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EXAMINER

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PAPER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GENESIS ATTACHMENTS
Patent Owner, Appellant

Appeal 2018-007445
Reexamination Control 90/013,926¹
Patent No. RE45,341 E
Technology Center 3900

Before DANIEL S. SONG, MEREDITH C. PETRAVICK, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The Appellant identifies Genesis Attachments, LLC as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

Claims 7–11 of U.S. Patent No. RE45,341 are subject to reexamination. The Patent Owner appeals under 35 U.S.C. §§ 134(b) and 306 from a Final Rejection of claims 7–11. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

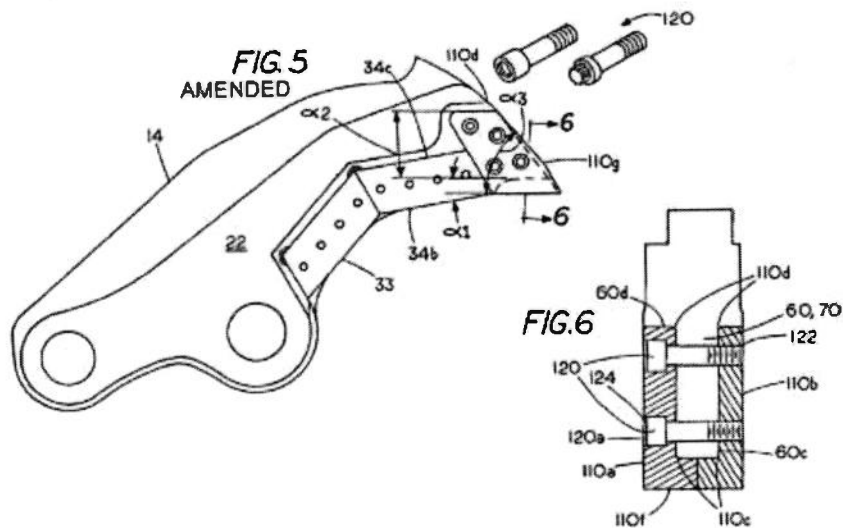
SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The claimed invention is directed to a replaceable shearing tip for a movable upper jaw of a demolition apparatus. RE45,341, 1:20–25.

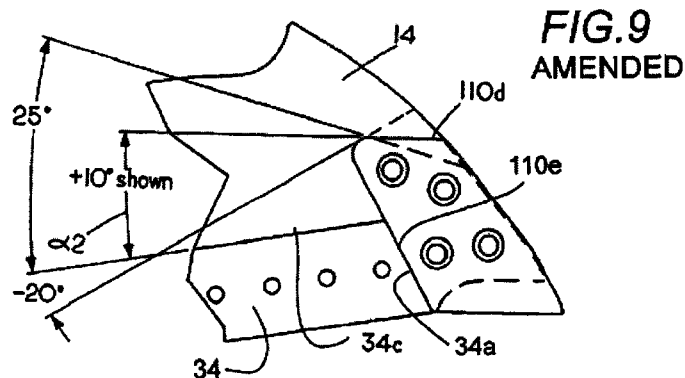
Amended Figure 5 and Figure 6 are reproduced below.



Amended Figure 5 depicts “a partial right-side view of the upper jaw of the apparatus with the tip mounted, showing various angles”, and Figure 6 depicts a cross section of the tip taken at lines 6 shown in Amended Figure 5. RE45,341 2:37–41. Replaceable shearing tip 110 has first half 110a and

second half 110b, each having a flange 110c with bottom edge 110f. *Id.* at 3:42–55.

Amended Figure 9 is reproduced below.



Like Amended Figure 5, Amended Figure 9 depicts a partial right-side view of the upper jaw of the apparatus with the tip mounted, showing various angles. *See id.* at 2:46. Rear surface 110e of first half 110a of shearing tip 110 engages shear blade 34a at forward edge 34a. *Id.* at 2:51–54.

THE CLAIMS

Claim 7 is the sole independent claim, and claims 8–11 depend directly from claim 7. Claim 7, reproduced below with emphases on disputed limitations, is illustrative of the subject matter on appeal.

7. A tip adapted to mount to a nose of an upper jaw of a demolition shear, the nose having a first laterally recessed mounting surface on a first side defining a first nose ledge surface and a second laterally recessed mounting surface on a second side defining a second nose ledge surface, wherein a lateral distance between the first and second lateral recessed mounting surfaces define a nose tip width, the nose tip width having a bottom end, the upper jaw of the demolition shear further having a shear blade, the shear blade having a forward edge, the tip comprising:

- (a) a first tip body having an inside face, an outside face, a top edge, a rear edge and a bottom flange extending laterally inward from said inside face such that said first tip body defines an L-shape in cross-

section, ***said bottom flange having a continuous planar bottom surface;***

wherein, when said first tip body is mounted to the nose of the upper jaw of the demolition shear,

(i) said bottom flange extends at least partially across the bottom end of the nose tip width from the first side;

(ii) said inside face of said first tip body is disposed adjacent the first laterally recessed mounting surface;

(iii) said top edge of said first tip body engages the first nose ledge;
and

(iv) ***a portion of said rear edge engages the forward edge of the shear blade at an oblique angle;***

(b) a second tip body having an inside face, an outside face, a top edge, a rear edge and a bottom flange extending laterally inward from said inside face such that said second tip body defines an L-shape in cross-section, ***said bottom flange having a continuous planar bottom surface;***

wherein, when said second tip body is mounted to the nose of the upper jaw of the demolition shear,

(i) said bottom flange extends at least partially across the bottom end of the nose tip width from the second side;

(ii) said inside face of said second tip body is disposed adjacent the second laterally recessed mounting surface; and

(iii) said top edge of said second tip body engages the second nose ledge.

Appeal Br., Claims App'x (emphases added).

THE REJECTIONS

The Examiner rejected the claims as follows:

(A) claims 7–10 under 35 U.S.C. § 103 over Okada² and Ramun³;

² Japanese Patent Application Pub. No. JP 09-0195528, pub. July 29, 1997 (“Okada”)

³ Int’l Patent Application Pub. No. WO 01/28687 A1, pub. Apr. 26, 2001 (“Ramun”)

(B) claim 11 under 35 U.S.C. § 103(a) over Okada, Ramun, and Sederberg⁴;

(C) claims 7–10 under 35 U.S.C. § 103 over Okada and LaBounty⁵;

(D) claims 7–9 under 35 U.S.C. § 103 over Okada and Morikawa⁶;

and

(E) claim 7 is under 35 U.S.C. § 103 over Okada and Ward⁷.

ANALYSIS

Rejections A, C, D, and E

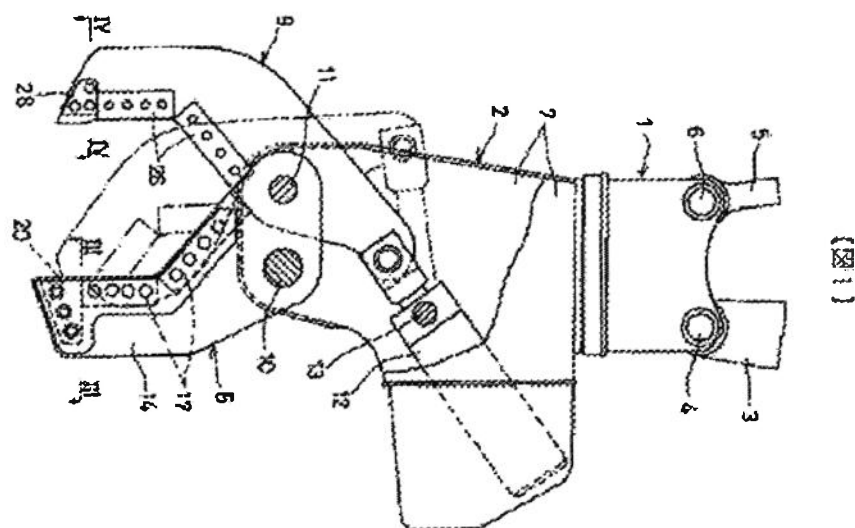
In each rejection, the Examiner finds that Okada discloses most of the elements of claim 7. *See e.g.*, Ans. 3–6, 11–13, 17–19, 23–25. Figure 1 of Okada is reproduced below.

⁴ U.S. Patent No. 5,992,023, iss. Nov. 30, 1999 (“Sederberg”)

⁵ Int’l Patent Application Pub. No. WO 96/37337, pub. Nov. 28, 1996 (“LaBounty”)

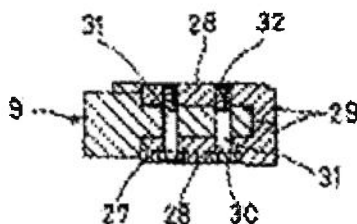
⁶ U.S. Patent No. 5,671,892, iss. Sep. 30, 1997 (“Morikawa”)

⁷ Int’l Patent Application Pub. No. WO 2004/013417 A1, pub. Feb. 12, 2004 (“Ward”)



Okada's Figure 1 depicts a partial front view of a steel cutting machine. Okada ¶ 36. Upper jaw 9 has front end blade 28 and shearing blade 26 *Id.* ¶¶ 21, 25. Figure 4 of Okada is reproduced below.

【図4】



Okada's Figure 4 depicts a section view along lines III in Figure 1. *Id.* ¶ 36. A pair of front end blades 28 are mounted on upper jaw 9. Front end blades 28 have protective piece 29.

The Examiner equates Okada's front end blades 28 to the claimed tip bodies, Okada's protective piece 29 to the claimed bottom flange, and

Okada's shearing blade 26 to the claimed shear blade. *See* Ans.⁸ 3–4. The Examiner finds, however, that protective piece 29 did not have a continuous planar bottom surface because, as seen in Okada's Figure 1, it has a beveled surface at the rear. *Id.* at 6. The Examiner also finds that, as seen in Okada's Figure 1, the rear edge of front end blade 28 does not engage the forward edge of shearing blade 26 at an oblique angle. *Id.*

The Examiner finds that each of Ramun, LaBounty, Morikawa, and Ward teaches a continuous planar bottom surface on a bottom flange of a tip and a tip having a rear edge that engages a shear blade at an oblique angle. Ans. 6–25. With regards to rejection A, Figure 1 of Ramun is reproduced below.

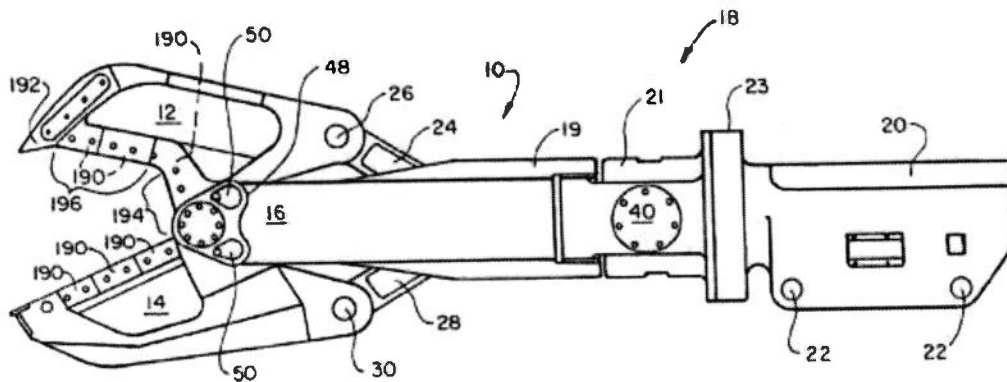


FIG. 1

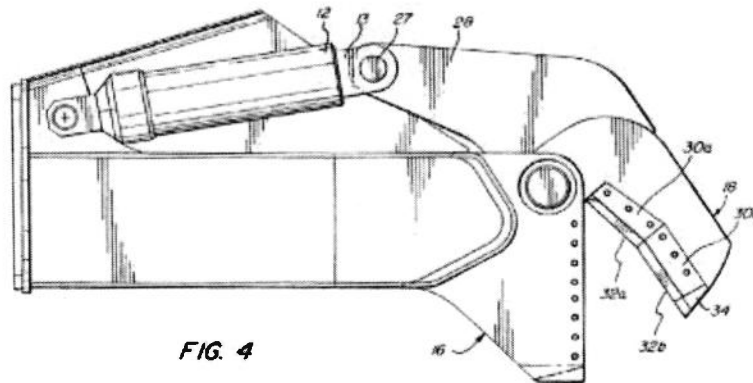
Ramun's Figure 1 depicts a side view of heavy-duty shear 10. Ramun 5:19–22. First blade 12 has a plurality of removable cutting inserts 190 and a piercing tip 192. *Id.* at 18:27–19:8.

The Examiner equates Ramun's piercing tip 192 to the claimed tip and Ramun's removable cutting insert 190 to the claimed shear blade. Ans.

⁸ Because the rejections from the Final Office Action, mailed September 25, 2017, are reproduced in the Answer, we cite to the Answer.

6–7. Based on the depiction in Ramun’s Figure 1, the Examiner determines that piercing tip 192 has a continuous planar bottom surface and that piercing tip 192 engages shear blade 190 at an oblique angle. *Id.*

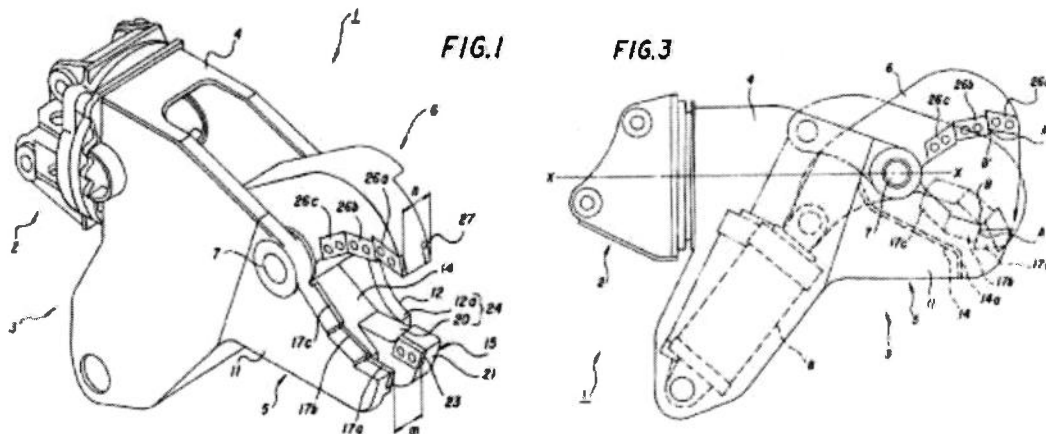
With regards to rejection C, Figure 4 of LaBounty is reproduced below.



LaBounty’s Figure 4 depicts a side elevational view of hydraulic shears with jaws open. LaBounty 5:7–8. Upper jaw 18 has front cutting blade 34 and removable cutting blade 32b. *Id.* at 7:5–16.

The Examiner equates LaBounty’s front cutting blade 34 to the claimed tip and LaBounty’s removable cutting blade 32b to the claimed shear blade. Ans. 13. Based on the depiction in LaBounty’s Figure 4, the Examiner determines that front cutting blade 34 has a continuous planar bottom surface and that cutting blade 34 engages shear blade 32b at an oblique angle. *Id.* at 14.

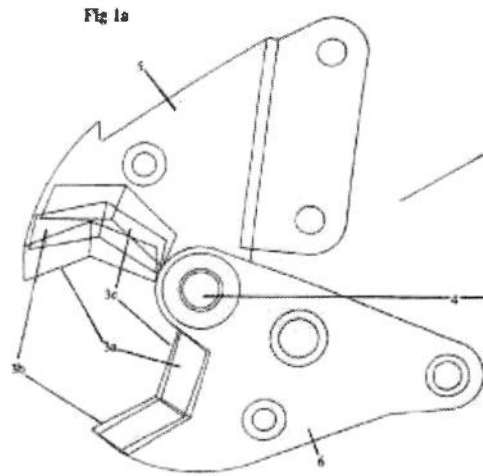
With regards to rejection D, Figures 1 and 3 of Morikawa are reproduced side-by-side below.



Morikawa's Figure 1 depicts a perspective view of the left front and Figure 3 depicts a side view of a shearing machine. Morikawa 4:3-5, 4:9-10. Upper jaw 6 has three upper shear blades 26a, 26b, and 26c. *Id.* at 5:41-43. Shear blade 26a "is shaped in the form of a parallelogram." *Id.* at 6:1-4.

The Examiner equates Morikawa's front shear blade 26a to the claimed tip and Morikawa's shear blade 26b to the claimed shear blade. Ans. 19-20. Based on the depiction in Morikawa's Figures 1 and 3 and the teaching that the blade is a parallelogram, the Examiner determines that shear blade 26a has a continuous planar bottom surface and that shear blade 26a engages shear blade 26b at an oblique angle. *Id.*

With regards to rejection E, Figure 1a of Ward is reproduced below.



Ward's Figure 1a depicts a side elevation of cutting or crushing implement 1. Ward 11:5–6. Implement 1 has three pairs of jaws 3a, 3b, and 3c, displaced across the width of the implement. *Id.* at 11:17, 12:5. The upper portion of each jaw has an inverted V-shaped form. *Id.* at 11:18–19.

The Examiner equates Ward's front portion of jaw 3a to the claimed tip and Ward's back portion of jaw 3b to the claimed shear blade. Ans. 25. Based on the depiction in Ward's Figure 1a, the Examiner determines that front portion of jaw 3a has a continuous planner bottom surface and that front portion of jaw 3a engages back portion of jaw 3b at an oblique angle. *Id.*

For each of rejections A, C, D, and E, the Examiner provides substantially the same alleged rationale for combining Okada and either Ramun, LaBounty, Morikawa, or Ward. *See* Ans. 7, 14, 20, 26. For example, the Examiner states:

Accordingly, it would have been obvious to those having ordinary skill in the art at the time of the invention to have incorporated these features [from] Ramun into the Okada device as a matter of design choice of known tip to blade attachment

configurations as well as known blade shapes for optimizing cutting efficacy and for structurally associating the tip to matching parts on the blade to help maintain the tip in its place during use.

Id. at 7; *e.g.*, *see also* Ans. 27 (“As such, only from the Ramun side view teaching of the absence of the bevel, those in the art would have been motivated to remove the bevel from the Okada tip as a mere choice in design”). In the Answer, the Examiner supplements the rejection with an additional alleged rationale for the combination. The Examiner states:

Given that the art is replete with suggestions to change the shape of the working tip dependent upon the materials being grasped by the jaws, mere choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success would have been ample suggestion for [one skilled in] the art to try the different tip shapes already known in the art in order to optimize gripability for any given material. Similarly, it would have been obvious to try known, predictable solutions for securing tip components to equipment jaws to also optimize efficacy.

Ans. 30; *e.g.*, *see also* 32 (“it is implicit from the teaching that different angles may work better, thus giving those in the art ample reason to try different angles to attempt to better grip the materials with which then intend to work (*sic*)”), 40 (“Here, the concept of changing the tip shape to accommodate different working materials was well established in the art.”).

For each of the proposed combinations, the Patent Owner argues that the Examiner has fails to provide a sufficient rationale to support the proposed combinations of the prior art and instead improperly relied upon hindsight. *See* Appeal Br. 6–8, 21–29, 36, 41, 51, 62–63; Reply Br. 1–18.

“The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly

contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” Manual of Patent Examining Procedures (“MPEP”) § 2144 (I) (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings).

However, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Rejections relying upon facts not in the record or on “common knowledge” should be judiciously applied. MPEP § 2144.03.

Here, we are persuaded by the Patent Owner that the Examiner’s alleged rationales for combining the prior art are conclusory and lack rational underpinning to support the legal conclusion of obviousness. First, the Examiner relies upon alleged knowledge generally available to one of ordinary skill in the art. For example, the Examiner asserts that one of ordinary skill in the art would have made the proposed combinations as a matter of design choice of known tip to blade attachment configurations because the known blade shapes optimize cutting efficacy and structurally associate the tip to matching parts on the blade to help maintain the tip in its

place during use. Ans. 7. As the Examiner acknowledges, however, these explicit benefits are not “spelled out in the references” but are allegedly implicit in the prior art. *E.g., see id.* at 29. The Examiner states that one of ordinary skill in the art would have known based on, for example, the prior art figures alone. *Id.* at 27 (“As such, only from the Ramun side view teaching of the absence of the bevel, those in the art would have been motivated to remove the bevel from the Okada tip as a mere choice in design.”).

However, the Examiner’s assertion as to knowledge generally available to one of ordinary skill in the art is conclusory and unsupported by sufficient evidence or other reasonable explanation. For example, the Examiner’s evidence (i.e., the prior art figures reproduced above) does not sufficiently establish that removing the bevel from Okada to create a continuous planar bottom surface would optimize cutting efficacy or optimize gripability for any given material. In as much as the Examiner may be asserting that the combination of the elements would have been obvious because the prior art discloses all the claimed elements, “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR Int’l*, 550 U.S. at 401.

The Examiner alleges that explicit teachings of the prior art suggest changing the shape of the working tip is dependent upon the materials being grasped by the jaws. *E.g., see* Ans. 30. The Examiner’s allegation is unsupported as the Examiner provides no citations or other indication as to what prior art provides the alleged explicit teaching. *E.g., see id.* We note that Ward generally discusses configuring implements to handle different

types of materials, but Ward does not explicitly teach configuring front cutting blade 34 based on handling different materials. *See generally* Ward.

We determine that the Examiner fails to provide the requisite articulated reasoning with rational underpinning to support the legal conclusion of obviousness. Accordingly, the rejections of claim 7, and claims 8–11, dependent thereon, are reversed.

Rejection B

The Examiner rejects claim 11 under 35 U.S.C. § 103(a) over Okada, Ramun, and Sederberg. Claim 11 depends from claim 7, and we have reversed the rejection of claim 7 under 35 U.S.C. § 103(a) over Okada, and Ramun. For the same reasons, we will not sustain the rejection of claim 11. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”).

DECISION

The decision of the Examiner to reject claims 7–11 is reversed.

REVERSED

Ssc