

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRETT WILLIAMS, NATHAN HARMON,
and DUANE MENTZE

Appeal 2008-0259
Application 10/703,862
Technology Center 2100

Decided: August 18, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER TO THE APPELLANTS

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-32. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

II. AUTHORITIES

When the Appellants filed their *Brief of Appellant*, such a brief was required to include the following contents.

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of (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.

37 C.F.R. § 41.37(c)(1)(v) (2006).¹ Reference to page and line numbers of the specification and to the reference characters of the drawings "is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." MPEP § 1205.02 (8th ed., Rev. 5, Aug. 2006).²

¹ We cite to the version of the Code of Federal Regulations in effect when the Appellants filed their *Brief of Appellant*. The current version includes the same rules.

² We cite to the version of the Manual of Patent Examining Procedure in effect when the Appellants filed their *Brief of Appellant*. The current version includes the same explanation.

III. ANALYSIS

Here, independent claim 24 is written in means-plus-function format. The Appellants' *Summary of Claimed Subject Matter*, however, identifies none of the claim's means plus functions nor any of the structure, material, or acts described in their Specification as corresponding to these functions (with reference to the Specification by page and line number and to the Figures by reference characters).

Furthermore, independent claims 1, 13, and 30 each recite method steps. The Appellants' Figure 5 "is a flow chart illustrating a methodology for accessing a service associated with a wireless network according to one embodiment." (Spec. ¶0017.) The *Summary*, however, fails to map the method steps of the claims to the blocks of their flow chart. From our review of the Figure, we do not find a one-to-one correspondence of the claimed method steps to the generalized steps in the Figure.

In explaining independent claim 18, moreover, the *Summary* refers to "a communications device." (App. Br. 2.) The claim, however, recites no such "communications device." Although claim 18 does recite *inter alia* "[a] configuration device," "a communications interface," "an external device," and "a storage device," the *Summary* fails to map any of these elements to the Appellants' Figures.

Similarly, claim 30 recites *inter alia* "a configuration device." The Appellants' *Summary*, however, fails to map this element to the Appellants' Figures.

IV. CONCLUSION

Because of the aforementioned omissions, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

V. ORDER

"We decline to substitute our speculation for the greater certainty that should come from the Appellants." *Ex Parte Dietz*, No. 2007-2386, 2008 WL 696147, at *2 (BPAI 2008). More specifically, the Appellants must submit a substitute *Summary of Claimed Subject Matter*. The substitute *Summary* shall include the following features:

- a mapping of each of the seven steps of claim 1 to the corresponding, individual steps of Figure 5;
- a mapping of each of the last two steps of claim 13 to the corresponding, individual steps of Figure 5;
- a mapping of the structural elements of claim 18 including "[a] configuration device," "a communications interface," "an external device," and "a storage device" to the corresponding reference characters of Figures 1-4;
- a mapping of each means plus function in claim 24, including the "configuration means," the "communications means," and the "wireless network means," to specific pages and line numbers of the Appellants' Specification and to specific

- reference characters of their Figures where the corresponding structure is respectively described and shown; and
- a mapping of each of the six steps of claim 30 to the corresponding, individual steps of Figure 5; and
- a mapping of the "configuration device" of claim 30 to the corresponding reference character of Figures 1-4.

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of this appeal. 37 C.F.R. § 41.50(d).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

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