

**UNIT: 35 U.S.C. 112(f)**

*(35 U.S.C. 112, sixth paragraph for pre-AIA applications filed before 9/16/2012)*

**Section: Making the Record Clear for Means-Plus-Function Claims**

The prosecution record should be clarified in the following situations:

- When a claim uses the word “means,” and § 112(f) is not invoked.
- When a claim uses a substitute for the word “means” (a generic placeholder), and § 112(f) is invoked.
- See MPEP 2181(I) for how to determine whether § 112(f) is invoked and MPEP 2181(VI) for clarifying the record.

In the above situations, use form paragraph 7.30.04, which sets forth the rebuttable presumptions raised with the use (or lack of use) of “means” language, as explained below.

- Use of the word “means” in a claim creates a rebuttable presumption that the claim element **is** to be treated in accordance with 35 U.S.C. § 112(f). The presumption that § 112(f) is invoked is rebutted when “means” is not modified by function or when the function is recited with sufficient structure or material within the claim itself to perform the recited function.
- Absence of the word “means” in a claim creates a rebuttable presumption that the claim element **is not** to be treated in accordance with 35 U.S.C. § 112(f). The presumption that § 112(f) is not invoked is rebutted when the claim element recites function but fails to recite sufficiently definite structure or material to perform that function.
  - Form paragraph 7.30.04 needs to be used only once during prosecution. The paragraph can be used at the first Office action, when “means” language is introduced, or at the time § 112(f) is first considered.
  - Further explanation should be provided if the presumptions are rebutted by the claim language.
    - ⇒ For example, if a claim limitation uses “means,” but the term is not modified by functional language or the limitation includes sufficient structure to perform the function, a statement in the Office action should explain the reasons why the claim limitation is not being treated under § 112(f).

*Sample Statement when no function is recited:* The limitation of claim **[insert claim number(s)]** that recite(s) **[identify applicable limitation or identify a group of limitations, for example those that recite “means”]** is/are not being treated in accordance with 35 U.S.C. 112(f) because the means recitation does not have an associated function.

*Sample Statement when structure is recited:* The limitation of claim **[insert claim number(s)]** that recite(s) **[identify applicable limitation or identify a group of limitations, for example those that recite “means”]** is/are not being treated in accordance with 35 U.S.C. 112(f) because the claimed function is modified by specific structure that performs the function.

- ⇒ For example, if a claim limitation does not use “means,” but instead uses a substitute word or generic placeholder that is coupled to a function without any

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structure that performs the function, a statement in the Office action should explain the reasons why the claim limitation is being treated under § 112(f).

*Sample Statement for a generic placeholder that is a “means” substitute:* The limitation of claim **[insert claim number(s)]** that recite(s) **[identify claim language that is a generic placeholder having no specific structure to perform the associated function]** is/are being treated in accordance with 35 U.S.C. 112(f) because the claimed function is modified by a word that is merely a generic placeholder (i.e., the claim uses a term that is a substitute for “means”) without specific structure that performs the function.

- Form ¶ 7.34.16 may be used when it is unclear whether applicant intends to invoke § 112(f) because “means” is used along with a term that *may* indicate structure or material.
- Form ¶ 7.34.21 may be used when “means” is not used but the function is not modified by structure. If more than one claim element needs to be addressed, the explanation may be consolidated so that the form paragraph need only be used once in the action.
- Form ¶ 7.34.17 may be used when applicant asserts that the claim should be treated under § 112(f) but “means” is not used and thus invocation of §112(f) is unclear.
- Form ¶ 7.34.22 may be used when applicant asserts that the claim should not be treated under § 112(f) but no structure is recited to perform the claimed function and thus invocation of §112(f) is unclear.