UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY R. HOLLAND, DAVID A. FONTANELLA, JR.,
THOMAS A. ZAPPE, MARK D. OELTJENBRUNS,
STEVE P. LOHMAN, JOSEPH M. WRIGHT, GARY M. KLINEFELTER,
JEFFREY J. SASSE, STACY W. LUKASKAWCEZ,
THOMAS C. PLATNER, and JON J. IBS

Appeal 2008-1177
Application 10/937,739
Technology Center 3600

Decided: July 2, 2008

Before LINDA E. HORNER, DAVID B. WALKER, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gary R. Holland et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-6 and 27-40. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is to a supply ordering method for identification card manufacturing systems (Spec. 1:9-12). Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A method of ordering a consumable supply of a card manufacturing device comprising steps of:
>
> receiving a request to order a consumable supply of the device from a user;
>
> retrieving supply information including a unique identifier;
>
> providing the supply information to a first web address; and
>
> retrieving a second web address through the first web address based upon the unique identifier, wherein the second web address is different from the first web address and is associated with the supply.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Morgavi	US 5,558,449	Sep. 24, 1996
Danneels	US 6,272,472 B1	Aug. 7, 2001
Chapman	US 2002/0116301 A1	Aug. 22, 2002
Hayward	US 2003/0023703 A1	Jan. 30, 2003

The following rejections are before us for review:

1. Claims 1-6, 27, 28, 31, and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayward, Danneels, and Morgavi.
2. Claims 29 and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayward, Danneels, Morgavi, and Chapman.
3. Claims 33, 34, 36, 37, and 38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayward and Morgavi.
4. Claim 35 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hayward, Morgavi, and Danneels.
5. Claims 39 and 40 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayward, Morgavi, and Chapman.

ISSUE

The issue before us is whether the Examiner erred in rejecting claims 1-6 and 27-40 under 35 U.S.C. § 103(a) as unpatentable over Hayward in combination with one or more of: Danneels, Morgavi, and Chapman. This issue turns on whether: (1) Hayward discloses retrieving supply information including a unique identifier; (2) the combination of Hayward and Danneels

teaches retrieving a second web address through the first web address based upon the unique identifier, wherein the second web address is different from the first web address and is associated with the supply; and (3) Hayward discloses supply information contained in a memory of the supply.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The customary and ordinary meaning of "unique" is 1. Being the only one of its kind. 2. Without an equal or equivalent; unparalleled. 3a. Characteristic of a particular category, condition, or locality. *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at www.bartelby.com.
2. The customary and ordinary meaning of "identify" is 1. To establish the identity of. 2. To ascertain the origin, nature, or definitive characteristics of. *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at www.bartelby.com.
3. Hayward discloses monitoring a peripheral device, such as a printer, to identify peripheral conditions that indicate a need to replace a consumable (e.g., when the printer runs out of ink) (Hayward 3:¶0034).

4. The peripheral condition is derived from sensors 12 and machine state 14 in firmware 16 of the peripheral device (*id.*).
5. The firmware 16 sends information about the peripheral condition to a computer 30 running an application program (*id.*).
6. The application program then provides the user with a screen that allows the user to replace the consumable (e.g., an ink cartridge) (Hayward 3:¶0038).
7. When the user selects to replace the cartridge by clicking on the "buy now" button, the application program has already sensed the peripheral indicia and the peripheral condition (e.g., magenta ink level low) and then launches a browser to access a purchase order page or screen from the manufacturer's server (Hayward 4:¶0051).
8. By "peripheral indicia," Hayward refers to "any of a model or part number, a date of manufacture, a serial number and even configuration information for peripherals that may have diverse reconfigurable parts" (Hayward 2:¶0025).
9. The purchase order screen is automatically filled out by the server with the part number to be ordered based on the peripheral indicia and the condition (Hayward 4:¶0051).
10. Hayward also teaches that when the user installs the software that comes with the peripheral, the user is prompted to "register" the software by entering information such as the user's name and the product name and model, such that the customer information and the exact peripheral indicia are sent to a registration server so that a

precise configuration can be stored on the server (Hayward 2:¶¶0024-0026).

11. Thus, when the customer selects the "buy now" button, the manufacturer's server can also automatically fill out the purchase order screen with the user personal information (e.g., name, address, shipment method, etc.) based on the user information previously entered by the customer during the initial registration (Hayward 4:¶0052).

12. In order to complete this automated ordering described in Hayward; the manufacturer's server must have some way of identifying the particular customer who clicked on the "buy now" button. In particular, as discussed above, in the registration process, the manufacturer's server associates the customer information (i.e., user name, address, etc.) with the exact peripheral indicia (i.e., serial number) (a unique identifier of the peripheral), so that when the peripheral indicia is transferred from the computer 30 to the manufacturer's server, the server can use this peripheral indicia (i.e., the peripheral's serial number) to identify the customer. As such, the peripheral serial number can serve as a unique identifier of the specific peripheral device in need of a supply and also can serve as the identifier of the consumer associated with the device.

13. Thus, Hayward discloses computer 30 retrieves supply information (e.g., the peripheral indicia and peripheral condition) which

includes a unique identifier (i.e., peripheral serial number) from the peripheral device.

14. In Hayward, information about the peripheral indicia and the peripheral condition are stored in a memory in computer 30, and not in the consumable supply of the peripheral (Hayward 3:¶0041, Fig. 6).

15. Even if the peripheral condition data is also in a memory of the firmware 16 of the peripheral device, this means only that the supply information is contained in a memory in the peripheral device itself, and not in the "supply" (e.g., the ink jet cartridge) of the peripheral device.

16. Danneels relates to dynamically generating a list of reseller's web sites based on a list of items to be purchased (Danneels, Abstract and col. 3, ll. 33-45).

17. Danneels does not disclose supply information contained in a memory of a consumable supply.

18. Morgavi relates to a card printing machine (Morgavi, col. 1, ll. 7-9).

19. Morgavi does not disclose supply information contained in a memory of a consumable supply.

20. Chapman discloses an automatic consumption-based replenishment of a supply chain (Chapman 1:¶0001).

21. Chapman does not disclose supply information contained in a memory of a consumable supply.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

ANALYSIS

Rejection of claims 1-6, 27, 28, 31, and 32 as unpatentable over Hayward, Danneels, and Morgavi

The Appellants argue claims 1-3, 6, 27, 28, and 31 as a first group (Br. 6-7). We select claim 1 as the representative claim, and the remaining claims of this group stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants contend that the Examiner erred in rejecting claim 1, because the combined prior art does not teach or suggest "retrieving supply

information including a unique identifier" (Br. 6). In particular, the Appellants argue that the teaching in Haywood of identifying a particular consumable (i.e., a magenta ink cartridge) is "not the retrieval of unique identifiers from supply information as claimed" (Br. 6-7).

Claim 1 recites "retrieving supply information including a unique identifier." A "unique identifier" is something that is one of a kind and that serves to indicate the origin, nature, or definitive characteristics of something else (Facts 1 & 2). This definition is consistent with the Appellants' Specification which describes, for example, that the unique identifier can be "a parts number for the supply, which may be unique for the particular customer, and/or a customer number that identifies the customer of the supply," "dealer information for the supply that identifies the user's particular dealer (i.e., one of many dealers), a default quantity of the supply, a price for the supply, customer contact information, and other information related to the supply and/or the customer" (Spec. 11:3-17).

Hayward discloses monitoring a peripheral device, such as a printer, to identify peripheral conditions that indicate a need to replace a consumable (e.g., when the printer runs out of ink) and sending this information to a computer 30 running an application program (Facts 3-5). The application program then provides the user with a screen that allows the user to replace the consumable (e.g., an ink cartridge) (Fact 6). When the user chooses to replace the cartridge, the application program has already sensed the peripheral indicia (e.g., peripheral device serial number) and the peripheral condition (e.g., magenta ink level low) and then launches a browser to

access a purchase order page or screen from the manufacturer's server (Facts 7 & 8). The purchase order screen is automatically filled out by the server with the part number to be ordered based on the peripheral indicia and the condition (Fact 9).

Hayward also teaches that the user can "register" the peripheral by entering information such as the user's name and the product name and model, such that the customer information and the exact peripheral indicia are sent to a registration server so that a precise configuration can be stored on the server (Fact 10). Thus, the manufacturer's server can also automatically fill out the purchase order screen with the user's personal information (e.g., name, address, shipment method, etc.) based on the user information previously entered by the customer during the initial registration (Fact 11).

In order to complete this automated ordering described in Hayward, the manufacturer's server must have some way of identifying the particular customer who clicked on the "buy now" button. In particular, as discussed above, in the registration process, the manufacturer's server associates the customer information (i.e., user name, address, etc.) with the exact peripheral indicia (i.e., serial number) (a unique identifier of the peripheral), so that when the peripheral indicia is transferred from the computer 30 to the manufacturer's server, the server can use this peripheral indicia (i.e., the peripheral's serial number) to identify the customer. As such, the peripheral serial number can serve as a unique identifier of the specific peripheral device in need of a supply and also can serve as the identifier of the

consumer associated with the device (Fact 12). Thus, we find that Hayward discloses computer 30 retrieves supply information (e.g., the peripheral indicia and peripheral condition) which includes a unique identifier (i.e., peripheral serial number) from the peripheral device (Fact 13).

The Appellants further contend that the Examiner erred in rejecting claim 1, because the combined prior art does not teach or suggest "retrieving a second web address through the first web address based upon the unique identifier, wherein the second web address is different from the first web address and is associated with the supply" (Br. 6). In particular, the Appellants argue that Danneels fails to teach or suggest accessing a second web address from a first web address "based on the unique identifier" (Br. 7)(emphasis in original).

The Examiner notes that "Hayward does not disclose retrieving a second web address through the first web address based upon the unique identifier, but does disclose forwarding a purchase order to a retailer" (Ans. 12-13, citing Hayward 3:¶¶54, 55). The Examiner relies on Danneels for teaching "retrieving a second web address through the first web address based upon identification of the consumable or consumables to be purchased, wherein the second web address is different from the first web address and is associated with the supply" (Ans. 4). In particular, the Examiner found that Danneels discloses that "after a purchaser links to a supplier's web site and selects items to be purchased, the supplier's web site generates and displays a list of resellers from which the purchaser can purchase the items, and can link a purchaser's web browser to the linking

page of a desired reseller" (Ans. 13, citing Danneels, col. 3, ll. 33-53). The Examiner determined that the list of resellers to which a purchaser can be linked is based on the particular items the purchaser is seeking to purchase (Ans. 13). Thus, when Hayward is modified with this teaching from Danneels, Hayward's method would include retrieving the second web address of the retailer through the first web address based upon the unique identifier of the supply being ordered (*id.*). We agree with the Examiner.

The Appellants appear to be arguing the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097-98 (Fed. Cir. 1986). Although Danneels may not disclose that the second web address is retrieved "based on a unique identifier," the teaching of using a unique identifier to identify a consumable to be reordered is already found in Hayward (Facts 3-13). The Examiner is relying on the combined teachings of the references for the determination of obviousness. As such, the Examiner has set forth a prima facie case of obviousness of claim 1, and the Appellants have failed to persuade us of error in the Examiner's rejection. Thus, we sustain the rejection of claims 1-3, 6, 27, 28, and 31.

The Appellants argue claims 4 and 5 as a second group (Br. 7-8). The Appellants contend that the Examiner erred in rejecting claim 4, because the combined prior art fails to teach or suggest that "the supply information is contained in a memory of the supply" as claimed (Br. 8). Appellants'

Specification describes that the consumable supplies (108) (e.g., an ink supply, overlaminate supply, or print ribbon supply) include a memory 110, in which supply information 112 is contained (Spec. 6:10-12). In Hayward, information about the peripheral indicia and the peripheral condition are stored in a memory in computer 30, and not in the consumable supply of the peripheral (Fact 14). Even if the peripheral condition data is also in a memory of the firmware 16 of the peripheral device, as found by the Examiner (Ans. 14), this means only that the supply information is contained in a memory in the peripheral device itself, and not in the "supply" (e.g., the ink jet cartridge) of the peripheral device, as claimed (Fact 15). Neither Danneels nor Morgavi cures the deficiency of Hayward (Facts 16-19). As such, we do not sustain the rejection of claim 4, and claim 5 which depends therefrom, as unpatentable over Hayward, Danneels, and Morgavi.

The Appellants argue claim 32 separately. The Appellants argue that the Examiner erred in rejecting claim 32, because the combination of the cited references fails to teach or suggest "retrieving supply information including a unique identifier that associates the supply to the customer" (Br. 8). As we found *supra* in our analysis of claim 1, Hayward discloses that the peripheral indicia (i.e., peripheral serial number) can serve both as a unique indicator of the specific peripheral device and as an indicator of the customer (Fact 12). Thus, the peripheral indicia in combination with the peripheral condition (e.g., magenta ink cartridge is low) associates the supply (magenta ink cartridge) with the customer (the customer associated with the peripheral device bearing the provided serial number). As such, we

sustain the rejection of claim 32 as unpatentable over Hayward, Danneels, and Morgavi.

Rejection of claims 29 and 30 as unpatentable over Hayward, Danneels, Morgavi, and Chapman

The Appellants rely on the same arguments for patentability of claims 29 and 30 as they made for patentability of claim 1 (Br. 9). As such, the Appellants have not persuaded us of error in the Examiner's rejection of claims 29 and 30 for the same reasons set forth *supra* in our analysis of the rejection of claim 1. Thus, we sustain the rejection of claims 29 and 30.

Rejection of claims 33, 34, 36-38 as unpatentable over Hayward and Morgavi

The Appellants contend that the Examiner erred in rejecting claims 33, 34, and 36-38 because the combination of cited references fails to teach or suggest "retrieving supply information contained in a memory of the supply including a unique identifier that associates the supply to a customer" (Br. 9). As we found *supra*, Hayward fails to disclose supply information contained in a memory of the supply (Facts 14 & 15). Morgavi fails to cure this deficiency of Hayward (Facts 18 & 19). As such, we do not sustain the rejection of claims 33, 34, and 36-38 as unpatentable over Hayward and Morgavi.

Rejection of claim 35 as unpatentable over Hayward, Morgavi, and Danneels

Claim 35 depends from and further limits claim 33. Danneels fails to cure the deficiency of the combination of Hayward and Morgavi (Facts 16 & 17). As such, we do not sustain the rejection of claim 35 as unpatentable over Hayward, Morgavi, and Danneels.

Rejection of claims 39 and 40 as unpatentable over Hayward, Morgavi, and Chapman

Claims 39 and 40 depend from and further limit claim 33. Chapman fails to cure the deficiency of the combination of Hayward and Morgavi (Fact 20 & 21). As such, we do not sustain the rejection of claims 39 and 40 as unpatentable over Hayward, Morgavi, and Chapman.

CONCLUSIONS

We conclude the Appellants have failed to show that the Examiner erred in rejecting under 35 U.S.C. § 103(a) claims 1-3, 6, 27, 28, 31, and 32 as unpatentable over Hayward, Danneels, and Morgavi and claims 29 and 30 as unpatentable over Hayward, Danneels, Morgavi, and Chapman.

The Appellants have shown that the Examiner erred in rejecting claims 4 and 5 as unpatentable over Hayward, Danneels, and Morgavi, claims 33, 34, and 36-38 as unpatentable over Hayward and Morgavi, claim 35 as unpatentable over Hayward, Morgavi, and Danneels, and claims 39 and 40 as unpatentable over Hayward, Morgavi, and Chapman.

DECISION

The decision of the Examiner to reject claims 1-3, 6, and 27-32 is affirmed. The decision of the Examiner to reject claims 4, 5, and 33-40 is reversed.

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) (2007).

AFFIRMED-IN-PART

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