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EXAMINER

CLARKE, SARA SACHIE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MUZZY PRODUCTS CORPORATION¹
Appellant

Appeal 2009-011350
Reexamination Control 90/008,081
Patent US 6,780,079 B2²
Technology Center 3900

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
JAMES T. MOORE, *Vice Chief Administrative Patent Judge*,
SCOTT R. BOALICK, DANIEL S. SONG and KEN B. BARRETT,
Administrative Patent Judges.

SONG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR RECONSIDERATION
OF THE EXAMINER'S SUBSTANTIAL NEW
QUESTION OF PATENTABILITY DETERMINATION³

¹ Muzzy Products Corporation is the real party in interest (App. Br. 2).

² Issued August 24, 2004 to John Musacchia, Jr. (hereinafter "'079 patent")
from Application Number 09/174,868 (hereinafter "'868 application").

³ The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The present *ex parte* reexamination of the '079 patent was instituted based on the request of a Third Party Requester on July 11, 2006. The Patent Owner (hereinafter "Appellant") challenges the Examiner's finding of a substantial new question of patentability (hereinafter "SNQ"). (App. Br. 4, 5). We construe Appellant's challenge as a request for reconsideration of the Examiner's SNQ determination. The authority to review issues related to SNQ has been delegated to the Chief Judge of the Board of Patent Appeals and Interferences. 75 Fed. Reg. 36357-58 (June 25, 2010). We have jurisdiction over this matter pursuant to the further delegation of that authority from the Chief Judge.

In addition to the SNQ issue, Appellant appeals the Examiner's rejection of claims 1-17. For the reasons given below, the procedural SNQ issue is dispositive, and we do not reach the merits of the rejection.

The '079 patent is the subject of the judicial proceeding styled *Muzzy Products Corporation v. Primos, Inc.*, U.S. District Court – Georgia Northern (Rome), 4:05cv182 (Ans. 2). This action has been stayed pending the resolution of this reexamination proceeding (Ans. 2).

During the prosecution of the '868 application, which issued as the '079 patent, an appeal to the Board was made (Appeal No. 2004-0430), the decision having been mailed March 11, 2004 (hereinafter "prior Decision"). The prior Decision reversed the rejection and remanded the case to the Examiner for further consideration. The '079 patent issued in due course.

In the present appeal, we REMAND for the reason set forth below.

THE INVENTION

The '079 patent being reexamined is directed to a hunting device known as a "game call," which is used to generate a sound that attracts an animal to be hunted (col. 1, ll. 8-32). The hunting device 10 may be secured to the hunter's thigh and includes an elevating device 150 which elevates the game call portion 30 with its sound emanating surface 32 so that the sound generated can "escape to ambient." (Col. 4, ll. 14-21; col. 5, l. 40 - col. 6, l. 10; Fig. 9). Figure 9 of the '079 patent is reproduced below.

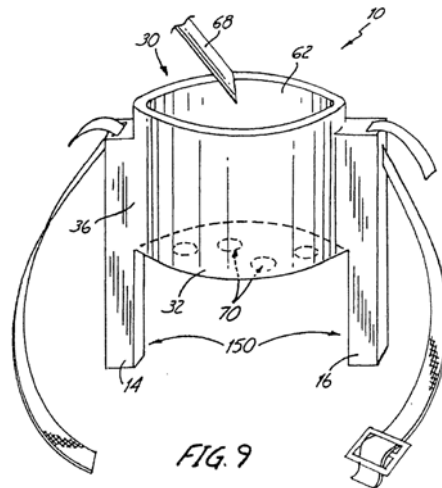


Figure 9 of the '079 patent reproduced above shows a perspective view of one embodiment of the hunting device including an elevating device 150 which elevates the game call portion 30 of the hunting device 10.

Representative claim 1 reads as follows (App. Br. 28, Claims App'x., emphasis added):

1. A hunting device for producing sound comprising:
 - (a) *a one-piece game call and elevating device*, wherein sound is produced, said game call having a scratch surface separated from a sound emanating surface, the sound emanating surface having apertures through which the sound in said game call escapes the game call; and
 - (b) a body attachment assembly, connected to said elevating device, designed to releasably attach the game call and elevating device to the body of a user of the hunting device;

the elevating device elevating the sound emanating surface of said game call such that the sound emanating surface is not in contact with a user when the body attachment assembly is attached to the body of a user, thereby providing an unencumbered path for the sound to escape the game call and reach ambient.

ISSUE

The dispositive issue raised in the present appeal is whether a SNQ can be established based on the same prior art reference, which is being considered in the reexamination for the same purpose as that during the original prosecution, in view of reconsideration of statements made in a Declaration of record in the original examination.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Original Examination

1. During the original examination of the '868 application which eventually issued as the '079 patent, the claims were rejected under 35 U.S.C. § 103(a) as obvious over prior art Patent No. 5,607,091, issued Mar. 4, 1997, to Mr. John Musacchia (hereinafter "Musacchia"), the Examiner stating that while "Musacchia does not disclose a hunting device for producing sounds that has a unitary construction[]," "unitary construction of the hunting device would have been obvious to one of ordinary skill in the art, since this would aid in the portability and usage of the device." (Non-final Rejection 3, Aug. 2, 1999).

2. In response, the inventor, Mr. John Musacchia Jr., filed a Declaration seeking to establish non-obviousness through long-felt need stating, *inter alia*:

A. "I am one of skill in the art of game calls. I developed the present game call device after noting several complaints by others in the art that a separate game call and holding device was disadvantageous." (¶ 2).

B. "First, I understand the [long-felt] need must have been a persistent one that was recognized by those of ordinary skill in the art. In this regard, the game call of the present invention overcomes problems first recognized by others in the art, namely those using my father's '091 game call holder." (¶ 6).

C. "My father and I noted from responses to his '091 holder that others were trying to develop a superior unitary game call device, but there were many prior unsuccessful attempts to do so." (¶ 8).

(Decl. of Mr. John Musacchia Jr., ¶¶ 2, 6, 8, Feb. 2, 2000 (hereinafter "Declaration"))).

3. After extensive prosecution, the original Examiner maintained the rejection of the claims over Musacchia stating that "Musacchia discloses the claimed invention except for the game call device constructed as one piece" and that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to form the game call device as one piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)." (Final Rejection 5, Sept. 24, 2002).

4. During the prosecution, the original Examiner also referred to the Declaration and stated that "[t]he affidavit has been fully considered by the examiner, but does not overcome the rejection" because of the lack of objective evidence "to account for long-felt need which must be recognized, persistent, and not solved by others." (Final Rejection 7, Aug. 1, 2000).

5. After further prosecution, the Applicant appealed to the Board (App. Br., Mar. 24, 2003).

6. In the original Examiner's Answer, the Examiner stated that "Appellant's arguments and 37 CFR 1.132 Affidavit have been given full consideration but they have not changed the Examiner's position." (Ans. 4, Apr. 29, 2003).

7. The original Board panel reversed the original Examiner's rejection stating that there is no *per se* rule that "forming several pieces integrally as a one-piece structure would have been obvious . . . [,]" and "in

this case, one must determine if it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Musacchia's separate call and platform as a one-piece structure." (Original Decision 4-5, Mar. 11, 2004).

8. The original Examiner issued a Notice of Allowance in response to the Board's decision and the application ultimately issued as the '079 patent (Notice of Allowance, Mar. 25, 2004).

Reexamination

9. The Central Reexamination Unit (hereinafter "CRU") Examiner granted a third party request for reexamination of the '079 patent, stating that the statements in the Declaration were only considered in context of long-felt need and not as admissions. (Order 2-4, Dec. 7, 2006). In particular, the CRU Examiner states:

Based upon the record of the earlier concluded examination, the examiner in the earlier concluded examination did not consider the declaration nor the statements made in the remarks relating to long-felt need with respect to a motivation to modify Musacchia '091 such that the device of the reference is of one-piece construction. Thus, the requester has presented Musacchia '091 in a new light in view of the inventor's declaration such that a reasonable examiner would consider Musacchia '091 and the declaration important in deciding whether any claim of the patent for which reexamination is requested is patentable. (Order 3-4, Dec. 7, 2006).

10. The CRU Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as obvious over Musacchia (Ans. 3).

PRINCIPLES OF LAW

35 U.S.C. § 303(a) (2006) states, in pertinent part:

The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

In applying this statutory language, the Federal Circuit stated that "to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose." *In re Swanson*, 540 F.3d 1368, 1380 (2008) (concluding that prior art used as a secondary reference in an obviousness rejection was sufficient to establish SNQ when considered as an anticipatory reference) (*citing* H.R.Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."))).

"[A]n 'argument already decided by the Office, whether during the original examination or an earlier reexamination' cannot raise a new question of patentability As [the Federal Circuit] explained in *In re Recreative Technologies Corp.*, the substantial new question requirement 'guard[s] against simply repeating the prior examination on the same issues and arguments' and bars 'a second examination, on the identical ground that had

previously been raised and overcome." *Id.* (Citations omitted).

"Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions While the standard is more flexible than before [the 2002 amendment to § 303], we are mindful that Congress intended that the courts continue to 'judiciously interpret the 'substantial new question' standard to prevent cases of abusive tactics and harassment of patentees through reexamination." *Id.* at 1380-81 (*citing* H.R.Rep.No. 107-120, at 3).

ANALYSIS

Prior to challenging the Examiner's substantive obviousness rejection, the Appellant requested the termination of the reexamination proceeding because no SNQ exists (App. Br. 5). In particular, the Appellant argued that there is no SNQ because the same question of patentability now asserted by the CRU Examiner – that is, whether it would have been obvious to make Musacchia's game call and the elevating device "one-piece" – was fully considered during the original examination (App. Br. 10-15).

The USPTO has recently clarified the procedure for seeking review of issues pertaining to a SNQ. *See* "Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in *Ex Parte* Reexamination Proceedings", 75 Fed. Reg. 36357-58 (June 25, 2010) (hereinafter "Notice") (delegating the authority to review issues related to the Examiner's determination that a reference raises a SNQ to the Chief

Administrative Patent Judge, who may further delegate this authority to a panel of Administrative Patent Judges deciding the appeal in the *ex parte* reexamination proceeding).

In the present appeal, the reexamination of the '079 patent was ordered prior to the date of the Notice. *See* Order Granting Request for Reexamination, December 7, 2006. Nonetheless, the Notice provides that:

for *ex parte* reexamination proceedings ordered prior to June 25, 2010, if the patent owner presents the SNQ [substantial new question of patentability] issue in its appeal brief, the BPAI panel will review the procedural SNQ issue along with its review of any rejections in an appeal and will enter a final agency decision accordingly.
75 Fed. Reg. 36357.

Hence, we address the SNQ issue on appeal. The Examiner contends that the Declaration filed during the prosecution of the '079 patent was only considered as to whether it demonstrated long-felt need, and not considered by either the original Examiner or the original Board panel as including admissions (Ans. 12, 16). In this regard, the CRU Examiner states that, when considered as admissions, the statements of the Declaration:

provide evidence of obviousness, which was specifically pointed out as missing in the prior examination, and therefore, cast Musacchia '091 in a new light. The teachings of Musacchia '091 considered in conjunction with the admissions are a new question of patentability not previously considered. As such, the teachings of Musacchia '091, in conjunction with the admissions in the record, raise a *substantial new* question of patentability.
(Ans. 14).

The CRU Examiner maintains that the rejection of claims 1-17 is proper in view of Musacchia's disclosure of the claimed invention except for

the "one-piece" construction (Ans. 3-9) and the admissions evidence, the CRU Examiner concluding:

Thus, in light of this [admissions] evidence, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the game call device of Musacchia '091 to a one-piece game call and elevating device because the admissions by the applicant in his declaration and remarks show that a one-piece design was considered desirable by those of skill in the art and would predictably result in preventing the loss of game calls, maintaining a true sound, and reducing the cost of the game call. Furthermore, in light of the admission evidence, one of ordinary skill in the art would have known that there are a finite number of identified, predictable solutions known in the art that would solve the recognized problems or needs. One of ordinary skill in the art would have recognized that pursuing the identified, predictable solution of using a one-piece configuration would result in the claimed invention with a reasonable expectation of success. (Ans. 10-11).

We disagree with the CRU Examiner's finding that a SNQ exists because the prior art Musacchia reference was previously considered during the original examination for the same or substantially the same purpose as it is now being considered in the reexamination. *See In re Swanson*, 540 F.3d at 1380. Both the original Examiner and the CRU Examiner rejected Appellant's claims as obvious over a single reference: the Musacchia '091 patent. (*See* FF 1, 3, 10 and Ans. 10-11). The original Examiner relied on Musacchia for the disclosure of the claimed invention except for the one-piece construction. (FF 1, 3, 7). The CRU Examiner relies on Musacchia for the disclosure of the claimed invention except for the one-piece construction. (Ans. 9). Thus, the question of patentability in both examinations is whether it would have been obvious to one of ordinary skill

in the art to make Musacchia's game call and elevating device in "one-piece."

While the CRU Examiner may be correct in asserting that the original Examiner and the previous Board panel considered the statements in the Declaration only in the context of long-felt need (FF 4, 9; Ans. 12, 16), these statements do not alter the purpose for which the CRU Examiner now relies on the Musacchia reference for finding the existence of a SNQ. In particular, the CRU Examiner does not apply the statements in the Declaration to gain any new understanding as to the teachings of the Musacchia reference, but rather, uses the statements merely to reach a different legal conclusion as to obviousness. While the CRU Examiner asserts that the statements in the Declaration casts Musacchia in a "new light" (Ans. 14), the CRU Examiner's position suggests that the CRU Examiner is viewing the Declaration, not the Musacchia reference, in a new light.

In view of the above, we find the statements in the Declaration insufficient to establish a SNQ. Hence, the Examiner's finding of a SNQ is incorrect, and we remand the case back to the CRU Examiner for termination of the reexamination. We do not reach the Appellant's arguments (App. Br. 21-26) directed to the merits of the substantive obviousness rejection of claims 1-17.

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Reexamination Control 90/008,081
Patent US 6,780,079 B2

CONCLUSION

We conclude that there is no substantial new question of patentability, and the case is REMANDED for further action consistent with this decision.

REMANDED

bim

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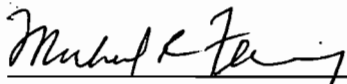
BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MUZZY PRODUCTS CORPORATION
Appellant

Appeal 2009-011350
Reexamination Control 90/008,081
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DELEGATION OF AUTHORITY
IN EX PARTE REEXAMINATION PROCEEDING APPEAL

Pursuant to the Notice published June 25, 2010, at Volume 75 of the Federal Register, pages 36357-58, the Chief Judge of the Board of Patent Appeals and Interferences hereby delegates authority to the panel to review issues related to the examiner's determination that a reference raises a substantial new question of patentability in this ex parte reexamination proceeding.



Michael R. Fleming
Chief Administrative Patent Judge

Appeal 2009-011350
Reexamination Control 90/008,081
Patent US 6,780,079 B2

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