

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM T. CARTER, Jr. et al.

Appeal No. 1998-0389
Application No. 08/576321

ON BRIEF

Before COHEN, ABRAMS, and GONZALES, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9 and 12-14, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a system for controlling the superheat of the metal exiting a cold wall induction guide tube apparatus in an electrostatic refining process. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

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| Benz <u>et al.</u> (Benz) | 5,332,197 | Jul. 26, 1994 |
|---------------------------|-----------|---------------|

Claims 1-9 and 12-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Benz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 14) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, the applied prior art reference, the respective positions articulated by the appellants and the examiner, and the guidance provided by our

reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection Under 35 U.S.C. § 102(b)

All of the claims on appeal stand rejected as being anticipated by Benz.

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). The examiner's rejection of the six independent claims and six dependent claims encompasses merely eight lines (Answer, pages 3 and 4). The appellants focus upon this in their Brief, arguing that the claims set forth the invention through the use of a number of "means-plus-function" recitations of structure, and that the examiner has failed to point out exactly where these limitations are found in the reference.

The twelve claims before us on appeal contain some eighteen recitations of structure in means-plus-function format, which must be evaluated in the context of the sixth paragraph of 35 U.S.C. § 112. In order to meet a means-plus-function limitation, the prior art must perform the identical function recited in the means limitation, and perform that function using the structure disclosed in the appellant's specification or an equivalent

structure. See Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir 1993).

The initial Valmont requirement is that the prior art perform the same function as that of the means recited in the claim. While the examiner has alleged that this is the case, he has not provided a detailed explanation of what structure in Benz performs the various functions. Moreover, even considering, arguendo, that the Benz structure performs the claimed functions, the examiner has failed to establish that the structure is the same as that disclosed by the appellants or its equivalent.¹ In this regard, not only has the means in the

¹While there is no litmus test for an “equivalent” that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion of equivalency or non-equivalency. These include:

(1) Whether the prior art elements perform the function specified in the claim in substantially the same way, and produce substantially the same results as the corresponding structure disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999).

(2) Whether a person of ordinary skill in the art would have recognized the interchangeability of the elements shown in the prior art for the corresponding elements disclosed in the specification. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

(3) Whether the prior art elements are the structural equivalents of the corresponding elements disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

(4) Whether there are insubstantial differences between the prior art elements and the corresponding elements disclosed in the specification.

(continued...)

reference that correspond to each of those recited in the appellants' claims not been identified, there has been no response to specific issues raised by the appellants in their arguments. For example, the appellants allege that the means disclosed in the reference are not concerned with "dynamically varying" the superheat of the melt steam "at a plurality of cycles per second," as is required in their claims, but merely establish and maintain a steady rate of discharge from the nozzle (Brief, page 6). This argument was merely refuted by the examiner, without pointing out where "dynamically varying" was taught in the reference (Answer, page 4). With regard to the appellants' question of where in Benz was the teaching of varying the superheat of the melt stream (Brief, page 10), the examiner supplied no answer at all. In response to the argument that one of the claimed means for accomplishing the objectives of their invention resided in providing two induction heating coils, whereas Benz discloses only one (Brief, page 9), the examiner stated that Benz did show two induction coils in the form of "items 135 and 185" and that the Benz means therefore were "identical" (Answer, page 4). However, although Benz admittedly states that two such coils are present (column 9, line 53), coil "135" is not shown in the drawings, nor is its operation explained, and this recitation in the patent would appear to be an error. In any event, however, the mere presence of a second coil would not, ipso facto, establish

¹(...continued)

IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138-39 (Fed. Cir. 2000).

that it would operate in the manner required by the “means” recitation in the appellants’ claims. Finally, the examiner made the statement that the appellants were merely using the structure disclosed by Benz in a different manner, a distinction that could not be relied upon for distinguishing the claimed apparatus from the prior art (Answer, pages 4-5); in view of the shortcomings we have pointed out above, this conclusion simply is not supported by evidence.

For the reasons set forth above, it is our view that the evidence adduced by the examiner fails to establish that the prior art structure discloses or teaches the means-plus-function structure recited in the appellants’ claims. This being the case, the rejection of claims 1-9 and 12-14 as being anticipated by Benz cannot be sustained.

Remand To The Examiner

As we noted above, the examiner stated that Benz disclosed two induction heating systems for controlling the heat applied to the melted material, but that one of those was mentioned in the text but not shown in the drawings or described in the disclosure. However, in reviewing the record before us, we noted that U.S. Patent No. 5,348,566, which is in the same area of technology and was mentioned by the appellants on page 7 of the specification, discloses two such systems.² In fact, there is a striking resemblance

²This patent has been cited as a reference against the claims in appellants’ application serial number 08/537966, which presently is before the Board of Patent Appeals and Interferences, awaiting decision.

between the structure shown in Figure 3 of this patent and Figure 3 of the appellants' drawings.

The present application therefore is remanded to the examiner for consideration of the above-identified patent as it might be relevant to the patentability of the claims.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for appropriate action.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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

REVERSED AND REMANDED

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| NEAL E. ABRAMS |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| JOHN F. GONZALES |) | |
| Administrative Patent Judge |) | |

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APPLICATION NO. 08/576321

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**DECISION: REVERSED AND
REMANDED**

Prepared By:

DRAFT TYPED: 27 Apr 01

FINAL TYPED: