

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. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SEUNG-HUN OH

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Appeal No. 1998-2552  
Application No. 08/292,977

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ON BRIEF

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Before OWENS, WALTZ, and TIMM, Administrative Patent Judges.  
WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 18 through 20, 31, 33, 35 and 36 as amended subsequent to the final rejection (see the amendment dated Nov. 6, 1997, Paper No. 36, entered as per the Advisory Action dated Nov. 26, 1997, Paper No. 37).

According to appellant, the invention is directed to a method of producing an optical fiber secondary preform by collapsing an over-cladding tube on an optical fiber primary

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perform by use of various support structures, rings, and sealing parts to align and seal the over-cladding tube (Brief, pages 2-4). A copy of illustrative claim 33 is attached as an Appendix to this decision.

The examiner has relied upon the following references as support for the rejections on appeal:

Baumgart et al. (Baumgart)	4,820,322	Apr. 11, 1989
Takahashi et al. (Takahashi)	54-13351	Jan. 31, 1979
(published Japanese Kokai Patent Application) <sup>1</sup>		

Claims 18-20, 31, 33, 35 and 36 stand rejected under 35 U.S.C. § 112, ¶2, as indefinite (Answer, page 6).<sup>2</sup> Claim 33 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Takahashi (Answer, page 4). Claim 31 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Takahashi in view of Baumgart (Answer, page 5). We reverse all of the examiner's rejections essentially for the reasons stated in appellant's Brief, Reply Brief, and as set forth below.

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<sup>1</sup> We rely upon an English translation of this document, previously made of record in this application.

<sup>2</sup> The examiner mistakenly includes cancelled claim 32 in this rejection (Answer, page 6).

**OPINION**

A. *The Rejection under 35 U.S.C. § 112, ¶2*

The examiner states that the means-plus-function terms as recited in the claims are indefinite as to their meanings because the specification fails to point out what the means encompass, i.e., "it is unclear if the means are limited to the disclosed embodiment or any possible means that meet the functionality." Answer, page 6.

Appellant cites various parts of the specification which clearly sets forth the structure designated for each means-plus-function term (Brief, pages 6-7). Accordingly, appellant urges the rejection is in error. We agree.

As cited by the examiner (Answer, page 6), *In re Donaldson*<sup>3</sup> holds that one must look to the specification to interpret claimed means plus function language in light of the corresponding structure, material, or acts described therein, and equivalents thereof. The strictures of 35 U.S.C. § 112, ¶6, apply when the word "means" appears in a claim element in combination with a function where there is not a sufficient

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<sup>3</sup>16 F.3d 1189, 1193, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)(in banc).

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recitation of structural limitations to perform this function. See *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999). It is clear that appellant's claims recite means-plus-function language with no corresponding structural limitations. Therefore we look to the specification to interpret the corresponding structure needed to accomplish the claimed function. As pointed out by appellant (Brief, pages 6-7), each means-plus-function term in the claims has specific corresponding structure as disclosed in the specification. Accordingly, the claimed language is definite and does not include "any possible means that meet the functionality" (Answer, page 6) but only includes the disclosed structures "and equivalents thereof." See *Al-Site Corp., supra*, and 35 U.S.C. § 112, ¶6 (1975).

The examiner further rejects claim 35 as indefinite since this claim recites that the ring is slid over the second end of the preform but the examiner alleges that the specification teaches that the preform is inserted into the ring (Answer, paragraph bridging pages 6-7).

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Appellant submits that the specification does not state that the preform is inserted into the ring, nor that the ring is slid over the preform (Brief, page 9). Appellant argues that either method would have been clear to one of ordinary skill in the art (*id.*).

It is well settled that the legal standard for definiteness is whether one of ordinary skill in the art would have been appraised of the scope of the claims. See *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The examiner has not shown, by convincing reasoning or evidence, that one of ordinary skill in the art would not have been appraised of the scope of the claim language in question.<sup>4</sup> Accordingly, since the examiner has not met the initial burden of establishing indefiniteness of the claimed language, we cannot sustain the rejection of claim 35 under 35 U.S.C. § 112, second paragraph.

For the foregoing reasons and those stated in the Brief and Reply Brief, we reverse the examiner's rejection of

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<sup>4</sup> We note that the examiner has not made any rejection based on the written description requirement of the first paragraph of 35 U.S.C. § 112.

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the claims on appeal under the second paragraph of section 112 as indefinite.

*B. The Rejections under 35 U.S.C. § 102(b) and § 103(a)*

It is well settled that the examiner bears the initial burden of establishing a *prima facie* case of unpatentability, whether on prior art grounds or any other basis. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In view of our claim construction above, the claimed means-plus-function language is limited to the structures disclosed in the specification "and equivalents thereof." See *Al-Site Corp.*, *supra*. The examiner has failed to point to any structure in Takahashi that is identical to that recited in claim 33 that would support the rejection under 35 U.S.C. § 102(b). Furthermore, the examiner has failed to establish that Takahashi discloses, suggests or teaches the structures recited in claims 33 and 31.<sup>5</sup> In other words, the

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<sup>5</sup> The examiner applies Baumgart as evidence that use of a vacuum pump to evacuate the space between the tube and the preform is conventional in the art to prevent bubbles from forming in the preform. Accordingly, Baumgart does not remedy the deficiencies discussed above with respect to the examiner's findings from Takahashi.

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examiner has failed to show the corresponding structures in the applied prior art for the first, second and third means recited in claims 31 and 33, namely the hand bar 18, the annular over-cladding tube sealing-up part 20, and the supporting handle tube 14, respectively (see the specification, page 6, last line; page 7, lines 9 and 17; and Figure 3). The examiner has also failed to allege that any of the structures of Takahashi are the "equivalents thereof" within the meaning of the sixth paragraph of 35 U.S.C.

§ 112. Accordingly, we determine that the examiner has failed to present any factual basis to support the rejections on appeal.

For the foregoing reasons and those set forth in the Brief and Reply Brief, the rejection of claim 33 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) over Takahashi is reversed. Similarly, the rejection of claim 31 under 35 U.S.C.

§ 103(a) over Takahashi in view of Baumgart is reversed.

*C. Summary*

The rejection of the claims on appeal under the second paragraph of 35 U.S.C. § 112 is reversed. The rejection of

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claim 33 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) over  
Takahashi is reversed. The rejection of claim 31 under 35  
U.S.C. § 103(a) over Takahashi in view of Baumgart is reversed.

The decision of the examiner is reversed.

**REVERSED**

TERRY J. OWENS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

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**APPENDIX**

33. A method of producing an optical fiber secondary preform by collapsing an over-cladding tube on an optical fiber primary preform, said optical fiber primary preform having a first means being adhered to one end of said optical fiber primary preform which supports said optical fiber primary preform during rotation, said first means having a second means for sealing a first end of said over cladding tube, said over-cladding tube having a third means adhered to a second end of said over cladding tube to support said second end of said over-cladding tube, said method comprising the steps of:

inserting a ring into an inner diameter of said third means, said ring being concentric with said second end of said over-cladding tube;

inserting a second end of said optical fiber primary preform through the inner diameter of said ring;

sealing said first end of said over-cladding tube by heating said first end of said over-cladding tube and the second means of said first means;

rotating said over-cladding tube; and

collapsing said over-cladding tube on said optical fiber primary preform by applying heat to said over-cladding tube when said over-cladding tube is rotated under a predetermined collapse condition to produce said optical fiber secondary preform.