

**APPELLANT'S**

**REPLY BRIEF**

**REPLY BRIEF FOR APPELLANT DONALDSON COMPANY, INC.**

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**United States Court of Appeals  
for the Federal Circuit**

FILED  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

DEC 28 1992

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**No. 91-1386**

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IN RE DONALDSON COMPANY, INC.

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**APPEAL FROM A DECISION OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

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### **Introduction**

The Solicitor has tried to support each of the Board's alternative grounds of rejection. Thus, his Responding Brief addresses both the literal language of Claim 1 and whether that language, which is a means expression, must be interpreted as paragraph 6 of section 112 requires.

One basic fact, however, renders both of the Solicitor's arguments incorrect. The structure disclosed in the sole prior-art reference that has been applied against claim 1, U.S. Patent No. 3,421,295 to Swift (Figure 1 of the Swift patent is attached to Donaldson's Lead Brief at TAB B), is wholly unlike the structure to which the claim refers. Claim 1 refers to a special hopper structure that is active, and which responds to the cleaning pulses of the collector. That structure alleviates a known problem in the dust-collector art. The hopper of the collector shown in the Swift patent, in contrast, has only a standard structure. It is passive, not active. It is also precisely the structure that the claimed invention has improved upon.

The Solicitor has been forced to take extreme measures to overcome this basic fact. To fit the Swift collector within the literal language of the claim, he must attribute to the Swift collector capabilities that it does not have. Because of the same fact, the Solicitor cannot prevail if the means expression is given the narrow scope that section 112 requires it to have. Instead, he must artificially recast the means expression into a broader, more easily rejectable limitation.

The following Reply Brief discusses the specifics of each these problems in turn.

#### **I. The Prior Art Does Not Respond to the Literal Language of the Claims**

##### **A. The Solicitor has reported Donaldson's statements about the art incorrectly**

According to the Solicitor, "Donaldson admitted that hopper walls vibrate quite violently" in prior-art dust collectors. Solicitor's Responding Brief, at 5. This is untrue. In fact, Donaldson used the adjective "violent" to describe only the cleaning pulses in dust collectors, and not the motion of the collector that results from the pulses. See, e.g., Donaldson's Appeal Brief to the Board at A61.



This distinction is very significant. The hopper walls of dust collectors are made of sturdy material. The cleaning pulses in a dust collector therefore do *not* cause the walls of the hopper to vibrate violently. Instead, the cleaning pulses impart so little motion to the hopper walls of a typical dust collector that the dust will often build up on the walls. For this reason, several prior-art dust collectors have included mechanisms to further encourage the collected dust to move downward in the hopper. See, e.g., U.S. Patent to Davis, No. 2,732,099, A98-104 (Figure 1 of Davis is attached to Donaldson's Lead Brief at TAB D).

The dust collector shown in the U.S. Patent to Lissy, No. 4,409,009, A90-96 (see Donaldson's Lead Brief at TA<sup>3</sup> C), shows how this refutes the Solicitor's position. Lissy shows a dust collector in which the walls of each hopper are separately actuated by vibrators to loosen the dust cake and cause the collected dust to fall to the bottom of the hopper. E.g., A93, col. 2 at lines 4-8, 48-55, and A95, col. 6 at lines 16-22. *The dust collector of Lissy, however, already incorporates a pulse-jet cleaning mechanism.* A94, col. 4 at lines 38-58. If pulse-jet cleaning mechanisms truly operated as the Solicitor asserts, the separate vibrators of Lissy would be unnecessary. Instead, however, Lissy acknowledges that, despite the presence of pulse-jet cleaning,

[o]ften times, . . . the powder collects and builds up on the walls of the hoppers.

A93, col. 2 at lines 1-4. See Donaldson's Lead Brief at 5.

Plainly, pulse-jet cleaning in a dust collector that has a typical hopper structure does *not* loosen the hardened dust that gathers on the hopper walls. The Solicitor's reconstruction of this key aspect of the prior art has no basis in fact and is therefore invalid.

**B. The prior art is not "responsive to pressure increases"**

The Solicitor has relied heavily on this invalid reconstruction of the prior art. Claim 1 specifically requires that the means at issue be

responsive to pressure increases in [the dirty-air] chamber caused by [the] cleaning means . . . .

A12, 74, col. 8 at lines 57-59. The Board asserted, with no explanation, that the Swift collector meets this requirement. See Decision at A5, and Decision on Reconsideration at A10 (discussed in Donaldson's Lead Brief at 3). But for his incorrect

reconstruction of the prior art, the Solicitor can find no support that assertion. See Solicitor's Responding Brief at 5-6.

The Swift collector, however, does not meet this literal requirement of claim 1. The stationary hopper walls of the Swift collector are rigid. See Donaldson's Lead Brief at 4-5. They are inert, and are not responsive to the cleaning pulses of compressed air in the Swift collector.

Simply put, the hopper walls of the Swift collector do not satisfy the clear, literal requirements of Claim 1. The Board's rejection of Claim 1 must therefore fail.

**II. The PTO's Interpretation of the Sixth Paragraph of Section 112 is Incorrect**

**A. The PTO's interpretation does not determine the patentability of the *claimed* invention**

The Solicitor has discussed the PTO's interpretation of the sixth paragraph of section 112 at length. Solicitor's Responding Brief at 7-37. Nowhere in that discussion, however, does he address the central weakness of the PTO's interpretation: the PTO's interpretation forces patent applicants to discuss the patentability of very broad inventions when the claims at issue will give patent rights over only narrow ones. See Moy, THE INTERPRETATION OF MEANS EXPRESSIONS DURING PROSECUTION, 68 JPTOS 246, 266-67 (1986) (hereinafter "MEANS EXPRESSIONS"); W. Whitmyer, THE PATENT AND TRADEMARK OFFICE'S REFUSAL TO FOLLOW *IN RE BOND*, 74 JPTOS \_\_\_, \_\_\_, nn.48-49 (forthcoming, June 1992) (hereinafter "Whitmyer"); Moy, JUDICIAL DEFERENCE TO THE PTO'S INTERPRETATIONS OF THE PATENT LAW, 74 JPTOS \_\_\_, \_\_\_, nn.146-57 (forthcoming June 1992) (hereinafter "JUDICIAL DEFERENCE").

The facts of the present case provide an example of this inequity. As the statute commands, the means expression in claim 1 of Donaldson's patent covers for infringement purposes only "the corresponding structure . . . described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6. That corresponding structure is a flexible diaphragm, which balloons outward in response to the momentary pressure increases that the pulse-jet cleaning mechanism creates. See, e.g., A74, col. 7 at lines 42-48. Claim 1 therefore gives exclusive rights over only that structure and other structures that perform substantially the same function, in the same way, to achieve substantially the same

result. See, e.g., *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1949) (defining scope of equivalents).

Interpreted in this way, the claim is too narrow to ever give rights over a rigid hopper structure such as the Swift collector possesses. Yet the PTO insists on preventing the claim from issuing solely because the Swift collector is part of the prior art.

This illogical result, which is an inescapable consequence of the PTO's statutory interpretation, strikes at the heart of the patent system. The U.S. patent system reflects a policy decision that inventors should be given exclusive rights over inventions that are novel and unobvious over the prior art. See 35 U.S.C. §§ 102, 103. It is "axiomatic," then, that the same invention must be used to determine both the fact of infringement and the inventor's entitlement to patent rights. See, e.g., *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 n.7 (Fed. Cir. 1988).

The PTO's interpretation flies in the face of this basic policy decision. See MEANS EXPRESSIONS, 68 JPTOS at 268. The PTO is refusing to allow Donaldson's claim 1 when that claim covers, for infringement purposes, only subject matter that is conceded<sup>1</sup> to be novel and unobvious. This situation occurs repeatedly under the PTO's interpretation of means expressions. See, e.g., MEANS EXPRESSIONS, 68 JPTOS at 246 (setting out PTO arguments in *In re Boersma*, No. 84-627 (May 4, 1984), summarized at 28 PTCJ 83 (May 24, 1984)).

When viewed in this way, it is clear that the PTO's interpretation of the statute is fundamentally at odds with the basic purpose of the patent system. The detailed legal rules and matters of administrative convenience that the Solicitor discusses cannot compensate for the destructive effects of the PTO's interpretation on the patenting process.

**B. This Court has already held that the PTO's interpretation is incorrect**

This Court has expressly instructed the PTO to interpret means expressions during prosecution according to the statute. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *In re Iwahashi*, 888 F.2d 1370, 1375 n.1 (Fed. Cir. 1989). According to *Bond*,

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<sup>1</sup> Claim 1 stands rejected only in light of the Swift patent, despite Donaldson's submission of over 1,000 pages of prior art.

[w]hile a "means-plus-function" limitation may appear to include all means capable of achieving the desired function, the statute requires that it be "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

910 F.2d at 833 (emphasis in original). The court in *Bond* vacated the PTO's rejection of the associated claim. *Id.* at 835. The statement quoted above is therefore clearly part of the court's holding. The Solicitor acknowledges that *Bond* is "directly contrary" to the PTO's interpretation of the statute. Solicitor's Responding Brief at 20. The Solicitor argues that the PTO is free to ignore both *Bond* and *Iwahashi* nonetheless because of early precedents of the Court of Customs and Patent Appeals. E.g., *id.* at 28 (citing *In re Lundberg*, 244 F.2d 543 (CCPA 1957)).

The Solicitor's argument in this area is fatally flawed for several reasons. First, his position rests on an overly formalistic view of how common law develops. The Federal Circuit is essentially the PTO's only reviewing court. The PTO is thus bound to apply the relevant law as the Federal Circuit determines it to be. See, e.g., GENIESSE, THE EXAMINATION SYSTEM IN THE U.S. PATENT OFFICE, at 35, PATENT STUDY NO. 29 OF THE SUBCOMMITTEE ON PATENTS, TRADEMARKS AND COPYRIGHT OF THE COMMITTEE OF THE JUDICIARY OF THE UNITED STATES SENATE, 86TH CONG., 2D SESS. (1958); see generally JUDICIAL DEFERENCE, 74 JPTOS \_\_\_\_ (forthcoming June 1992). This Court's current views on means expressions are known: it has at least twice instructed the PTO to adhere to the statutory language. Far from being faithful to the law, the PTO's actions are really a thinly veiled refusal to acquiesce to the authority of this Court.

In addition, the Solicitor's view of the law on this point is wrong even under the extremely rigid view of precedent that he is espousing. "The CCPA's later decisions control because that court always sat *en banc*." *In re Gosteli*, 872 F.2d 1008, 1011 (Fed. Cir. 1989). The CCPA held, in *In re Knowlton*, 481 F.2d 1357 (CCPA 1973), that

[i]f the applicant chooses to use such [means-plus-function] language, the statute instructs the interpreter of the claims, e.g., the Patent Office or the courts, as to how such language shall be interpreted.

*Id.* at 1366 (first emphasis added, second emphasis in original). *Knowlton* is subsequent to, and therefore controls, both of the decisions upon which the Solicitor relies, *Lundberg* and *In re Sweet*,

393 F.2d 837 (CCPA 1968). See Solicitor's Responding Brief at 26-27. Thus, even if the PTO is bound as rigidly to CCPA caselaw as the Solicitor asserts, that law supports Donaldson and not the PTO. See Whitmyer, 74 JPTOS \_\_\_, \_\_\_, nn.21-33 (forthcoming June 1992).

### III. If necessary, this Court should address the PTO's interpretation in banc

As discussed in the preceding section, the PTO's interpretation of section 112 is contrary to already extant, binding precedents of this Court. Any three-judge panel of this Court therefore has both the power and the duty to hold the PTO's rejection of claim 1 to be contrary to law. See generally *South Corp. v. United States*, 660 F.2d 1368 (Fed. Cir. 1982).

Even if the Solicitor's arguments concerning *Lundberg* and *Sweet* were correct, however, it would be clearly in the interests of justice for this Court to consider the matter in banc. Justice certainly requires that Donaldson receive the protections Congress intended to give under the statute. On a broader scale, the PTO's refusal to interpret means expressions as this Court has commanded is causing serious disruptions in practice before the PTO. See, e.g., *In re Akamatsu*, No. 91-3230 (Mar. 20, 1992) (decision of Board of Patent Appeals and Interferences refusing to follow *Iwahashi* and *Bond*), summarized in 44 PTCJ 53 (May 21, 1992); Thomas E. Fisher, COMMENTS ON APPLICATION OF 35 U.S.C. 112 ¶6, 44 PTCJ 46 (May 14, 1992).

This Court, then, should if necessary go in banc to clarify the binding nature of its prior decisions in this area. Such in banc consideration could encompass this entire appeal or, alternatively, be limited to the legal task of interpreting section 112. Cf. *Kingsdown Medical Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 876-78 (Fed. Cir. 1988) (considering portion of appeal in banc).

#### A. The statutory language precludes the PTO's interpretation

The PTO's interpretation of the last paragraph of section 112 is complex. To support it the PTO relies on a variety of

sources, such the weight of its own interpretive decision-making<sup>2</sup>, see, e.g., Solicitor's Responding Brief at 21, and scholarly commentary on the provision. See *id.* at 9, (discussing Federico, COMMENTARY ON THE NEW PATENT ACT, reprinted at 35 U.S.C.A. 1 (1954 ed., West)).

As this Court has recognized, however, "statutory interpretation begins with the language of the statute." *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1579 (Fed. Cir. 1990). If the language is clear and fits the case, the plain meaning of the statute is "conclusive." *Id.* Stated another way, a statutory provision will be interpreted contrary to its plain meaning only on "rare occasions under highly unusual circumstances." *Id.* "Absent extraordinary circumstances," the inquiry into a statute's proper meaning "end[s]" with the statute's plain meaning. *Id.* at 1580.

### 1. The statutory language is mandatory

The language of the sixth paragraph of section 112 falls within the general rule, and not the exception. The language is clear and its meaning is unambiguous. There are no "highly unusual circumstances"<sup>3</sup> present in this case, moreover, and so and the PTO's suggested interpretation must be rejected. The statutory language, for example, directs what a means expression "shall be construed to cover." It does not draw any distinction

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<sup>2</sup> The courts have traditionally given little deference to the PTO's interpretive rulings on matters of pure law. This practice is the better position under modern administrative-law principles, including *Chevron U.S.A. Inc. v. Natural Resources Defense Council*, 467 U.S. 837 (1984). See generally JUDICIAL DEFERENCE, 74 JPTOS \_\_\_ (forthcoming June 1992).

<sup>3</sup> *VE Holding* identifies unusual circumstances as a clearly expressed congressional intent contrary to the plain language of the statute, or a literal meaning of the statute that is so unlikely that Congress could not have intended it. 917 F.2d at 1579-80. Neither circumstance is present in this case. Congress expressed no intent on the issue, see MEANS EXPRESSIONS, 68 JPTOS at 273-78, thus mirroring the facts in *VE Holding*. See 917 F.2d at 1580 ("The legislative history . . . reveals no legislative intent . . ." (emphasis in original))." The benefits inherent in a symmetrical interpretation of the provision, see *supra*, section II.A.; see generally MEANS EXPRESSIONS, 68 JPTOS at 266-68, renders it likely, rather than unlikely, that Congress intended the statutory language to be given its plain meaning.

between patentability, validity, and enforcement. It provides no basis upon which to exclude the PTO from those persons who "shall" apply the statutory direction. See, e.g., *Knowlton*, 481 F.2d at 1366.

2. "Cover" and "construe" do not have the specialized meanings that the Solicitor asserts

Congress' use of the words "cover" and "construe" do not introduce any ambiguity into the statutory language. The Solicitor's speculations concerning those words, in fact, are demonstrably incorrect. Court decisions prove that, at the time the statutory provision governing means expressions was written in 1952, "cover" and "construe" were used commonly to refer to patentability matters. E.g., *In re Kinney*, 168 F.2d 756, 757 (CCPA 1948); *In re Davis*, 164 F.2d 626, 628 (CCPA 1947); *In re Flint*, 150 F.2d 126, 131-32 (CCPA 1945). The PTO, in fact, was using these terms itself in its own administrative adjudications. E.g., *In re Frey*, 182 F.2d 184, 186 (CCPA 1950) (quoting decision of the Patent Office). The presence of these two words in the statutory provision is therefore no reason to believe that Congress intended the PTO's interpretation.

The PTO's use of the statutory terms, in fact, may be more probative than such use by the Supreme Court. The principal author of the statutory language, Pasquale J. Federico, was himself an Examiner-in-Chief of the PTO at the time the statutory provision was written and passed. Solicitor's Responding Brief at 10. See generally, Giles Rich, CONGRESSIONAL INTENT - OR, WHO WROTE THE PATENT ACT OF 1952?, reprinted in Witherspoon, NONOBVIOUSNESS: THE ULTIMATE CONDITION OF PATENTABILITY, 1:1 (1978) (hereinafter "CONGRESSIONAL INTENT").

B. The Solicitor's reliance on legislative reenactment is invalid

According to the Doctrine of Legislative Reenactment, it can be inferred that Congress has approved of an agency interpretation when Congress reenacts the statutory provision at issue without change. See, e.g., 2B Singer, SUTHERLAND ON STATUTORY CONSTRUCTION, § 49.09 (5th ed. 1992). The Doctrine of Legislative Reenactment is limited, however. Applied indiscriminately it would result in finding congressional approval of every agency interpretation each time Congress amends any portion of the agency's governing act. In that broad form the

concept of legislative reenactment would overwhelm the other aspects of judicial review of agency interpretations.

The concept therefore applies only where Congress has expressly approved of the administrative interpretation at issue. See, e.g., *International Union, UAW v. Brock*, 816 F.2d 761, 767 (D.C. Cir. 1987). Thus Congress must have provided an "affirmative indication" of an intent to ratify the interpretation, e.g., *id.*; *Association of American R.Rs. v. ICC*, 564 F.2d 486, 493 (D.C. Cir. 1977), or some other "showing that the attention of Congress was specifically directed to the matter at hand." *Plasterer's Local Union No. 79, AFL-CIO v. NLRB*, 440 F.2d 174 (D.C. Cir. 1970), *rev'd on other grounds*, 404 U.S. 116 (1971).

*American Federation of Labor and Congress of Industrial Organizations v. Brock*, 835 F.2d 912 (D.C. Cir. 1987), illustrates how stringent this requirement is. The issue in *AFL-CIO v. Brock* was whether Congress' amendments to the Immigration and Nationality Act, 8 U.S.C. §§ 1101, *et seq.* (the "Act") legislatively approved the definition by the Department of Labor (the "agency") of whether foreign labor was having an "adverse effect" on domestic wages. The agency had originally adopted both the concept of adverse effect and a definition for it via rulemaking action. Congress' amendments expressly incorporated the concept of adverse effect into the Act, using the agency's own language, but were silent on how the term should be defined. *AFL-CIO v. Brock*, 835 F.2d at 913-14.

Faced with this situation, the District of Columbia Circuit held that Congress had not legislatively approved the agency's definition of adverse effect. *Id.* at 916. In doing so it expressly noted that the party who invoked the concept of legislative reenactment had "offer[ed] no evidence that Congress was even aware of the Department's policy." *Id.*

The Congressional amendments upon which the Solicitor is relying clearly fail to meet this required standard. One amendment added to the second paragraph of section 112 a second sentence that pertained to dependent claims. Act of July 24, 1965, Pub. L. No. 89-83, § 9, 1965 U.S. CODE CONG. & AD. NEWS (79 Stat.) 259. The other amendment replaced that sentence with the present three paragraphs that deal with multiply dependent claims.<sup>4</sup> Act of Nov. 14, 1975, Pub. L. No. 94-131, § 7,

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<sup>4</sup> The Solicitor confuses the substance of these two amendments.



1975 U.S. CODE CONG. & AD. NEWS (89 Stat.) 685, 692. As in *AFL-CIO v. Brock*, there is no indication that Congress considered or was even aware of the PTO's interpretation on either occasion. See, e.g., S. REP. NO. 301, 89TH CONG., 1ST SESS. 1, reprinted in 1965 U.S. CODE CONG. & AD. NEWS 2315, 2319 (referring to Pub. L. No. 89-83); H.R. REP. NO. 592, 94TH CONG., 1ST SESS. 22, reprinted in 1975 U.S. CODE CONG. & AD. NEWS 1220-25, 1241-42 (referring to Pub. L. No. 94-131). In fact, Congress on both occasions addressed aspects of the statute that were far removed from the interpretation that is at issue in this case. Certainly they were much further afield than was the congressional action in *AFL-CIO v. Brock*. The Solicitor does not cite to any supporting evidence.

This same infirmity applies to the Solicitor's attempt to rely on Congress' passage of the Federal Courts Improvement Act in 1982. See Solicitor's Responding Brief at 16. There appears to be no evidence at all that Congress considered the PTO's interpretation as part of its deliberations on the Act. See, e.g., S. REP. NO. 97-275, 97TH CONG., 2D SESS., reprinted at 1982 U.S. CODE CONG. & AD. NEWS 11; H.R. REP. NO. 97-312, 97TH CONG., 1ST SESS. (1981).

The Solicitor has asserted that this difficulty can be overcome via a legal presumption of congressional awareness. Solicitor's Responding Brief at 13. According to that theory, "Congress is presumed to be aware of an administrative or judicial interpretation of a statute." *Id.* In the PTO's eyes, therefore, Congress' silence works in favor of, not against legislative reenactment.

This is incorrect as well. The United States Court of Appeals for the District of Columbia Circuit, in fact, has expressly rejected this exact argument on numerous occasions. E.g., *General American Transportation Corp. v. ICC*, 872 F.2d 1048, 1053 (D.C. Cir. 1989); *AFL-CIO v. Brock*, 835 F.2d at 916 n.6. "[The rule of implied adoption of an agency interpretation on reenactment] does not apply where nothing indicates that the legislature had its attention directed to the administrative interpretation upon reenactment." 2B C. Sands, *SUTHERLAND ON STATUTORY CONSTRUCTION*, § 49.09, at 400 (4th ed. 1984) (cited with approval in *AFL-CIO v. Brock*, 835 F.2d at 916 n.16). The two legal rules that the Solicitor is seeking to combine arise from different policies and cannot be joined in the manner that he suggests.

**C. Mr. Federico's commentary does not support the PTO**

The PTO has traditionally relied upon the statements of Mr. Federico in his COMMENTARY ON THE NEW PATENT ACT, reprinted at 35 U.S.C.A. 1, 26, as authority for its interpretation of the sixth paragraph of section 112. See Solicitor's Responding Brief at 9. With all respect to Mr. Federico, however, the PTO is relying upon his commentary for more support than it can give. Mr. Federico was an employee of the United States Patent Office; he was not an elected member of Congress. See generally CONGRESSIONAL INTENT at 1:3-5. As a result, his writings shed little or no light on the mental state of the elected members of Congress. See generally MEANS EXPRESSIONS, 68 JPTOS at 275-76. His own intentions concerning the statutory language are not particularly relevant. *Id.*

There are indications, in fact, that Mr. Federico himself would have objected to the PTO's current attempts to rely on his commentary. He cautions in his commentary, for example, that

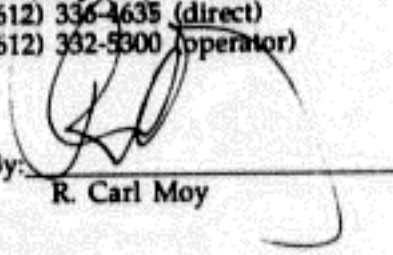
[i]n such an extended discussion it is obviously impossible to avoid expressions . . . of personal opinion and it should be understood that the paper contains some opinions and views of the writer although not always labelled as such.

Federico, 35 U.S.C.A. at 2. He candidly admits that his commentary is itself a consolidation of speeches he gave *after* the passage of the 1952 Patent Act. *Id.* at 1-2. Congress therefore cannot have relied upon the commentary when voting on the Act. See generally MEANS EXPRESSIONS, 68 JPTOS at 275-76. Even Mr. Federico's own language is equivocal, and no other known source bearing on Congress' intent supports the PTO's interpretation. *Id.*

**IV. Conclusion**

For the foregoing reasons, as well as those expressed in Donaldson's Lead Brief, Donaldson asks that the PTO's rejection of Claim 1 be reversed.

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