USPTO Director Affirms Recent Decision from Board of Patent Appeals and Interferences

By: Robert J. Diaz, Esq.

In a relatively rare precedential opinion[1] signed by both the Director and Deputy Director of the United States Patent and Trademark Office (USPTO), the Board of Patent Appeals and Interferences clarified when findings made by a patent examiner are reviewed *de novo* by the board. The board's February 26, 2010 decision in *Ex Parte Frye* (Appeal No. 2009-006013) makes it clear that ordinarily the specific factual findings of an examiner are reviewed *de novo* only when the applicant specifically challenges those findings on appeal. The fact that the director signed off on the opinion likely indicates appellants can expect greater scrutiny by the board on this issue in the future.

All of the claims at issue in *Frye* were rejected, in one way or another, based on a determination by the examiner that a prior art patent U.S. Patent No. 5,491,912 to Snabb (the Snabb patent) disclosed a shoe where the "rear heal section of the insole" and the "forward toe section of the insole" met at a point "substantially halfway" with respect to the upper surface or outsole of the shoe, as required by the claims.[2] The applicant contended that the examiner's findings as to what the Snabb patent disclosed were wrong and the transition point between the rear section and forward section of the shoe "would never be considered to be at a halfway point of the shoe."[3] The appellant further asserted that "this erroneous underlying finding of fact pervades the examiner's finding of anticipation of claims 1, 5, and 11 and the examiner's ultimate conclusions of obviousness of claims 8, 14-16, 19, and 20."[4] The board reversed the examiner's rejection of the claims because [t]he [e]xaminer's finding that Snabb discloses a meeting point located 'substantially halfway' . . . as claimed rests on an unreasonably broad interpretation of 'substantially halfway.'"[5] In arriving at this conclusion, the board noted that under its mandate under 35 U.S.C. §6(b) "to review adverse decisions of examiners upon applications for patents" it reviews "the particular finding(s) contested by an appellant *anew in light of all the evidence and argument* on that issue" — a *de novo* standard;[6] however, the board also made clear that while findings of the examiner contested by the appellant are reviewed *de novo*, "the [b]oard will not, as a general matter, unilaterally review those uncontested aspects of the rejection."[7] That is, if an appellant contests a rejection based upon a particular finding made by the examiner, the "[b]oard need not review the other, uncontested findings of fact made by the examiner underlying the rejection, such as the presence of uncontested limitations in the prior art."[8]

The importance of the *Frye* decision is underscored by the fact that both USPTO Director David J. Kappos and Deputy Director Sharon R. Barner joined the board in issuing the decision. While the director is a statutory member of the board,[9] it is very unusual for the director to sign off on board decisions. Particularly given the fact that the finding of the examiner at issue in *Frye* was properly raised on appeal, it is safe to conclude that the *Frye* decision, and the director's decision to sign off on it, was intended to emphasize the importance of challenging on appeal the specific factual

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[1] Of the 6,962 Ex Parte Appeals decisions issued by the board in 2009, only four cases issued as Precedential Opinions. (See 10-15-2009 BPIA Presentation to the AIPLA which can be found on the PTO website at http://www.uspto.gov/ip/boards/bpai/stats/present/index.jsp)
[2] *Frye*, at 3-4
[3] *Id.* at 4
[4] *Id.* at 12
[5] Id. at 14
[6] *Id.* at 10 (emphasis added)
[7] *Id.*
[8] *Id.*
[9] See 35 U.S.C. §6(a)

findings made by the examiner, rather than just the examiner's general basis for a rejection. The board, it appears, will defer to the factual findings made by the examiner, unless those findings are specifically challenged in the appeal.

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