

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 STEVEN M. BURNS and RICHARD W. VARSELL

Appeal 2006-2465
Application 10/266,052
Technology Center 1700

Decided: September 29, 2006

Before WARREN, KRATZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

COMBINED ORDER REMANDING TO THE EXAMINER and
ORDER UNDER 37 CFR § 41.50(d)(1)

Appellants appeal the Examiner's final rejection of claims 1, 3 to 10, and 23 to 29. Because the issues are not ripe for appeal, we remand this application to the Examiner.

We order both the Examiner and the Appellants to take appropriate action consistent with the views expressed below. We return this application to the Examiner's jurisdiction for purposes of properly interpreting the

claims on appeal and reevaluating the Examiner's § 102 and § 103 rejections based on the properly interpreted claims.

The subject matter on appeal relates to an apparatus for coating a workpiece. Further details of the appealed subject matter are provided in independent claims 1 and 23 which are reproduced below, as presented in the Brief:

1. An apparatus for coating a workpiece having a first airfoil portion with a leading edge and a trailing edge comprising a device for simultaneously manipulating said workpiece about multiple axes while holding a center of workpiece at a fixed horizontal and vertical location with respect to a source of coating material and said device including means for rotating said leading edge of said airfoil portion over said trailing edge of said airfoil portion about said center during a coating operation.

23. An apparatus for coating at least one engine component having a center and an airfoil portion with a leading edge, a trailing edge and a longitudinal axis, said apparatus comprising:

a modular fixture having a first end plate and a stub shaft attached to a first surface of said first end plate;

said modular fixture being rotated about a first axis defined by said stub shaft;

means for supporting said at least one engine component at an angle with respect to said first axis, said supporting means being non-movably attached to a second surface of said end plate;

said supporting means including means for allowing said engine component to rotate about said longitudinal axis so that said leading edge rotates about said trailing edge while said center of said at least one engine component is maintained at a fixed horizontal and vertical location with respect to a source of coating material.

Any initial inquiry into the propriety of the Examiner's prior art rejection requires the determination the precise scope of the claimed subject matter. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Generally, we give the broadest reasonable interpretation to the

terms in the claims consistent with the Appellants' specification. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). When the terms in the claims are written in a "means-plus-function" format, however, we interpret them as the corresponding structures described in the specification or equivalents thereof consistent with § 112, sixth paragraph. *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc). This interpretation is appropriate only if the claimed means-plus-function elements do not include sufficient structural limitations for performing the claimed functions, thus invoking § 112, paragraph 6. *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1319, 50 USPQ2d 1161, 1167 (Fed. Cir. 1999).

As stated by our reviewing court in *B. Braun Med., Inc., v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997):

[S]tructure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, 6.

In *Atmel Corp. v. Info. Storage Devices Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999), our reviewing court further stated that the particularity requirement of 35 U.S.C. § 112, second paragraph, requires that

the corresponding structure(s) of a means-plus-function limitation . . . [is] disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, **one does not know what claim means.** (Emphasis added.)

The structures equivalent to the corresponding structures described in the specification include those which

- 1) perform substantially the same function in substantially the same way to produce substantially the same result, *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1990);
- 2) have insubstantial differences, *Valmount Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042-44, 25 USPQ2d 1451, 1453-56 (Fed. Cir. 1993);
- 3) are structurally equivalent, *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990); and
- 4) a person having ordinary skill in the art would have recognized as interchangeable, *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d at 1316, 50 USPQ2d at 1165.

Here, the appealed claims recite various means plus function limitations including “means for rotating,” “means for tilting,” and “means for supporting.”

On the present record, Appellants, when addressing claim 23, have argued the specific means-plus-function limitation (Br. 8). The record is not clear whether the means-plus-function limitations invoke § 112, paragraph 6. While the Appellants have identified the “means” clauses in the claim and pointed to disclosure with respect thereto in the specification in the Summary of Claimed Subject Matter in the Brief (Br. 2-5), it is not stated therein whether the structure and materials so describe correspond to the claimed function within the meaning of this statutory provision. See 37 C.F.R. § 41.37(c)(1)(v) (2005). Thus, the Examiner is left to interpret the claims with respect to the corresponding structures described in the specification or equivalents thereof. If these means-plus-function limitations

must be interpreted as the corresponding structures described in the specification or equivalents thereof, the Examiner and the Appellants must indicate what structures in the specification, if any, correspond to the above means-plus-function limitations, and what prior art structures, if any, are equivalent to the above means-plus-function limitations.

Implicit in these requirements is that both the Examiner and the Appellants must indicate whether the “corresponding” structures in the specification are described in a manner that would satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph.

Therefore, pursuant to 37 CFR § 41.50(d)(1) (2004), we order the Appellants to file a Supplemental Paper to explain whether or not the claimed means-plus-function limitations invoke §112, paragraph 6, and if invoked, specify what the structures in the specification are encompassed by the means-plus-function limitations. The Appellants shall specify a portion of the specification relied upon to show the structures corresponding to the claimed means-plus-function limitations and shall explain why the structures relied upon are considered “corresponding” within the meaning of *B. Braun Med., Inc., supra* and *Atmel Corp., supra*.

Upon receiving the Appellants’ Supplemental Paper (if submitted), the Examiner is to determine whether the claimed means-plus-function limitations invoke §112, paragraph 6, and if invoked, what structures, if any, in the Specification correspond to the claimed means-plus-function limitations. This evaluation necessarily requires the Examiner to determine whether the claim language and the corresponding structures described in the specification are in compliance with the definiteness requirement of

Appeal 2006-2465
Application 10/266,052

35 U.S.C. 112, second paragraph. In other words, the Examiner must ascertain the correctness of the Appellants' response to our Order pursuant to 37 CFR § 41.50(d) (2004).

Once the claim scope is properly defined, the Examiner must reevaluate the content of the applied prior art and determine whether it still anticipates the claimed subject matter within the meaning of 35 U.S.C. §§ 102 and 103. The Examiner must determine whether the prior art structures are identical or "equivalent" to the corresponding structures described in the specification. The Examiner is authorized to submit a Supplemental Examiner's Answer containing the above analyses if such analyses do not constitute a new ground of rejection.

If the Examiner determines that such analyses change the thrust of the Examiner's § 102 and § 103 rejections or determine that the claims are indefinite and/or obvious under different statutory grounds, the Examiner must reopen the prosecution of this application to include such new grounds of rejection so that Appellants are given an opportunity to respond pursuant to the procedural due process requirement

CONCLUSION

In summary, the Appellants are given **a non-extendable time period of two (2) months** from the mailing date of this order to file a Supplemental Paper. Failure to respond within the given time period will result in the dismissal of the appeal.

The instant application is remanded to the Examiner to consider the aforementioned issues and act accordingly.

Appeal 2006-2465
Application 10/266,052

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2004) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

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

REMANDED AND ORDER UNDER 37 CFR § 41.50(d)(1)

clj

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