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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEORGE SUGIHARA

Appeal 2018-003802
Application 11/716,382
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s
rejection of claims 60–63. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our decision references Appellant’s Appeal Brief (“Appeal Br.,” filed July 11, 2017) and Reply Brief (“Reply Br.,” filed February 15, 2018), and the Examiner’s Answer (“Ans.,” mailed December 18, 2017) and Non-Final Office Action (“Non-Final Act.,” mailed March 9, 2017). Appellant identifies the real party in interest as Ocean Resource Exchange, LLC. Appeal Br. 3.

CLAIMED INVENTION

Appellant’s claimed invention “relates to systems and methods for apportioning the quota amongst, for example fishermen, of by-catch unsought-for marine animals” (Spec. ¶ 2).

Claim 60, reproduced below with bracketed notations added, is the sole independent claim, and is representative of the claimed subject matter:

60. A system comprising:

[(a)] a computer connected to a computer network and comprising:

[(a1)] a database storing information relating to a by-catch quota, the information comprising a species to which the by-catch quota relates, a quantity of that species that an entity is authorized to by-catch, a recent by-catch capture history of a plurality of entities, and a time period to which the quota relates; and

[(a2)] a processor configured to initially distribute the by-catch quota amongst the plurality of entities based at least in part on the recent by-catch capture history, wherein an entity having a low by-catch capture rate relative to other entities in a previous time period is allocated a larger fraction of the by-catch quota in a subsequent time period.

REJECTION

Claims 60–63 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.²

² Concurrently with the filing of a Notice of Appeal on June 8, 2017, Appellant filed an Amendment canceling claims 1–59 and 64–73.

ANALYSIS

This application was previously before us on appeal. Of relevance here, in the previous appeal, *Ex parte Sugihara*, Appeal No. 2013-004762, at 11 (PTAB Jan. 19, 2016), we affirmed the Examiner’s rejection of claims 1, 3–7, 9–13, 25, 31–51, and 68–70 under 35 U.S.C. § 101 but reversed the § 101 rejection of claims 60–63.

Appellant argues that the Board’s previous decision is the “law of the case” and controls the prosecution of this application. Therefore, according to Appellant, “the Examiner should not have reissued the § 101 rejection [of claims 60–63] that the Board already reversed” (Appeal Br. 6).

The law of the case doctrine is a judicially-created doctrine designed to prevent the re-litigation of issues that already have been decided. It also has been routinely applied by federal administrative agencies to give preclusive effect to their earlier decisions in the same matter. Consistent with other administrative bodies, the Board has applied the law of the case doctrine and has held that all findings and conclusions in a first decision by the Board — whether express or implicit — are entitled to issue-preclusive effect during further prosecution of the same application. *See, e.g., Ex parte Fisher*, Appeal No. 2013-000665, 2015 WL 5782991, at *4 (PTAB Sept. 16, 2015); *Ex parte Keggenhoff*, Appeal No. 2012-001720, 2014 WL 3950403, at *5 (PTAB Aug. 11, 2014); *Ex parte Wood*, Appeal No. 2010-006834, 2012 WL 2929626, at *3 (BPAI July 12, 2012). Under the law of the case doctrine, the Board will, thus, generally adhere to a decision in a prior appeal in the same case unless one of three exceptions exists: (1) the evidence in a subsequent trial contains new and different material evidence; (2) there has been an intervening change of controlling legal authority; or

(3) the earlier ruling was clearly erroneous and would work a manifest injustice. *See Gould, Inc. v. United States*, 67 F.3d 925, 930 (Fed. Cir. 1995).

It is manifest here that exception (1) exists, and that the “law of the case” doctrine does not apply to the present appeal, in that the “evidence” before us now is substantially different from the “evidence” before the panel in the prior Board decision. Claim 60, as previously presented before the Board, recited a system comprising “a computer connected to a computer network and having a database” for storing particular information:

- 60. A system comprising:
 - a computer connected to a computer network and having a database for storing information relating to a by-catch quota, the information comprising:
 - a species to which the by-catch quota relates,
 - a quantity of that species that an entity is authorized to by-catch, and
 - a time period to which the quota relates.

During prosecution, subsequent to the Board’s January 19, 2016 decision, independent claim 60 was amended to its current form, i.e., to recite that the computer additionally comprises

- a processor configured to initially distribute the by-catch quota amongst the plurality of entities based at least in part on the recent by-catch capture history, wherein an entity having a low by-catch capture rate relative to other entities in a previous time period is allocated a larger fraction of the by-catch quota in a subsequent time period[,]

i.e., limitation (a2).

The only issue decided in the previous appeal, and, therefore, the only issue that is the basis for binding law of the case, concerns the patent eligibility of claim 60, as presented at the time of the previous appeal.

Claim 60, now before us, is not the same claim that was considered in the previous Board decision, and raises distinct factual and legal issues that were not previously before this Board. Because the factual and legal considerations affecting the patent eligibility of claims 60–63 have changed since the previous decision, we are not persuaded that the prior Board decision constitutes the law of the case in this appeal.

Appellant asserts that the amendment to claim 60 merely narrowed claim 60 to include the features that the Board found were not disclosed by any of the cited references (Appeal Br. 6). And Appellant argues that if the broader version of claim 60 was not directed to an abstract idea, the amended narrower version of the claim also cannot be directed to an abstract idea because “the claim is not directed to anything new; the claim now covers **less** not more and is **more** concrete and specific not **less**” (*id.* at 7).

Patent eligibility does not turn on whether or not a claim is narrowly drawn. Thus, whether or not claim 60 has been narrowed does not affect whether the claim is directed to an abstract idea under step one of the *Mayo/Alice* framework.³ *See, e.g., Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1321 (Fed. Cir. 2016) (“A narrow claim directed to an abstract idea, however, is not necessarily patent-eligible”); *see also BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1287 (Fed. Cir. 2018)

³ The Supreme Court, in *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014), reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.*

(“[A] claim is not patent eligible merely because it applies an abstract idea in a narrow way.”).

Appellant ostensibly maintains otherwise (Reply Br. 3–4). But, it also is immaterial, without more, that the Examiner has acknowledged that claim 60, as amended, is novel and/or non-obvious in view of the cited references. Neither a finding of novelty nor a non-obviousness determination automatically leads to the conclusion that the claimed subject matter is patent eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice Corp.*, 573 U.S. at 217–18 (citation omitted). “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). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent ineligible. *See Mayo*, 566 U.S. at 90; *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘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.”).

For the foregoing reasons, we are not persuaded that the Board’s previous decision is the “law of the case” and, thereby, controls the prosecution of this application. As such, we are not persuaded that the Examiner erred in reentering a § 101 rejection of claims 60–63. Because

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Appellant has presented no further arguments, we sustain the Examiner's rejection.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
60–63	101	Eligibility	60–63	

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