UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QUINTIN T. PHILLIPS and ERIC D. DEBOURSE

Appeal 2008-3885
Application 09/932,237
Technology Center 3600

Decided: November 24, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Phillips, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.[1]

THE INVENTION

The invention relates to a device or method of marketing using an image forming device, which receives marketing messages based on the association of a consumable with the image forming device. Specification [008-009]. For example, when toner is coupled to a printer, advertisements stored in a memory device are retrieved and displayed for the user of the printer. The advertisements were previously sold and stored on the memory device by a marketing system. Specification [0049].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. An article of manufacture comprising:
> a processor-usable medium having processor-useable code embodied therein and configured to cause processing circuitry to perform steps comprising:
> providing a marketing message intended for an image forming device user from a party other than a provider of a consumable:
> monitoring an association of a consumable with an image forming device; and
> enabling communication of the marketing message to the image forming device user responsive to the monitoring,

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 14, 2007) and Reply Brief ("Reply Br.," filed Nov. 13, 2007), and the Examiner's Answer ("Answer," mailed Sep. 11, 2007).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Shimbori	US 2004/0204986 A1	Oct. 14, 2004

The following rejection is before us for review:

1. Claims 1-25 are rejected under 35 U.S.C. §102(e) as being anticipated by Shimbori.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-7 and 21 under 35 U.S.C. § 102(e). Specifically, does Shimbori describe an article configured to cause enabling communication of a marketing message responsive to the monitoring of the consumables?

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 8-19 and 22-24 under 35 U.S.C. § 102(e). Does Shimbori describe a method including: 1) providing a consumable usable in an image forming device to form hard images and additionally to enable a marking function with respect to image forming device users, 2) receiving an indication regarding a desirous party to utilize the marketing function and 3) initiating the marketing function after the enabling? Further, with respect to some of the dependent claims, does Shimbori describe detecting a triggering event with respect to the consumable and the consumable comprising a memory device?

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 20 and 25 under 35 U.S.C. § 102(e). Does Shimbori describe initiating communication of the marketing message responsive to detecting a triggering event with respect to the consumables?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) 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).

Claim 1

1. Claim 1 recites "a processor-usable medium having processor-usable code embodied therein and configured to cause processing circuitry to perform steps."
2. One step is "monitoring an association of a consumable with an image forming device."
3. Another step is "enabling communication of the marketing message to the image forming device user responsive to the monitoring."
4. The ordinary and customary meaning of "association" is "the state of being associated." (*See Merriam-Webster's Collegiate Dictionary* 70 (10th Ed. 1993,) (Entry for "association"; n.).
5. The ordinary and customary meaning of "associate" is "1: to join as a partner, friend, or companion 2: *obs*: to keep company with: ATTEND 3: to join or connect together: COMBINE 4: to bring

together or into relationship in any of various intangible ways (as in memory or imagination).” (*See Merriam-Webster’s Collegiate Dictionary* 70 (10th Ed. 1993,) (Entry for “associate”; vt.).

6. The Specification does not provide an express definition of “association.”
7. Shimbori describes a consumable ordering apparatus which monitors the remaining amount of consumables. Shimbori [0044].
8. In response to a low amount of consumable, the consumable ordering apparatus automatically places an order for consumables in order to avoid a lack of consumables. Shimbori [0044].
9. A printing monitoring unit monitors whether or not the printing has been finished normally and whether or not the correct paper is used. Shimbori [0047].
10. In response to a finished normal printing, a printing certifying unit issues a certificate to ensure that points are fairly issued. Shimbori [0047].

Claim 8

11. Claim 8 recites a marketing method comprising “providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users.”
12. Claim 8 recites “receiving an indication regarding a desirous party to utilize the marketing function.”
13. Claim 8 recites “initiating the marketing function after enabling.”
14. A printer prints on paper, which is a consumable. Shimbori [0044].

15. The printer user requests printing of advertisements from the internet at the terminal unit. Shimbori [0041 and 0067].
16. The advertisements are printed on the paper. Shimbori [0041].
17. The printed advertisement includes a barcode with user identifying information and advertisement identifying information. Shimbori [0042].
18. A user takes the printed advertisement to a shop clerk, who reads the barcode and records the purchase. Shimbori [0042].

Claim 12

19. Claim 12 recites "detecting a triggering event with respect to the consumable, and wherein the initiating is responsive to the detecting."
20. Shimbori describes a print monitoring unit which detects the type of paper used. Shimbori [0075].
21. In response to detecting an unregistered paper type, the user is notified that a paper exchange is necessary. Shimbori [0075].
22. The print monitoring unit also detects whether the printing has finished normally. Shimbori [0047].
23. In response to a normal printing, a print certifying unit issues a certificate. Shimbori [0047].
24. The certificate is sent to a terminal unit, which assigns points (i.e. credits) to the printer owner. Shimbori [0075].
25. Shimbori describes a printing managing apparatus which can restrict the number of sheets each user can print with points so as not to exceed a predetermined limit. Shimbori [0020].

26. In response to the limit being exceeded, the user does not receive points for the printing. Shimbori [0020].

Claims 16, 17, 19 and 22-24

27. Claim 16 recites "the consumable comprises a memory device configured to store the marketing message."
28. Claim 17 recites "the consumable comprises a memory device."
29. Claims 19 and 22-24 all recite a memory device having electrical storage space.
30. The Specification describes an integrated circuit memory device 36 on the consumable 34. Specification [0030].
31. Paper is an example of a consumable in the Specification. Specification [0022].

Claim 18

32. Claim 18 recites "monitoring the consumable utilizing an external device with respect to the image forming device."
33. Claim 18 depend on claim 8.
34. Examiner states: "Shimbori discloses in paragraph [0079] that unit 210 is part of the printer." (Answer 25.)
35. In Shimbori, unit 210 is the consumables managing unit. Shimbori [0062].

Claim 20

36. Claim 20 recites "detecting a triggering event with respect to the consumable after the associating."
37. Claim 20 recites "initiating communication of the marketing message using the printer responsive to the detecting."

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr*., 367 F.3d 1359, 1369 (Fed. Cir. 2004). "[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad*., 367 F.3d at 1364." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp*., 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The rejection of claims 1-7 and 21 under 35 U.S.C. § 102.

The Appellants argue that the Examiner erred in rejecting claim 1 because Shimbori does not describe monitoring of an association of the

consumable with the image forming device and enabling communication of the marketing message to the image forming device user responsive to the monitoring. (App. Br. 6.)

First, Appellants contend that Shimbori does not describe monitoring of an association of the consumable with the image forming device because Shimbori only monitors the capacity of the consumable. Appellants argue that the capacity does not give any evidence of an association of the consumable with the image forming device. (App. Br. 6 -7.)

The Examiner contends that the consumable ordering apparatus (Answer 12) or the printing monitoring unit in Shimbori (Answer 13) meets this limitation.

We find that the ordinary and customary meaning of "association" is the state of being joined together. (FF 4-6.) Monitoring the association of a consumable with an image forming device is broad and encompasses monitoring the amount of paper that is joined with a printer. (FF 7-8.) However, monitoring the association of a consumable does not encompass monitoring printing or the type of paper by the printing monitoring unit. (FF 9-10.)

Second, the Appellants argue that the enabling of communication of the marketing message is not responsive to the monitoring (App. Br. 6 -7). We agree. The Examiner states that the lack of a consumable would inherently result in the inability to print the advertisement (Answer 14). However, in Shimbori, the consumables ordering apparatus checks on the remaining amount of consumables and if low, automatically reorders the consumable in order to avoid a lack of consumable items. (FF 7-8.) The consumables ordering apparatus does not enable the communication of the

marketing message. We find that Shimbori does not describe an article configured to enable communication of the marketing message to the image forming device user *responsive* to the monitoring.

Accordingly, we hold that the Examiner erred in rejecting claim 1 and dependent claims 2-7 and 21 under 35 U.S.C. § 102(e) because Shimbori does not anticipate all of the limitations of claim 1.

Claims 8-11

The Appellants argued claims 8-11 as a group (App. Br. 7). We select claim 8 as the representative claim for this group, and the remaining claims 9-11 stand or fall with claim 8. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that the Examiner erred in rejecting claim 8 because Shimbori does not describe 1) providing a consumable usable in an image forming device to form hard images and additionally to enable a marketing function with respect to image forming device users, 2) receiving an indication regarding a desirous party to utilize the marketing function and 3) initiating the marketing function after the enabling. (App. Br. 7-8.)

First, the Appellants state, "Applicants respectfully submit that the reliance upon the consumable of Shambori (*sic)* is improper and the single function of printing on paper of Shambori (*sic)* has been relied upon as teaching two disparate limitations of the consumable usable to from hard images and usable to enable a marketing function." (Reply Br. 4.)

However, claim 8 recites "providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users." The limitation recites one step of "providing a consumable." The consumable is limited to being

capable of performing the two functions. The consumable is used to form hard images and is used to enable a marking function. The recitation does not recite two disparate steps as argued by the Appellant.

The Examiner considered the consumable in Shimbori to be paper, on which is printed the advertisement and a barcode. (Answer 15.) The Examiner considered the marketing function to be redeeming the advertisement at the store. (Answer 16.)

We agree with the Examiner's construction of the claim and conclusion that Shimbori meets the claimed subject matter in light of that construction. Providing the paper in the printer in Shimbori meets the step of providing a consumable. The paper is capable of being used to form hard images since the advertisement is printed on the paper. (FF 14.) The paper is also capable of being used to enable a marketing function since the advertisement and bar code have to be printed in order to be redeemed at the store. (FF 15-18.)

Second, the Appellants contend that Shimbori does not describe the step of receiving an indication regarding a desirous party to utilize the marketing function. (App. Br. 8.) The Examiner considered the desirous party to be the user who prints the advertisement and the indication to utilize the marketing function to be the request to print the advertisement. (Answer 16.)

We agree with the Examiner. Shimbori describes a user instructing a terminal on the image device to access the advertisement, which can be printed when the user wishes. (FF 15.) Receiving a print request from the user meets the step of receiving an indication regarding a desirous part to utilize the marketing function.

Third, the Appellants contend that Shimbori does not describe initiating the marketing function after enabling. (App. Br. 8.) The Appellants argue that presenting the advertisement to the shop cannot be considered initiating the marketing function since it occurs after the printing of the advertisement. The Appellants' argument seems to be premised on the marketing function being the communication of the advertisement. However for claim 8, the Examiner considered the marketing function to be redeeming the advertisement at the store and the taking of the advertisement to the shop to be the initiating of the marketing function. (Answer 16.)

We agree with the Examiner that redeeming the advertisement at the shop meets the step of initiating the market function. The advertisement is taken to the shop after it is printed on paper. (FF 18.)

We hold that the Examiner did not err in rejecting claims 8-11 under 35 U.S.C. § 102(e).

Claims 12-15

The Appellants contend that Shimbori does not describe the step of detecting a triggering event with respect to the consumable and the step of initiating of the marketing function being responsive to the detecting. (App. Br. 13.) The Examiner considers detecting a triggering event to be either 1) detecting a type of paper, 2) detecting whether the printing completed normally or 3) detecting whether the number of printed sheets has exceeded a limit. (Answer 21.)

In all three alternatives put forth by the Examiner, the initiating of the marketing function is not responsive to the detecting. (FF 20-26.) We do not find that these alternatives establish that Shimbori describes the step of

detecting a triggering event and initiating the marketing function *in response to the detecting*.

We hold that the Examiner erred in rejecting claim 12 and dependent claims 13-15 under 35 U.S.C. § 102(e) since Shimbori does not describe the steps of detecting a triggering event and initiating the marketing function responsive to the detecting.

Claims 16, 17, 19 and 22-24

The Appellants argue that the Examiner erred in rejecting claim 16 because Shimbori does not teach a memory device provided on the consumable and configured to store a marketing message. Claims 19 and 22-24 also recite a memory device.

The Examiner considers the memory device to be the hard copy of the advertisement and argues that this interpretation is consistent with the Specification. The Examiner states that the Specification gives paper as an example of a consumable. (Answer 23.)

We find that the Specification gives paper as an example of a consumable (FF 31), but gives an integrated circuit memory device as memory device on the consumable (FF 30). The Specification does not equate paper to the memory device and we find that such a construction of the term “memory device” would not be within the ordinary and customary meaning one of ordinary skill in the art would give that term. Furthermore, we note that the Examiner previously equated the paper in Shimbori to the consumable in the claim. (Answer 15.) However, there is no evidence that Shimbori describes a memory device on the consumable to thus meet the claimed “memory device.”.

We hold that the Examiner erred in rejecting claims 16, 17, 19 and 22-24 under 35 U.S.C. § 102(e).

Claim 18

The Appellants argue that the Examiner erred in rejecting claim 18 because Shimbori does not describe 1) the step of enabling comprising monitoring the status of the consumable with an external device and 2) the step of initiating the marketing function comprising forwarding a marketing message to the image forming device.

For the step of enabling, the Examiner relies upon the consumables managing unit in combination with the terminal unit (Answer 25). For the step of initiating, the Examiner states: "When the remaining amount is enough the marketing message is communicated to the image forming device and a hard copy of the advertisement is printed as described in paragraph [0041]-[0042]." (Answer 27.)

The Examiner's argument is inconsistent with the interpretation of Shimbori applied to claim 8. Claim 18 depends upon claim 8. The Examiner, when discussing claim 8, considered the marketing function to be redeeming the advertisement at the store. The Examiner states: "However, Shimbori discloses the initiating of the marketing function that occurs after enabling as the interaction of the user with the store during redemption." (Answer 16.) Claim 18 now further limits the marketing function to be forwarding a marketing message to the image forming device. The Examiner has not explained how all of the limitations of claim 8 are met if the marketing function is now considered to be forwarding a marketing message instead of redeeming the advertisement.

We hold that the Examiner erred in rejecting claims 18 under 35 U.S.C. § 102(e).

Claims 20 and 25

As further explained below, we will enter a new ground of rejection on claim 20 under 35 U.S.C. § 112, second paragraph, on the ground that claim 20 is indefinite. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, we are not placed in a position to make a determination as to patentability under 35 U.S.C. § 102. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970. However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. *See Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). Therefore, in the interest of judicial economy, we will address the rejection under 35 U.S.C. § 102(e).

The Appellants argue that Shimbori does not describe the steps of detecting a triggering event with respect to the consumable and of initiating the communication of the marketing message using the printer responsive to the detecting. (App. Br. 9.)

The Examiner considers detecting a trigger to be 1) detecting a type of paper, 2) detecting whether the printing completed normally or 3) detecting whether the printed sheets has exceeded a limit. (Answer 18.)

As with claim 12 above, we find that Shimbori does not describe the step of detecting a triggering event and initiating the marketing message in response to the detecting. In all three alternatives put forth by the Examiner,

the initiating of the marketing message is not responsive to the detecting. (FF 20-26.)

We hold that the Examiner erred in rejecting claims 20 and 25 under 35 U.S.C. § 102(e).

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b) a new grounds of rejection is included in this opinion.

Independent claim 20 recites the step of "detecting a triggering event with respect to the consumable after the associating." However, claim 20 does not recite an associating step nor is the step implicit. The associating step lacks antecedent basis in the claim and causes the claim to be indefinite. Therefore, claim 20 is rejected under 35 U.S.C. 112, 2nd paragraph, for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

CONCLUSIONS OF LAW

We conclude:

The Appellants have not shown that the Examiner erred in rejecting claim 8-11 under U.S.C. § 102 as being anticipated by Shimbori

The Appellants have shown that the Examiner erred in rejecting claims 1-7 and 12-25 under 35 U.S.C. § 102 as anticipated by Shimbori.

A new ground of rejection has been applied to claim 20 under 35 U.S.C. § 112, second paragraph.

DECISION

The decision of the Examiner to reject claims 1-25 is affirmed-in-part. We enter a new ground of rejection of claim 20 under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> • (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> • (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

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).

<u>AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)</u>

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