

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HANS-PETER WILFER

Appeal No. 2004-0918
Application No. 09/715,547

ON BRIEF¹

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 24 to 30, which are all of the claims pending in this application.

We REVERSE.

¹ On April 8, 2004, the appellant waived the oral hearing (see Paper No. 26) scheduled for June 10, 2004.

BACKGROUND

The appellant's invention relates to a portable housing, constructed for accommodating an audio or light mixer, the housing having an accommodating frame for the mixer with a bottom, a front wall, a rear wall, two sidewalls and an upper side (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claim 24, the only independent claim on appeal, reads as follows:

A portable housing for receiving an audio or light mixer and an audio or light effect device, comprising
a frame having a bottom, front and rear walls, two opposite side walls, and an upper side, the bottom, the front, rear, and side walls defining together a space within which the audio or light mixer and the audio or light effect device, respectively, are received, the frame further having first opening for operating the audio or light mixer receivable in the receiving space, and a second, slide-in opening spaced from the first operating opening and through which the audio or light effect device is inserted into the receiving space; and
means provided within the frame for accommodating the audio or light mixer and the audio or light effect device in the receiving space.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|--------|-----------|---------------|
| Benson | 941,608 | Nov. 30, 1909 |
| Siklos | 3,424,509 | Jan. 28, 1969 |

Claims 24 to 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Siklos.

Claims 24 to 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Benson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 22, mailed November 25, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 21, filed October 6, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we will not sustain the rejection of claims 24 to 30 under 35 U.S.C. § 102(b) as being anticipated by Siklos or Benson.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713

F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant argues in the brief that claim 24 is not anticipated by Siklos or Benson since they do not disclose the claimed "accommodating means" (i.e., means provided within the frame for accommodating the audio or light mixer and the audio or light effect device in the receiving space). We agree.

The Court of Appeals for the Federal Circuit has established a framework for determining whether an element of a claim invokes means-plus-function treatment. See Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1314, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999); Sage Prods. Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997). If the word "means" appears in a claim element in association with a function, the presumption is that 35 U.S.C. § 112, paragraph 6 applies. See id. This presumption collapses, however, if the claim itself recites sufficient structure, material, or acts to perform the claimed function. See id. Without the term "means," a claim element is presumed to fall outside means-plus-function strictures. See id. Once again, however, that presumption can collapse when an element lacking the term "means" nonetheless relies on functional terms rather than structure or material to

describe performance of the claimed function. See Al-Site, 174 F.3d at 1318, 50 USPQ2d at 1167.

Because the claimed "accommodating means" of claim 24 uses the word "means," we presume that 35 U.S.C. § 112, paragraph 6 applies. We next look to whether the claimed "accommodating means" of claim 24 specifies a function. In making this determination, we rely primarily on the claim language itself. See York Prods., Inc. v. Central Tractor, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996). After reviewing the language of the claimed "accommodating means" of claim 24, we reach the determination that it specifies the function of accommodating within the receiving space of the frame both (1) the audio or light mixer; and (2) the audio or light effect device. In sum, the claimed "accommodating means" of claim 24 does warrant interpretation under 35 U.S.C. § 112, paragraph 6.

As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six.

Accordingly, the USPTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. Thus, in order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

In this case, the structure described in the appellant's' specification (see pp. 7 and 11) and shown in the drawings (see Figures 1-5 and 7-9) corresponding to the "accommodating means" are the L-shaped rails 30, 31 fixed to the opposite side walls and spaced apart to accommodate an audio or light mixer and the audio or light effect device.

While there is no litmus test for an "equivalent" that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a

conclusion that one element is or is not an "equivalent" of a different element in the context of 35 U.S.C. § 112, sixth paragraph. Among the indicia that will support a conclusion that one element is or is not an equivalent of another are:

(A) Whether the prior art element(s) performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element(s) disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999);

(B) Whether a person of ordinary skill in the art would have recognized the interchangeability of the element(s) shown in the prior art for the corresponding element(s) disclosed in the specification. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999); Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1757 (Fed. Cir. 1998);

(C) Whether the prior art element(s) is a structural equivalent of the corresponding element(s) disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990);

(D) Whether there are insubstantial differences between the prior art element(s) and the corresponding element(s) disclosed in the specification. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d

1129, 1138-39 (Fed. Cir. 2000); Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993).

In the anticipation rejections before us in this appeal, the examiner has determined (answer, pp. 3-4) that the claimed "accommodating means" was readable on² Siklos' projection 20 and Benson's rigid supports 21. However, the examiner has not set forth any basis as to why either Siklos' projection 20 or Benson's rigid supports 21 would be equivalent to the "accommodating means" (i.e., the L-shaped rails 30, 31 fixed to the opposite side walls and spaced apart to accommodate an audio or light mixer and the audio or light effect device) disclosed in the present application. The examiner never applied any of the above-noted indicia to support a conclusion that either Siklos' projection 20 or Benson's rigid supports 21 is or is not an "equivalent" of the structure disclosed by the appellant in the context of 35 U.S.C. § 112, sixth paragraph. Thus, it is our view that the examiner has not met the burden of establishing a case of anticipation since the examiner has not established that either Siklos' projection 20 or Benson's rigid supports 21 is an "equivalent" of the structure disclosed by the appellant.

² As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In any event, in applying the above-noted tests for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 to ascertain whether the structure of either Siklos' projection 20 or Benson's rigid supports 21 is or is not an "equivalent" of the structure disclosed by the appellant, we conclude that neither Siklos' projection 20 nor Benson's rigid supports 21 is an "equivalent" of the structure disclosed by the appellant. In that regard, it is clear to us that Siklos' projection 20 or Benson's rigid supports 21 do not perform the function specified in the claim in substantially the same way, and do not produce substantially the same result as the corresponding element disclosed by the appellant. Furthermore, it is our view that a person of ordinary skill in the art would not have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the appellant's specification. Based upon the above determinations, we conclude that there are substantial differences between Siklos' projection 20 and Benson's rigid supports 21 and the structure disclosed by the appellant. Accordingly, under the above-noted tests for determining equivalence under the sixth paragraph of 35 U.S.C. § 112 we conclude that Siklos' projection 20 and Benson's rigid supports 21 are not equivalent to the structure disclosed by the appellant. In summary, we have reviewed the teachings of Siklos and Benson but fail to find any teaching therein of the claimed "accommodating means."

For the reasons set forth above, the decision of the examiner to reject claims 24 to 30 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 24 to 30 under 35 U.S.C. § 102(b) is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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