

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INVNET RIVIER

Appeal No. 2006-1211
Application 10/277,697

HEARD: May 23, 2006

Before KIMLIN, WARREN and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 27 through 32 under 35 U.S.C. § 102(b) as anticipated by Forester (answer, pages 3-4); claims 1 through 3, 5, 7 through 14 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox (answer, pages 4-6); claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Vadasz (answer, pages 6-7); claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Theeuwes et al. (Theeuwes) (answer, page 7); claims 15 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Forester in view of Maddox and Theeuwes as applied above, and further in view of Paluch (answer, pages 7-8); claims 19, 20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Porzio et al. (answer, pages 8-9); claims 23 and 24 under 35 U.S.C.

§ 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Luhadiya et al. (answer, page 9); claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Carroll et al. (answer, pages 9-10); claim 26 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Knebl (answer, pages 10-11); and claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Forester and Maddox as applied above, and further in view of Nesser (answer, pages 11).¹

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellant.

The principal issues in this appeal involve the following representative language from independent claim 1 which specifies a property of a casing of a confectionery product and properties of a filling of confectionery material encompassed therein:

wherein the casing is capable of forming release means upon the action of the saliva in the mouth which acts to liberate the filling out of the casing and wherein the confectionery material has dissolution properties effective to act together with the release means so as to enable the casing to be left substantially as an empty shell before it has entirely dissolved in the mouth.

The language of independent claims 27, 28 and 30 is similar.

The examiner and appellant² do not provide an interpretation for the language “forming release means upon the action of the saliva in the mouth which acts to liberate the filling out of the casing” that specifies a function without defining structure which satisfies that function and thus, the strictures of 35 U. S. C. § 112, sixth paragraph, apply. *See Texas Digital Sys., Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited

¹ Claims 1 through 33 are all of the claims in the application.

² 37 CFR § 41.37(c)(1)(v) (2005) *Summary of claimed subject matter* provides in pertinent part: For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any by reference characters.

See also Manual of Patent Examining Procedure § 1205.02 (8th ed., Rev. 3, August 2005; 1200-14).

therein. Therefore, the “means” language in this limitation must be construed as limited to the “corresponding structure” disclosed in the written description in the specification and “equivalents” thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*en banc*).

The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “‘the specification . . . clearly links or associates that structure to the function recited in the claim.’ [Citation omitted.]” *Texas Digital Sys.*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six,” and in this respect, the examiner should not confuse “impermissibly imputing limitations from the specification into a claim with properly referring to the specification to determine the meaning of a particular word or phrase in a claim. [Citations omitted.]” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *see also In re Morris*, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) (explaining *Donaldson*).

The principal disclosure of “release means” formed “upon the action of the saliva in the mouth which acts to liberate the filling out of the casing” in the written description in the specification is “[w]hen zones of reduced thickness are provided in the casing, the passage means are formed after the confectionery product has been maintained in contact with the saliva during a few seconds” (page 5, l. 33, to page 6, l. 2; *see also* page 6, ll. 2-4). The “zones of reduced thickness” are illustrated by “zones of reduced thickness” **70** in **FIGS. 2 and 4** (*id.*, page 17, ll. 13-24). It is further disclosed that “the zone(s) of reduction may be flattened slits . . . [and] [t]he resulting passage(s) may be formed after a certain time lag between the introduction of the product in the mouth and the beginning of the release of the filling . . . depending upon the initial thickness of the reduction, melting properties of the . . . casing, etc.” (*id.*, page 17, ll. 1-8).

Thus, we determine that “zones of reduced thickness” in the casing, including flattened slits,” constitute the corresponding structure in the written description necessary to perform the function of opening the casing upon the action of saliva which acts to liberate the filling out of the casing. While “holes” can enlarge “upon the action of saliva in the mouth” (see *id.*, page 17, ll. 8-9), there is no disclosure that such action also “acts to liberate the filling out of the casing,” that is, enlarges the “holes” so as “to liberate the filling out of the casing.” Indeed, appellant discloses in the written description that the size of the “hole can be linked to the amount of the filling” and “release [the filling] upon short contact with the saliva” (e.g., page 17, l. 25, to page 18, l. 8; **FIGs. 5 and 6**, “holes” **720,721** and **750,751**, respectively). Thus, on this record, “holes” are not “equivalent” to the “corresponding structure” because they do not perform the identical function in substantially the same manner to obtain substantially the same result and are otherwise substantially different in structure.

We interpret the further claim requirement “wherein the confectionery material has dissolution properties effective to act together with the release means so as to enable the casing to be left substantially as an empty shell before it has entirely dissolved in the mouth” to plainly specify that once the saliva in the mouth has opened the shell at a zone or zones of reduced thickness, the confectionery material filling the shell will be “substantially” dissolved via action of the saliva which has entered the shell through said “release means” before the thus “substantially” empty casing is entirely dissolved by the saliva. We find no definition or general guidelines and examples in the written description in the specification sufficient as a standard to enable a person of ordinary skill in the art to determine the degree to which the confectionery material is “substantially” released from the casing before the casing is dissolved in the mouth. Thus, we give the term “substantially” its ordinary meaning of “largely but not wholly,” and therefore, the dissolution properties of the confectionery material must be such that it will largely but not wholly dissolve in the saliva from the time that the “release means” is formed by the action of the saliva and before the casing is dissolved by the same action. *See Morris*, 127 F.3d at 1054-55, 44 USPQ2d at 1027; *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622-23 (Fed. Cir. 1996) (“In this case, the patent discloses no novel use of claim words. Ordinarily, therefore, ‘substantially’ means ‘considerable in . . . extent,’ *American Heritage Dictionary Second College Edition* 1213 (2d ed. 1982), or

‘largely but not wholly that which is specified,’ *Webster’s Ninth New Collegiate Dictionary* 1176 (9th ed. 1983.”); *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984) (“Definiteness problems often arise when words of degree are used in a claim. That some claim language may not be precise, however, does not automatically render a claim invalid. When a word of degree is used . . . [it] must [be determined] whether the patent’s specification provides some standard for measuring that degree.”); *In re Mattison*, 509 F.2d 563, 564-65, 184 USPQ 484, 486 (CCPA 1975) (“substantially increase the efficiency of the compound as a copper extractant”); cf. *In re Marosi*, 710 F.2d 799, 802-03, 218 USPQ 289, 292 (Fed. Cir. 1983) (“essentially free of alkali metal”).

We pointed out above that the examiner has not determined the “corresponding structure” disclosed in the written description in the specification and “equivalents” thereof with respect to the claim language. The interpretation of this language is necessary to the interpretation of the remainder of the subject claim language. Thus, in the absence of the examiner’s determinations in these respects, the basis for the ground of rejection under § 102(b) based on Forester and all of the grounds of rejections under § 103(a) essentially based on Forester and Maddox is not apparent from the record. We agree with appellant (brief, page 14; reply brief, pages 1-2) that the examiner does not state the factual basis in Forester for the claim language we interpreted above in rejecting independent claims 27, 28 and 30 under § 102(b) (see answer, paragraph bridging pages 3-4, second sentence, last clause). Indeed, while the examiner cites col. 1, ll. 16-25 and 27-31, of Forester in this respect, there is no identification of the claimed “release means” or the interaction of this property of the casing with the dissolution properties of the confectionery material, and the examiner further admits as much with respect to both claim requirements (answer, paragraph bridging pages 5-6, first sentence).

With respect to the grounds of rejection under § 103(a), we also agree with appellant that the examiner has not explained the teachings in Forester and in Maddox which would have suggested to one of ordinary skill in this art to combine the same, and would have further motivated this person to modify Forester by the teachings of Maddox to arrive at the claimed invention encompassed by independent claims 1 and 30, as we have interpreted these claims above (brief, pages 15-16; reply brief, pages 2-3). Indeed, the record is silent with respect to a scientific explanation or objective evidence supporting the examiner’s position that “the Office

interprets” the placing of the Maddox capsule in “hot water,” that is, “95° C.” to dissolve the gelatin capsule (e.g., col. 4, ll. 13-15), “to include placing the [capsule] in the mouth with saliva” (answer, page 6; see also pages 11-12).

Therefore, the examiner has not established a *prima facie* case of anticipation under § 102(b) or a *prima facie* case of obviousness under § 103(a), and accordingly, we reverse these grounds of rejection. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3. (Fed. Cir. 1990); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The examiner’s decision is reversed.

Other issues

Dependent claim 5 is apparently intended to further limit the confectionery product of claim 1 as follows:

wherein the release means comprises at least one hole and/or zones of reduced thickness provided in the casing which is capable of eventually forming at least one outside passage communicating with the filling.

We note that there is no corresponding claim dependent on any of the other independent claims.

We interpret claim 5 to plainly specify that “release means comprise at least” one hole or zone of reduce thickness, wherein the open-ended term “comprises” opens the claim to additionally include any other manner of “release means . . . capable of eventually forming at least one outside passage communicating with the filling.” *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term >comprises= permits the *inclusion* of other steps, elements, or materials.”). Since claim 5 specifies structure for the “release means,” is not subject to interpretation under § 112, sixth paragraph.

Thus, claim 5 is at odds with claim 1 on which it depends. This is because we interpreted “release means” under § 112, sixth paragraph, above as being limited to the corresponding

structure “zones of reduced thickness” and equivalent structure, and claim 5 specifies that this term can separately and severally include the structure “hole” and any other additional structure.

Accordingly, upon further prosecution of the appealed claims subsequent to the disposition of this appeal, the examiner should consider whether claim 5 complies with 35 U.S.C. § 112, second paragraph. *See In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); *cf. Donaldson Co.*, 16 F.3d at 1194-95, 29 USPQ2d at 1850 (“[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.”).

Reversed

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Administrative Patent Judge)	
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