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Decision on Appeal

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER J. RUDY

Appeal 2017-006934
Application 07/425,360[1]
Technology Center 3600

Before MICHAEL C. ASTORINO, MICHELLE R. OSINSKI, and AMEE A. SHAH, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] "The real party in interest is the inventor and applicant, Christopher John Rudy." Appeal Br. 1 (filed Apr. 27, 2016).

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant appeals from the Examiner's decision rejecting claims 34, 35, 37, 38, 40, and 45–49.[2] Final Act. 2–4 (mailed Sept. 22, 2015). Claims 1–25, 36, 39, 41–44, and 50–53 are canceled, and claims 26–33 and 54–60 are allowed. Amendment (filed Feb. 16, 2016, (entered by Advisory Action, mailed Mar. 3, 2016)); Final Act. 4. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Subject Matter on Appeal

Claims 34 and 38 are independent. Claim 34 is illustrative of the claimed subject matter on appeal and reproduced below with some formatting changes:

34. A method for fishing comprising steps of

(1) observing clarity of water to be fished to determine whether the water is clear, stained or muddy,

(2) measuring light transmittance at a depth in the water where a fishing hook is to be placed, and then

(3) selecting a colored or colorless quality of the fishing hook to be used by matching the observed water conditions ((1) and (2)) with a color or colorless quality which has been previously determined to be less attractive under said conditions than those pointed out by the following correlation for fish-attractive non-fluorescent colors:

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[2] This is the Appellant's fourth appeal in the instant application before the Patent Trial and Appeal Board and, its predecessor, the Board of Patent Appeals and Interferences. The previous decision (mailed Dec. 26, 2012) from this Board was appealed to and affirmed by the United States Court of Appeals for the Federal Circuit. *In re Rudy*, 558 Fed. Appx. 1011 (Mem) (Fed. Cir. 2014).

Water Condition	% Light Transmittance, i.e., light intensity at fishing depth as a percentage of light intensity at surface on a clear noon summer day										
Clear	0% Black	10% White	20% Yellow Blue	30% Blue	40% Purple	50% Silver Green	60% Green	70% Gray	80% Gold	90% Red	100% Red
Stained	0% Black	10% White Black	20% Black Yellow	30% Gold	40% Orange	50% Red	60% Silver	70% Blue	80% Purple Green	90% Green	100% Gray
Muddy	0% Black	10% Orange	20% Yellow	30% Yellow Silver	40% Silver White	50% Red White	60% Red Gold	70% Green	80% Gray Blue	90% Purple	100% Black

Rejection

Claims 34, 35, 37, 38, 40, and 45–49 are rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

ANALYSIS

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (internal quotation marks and citation omitted).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is "directed to." *See Alice*, 573 U.S. at 219 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk."); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010)

("Claims 1 and 4 in petitioners' application explain the basic concept of hedging, or protecting against risk.").

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as "molding rubber products" (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); "tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores" (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

If the claim is "directed to" an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where "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." *Alice*, 573 U.S. at 221 (citation omitted). "A claim that recites an abstract idea must include 'additional features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'" *Id.* (quoting *Mayo*, 566 U.S. at 77). "[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention." *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE,

84 Fed. Reg. 50 (Jan. 7, 2019) ("2019 Revised Guidance"). Under the 2019 Revised Guidance, we first look to whether the claim recites:

> (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
>
> (2) additional elements that integrate the judicial exception into a practical application (*see* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2106.05(a)–(c), (e)–(h) (9th Ed., Rev. 08.2017, Jan. 2018)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

> (3) adds a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional" in the field (*see* MPEP § 2106.05(d)); or
>
> (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 2019 Revised Guidance.

Step One of the Mayo/Alice Framework

Under the first step of the *Mayo/Alice* framework and Step 2A, Prong 1, of Office Guidelines (*see* 2019 Revised Guidance, 84 Fed. Reg. at 53–54), the Examiner determines that the claims are directed to "a protocol for fishing," characterized "by correlating a particular hook with a water condition in the claimed chart which is recognition of data within a selected data set." Final Act. 2–4. Using the language of claim 34, the Examiner determines:

> Claim 34 is directed to a method of fishing which comprises the steps of "observing clarity of the water to be fished" which is collection of data, "measuring light transmittance at depth in the water where a fishing hook is to be placed" which can be

> performed by a human by visual observation, and "selecting a colored or colorless quality of the fishing hook to be used by matching the observed water conditions," which is recognition of data within a selected data set.

Id. at 2. The Examiner determines that this concept involves mental processes and human action, which is abstract. *Id.* at 2–3, 5.

The Appellant argues "[n]o abstract idea is found in any present method claim" and that "concrete steps are required so that the art of fishing is improved thereby." Appeal Br. 5. More specifically, the Appellant argues that because "the present claims require the limitation of a method for fishing and require use of a hook in the method, they require a method for hooking fish or gathering fish through the use of a hook." *Id.* The Appellant supports this argument by highlighting the preamble of claim 34, which recites, "[a] method for fishing," and suggesting that the claims "require *use* of a fishing hook in the method." Reply Br. 2 (filed May 3, 2017); *see id.* at 3–4.

The Federal Circuit has explained that "the 'directed to' inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

An examination of claim 34 shows a "method for fishing" with three steps: "(1) observing clarity of water to be fished"; "(2) measuring light transmittance at a depth in the water where a fishing hook is to be placed"; "and then (3) selecting a colored or colorless quality of the fishing hook to be used." Appeal Br., Claims App. The Specification describes these steps

with particular regard to a method of selecting a fishing hook. *See* Spec. 8:15–9:9. The Specification describes:

> [I]n one embodiment thereof, advantageously the fishing hook(s) is(are) *selected* which is(are) less attractive to fish under fishing conditions of water clarity, light intensity, any color of the water and so forth, as the artisan understands. Colorless, transparent fishing hooks may thus be *selected*. Alternatively, colored or shaded fishing hooks may be so *selected*. The *selection can be one based upon instinct or personal experience of the angler*, or it may employ the *selection* of colors, shades and so forth or the like in contrast to the colors, etc., which are *selected* in the foregoing two Hill patents describing methods . . . .

Id. at 8:15–24 (emphases added).[3] Thereafter, the Specification recites the subject matter of claim 34 nearly verbatim. *See id.* at 8:24–9:9.

To the extent that the preamble of claim 34, which recites a "method of fishing," breathes life, meaning, and vitality into the claim, the claim, as a whole, calls for a process of selecting a colored or colorless quality of a fishing hook. The object or purpose of this process is to attempt to catch a fish, i.e., a method of fishing. The claimed method does not call for any action after the colored or colorless quality of a fishing hook is selected. For example, the claim does not require many of the core precepts of fishing, including securing the selected fishing hook to a fishing line or placing the selected fishing hook in water.

The method of claim 34 includes the steps of observing water clarity and measuring light transmittance of water, and then selecting a fishing hook

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[3] "[T]he foregoing two Hill patents" refer to Hill (US 4,599,820, iss. July 15, 1986) (hereinafter "Hill '820") and Hill (US 4,693,028, iss. Sept. 15, 1987), which "describe[] methods and apparatus for selecting fishing lure color." Spec. 1:22–23; Spec. Amendment (filed June 18, 2015; entered Feb. 26, 2016).

based on the observing and measuring steps and on a correlation. Observing water clarity may be mentally performed by perceiving a characteristic of water in one of three states: clear, stained, or muddy. Measuring light transmittance of water may be mentally performed by determining "light intensity at fishing depth as a percentage of light intensity at surface on a clear noon summer day," where the percentages are one of 0%, 10%, 20%, 30%, 40%, 50%, 60%, 70%, 80%, 90%, and 100%. *See* Spec 8:27–9:9; *see also* Appeal Br. 8 ("A fisherman must also measure light transmittance at a depth where a fishing hook is to be placed . . . , the claims not specifying how that is to be done."). Selecting a fishing hook may be mentally performed by memorizing or reading the correlation for fish-attractive non-fluorescent color in the claim. *See* Spec. at 8:21–23 ("The selection can be one based upon instinct or personal experience of the angler, or it may employ the selection of colors, shades and so forth or the like in contrast to the colors, etc."). More specifically, selecting a fishing hook is based on data recorded in the observing and measuring steps, which leads to a closed set of predetermined options. The predetermined options are represented in a correlation for fish-attractive non-fluorescent color, which is expressed in the form of a table of rows and columns, and reproduced below:

Water Condition	% Light Transmittance, i.e., light intensity at fishing depth as a percentage of light intensity at surface on a clear noon summer day										
Clear	0% Black	10% White	20% Yellow Blue	30% Blue	40% Purple	50% Silver Green	60% Green	70% Gray	80% Gold	90% Red	100% Red
Stained	0% Black	10% White Black	20% Black Yellow	30% Gold	40% Orange	50% Red	60% Silver	70% Blue	80% Purple Green	90% Green	100% Gray
Muddy	0% Black	10% Orange	20% Yellow	30% Yellow Silver	40% Silver White	50% Red White	60% Red Gold	70% Green	80% Gray Blue	90% Purple	100% Black

This table is small enough to be mentally analyzed by memorizing or reading the data.

Independent claim 38, like that of claim 34, includes the steps of observing water clarity and measuring light transmittance of water, and then selecting a fishing hook based on the observing and measuring steps based on a correlation. *See* Appeal Br., Claims App. Independent claim 38 and dependent claims 35, 37, 40, and 45–49 further define the selected fishing hook, or its condition (e.g., baited, orange, red). *See id.*

Thus, the claimed steps, under the broadest reasonable interpretation of the claim limitations in light of the Specification, recite a method to select a colored or colorless quality of a fishing hook based on observed and measured water conditions, which is a concept performed in the human mind. And, when viewed through the lens of the 2019 Revised Guidance, the Examiner's analysis depicts the claimed subject matter as the ineligible "mental processes" under Prong One of Revised Step 2A. *See Mayo*, 566 U.S. at 71 ("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" (quoting *Benson*, 409 U.S. at 67)); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371–72 (Fed. Cir. 2011); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016); *In re Brown*, 645 F. App'x. 1014, 1017 (Fed. Cir. 2016) (non-precedential) (claim limitations "encompass the mere idea of applying different known hair styles to balance one's head. Identifying head shape and applying hair designs accordingly is an abstract idea capable, as the Board notes, of being performed entirely in one's mind"). Accordingly,

we disagree with the Appellant's contention that the claims do not recite an abstract idea.

Under Step 2A, Prong 2 of the 2019 Revised Guidance (84 Fed. Reg. at 54), we look to whether the claims "apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception," i.e., "integrates the . . . judicial exception into a practical application."

In this regard, the Appellant argues that claim 34 is not directed to an abstract idea because "[t]he claims are practiced so that they act upon or transform *fish* from the fishing: freely swimming fish are hooked and gathered to be caught fish."[4] Appeal Br. 5; *see* Reply Br. 5. The Appellant's argument is not persuasive at least because the claims do not require a fish to be caught. *See* Ans. 4 (mailed June 1, 2016). Stated otherwise, catching a fish is not an additional element of the claim and does not "effect[] a transformation or reduction of a particular article to a different state or thing." 2019 Revised Guidance, 84 Fed. Reg. at 54. Further, we determine that the claims lack a transformation of a fishing hook to a different state or thing or otherwise provide for an additional element that integrates the abstract idea into a practical application. *Id.* at 55; *see also* Ans. 5–7. The claims also lack "[a]n additional element [that] reflects an improvement in the functioning of a computer, or an improvement to

[4] We acknowledge that some of these considerations may be properly evaluated under Step 2 of Alice (Step 2B of Office guidance). Solely for purposes of maintaining consistent treatment within the Office, we evaluate them under Step 1 of Alice (Step 2A of Office guidance). *See* 2019 Revised Guidance at 55.

other technology or technical field" or "an additional element [that] implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim." 2019 Revised Guidance, 84 Fed. Reg. at 55.

Thus, we are not persuaded of error in the Examiner's determination that the claims are directed to an abstract idea.

Step Two of the Mayo/Alice Framework

Under the second step in the *Mayo/Alice* framework, and Step 2B of the 2019 Revised Guidance, we determine that the claim limitations, taken individually or as an ordered combination, do not amount to significantly more than the judicial exception. *See* Final Act. 2–3, 6; Ans. 7. Independent claims 34 and 38 include the following elements: water to be fished; a fishing hook of colored or colorless quality; and a correlation chart for water conditions and light transmittance. *See* Appeal Br., Claims App. Independent claim 38 and dependent claims 35, 37, 40, and 45–49 further define the selected fishing hook, or its condition (e.g., baited, orange, red). *See id.*

These claim elements, alone and in combination, are no more than generic components. *See* Spec. 1:17–19; 8:21–9:12; Spec. Amendment (filed Apr. 11, 2006); Hill '820, Figs. 35A, 35B, 36, col. 6, ll. 59–68. Additionally, we note that claim 34 recites, "measuring light transmittance at a depth in the water where a fishing hook is to be placed." Appeal Br., Claims App. However, the claim does not call for any particular instrument to measure light transmittance. *See* Appeal Br. 8 ("A fisherman must also measure light transmittance at a depth where a fishing hook is to be placed - which may be carried out, for example, with a Secchi disc, or with another

instrument or method, the claims not specifying how that is to be done."). Notably, the record only describes generic instruments that are used to measure light transmittance which are well-understood, routine, and conventional (e.g., a Secchi disc). *See id.*; Spec. 9:11–12.

Further, the Appellant does not offer additional reasoning or argument why the claims "[a]dd[] a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present." 2019 Revised Guidance, 84 Fed. Reg. at 56.

The Appellant argues that the claims recite an "inventive concept" because "the claims are "novel and unobvious." *See* Appeal Br. 8; *see also id.* at 9–10; Reply Br. 3, 4. However, an abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it. *See Mayo*, 566 U.S. at 78. "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). Indeed, "[t]he 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter." *Diehr*, 450 U.S. at 188–89; *see also Mayo*, 566 U.S. at 91 (rejecting "the Government's invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101").

The Appellant argues that method claim 34 does not preempt any field or transgress the public domain, particularly fishing. Appeal Br. 5; Reply Br. 2. The Appellant points out that "the driving concern for not permitting patenting of abstract ideas is preemption of a field by the claims." Reply

Br. 4 (citing *Alice*, 573 U.S. at 216). The Appellant asserts "that preemption does not occur since there are numerous alternatives to the claimed methods for fishing." *Id.* at 5; *see* Appeal Br. 8. The Appellant's argument is not persuasive. Although the Supreme Court has described "the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption," *see Alice*, 573 U.S. at 216, characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. "The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 573 U.S. at 216). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.* In this case, claim 34 is not sufficiently limiting so as to fall clearly on the side of patent-eligibility. *Supra.*

The Appellant also suggests the USPTO classification, particularly "an entire subclass in class 43, fishing, trapping, and vermin destroying, subclass 4.5, is dedicated to methods of fishing, i.e., methods for hooking or gathering fish," and the patents within this subclass, including the Hill patents (*supra* n.3), would embrace patent ineligible subject matter under the Examiner's analysis. *See* Appeal Br. 6–7; Reply Br. 2–3. The Appellant's argument is not persuasive. The issue in the present appeal is whether the rejected claims are patent-eligible. *See* Ans. 4–5. Whether the USPTO classification system includes a subclass for the application to be examined

is not relevant to that issue. Nor is it relevant that claims in patented cases, such as method claim 1 of Hill '820, have some similarity to the current claims as those claims are not within our purview.

We have considered the remaining arguments advanced by the Appellant in the Appeal Brief at pages 2–9 and the Reply Brief at pages 1–6, and have determined that they are unpersuasive of Examiner error. Therefore, we agree with the Examiner's determination that the limitations of claim 34 do not transform the claims into significantly more than the abstract idea.

Conclusion

Thus, we sustain the Examiner's rejection of claims 34, 35, 37, 38, 40, and 45–49 under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

DECISION

We AFFIRM the Examiner's decision rejecting claims 34, 35, 37, 38, 40, and 45–49.

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).

AFFIRMED

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