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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MASAYUKI SHIGEYOSHI

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Appeal 2015-000577  
Application 12/984,077  
Technology Center 3700

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Before CHARLES N. GREENHUT, JILL D. HILL, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–  
9. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

### CLAIMED SUBJECT MATTER

The claims are directed to a tip-base metal distance control method for an arc welding system. Claim 1, reproduced below, is illustrative of the claimed subject matter:

Claim 1:

A tip-base metal distance control method for an arc welding system, the method comprising:

(i) measuring actual welding current values under a predetermined actual welding condition, and calculating an average actual welding current value under the actual welding condition to obtain a calculated average actual welding current value;

(ii) extracting, from a reference-current storage table, a stored average welding current value under a stored welding condition corresponding to the actual welding condition to obtain an extracted average welding current value, and setting the extracted average welding current value as a reference current value;

(iii) comparing the calculated average actual welding current value with the reference current value to obtain a comparison result; and

(iv) correcting a position of a welding torch in arc welding in an upward or a downward direction based on the comparison result so as to maintain a fixed distance between a tip at an end of the welding torch and a base metal.

### REJECTION

Claims 1–9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shigeyoshi (US 2008/0083716 A1) in view of Blankenship et al. (US 6,940,039 B2) and Jung (KR 102001-0095573 A).

OPINION

In the Final Office Action, the Examiner cites paragraphs 8, 9, 12, 22, 27, 28, 55–59, 62, 66, 68, 70, 86, 87, and Figure 4 of Shigeyoshi as disclosing subject matter falling within limitations (ii) and (iv) of independent claim 1, and within similar limitations appearing in independent claims 8 and 9. Appellant accurately summarizes the cited paragraphs and correctly argues that these paragraphs do not appear to contain any subject matter falling within these contested limitations. App. Br. 21–28. In response, the Examiner reproduces the citation to the aforementioned paragraphs of Shigeyoshi with some additional cites, but does not provide further explanation of the reasoning or respond to Appellant’s arguments. Ans. 6. Repetition does not shed light on the Examiner’s position.

“[T]he precise language of 35 U.S.C. § 102 that ‘(a) person shall be entitled to a patent unless,’ concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.” *In re Warner* 379 F.2d 1011, 1016 (CCPA 1967). The Patent Trial and Appeal Board is primarily a tribunal of review. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075–77 (BPAI 2010)(precedential). For that review to be meaningful, it must be based on some concrete evidence in the record to support the Examiner’s factual findings and legal conclusions. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). A rejection must be set forth in a sufficiently articulate and informative manner as to meet the notice requirement of § 132, such as by identifying where or how each limitation of the rejected claims is met by the prior art references. *In re Jung*, 637 F. 3d 1356, 1363 (Fed. Cir. 2011); *see also* 37 C.F.R. § 1.104(c)(2) (“When a

reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”); *Gechter v. Davidson* 116 F.3d 1454, 1460 (Fed. Cir. 1997)(PTO must create a record that includes “specific fact findings for each contested limitation and satisfactory explanations for such findings.”).

In further responding to Appellant’s arguments the Examiner points to portions of the Blankenship and Jung references not previously relied on regarding the contested limitations. App. Br. 6–7. These citations do not address the specific language of the claims and also do not make it apparent how each contested limitation of the rejected claims is met by the prior art. The Examiner proceeds to raise several issues relevant to 35 U.S.C. § 112—a section under which no rejection has previously been set forth—and introduce additional evidence not previously relied upon. Ans. 7, 9 (citing *Kazuichi*, JP11-058016); Reply Br. 6–7. It is not clear on the record before us, but if the Examiner intended to include a new rejection, different from that from which the appeal was taken, there is a procedure for doing so, which was not followed. *See* 37 C.F.R. § 41.39(2). We cannot affirm any rejection to which an appellant has not had a fair opportunity to react. *Jung*, 637 F. 3d at 1365.

As to the Examiner’s proposed construction of the term “fixed,” (Ans. 7, 10) in light of the shortcomings discussed above, we do not regard the issue as dispositive, but nevertheless note that it is not reasonable to attribute a meaning to a term that contradicts its use in the Specification. The Examiner cannot reasonably include, within the definition of the term

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“fixed,” subject matter which the Specification expressly identifies as not fixed. *See* Spec. 5:4–15; Reply Br. 5–6. “[When giving claim] terms their broadest reasonable construction, the construction cannot be divorced from the specification.” *In re NTP*, 654 F. 3d 1279, 1288 (Fed. Cir. 2011).

DECISION

The Examiner’s rejection is reversed.

REVERSED