

APPELLEE'S

BRIEF

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THE FEDERAL CIRCUIT

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BRIEF FOR APPELLEE
COMMISSIONER OF PATENTS AND TRADEMARKS FRANCIS X. GINDHART
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UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT

91-1386

In re DONALDSON COMPANY, INC.

Appeal from the Board of Patent
Appeals and Interferences

Reexamination No. 90/001,776
of U.S. Patent No. 4,395,269

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Rule 47.5 Statement of Related Cases

No other appeal from the Board of Patent Appeals and Interferences in connection with the reexamination or patent on appeal has been previously before this or any other court.

The only known related pending case would be In re Nettle, Federal Circuit Appeal No. 91-1398. That appeal could be considered related in that it involves the same issue as Issue 2 in the present appeal. The panel in In re Nettle consists of Circuit Judge Archer, Senior Circuit Judge Smith, and Circuit Judge Lourie.

Rule 47.6 Jurisdictional Statement

(a) The Board of Patent Appeals and Interferences had jurisdiction under 35 U.S.C. §§ 134 and 306.

(b) This Court has jurisdiction under 35 U.S.C. §§ 141 and 306 and 28 U.S.C. § 1295(a)(4)(A).

(c) The action of the Board of Patent Appeals and Interferences on request for reconsideration was entered on April 17, 1991. The time for appeal is two months. 35 U.S.C. § 142 and 37 CFR § 1.304(a). The notice of appeal was timely filed on June 6, 1991.

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STATEMENT OF THE ISSUES

Commissioner disagrees with Donaldson's statement of the issues. Commissioner believes the issues are (1) did the Board clearly err in finding that Swift's hopper walls are responsive to pressure increases caused by jet-cleaning pulses and move particulate matter in a downward direction to a bottommost point and (2) if not, did it err in interpreting 35 U.S.C. § 112's sixth paragraph?

STATEMENT OF THE CASE

Commissioner considers Donaldson's statement incomplete and inaccurate in the following respects.

I. The Claim Language

With numerals added to refer to Donaldson's Figure 2 (A70) reproduced on the facing page, claim 1 reads (A12):

1. An air filter assembly 10 for filtering air laden with particulate matter, said assembly 10 comprising:

a housing having a clean air chamber 60 and a filtering chamber 22, said housing having an upper wall 16, a closed bottom 26, and a plurality of side walls 17, 62 depending from said upper wall 16;

a clean air outlet 64 from said clean air chamber 60 in one of said side walls 62;

a dirty air inlet 20 to said filtering chamber 22 positioned in a wall 16 of said housing in a location generally above said clean air outlet 64;

means 28 separating said clean air chamber 60 from said filtering chamber 22 including means mounting a plurality of spaced-apart filter elements 32 within said filtering chamber 22, with each of said elements 32 being in fluid communication with said air outlet 64;

pulse-jet cleaning means 65, intermediate said outlet 64 and said filter elements 32, for cleaning each of said filter elements 32; and

a lowermost portion 25 in said filtering chamber 22 arranged and constructed for the collection of particulate matter, said portion 25 having means 24, responsive to pressure increases in said chamber 22 caused by said cleaning means 65, for moving particulate matter in a downward direction to a bottommost point 68 in said portion 25 for subsequent transfer to a location exterior to said assembly 10.

Fig. 1

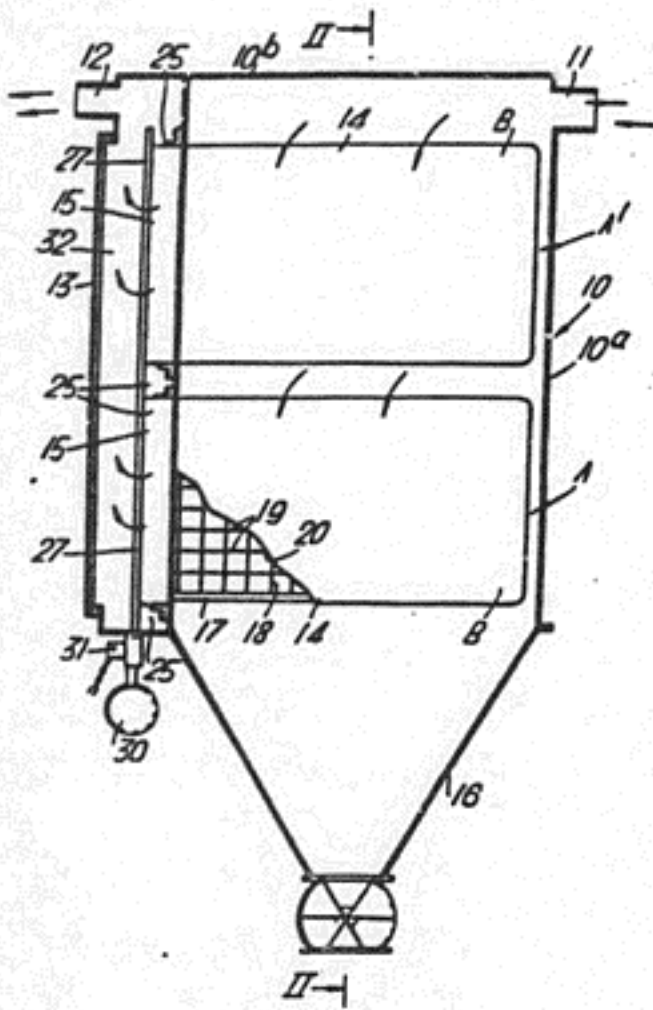
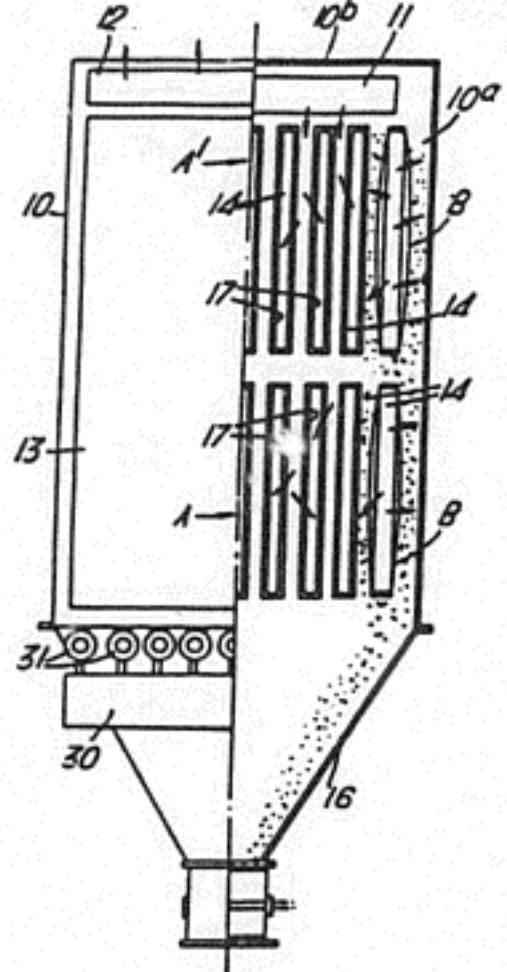


Fig. 2



II. The Reference

The Board held (A5-6) claim 1 obvious in view of U.S. patent 3,421,295 to Swift (A82-88).

With reference to Swift's Figures 1 and 2 (A92-83) reproduced on the facing page, Swift discloses an air filter assembly differing from Donaldson's disclosed invention in only two relevant aspects. First, Swift's dirty air inlet 11 is not positioned in a location above the clean air outlet 12. Donaldson has not argued that such a difference would have been unobvious. Second, Swift's hopper 16 is not shown to be flexible. It is Commissioner's position that the second difference is recited only in allowed claims and not in rejected claim 1.

Swift teaches pulse-jet cleaning means using pulses of compressed high energy gas having sufficient energy to immediately counteract the energy and pressure producing and normally maintaining the filtering flow (A86, column 1, lines 44-52). Swift's Figure 2 illustrates particulate matter being jet-cleaned, from spaced-apart filter elements 14, in the direction of the arrows and then moving down along means 16 to a bottommost point.

III. Prosecution In The Patent And Trademark Office

In its Request For Reexamination, Donaldson conceded that "the pulse emitted during the pulse-jet cleaning of a filter element causes some amount of vibration throughout the dust collector" (A21, paragraph 6). In its Appeal Brief to the

Board, Donaldson admitted that vibrations of jet-cleaning pulses can be "quite violent" (A61, lines 21-23). Donaldson also admitted in its Appeal Brief to the Board that vibrations, induced by vibrators, were known to shake particulate matter from hopper walls (A63).

The Examiner found that Swift's hopper is constructed and arranged to move particulate matter downwardly responsive to pressure increases from pulse jet cleaning means, i.e., that Swift's high-pressure pulses introduce vibration into Swift's hopper walls 16 (A45, lines 8-11). The Board agreed with the Examiner, without going into details (A5).

SUMMARY OF ARGUMENT

PTO's findings, that Swift's hopper is responsive to pressure increases caused by jet cleaning means and that it moves particulate matter downward, were not clearly erroneous. If the issue is reached, PTO correctly interpreted 35 U.S.C. § 112's last paragraph.

ARGUMENT

I. Standard Of Review

Donaldson has the burden of establishing that the Board's fact findings are clearly erroneous or that the Board committed an error of law, In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985), In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986), and that such error was harmful, 28 U.S.C. § 2111 (1982).

In Issue 1, Donaldson rests its challenge (Br6, lines 1-5) on a finding of fact, viz. (A5):

we are convinced that hopper 16 of the gas filtering apparatus of Swift is "responsive" to pressure increases in the apparatus caused by the jet-cleaning means whereby filtered particulate matter is caused to move in a downward direction.

Thus, Donaldson must show clear error in order to prevail on Issue 1.

Issue 2 is not reached unless Donaldson failed to carry its burden on the first issue. If it is reached, Issue 2 presents a holding of law in which Donaldson must show error.

II. Issue 1: The Board's Findings Regarding Swift Were Not Clearly Erroneous

A. Donaldson Conceded That Hopper Walls Vibrate In Response To Cleaning Pulses

As set forth above, Donaldson admitted that hopper walls vibrate quite violently in response to pressure pulses (A61). Swift's jet-cleaning pressure pulses have high energy (A86, column 1, lines 50-52). Thus, the finding that Swift's hopper walls respond (by vibrating) to pressure increases caused by jet-cleaning was not clearly erroneous.

B. Donaldson Conceded That Vibrating Hopper Walls Can Move Particulate Matter Downward

As set forth above, Donaldson admitted that vibrating hopper walls can move particulate matter downward (A63). That admission was made in the context of separate vibrators to induce additional vibrations. However, Donaldson's appealed claim does not require a large amount of response or of

consequent particulate migration (A12). Therefore, Donaldson's arguments (Br5-6) that prior hoppers did not "reliably" move particulates downward, do not show clear error in the Board's finding that they did move (at least some) particulates downward.

C. Even If Swift's Vibrations Do Not Cause Particulate Matter To Move Downward, Swift's Sloping Walls Do

In its Request For Reconsideration, Donaldson argued (A118):

it is apparent from Swift that the hopper structure, to the extent that it does function to move collected dust downward, does so completely independently of the cleaning pulses.

However, claim 1 does not require the means to move particulate matter in response to pressure increases (A12).

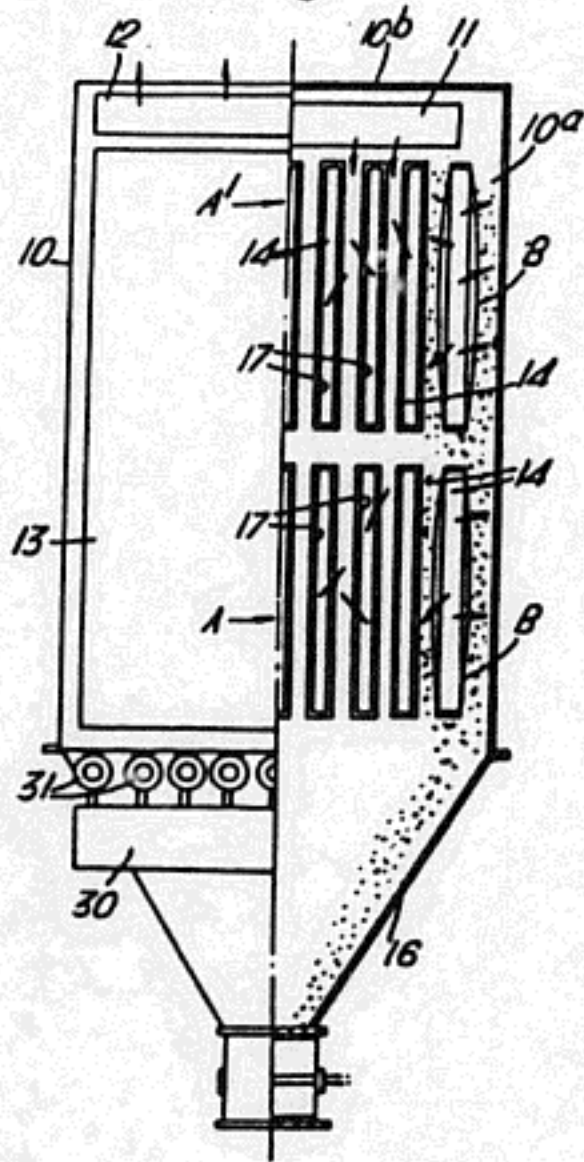
Claim 5, in contrast, specifies that (A75):

the filtered particulate matter is caused to move downwardly for collection by the flexing of said sloping surface in response to the increases in pressure within said filtering chamber caused by the operation of said pulse-jet cleaning means.

Claim 1 merely requires the means to both move particulate matter and be responsive to pressure increases (A12). See In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984) (claims subject to reexamination must be given their broadest reasonable interpretation).

As set forth above, Swift's means 16 responds by vibrating.

Fig. 2



As shown by the falling particulate matter in Figure 2 reproduced on the facing page, Swift's means 16 moves particulate matter downward toward a bottommost point by virtue of being slanted toward a bottommost point (A83). As noted in Swift's specification (A88, column 5, lines 45-47):

The heavier particles of dust fall under the influence of gravity into the hopper 16 being assisted in this fall by the downward flow of gas through the pads.

Thus, the slanted walls of Swift's hopper 16, in conjunction with gravity, move particulate matter downwardly towards a bottommost point.

III. Issue 2: The Board Did Not Err In Interpreting 35 U.S.C. § 112's Last Paragraph

Commissioner's position on 35 U.S.C. § 112's final paragraph is set forth in section A, *infra*, identically as published in a Commissioner's Notice of December 13, 1991, "Applicability Of The Last Paragraph Of 35 U.S.C. § 112 To Patentability Determinations Before The Patent And Trademark Office," 1134 Off. Gaz. Pat. Office 631 (Jan. 7, 1992).

Application to the present case is discussed in section B.

A. Applicability Of The Last Paragraph Of 35 U.S.C. § 112 To Patentability Determinations Before The Patent And Trademark Office

The following paragraph was first enacted in 1952 as the third paragraph of 35 U.S.C. § 112:

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.

Act of July 19, 1952, ch. 950, 66 Stat. 798-99. The scope of a "means" in a claim undergoing a patentability determination over the prior art in the Patent and Trademark Office (PTO) is a function of (1) whether § 112's last clause ("and such claim shall be construed to cover . . .") applies and (2) if so, how. It is the position of PTO that the clause does not apply.

1. Applicability Of § 112's Last Clause

The applicability of the last clause to ex parte patentability determinations vis-a-vis the prior art is resolved by examining the statutory language, legislative history, CCPA decisions, long-standing PTO interpretation, legislative reenactment, and Federal Circuit cases.

(a) History Of The Legislation, PTO Interpretation, and CCPA Precedent

The last clause of section 112's last paragraph states that means-plus-function claims "shall be construed to cover the corresponding structure material, or acts described in the specification and equivalents thereof." Act of July 19, 1952,

ch. 950, 66 Stat. 798-99. Commentary concerning that clause as enacted in 1952 states that the clause:

relates primarily to the construction of such claims for the purpose of determining when the claim is infringed (note the use of the word "cover"), and would not appear to have much, if any, applicability in determining the patentability of such claims over the prior art, that is, the Patent Office is not authorized to allow a claim which "reads on" the prior art.

P. J. Federico, "Commentary on the New Patent Act," 35 U.S.C.A. 1, 25-26 (1954). Federico's passage notes that "cover" refers to infringement, and contrasts claim "construction," done for infringement purposes, with PTO patentability determinations. Id. Federico assisted in drafting of Act and was regarded as an expert in the subject-matter of the Act. Report Of The Committee On The Judiciary, H.R. 7794, reprinted at 34 J. Pat. Off. Soc'y 549, 552 (1952). Federico's contemporaneous commentary accompanying the new statute in U.S.C.A. deserves consideration as showing the last clause was intended to affect infringement cases and not to affect PTO ex parte patentability determinations vis-a-vis the prior art.

Similarly, Charles J. Zinn's contemporaneous commentary says:

The final paragraph of section 112 relating to functional claims is new. It recognizes the validity of combination claims wherein the novelty is expressed in functional terms. It offsets the theory of the Halliburton case but does not go so far as to permit the use of single means claims.

Commentary on New Title 35, U.S. Code "Patents," reprinted in 1952 U.S. Code Cong. and Ad. News 2509, 2514 (emphasis added). Zinn's passage notes the final paragraph's effect on claim validity (a post-issuance, court-determined matter) but not on patentability (a pre-issuance, PTO-determined matter). Id. It also notes that the final paragraph addressed Halliburton Co. v. Walker, 329 U.S. 1 (1946). Halliburton involved infringement/validity, not ex parte patentability. Id. Zinn, as the Judiciary Committee's law revision counsel, directed and supervised the actual work of preparing the preliminary drafts and the bill that became Title 35. Report Of The Committee On The Judiciary accompanying H.R. 7794, reprinted at 34 J. Pat. Off. Soc'y 549, 552 (1952). Thus, Mr. Zinn's insight is consistent with the proposition that the third paragraph of § 112 affects validity but not ex parte patentability determinations.

Less than six months after the effective date of the 1952 act, an eight-member panel of the Board of Appeals decided Ex Parte Ball, 99 USPQ 146 (Bd. Pat. App. 1953). The eight-member panel in Ex Parte Ball included then Commissioner of Patents Watson, as well as Examiner-in-Chief Federico. Ball contended that:

each of the appealed claims distinguishes from the prior art in the recitation of a means or an elemental structure for performing a specified function that is not contemplated by the cited references . . .

Id. at 148. Before enactment of § 112's last paragraph, the Board had sustained rejections of Ball's claims because, comparing the claim language to the prior art, "any differences which exist are only functionally expressed" in the claims.

Id.

After enactment, the Board withdrew that position on reconsideration, apparently due to the first clause of § 112's last paragraph: "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" The Board reversed rejections of those claims that recited a novel function:

this function, as set forth, is distinctly unlike any function which is or could possibly be performed by the apparatus of [the prior art].

Id. at 148-49.

However, the Board sustained rejections of the claims (e.g. claim 39) whose recited function was performed by the prior art. Id. at 150. The Board reasoned that despite the last clause ("and such claims shall be construed to cover . . .") of § 112's last paragraph, the claims in a pending application would be controlled by § 112's second paragraph, requiring the language itself of a claim to particularly point out the novel subject matter. Id. The dominance of the second paragraph over the third was simultaneously stated in dictum in In re Arbeit, 206 F.2d 947, 958, 99 USPQ 123, 131 (CCPA 1953). Similar statements have

appeared in all eighty-five subsequent editions of the Manual of Patent Examining Procedure (MPEP), from 1955 to present, specifically referring to Ex Parte Ball. MPEP § 706.03(c).

In 1957, the CCPA squarely held that the last clause of § 112's last paragraph ("and such claim shall be construed to cover . . .") does not apply to PTO's patentability determinations. In re Lundberg, 244 F.2d 543, 548, 113 USPQ 530, 534 (CCPA 1957). The CCPA stated:

notwithstanding the third [now sixth] paragraph of section 112, it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of a detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim.

Id. That holding was central to the CCPA's judgment affirming PTO's rejection of claim 54:

It is thus apparent that [prior art] either expressly discloses or reasonably would suggest to one skilled in the art, each element in the claimed combination, including the recited function of the detecting instrument. In view of our foregoing analysis of 35 U.S.C. § 112, it is not seen that claim 54 patentably defines over the prior art. We accordingly sustain the board's rejection of this claim.

Id., 244 F.2d at 550, 113 USPQ at 536.

Following the CCPA's 1957 Lundberg decision, in 1965 Congress reenacted the "third" paragraph of § 112 (1952) as

the "sixth" paragraph of § 112. Pub. L. 89-83, § 9, 79 Stat. 261 (1965). In enacting Public Law 89-83, Congress saw no reason to disagree with the Lundberg and PTO interpretations: that the last clause does not apply in proceedings before PTO to determine whether claimed subject matter is patentable over the prior art under 35 U.S.C. §§ 102 or 103. See Lorillard v. Pons, 434 U.S. 575, 580 (1978) ("Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change"); Atkins v. United States, 556 F.2d 1028, 1039 (Ct. Cl. 1977), cert. denied, 434 U.S. 1009 (1978) ("A cardinal principle of statutory interpretation is that, in the absence of a clearly expressed intent to the contrary, the revision or recodification of a statute indicates approval of court interpretations of the statute made prior to reenactment"). Upon reenactment, Congress did not in any way express disapproval of the PTO/CCPA means-plus-function interpretation as applied to ex parte examination.

In 1968, the CCPA in deciding In re Sweet, 393 F.2d 837, 841-42, 157 USPQ 495, 499 (CCPA 1968) noted, consistent with Lundberg and PTO's now well-established interpretation of the "third/sixth" paragraph of § 112, that:

However, a recitation of "means" for performing a function is interpreted broadly to cover all means capable of performing the stated function and is not limited to the particular structure which the application may disclose.

The CCPA affirmed as to those claims where the claimed function was obvious from the prior art, but reversed where the function was not disclosed or otherwise made obvious (i.e., claim 17). Id., 393 F.2d at 842-3, 157 USPQ at 500.

In 1975, Congress again reenacted the "sixth" paragraph of § 112. Pub. L. 94-131, § 7, 89 Stat. 690-91 (1975). Despite a second amendment of § 112, Congress again declined to legislatively overrule the CCPA/PTO interpretation of the "third/sixth" paragraph of § 112, as applied to patentability determinations of claims pending before PTO vis-a-vis the prior art. See Ralden Partnership v. United States, 891 F.2d 1575, 1579 (Fed. Cir. 1989) (an inference can be drawn that Congress acquiesced in agency interpretation of statute twice reenacted). Only Congress can "un-adopt" that interpretation.

The last clause of § 112's last paragraph was consistently interpreted by the CCPA and PTO up to the time of the creation of the Federal Circuit. The PTO has now employed that interpretation without difficulty for thirty-eight years, a period in which PTO has issued over 2,436,000 patents.

There is no question that, both prior to and after creation of the Federal Circuit, courts of appeals applied the last clause of § 112's last paragraph in infringement cases. It is also true that the last clause was not applied during PTO patentability determinations. But that is exactly what PTO believes Congress intended. In this respect, over 30 years of experience from 1952 to 1983 provides a certain "comfort

level." Patent practitioners generally understand how the last paragraph of § 112 was, and is, applied by PTO to determine whether means-plus-function limitations differ from the prior art.

Until creation of the Federal Circuit, the CCPA applied the Lundberg rationale to claims undergoing patent examination and courts of appeals applied the last clause of § 112's last paragraph in infringement cases. Nothing in the Federal Courts Improvement Act of 1982, Pub. L. 97-164, Title I (1982), was intended to change the manner in which the Federal Circuit was to deal with interpretation of claims during examination or construction of claims in infringement cases.

(b) Federal Circuit Treatment

The "sixth" paragraph of § 112 was consistently interpreted and applied by the CCPA and PTO up to the time of the creation of the Federal Circuit. However, it has been inconsistently interpreted by the Federal Circuit. Insofar as PTO is aware, In re Mulder, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983), represents the first arguable departure from Lundberg. The Mulder court said:

With respect to claim 9, we note that it is drafted in "means plus function" format, so that it is "construed to cover the corresponding structure * * * described in the specification and equivalents thereof." 35 U.S.C. § 112. As stated above, the board said that de Troye's arrangement constituted means to reduce input series resistance. Appellants have neither asserted nor shown that de Troye's structure is not the equivalent of the structure disclosed in their specification for reducing input series resistance.

The Mulder Board said what it said because it found de Troye to disclose the function. Hence, consistent with long-standing practice, it made no inquiry into the equivalency of the structures of the reference and Mulder. One might assume that appellants (Mulder) did not present a non-equivalence argument, because then well-established Lundberg/Sweet principles would have rendered such an argument futile.

In June of 1986, a journal article questioned whether PTO was properly applying the sixth paragraph of § 112 in resolving §§ 102/103 issues. Moy, "The Interpretation of Means Expression During Examination," 68 J. Pat. Off. Soc'y 246 (1986). Moy acknowledges the existence of, and discusses, published (precedential) and unpublished (unprecedential) ex parte CCPA/Federal Circuit decisions which support PTO's view. Id. at 256-9. Moy thinks that it is wrong for PTO to confine its examination of means-plus-function clauses to simply whether the identical function is performed. However, Moy does not address whether Congress' two reenactments of the means-plus-function provisions of § 112 constitute legislative adoption of PTO's interpretation of the sixth paragraph based on Lundberg. Nor does Moy point to anything in the Federal Courts Improvement Act which suggests that the newly created Federal Circuit was no longer to apply Lundberg.

Non-precedential Federal Circuit opinions have applied the Lundberg rule. See, e.g., In re Boersma, No. 84-627 (Fed. Cir.

May 4 1984) (unpublished [¹]), summarized at 28 Pat. Tm & Copyrt. J. 83 (BNA May 24, 1984). Lundberg was addressed in concurring opinions of In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). Queener argued that PTO erroneously refused to apply the last clause of § 112's last paragraph. The Court affirmed without reaching Queener's argument, explicitly indicating that it "need not, and does not" reach other matters, "including those pertaining to the 'means plus function'" Id., 796 F.2d at 464, 230 USPQ at 440. Senior Judge Miller, concurring, suggested that Queener's argument "is reasonable and should not be rejected out of hand or ignored by the majority and Judge Newman's concurring opinions." Id. Judge Newman separately concurred, citing Lundberg and noting:

[I]n view of Senior Judge Miller's interpretation of precedent to hold that the last paragraph of section 112 is reasonably applied, in prosecution before the PTO, so that the claims need not distinguish from the prior art, I write separately to express my concern lest we reopen that closed book. It is now beyond debate that limitations from the specification will not, during examination before the PTO, be imputed to the claims in order to avoid prior art; such limitations must be specifically stated in the claims. . . This law has been consistently applied.

Id., 796 F.2d at 464, 230 USPQ at 440.

In 1989, a Federal Circuit panel decided In re Iwahashi, 888 F.2d 1370, 1375 n.1, 12 USPQ2d 1908, 1912 n.1 (Fed. Cir.

¹ Note that, pursuant to Fed. Cir. Rule 47.8(c), this case is not being cited as precedent. Rather, this non-precedential case is referred to as historical context.

1989). In re Iwahashi involved a § 101 rejection, not a rejection based on the prior art. Under In re Meyer, 688 F.2d 789, 796 n. 6, 215 USPQ 193, 199 n.6 (CCPA 1982), equivalence under § 112's last paragraph is applicable to § 101 rejections, but not to rejections based on the prior art. The Iwahashi panel did not explicitly recognize the Meyer distinction.

Iwahashi note 1 refers to a statement of law in In re Sweet, supra, to the effect that "means" for performing a function is interpreted broadly to cover all means capable of performing the stated function and is not limited to the particular structure which the application may disclose. Note 1, however, disagrees with the "truth" (correctness) of Sweet's statement of law. Note 1 says that the statement is partly true and partly untrue. The untrue part is said to be the first part, i.e., that means is interpreted to cover all means for performing the function. According to the note, the first part of the statement should have said that the means is interpreted as limited to the means disclosed in the specification and all equivalents thereof which perform the function.

"The immediately preceding two paragraphs" of the Sweet opinion, i.e., those appearing at 393 F.2d at 841, col. 2, 157 USPQ at 499, col. 1-2, are said to demonstrate that Sweet considered equivalence of structure under the last paragraph

of § 112. In re Iwahashi, supra. PTO does not believe that the "two paragraphs" demonstrate what the footnote says.

The Iwahashi footnote warns against removing the disputed statement of law from its context. The disputed statement of law in In re Sweet related to different claim language than did the two paragraphs. In volume 393 of the F.2d reporter, the two paragraphs related only to the function discussed on pages 840-41, whereas the disputed statement of law related only to the discussion of the whereby clause on page 842.

The two paragraphs dealt with whether the reference had a means to perform the claimed function "to simultaneously change the position of said cutting elements for cutting a different size diameter." In re Sweet, supra, 393 F.2d at 841, 157 USPQ at 499. The only precedent cited in the two paragraphs, In re Danly, 263 F.2d 844, 847 120 USPQ 528, 531 (CCPA 1959), also dealt only with whether a reference exhibited "actual performance of the stated functions," as those functions were interpreted.

The disputed statement of law, however, dealt with whether the whereby clause (whereby said cutting elements will "cut at substantially the same distance from the center of rotation on said different size diameter") required that the cutting elements be in alignment with radii of the workpiece. In re Sweet, supra, 393 F.2d at 842, 157 USPQ at 499-500. Since the language itself of the claim did not require such alignment,

the CCPA refused to read it into the claim. Id. at note 6 and accompanying text.

In 1990, a Federal Circuit panel decided In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Without citing Lundberg, that panel made a statement directly contrary^[2] to Lundberg regarding a pending claim:

While 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." 35 U.S.C. § 112 ¶ 6 (emphasis added);

In re Bond, 910 F.2d at 833, 15 USPQ2d at 1568. The panel remanded to the Board because the Board had not determined equivalence under § 112 ¶ 6. The Board had not done so because

² See Fisher, Thomas E., "Comments On Application Of 35 USC 112¶6," 44 PTCJ 46, BNA May 14, 1992, for printed commentary, criticizing the Commissioner's O.G. Notice. Fisher asserts that Lundberg and Bond are rationalizable. PTO submits that a comparison of those cases shows that they are not rationalizable. Lundberg held that a means clause can not "include the limitations which comprise said means and which are set forth [only] in the disclosure." Lundberg, supra, 244 F.2d at 547, 113 USPQ at 533. Bond, on the other hand, applied § 112's last paragraph ("structure . . . described in the specification") to a pending means claim. Bond, supra, 910 F.2d at 833, 15 USPQ2d at 1568.

it was (and is) the PTO's position that the last clause does not apply to pending applications.

(c) Mandatory Authority

The following mandatory authority forecloses PTO interpretation of pending means claims as limited to structure, material, or acts described in the specification and equivalents thereof under 35 U.S.C. § 112.

Supreme Court cases hold that an agency's consistent long-standing interpretation of a statute is entitled to deference. Chevron U.S.A. Inc. v. Natural Resources Defense Council, 467 U.S. 837, 843-45, reh'g denied, 468 U.S. 1227 (1984); United States v. Clark, 454 U.S. 555, 565 (1982); FEC v. Democratic Senatorial Campaign Committee, 454 U.S. 27, 32 (1981). In FEC, the Court of Appeals had struck down an agency interpretation of a statute. The Supreme Court reversed because the agency's interpretation was within its authority rather than frustrative of the policy Congress sought to implement or "inconsistent with the statutory mandate." FEC, supra.

As set forth above, the PTO has consistently and historically interpreted the last clause ("and shall be construed to cover . . .") as inapplicable to pending applications. In re Queener, 796 F.2d 461, 464, 230 USPQ 438, 440 (Fed. Cir. 1986) (Newman, J., concurring); Moy, "The Interpretation Of Means Expressions During Prosecution," 68 J. Pat. Tm. Off. Soc'y. 246, 251 (1986). Thus, PTO's

interpretation of the last clause of § 112's last paragraph is not easily overcome. In fact, application of the last clause to applications pending before the PTO is foreclosed by (1) the clause itself, (2) binding precedent, and (3) Congressional re-enactment.

(1) The Clause Itself

As discussed below, the Supreme Court used the terms "construed" or "cover" around 1952 when referring to post-issuance matters in court (e.g., validity or infringement), and not to interpretation of claims by the PTO in a patentability determination. Therefore, it is reasonable to conclude that a 1952 statute that used either of those terms referred only to matters in court, not in the PTO. Since the last clause of § 112's final paragraph used (A) "construed" and (B) "covered" in the same phrase "construed to cover" it must have referred only to infringement cases in court. Use of the term (C) "equivalents" further indicates that a court, not a PTO, determination is called for. The combined import of all three terms is clear.

(A) "construed"

The Supreme Court has used "construed" only to refer to post-issuance court matters and not to PTO patentability determinations. See, e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 336 U.S. 271, 276-77 (1948), aff'd on reh'g, 339 U.S. 605 (1950), reh'g denied, 340 U.S. 845 (1950). The Supreme Court's usage just prior to the 1952 enactment is

especially relevant to the meaning attributed to "construed" in the 1952 Act. The last paragraph of § 112 was enacted in response to then-recent Supreme Court precedent. *Federico, supra*; *Zinn, supra*.

In *Graver Tank*, the Supreme Court reversed the Court of Appeals for erroneously importing limitations from the specification into the claims. *Graver Tank*, 336 U.S. at 276-77. The relevant passage dealt with a district court's holding invalid certain claims asserted in an infringement action:

The Court of Appeals [erroneously] considered that because there was nothing in the record to show that the applicants for the patent intended by these claims to assert a monopoly broader than nine metallic silicates named in the specifications, the [district] court should have construed the claims as thus narrowed and limited by the specifications.

Id. Because of the similar topic of that passage, and because *Graver Tank* was the seminal case on equivalents, Congress' usage of "construed" four years later in the last clause of § 112's last paragraph was predictably consistent with that passage. Claims were "construed" by courts.

As another example, in *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 149 (1950), *reh'g denied*, 340 U.S. 918 (1951), the Supreme Court applied § 112's precursor in an infringement case. The Court found clearly

erroneous a district court's "construction" of an asserted claim because the limitation relied on was:

not mentioned in the claims, except, perhaps, by a construction too strained to be consistent with the clarity required of claims which define the boundaries of a patent monopoly.

Id. Claims were "construed" by courts.

The Federal Circuit's usage of "construe" is not especially probative of legislative intent because it is well after the 1952 enactment. However, when addressing why PTO's standards for patentability should be stricter than a district court's standards for validity, the Federal Circuit distinguishes between claims being "construed" by district courts, and "interpreted" or the like by the PTO. See, e.g., In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984); see also In re Etter, 756 F.2d 852, 858-59, 225 USPQ 1, 5-6 (Fed. Cir.) (in banc) (rule of claim "construction" has no role in PTO reexamination), cert. denied, 474 U.S. 828 (1985). Similarly, in Burlington Indus. v. Quigg, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987), the court stated:

Issues of judicial claim construction such as arise after patent issuance, for example during infringement litigation, have no place in prosecution of pending claims before the PTO . . .

Thus, the last clause of § 112's last paragraph has no place in prosecution of pending claims before the PTO under § 102 or § 103.

(B) "cover"

Federico's above-quoted statement reveals that the word "cover" in § 112 is used to connote an infringement context. No known Supreme Court precedent uses the word "cover" in an ex parte patentability case.

(C) "equivalents"

Section 112's reference to "equivalents" indicates an infringement, not prosecution, setting. Compare Graver Tank & Mfg. Co., supra, 339 U.S. at 610 ("equivalence. . . is to be decided by the trial court."). "Equivalents" under § 112 speaks solely to infringement; is judicially, not administratively, determined; and involves redefining issued claims:

exists solely for the equitable purpose of "preventing an infringer from stealing the benefit of an invention". . . equivalency is judicially determined by reviewing the content of the patent, the prior art, and the accused device, and essentially redefining the scope of the claims.

Texas Instruments, Inc. v. United States I.T.C., 805 F.2d 1558, 1572, 231 USPQ 833, 842 (Fed. Cir. 1986), reh'g denied, 846 F.2d 1369, 6 USPQ2d 1886 (Fed. Cir.), reh'g denied, 7 USPQ2d 1414 (Fed. Cir. 1988) (in banc). The inclusion of "equivalents" in § 112's last paragraph appears to address concerns of Halliburton Co. v. Walker that dealt only with potential infringers. Halliburton, supra, 329 U.S. at 12-13.

(2) Binding Precedent

As a CCPA case, Lundberg is binding precedent. South Corp. v. United States, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc).

The Lundberg case cannot be distinguished on the grounds that no appealed claims were held patentable. The CCPA did not decide whether the disclosed means would have been obvious if incorporated into a claim. Lundberg, supra, 244 F.2d at 551, 230 USPQ at 537.

The Lundberg case cannot be distinguished as one in which the applicant urged limitation of a claim to the disclosed means only exclusive of equivalents. The CCPA held that a function clause cannot be used to incorporate any limitations whatsoever into an applicant's claims, id., and that limitations not included in the language itself of the claims cannot impart patentability, id., 244 F.2d at 548, 113 USPQ at 534. It is irrelevant to those holdings whether attempted limitations would come from the disclosed means or from its equivalents. The CCPA noted that § 112 required means-plus-function claims to be "construed to cover the corresponding structure, * * * described in the specification and equivalents thereof." Id., 244 F.2d at 546, 113 USPQ at 533 (emphasis added).

In his brief, Lundberg repeatedly argued for limitation to means "described in the specification, and equivalents thereof." Lundberg's Brief For Appellants, pages 9, 14, 35,

and 38 (emphasis added) [A171, A176, A197, and A200]. Lundberg implicitly argued that the prior art was not the same as, or equivalent to, the means described in his specification.

For example, Lundberg quoted his specification's detailed description of claim 54's detecting means. Lundberg's Brief at 33-34 [A195-96]. Lundberg argued that the Board had erred in saying that the prior art means was the same. Lundberg's Brief at 34 [A196]. Lundberg argued further that the prior art means was not equivalent to Lundberg's disclosed means in that he argued the prior art distinguished itself from the type of detector means (a detector of one or more components of magnetic field) disclosed in Lundberg's specification. Lundberg's Brief at 35 [A197]. Lundberg cited record page 210 showing that the prior art distinguished itself from the type of detector means disclosed in Lundberg's specification. Lundberg's Brief at 35 [A197]. Lundberg concluded that section of argument citing the 1952 Patent Act as requiring limitations "described in the specification and equivalents therefor [sic, thereof]." Lundberg's Brief at 35 [A197].

As another example, Lundberg argued that claim 54's airplane means for transporting referred to aircraft capable of the type of movement "repeatedly set forth in the present application" which he alleged was not even along the lines of the prior art's contemplation. Lundberg's Brief at 24-26 [A186-88].

(3) Congress'
Reenactments

Acts of Congress are mandatory authority. As discussed above, Congress' reenactments implicitly adopted and re-adopted the PTO/CCPA interpretation.

(d) Effect of Federal Circuit
Panel Decisions

Without addressing In re Lundberg, Federal Circuit panels have made statements contrary to the above statement of mandatory authority, viz., In re Bond, 910 F.2d 831, 833, 835, 15 USPQ2d 1566, 1568, 1569 (Fed. Cir. 1990), and arguably In re Iwahashi, 888 F.2d 1370, 1375 n.1, 12 USPQ2d 1908, 1912 n.1 (Fed. Cir. 1989) (not a prior art case) and In re Mulder, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983) (no definitive treatment).

Those panel decisions do not overcome the mandatory authority set forth supra. For example, they do not overcome In re Lundberg, which is binding precedent in the Federal Circuit. See Capital Elec. Inc. v. United States, 729 F.2d 743, 746 (Fed. Cir. 1984); South Corp. v. United States, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc). Although Note 1 in In re Iwahashi disagreed with the "truth" of Sweet's statement of law, the In re Iwahashi panel had no authority to overrule any CCPA case. And, of course, no court can overcome the mandatory authority, discussed above, of § 112's last clause itself and Congress' re-enactments.

(e) Other Considerations

Interpreting "means" in pending claims as including any capable means rather than the disclosed means and equivalents thereof, comports more with (1) the reverse doctrine of equivalents, (2) the statutory presumption of validity, and (3) policy considerations.

(1) Reverse Doctrine Of
Equivalents

Section 112 ¶ 6 operates like the reverse doctrine of equivalents. Intel Corp. v. United States Int'l Trade Comm'n, [946 F.2d 821, 842] Appeal No. 89-1459, 20 USPQ2d 1161, 1179 (Fed. Cir. September 17, 1991). One treatise states that:

Lundberg represents the better interpretation of Section 112 ¶ 6. This section is best understood as an expression of the reverse doctrine of equivalents. The reverse doctrine addresses how to treat later technical developments covered in words but not in substance by the claims in suit.

2 Patent Law Perspectives, ¶ 2.9[5], p. 2-1172.1 through p. 2-1172.7 (1991). Thus, consideration of equivalents at the time of prosecution is an unnecessary expenditure of resources and ineffectual because equivalence, and the reverse doctrine in particular, speaks to future advances. See Westinghouse v. Boyden Power Brake Co., 170 U.S. 537, 568 (1898); Graver Tank Mfg. v. Linde, *supra*, 339 U.S. at 608. Halliburton Co. v. Walker, 329 U.S. 1, 12, 13 (1946), was addressed by § 112's last paragraph and points out that a device may not be known as of the patent issue date as an equivalent of a claimed means.

Neither PTO nor an applicant can predict what means will be shown after issuance of a patent to be equivalent to the claimed means:

It is not required that those skilled in the art knew, at the time the patent application was filed, of the asserted equivalent means of performing the claimed functions; that equivalence is determined as of the time infringement takes place.

Texas Instruments, Inc. v. United States I.T.C., 805 F.2d 1558, 1563, 231 USPQ 833, (Fed. Cir. 1986), reh'g denied, 846 F.2d 1369, 6 USPQ2d 1886 (Fed. Cir.) (note concurring opinion by Judge Davis), reh'g denied, 7 USPQ2d 1414 (Fed. Cir. 1988) (in banc). See also D.M.I., Inc. v. Deere and Co., 755 F.2d 1570, 1574, 225 USPQ 236, 238 (Fed. Cir. 1985) ("there is and can be no requirement that applicants describe or predict every possible means of accomplishing that function"); S.R.I. Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (in banc) (plurality) ("The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention").

If pending means claims were interpreted as limited to disclosed means and equivalents thereof, patent applicants would have to prosecute based on what they predict to be or not to be equivalent in the future. That is impractical, if not nonsensical, because equivalence is determined "as of the time infringement takes place," Texas Instruments, supra. Statements during prosecution, however, may estop patentees

from asserting a full range of equivalents against infringers in the future. See 2 Patent Law Perspectives, supra at 2-1172.5 (1991). Lacking such statements, courts would re-determine equivalence during infringement suits, duplicating and superceding PTO's determinations.

(2) Presumption Of
Validity

In courts, issued claims are presumed valid. 35 U.S.C. § 282. Thus, courts determining validity in infringement cases give a narrower meaning to issued claims (to preserve their validity) than the "broadest reasonable interpretation" PTO gives to pending claims. In re Etter, 756 F.2d 852, 858-59, 225 USPQ 1, 5-6 (Fed. Cir.) (in banc), cert. denied, 474 U.S. 828 (1985). The court stated:

In litigation, where a patentee cannot amend his claims, or add new claims, the presumption [of validity], and the rule of claim construction (claims shall be construed to save them if possible), have important roles to play. In reexamination, where claims can be amended and new claims added, and where no litigating adversary is present, those roles and their rationale simply vanish.

Id. See also In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (citing In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) for the proposition that "before the application is granted, there is no reason to read into the claim the limitations of the specification"). Because § 282's presumption of validity and the narrowing rule of claim construction do not apply to pending claims, In re

Etter, supra, the reasons for construing issued means claims as limited to disclosed means and equivalents thereof under § 112 "simply vanish" in PTO examination.

A validity appeal from a district court is "quite another thing" (compared to an ex parte PTO appeal) because, inter alia, various additional segments (e.g. § 282) of the patent statute are applicable to an issued patent. Compare Polaroid Corp. v. Eastman Kodak Co., 789 F.2d 1556, 1559 n.8, 229 USPQ 561, 563 n.8 (Fed. Cir.), cert. denied, 479 U.S. 850 (1986).

(3) Policy
Considerations

Given PTO's long-standing interpretation of the sixth paragraph, judicially sanctioned in Lundberg, and twice implicitly adopted by Congress through reenactments of § 112, any change in the practice is properly addressed by Congress -- not the courts or PTO. A change in practice involves policy issues which would affect many involved in the patent system -- PTO, patentees, and accused infringers. These and other policy issues are appropriately debated and resolved by Congress:

(A) PTO Workload

PTO's workload will increase; without the benefit of live testimony and testing facilities, PTO will have to resolve structural equivalency.

(B) Practical
Application

Patent applicants may have concerns about pre-committing views on non-equivalency prior to the time a patent is asserted.

Under § 112, a court may determine the breadth of equivalents to be afforded means plus function clauses in issued patents with reference to, inter alia, expert testimony and the prosecution history. Intel Corp. v. United States Int'l Trade Comm'n, [946 F.2d 821, 842-43] Appeal No. 89-1459, 20 USPQ2d 1161, 1179-80 (Fed. Cir. September 17, 1991). The PTO has no facility for calling its own expert to balance expert testimony that arguably could be made of record under 37 CFR § 1.132. Before prosecution is complete, there is no coherent prosecution history; it is a moving target.

Because equivalency is determined with reference to testimony of experts and others versed in the technology, it requires a determination of credibility. Graver Tank, supra, 339 U.S. at 609. The Patent and Trademark Office is ill-equipped to assess credibility in ex parte patentability determinations.

Thus, it would be impractical for the PTO to attempt to apply the last clause of § 112's final paragraph when comparing prior art to claims in ex parte examination.

(C) Burden
Shifting

If PTO accepted an applicant's non-equivalency argument, the burden of proof may shift in infringement cases; the accused infringer would have to prove non-equivalency, whereas today the patent owner must prove equivalency.

(D) Claim Clarity

If pending means claims were interpreted as limited to the disclosed means and equivalents thereof without explicit claim language, it would be much more difficult to read and understand such claims. For example, identically worded claims in different applications could have different meanings, even to the point of mutual allowability and non-interference.

2. If § 112 Applies, How?

PTO must apply the "broadest reasonable interpretation" to pending claims.

In *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984), this court said that claims subject to reexamination will "be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims." 740 F.2d at 1571, 222 USPQ at 936. That standard is applied in considering rejections entered in the course of prosecution of original applications for patent. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir.) (in banc) (interpreting "means" clause), cert. denied, 474 U.S. 828 (1985).

That requirement would be applicable to PTO even if § 112's last clause were also applicable. The only case directly requiring PTO to determine equivalents under § 6 required PTO at the same time to apply the "Broadest reasonable interpretation" to the claim. In re Bond, 910 F.2d at 833, 15 USPQ2d at 1567. In PTO's view, the broadest reasonable interpretation of "means" for performing a function renders all capable means equivalent.

A court in a validity/infringement case must apply a narrow construction dictated by § 282's presumption of validity, as discussed supra. In a validity/infringement case, "section 112 § 6 operates to cut back on the types of means which could literally satisfy the claim language." Johnston v. Ivac Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989) (emphasis in original). In such a case, claims are not given the broadest reasonable construction. Compare In re Etter, supra, 225 USPQ at 3, 756 F.2d at 862 (Nies, J., concurring) ("claims in litigation are to be 'so construed, if possible as to sustain their validity.' [citation omitted]. Claims in reexamination, on the other hand, 'will be given their broadest reasonable interpretation.'"). Since PTO must apply the broadest reasonable interpretation, the Johnston v. Ivac Corp. considerations do not dictate the same result in the PTO. Compare In re Zletz, supra, 893 F.2d at 321, 13 USPQ2d at 1322 (Board erred by applying the mode of claim construction used by courts in litigation).

Even if § 112's last clause applied to PTO's ex parte patentability determinations vis-a-vis the prior art, and even if all capable means were not equivalent, the clause would not limit pending means claims to disclosed and equivalent means. As set forth supra, § 112 ¶ 6 operates like the reverse doctrine of equivalents and speaks only to post-issuance advances. Thus, pre-issuance, a claim encompasses disclosed and equivalent means as well as any other means for performing the function.

B. Section 112's Last Paragraph Does Not Support Reversal In The Present Case

The Board properly held that limitations (e.g. flexible, sloping surface) appearing in the specification are not to be read into the claims (A10). The statute does not say that means claims "include" disclosed means and equivalents. 35 U.S.C. § 112 sixth paragraph. Donaldson accidentally misquotes the statute to say "include" (Br6 line 28 block quote). The accidentally misquoted language is telling. Rather than "include," the statute says "cover." 35 U.S.C. § 112 sixth paragraph. Congress' use of "cover" is significant, as discussed supra.

Even if the Board made a legal error, and § 112's final paragraph limits pending means claims to disclosed means and equivalents, such error was harmless in this case because Donaldson did not show non-equivalence. See In re Mulder, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983) (affirming Board decision where applicant failed to assert and show

non-equivalence). If Mulder is the law, placing the burden of showing non-equivalence on an applicant would be supported by "Practical Application" concerns set forth supra.

In this case, Donaldson did not even assert non-equivalence to the examiner or in its Appeal Brief to the Board (A57-A66). Donaldson's arguments on non-equivalence in its Request For Reconsideration (A119) did not demonstrate any point that the Board "misapprehended or overlooked in rendering the decision" or that the Board should have otherwise reconsidered. 37 CFR § 1.197(b).

If the Board committed harmful legal error, and should have followed In re Bond, then this court should vacate (rather than reverse as urged by Donaldson) and remand for a determination of equivalence vel non in the first instance, as in In re Bond, 910 F.2d 831, 833-34, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

CONCLUSION

The decision of the Board, affirming the rejection of claim 1, should be affirmed for the reasons stated.

Respectfully submitted,


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CERTIFICATE OF SERVICE

I hereby certify that on June 5, 1992, I caused two copies of the foregoing BRIEF FOR APPELLEE, COMMISSIONER OF PATENTS AND TRADEMARKS to be delivered by Federal Express (a one-day delivery service) addressed as follows:

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