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Addressing 35 U.S.C. § 112(f) or “Means-plus-Function” Limitations in an Office Action using New Form Paragraphs

September 2017

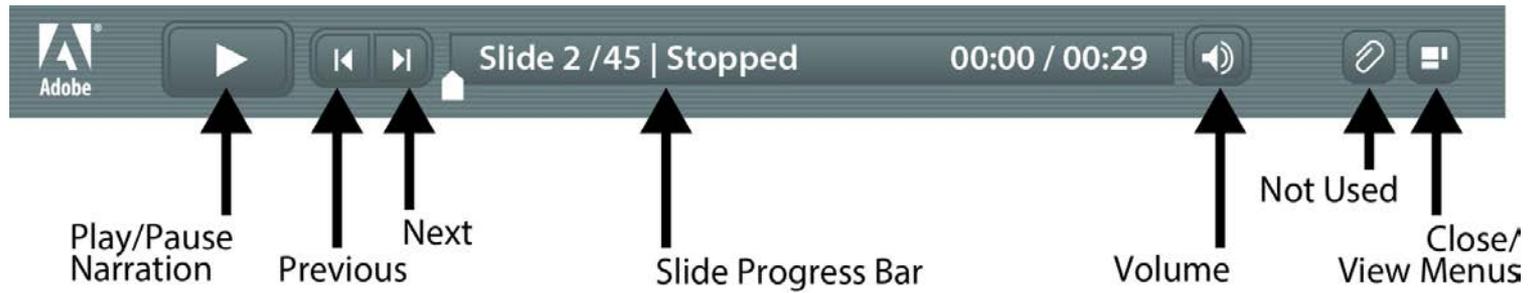
UNITED STATES
PATENT AND TRADEMARK OFFICE





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Training Purpose

- Review how to identify claim language that needs to be interpreted under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph (§ 112(f) claim elements or limitations)
- Introduce new form paragraphs that:
 - Establish § 112(f) claim interpretation in view of the presumptions
 - Address the two situations in which the § 112(f) presumptions are rebutted
 - Provide a section to indicate when § 112(f) presumptions are overcome



§ 112(f) is Simply a Style of Claim Drafting

- When an element or step is claimed **only** by its function, § 112(f) interpretation is required
- Recognizing this style matters because the broadest reasonable interpretation (BRI) of that claim language changes under § 112(f)



Indicate § 112(f) Interpretation During Prosecution

- Critical to clearly communicate § 112(f) claim interpretation in the Office action
 - Puts applicant on notice
 - Explanation becomes part of the public record, which informs everyone reading the patent history about the scope of patent protection
 - Helps resolve disputes at the PTAB and courts
 - Assists patentees to clearly establish patent rights with competitors and licensees
 - Promotes innovation by clearly defining the limits of patent protection



De-mystifying § 112(f): Tips for Recognizing This Claim Drafting Style

- The claim limitation recites a function
- A named structure, a material or an act that performs that function is not recited in the claim



A Word on “Generic Placeholders”

- Other words often stand in for “means”
- We call these generic placeholder words because they are holding the place for a named structure and have no specific structural meaning on their own
 - There is no exhaustive list of generic placeholders, but the following words have been treated as generic placeholders in particular circumstances: “mechanism,” “device,” “unit,” “module”



Consider these Presumptions When Identifying § 112(f) Language

- A claim limitation that does **not** use the term “means” or “step” creates a rebuttable presumption that the claim limitation is **not** interpreted under § 112(f)
 - This presumption is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function
 - Need to acknowledge the presumption and indicate when it is rebutted



Consider these Presumptions When Identifying § 112(f) Language (cont.)

- A claim limitation that explicitly uses the term “means” or “step” creates a rebuttable presumption that the claim limitation is interpreted under § 112(f)
 - This presumption is rebutted when the claim limitation recites sufficient structure, material or acts to entirely perform the recited function
 - “Step-plus-function” limitations are rare because claim steps typically use action words that rebut the presumption that § 112(f) applies
 - Need to acknowledge the presumption and indicate when it is rebutted



The Three Prong Test from MPEP 2181 for Identifying § 112(f) Claim Limitations

- Apply § 112(f) to a claim limitation if it meets the following 3-prong test:
 - (A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
 - (B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and
 - (C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function



Establish BRI and Examine for Patentability

- Establish the BRI of the § 112(f) and non-§ 112(f) claim limitations
- Once the claim interpretation has been established, examine the claims to determine if they satisfy all patentability requirements



Preparing An Office Action

- When applicable, discussion of § 112(f) will appear toward the beginning of an Office action under the “CLAIM INTERPRETATION” heading
 - Remember, § 112(f) controls claim interpretation and is **not** the basis for a rejection
- This heading can also be used when the examiner determines that other clarifying claim interpretation remarks would benefit the prosecution record



Make Full Use of an Office Action

- Use your Office action to provide additional explanation whenever prosecution decisions and/or positions can be clarified
- Office actions are not limited to rejections, objections, and formalities

New Form Paragraphs

- The following three form paragraphs are being introduced to assist examiners in establishing claim interpretation under § 112(f) on the record and explaining the associated presumptions:

Broadest Reasonable Interpretation under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph: Use of “Means” (or “Step”) in Claim Drafting and Rebuttable Presumptions	FP 7.30.05
35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, Invoked Despite Absence of “Means”	FP 7.30.06
35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, Not Invoked Despite Presence of “Means” or “Step”	FP 7.30.07



New Form Paragraphs (cont.)

- The following three form paragraphs are to be used when § 112(f) issues are raised in an Office action

Header for Claim Interpretation	FP 7.30.03.h
Statement of Statutory Basis, 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph	FP 7.30.03
Broadest Reasonable Interpretation under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph: Use of “Means” (or “Step”) in Claim Drafting and Rebuttable Presumptions Raised	FP 7.30.05



New Form Paragraph 7.30.05 – Explains the Applicability of § 112(f) and Presumptions

- Explains that § 112(f) limits the BRI
- Sets forth the three-prong test that the examiner has used to determine whether or not to apply § 112(f) to a certain claim limitation
- Sets forth the rebuttable presumptions associated with § 112(f)
- States that the presumptions will be followed unless an indication that they have been rebutted is included in the Office action



New Form Paragraph 7.30.06 – § 112(f) Invoked Despite Absence of “Means”

- Use this form paragraph in the Office action when a claim limitation does not use “means” but is being interpreted under § 112(f)
 - Identify the claim limitations where § 112(f) applies because a generic placeholder coupled with functional language is used instead of the word “means”



New Form Paragraph 7.30.07 – § 112(f) Not Invoked Despite Presence of “Means” or “Step”

- Use this form paragraph when a claim limitation uses the word “means” or “step” but is not being interpreted under § 112(f)
 - Identify the claim limitations where § 112(f) does not apply because sufficient structure or action to perform the function is recited with the word “means” or “step”



Proper Response by Applicant

- An appropriate response to avoid interpretation under § 112(f) would be:
 - Amend the claim limitation to clearly recite a definite structure, material or act that entirely performs the recited function; or
 - Present a sufficient showing that the claim limitation recites a structure, material or act that entirely performs the recited function



Proper Response by Applicant (cont.)

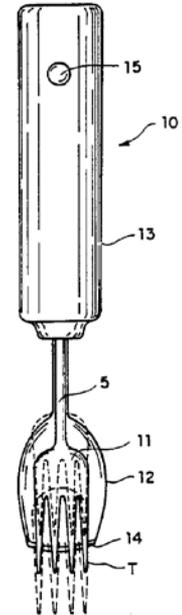
- An appropriate response to obtain interpretation under § 112(f) would be:
 - Amend the claim limitation to remove the structure, material or act that performs the recited function; or
 - Present a sufficient showing that the claim limitation does not recite any structure, material or act that entirely performs the recited function



Example

The present invention of a cutlery apparatus is generally designated 10 in FIG. 1. The apparatus 10 is comprised of a number of primary components, namely a fork 11, a spoon 12, and handle 13.

Disposed at the bottom most edge of the spoon 12 is a knife blade 14. A button 15 for the actuation of the mechanism contained within the handle 13 is disposed along the interior length of the handle 13. When the apparatus 10 is in a substantially vertical position, the button 15 can actuate the rotary mechanism of the spoon 12 with the knife blade 14 disposed thereon.





Hypothetical Claim 1

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a knife blade disposed adjacent to the fork and rotatably attached to the cutlery handle



BRI of the Last Limitation of Claim 1

a knife blade disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation does not meet the three-prong test because it does not use the word “means” and does not recite a function associated with the knife blade
 - “Knife blade” is a recognized term for a structure
 - There is no indication that “knife blade” should be given anything other than its plain meaning in the art
 - Because § 112(f) is not invoked, the BRI of “knife blade” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades



Addressing BRI in the Office Action

- The last limitation of claim 1 does not invoke § 112(f) or use words that would raise any § 112(f) presumptions
- There is no need to address § 112(f) in the Office action



Hypothetical Claim 2

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle



BRI of the Last Limitation of Claim 2

means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation meets the three-prong test because it uses the word “means”, recites the function “cutting”, and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is invoked because it uses the word “means”
 - The words of the claim do not rebut that presumption (“means” is not modified by other words that denote structure)
 - Because § 112(f) is invoked, the BRI of “means for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure



Addressing BRI in the Office Action

The last limitation of claim 2 meets the three-prong test and therefore invokes § 112(f). The words of the claim do not rebut the presumption that the claim limitation is to be interpreted under § 112(f). There is no need to add further explanation.

To establish the § 112(f) interpretation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05



Hypothetical Claim 3

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a device for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle



BRI of the Last Limitation of Claim 3

a device for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “cutting” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the cutting function (the word “device” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “device for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure



Addressing BRI in the Office Action

- The last limitation of claim 3 meets the three-prong test and therefore invokes § 112(f). The last limitation of claim 3 does not use the word “means,” but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f). Additional explanation is needed.
- To establish the § 112(f) interpretation and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Invoked Despite the Absence of “Means”	FP 7.30.06



Hypothetical Claim 4

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle;
 - a device for cutting disposed adjacent to the fork; and
 - a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork



BRI of the Last Limitation of Claim 4

a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “rotating” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the rotating function (the word “mechanism” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “a mechanism ... for rotating” is limited to what is disclosed in the specification, which is a motor and equivalents to that structure

Addressing BRI in the Office Action

- The last two limitations of claim 4 meet the three-prong test and therefore each invokes § 112(f). These limitations do not use the word “means,” but the words of each rebut the presumption that the claim limitations are not to be interpreted in accordance with § 112(f). Additional explanation is needed.
- To establish the § 112(f) interpretation and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Invoked Despite the Absence of “Means”	FP 7.30.06



Hypothetical Claim 5

- The cutlery apparatus of claim 4, further comprising:
 - a unit disposed between the cutlery handle and the fork for biasing the fork with respect to the cutlery handle



BRI of the Limitation of Claim 5

a unit disposed between the cutlery handle and the fork for biasing the fork with respect to the cutlery handle

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “biasing” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the biasing function (the word “unit” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “unit ... for biasing” is limited to what is disclosed in the specification, which is a spring and equivalents to that structure



Addressing BRI in the Office Action

- The limitation of claim 5 meets the three-prong test and therefore invokes § 112(f). The limitation does not use the word “means,” but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f).
Additional explanation is needed
- To establish the § 112(f) interpretation and provide an explanation for this dependent claim, draft the Office action with the paragraphs noted on slide 33 for claim 4 and include the “unit... for biasing” and claim 5 in the explanatory inserts for **FP 7.30.06**



Hypothetical Claim 6

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a knife blade means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle



BRI of the Last Limitation of Claim 6

a knife blade means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation does not meet the three-prong test because even though it uses the word “means” coupled with the function “cutting”, it also recites a knife blade, which is structure that performs the recited function
 - Raises presumption that § 112(f) is invoked because it uses the word “means”
 - Presumption is rebutted because the limitation recites structure that can perform the cutting function (i.e., “a knife blade”)
 - Because § 112(f) is not invoked, the BRI of “a knife blade means for cutting” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades that can perform the cutting function

Addressing BRI in the Office Action

The last limitation of claim 6 does not meet the three-prong test and therefore does not invoke § 112(f). The last limitation of claim 6 uses the word “means,” but the words of the claim rebut the presumption that the claim limitation is to be interpreted in accordance with § 112(f). Explanation is needed.

To establish that § 112(f) interpretation is not being used and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Not Invoked Despite Presence of “Means” or “Step”	FP 7.30.07



Summary

- Interpretation under § 112(f) is triggered by claim language and is not optional
- Noting § 112(f) interpretation in an Office action benefits the examiner, the applicant and the public
- Use the new form paragraphs to make § 112(f) interpretation on the record



Questions and Follow-up

- See your SPE or QAS for questions
- Additional resources can be found on the “35 U.S.C. § 112(f) Examination Guidance and Training Materials” Web page:
<http://ptoweb.uspto.gov/patents/exTrain/112f.html>

Addressing 35 U.S.C. § 112(f) or “Means-plus-Function” Limitations in an Office Action using New Form Paragraphs

September 2017



CBT NARRATION:

Accessibility note: Recorded materials in this CBT do not always exactly match the contents of the slides in this presentation.

Welcome to “Addressing 35 U.S.C. § 112(f) or “Means-plus-Function” Limitations in an Office Action using New Form Paragraphs”. The discussion of 35 U.S.C. § 112(f) in this presentation should be understood to also cover pre-AIA 35 U.S.C. 112, sixth paragraph, which is the same statutory provision renamed as paragraph (f) under the America Invents Act in 2012.

This training is not intended to be an in-depth analysis of 112(f) but rather a review of how to identify claim language that needs to be interpreted under 112(f) and introduction of the new form paragraphs and their use in an Office Action.

Presentation Navigation Notes

- Use menu at right to navigate to slides out of order using slide titles on the "Outline" tab
- Use bottom toolbar to control slides and voice recordings



CBT NARRATION:

Note that you can use the menu at right to navigate by slide titles using the Outline tab.

Also, take a moment to get familiar with the bottom toolbar, which has buttons to play and pause voice recordings, to move to the next or previous slide, to adjust the volume of the voice recordings, and to minimize and then re-open the bottom toolbar and the right-hand menu. To replay voice recordings, move the pointer on the slide progress bar back to the beginning.

Click the next button to continue.

Training Purpose

- Review how to identify claim language that needs to be interpreted under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph (§ 112(f) claim elements or limitations)
- Introduce new form paragraphs that:
 - Establish § 112(f) claim interpretation in view of the presumptions
 - Address the two situations in which the § 112(f) presumptions are rebutted
 - Provide a section to indicate when § 112(f) presumptions are overcome

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CBT NARRATION:

The purpose of this training is to review how to identify claim language that needs to be interpreted under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. § 112, sixth paragraph. This type of claim language will be called “section 112(f) claim limitations” throughout this presentation, but it should be noted that the words “limitations” and “elements” are used interchangeably by the courts and the MPEP. This training will also introduce new form paragraphs that establish § 112(f) claim interpretation in view of the presumptions, address the two situations in which the § 112(f) presumptions are rebutted, and provide a section to indicate when § 112(f) presumptions are overcome.

These new form paragraphs replace some of the current 112(f) form paragraphs in an effort to streamline recording 112(f) claim interpretation in an Office action. These new form paragraphs significantly reduce the amount of information examiners need to insert, which will make them easier to use.

§ 112(f) is Simply a Style of Claim Drafting

- When an element or step is claimed **only** by its function, § 112(f) interpretation is required
- Recognizing this style matters because the broadest reasonable interpretation (BRI) of that claim language changes under § 112(f)

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CBT NARRATION:

Section 112(f) is simply a style of claim drafting. It is not a requirement for patentability like other sections of 35 USC 112 and thus does not form a basis for a rejection on its own. It is just a technique that can be used when drafting claims that influences how a claim will be interpreted. Using this style of claim drafting is only permitted in claims to combinations of elements or steps. A claim with a single element cannot make use of this type of claim drafting because the statute restricts its use to claims that recite a combination of elements.

When an element or step is claimed **only** by its function, § 112(f) interpretation is required. Application of § 112(f) is driven by the claim language, not by applicant's intent or mere statements to the contrary. When certain claim language is used, § 112(f) interpretation must be applied – it is not optional. Recognizing this claiming style matters because the broadest reasonable interpretation or BRI of that limitation changes. As a reminder, every claim must be given its BRI in light of the specification as it would be interpreted by one of ordinary skill in the art. Under § 112(f) interpretation, the BRI is limited to what is disclosed in the specification (and equivalents) and therefore controls the scope of applicable prior art. Usually, the interpretation will be more narrow when § 112(f) is used.

Indicate § 112(f) Interpretation During Prosecution

- Critical to clearly communicate § 112(f) claim interpretation in the Office action
 - Puts applicant on notice
 - Explanation becomes part of the public record, which informs everyone reading the patent history about the scope of patent protection
 - Helps resolve disputes at the PTAB and courts
 - Assists patentees to clearly establish patent rights with competitors and licensees
 - Promotes innovation by clearly defining the limits of patent protection

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CBT NARRATION:

It is critical to make § 112(f) interpretation part of the prosecution record so that everyone is aware of the interpretation given during examination. By making the claim interpretation part of the written record during prosecution, applicant is put on notice that the examiner recognized the use of § 112(f). As a result, if applicant did not intend to invoke § 112(f), the claims can be amended or applicant can point out the claim language that avoids invoking § 112(f). That way, the proper interpretation will be used when examining for patentability, especially in terms of determining applicable prior art. This will make prosecution more efficient by airing any disagreements regarding claim interpretation early in prosecution and providing an opportunity to come to a meeting of the minds between the examiner and the applicant. Also, making the claim interpretation of record will serve as a refresher for the examiner when picking up the application later in prosecution.

After the patent issues, when the interpretation is put on the record, anyone reading the prosecution history is put on notice that the claim was examined under this interpretation. This assists the public, competitors, potential licensees, and the courts in understanding the boundaries of the patent protection and the reasons that the claims were allowed. This can help avoid unnecessary claim interpretation disputes and will focus any claim interpretation issues in the case of litigation.

De-mystifying § 112(f): Tips for Recognizing This Claim Drafting Style

- The claim limitation recites a function
- A named structure, a material or an act that performs that function is not recited in the claim

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CBT NARRATION:

Due to the language variations that can be used in § 112(f) limitations, identifying these limitations does not lend itself to a simple test or mere list of acceptable words. However, there are some tips that can assist identification. First, a § 112(f) limitation must recite a function. When reading the claim, flag any functions. Functions are often phrased as an action following a preposition, such as “for printing”. A function can also be used as a modifier, such as “a printing means.” Preambles are not typically separate limitations or elements of the claim, so a function in the preamble usually does not trigger § 112(f). If there is no function recited, there is no possibility of invoking § 112(f).

Second, if there is a function recited, § 112(f) is only an issue when there is nothing recited in the claim to perform that function. Saying it another way, § 112(f) only applies when a structure, a material or an act that performs that function is not recited in the claim. The structure, material or act must be recited by name. A “named” structure, material or act is one that would be recognized by someone of ordinary skill in the art as performing that function because it has a reasonably well understood meaning in the art, such as “a printer.” When the claim includes a sufficiently definite structure, material or act by name that performs the recited function, § 112(f) does not apply. For example, “a printer for printing” does not use § 112(f) because although it recites the function of printing, it also recites the name of the structure that performs that function, which in this case is a printer.

Traditionally, in § 112(f) limitations, the word “means” or “step” stands in for a named structure, material, or act, such as “means for printing.” These words come from the statute. This is why § 112(f) limitations are commonly referred to as “means-plus-function” or “step-plus-function” limitations. “Means-plus-function” limitations refer to structural elements. Because structural elements appear in both product claims and process claims, “means-plus-function” limitations can appear in any type of claim.

“Step-plus-function” claims, on the other hand, recite a step in purely functional terms. Accordingly, “step-plus-function” limitations will appear in process claims as a “step for [function]” without specific actions (for example, “a step for raising the pH of water”). If any action is recited in the limitation (e.g., “a step for raising the pH of water by adding baking soda”), the presumption that § 112(f) is invoked is rebutted. Since it is unusual to recite a step with no action words, step-plus-function limitations are rare.

A Word on “Generic Placeholders”

- Other words often stand in for “means”
- We call these generic placeholder words because they are holding the place for a named structure and have no specific structural meaning on their own
 - There is no exhaustive list of generic placeholders, but the following words have been treated as generic placeholders in particular circumstances: “mechanism,” “device,” “unit,” “module”

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CBT NARRATION:

Other words often stand in for “means”— we call these generic placeholder words because they are holding the place for a named structure and have no specific structural meaning on their own. Claim limitations that use these words are effectively claiming a function without any limits on how that function is performed since no structure is recited. As a result, the courts have expanded application of § 112(f) to certain claim limitations that do not use the word “means.” The concept of a generic placeholder has only been applied to means-plus-function limitations, and thus does not extend to step-plus-function limitations.

There is no exhaustive list of generic placeholders, but the following words have been treated as generic placeholders in particular circumstances: “mechanism,” “device,” “unit,” or “module.” It is important to remember that use of these words does not automatically result in § 112(f) interpretation. You must read the specification from the perspective of one of ordinary skill in the art to recognize whether a word has a reasonably well understood meaning in the art or whether it is just a generic word with no specific structural meaning relating to that function. There is no list of words that automatically results in § 112(f) interpretation, and likewise there is no list of words that avoids § 112(f) interpretation. Every case will turn on its own unique set of facts.

Consider these Presumptions When Identifying § 112(f) Language

- A claim limitation that does **not** use the term “means” or “step” creates a rebuttable presumption that the claim limitation is **not** interpreted under § 112(f)
 - This presumption is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function
 - Need to acknowledge the presumption and indicate when it is rebutted

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CBT NARRATION:

There are several presumptions to consider when identifying § 112(f) language. Both presumptions relate to the presence or absence of the statutory language “means” or “step.” However, the words of the claims, themselves, may rebut or overcome these presumptions.

The first presumption we will address is that a claim limitation that does not use the term “means” or “step” creates a rebuttable presumption that the claim limitation is not interpreted under § 112(f). Claim limitations devoid of “means” or “step” will be understood to be given their plain meaning.

This presumption is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function. This occurs when a generic placeholder is used instead of the word “means.” When this presumption is overcome, the claim limitation will be interpreted under § 112(f), thus changing its broadest reasonable interpretation, or BRI. Due to this change in interpretation, provide an explanation on the record to establish that § 112(f) claim interpretation is being used during examination.

This presumption is rarely if ever overcome by a process claim limitation that does not use the word “step” because, unlike for “means,” the courts have not indicated that a generic placeholder can be used instead of the word “step.”

Consider these Presumptions When Identifying § 112(f) Language (cont.)

- A claim limitation that explicitly uses the term “means” or “step” creates a rebuttable presumption that the claim limitation is interpreted under § 112(f)
 - This presumption is rebutted when the claim limitation recites sufficient structure, material or acts to entirely perform the recited function
 - “Step-plus-function” limitations are rare because claim steps typically use action words that rebut the presumption that § 112(f) applies
 - Need to acknowledge the presumption and indicate when it is rebutted

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CBT NARRATION:

The second presumption we will address is that a claim limitation that explicitly uses the term “means” or “step” creates a rebuttable presumption that the claim limitation is interpreted under § 112(f). This is the classic case of means-plus-function language. Set forth this presumption on the record so that claim limitations explicitly using “means” or “step” will be understood to be interpreted based on structure, material or acts disclosed in the specification (and equivalents thereof) as performing the recited function.

This presumption is rebutted when the claim limitation recites sufficient structure, material or acts to entirely perform the recited function. This can often happen when “means” is modified with a structural word, such as “a printer means for printing.” Remember § 112(f) is only pertinent when a function is recited. So, for example “a printer means” standing alone would not raise the presumption since no corresponding function is recited, and would also not be treated under § 112(f).

When the presumption is overcome, provide an explanation to establish that § 112(f) interpretation is not being used.

“Step-plus-function” limitations are rare because claim steps typically use action words that when used with the words “step for” would rebut the presumption that § 112(f) applies.

The Three Prong Test from MPEP 2181 for Identifying § 112(f) Claim Limitations

- Apply § 112(f) to a claim limitation if it meets the following 3-prong test:
 - (A) the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;
 - (B) the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and
 - (C) the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts for performing the claimed function

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CBT NARRATION:

MPEP 2181, subsection I, provides details regarding identifying § 112(f) language and sets forth a three-prong test. A claim limitation that meets the following 3-prong test will be interpreted under § 112(f).

Prong (A): the claim limitation uses the term “means” or “step” or a term used as a substitute for “means” that is a generic placeholder (also called a nonce term or a non-structural term having no specific structural meaning) for performing the claimed function;

Prong (B): the term “means” or “step” or the generic placeholder is modified by functional language, typically, but not always linked by the transition word “for” (e.g., “means for”) or another linking word or phrase, such as “configured to” or “so that”; and

Prong (C): the term “means” or “step” or the generic placeholder is not modified by sufficient structure, material, or acts to perform the claimed function.

The presumptions discussed earlier are apparent in this three-prong test. Claim limitations that do not meet the three-prong test are interpreted under the plain-meaning claim interpretation standard set forth in MPEP 2111. Not meeting the three-prong test will never result in a rejection under § 112(f), it simply controls how the BRI is evaluated.

It should be rare to be unable to determine if a word is a name for structure under Prong A. The best practice is to establish a position on claim interpretation based

on the words of the claim, the specification and the state of the art and examine for patentability based on that interpretation. If the interpretation is not evident, add explanatory remarks to the Office action so that the applicant can understand the position and respond accordingly.

Establish BRI and Examine for Patentability

- Establish the BRI of the § 112(f) and non-§ 112(f) claim limitations
- Once the claim interpretation has been established, examine the claims to determine if they satisfy all patentability requirements

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CBT NARRATION:

After analyzing the claim and determining whether there are any limitations that need to be interpreted under § 112(f), establish the BRI of the claim taking into account all of the words of the claim, including § 112(f) limitations and non-§ 112(f) limitations.

Remember, the BRI of a § 112(f) claim limitation is limited to the description in the specification of the structure (and equivalents) that performs the recited function. The BRI of a non-§ 112(f) claim limitation is its plain meaning in light of the specification (in other words, the ordinary and customary meaning given to the term by those of ordinary skill in the art at the time of the invention) unless the rare circumstance of a special definition or disclaimer occurs.

Once the claim interpretation has been established, examine the claims to determine if they satisfy all patentability requirements, particularly 35 U.S.C. §§ 101, 102, 103 and 112, along with non-statutory double patenting.

Preparing An Office Action

- When applicable, discussion of § 112(f) will appear toward the beginning of an Office action under the “CLAIM INTERPRETATION” heading
 - Remember, § 112(f) controls claim interpretation and is **not** the basis for a rejection
- This heading can also be used when the examiner determines that other clarifying claim interpretation remarks would benefit the prosecution record

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CBT NARRATION:

After the claim interpretation has been established and the claims have been examined with respect to all of the patentability provisions, an Office action will be prepared. Most examiners use OACS or OC to assist them with the preparation of an Office action. When applicable, in setting up an Office action, discussion of § 112(f) will appear toward the beginning of the Office action under the “CLAIM INTERPRETATION” heading, because § 112(f) controls claim interpretation and is not the basis for a rejection.

In explaining the claim interpretation, remember that § 112(f) applies to individual claim limitations/elements. There is no such thing as a “means-plus-function” claim; rather there are claims with means-plus-function limitations. Address when a claim limitation is first being interpreted under § 112(f). This will typically be in the first Office action or when the claim with such limitations is first introduced. Once the claim interpretation is established on the record, there is no need to repeat it in subsequent actions unless there is a change.

The “CLAIM INTERPRETATION” heading can also be used when the examiner determines that other clarifying claim interpretation remarks would benefit the prosecution record or when a special definition or disclaimer is set forth in the specification.

Make Full Use of an Office Action

- Use your Office action to provide additional explanation whenever prosecution decisions and/or positions can be clarified
- Office actions are not limited to rejections, objections, and formalities

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CBT NARRATION:

Make full use of an Office action by providing additional explanation whenever prosecution decisions and/or positions can be clarified. This will make prosecution more efficient and reduce work downstream.

Office actions are not limited to rejections, objections, and formalities. Adding clarifying remarks will enhance communication with the applicant and facilitate a meeting of the minds. Ways to enhance the record and provide additional remarks, when deemed helpful, include providing reasons why certain subject matter is allowable, explaining whether a priority document provides support for claimed subject matter, describing claim interpretation such as by identifying claim terms that are not given their plain meaning, noting the breadth of claim terms, especially when breadth is unsupported by the disclosure, or identifying § 112(f) language.

New Form Paragraphs

- The following three form paragraphs are being introduced to assist examiners in establishing claim interpretation under § 112(f) on the record and explaining the associated presumptions:

Broadest Reasonable Interpretation under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph: Use of "Means" (or "Step") in Claim Drafting and Rebuttable Presumptions	FP 7.30.05
35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, Invoked Despite Absence of "Means"	FP 7.30.06
35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, Not Invoked Despite Presence of "Means" or "Step"	FP 7.30.07

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CBT NARRATION:

New form paragraphs are being introduced to assist examiners in establishing claim interpretation under § 112(f) on the record and explaining the associated presumptions. There is now a tab in OACS and OC Office action wizard for Claim Interpretation. The new form paragraphs will be selectable under this tab. The new form paragraphs will replace 7.30.04 and 7.34.21, which previously set forth the presumptions and addressed the boundaries of § 112(f) limitations. The new form paragraphs include numbers 7.30.05, 7.30.06, and 7.30.07, all of which will be discussed in detail in the next few slides and will be available on the training resource page. The new form paragraphs will be used with existing form paragraphs 7.30.03.h and 7.30.03, which are the Claim Interpretation header and the text of the statute.

The new form paragraphs were designed based on feedback from examiners to be easier to use than the previous paragraphs 7.30.04 and 7.34.21. These old form paragraphs required additional explanation about overcoming the presumptions and written identification of the corresponding structure. The new form paragraphs explain when the presumptions are overcome and only require identification of the claim elements at issue.

New Form Paragraphs (cont.)

- The following three form paragraphs are to be used when § 112(f) issues are raised in an Office action

Header for Claim Interpretation	FP 7.30.03.h
Statement of Statutory Basis, 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph	FP 7.30.03
Broadest Reasonable Interpretation under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph: Use of "Means" (or "Step") in Claim Drafting and Rebuttable Presumptions Raised	FP 7.30.05

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CBT NARRATION:

The following three form paragraphs are to be used in an Office action when § 112(f) issues are present: The Header for Claim Interpretation Form Paragraph 7.30.03.h, the Statement of Statutory Basis, 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph Form Paragraph 7.30.03, and a new paragraph that establishes the Broadest Reasonable Interpretation under 35 U.S.C. § 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph: Use of "Means" (or "Step") in Claim Drafting and Rebuttable Presumptions Raised, which is Form Paragraph 7.30.05.

New Form Paragraph 7.30.05 – Explains the Applicability of § 112(f) and Presumptions

- Explains that § 112(f) limits the BRI
- Sets forth the three-prong test that the examiner has used to determine whether or not to apply § 112(f) to a certain claim limitation
- Sets forth the rebuttable presumptions associated with § 112(f)
- States that the presumptions will be followed unless an indication that they have been rebutted is included in the Office action

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CBT NARRATION:

New Form Paragraph 7.30.05 explains the applicability of § 112(f) and the presumptions. The paragraph explains that § 112(f) limits the BRI. It also restates the three-prong test that the examiner has used to determine whether or not to apply § 112(f) to a certain claim limitation, which can be used to confirm the analysis when drafting the action. It sets forth the rebuttable presumptions associated with § 112(f) and states that the presumptions will be followed unless an indication that they have been rebutted is included in the Office action.

This form paragraph was designed to assist the examiner in quickly identifying the claim interpretation and setting forth the presumptions on the record. No further explanation is required with this form paragraph, unless the examiner determines that additional clarification on claim interpretation would be useful.

While the identification of corresponding structure is no longer required when establishing claim interpretation, it would be appropriate to do so when making a rejection.

New Form Paragraph 7.30.06 – § 112(f) Invoked Despite Absence of “Means”

- Use this form paragraph in the Office action when a claim limitation does not use “means” but is being interpreted under § 112(f)
 - Identify the claim limitations where § 112(f) applies because a generic placeholder coupled with functional language is used instead of the word “means”

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CBT NARRATION:

New Form Paragraph 7.30.06 explains that § 112(f) has been invoked despite the absence of “means” in the claim limitation. When a claim limitation does not use “means” but is being interpreted under § 112(f), this paragraph assists the examiner in making this indication in the Office action. It explains that § 112(f) applies to one or more claim limitations that do not use the word “means” but instead use a generic placeholder that is coupled with functional language.

To use this form paragraph, the examiner only needs to identify the § 112(f) claim limitation, which will be the claim phrase with the generic placeholder and function, and the claim in which it appears. If multiple limitations are being interpreted under § 112(f), identify each instance. If additional explanation is deemed useful, remarks can be added after the identification of each limitation. For instance, an examiner might add the following explanation: “In this application the recited ‘module’ for printing in claim 1 has no structural meaning and is considered a generic placeholder.”

New Form Paragraph 7.30.07 – § 112(f) Not Invoked Despite Presence of “Means” or “Step”

- Use this form paragraph when a claim limitation uses the word “means” or “step” but is not being interpreted under § 112(f)
 - Identify the claim limitations where § 112(f) does not apply because sufficient structure or action to perform the function is recited with the word “means” or “step”

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CBT NARRATION:

New Form Paragraph 7.30.07 explains that § 112(f) is not invoked despite the presence of “means” or “step” in a claim limitation. When a claim limitation uses the word “means” or “step” but is not being interpreted under § 112(f), this form paragraph assists the examiner to indicate such in the Office action. It explains that § 112(f) does not apply to one or more claim limitations that use the word “means” or “step” but also recite sufficient structure or action to perform the function.

To use this form paragraph, the examiner only needs to identify the claim limitation that uses the word “means” or “step,” and the claim in which it appears. If multiple limitations use these words and are not being interpreted under § 112(f), identify each instance. If additional explanation is deemed useful, remarks can be added after the identification of each limitation. For instance, an examiner might add the following explanation: “In this application the recited ‘means’ for printing in claim 1 is modified by ‘printer,’ which is the structure that performs that function.”

Proper Response by Applicant

- An appropriate response to avoid interpretation under § 112(f) would be:
 - Amend the claim limitation to clearly recite a definite structure, material or act that entirely performs the recited function; or
 - Present a sufficient showing that the claim limitation recites a structure, material or act that entirely performs the recited function

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CBT NARRATION:

Let's review what a proper response looks like if the applicant does not agree with the examiner's claim interpretation relating to § 112(f). Remember, whether § 112(f) is invoked or not is controlled by the claim language, not by applicant's intent or mere statements to the contrary.

An appropriate response to avoid interpretation under § 112(f) would be to amend the claim limitation to clearly recite a definite structure, material or act that entirely performs the recited function; or to present a sufficient showing that the claim limitation recites a structure, material or act that entirely performs the recited function.

Proper Response by Applicant (cont.)

- An appropriate response to obtain interpretation under § 112(f) would be:
 - Amend the claim limitation to remove the structure, material or act that performs the recited function; or
 - Present a sufficient showing that the claim limitation does not recite any structure, material or act that entirely performs the recited function

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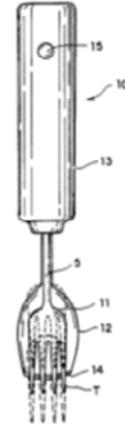
20

CBT NARRATION:

An appropriate response to obtain interpretation under § 112(f) would be to amend the claim limitation to remove the structure, material or act that performs the recited function; or to present a sufficient showing that the claim limitation does not recite any structure, material or act that entirely performs the recited function.

Example

The present invention of a cutlery apparatus is generally designated 10 in FIG. 1. The apparatus 10 is comprised of a number of primary components, namely a fork 11, a spoon 12, and handle 13. Disposed at the bottom most edge of the spoon 12 is a knife blade 14. A button 15 for the actuation of the mechanism contained within the handle 13 is disposed along the interior length of the handle 13. When the apparatus 10 is in a substantially vertical position, the button 15 can actuate the rotary mechanism of the spoon 12 with the knife blade 14 disposed thereon.



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CBT NARRATION:

Use of the new form paragraphs will be illustrated with this simple example that is technology neutral. This invention is based on U.S. Patent 4,922,611, but the claims are hypothetical. In this invention, a piece of cutlery has a fork and a spoon attached to a handle. The bottom most edge of the spoon is a knife blade. A motor is mounted in the handle and is actuated by a button on the handle to rotate the spoon around the fork. The fork is mounted on a spring within the handle to allow the fork to move in and out from the handle to assist in impaling food. In operation, the fork impales a piece of food, and when the button is activated, the motor causes the spoon with the knife blade to rotate around the fork to cut a circular piece from the food.

Use the sample action provided with this presentation to walk along with the examples in the following slides.

Hypothetical Claim 1

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a knife blade disposed adjacent to the fork and rotatably attached to the cutlery handle

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CBT NARRATION:

Hypothetical claim 1 reads:

A cutlery apparatus comprising:

a cutlery handle;

a fork movably engaged with the cutlery handle; and

a knife blade disposed adjacent to the fork and rotatably attached to the cutlery handle.

BRI of the Last Limitation of Claim 1

a knife blade disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation does not meet the three-prong test because it does not use the word “means” and does not recite a function associated with the knife blade
 - “Knife blade” is a recognized term for a structure
 - There is no indication that “knife blade” should be given anything other than its plain meaning in the art
 - Because § 112(f) is not invoked, the BRI of “knife blade” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades

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CBT NARRATION:

Of course, during examination the claim must be viewed as a whole and all of the limitations must be considered when establishing the BRI in light of the specification as it would be interpreted by one of ordinary skill in the art. For purposes of this discussion, however, we will focus only on the last limitation of claim 1.

Looking at the last limitation of claim 1, should this language be interpreted under § 112(f)?

This limitation does not meet the three-prong test because it does not use the word “means” and does not recite a function associated with the knife blade. “Knife blade” is a recognized term for a structure. There is no indication that “knife blade” should be given anything other than its plain meaning in the art. Because § 112(f) is not invoked, the BRI of “knife blade” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades.

Addressing BRI in the Office Action

- The last limitation of claim 1 does not invoke § 112(f) or use words that would raise any § 112(f) presumptions
- There is no need to address § 112(f) in the Office action

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CBT NARRATION:

The last limitation of claim 1 does not invoke § 112(f) or use words that would raise any § 112(f) presumptions. Therefore, there is no need to address § 112(f) in the Office action.

Note in the sample action, the "TIPS" indicate that if claim 1 was the only claim under examination, there would be no need to make any remarks in the action regarding § 112(f).

Hypothetical Claim 2

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

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CBT NARRATION:

Hypothetical claim 2 reads:

A cutlery apparatus comprising:

a cutlery handle;

a fork movably engaged with the cutlery handle; and

means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle.

BRI of the Last Limitation of Claim 2

means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation meets the three-prong test because it uses the word “means”, recites the function “cutting”, and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is invoked because it uses the word “means”
 - The words of the claim do not rebut that presumption (“means” is not modified by other words that denote structure)
 - Because § 112(f) is invoked, the BRI of “means for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure

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CBT NARRATION:

Again focusing just on the last limitation of claim 2, should this language be interpreted under § 112(f)?

This limitation meets the three-prong test because it uses the word “means”, recites the function “cutting”, and does not include any structure that can perform that function. It also raises the presumption that § 112(f) is invoked because it uses the word “means.” The words of the claim do not rebut that presumption since “means” is not modified by other words that denote structure. Because § 112(f) is invoked, the BRI of “means for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure.

Addressing BRI in the Office Action

The last limitation of claim 2 meets the three-prong test and therefore invokes § 112(f). The words of the claim do not rebut the presumption that the claim limitation is to be interpreted under § 112(f). There is no need to add further explanation.

To establish the § 112(f) interpretation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05

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CBT NARRATION:

The last limitation of claim 2 meets the three-prong test and therefore invokes § 112(f). The words of the claim do not rebut the presumption that the claim limitation is to be interpreted under § 112(f). There is no need to add further explanation.

To establish the § 112(f) interpretation, draft the Office action with the Claim Interpretation Header Form Paragraph 7.30.03.h, the Statutory Basis Form Paragraph 7.30.03, and Form Paragraph 7.30.05 to set forth the BRI, the three-prong test, and the presumptions.

Note in the sample action, the "TIPS" indicate that these form paragraphs are inserted to make record of § 112(f), but no further explanation is needed. If the examiner believes that further explanation would be beneficial, it can be added after the form paragraph.

Hypothetical Claim 3

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a device for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

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CBT NARRATION:

Hypothetical claim 3 reads:

A cutlery apparatus comprising:

 a cutlery handle;

 a fork movably engaged with the cutlery handle; and

 a device for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle.

BRI of the Last Limitation of Claim 3

a device for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “cutting” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the cutting function (the word “device” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “device for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure

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CBT NARRATION:

Focusing just on the last limitation of claim 3, should this language be interpreted under § 112(f)?

Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “cutting” and does not include any structure that can perform that function. It raises the presumption that § 112(f) is not invoked due to absence of “means.” However, the presumption is rebutted because no structure is recited that can perform the cutting function since the word “device” is a generic placeholder that does not denote structure.

Because § 112(f) is invoked, the BRI of “device for cutting” is limited to what is disclosed in the specification, which is a spoon with its bottom-most edge formed as a knife blade and equivalents to that structure.

Addressing BRI in the Office Action

- The last limitation of claim 3 meets the three-prong test and therefore invokes § 112(f). The last limitation of claim 3 does not use the word "means," but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f). Additional explanation is needed.
- To establish the § 112(f) interpretation and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Invoked Despite the Absence of "Means"	FP 7.30.06

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CBT NARRATION:

The last limitation of claim 3 meets the three-prong test and therefore invokes § 112(f). The last limitation of claim 3 does not use the word "means," but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f). Additional explanation is needed.

To establish the § 112(f) interpretation and provide an explanation, draft the Office action with the Claim Interpretation Header Form Paragraph 7.30.03.h, the Statutory Basis Form Paragraph 7.30.03, Form Paragraph 7.30.05 to set forth the BRI, the three-prong test, and the presumptions, and finish with Form Paragraph 7.30.06 to explain why the presumption is rebutted (in other words, § 112(f) invoked despite the absence of "means").

Note in the sample action, the "TIPS" indicate that for this form paragraph the examiner needs to identify the claim and claim limitation that raises the § 112(f) issue. If further explanation is needed it can be added after the form paragraph.

Hypothetical Claim 4

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle;
 - a device for cutting disposed adjacent to the fork; and
 - a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork

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CBT NARRATION:

Hypothetical claim 4 reads:

A cutlery apparatus comprising:

- a cutlery handle;
- a fork movably engaged with the cutlery handle; and
- a device for cutting disposed adjacent to the fork; and
- a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork.

BRI of the Last Limitation of Claim 4

a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “rotating” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the rotating function (the word “mechanism” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “a mechanism ... for rotating” is limited to what is disclosed in the specification, which is a motor and equivalents to that structure

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CBT NARRATION:

It has already been established that the device for cutting should be interpreted under § 112(f). The last limitation recites a mechanism mounted to the cutlery handle and coupled to the device for cutting for rotating the device around the fork to cut a circular path in food impaled by the fork.

Looking at the last limitation of claim 4, should this language also be interpreted under § 112(f)?

Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “rotating” and does not include any structure that can perform that function. It raises the presumption that § 112(f) is not invoked due to absence of “means.” However, the presumption is rebutted because no structure is recited that can perform the rotating function since the word “mechanism” is a generic placeholder that does not denote structure. Because § 112(f) is invoked, the BRI of the mechanism for rotating is limited to what is disclosed in the specification, which is a motor and equivalents to that structure.

Addressing BRI in the Office Action

- The last two limitations of claim 4 meet the three-prong test and therefore each invokes § 112(f). These limitations do not use the word “means,” but the words of each rebut the presumption that the claim limitations are not to be interpreted in accordance with § 112(f). Additional explanation is needed.
- To establish the § 112(f) interpretation and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Invoked Despite the Absence of “Means”	FP 7.30.06

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CBT NARRATION:

The last two limitations of claim 4 meet the three-prong test and therefore each invokes § 112(f). Remember that § 112(f) is a limitation by limitation analysis. These limitations do not use the word “means,” but the words of each rebut the presumption that the claim limitations are not to be interpreted in accordance with § 112(f). Additional explanation is needed.

To establish the § 112(f) interpretation and provide an explanation, draft the Office action with the Claim Interpretation Header Form Paragraph 7.30.03.h, the Statutory Basis Form Paragraph 7.30.03, Form Paragraph 7.30.05 to set forth the BRI, the three-prong test, and the presumptions, and finish with Form Paragraph 7.30.06 to explain why the presumption is rebutted (in other words, § 112(f) invoked despite the absence of “means”).

Note in the sample action, the “TIPS” indicate that for this form paragraph the examiner needs to identify the claim and claim limitation that raises the § 112(f) issue. If further explanation is needed it can be added after the form paragraph. In this case, two limitations of claim 4 require interpretation under § 112(f) and rebut the presumption, so each should be identified in the form paragraph.

There may be certain situations in which the same word is used repeatedly throughout a claim set as a generic placeholder for means. In such cases, after the examiner analyzes each instance to determine whether § 112(f) interpretation is

required, that word could be addressed in a single statement, such as by referring to “mechanism” in the first insert of the form paragraph and noting all the claims in which it appears and where § 112(f) interpretation is appropriate in the second insert of the form paragraph.

Hypothetical Claim 5

- The cutlery apparatus of claim 4, further comprising:
 - a unit disposed between the cutlery handle and the fork for biasing the fork with respect to the cutlery handle

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CBT NARRATION:

Hypothetical claim 5 reads:

The cutlery apparatus of claim 4, further comprising:

a unit disposed between the cutlery handle and the fork for biasing the fork with respect to the cutlery handle.

BRI of the Limitation of Claim 5

a unit disposed between the cutlery handle and the fork for biasing the fork with respect to the cutlery handle

- Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “biasing” and does not include any structure that can perform that function
 - Raises presumption that § 112(f) is not invoked due to absence of “means”
 - Presumption rebutted because no structure is recited that can perform the biasing function (the word “unit” is a generic placeholder that does not denote structure)
 - Because § 112(f) is invoked, the BRI of “unit ... for biasing” is limited to what is disclosed in the specification, which is a spring and equivalents to that structure

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CBT NARRATION:

Focusing just on the limitation of dependent claim 5, should this language be interpreted under § 112(f)?

Despite the absence of the word “means”, this limitation meets the three-prong test because it uses a generic placeholder coupled with the function “biasing” and does not include any structure that can perform that function. It raises the presumption that § 112(f) is not invoked due to absence of “means.” However, the presumption is rebutted because no structure is recited that can perform the biasing function since the word “unit” is a generic placeholder that does not denote structure.

Because § 112(f) is invoked, the BRI of the unit for biasing is limited to what is disclosed in the specification, which is a spring and equivalents to that structure.

Addressing BRI in the Office Action

- The limitation of claim 5 meets the three-prong test and therefore invokes § 112(f). The limitation does not use the word "means," but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f). Additional explanation is needed
- To establish the § 112(f) interpretation and provide an explanation for this dependent claim, draft the Office action with the paragraphs noted on slide 33 for claim 4 and include the "unit... for biasing" and claim 5 in the explanatory inserts for **FP 7.30.06**

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CBT NARRATION:

The limitation of claim 5 meets the three-prong test and therefore invokes § 112(f). The claim does not use the word "means," but the words of the claim rebut the presumption that the claim limitation is not to be interpreted in accordance with § 112(f). Additional explanation is needed.

To establish the § 112(f) interpretation and provide an explanation for this dependent claim, draft the Office action with the paragraphs noted on slide 33 for claim 4 and include appropriate remarks for dependent claim 5, in this case noting "unit for biasing" in claim 5, in the explanatory insert for FP 7.30.06.

Note in the sample action, the "TIPS" indicate that for this form paragraph the examiner needs to identify the claim and claim limitation that raises the § 112(f) issue. If further explanation is needed it can be added after the form paragraph.

Hypothetical Claim 6

- A cutlery apparatus comprising:
 - a cutlery handle;
 - a fork movably engaged with the cutlery handle; and
 - a knife blade means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

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CBT NARRATION:

Hypothetical claim 6 reads:

A cutlery apparatus comprising:

a cutlery handle;

a fork movably engaged with the cutlery handle; and

a knife blade means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle.

BRI of the Last Limitation of Claim 6

a knife blade means for cutting disposed adjacent to the fork and rotatably attached to the cutlery handle

- This limitation does not meet the three-prong test because even though it uses the word “means” coupled with the function “cutting”, it also recites a knife blade, which is structure that performs the recited function
 - Raises presumption that § 112(f) is invoked because it uses the word “means”
 - Presumption is rebutted because the limitation recites structure that can perform the cutting function (i.e., “a knife blade”)
 - Because § 112(f) is not invoked, the BRI of “a knife blade means for cutting” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades that can perform the cutting function

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CBT NARRATION:

Finally, focusing just on the last limitation of claim 6, should this language be interpreted under § 112(f)?

This limitation does not meet the three-prong test because even though it uses the word “means” coupled with the function “cutting”, it also recites a knife blade, which is a named structure that performs the recited function. It raises the presumption that § 112(f) is invoked because it uses the word “means.” That presumption is rebutted because the limitation recites structure that can perform the cutting function (i.e., “a knife blade”). Because § 112(f) is not invoked, the BRI of “a knife blade means for cutting” would be its plain meaning, which those of ordinary skill in the art would recognize as covering a wide variety of blades that can perform the cutting function.

Addressing BRI in the Office Action

The last limitation of claim 6 does not meet the three-prong test and therefore does not invoke § 112(f). The last limitation of claim 6 uses the word “means,” but the words of the claim rebut the presumption that the claim limitation is to be interpreted in accordance with § 112(f). Explanation is needed.

To establish that § 112(f) interpretation is not being used and provide an explanation, draft the Office action with:

Claim Interpretation Header	FP 7.30.03.h
Statutory Basis	FP 7.30.03
BRI, Three-Prong Test, and Presumptions	FP 7.30.05
Presumption Rebutted - § 112(f) Not Invoked Despite Presence of “Means” or “Step”	FP 7.30.07

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CBT NARRATION:

The last limitation of claim 6 does not meet the three-prong test and therefore does not invoke § 112(f). Since the last limitation of claim 6 uses the word “means,” and the words of the claim rebut the presumption that the claim limitation is to be interpreted in accordance with § 112(f), explanation is needed.

To establish that § 112(f) interpretation is not being used and provide an explanation, draft the Office action with the Claim Interpretation Header Form Paragraph 7.30.03.h, the Statutory Basis Form Paragraph 7.30.03, Form Paragraph 7.30.05 to set forth the BRI, the three-prong test, and the presumptions, and finish with Form Paragraph 7.30.07 to explain why the presumption is rebutted (in other words, § 112(f) not invoked despite the presence of “means”).

Note in the sample action, the “TIPS” indicate that for this form paragraph the examiner needs to identify the claim and claim limitation that raises the § 112(f) issue. If further explanation is needed it can be added after the form paragraph.

Summary

- Interpretation under § 112(f) is triggered by claim language and is not optional
- Noting § 112(f) interpretation in an Office action benefits the examiner, the applicant and the public
- Use the new form paragraphs to make § 112(f) interpretation on the record

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CBT NARRATION:

In summary, interpretation under § 112(f) is triggered by claim language and is **not** optional.

Noting § 112(f) interpretation in an Office action benefits the examiner, the applicant, and the public.

Finally, use the new form paragraphs to make § 112(f) interpretation on the record.

Questions and Follow-up

- See your SPE or QAS for questions
- Additional resources can be found on the “35 U.S.C. § 112(f) Examination Guidance and Training Materials” Web page:
<http://ptoweb.uspto.gov/patents/exTrain/112f.html>

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CBT NARRATION:

Please see your SPE or QAS with questions. Additional resources and training on identifying 112(f) limitations can be found on the internal microsite called “35 U.S.C. § 112(f) Examination Guidance and Training Materials.”