

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MAURO BARBIERI, JAN NESVADBA,  
GERHARDUS MEKENKAMP, MARCO CECCARELLI,  
WILHELMUS FONTIJN, AND RONALD TOL

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Appeal 2007-4518  
Application 10/129,693  
Technology Center 2100

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Decided: March 17, 2008

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Before JOSEPH L. DIXON, JEAN R. HOMERE, and STEPHEN C. SIU,  
*Administrative Patent Judges.*

SIU, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER  
BACKGROUND

Appellants' invention relates to displaying a colored slider bar corresponding to video data. An understanding of the invention can be derived from a reading of exemplary claim 1, reproduced below.

1. An apparatus for reproducing an ordered information unit, said apparatus having:

presentation generator means for generating a length display of the information unit on a display unit, said length display being divided in consecutive portions, a portion corresponds to a position in the information unit, said length display further comprises a marker, the apparatus further comprises:

user operable input means for receiving commands for moving the marker along the consecutive portions,

means for determining the portion at which the marker is located, and

means to enable reproduction of the information unit at the position indicated by the determined portion, characterized in that a portion of the length display has at least one visual parameter, said visual parameter color determined based on at least one parameter associated with at least a part of the information unit content corresponding to said portion.

#### PRIOR ART

The prior art references of record relied upon by the Examiner in rejection the appealed claims are:

Mills	5,513,306	April 30, 1996
Gould	5,623,588	April 22, 1997

#### REJECTIONS

Claims 1-7, 10, and 11 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Mills. Claims 8 and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mills and Gould.

Rather than attempt to address the merits of this appeal at this time, we have elected to remand the application to allow Appellants and the Examiner to place the appeal in a better and proper condition for our review.

Claim 1 recites a presentation generator means, an input means, a means for determining, and a means to enable reproduction of information. Because claim 1 specifies the word “means” with corresponding functions and does not recite sufficient structure, material, or acts to perform the recited functions, there is a presumption that Appellants have invoked the statutory mandates for means-plus-function clauses of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. “The use of the word ‘means,’ which is part of the classic template for functional claim elements, gives rise to ‘a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.’” *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427 (Fed. Cir. 1997). Therefore, claim 1 represents a means-plus-function claim subject to the statutory mandates of 35 U.S.C. § 112, 6<sup>th</sup> paragraph.

Means-plus-function language in a claim is construed by corresponding structure, material, or acts described in the specification. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994). Therefore, we are required by statute to look to the instant specification to construe the “means” language recited in claim 1 as limited to the corresponding structure, act, or materials disclosed in the instant specification and equivalents thereof.

However, we find Appellants’ Brief deficient because the correspondence for the means-plus-function limitations of claim 1 to

Appeal 2007-4518  
Application 10/129,693

sufficient structure, material, or acts from the specification has not been sufficiently set forth.

Additionally, we find that the Examiner does not appear to have considered the “means” language of claim 1 in view of structure, material, or acts disclosed in the instant specification, such structure, material, or acts not having been established or identified in Appellants’ Brief.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- (1) send a notice of non-compliance of the Appeal Brief;
- (2) evaluate the Amended Brief for compliance with 37 C.F.R. § 41.37, the Amended Brief to include correlations and correspondence between claim terms in means-plus-function claims and specific structure, material, or acts from the instant specification;
- (3) evaluate means-plus-function claims, construing claim terms as limited to specific structure, material, or acts from the specification as identified by Appellants in the Amended Brief;
- (4) further evaluate claims for issues under 35 U.S.C. § 112, 1<sup>st</sup> paragraph and 35 U.S.C. § 112, 2<sup>nd</sup> paragraph in view of claim construction under 35 U.S.C. § 112, 6<sup>th</sup> paragraph;
- (4) prepare a Supplemental Examiner’s Answer which sets forth the Examiner’s claim interpretation and responds to all of Appellants’ arguments providing clear citations to the Amended Brief;
- (5) take further action as may be appropriate.

Appeal 2007-4518  
Application 10/129,693

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of the rejections of record. 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

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