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**JUDGMENT OF THE UNITED STATES COURT  
OF APPEALS FOR THE FEDERAL CIRCUIT  
(APRIL 11, 2022)**

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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IN RE: SAWSTOP HOLDING LLC,

*Appellant*

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2021-2161

Appeal from the United States Patent and  
Trademark Office, Patent Trial and Appeal Board  
in No. 15/935,432

Before: LOURIE, REYNA, and CHEN,  
Circuit Judges.

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**JUDGMENT**

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DAVID FANNING, SawStop, LLC, Tualatin, OR,  
argued for appellant SawStop Holding LLC.

WILLIAM LAMARCA, Office of the Solicitor, United  
States Patent and Trademark Office, Alexandria, VA,  
argued for appellee Andrew Hirshfeld. Also repre-  
sented by KAKOLI CAPRIHAN, THOMAS W.  
KRAUSE, AMY J. NELSON, FARHEENA YASMEEN  
RASHEED.

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THIS CAUSE having been heard and considered, it is  
ORDERED and ADJUDGED:

PER CURIAM (LOURIE, REYNA, and CHEN,  
*Circuit Judges*).

**AFFIRMED. See Fed. Cir. R. 36.**

ENTERED BY ORDER OF THE COURT

/s/ Peter R. Marksteiner  
Clerk of Court

April 11, 2022  
Date

**DECISION ON APPEAL OF  
THE USPTO PATENT TRIAL  
AND APPEAL BOARD  
(MAY 24, 2021)**

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UNITED STATES PATENT  
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL  
AND APPEAL BOARD

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*Ex parte* STEPHEN F. GASS

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Appeal 2020-005769  
Application 15/935,432  
Technology Center 3700

Before: Daniel S. SONG, Edward A. BROWN,  
and Michael J. FITZPATRICK,  
Administrative Patent Judges.

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SONG, Administrative Patent Judge.

**DECISION ON APPEAL**

**STATEMENT OF THE CASE**

Pursuant to 35 U.S.C. § 134(a), the Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 4 and 6. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42(a). The Appellant identifies the real party in

We AFFIRM.

**CLAIMED SUBJECT MATTER**

The claims are directed to a band saw with an improved safety system. Claim 6, reproduced below, is the sole independent claim on appeal:

6. A band saw comprising:

a first wheel;

a second wheel spaced apart from the first wheel, where the second wheel is mounted for rotation on a shaft, where the shaft is conductively coupled to the second wheel, and where the shaft and second wheel are electrically isolated from ground;

a motor configured to drive at least one of the first and second wheels;

a band blade extending around the wheels;

signal generation circuitry adapted to generate an electrical signal;

a capacitive coupling connected to the signal generation circuitry and adapted to capacitively couple the signal generation circuitry to the band blade through the shaft and the second wheel to transfer at least a portion of the electrical signal to the band blade;

where the capacitive coupling includes two spaced-apart conductors, and where at least a portion of the shaft is one of the two

conductors and a charge plate adjacent the shaft is the other of the two conductors; and detection circuitry to monitor the electrical signal on the band blade for changes indicative of a dangerous condition between a person and the band blade, where the detection circuitry triggers an action to mitigate the dangerous condition when the changes indicative of the dangerous condition are detected.

Appeal Br. 8-9.

### OPINION

The Examiner rejects claims 4 and 6 on the ground of non-statutory double patenting as being unpatentable over claims 1-19 of Gass (US Patent No. 7,284,467 B2, iss. Oct. 23, 2007 (“467 Patent”)) in view of Friemann (US Patent No. 3,858,095, iss. Dec. 31, 1974). Final Act. 3. In performing a one-way determination of patentable distinctness, the Examiner finds that the claims 2 and 3 of the ’467 Patent claim the invention as substantially recited in the appealed claim 6 “except for the structural details of the band saw.” Final Act. 3-4 (citing the ’467 Patent, claims 2, 3). The Examiner also finds that Friemann discloses such structural details of a band saw, and concludes that:

It would have been obvious to one of ordinary skill to have applied the shut-down system of [the ’467 Patent] to a band saw (as suggested by both Frie[mann and claim 16 of [the ’467 Patent]). The spaced-apart arbor and charge plate of [the ’467 Patent] would now be on one of the wheel arbors (8 or 12) of

Frie[ ]mann's band saw.

Final Act. 3-4.

We agree with the Examiner's findings and conclusion, and address the Appellant's arguments *infra*.

The Appellant argues that "the present non-statutory double patenting rejection is improper because it is not based on a statute; rather, it is based on a judicially created doctrine." Appeal Br. 3; *see also* Reply Br. 2. The Appellant argues that "Congress has not given courts power to create substantive patent law, and therefore, the judicially created doctrine of non-statutory double patenting is *ultra vices*," and that "Congress also has not delegated authority to the Patent Office to generate regulatory law concerning non-statutory double patenting." Appeal Br. 3-4; *see also* Reply Br. 2. The Appellant also asserts that:

the primary basis for the judicial doctrine of non-statutory double patenting, i.e., to prevent an alleged improper extension of patent term, is inapplicable for an application that would, if granted, result in a patent with a term measured from the earliest filing date instead of the issue date, as is the case here.

Appeal Br. 4.

The Appellant further argues that the other justification for non-statutory double patenting of "preventing possible harassment by multiple patent owners, could be addressed by a commitment to maintain common ownership of the patents at issue rather than a disclaimer of patent term." Appeal Br. 4. Thus, the Appellant argues that "the doctrine is

now dated and unwarranted, and should be retired.”  
Reply Br. 2-3.

The Appellant’s arguments are unpersuasive before the Board. As the Appellant points out, non-statutory double patenting is a judicially created doctrine, and importantly, as noted by the Examiner, “the Federal Circuit[,] has explicitly upheld the doctrine of non-statutory double patenting.” Ans. 5 (citing *Eli Lilly & Co. v. Barr Labs, Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001)). Accordingly, we decline the Appellant’s request to retire a doctrine upheld by our reviewing court. See 35 U.S.C. § 141(a) (“An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s decision to the United States Court of Appeals for the Federal Circuit.”).

The Appellant also argues that claims 4 and 6 are nonetheless patentably distinct over the claims of the ’467 Patent, even if its claims are combined with Friemann. Appeal Br. 5. In that regard, the Appellant points out that, whereas claim 6 recites a band saw, claims 1 and 2 of the ’467 Patent are directed to “a circular blade” or a “cutting tool mounted on a rotatable, electrically conductive shaft,” respectively. Appeal Br. 5-6; see also ’467 Patent, claims 1 and 2. According to the Appellant, “[a] band blade extending around wheels is patentably distinct from a circular blade coupled to an arbor or a cutting tool mounted on a rotatable shaft.” Appeal Br. 5-6.

This argument is unpersuasive because it argues double patenting based on anticipation, i.e., based on statutory double patenting, whereas the applied double patenting rejection is based the combination of the claims of the ’467 Patent and Friemann. Final Act. 3.



As the Examiner points out, the rejection specifically relies on claim 16 of the '467 Patent itself, which claims “where the cutting tool comprises a band blade.” '467 Patent, claim 16. The rejection also specifically relies on Friemann, which is directed to “a protective device . . . wherein said cutting member comprises a band cutter,” and discloses the recited components of a band cutter, including the claimed wheels. Ans. 5; Friemann, claim 2; Fig. 2. Thus, a band blade is not only claimed in claim 16 of the '467 Patent, but is also disclosed in Friemann’s protective circuit arrangement for band cutter machines. The Appellant essentially argues claims 1 and 2 of the '467 Patent separately, whereas the rejection relies on the combination of the claims of the '467 Patent and Friemann in concluding that the invention of claim 6 would have been an obvious variation that is not patentably distinct. Final Act. 4; *see also* Ans. 5.

The Appellant also asserts that the '467 Patent and Friemann:

fail to disclose or suggest an electrically isolated “shaft [which] is conductively coupled to [a] second wheel,” where “at least a portion of the shaft is one of [ ] two conductors” in a capacitive coupling through which “at least a portion of [an] electrical signal [is transferred] to the band blade.”

Reply Br. 3 (alterations in original); *see also* Appeal Br. 6 (“None of the cited claims teach a band saw shaft which is a conductor conductively coupled to a wheel as in the manner recited.”); Reply Br. 4.

This assertion of the Appellant is also unconvincing. As to the '467 Patent, claim 3 (which depends

from independent claim 2) specifically claims that “the shaft is electrically insulated from the frame.” ’467 Patent, claim 3. With respect to the shaft, claim 2 of ’467 Patent claims “an electrically conductive cutting tool mounted on a rotatable, electrically conductive shaft,” and further claims:

a capacitive coupling adapted to impart an electrical signal onto the cutting tool . . . where the capacitive coupling comprises at least a portion of the shaft as one conductive plate, and a second conductive plate adjacent to and spaced apart from the shaft so that there is a gap between the shaft and the second conductive plate.

’467 Patent, claim 2.

As to the conductive connection between the shaft and the second wheel, we agree with the Examiner that when the invention of claim 6 is applied to a band cutter machine, “[t]he spaced-apart arbor and charge plate of [the ’467 Patent] would now be on one of the wheel arbors (8 or 12) of Friemann’s band saw.” Final Act. 4. In particular, claim 2 of the ’467 Patent recites “capacitive coupling” of the cutting tool, wherein “the capacitive coupling comprises at least a portion of the shaft,” so as to establish a capacitive coupling between the cutting tool and the shaft. ’467 Patent, claim 2. As such, when implemented on a band cutter as suggested by claim 16 of the ’467 Patent and by Friemann, a conductive coupling between the shaft and the second wheel would have been obvious in order to maintain capacitive coupling between the cutting tool (i.e., band cutter) and the shaft, so as to allow for functionality in detecting contact between a person and the cutting tool. *See* Final Act. 3-4.

The Appellant further argues that appealed claim 6 is distinct from the claims of the '467 Patent because claim 6 recites a “detection circuitry” which “triggers an action to mitigate the dangerous condition when changes indicative of the dangerous condition are detected,” whereas claim 9 of the '467 Patent claims “a reaction system adapted to stop movement of the cutting tool upon detection of contact,” and claim 13 claims a “brake mechanism configured to engage and stop the cutting tool.” Appeal Br. 6. Thus, according to the Appellant, the appealed claim 6 mitigates the dangerous condition “without requiring a movement of a cutting tool to be stopped, or a brake mechanism to engage and stop a cutting tool,” and “can be practiced by a device which might not meet the limitations of claims 9 or 13 of the cited patent.” Appeal Br. 6.

This argument is also unpersuasive because claim 2 of the '467 Patent recites “a reaction system configured to cause one or more predetermined actions to take place upon detection of contact between a person and the cutting tool,” and does not recite stopping a cutting tool. '467 Patent, claim 2; *see also* Ans. 6-7 (the Examiner explaining that claimed “trigger[ing] an action to mitigate the dangerous condition” is the same, and thus, disclosed by, claim 2 of the '467 Patent’s recitation “configured to cause one or more predetermined actions to take place upon detection of contact between a person and the cutting tool.”). Indeed, the fact that various dependent claims of the '467 Patent explicitly claim stopping the cutting tool, which is a specific type of action to mitigate the dangerous condition, support the conclusion that the broader recitation in the appealed claim 6 is not

patentably distinct from the narrower claims of the '467 Patent. See *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1376 (Fed. Cir. 2005) (“[T]his court perceives no error in the district court’s determination that the earlier species renders the later genus claims invalid under non-statutory double patenting.”).

The Appellant further argues that claim 4 requires “a second capacitive coupling adapted to capacitively couple the detection circuitry to the band blade,” but the claims of the '467 Patent do not recite “a second capacitive coupling.” Appeal Br. 7. However, the Appellant’s argument does not address the Examiner’s reasoning for rejecting claim 4, which is, “[a]s for claim 4, the duplication of parts (2nd coupling, 2nd charge plate) is considered to be an obvious duplication of parts for multiplied effect.” Final Act. 5 (citing MPEP 2144.04 VI B).

Finally, the Appellant points out that claim 16 of the '467 Patent, “which is the only claim to even mention ‘a band blade,’ does not recite a shaft.” Appeal Br. 7. However, as the Examiner responds, this argument does not address the actual rejection, which is specifically based on the claims of the '467 Patent, in particular, claims 2 and 3 that require a shaft, and a band saw as suggested by claim 16 of the '467 Patent and Friemann.

Therefore, in view of the above considerations, the rejection sufficiently supports the conclusion that the invention of appealed claims 4 and 6 are not patentably distinct from, and instead, are an obvious variation of, the invention in the claims of the '467 Patent. Accordingly, we affirm the Examiner’s rejection of claims 4 and 6 on the ground of non-statutory double

patenting as being unpatentable over the claims of the '467 Patent in view of Friemann.

**CONCLUSION**

The Examiner's rejection is affirmed.

**DECISION SUMMARY**

In summary:

Claims Rejected	Reference(s)/Basis	Affirmed
4, 6	Non-statutory double patenting (Gass, Friemann)	4, 6

**TIME PERIOD FOR RESPONSE**

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**