

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte INGE MAUDAL

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Appeal No. 97-4056  
Application No. 08/238,926<sup>1</sup>

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ON BRIEF

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 13, 14 and 20. Subsequent to the final rejection, the examiner allowed claims 1 through 12 and 19. Claims 15 through 18 have been canceled.

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<sup>1</sup> Application for patent filed May 6, 1994. According to the appellant, the application is a continuation of Application No. 07/880,901, filed May 8, 1992, now U.S. Patent No. 5,336,018, which is a continuation of Application No. 07/497,489, filed March 22, 1990, now abandoned.

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Application No. 08/238,926

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a system for cleansing a harbor or bay. An understanding of the invention can be derived from a reading of exemplary claims 13 and 20 and a copy of those claims, as they appear in the appendix to the appellant's brief, is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) is:

Parker	833,544	Oct. 16, 1906
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Claims 13, 14 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Parker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 102(b) rejection, we make reference to the examiner's answer (Paper No. 23, mailed May 27, 1997) and the supplemental examiner's answer (Paper No. 25, mailed July 21, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 20, filed March 13, 1997), reply brief (Paper No. 24, filed June 3, 1997), citations on appeal (Paper No. 26, filed August

29, 1997) and supplemental brief (Paper No. 27, filed September 2, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**Claim 20**

The rejection of claim 20 under 35 U.S.C. § 102(b) as being anticipated by Parker is sustained.

Parker discloses a method and apparatus for cleansing harbors. By way of example, Parker shows in Figure 1, his invention applied to the harbor of Havana, Cuba. Specifically, Figure 1 illustrates a bay or harbor 2 whose entrance is the strait 3, opening into the sea 4. Additionally, Figure 1 shows a canal or waterway 7 affording direct communication between the open sea 4 and an upper end 5 of the bay 2 and a head-producing

mechanism 8, illustrated in detail in Figures 2-3, located at the intake end of the canal at any point where it may be directly exposed to the action of the waves of the sea at all tides. As shown in Figures 2-3, the head-producing mechanism 8 includes an apron (comprised of elements numbered 25, 26, 27 and 35) hinged to cross-pieces 18 by a suitable hinge connection 28. Parker teaches at page 2, lines 18-35, that the head-producing mechanism 8 is employed

to produce and to preserve a constantly higher level of water within the canal 7 than the varying mean level of the sea without. The two levels change with the rise and fall of the tide; but at all tides there is a differential of levels or head, which produces continuously a flow through the canal 7 and discharge therefrom into the end 5 of the bay 2.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ

781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

We agree with the examiner that claim 20 "reads on" Parker and therefore Parker does anticipate claim 20. We read claim 20 on Parker as follows: In a harbor (Parker's bay or harbor 2) having an entrance (Parker's strait 3) between the harbor and an open sea area (Parker's sea 4), the entrance being sufficiently unobstructed to permit free and continuous tidal propagation therethrough (the appellant admits on page 19, lines 37-39, of the brief that the tide propagates through Havana Harbor as a wave),<sup>2</sup> a system for cleansing the harbor (Parker's canal or waterway 7 and head-producing mechanism 8) comprising: a conduit (Parker's canal or waterway 7) having first and second openings; said first opening placed within said harbor (Parker's canal or waterway 7 communicates with the upper end 5 of the bay or harbor 2 and thus inherently has an outlet opening at the harbor end of

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<sup>2</sup> Additionally, Parker specifies (page 1, lines 22-26) that harbors of the class specified have a narrow entrance or strait into which drives at regular intervals the tide from the sea, of which a portion with equal regularity recedes.

the canal or waterway 7); said second opening placed substantially in said open sea area (see Parker's Figure 2 which shows that the canal or waterway 7 has an inlet opening placed in the sea area); and said first and second opening being in fluid communication to permit flow of water through said conduit (Parker's canal or waterway 7 permits flow of water from the inlet opening to the outlet opening at the harbor end of the canal or waterway 7).

The appellant's argument (supplemental brief, page 18, and brief, pages 31-32) that appellant's invention resides in the removal of a critical and massive structure (i.e., Parker's head-producing mechanism 8) is unpersuasive for the following reason. Claim 20 is drafted utilizing the transitional phrase "comprising." Therefore, claim 20 is open-ended and does not exclude additional, unrecited elements such as Parker's head-producing mechanism 8.

Since each and every element as set forth in claim 20 is found, either expressly or inherently described, in Parker, we sustain the examiner's rejection of claim 20 under 35 U.S.C. § 102(b).

**Claims 13 and 14**

The rejection of claims 13 and 14 under 35 U.S.C. § 102(b) as being anticipated by Parker is not sustained.

Independent claim 13 recites, inter alia, a system for cleansing a polluted bay comprising (1) fluid communication means across the isthmus for establishing flow of water between the open ocean area and a back area; and (2) flow control means in the fluid communication means for regulating flow of water.

The appellant argues in the reply brief and the supplemental brief that Parker does not teach or disclose the "flow control means in the fluid communication means for regulating flow of water" as recited in claim 13. The examiner responded (supplemental examiner's answer, pages 2-4) by finding that (1) Parker's head-producing mechanism 8 regulates the flow of water, (2) Parker's head-producing mechanism 8 is not the same structure as disclosed by the appellant for performing the recited function, and (3) Parker's head-producing mechanism 8 does not operate on the same principle as the appellant's flow control means. Nevertheless, the examiner appears to be of the

view that, because claim 13 does not set forth specifically how the claimed means functions to regulate flow, the "flow control means" language of the claim may be broadly interpreted to read on Parker's structure.

As recently explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the Patent and Trademark Office (PTO) is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such means when rendering a patentability determination. Thus, in order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg.

Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993);  
Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386  
(Fed. Cir. 1989).

It is our opinion that the structure of Parker's head-producing mechanism 8 is not the structure disclosed in the appellant's specification for performing the function or an equivalent structure. The appellant's specification sets forth five specific embodiments, shown in figures 7a-11b, for the corresponding structure to the recited "flow control means in the fluid communication means for regulating flow of water." Clearly, Parker's head-producing mechanism 8 is not the same structure as disclosed by the appellant. Thus, the issue of whether Parker's head-producing mechanism 8 is an equivalent structure<sup>3</sup> to any of the five specific embodiments disclosed by the appellant must be resolved. Comparison of Parker's head-producing mechanism 8 to the five specific embodiments disclosed by the appellant compels us to the conclusion that the claimed "flow control means" and Parker's flow control means (i.e., head-

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<sup>3</sup> "[A]n equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification." Valmont, 983 F.2d at 1043, 25 USPQ2d at 1455.

producing mechanism 8) are not structurally equivalent under section 112. We reach this conclusion based upon the fact that they operate in strickenly different manners. Each of the five embodiments of the appellant's "flow control means" regulates the flow of water dependent on the direction of the tide so that in one direction of the tide the flow control means permits flow through the flow communications means (i.e., the conduit 32, conduit 132, or channel 232) and in the other direction of the tide the flow control means restricts/regulates flow through the flow communications means. Parker's flow control means (i.e., head-producing mechanism 8) does not regulate the flow of water dependent on the direction of the tide, in fact, Parker's flow control means permits flow through his flow communications means (i.e., canal or waterway 7) in both directions of the tide. Thus, we agree with the examiner that Parker's head-producing mechanism 8 does not operate on the same principle as the appellant's flow control means. However, for that reason, we find that Parker's head-producing mechanism 8 is not an equivalent structure to the structure described in the appellant's specification expressed in claim 13 as "flow control means."

Since each and every element as set forth in independent claim 13 is not found, either expressly or inherently described, in Parker, we do not sustain the examiner's rejection of claim 13, or claim 14 which depends therefrom, under 35 U.S.C. § 102(b).

CONCLUSION

To summarize, the decision of the examiner to reject claims 13 and 14 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claim 20 under 35 U.S.C. § 102(b) is affirmed.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPENDIX

13. In a polluted bay which is open to an ocean area through a substantially unobstructed entrance, the bay having back areas separated from the ocean area by an isthmus, a system for cleansing the polluted bay comprising:

fluid communication means across the isthmus for establishing flow of water between the open ocean area and a back area; and

flow control means in the fluid communication means for regulating flow of water.

20. In a harbor having an entrance between the harbor and an open sea area, the entrance being sufficiently unobstructed to permit free and continuous tidal propagation therethrough, a system for cleansing the harbor comprising:

a conduit having first and second openings;  
said first opening placed within said harbor;  
said second opening placed substantially in said open sea area; and

said first and second opening being in fluid communication to permit flow of water through said conduit.

APPEAL NO. 97-4056 - JUDGE NASE  
APPLICATION NO. 08/238,926

APJ NASE

APJ STAAB

APJ ABRAMS

DECISION: **AFFIRMED-IN-PART**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 22 Dec 98

**FINAL TYPED:**