (Final Act. 5; Ans. 18–19), we turn to the second part of the *Alice/Mayo* analysis. We analyze the claims to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357 (internal quotations and citation omitted).

Regarding *Alice* step 2, Appellants address the purported *inventive concept* of the claims. Appellants urge:

under the legal holding of Enfish, McRO and Electric Power Group, *it is believed that no further analysis under Mayo part 2 is required* and Appellants' claims are indeed directed to patent eligible subject matter as dictated by Enfish and the Deputy Commissioner for Patent Examination Policy of the United States Patent and Trademark Office.

App. Br. 11 (emphasis added in italics, underline in original).

Regarding part two of the *Alice* test, we find merely appending purely conventional steps to an abstract idea (such as “categorizing” a print job as *work related* or *not work related* and “determining” whether or not to print the print job based on a set of specified conditions — claim 1) does not supply a sufficiently inventive concept. *See Alice Corp.* 134 S. Ct. at 2357–

58. Regarding Appellants' comment that "no further analysis under Mayo part 2 is required" (App. Br. 11), we note that arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

To the extent Appellants' may rely on *BASCOM* in the Appeal Brief (5, 8), as support under *Alice* step 2, we find Appellants' arguments unavailing. *Id.*

In *BASCOM*, the Federal Circuit concluded that the subject claims (a method and system for filtering Internet content) were directed to an abstract idea. However, the *BASCOM* court found the claimed Internet content filtering, which featured an implementation "versatile enough that it could be adapted to many different users' preferences while also installed remotely in a single location," expressed an inventive concept in "*the non-conventional and non-generic arrangement of known, conventional pieces.*" *BASCOM*, 827 F.3d at 1346, 1350 (emphasis added).<sup>4</sup>

Here, Appellants fail to identify the particular non-conventional and non-generic *structural* arrangement of conventional elements in the claims that provides the purported technical improvement. Therefore, we are not persuaded that Appellants' claims provide a technical improvement over prior systems or methods that provided conditional restrictions on printing.

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<sup>4</sup> The *BASCOM* court also concluded the claims did not preempt the use of the abstract idea of filtering content on the Internet or on generic computer components performing conventional activities. The court concluded that the claims carved out a specific location for the filtering system, namely, on a remote Internet service provider (ISP) server, and required the filtering system to give users the ability to customize filtering for their individual network accounts. *BASCOM*, 827 F.3d at 1352.

*See BASCOM*, 827 F.3d at 1348 (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea”).

On this record, and in light of the guidance of *BASCOM*, we are of the view that Appellants’ claims do not arrange or operate the recited generic computer components in an unconventional manner to achieve an improvement in computer functionality. Further regarding the use of the recited generic computer components, the Supreme Court has held “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358.

Contrary to Appellants’ contentions (App. Br. 6), we find the claims on appeal are *silent* regarding specific limitations directed to an *improved* computer system, processor, memory, network, database, or Internet. Therefore, we find Appellants’ claimed invention does not provide a solution “necessarily rooted in *computer technology* in order to overcome a problem specifically arising in the realm of computer networks,” as considered by the court in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (emphasis added).

Our reviewing court provides additional guidance: “[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1096 (Fed. Cir. 2016; *OIP Techs., Inc., v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (claims reciting, *inter alia*, sending messages over a network, gathering statistics, using a computerized system to determine automatically an estimated outcome, and presenting offers to potential customers found to merely recite “well-understood, routine conventional

activities” by either requiring conventional computer activities or routine data-gathering steps) (internal citation omitted); *see also Elec. Power Grp.*, 830 F.3d at 1355 (“We have repeatedly held that such invocations of computers and networks that are not even arguably inventive are ‘insufficient to pass the test of an inventive concept in the application’ of an abstract idea” (quoting *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353, 1355 (Fed. Cir. 2014))); *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017) (“Rather, the claims recite both a generic computer element—a processor—and a series of generic computer ‘components’ that merely restate their individual functions . . . . That is to say, they merely describe the functions of the abstract idea itself, without particularity. This is simply not enough under step two”).<sup>5</sup>

The Supreme Court additionally guides that the “prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or [by] adding ‘insignificant post[-]solution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)).

Although the functions recited in Appellants’ system claims may be performed faster or more efficiently with the recited “plurality of client

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<sup>5</sup> *See also Accenture Glob. Servs.*, 728 F.3d at 1344–45 (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] . . . on a computer” [is] not patent eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

computers over a computer communications network” (claim 7), we find the resultant speed increase comes from a “general-purpose computer, rather than from the patented method itself,” and does “not materially alter the patent eligibility of the claimed [invention].” *FairWarning*, 839 F.3d at 1095 (citation omitted).

Further, while Appellants’ invention is directed to the *result* of conditionally restricting further processing of a print job — e.g., *see* the last paragraphs of independent claims 1, 7, and 13, we find no language in the claims on appeal that focuses on a specific means or method that *improves* the recited generic workgroup printer, processor, memory, client computer, or network that is used to perform selected steps or functions of claims 1–18.

Thus, analogous to the court’s finding in *TLI Communications* (823 F.3d at 612), we find Appellants’ claims are “directed to the use of conventional or generic technology in a nascent but well-known environment, without any claim that the invention reflects an inventive solution to any problem presented by combining the two.” *Id.*

Because we find Appellants have not established that claims 1–18 are directed to an *improvement* in the recited generic computer components, we conclude that none of the claim limitations, viewed both individually and as an ordered combination, amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter.

In light of the foregoing, we conclude, under the *Mayo/Alice* analysis, that each of Appellants’ claims 1–18, considered as a whole, is directed to a *patent-ineligible abstract idea* (under *step one*), and under *step two*, does not recite something *significantly more* to transform the nature of the claim into

a patent-eligible application.

Accordingly, for the reasons discussed above, we sustain the Examiner's rejection A under 35 U.S.C. § 101 of claims 1–18, as being directed to a judicial exception, without significantly more.<sup>6</sup>

*Rejection B of Representative Claim 1 under § 103(a)*

Appellants contest the following conditional limitation of representative independent claim 1:

*restricting further processing of the print job when it is determined both that the print job is non-work related and also that the printing of the print job on behalf of the end user encroaches within the threshold value of the remaining allocation of printing resources established for the end user.*

(emphasis added).

Appellants focus on paragraphs 63 and 64 of Ruggle, and contend:

As can be seen, Examiner asserts with particularity that “Ruggle discloses, in paragraph [0063]–[0064], that the content to be printed (i.e. the “print job”) may not be covered by the work license and, as such, the content is blocked from being printed unless the user individually licenses it. Such a restriction is based on the content being printed being work-related (i.e. covered by the work license) or not work related (i.e. instead requiring a separate personal license).” [The] Examiner's statement, though, appears to be false. Paragraph [0063] on its face teaches only a “summary report” that notifies the user that the content being viewed “is either (1) already covered by the user's license so they can print, e-mail or display the content on their intranet or (2) instantly licensable as indicated by either a changing of the color

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<sup>6</sup> To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. See 37 C.F.R. § 41.37(c)(1)(iv).

of the dynamic license icon” or by presenting a message to the user. There is nothing in paragraph [0063] that suggests or teaches the blocking of content as asserted by Examiner. Second, paragraph [0064] only refers to the several "licensing options" of the user without mention of any content blocking despite Examiner's statement to the contrary. Thus, while Ruggle teaches the licensability of content for use by end users when site licensed by the user's company and only for the needs of the company, Ruggle does not teach what Examiner claims Ruggle teaches at page 4 of the final office action:

that the content to be printed (i.e. the "print job") may not be covered by the work license and, as such, the content is blocked from being printed unless the user individually licenses it. Such a restriction is based on the content being printed being work-related (i.e. covered by the work license) or not work related (i.e. instead requiring a separate personal license).

To be clear, Examiner contends that the foregoing paragraphs of Ruggle expressly teach the blocking of printing of content unless the user individually licenses the content. Clearly, this is an erroneous interpretation of what actually is present in Ruggle. For this reason, Appellants seek the reversal of the rejections under 35 U.S.C. § 103(a).

App. Br. 16–17.

In response, the Examiner further explains the basis for the rejection:

Regarding [A]ppellants['] argument about the Ruggle reference specifically, the teachings of Ruggle are far more extensive than a mere "summary report" as [A]ppellants suggest and, contrary to appellants assertion, include a blocking of content. Specifically, Ruggle teaches that "the user is restricted from accessing content" and displays a red license icon to indicate such (paragraph [0062] of the Ruggle reference). Additionally, Ruggle's content restriction explicitly relates to an

internal site license for which a "user can only use content for internal (company) needs" (paragraph [0064] of the Ruggle reference). The disclosed licensing for company needs only constitutes the claimed evaluation of whether or not the content to be printed is "work related". Lastly, Ruggle contemplates printing specifically as required by claim 1; if the user is licensed, they are notified that they can print the content (paragraph [0063] of the Ruggle reference; see also paragraph [0051] noting that licenses generally allow printing of content). Consequently, applicants argument to the contrary are found unpersuasive.

Ans. 20–21.

Appellants respond in the Reply Brief:

Thus, as can be seen, while Examiner only relies upon Ruggle for the teaching of the blocking of printing of content unless the user individually licenses the content, Examiner proceeds to demonstrate only that Ruggle teachings the blocking of access to content without a license and the permission to print content if licensed.

Reply Br. 7.

In support, Appellants reproduce paragraph 63 of Ruggle, and urge:

In review of paragraph [0063], it is clear that an "icon" that is found in a "report" includes as a function of its color, a notification that the content already being viewed by the end user is able to be printed. More to the point, paragraph [0063] does not describe any functionality-only the purpose of an icon. Certainly, the "icon" of paragraph [0063] does not portend to "block" anything-it is just an icon with a particular color interpreted by a user to have a certain meaning of reminding a user that the content to which the user already has access can be printed.

Reply Br. 7–8.

We emphasize that the Examiner's ultimate legal conclusion of obviousness is based upon the *combined* teachings and suggestions of the

cited references. Particularly with respect to the multiple paragraphs cited by the Examiner in Ruggle, our reviewing court guides: “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009). An obviousness inquiry is not limited to the prior art’s preferred embodiment. *See, e.g., Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1370 (Fed. Cir. 2007).

Here, in response to Appellants’ contentions in the Appeal Brief regarding the contested “restricting further processing” limitation of claim 1, the Examiner specifically finds and explains: “Ruggle teaches that ‘the user is restricted from accessing content’ and displays a red license icon to indicate such (paragraph [0062] of the Ruggle reference).” Ans. 20–21.

In the Reply Brief, we find Appellants fail to substantively and persuasively address the Examiner’s specific finding (Ans. 20–21) regarding Ruggle’s paragraph 64 that expressly discloses a “red license icon indicates that the user is restricted from accessing content,” which we find, in combination with the cited teachings and suggestions of Dance and Bartley, and Yoshida, teaches or suggests the contested “restricting further processing” limitation of representative independent claim 1.<sup>7</sup>

In the event our reviewing court may disagree, we further emphasize the conditional language employed in the contested “restricting further

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<sup>7</sup> “[T]he question under 35 USC 103 is not merely what the references expressly teach but what they would have *suggested* to one of ordinary skill in the art at the time the invention was made.” *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)). (Emphasis added); *see also* MPEP § 2123.

processing” limitation recited in claim 1. *See Ex parte Schulhauser*, Appeal No. 2013-007847, at \*9 (PTAB, April 28, 2016) (precedential) (holding “The Examiner did not need to present evidence of the obviousness of the remaining method steps of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim (e.g., instances in which the electrocardiac signal data is not within the threshold electrocardiac criteria such that the condition precedent for the determining step and the remaining steps of claim 1 has not been met.”); *see also Ex parte Katz*, Appeal No. 2010-006083, 2011 WL 514314, at \*4–5 (BPAI Jan. 27, 2011).

Applying the controlling guidance of *Schulhauser* here, we additionally find the Examiner need not present evidence of the obviousness of the conditional method step “restricting further processing” of claim 1 *that is not required to be performed* under a broadest reasonable interpretation of the claim.<sup>8</sup>

Therefore, on this record, and based upon a preponderance of the evidence, we are not persuaded of error regarding the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness for representative independent claim 1.

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<sup>8</sup> *See, also e.g., Applera Corp. v. Illumina, Inc.*, 375 Fed. Appx. 12, 21 (Fed. Cir. 2010) (unpublished) (affirming a district court's interpretation of a method claim as including a step that need not be practiced if the condition for practicing the step is not met); *Cybersettle, Inc. v. Nat 'l Arbitration Forum, Inc.*, 243 Fed. Appx. 603, 607 (Fed. Cir. 2007) (unpublished) (“It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.”).

Accordingly, we sustain the Examiner's § 103 rejection B of representative independent claim 1. The remaining claims rejected under rejection B (not argued separately) fall with claim 1. *See "Grouping of Claims" supra.*

*Rejection C of Claims 2, 8, and 14 rejected under § 103*

Claims 2, 8, and 14 depend from independent claims 1, 7, and 13, respectively. Appellants advance no further substantive arguments regarding these claims. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we sustain the Examiner's § 103 rejection C of dependent claims 2, 8, and 14, for the reasons discussed above regarding claim 1.

DECISION

We affirm the Examiner's rejection of claims 1–18 under 35 U.S.C. § 101 as being directed to a judicial exception, without significantly more.

We affirm the Examiner's rejections of claims 1–18 under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED