

### A PRIOR ART REFERENCE THAT DISCLOSES ANY OF THE STRUCTURES ENCOMPASSED BY A MEANS-PLUS-FUNCTION CLAUSE OF A CLAIM ANTICIPATES THAT CLAIM

Volume III, Issue No. 3

by Mel R. Quintos

1. In a musical instrument of the type which comprises

a keyboard secured to a guitar body and a neck, said neck further comprising a playing surface in which said playing surface is substantially rigid, the improvement comprising

a means for producing musical tones from said playing surface in which a musician is able to contact and smoothly slide a finger relative to said playing surface in order to produce and change said musical tones thereby.

CLAIM 1 OF  
U.S. PATENT APPLICATION

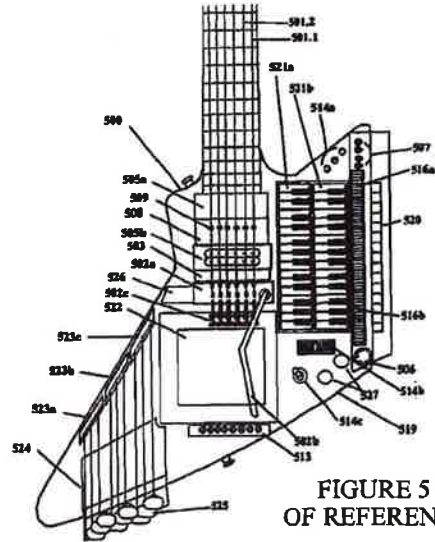


FIGURE 5  
OF REFERENCE

Claim 1 (shown above) was rejected by the examiner as being anticipated by Figure 5 of a “Ludwig reference” (also shown above). The applicant, Mr. W.Y. Guess, appealed to the USPTO Board of Patent Appeals and Interferences. The Board affirmed the examiner’s rejection of claim 1 based on the above-shown Figure 5 of the Ludwig reference, “which depicts a stringed guitar with a keyboard built into the guitar body.” Mr. Guess appealed the Board’s decision to the U.S. Court of Appeals for the Federal Circuit.

In June 2009, the court in *In re Guess* affirmed the Board’s decision. The court found claim 1 as a *Jepson*-type claim, which recites prior art in the preamble of the claim, the claimed invention consisting of the preamble in combination with the improvement. According to the court, the last clause of claim 1 is allegedly the “inventive improvement,” the improvement limitation of claim 1 being in a means-plus-function language (“means for producing musical tones”) governed by 35 U.S.C. §112, 6<sup>th</sup> paragraph. Based on 35 U.S.C. §112, 6<sup>th</sup> paragraph, the means-plus-function language of claim 1 is to be interpreted in light of the “corresponding structure, material or acts described in the specification and equivalents thereof” (emphasis added).

In determining what it means to produce musical tones as set forth in claim 1, the court turned to the specification. The specification describes producing musical notes in the traditional manner of bass guitars “by pressing each string to a plurality of frets ... as is common with most bass guitars.” Mr. Guess argued that the Board made a mistake in not including the structures that consist of electrical resistors and power supply that produce electronic signals that are converted into so-called “MIDI processor notes,” as also described in the specification. These electrical components are not disclosed in the Ludwig reference. The court found however that “the resistors and power supply serve as an *alternative* means of producing musical tones” (emphasis added). The court then held that because “[a] means-plus-function limitation encompasses *all* of the structures in the specification that perform the recited function,” citing the 2000 case of *Ishida v. Taylor*, the claimed invention of Mr. Guess is anticipated by “any prior art reference with structure that performs the claimed function of producing musical tones [simply] by means of a guitar with strings adjacent a neck playing surface” as shown in, for example, Figure 5 of the Ludwig reference.

**Washington D.C. Office:**  
4<sup>th</sup> Floor  
1420 K Street, N.W.  
Washington, DC 20005  
U.S.A.  
Tel: 202.659.2930  
Fax: 202.887.0357  
[www.kqhpatentlaw.com](http://www.kqhpatentlaw.com)

**Tokyo Liaison Office:**  
Tokyo Banker’s Club Building  
15th Floor  
1-3-1 Marunouchi, Chiyoda-ku  
Tokyo 100-0005  
JAPAN  
Tel: 03.3216.7188  
Fax: 03.3216.7210

**Pittsburgh Office:**  
Greater Beneficial Union of  
Pittsburgh Building, Suite 308  
4232 Brownsville Road  
Pittsburgh, PA 15227  
U.S.A.  
Tel: 412.881.8450  
Fax: 412.881.8570