

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SHAWN ALAN WAKEFIELD, JIMMIE RAY SHAVER  
and BRETT ALAN SLOAN

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Appeal No. 2002-2026  
Application No. 09/620,424

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HEARD: April 3, 2003

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Before BARRETT, FLEMING, and SAADAT, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claim 11. Claims 1-10 have been canceled.

The invention relates to improving the read performance for a disk drive utilizing redundant synchronization fields in a data block used to store user data. See page 1 of Appellants' specification. Figure 7 is a generalized flow chart for a MIS-SYNC RECOVERY routine representative of programming stored in

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memory and utilized by a system processor of the disc drive, as shown in Figure 2. See page 5 of Appellants' specification.

Figure 11 is a generalized flow chart for a SPLIT SECTOR RECOVERY routine representative of programming stored in memory and utilized by a system processor of the disc drive, as shown in Figure 2. See page 6 of Appellants' specification.

As shown in Figure 2, circuitry used to control the disc drive 100 includes a spindle control circuit 142, a servo control circuit 144 and a read/write channel 146, all operably connected to a system processor 150. It will be recognized that the system processor 150 communicates with and controls the operation of these circuits in a known manner, with the exceptions as discussed below. Additionally, an interface circuit 152 is shown connected to the read/write channel 146 and to the system processor 150, with the interface circuit 152 serving as a conventional data interface and buffer for the disc drive. The interface circuit 152 includes a sequencer which comprises hardware used to establish varying timing sequences during the operation of the read/write channel 146. See page 7 of Appellants' specification.

Appellants describe in detail the MIS-SYNC RECOVERY routine as shown in Figure 7 on pages 15 and 16 of Appellants'



**OPINION**

With full consideration being given to the subject matter on appeal, the Examiner's rejection and the arguments of Appellants and Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claim 11 under 35 U.S.C. § 102.

**Scope of Claim**

The first question that we must address is whether the "recovery means for recovering the data from the disc" recited in Appellants' claim 11, is a means-plus-function element entitled to defining structure as required under 35 U.S.C. § 112, sixth paragraph. Our first determination is to determine whether the claim element recites function or recites structure. Our reviewing court has stated

"[a] limitation that is expressed in 'means-plus-function' language and does not recite the fine structure in support of its function, is subject to the requirements of 35 U.S.C. § 112, sixth paragraph."

**B. Braun Med., Inc. v. Abbott Labs.**, 124 F.3d 1419, 1424, 43 USPQ2d 1896,1899 (Fed. Cir. 1997).

The Examiner argues that the phrase "recovery means for recovering the data from the disc" does not qualify as means-plus-function element under 35 U.S.C. § 112, sixth paragraph, because it includes the word "recovery" and therefore refers to a definite structure to perform to recovery function. Thus, the

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issue for us to decide is whether the word "recovery" before the word "means" defines structure.

Our reviewing court, when considering the issue of whether "perforation means . . . for tearing" defines structure or function, the court stated

"[t]o invoke [35 U.S.C. § 112, sixth paragraph] statute, the alleged means-plus-function claim element must not recite a definite structure which performs the described function." **See Cole v. Kimberly-Clark Corp.**, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996). To make this determination, the court turned to a dictionary to confirm the ordinary meaning of "perforation." Id.

Turning to Webster's New World Dictionary, Third College Edition copyright 1998, page 1112 we find that the definition of recovery is "the act or an instance of recovery."<sup>3</sup> From the ordinary meaning of "recovery," we find that the term only recites the function of the act of recovering which is to get back something that is lost. Because the element "recovery means for recovering the data from the disc" does not recite any structure for recovering the data, we find that the claimed element must be properly treated under 35 U.S.C. § 112, sixth paragraph.

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<sup>3</sup> A copy of the appropriate pages of the Webster New World Dictionary is included as an attachment to this opinion.

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To determine the scope of a claim which qualified under 35 U.S.C. § 112, sixth paragraph, our reviewing court has set forth a two-step test. Our reviewing court states

[a] two-step test should be employed to determine scope of a means-plus-function claim: 1) identify the function; 2) identify the corresponding structure. ***Texas Digital Systems, Inc. v. Telegenix Inc.***, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822 (Fed. Cir. 2002). The first step . . . is to identify the function of the means-plus-function limitation. The next step is to identify the corresponding structure in the written description necessary to perform the function. ***Citing Micro Chem., Inc. v. Great Plains Chem. Co.***, 194 F.3d 1250, 1258, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999).

As pointed out above, we have already identified the function recited as the act of recovering data. We now must turn to the specification to identify the corresponding structure.

Appellants have argued on page 10 of the brief that the "means for recovering" includes the system processor programmed in accordance with Figure 7 and the specification page 15, line 4 through page 16, line 14 and also includes the processor programmed in accordance with Figure 11 and the specification page 19, line 1 through page 21, line 1. When questioned at the oral hearing, Appellants' attorney agreed to amend the specification to make clear the structure that corresponds to the recovery means for recovering the data. The proposed amendment to the specification is attached to the opinion. The Board has

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determined that the proposed amendment does not constitute new matter and would provide notice to the public as to the scope of Appellants' claim 11. We strongly urge the Examiner to enter the amendment as there is recommended practice as per MPEP 2181 and 37 CFR § 1.75(d)(1).

We agree with Appellants as to the corresponding structure identified above in the proposed amendment to the specification. Therefore, the element "recovery means for recovering the data" shall be construed to cover the corresponding above structure identified above and equivalents thereof.

**35 U.S.C. § 102 REJECTION**

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Upon our review of Holsinger, we fail to find that Holsinger teaches the above identified correspondence which is construed to be covered by Appellants' claim 11. Furthermore, we note that the Examiner has made no attempt to show that Holsinger teaches

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this structure. Therefore, we will not sustain the Examiner's rejection that claim 11 is anticipated by Holsinger under 35 U.S.C. § 102.

In view of the forgoing, we have not sustained the Examiner's rejection under 35 U.S.C. § 102.

**REVERSED**

LEE E. BARRETT	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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