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BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE LINCOLN ELECTRIC COMPANY
Requester and Appellant

v.

Patent of ILLINOIS TOOL WORKS, INC.
Patent Owner and Respondent

Appeal 2013-000727
Reexamination Control 95/000,205
Patent US 7,049,546 B2
Technology Center 3999

Before RICHARD TORCZON, HOWARD B. BLANKENSHIP,
ALLEN R. MacDONALD, SCOTT R. BOALICK, and STEPHEN C. SIU,
Administrative Patent Judges.

PER CURIAM

DECISION ON APPEAL

STATEMENT OF THE CASE

In an earlier Decision (mailed Feb. 29, 2012), the Board affirmed the Examiner's final decision favorable to the patentability of claims 19-22 but reversed with respect to claims 1-18 and 23-47. We entered rejections against claims 1-18 and 23-47 designated as new grounds. Owner elected to reopen prosecution before the Examiner (37 C.F.R. § 41.77(b)(1)). Owner submitted amendments to the claims in the Response After Board Decision ("Response," filed Mar. 23, 2012). Requester did not file comments (pursuant to 37 C.F.R. § 41.77(c)) in response to Owner's Response. Neither Owner nor Requester submitted comments (§ 41.77(e)) in response to the Examiner's determination (§ 41.77(d)) that all the rejections had been overcome.

The proceeding has been returned to the Board (37 C.F.R. § 41.77(f)). Our new Decision is deemed to incorporate the earlier Decision, except for those portions specifically withdrawn. 37 C.F.R. § 41.77(f).

Claim Status/Representative Claim

Claims 1-7, 9-27, and 29-47 are present and are subject to reexamination. Claims 8 and 28 have been canceled.

Claim 1 (as amended):

1. A welding, cutting or heating system capable of receiving a range of input voltages spanning at least two input utility voltages having a ratio of at least 1.5, comprising:

an input circuit configured to receive any input voltage within the range of input voltages, and configured to provide a first dc signal;

a converter configured to receive the first dc signal and to provide a boosted converter output that is maintained while an output current is being provided, and configured to receive at least one control input;

an output circuit configured to receive the converter output and to provide a welding, heating or cutting signal;

a controller, including a power factor correction circuit, and a driver circuit responsive to feedback indicative of an input current, and configured to provide at least one control signal to the converter; and

an auxiliary power source configured to receive the any input voltage within the range of input voltages and configured to provide a control power signal to the controller, regardless of the magnitude of input.

Owner's Contentions

Owner contends that the amendments submitted with the Response overcome all the grounds of rejection entered in the earlier Decision:

I. Claims 1-18 and 23-47 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

II. Claims 6-18, 26-33, 37, and 39-47 were rejected, in the alternative, under 35 U.S.C. § 112, first paragraph, for lacking adequate written description.

ANALYSIS

I. 35 U.S.C. § 112, Second Paragraph

In the earlier Decision, we explained why the claims that recited the term “rectified magnitude” were indefinite. Earlier Decision 6-8. All the claims directed to the feature of “rectified magnitude” that are now before us add the modifier “average” -- i.e., “average rectified magnitude” -- consistent with the suggestion in the earlier Decision. *See* Independent Claims 26, 32, 34, 37, 38, and 39.

We also determined that Claim 1 was indefinite for additional reasons having to do with its recitation of “rectified magnitude.” Earlier Decision 8-9. The feature relating to “rectified magnitude” is not recited in Claim 1 that is before us.

Further, we earlier determined that recitations that related power factor correction with feedback indicative of an input current rendered the claims indefinite. Earlier Decision 9-14. Of the claims that are now before us, all that recite the language “feedback indicative of an input current” relate the feedback to a driver circuit, rather than to power factor correction. *See* Independent Claims 1, 6, 26, 32, 34, 37, 38, and 39.

Finally, we earlier determined that dependent claims 8 and 28 were indefinite because of a failure to relate the steps of “deriving auxiliary power” to steps recited in the base claims. Earlier Decision 14-15. Owner has canceled Claims 8 and 28.

Accordingly, the earlier rejection under § 112, second paragraph, has been overcome. We withdraw the rejection of the claims under 35 U.S.C. § 112, second paragraph, as being indefinite.

II. 35 U.S.C. § 112, First Paragraph

We earlier entered an alternative ground of rejection for lack of written description support for the relation of “feedback indicative of the input current” to power factor correcting, and to feedback indicative of a generic “input” for claims that did not require that the “feedback” be used for power factor correction. Earlier Decision 15-16.

As we indicated *supra*, all the claims that now contain the language “feedback indicative of an input current” relate the feedback to a driver circuit, rather than to power factor correction. Further, all the claims reciting feedback are limited to “a driver circuit” responsive to “feedback indicative of an input current,” for which the '546 patent provides literal written description support. *See, e.g.*, Claim 1; '546 patent col. 6, l. 66 - col. 7, l. 3.

Accordingly, the earlier rejection under § 112, first paragraph, has been overcome. We withdraw the rejection of the claims under 35 U.S.C. § 112, first paragraph, as lacking written description support.

III. Prior Art

In the earlier Decision, we did not consider Requester’s numerous proposed grounds of rejections under 35 U.S.C. § 103(a), except for original patent claim 19, with claims 20 through 22 dependent. We sustained the Examiner’s decision not to enter any of the proposed rejections over the prior art as to claims 19 through 22 because Requester had not: (1) shown that the allegedly inherent power source in JP '778¹ discussed with respect

¹ Japanese Patent Publication H2-41778, with English translation.

to corresponding structure in the '546 patent would be recognized by one of ordinary skill in the art as identical or equivalent to auxiliary power controller 105 in the '546 patent; or (2) demonstrated after an equivalents analysis that structures including non-equivalent structures in the prior art would have rendered obvious the subject matter as a whole of base claim 19.

Each of present independent claims 14, 30, and 36 sets forth auxiliary power means that are presumed to be interpreted in accordance with 35 U.S.C. § 112, paragraph six. Owner argues in the Response that Requester has not done the required analysis of claim scope under § 112, paragraph six, in the proposed rejections. We agree. *See, e.g., Original Inter Partes Request*, filed Feb. 2, 2007, Appendix A, Claim 14 -- “*JP '778* inherently discloses this feature,” then referring to “auxiliary power supplies” in other prior art references.

Owner also argues in the Response that each of independent claims 1, 6, 23, 26, 32, 34, 37, 38, and 39 is patentable over the prior art because the prior art fails to teach the claimed control power, boosted converter output, and power factor correcting. We find that each of independent claims 1, 6, 26, 32, 34, 37, 38, and 39 recites a “driver circuit” responsive to “feedback indicative of an input current,” which is a limitation that was not present in the earlier claims and was thus not addressed by Requester.

IV. New Ground of Rejection

Owner further argues in the Response that independent claim 23, which is an original patent claim, is patentable over the prior art because Requester failed to show the inherent auxiliary power source of the prior art

derives power from the input voltages. However, Owner refers as support for that assertion to so-called related reasoning in the earlier Decision with respect to (means plus function) claim 19. Response 15. Owner provides no explanation or evidence in support of why the “auxiliary power circuit” of claim 23 should be interpreted as a 35 U.S.C. § 112, paragraph six, limitation, or why the Board’s reasons for sustaining the Examiner’s decision not to enter proposed rejections against claim 19 would be applicable to claim 23.

We enter the following rejection against the claims as permitted by 37 C.F.R. § 41.77(b):

Claim 23-25 are rejected under 35 U.S.C. § 103(a) over JP '778 in view of Reynolds (US 5,319,533) or Carvalho (US 4,540,892), as set forth in the Original *Inter Partes* Request, filed February 2, 2007.

DECISION

Claims 1-7, 9-22, 26, 27 and 29-47 have not been shown to be unpatentable.

Claims 23-25 are rejected under 35 U.S.C. § 103(a) in what we designate a new ground of rejection.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Correspondingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer

issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

For further guidance on new grounds of rejection, see 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, **WITHIN ONE MONTH FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing*. The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the “claims so rejected.” Accordingly, a request to reopen prosecution is limited to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall be limited in scope to the issues raised by the Board's opinion reflecting its decision to reject the claims and the patent owner's response under

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paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board's entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board's rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

Requests for extensions of time in this proceeding are governed by 37 C.F.R. §§ 1.956, 41.77(g), and 41.79(e).

AFFIRMED-IN-PART -- 37 C.F.R. § 41.77(b)

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