**FUNCTIONAL LANGUAGE WORKSHEET**

This worksheet is used in the **2016 Functional Language Workshop** to facilitate the discussion of the interpretation and definiteness under 35 U.S.C. 112(b) of hypothetical product claims reciting functional language. As every claim must be examined individually based on the particular elements recited therein, a separate worksheet should be used to analyze each claim. The use of this worksheet during examination is optional.

**Example:** _____     **Claim:** _____

# Part I: Identifying Functional Language

**This claim includes at least one instance of functional language, which is:**

_____


**1.      Does the claim element including this functional language invoke 35 U.S.C. 112(f)?**

Use the three-prong analysis in MPEP 2181 to determine whether the claim limitation invokes § 112(f).

| Yes | No | Notes |
|-----|-----|-------|
| ☐ | ☐ | Prong A is met because:<br><br>Prong B is met because:<br><br>Prong C is met because: |

# Part II: Construing Functional Language

**2.      What is the broadest reasonable interpretation (BRI) of the functional language? Answer part A if the functional language does not invoke § 112(f), and Part B if the functional language is part of a § 112(f) limitation**.

| A.   BRI if § 112(f) is __not__ invoked |
|---|
| The structure, material or act in the claim that is connected to (*i.e.*, performs) the recited function is:<br><br>The BRI of the functional language is:<br><br><br> |

**FUNCTIONAL LANGUAGE WORKSHEET**

| B.  BRI if § 112(f) is invoked |
|---|
| The corresponding structure, material or act in the specification that performs the recited function is:<br><br>The BRI of the § 112(f) limitation is: |

3.    **Does the functional language limit the claim scope (*i.e.*, must a prior art reference disclose this functional limitation in order to anticipate the claim)?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The reason why the functional language does (or does not) limit the claim scope is: |

## Part III: Definiteness of Functional Language

**For § 112(f) limitations:**

4.    **If the functional language is part of a "means"-type § 112(f) limitation, answer the following questions about the corresponding structure or material.  Otherwise, <u>skip to Question 5</u>.**

A)    **Does the specification disclose or describe a structure or material as performing the claimed function?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The corresponding structure or material is: |

B)    **Is the disclosed or described structure or material sufficient to perform the entire claimed function?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The reason is: |

**FUNCTIONAL LANGUAGE WORKSHEET**

C) **Does the specification clearly link the structure or material to the claimed function?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The reason is: |

**For functional language that does not invoke § 112(f):**

5. **Are the boundaries of the functional language clear,** *i.e.***, can one of ordinary skill in the art draw the boundary between what is covered by the claim and what is not covered?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The boundaries of the functional language are: |

**Following Question 4 or 5, for § 112(f) limitations <u>and</u> limitations that do not invoke § 112(f):**

6. **Should the claim be rejected as indefinite under 35 U.S.C. 112(b)?**

| Yes | No | Notes |
|---|---|---|
| ☐ | ☐ | The indefinite claim language is:<br><br>This limitation is unclear because:<br><br>A suggestion for how applicant could resolve the unclear boundaries is: |

## Part IV: Addressing Functional Language

**Group Discussion:**

Assume that prior art reference X was published by another several years prior to applicant's earliest filing date (*i.e.*, X qualifies as prior art under § 102) and teaches elements that meet all the structural elements recited in this claim.

Using the BRI of this claim taking into account any limits imposed by the functional language, what prior art rejections would be appropriate? Consider scenarios where X explicitly discloses the recited function or where the structure in X performs the function with the same means, an equivalent means or a different means. If the claim has been found indefinite, assume that the best possible understanding of the claim is being used in the prior art rejection for purposes of compact prosecution.