

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION
Respondent, Requester

v.

FELLOWES, INC.
Appellant, Patent Owner

Appeal 2013-010043
Reexamination Control 95/001,723
Patent No. US 7,963,468 B2¹
Technology Center 3900

Before STEVEN D.A. McCARTHY, DANIEL S. SONG and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

1 In a “Decision on Appeal,” mailed February 7, 2014 (Decision”), we
2 reversed the Examiner’s decision adopting grounds of rejection 1-6 against
3 claims 9-12 under 35 U.S.C. § 103(a) (2011). The

¹ Issued June 21, 2011 to Tai Hoon K. Matlin and Eric Gach (the “’468 patent”). The ’468 patent issued from Appl. No. 12/616,567, filed November 11, 2009.

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1 Requester seeks rehearing of this decision. (“Respondent/Third Party
2 Requester Request for Rehearing under 37 C.F.R. § 41.79,” dated
3 March 7, 2014 (“Rehearing Request” or “Reh’g Req.”)). The Patent Owner
4 has responded. (“Patent Owner’s Opposition to Request for Rehearing,”
5 dated March 14, 2014).

6 Requests for rehearing are limited to matters overlooked or
7 misapprehended by the Board in rendering the original decision. *See*
8 37 C.F.R. § 41.79(b)(1) (2011). We grant the request for rehearing to the
9 extent that we have considered the three points listed on page 2 of the
10 Rehearing Request but otherwise deny the request.

11 We begin from the principle of law that a party taking a position
12 adverse to the patentability of a claim generally bears the burden of proving
13 a factual underpinning for a rejection of the claim by preponderance of the
14 evidence. *See Rambus Inc. v. Rea*, 731 F.3d 1248, 1255 (Fed Cir. 2013). As
15 to the first point raised in the Rehearing Request, we find as fact that neither
16 the Examiner nor the Requester has proven by preponderance of the
17 evidence that placing the thickness detector upstream of the presence sensor,
18 regardless how close, necessarily would have resulted in *preventing* the start
19 of energization of a cutting mechanism of a shredder in response to a part of
20 the thickness detector moving to a second position. As a consequence,
21 neither the Examiner nor the Requester has proven the subject matter of
22 claim 9 as a whole would have flowed naturally from, or would have been
23 suggested by, merely combining a threshold detector and a presence sensor
24 in the feed-aperture of a shredder for the purpose of obtaining the known
25 function of a threshold detector and the known function of a presence
26 detector.

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1 As to the second point, we find as fact that Yoshida² did not teach
2 preventing the start of energization of a cutting mechanism of a shredder in
3 response to a part of the thickness detector moving to a second position.
4 (FF³ 11 and 14). Teaching the use of a thickness detector to stop an
5 energized motor is not the same as teaching that the energization of the
6 cutting mechanism should be prevented. Neither the Requester nor the
7 Examiner has provided persuasive reasoning to demonstrate that Yoshida
8 would have suggested the latter to one of ordinary skill in the art.

9 As to the third point, we find as fact that neither the Examiner nor the
10 Requester has proven by preponderance of the evidence that one of ordinary
11 skill in the art would have known, as a matter of common sense or
12 otherwise, that a threshold detector upstream of a presence sensor should
13 have been used to *prevent the starting* of energization of the cutting
14 mechanism in response to the part of the thickness detector moving to the
15 second position. (*See, e.g.,* FF 4; *see also* FF 11, 14, 20, 23, 28, 33 and 36).
16 Therefore, neither the Examiner nor the Requester has proven that it would
17 have been a matter of common sense to configure a controller in a shredder
18 to start energization of [a] cutting mechanism [of
19 the shredder] only in response to the presence
20 sensor detecting the presence of . . . sheet material
21 inserted into [a] feed-aperture [of the shredder] and

² Yoshida (JP H09-38513A, publ. Feb. 10, 1997). References to “Yoshida” will be to an English-language translation prepared by Asian Technical Translation Pty Ltd. The translation was filed in Appendix C to the Request and is of record in this proceeding. Yoshida was referred to as “JP ‘513” in the Request.

³ The acronym “FF” refers to Findings of Fact listed on pages 8-21 of the Decision.

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1 [a] part of the thickness detector not having been
2 moved to [a] second position by the sheet material;
3 [and] . . .

4 to prevent the starting of energization of the
5 cutting mechanism . . . in response to the part of
6 the thickness detector moving to the second
7 position

8 as recited in claim 9.

9

10 DECISION

11 We grant the request for rehearing to the extent that we have
12 considered the three points listed on page 2 of the Rehearing Request but
13 otherwise deny the request.

14 Requests for extensions of time in this *inter partes* reexamination
15 proceeding are governed by 37 C.F.R. § 1.956 (2011).

16 A party seeking judicial review of a final decision of the Board must
17 timely serve notice on the Director of the United States Patent and
18 Trademark Office. *See* 37 C.F.R. § 1.983 (2011) and 37 C.F.R. § 90.1
19 (2011).

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21 DENIED

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