

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* MASATSUGU UEHARA, YASUHIRO NAKAI,  
and HAJIME HIRATA

---

Appeal 2007-0874  
Application 10/130,255  
Technology Center 1700

---

Decided: July 17, 2007

---

Before EDWARD KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,  
*Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

**REMAND PURSUANT TO 37 C.F.R. § 41.50(a)**

Pursuant to 37 C.F.R. § 41.50(a) (2004), we remand this application to the Examiner to take appropriate action consistent with the instruction below.

At page 3 of the Answer, the Examiner has rejected claims 10-16 and 18-19 under 35 U.S.C. [§] 102(b) as anticipated by U.S. Patent 4,994,976 issued to Akasaka on February 19, 1991.

Any inquiry into the propriety of the Examiner's § 102(b) rejection requires us to determine the scope of the claims on appeal. *Se, e.g., Gechter v. Davidson*, 116 F.3d 1454, 1460 n.3, 43 USPQ2d 1030, 1035 n.3 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Here, the Appellants set forth, *inter alia*, means-plus-function limitations in independent claims 10, 12, and 16. *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997)(The use of the term "means" raises a presumption that the means-plus-function limitation is intended.); *Ex parte Klumb*, 159 USPQ 694, 695 (Bd. Pat. App. & Int. 1967)(The manner in which a "means-plus-function" is expressed, either by a function followed by the term "means" or by the term "means for" followed by a function, is unimportant so long as the modifier of that term specifies a function to be performed.). The means-plus-function limitations in question are "plural thickness adjusting means for adjusting the thickness of the sheet" and "a specific thickness adjusting means" in claims 10, 12, and 16. These means-plus-function limitations must be interpreted as the corresponding structure described in the Specification and equivalents thereof consistent with 35 U.S.C. § 112, 6<sup>th</sup> paragraph. *See, e.g., In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(*in banc*). Indeed, according to 37 C.F.R. § 41.37(c)(v)(2004), the Appellants are required to identify the specific structure in the Specification corresponding to the claimed means-plus-function limitations in the

“Summary of claimed subject matter” section of the Brief.<sup>1</sup> Specifically, 37 C.F.R. § 41.37(c)(v) states in relevant part:

[E]very 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 [S]pecification as corresponding to each claimed function must be set forth with reference to the [S]pecification by page and line number, and to the drawing, if any, by reference characters.

This requirement is consistent with the holdings of *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997) and *Atmel Corp. v. Information Storage Device, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d at 1424, 43 USPQ2d at 1900 states that:

[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. [Emphasis added.]

*Atmel Corp. v. Information Storage Device, Inc.*, 198 F.3d at 1382, 53 USPQ2d at 1230 also states that:

[T]he corresponding structure(s) of a means-plus-function limitation *must be disclosed* in the written description in such a manner that one skilled in the art will know and understand

---

<sup>1</sup> The Appellants appear to assert in the Argument section of the Brief that the claimed specific means-plus-function limitations may correspond to heaters. This assertion still is problematic for two reasons. First, the term “heater” is not the structure of an apparatus; it only connotes a heating function. Second, the Specification page and line numbers are not referred to show that the Specification supports this interpretation consistent with *Information Storage Device, Inc.* and *Abbott Labs.*

what structure corresponds to the means limitation. Otherwise, *one does not know what the claim means.*" [Emphasis added.]

However, the Appellants fail to comply with the above requirement of 37 C.F.R. § 41.37(c)(v).

Upon return of this application, the Examiner is to notify the Appellants of the above deficiency in the Brief and require them to correct it within an appropriate statutory time period. Once the Appellants submit a corrected Brief in response to the Examiner's notice of a defective Brief, the Examiner must determine (1) the correctness and adequacy of the Appellants' description and explanation directed to the specific structures corresponding to the claimed means-plus-function limitations and (2) the propriety of the applicability of the rejection of record. If the rejection is to be maintained, the Examiner may provide, if necessary, a Supplemental Answer in response to the corrected Brief. The Supplemental Answer can be used to further explain the rejection of record in terms of the specific structures described in the Specification allegedly corresponding to the claimed means-plus-function limitations or equivalents thereof. The Examiner is reminded that the structures taught or suggested in the prior art reference are considered "equivalents thereof" if they, relative to the corresponding structures,

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. 1999);

Appeal 2007-0874  
Application 10/130,255

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) would have been recognized by one of ordinary skill in the art as interchangeable, *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

If the Specification fails to adequately describe the structures corresponding to the claimed means-plus-function limitations in accordance with *Abbott Labs* and *Information Storage Devices Inc.* discussed *supra*, the Examiner must set forth a new ground of rejection under 35 U.S.C. § 112, second paragraph, and reopen the prosecution of this application.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 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.

REMANDED

sld/ls

KUBOVCIK & KUBOVCIK  
SUITE 710  
900 17<sup>TH</sup> STREET, NW  
WASHINGTON, DC 20006