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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRADLEY P. ACTIS

Appeal 2017-011638¹
Application 13/849,436
Technology Center 3700

Before LISA M. GUIJT, BRADLEY B. BAYAT, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the decision rejecting claims 1–17, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on October 22, 2019.

We REVERSE.

¹ “Appellant” refers to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “H.W. J. DESIGNS AGRIBUSINESS, INC.” Appeal Br. 1.

CLAIMED INVENTION

“The present disclosure generally relates to an apparatus and method for automatically strapping bales of cotton, other fibers, or stacks of articles, such as lumber, bricks, shipping boxes, which are suitable for strapping.”

Spec. 1:4–6. Appellant’s claimed invention “relate[s] to a system and method for welding the ends of thermoplastic straps together so as to form strapped bales of cotton or any other desired materials or items.” *Id.* 1:6–8.

Claims 1 and 7 are the independent claims on appeal. Claim 7, reproduced below, is illustrative of the subject matter on appeal.

7. A system for welding comprising a plurality of weld assemblies, each of said weld assemblies comprising:

[(a)] a stationary weld jaw substantially stationary from translational movement;

[(b)] a fixed weld jaw secured to a connecting rod by at least two secured points; said fixed weld jaw and said connecting rod are fixed from rotational and translational movement relative to one another;

[(c)] a link pivotably connected to the fixed weld jaw by a first pivot pin and pivotably connected to a structure by a second pivot pin to angularly rotate relative to the fixed weld jaw and the structure;

[(d)] a crank pivotably connected to the connecting rod to impart reciprocating motion on the connecting rod; and

[(e)] wherein a centerline of the crank is adjustable relative to the first pivot pin.

Appeal Br. 10–11, Claims App. (formatting and bracketed matter added).

REJECTIONS

Claims 1, 3, 5–9, 11, and 13–16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jaenson et al. (US 6,487,833 B1, iss. Dec. 3, 2002) (“Jaenson”).

Claims 2, 4, 10, 12, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jaenson.

ANALYSIS

Anticipation by Jaenson

Based on our review of the record, including the Examiner’s Final Office Action and Answer, and Appellant’s Appeal Brief and Reply Brief, for the reasons discussed below, we agree with Appellant that the Examiner’s rejection of independent claims 1 and 7 as anticipated by Jaenson under 35 U.S.C. § 102(b) is in error.

Claims 7–9, 11, 13, and 16

The Examiner maintains that claim 7 is anticipated by Jaenson because Jaenson discloses limitations (a) through (e) of Appellant’s claimed invention. *See* Answer 2–4. Limitation (b) requires “a fixed weld jaw secured to a connecting rod by at least two secured points; said fixed weld jaw and said connecting rod are fixed from rotational and translational movement relative to one another.” Appeal Br. (Claims App.). In rejecting this limitation, the Examiner finds Figure 11 of Jaenson discloses “a fixed weld jaw (86) secured to a connecting [rod 120] by at least two secured points,” such that elements 86 and 120 “are fixed from rotational and translational movement relative to one another.” Final Act. 3.

Appellant argues that “Jaenson does not disclose how the connecting rod 120 is connected to the lower weld plate 86, and, more specifically, does not indicate whether the lower weld plate 86 is fixed to the connecting rod 120 such that there is no rotational and translational movement between the fixed weld jaw and the connecting rod.” Appeal Br. 5. According to Appellant:

Although Jaenson discloses that the connecting rod 120 effects movement of the lower weld plate 86, Jaenson does not disclose how the connecting rod 120 effects movement of the lower weld plate 86. FIG. 11 shows the connection rod 120 projecting into the support block 114. However, there is NO disclosure regarding how the connecting rod 120 is secured to the support block 114 nor whether it has any connection to the lower weld plate 86. Moreover, even if the connecting rod 120 is connected to the lower plate 86, Jaenson does not specify no rotational and translational movement between the lower plate 86 and the connecting rod 120.

Id. Appellant contends that “Jaenson does not disclose the connecting rod 120 is connected to the lower weld plate 86” and the Examiner does not specify where the cited text can be found in Jaenson. *Id.* at 8.

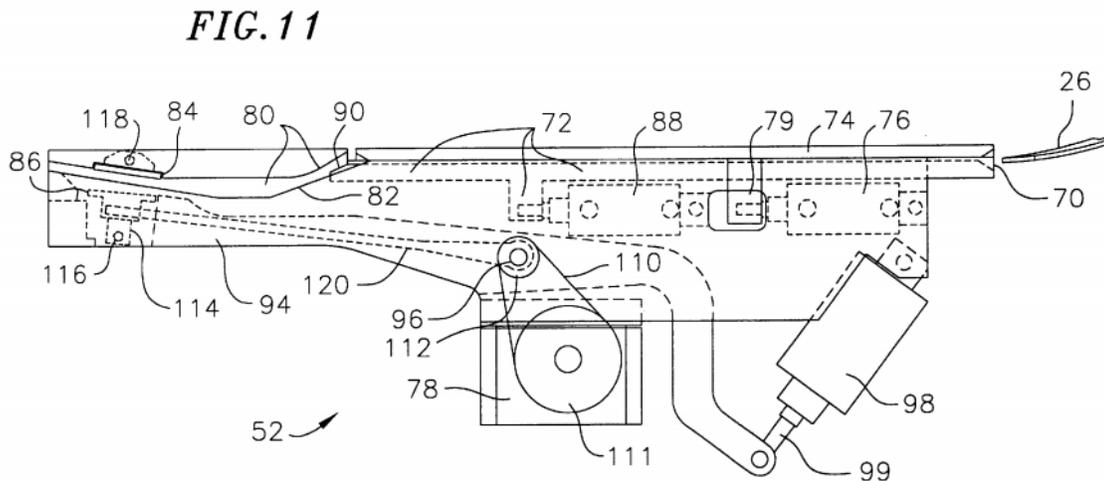
The Examiner responds:

However this argument is unpersuasive because the connecting rod 120 as shown in figure 11 is connected to fixed lower jaw 86 to be able to slide along the top surface of the support block 114. And applicant submits that “the lower weld plate 86 reciprocates due to movement of the connecting rod” therefore the lower weld plate is fixed to the connecting rod for movement. And is clearly connected to allow for movement of the fixed weld jaw and would not be able to effect movement if the connecting rod was not fixed to prevent rotational or translational movement.

Answer 8. We are persuaded by Appellant's argument.

A determination that a claim is anticipated under 35 U.S.C. § 102(b) requires that we compare the claim to the prior art reference and make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998); *see also In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

Jaenson relates to a weld arm finger assembly that operates by moving strap portions attached to weld plates back and forth with respect to one another to generate a substantial amount of heat through friction, which softens the interfacing regions of the strap portions until a weld is formed. Jaenson 4:5–12. Figure 11 of Jaenson is reproduced below:



Jaenson discloses that its "[w]elding motion is accomplished by coupling the connecting rod **120** to eccentric pivot pin **96**, which is rotated at a high speed, by a motor **78** coupled to the eccentric pivot pin (eccentric crank) **96**

by a belt **110** and pulley **111, 112**, arrangement.” Jaenson 16:34–38.

According to Jaenson,

the lower lever arm **94** applies upward pressure to the lower weld plate **86** through the support block **114**, upon which the lower weld plate **86** slides. The lower weld plate **86** slides along the top surface of the support block **114** as the lower weld plate **86** reciprocates due to movement of the connecting rod **120** caused by the eccentric pivot pin **96**. The support block **114** is pivotally mounted to the lever arm **94** via pivot pin **116**, so as to facilitate rocking of the upper and lower **86** weld plates.

Id. 16:49–57. “The motor **78**, pulleys **111** and **112**, eccentric pivot pin **96** and connecting rod **120** cooperate to define a drive which effects both longitudinal movement and rocking of the lower weld plate **86**.” *Id.* 17:49–52.

The Examiner does not cite to any express disclosure in the text of Jaenson that describes limitation (b) of claim 7. Instead, the Examiner relies on Figure 11’s schematic in Jaenson and asserts that “connecting rod 120 as shown in figure 11 is connected to fixed lower jaw 86.” Answer 8. We have reviewed Figure 11 of Jaenson, as well as its corresponding description, but we find nothing that shows or expressly discloses whether or how the lower weld plate 86 is secured to connecting rod 120, as required by limitation (b). Although Jaenson discloses that the eccentric portion of the eccentric pivot 96 affects reciprocating movement of the connecting rod 120 and, consequently, the lower weld plate 86 (Jaenson 16:16–19), Jaenson does not show whether the connecting rod 120 is fixed to the lower weld plate 86 by at least two secured points, such that the weld plate and the connecting rod are fixed from rotational and translational movement relative

to one another, as required by limitation (b). Thus, the Examiner has not shown that limitation (b) of claim 7 is expressly found in Jaenson. Jaenson can, nevertheless, anticipate claim 7 if it inherently describes the claimed subject matter.

To the extent that the Examiner maintains that Jaenson's connecting rod 120 "is clearly connected to allow for movement of the fixed weld jaw" (Answer 8), more than speculation is required. "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citation omitted)). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). Appellant contends, and the Examiner does not counter, that "the connecting rod 120 can be directly connected to the support block 114 to effect movement of the lower weld plate 86 or the connecting rod 120 can be pivotally connected to the lower weld plate 86." Appeal Br. 5. To rely upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to support reasonably the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). However, the Examiner only speculates and provides no further evidence or reasoning to support the finding that Jaenson's lower weld plate is *necessarily* secured to the connecting rod 120 by at least two

secured points, such that the fixed weld plate and the connecting rod 120 are fixed from rotational and translational movement relative to one another.

Accordingly, the Examiner has not established by a preponderance of the evidence that Jaenson discloses either expressly or inherently “a fixed weld jaw secured to a connecting rod by at least two secured points; said fixed weld jaw and said connecting rod are fixed from rotational and translational movement relative to one another,” as called for in claim 7. Thus, we do not sustain the rejection of independent claim 7, and dependent claims 8, 9, 11, 13, and 16, as being anticipated by Jaenson.

Claims 1, 3, 5, 6, 14, and 15

Independent claim 1 recites “[a] method for welding two ends of a strap comprising,” in part, “fixing the fixed weld jaw to a connecting rod to prevent rotational and translational movement between the two.” Appeal Br. (Claims App.). In rejecting this step of claim 1 as being anticipated by Jaenson, the Examiner relies on the same finding as to limitation (b) of claim 7. *See* Final Act. 2 (“fixing the fixed weld jaw (86) to a connecting rod (120) to prevent rotational and translational movement between the two”). For the same reasons discussed above, the Examiner has not shown, either expressly or inherently, that Jaenson’s lower weld plate 86 is fixed to connecting rod 120, such that rotational and translational movement is prevented between the two. As such, the Examiner has not established a prima facie case of anticipation as to claim 1. Thus, we do not sustain the rejection of independent claim 1, and dependent claims 3, 5, 6, 14, and 15, as being anticipated by Jaenson.

Obviousness over Jaenson

Claims 2, 4, 10, 12, and 17

In rejecting dependent claims 2, 4, 10, 12, and 17 as unpatentable over Jaenson, the Examiner relies on the same deficient findings in Jaenson for independent claims 1 and 7. Thus, we do not sustain the obviousness rejection of dependent claims 2, 4, 10, 12, and 17 that incorporate the erroneous findings of claims 1 and 7.

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 3, 5–9, 11, 13–16	102(b)	Jaenson		1, 3, 5–9, 11, 13–16
2, 4, 10, 12, 17	103(a)	Jaenson		2, 4, 10, 12, 17
Overall Outcome				1–17

CONCLUSION

The decision of the Examiner to reject claims 1–17 is reversed.

REVERSED