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| APPLICATION NO.                           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/552,774                                | 10/12/2005  | Bernhard Gleich      | DE 030117           | 2136             |
| 24737                                     | 7590        | 02/13/2013           | EXAMINER            |                  |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS |             |                      | GUPTA, VANI         |                  |
| P.O. BOX 3001                             |             |                      | ART UNIT            | PAPER NUMBER     |
| BRIARCLIFF MANOR, NY 10510                |             |                      | 3777                |                  |
|   |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|   |             |                      | 02/13/2013          | ELECTRONIC       |

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BERNHARD GLEICH and JURGEN WEIZENECKER

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Appeal 2011-006710  
Application 10/552,774  
Technology Center 3700

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Before ERIC GRIMES, JEFFREY N. FREDMAN, and  
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

#### DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a device for determining mechanical parameters of an examination object. The Examiner has rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We vacate the rejection on appeal and enter a new ground of rejection for indefiniteness.

### STATEMENT OF THE CASE

Claims 1-9, 19 and 20 are on appeal. Claim 1, the only independent claim on appeal, is representative and reads as follows:

1. A device for determining mechanical, particularly elastic, parameters of an examination object, comprising
  - a) at least one arrangement for determining the spatial distribution of magnetic particles in at least one examination area of the examination object, comprising
    - a means for generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength,
    - a means for detecting signals which depend on the magnetization in the examination object, particularly in the examination area, that is influenced by a spatial change in the particles, and
    - a means for evaluating the signals so as to obtain information about the, in particular temporally changing, spatial distribution of the magnetic particles in the examination area; and
  - b) at least one means for generating mechanical displacements, in particular oscillations, at least in and/or adjacent to the examination area of the examination object.

The sole rejection before us for review is the Examiner's rejection of claims 1-9, 19 and 20 under 35 U.S.C. § 102(a) over Kraus.<sup>1</sup>

We vacate this rejection in favor of a rejection of claims 1-9, 19 and 20 under 35 U.S.C. § 112, second paragraph. A prior art rejection of a claim, which is so indefinite that "considerable speculation as to meaning of

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<sup>1</sup> Kraus, Jr., et al., US 6,470,220 B1, issued Oct. 22, 2002.

the terms employed and assumptions as to the scope of such claims” is needed, is likely imprudent. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the examiner and the board were wrong in relying on what at best were speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.) We find it imprudent to speculate as to the scope of the “means for evaluating” element of these claims in order to reach a decision on this issue under § 102. It should be understood, however, that our decision to vacate the § 102 rejection is based on the indefiniteness of the claimed subject matter and does not reflect on the merits of the underlying rejection.

I.

Based on our authority under 37 C.F.R. § 41.50(b), we enter the following new ground of rejection: Claims 1-9, 19 and 20 are rejected under 35 U.S.C. § 112, second paragraph, because they are indefinite.

*Findings of Fact*

The following findings of fact (“FF”) are supported by a preponderance of the evidence of record.

FF1. The Specification discloses as follows:

In order to change the spatial position of the two part-areas in the examination area, for example, a magnetic field that can be changed locally and/or temporally can be generated. *It may also be provided that the signals induced in at least one coil by the temporal change in the magnetization in the examination area are received and evaluated in order to obtain information about the spatial distribution of the magnetic particles in the examination area.* Signals that are as high as possible can be

obtained by the spatial position of the two part-areas changing as rapidly as possible. A coil which is used to generate a magnetic field in the examination area can be used to detect the signals. However, at least one special coil is preferably used.

(Specification 5, ll. 19-27.) (Emphasis added.)

FF2. The Specification discloses as follows:

An arrangement having a filter connected downstream of the coil arrangement is likewise advantageous, said filter suppressing from the signal induced in the coil arrangement the signal components in a first frequency band and allowing through the signal components in a second frequency band which contains higher frequency components than the first frequency component. This makes use of the fact that the magnetization characteristic in the region in which the magnetization passes from the unsaturated state to the saturated state is non-linear. This non-linearity means that a magnetic field which runs for example in a sinusoidal manner over time with the frequency  $f$  in the range of non-linearity, brings about a temporally changing induction with the frequency  $f$  (fundamental component) and integer multiples of the frequency  $f$  (upper or higher harmonics). *The evaluation of the upper harmonics has the advantage that the fundamental component of the magnetic field that is active at the same time for moving the field-free point does not have any influence on the evaluation.*

(Specification 7, ll. 20-32.) (Emphasis added.)

FF3. The Specification discloses as follows:

Also suitable is a device according to the invention which has a means for generating a temporally changing magnetic field that is superposed on the magnetic gradient field, for the purpose of moving the two part-areas in the examination area.

A suitable device according to the invention is characterized by a coil arrangement for *receiving* signals

induced by the temporal change in the magnetization in the examination area.

(Specification 4, ll. 26-28.) (Emphasis added.)

FF4. The Specification discloses as follows:

An arrangement may be provided with means for generating a temporally changing magnetic field that is superposed on the magnetic gradient field for the purpose of moving the two part-areas in the examination area. The area generated by the gradient coil arrangement is in this case moved around the field zero point, i.e. the first part-area, within the examination area by the temporally changing magnetic field. Given a suitable temporal profile and orientation of this magnetic field it is possible in this way for the field zero point to pass through the entire examination area.

(Specification 6, ll. 22-28.)

#### *Principles of Law*

A patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function. To allow that form of claiming under section 112, paragraph 6, would allow the patentee to claim all possible means of achieving a function.

*Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009). *See also, Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 521 F.3d 1328, 1331 (Fed. Cir. 2008).

#### *Analysis*

Our rules require that for claims including “means for” language, the Appeal Brief contain:

For each rejected independent claim, and for each dependent claim argued separately under the provisions of paragraph

(c)(1)(vii) of this section, if the claim contains a means plus function or step plus function recitation as permitted by 35 U.S.C. 112, sixth paragraph, then the concise explanation must identify the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters.

37 C.F.R. § 41.37(c)(1)(v). The first element of claim 1 includes “a means for evaluating the signals so as to obtain information about the, in particular temporally changing, spatial distribution of the magnetic particles in the examination area.” (App. Br., Claims Appendix.) For support of this limitation (and all of the other limitations of claim 1), Appellants point to page 2, line 32 through page 4, line 4 and page 5, line 5 through page 7, line 32 of the Specification (App. Br. 3). However, after reviewing the cited passages of the Specification, we are unable to identify any passage sufficiently disclosing a structure for performing the evaluation function for the means-plus-function element of claim 1 (*see, e.g.*, FF1 – FF4).

Appellants’ Summary of the Claimed Subject Matter in the Brief does not point to any disclosure of any specific algorithm or structure for implementing an assessment related to the temporally changing, spatial distribution of the magnetic particles in the examination area as claimed. Where the Specification does describe evaluating this distribution, it does so generally and provides only a recitation of the evaluation function as opposed to providing an adequate disclosure of an algorithm for implementing the evaluation function (*see, e.g.*, FF1 – FF4). *See Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) (“A computer-

implemented means-plus-function term is limited to the corresponding structure disclosed in the specification and equivalents thereof, and the corresponding structure is the algorithm.”). Accordingly, claim 1 and dependent claims 2-9, 19 and 20 are unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

### SUMMARY

Claims 1-9, 19 and 20 are indefinite when read in light of the Specification because the scope of the “means for evaluating” element is unclear. We therefore vacate the rejections on appeal and enter a new ground of rejection for indefiniteness.

### TIME PERIOD FOR RESPONSE

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b), which provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

VACATED, 37 C.F.R § 41.50(b)

cdc