

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MOHAMED H. KHAN,  
JAMES A. COLE, and JOEL A. TAUBE

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Appeal 2007-4145  
Application 10/222,626  
Technology Center 1700

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Decided: January 30, 2008

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Before CHARLES F. WARREN, PETER F. KRATZ, and  
LINDA M. GAUDETTE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner rejecting, for at least the second time, claims 1 through 20 in the Office Action mailed August 24, 2006 (“Office Action”). 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

ORDER REMANDING TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 6, August 2007).

The record shows the Examiner relied on an English language Abstract of Natsume prepared by the Patent Office of Japan along with Figs. 1 and 2 of the underlying Japanese patent document in stating the grounds of rejection based on prior art in the Office Action and the Answer. Indeed, the statements of the grounds of rejection read the same in both documents. Office Action 3-9; Ans. 4-10. In the Brief filed December 11, 2006, Appellants responded with contentions that the Abstract and the Figs. 1 and 2 do not support the Examiner's position. Br., e.g., 15-19. In the Answer, the Examiner relied on information in an unidentified "translation" to further support the grounds of rejection in responding to Appellants' arguments. Ans., e.g., 12-21. The Answer does not identify the translation or otherwise provide specific notice to Appellants that it was relied on to support the grounds of rejection. The official USPTO electronic file contains a copy of a translation of Natsume dated January 2007 ("'07 translation")<sup>1</sup> that was entered in the official electronic file along with the Answer.

A translation is, of course, not the same document as the document that was translated. Thus, in relying on the '07 translation, the Examiner effectively relied on information beyond that which was set forth in the

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<sup>1</sup> Translation of Natsume prepared for the USPTO by Schreiber Translations, Inc. (PTO 2007-2021 January 2007).

Office action to support the grounds of rejection. Reliance on evidence in a document not set forth in the statement of a ground of rejection is clearly impermissible. *See In re Hoch*, 428 F.2d 1341, 1342 n. 3 (CCPA 1970); *cf. Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (BPAI 1993).

We considered the '07 translation with respect to Appellants' contentions that the Abstract and the Figs. 1 and 2 did not provide sufficient evidence to support the grounds of rejection. We found that passages of the '07 translation reasonably appeared to be very roughly translated. Accordingly, we obtained a further translation of Natsume ("‘08 translation").<sup>2</sup> The '08 translation has been entered into the official electronic files of the USPTO of this Application with a date of January 11, 2008. The '08 translation provides different information than the '07 translation. For example, the passage at page 12, lines 10-21, of the '08 translation provides different information with respect to "cyclic aperture (62)" than does the passage at page 15, line 13 to page 16, line 9, of the '07 translation with respect to "ringed shaped opening 62," which difference appears to be material with respect to the ground of rejection of appealed claims 6 through 8, 17, and 18 that specify "an elongated tube having a J-shaped end portion."

Moreover, we determine claim 20 specifies an apparatus comprising at least, among other things, "insulating means" and "product collecting means." The Examiner has not considered these "means-plus-function" limitations with respect to the strictures of 35 U.S.C. § 112, sixth paragraph,

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<sup>2</sup> Translation of Natsume prepared for the USPTO by Schreiber Translations, Inc. (PTO 2007-2021 January 2008).

since the “corresponding structure” in the Specification and “equivalents” thereof with respect to the “means-plus-function” limitations have not been determined in a manner consistent with the requirements of this statutory provision before applying the references to the claims. *See Ans.*, e.g., 6-7 and 19-21. Thus, the Examiner did not first interpret the “means” claim language in the claims before applying the prior art and, therefore, did not consider all of the claim limitations in making out the grounds of rejection. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63 (CCPA 1974) (in considering grounds of rejection “*every* limitation in the claim must be given effect rather than considering one in isolation from the others”); *cf. In re Donaldson Co.*, 16 F.3d 1189, 1195-97 (Fed. Cir. 1994) (*en banc*).

The resolution of the issues with respect to the ground of rejection of claim 20 under 35 U.S.C. § 102(b) requires that the “means-plus-function” language in the claims must first be interpreted by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in Appellants' Specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.”); *Donaldson*, 16 F.3d at 1192-95 (“[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.”); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989) (citing *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.”)).

In view of the “means-plus-function” recitations, claim 20 must be interpreted with respect to whether any or all of the “means-plus-function” limitations specify a function without defining structure sufficient to satisfy that function. If either or both of the “means-plus-function” limitations specify only a function and not the structure for satisfying that function, the strictures of 35 U. S. C. § 112, sixth paragraph, apply to the limitation(s).

*See Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1208 (Fed. Cir 2002), and cases cited therein. A Claim containing “means-plus-function” language complying with this statutory provision must be construed as limited to the “corresponding structure” disclosed in the written description in the Specification and “equivalents” thereof. *Donaldson*, 16 F.3d at 1195.

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 claims.’ (citation omitted).” *Texas Digital Sys.*, 308 F.3d at 1208. “[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 (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. “[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 recited in a claim. (citations omitted).” *Donaldson*, 16 F.3d at 1194-95; *see also Morris*, 127 F.3d at 1055-56 (explaining *Donaldson*).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to (1) interpret the “means” limitations of claim 20 by first determining the “corresponding structure” and “equivalents thereof” for the “function” in the limitation that is described in the Specification, in a manner consistent with the requirements of 35 U.S.C. § 112, sixth paragraph, and then determining whether the corresponding structure or “equivalents” thereof are taught or suggested by the applied prior art, and (2) determine the applicable teachings of Natsume, and apply this reference to the claims on this basis, with a view toward placing this Application in condition for decision on appeal with respect to the issues presented.

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This remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a supplemental answer to the Board in response to this Remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. §41.50(a)(2) (2007), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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FENNEMORE, CRAIG, P.C.  
1700 LINCOLN STREET  
SUITE 2900  
DENVER, CO 80203