

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENESIS ATTACHMENTS, LLC
Requester, Respondent

v.

ALLIED ERECTING AND DISMANTLING CO., INC., et al.
Patent Owner, Appellant

Appeal 2014-001006
Inter partes Reexamination Control 95/001,352
Patent US 7,121,489 B2
Technology Center 3900

Before JEFFREY B. ROBERTSON, DANIEL S. SONG and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING

The Patent Owner filed a Request for Rehearing Pursuant to 37 C.F.R. § 41.79 requesting reconsideration of the New Decision Under 37 C.F.R. § 41.77(f) mailed March 19, 2014 (hereinafter "New Decision") which rejects claims 1-21 of the '489 patent.

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We DENY the Patent Owner's request.

ANALYSIS

The Patent Owner asserts that the New Decision is unsupported by substantial evidence and contrary to law because:

1. The articulated reason for combining Ogawa with Caterpillar in order to allow the blades of Caterpillar "to be opened wider" lacks rational underpinnings (Req. 2–4);
2. The articulated reason for combining Ogawa with Caterpillar in order to "minimize movement of the object[]" lacks rational underpinnings (Req. 2, 5–7);
3. The Board improperly dismissed statements of the Requester regarding the asserted "long-felt need" (Req. 2, 7–9);
4. The Board improperly dismissed evidence of copying (Req. 2, 9); and
5. The Board's conclusion of obviousness was based on impermissible hindsight reconstruction (Req. 2, 9–10).

Argument 1

The Patent Owner asserts that the articulated reason for combining Ogawa with Caterpillar in order to "allow the blades to be opened wider" lacks rational underpinnings because a simpler way of making the blades of Caterpillar open wider is to make the movable jaw smaller as shown in Patent Owner's modified illustration of Fig. 3 of Caterpillar (*see* Req. 3-4).

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We initially note that the rationale of the Board was initially set forth in Appeal 2012-007030 (*see* Decision mailed September 4, 2014 (hereinafter "the '7030 Decision") 30) and was quoted and further explained in the New Decision in response to the Patent Owner's arguments that the Board failed to articulate a reason with rational underpinnings (New Decision 13-14).

As to the Patent Owner's argument regarding making the movable jaw smaller (Request 3-4), we observe that the existence of another alternative solution that would allow for wider opening does not negate the fact that such wider opening is attainable by combining the teachings of Caterpillar and Ogawa, or diminish the conclusion that such combination would have been obvious to one of ordinary skill in the art. As also explained,

The record also establishes that it is well known in the art to provide tools with jaws wherein only one of the jaws is movable and the other is fixed (*see, e.g.,* '7030 Decision, FF2 E; FF5 A) or wherein both of the jaws are movable (*see, e.g.,* FF3 A; '7030 Decision, FF4 A).

(New Decision 13; *see also* New Decision 15-16).

Moreover, "the prior art itself clearly demonstrates that there exists a market for tools in which both of the jaws are movable (*see, e.g.,* FF3 A; '7030 Decision, FF4 A)." (New Decision 14). Thus, the Patent Owner's argument based on identification of an alternative solution is unpersuasive.

Argument 2

The Patent Owner asserts that the articulated reason for combining Ogawa with Caterpillar to "minimize movement of the object as it is grasped" lacks rational underpinnings because if "[t]he object is initially in contact with the fixed stationary blade and the moving blade alone . . .

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pivot[s] to contact the object," then "[t]he object does not move at all when it is grasped." (Req. 5-7, 14). This argument was also previously addressed (New Decision 16-17). Specifically, the Board stated:

If only one of the blades is movable, the movable blade must displace the object until it abuts against the non-movable blade in order to grasp the object. *Whereas such movement of the object may be reduced by first abutting the non-movable blade against the object prior to moving the movable blade, . . . such positioning may not be attainable or desirable in all circumstances.*

(New Decision 17, emphasis added).

Moreover, as noted above with respect to *Argument 1*, the record is clear that jaws, wherein one or both of the blades move, are well known in the art. Thus, the Patent Owner's argument is unpersuasive.

Argument 3

The Patent Owner argues that in the New Decision, the Board improperly dismissed statements of the Requester regarding the asserted "long-felt need." (Req. 7-9). However, this assertion is meritless because the Board already addressed this argument in detail (New Decision 21-22).

Argument 4

The Patent Owner argues that the Board improperly dismissed evidence of copying, which includes the fact that the Requester was found liable to the Patent Owner for trade secret misappropriation and that the "misappropriated trade secrets of the Patent Owner used by Genesis to design their jaw set were some of the design details used for the internal

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elements of the jaw set that is the subject of the present reexamination proceeding." (Req. 9).

The trade secret argument was already addressed by the Board in the New Decision, which explained that such vague assertions regarding use of some unidentified "internal elements" of the jaw set do not persuasively establish nexus between the misappropriated trade secrets and the claimed invention (New Decision 22-23). The Patent Owner also argues in the Request for Rehearing that "from a cursory inspection, it can be seen that there are many similarities between the designs disclosed in the Genesis '718 patent and the design claimed in the Patent Owner's patent" (Req. 9). However, such vague assertions of "many similarities" are inadequate to demonstrate copying which

may be demonstrated either through internal documents, *see Akamai Techs., Inc. v. Cable & Wireless Internet Servs., Inc.*, 344 F.3d 1186, 1196-97 (Fed. Cir. 2003); direct evidence such as disassembling a patented prototype, photographing its features, and using the photograph as a blueprint to build a virtually identical replica, *see Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1285 (Fed. Cir. 2000); or access to, and substantial similarity to, the patented product (as opposed to the patent), *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985), *overruled on other grounds by, Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1359 (Fed. Cir. 1999) (en banc).

Iron Grip Barbell Co. Inc. v. USA Sports, Inc., 392 F.3d 1317, 1325 (Fed. Cir. 2004).

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Argument 5

Finally, the Patent Owner asserts that the Board's conclusion of obviousness was based on impermissible hindsight (Req. 9–10). However,

Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill [in the art] at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.

In re McLaughlin, 443 F.2d 1392, 1395 (CCPA 1971).

The Board's conclusion of obviousness set forth in the New Decision derives from proper consideration of the knowledge disclosed in the prior art of record and does not include knowledge gleaned only from the '489 patent. Reasons with rational underpinnings that support this conclusion are also set forth. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

CONCLUSION

The Patent Owner's request to modify the New Decision is DENIED.

DENIED

Pursuant to 37 C.F.R. § 41.79(d), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. See 37 C.F.R. §§ 90.1 and 1.983.

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cc:

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