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In re Application of
Christopher J. RUBY
Application No. 07/425,360
Filed: October 21, 1998
Attorney Docket No.: CJR4
For: EYELESS, KNOTLESS,
COLORABLE AND/OR
TRANSLUCENT/TRANSPARENT
FISHING HOOKS WITH ASSOCIATABLE
APPARATUS AND METHODS

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed January 31, 2017, requesting that the Director exercise her supervisory authority and overturn the decision of December 28, 2016 by the Director of Technology Center 3600 (Technology Center Director), which decision refused petitioner's request to designate the examiner's answer of June 1, 2016 as containing a new ground of rejection and reopen prosecution in the above-identified application.

The petition to designate the examiner's answer of June 1, 2016 as containing a new ground of rejection and reopen prosecution in the above-identified application is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on October 21, 1989.

After several appeals to the Board of Patent Appeals and Interferences and Patent Trial and Appeal Board (Board), and an appeal to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), a non-final Office action was mailed on March 12, 2015. The non-final Office action of March 12, 2015, included a rejection of claims 34, 35, 37, 38,

40, and 45 through 49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

A reply to the non-final Office action of March 12, 2015, was filed on June 16, 2015. The reply of June 16, 2015, included an amendment to claim 34 and added new claims 54 through 60.

A final Office action was mailed on September 22, 2015. The final Office action of September 22, 2015: (1) maintained the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and (2) indicated that claims 26 through 33 and 54 through 60 were allowed.

A notice of appeal to the Board under 35 U.S.C. § 134 and 37 CFR 41.31 was filed on December 14, 2015. An appeal brief was filed on April 27, 2016.¹

An examiner's answer was mailed on June 1, 2016. The examiner's answer of June 1, 2016: (1) indicated that the ground of rejection set forth in the final office action of September 22, 2015 is being maintained, and no new grounds of rejection is being presented; and (2) included a "Response to Argument" section responding to the arguments set forth by the petitioner in the appeal brief of April 27, 2016.

A petition under 37 CFR 1.181 was filed on July 20, 2015, requesting that the rejection in the examiner's answer be designated as a new ground of rejection and that prosecution in the above-identified application be reopened. The petition of July 20, 2015 was dismissed by the Technology Center Director in a decision mailed on September 2, 2016.

A renewed petition was filed on October 13, 2016, again requesting that the rejection in the examiner's answer be designated as a new ground of rejection and that prosecution in the above-identified application be reopened. The renewed petition of October 13, 2016, was denied by the Technology Center Director in a decision mailed December 28, 2016.

The instant petition was filed on January 31, 2017, and again requests that the rejection in the examiner's answer be designated as a new ground of rejection and that prosecution in above-identified application be reopened.

¹ The appeal brief is dated February 16, 2016 and includes a certificate of mailing under 37 CFR 1.8 along with a statement that attests on a personal knowledge basis to its previously timely mailing. Accordingly, the appeal brief is considered to have been timely filed. See 37 CFR 1.8(b).

STATUTE AND REGULATION

35 U.S.C. § 134 provides that:

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

37 CFR 41.31 provides that:

(a) Who may appeal and how to file an appeal. An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.02(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under ex parte reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under ex parte reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirements of §§ 1.33 and 11.18(a) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

37 CFR 41.39 provides that:

(a) *Content of examiner's answer.* The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief.

(1) An examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision), unless the examiner's answer expressly indicates that a ground of rejection has been withdrawn.

(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon any Evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. The examiner must obtain the approval of the Director to furnish an answer that includes a new ground of rejection.

(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131, or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131, or 1.132 of this title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be

reopened before the primary examiner under paragraph (b)(1) of this section.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

37 CFR 41.40 provides that:

(a) *Timing.* Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § 1.181 to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant must file a reply under § 1.111 of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § 1.111, the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

OPINION

Petitioner argues that the examiner's answer of June 1, 2016, contains new grounds of rejection and should be designated as such. Petitioner specifically asserts that the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 in the examiner's answer changes the thrust of the rejection set forth in the final Office action of September 22, 2015, because the examiner's answer contains new reasoning not found in the final Office action of September 22, 2015. Petitioner cites *In re Leithem*, 661 F.3d 1316 (Fed. Cir. 2011), *In re Stepan Co.*, 660 F.3d 1341 (Fed. Cir. 2011), *In re Kumar*, 418 F.3d 1361 (Fed. Cir. 2005), *In re Kronig*, 539 F.2d 1300 (CCPA 1976), and *In re Waymouth*, 486 F.2d 1058 (CCPA 1973), in support of the position that the examiner's answer contains a new ground of rejection.

Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. See *Kronig*, 539 F.2d at 1303. A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the applicant. See *In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting *Leithem*, 661 F.3d at 1319). The prior rejection, however, need not be repeated *in haec verba* to avoid being considered a new ground of rejection. See *id.* In addition, further explaining and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. See *In re Jung*, 637 F.3d 1356, 1364-65 (2011).

Section 1207.03(III) of the Manual of Patent Examining Procedure (MPEP) specifically provides that:

A position or rationale that changes the "basic thrust of the rejection" will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the "basic thrust of the rejection" is the same. *In re Kronig*, 539 F.2d at 1303; see also *In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time "did not change the rejection" and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when "explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner"); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) ("It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection." (citations omitted)); *In*

re Cowles, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of "different language" does not necessarily trigger a new ground of rejection).

See MPEP § 1207.03(III).

The final Office action of September 22, 2015, included a rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 in the final Office action of September 22, 2015 indicated that the claims were directed to an abstract idea without additional elements that are sufficient to amount to significantly more than the abstract idea.² In determining that claim 34 was directed to an abstract idea, the final Office action of September 22, 2015 indicated that the claimed "fishing hook" was a field of use recitation, and the use of the hook for the purpose of fishing is routine and conventional.³

In the appeal brief of April 27, 2016, petitioner argued, *inter alia*, that the recitation of "method for fishing" as recited in the preamble of independent claims 34 and 38, necessarily requires the examiner to read into the claims many of the acts commonly performed in the practical endeavor of fishing, such as using the hook to actually hook and catch fish.⁴ The "Response to Argument" section of the examiner's answer of June 1, 2016 responded to petitioner's argument by indicating that: (1) the claimed method does not recite the steps (hooking fish or gathering fish) that the petitioner contends should be read into the claims;⁵ and (2) the claimed "hook" has an intended use for catching fish, and there are no positive steps recited in the claimed method that involve catching fish with the hook.⁶

The basic thrust of the examiner's position in rejecting claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 has remained the same from the final Office action of September 22, 2015 to the examiner's answer of June 1, 2016. The legal basis for the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 in both the final Office action of September 22, 2015 and the examiner's answer of June 1, 2016 is the subject matter eligibility requirement of 35 U.S.C. § 101. The rationale for the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 35 U.S.C. § 101 in both the final Office action of September 22, 2015 and the examiner's answer of June 1, 2016 tracks the *Mayo-Alice*⁷ two-step framework. See *In re Smith*, 815 F.3d 816, 818 (Fed. Cir. 2016) (to determine

² See Office action dated September 22, 2015 at page 3.

³ *Id.*

⁴ See appeal brief filed April 27, 2016 at page 5, line 11 to page 6, line 7.

⁵ See examiner's answer dated June 1, 2016 at pages 2 to 3.

⁶ *Id.*

⁷ *Mayo v. Prometheus*, 566 U.S. ____ (2012), and *Alice Corp. v. CLS Bank Int'l*, 573 U.S. ____ (2014).

whether an invention claims ineligible subject matter, one applies "the now-familiar two-step test introduced in *Mayo*, and further explained in *Alice*") (citations omitted). As to the first step, both the final Office action of September 22, 2015 and the examiner's answer of June 1, 2016 take the position that claims 34, 35, 37, 38, 40, and 45 through 49 are directed to an abstract idea. See *id* ("First, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea."). As to the second step, both the final Office action of September 22, 2015 and the examiner's answer of June 1, 2016 take the position that the additional elements recited in claims 34, 35, 37, 38, 40, and 45 through 49, considered alone and in combination, do not amount to an inventive concept. See *id* ("Second, we '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.'") (quoting *Alice* and *Mayo*). Therefore, the basic thrust of the examiner's position in rejecting claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 has remained the same from the final Office action of September 22, 2015 to the examiner's answer of June 1, 2016.

The "Response to Argument" section of the examiner's answer of June 1, 2016, does include additional explanation in response to arguments presented by petitioner for the first time in the appeal brief of April 27, 2016. Such additional explanation, however, does not change the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 as set forth in the final Office action of September 22, 2015. The additional discussion in the examiner's answer of June 1, 2016 relative to the final Office action of September 22, 2015 amounts only to an elaboration on the rationale set forth in the final Office action of September 22, 2015. See *Jung*, 637 F.3d at 1364–65.

An examiner is not required to anticipate an applicant's arguments concerning the scope of the claims in advance and preemptively respond to those arguments. See *id.* at 1363. Although the examiner did not use identical language in both the "Response to Argument" section of the examiner's answer of June 1, 2016, and the final Office action of September 22, 2015, the use of different language in responding to an applicant's arguments is not considered a new ground of rejection, provided that the "basic thrust of the rejection" is the same. See *Leithem*, 661 F.3d at 1319 (a prior rejection need not be repeated *in haec verba* to avoid being considered a new ground of rejection).

The cases cited by petitioner are readily distinguishable from the circumstances of the above-identified application. *Waymouth* involved the Board relying upon an aspect of a claim element different from the aspect of the claim element relied upon in the examiner's answer in affirming a rejection under 35 U.S.C. § 112, ¶ 1 (now 35 U.S.C. § 112(a)). The circumstances of the above-identified application do not involve such a change in the aspect of a claim element being relied upon in the rejection. The remaining cases cited by petitioner involve prior art rejections in which additional factual

information was brought to bear in support of the rejection.⁸ The circumstances of the above-identified application do not involve the examiner engaging in calculations based upon values disclosed in the prior art reference for the first time in the examiner's answer (*cf.*, *Kumar*). The circumstances of the above-identified application do not involve the examiner changing the interpretation of how a claim element is met by a disclosure in the prior art reference for the first time in the examiner's answer (*cf.*, *Leithem* or *Biedermann*). The circumstances of the above-identified application do not involve the examiner treating an applicant-submitted affidavit or declaration as inadequate on the merits (rather than as ineffective) for the first time in the examiner's answer (*cf.*, *Stepan*). Put simply, the circumstances of the above-identified application are most analogous to the circumstances present in *Jung* (explanation of why the claims are not as limited as asserted by the applicant is not a change to the basic thrust of the rejection), and are not analogous to the circumstances present in any of the cases in which a new ground of rejection was found.

In conclusion, the examiner's answer of June 1, 2016 did not change the basic thrust of the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101 vis-à-vis the final Office action of September 22, 2015, and petitioner has been given a fair opportunity to respond to the rejection of claims 34, 35, 37, 38, 40, and 45 through 49 under 35 U.S.C. § 101. Accordingly, the examiner's answer of June 1, 2016 does not contain a new ground of rejection warranting the reopening of prosecution in the above-identified application.

DECISION

For the previously stated reasons, the petition is granted to the extent that the Technology Center Director decision of December 28, 2016 has been reviewed, but the petition is **DENIED** with respect to designating the examiner's answer of June 1, 2016 as containing a new ground of rejection and reopening prosecution in the above-identified application. As such, neither the Technology Center Director decision of December 28, 2016 nor the examiner's answer of June 1, 2016 will be disturbed.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). See MPEP 1002.02.

⁸ The rejection at issue in *Kronig* was determined to not constitute a new ground of rejection.

Petitioner is reminded that the appeal forwarding fee (37 CFR 41.20(b)(4)) must be paid within **two (2) months** from the mailing date of this decision in order to avoid dismissal of the appeal. See 37 CFR 41.45. Extensions of time under 37 CFR 1.136(a) are not applicable to this time period. See 37 CFR 41.45(c).

Petitioner is also reminded that a reply brief may be filed within **two (2) months** from the mailing date of this decision. See 37 CFR 41.41(a). Extensions of time under 37 CFR 1.136(a) are not applicable to this time period. See 37 CFR 41.41(c)

Telephone inquiries concerning this decision should be directed to Vincent N. Trans at (571) 272-3613.

A handwritten signature in black ink, appearing to read 'R. W. Bahr', is positioned above the printed name.

Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy