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This heading only needs to be used when the action includes remarks regarding claim interpretation.

If Hypothetical claim 1 was the only claim under examination, there would be no need to use this heading.

See slide 24.

This paragraph establishes the BRI and presumptions relating to § 112(f) interpretation. It also states the three prong test from MPEP 2181 for quick reference. It only needs to be used once during prosecution.

This paragraph is needed for Hypothetical claims 2-6, since each of them raise issues relating to § 112(f) interpretation.

See slides 27, 30, 33, 36, 39.

Sample Office action excerpt for hypothetical claims 1-6

[FP 7.30.03.h]

CLAIM INTERPRETATION

[FP 7.30.03]

The following is a quotation of 35 U.S.C. 112(f):

(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The following is a quotation of pre-AIA 35 U.S.C. 112, sixth paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

[FP 7.30.05]

The claims in this application are given their broadest reasonable interpretation using the plain meaning of the claim language in light of the specification as it would be understood by one of ordinary skill in the art. The broadest reasonable interpretation of a claim element (also commonly referred to as a claim limitation) is limited by the description in the specification when 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is invoked.

As explained in MPEP 2181, subsection I, claim limitations that meet the following three-prong test will be interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph:

(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.

Use of the word “means” (or “step”) in a claim with functional language creates a rebuttable presumption that the claim limitation is to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is rebutted when the claim limitation recites sufficient structure, material, or acts to entirely perform the recited function.

TIPS

If claim 2 was the only claim under examination, this section could end here. The Office action would then continue on by addressing whether the claims given their BRI meet the requirements for patentability.

This paragraph establishes § 112(f) interpretation despite the absence of “means.”

Yellow highlighted **insert 1** identifies the claim limitation, which recites a function along with a generic placeholder, that is being interpreted under § 112(f).

Green highlighted **insert 3** identifies the claim in which the limitation appears.

See slide 30.

When multiple § 112(f) limitations need explanation, they can be handled in a single paragraph.

This is the same way other form paragraphs are used. For example, when a claim has a number of terms or phrases that are indefinite, the Office action would list each term or phrase.

See slide 33.

Absence of the word “means” (or “step”) in a claim creates a rebuttable presumption that the claim limitation is not to be treated in accordance with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph. The presumption that the claim limitation is not interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, is rebutted when the claim limitation recites function without reciting sufficient structure, material or acts to entirely perform the recited function.

Claim limitations in this application that use the word “means” (or “step”) are being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action. Conversely, claim limitations in this application that do not use the word “means” (or “step”) are not being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, except as otherwise indicated in an Office action.

[FP 7.30.06]

This application includes one or more claim limitations that do not use the word “means,” but are nonetheless being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, because the claim limitation(s) uses a generic placeholder that is coupled with functional language without reciting sufficient structure to perform the recited function and the generic placeholder is not preceded by a structural modifier. Such claim limitation(s) is/are: **a device for cutting** in claim **3**.

Because this/these claim limitation(s) is/are being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, it/they is/are being interpreted to cover the corresponding structure described in the specification as performing the claimed function, and equivalents thereof.

If applicant does not intend to have this/these limitation(s) interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, applicant may: (1) amend the claim limitation(s) to avoid it/them being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph (e.g., by reciting sufficient structure to perform the claimed function); or (2) present a sufficient showing that the claim limitation(s) recite(s) sufficient structure to perform the claimed function so as to avoid it/them being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.

[To address multiple claim limitations Use FP 7.30.06, as follows:]

... Such claim limitation(s) is/are: **a device for cutting** and **a mechanism for** in claim **4**. ...

[Examiners can add the insertions in any manner they choose, for instance a list or a chart. Depending on the results of the examiner’s claim interpretation analysis, it may be useful to provide a single explanation regarding repeated use of certain words in the particular claims at issue being used as substitutes for means.]

TIPS

If explanation is needed for dependent claims with § 112(f) limitations and the appropriate form paragraphs are already being used, the dependent claims can be added too.

See slide 36.

This paragraph establishes that § 112(f) interpretation is not being used despite the presence of “means.”

Yellow highlighted **insert 1** identifies the claim limitation, which recites a function along with the structure that performs the function, that is not being interpreted under § 112(f) despite the use of “means.”

Green highlighted **insert 2** identifies the claim in which the limitation appears.

See slide 39.

Sample Office action excerpt for hypothetical claims 1-6

[Dependent claims can also be added when using FP 7.30.06]

...Such claim limitation(s) is/are: a device for cutting in claim 4; a mechanism for rotating the device in claim 4; a unit for biasing the fork in claim 5. ...

[FP 7.30.07]

This application includes one or more claim limitations that use the word “means” or “step” but are nonetheless **not** being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph because the claim limitation(s) recite(s) sufficient structure, materials, or acts to entirely perform the recited function. Such claim limitation(s) is/are: a knife blade means for cutting in claim 6.

Because this/these claim limitation(s) is/are **not** being interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, it/they is/are **not** being interpreted to cover only the corresponding structure, material, or acts described in the specification as performing the claimed function, and equivalents thereof.

If applicant intends to have this/these limitation(s) interpreted under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, applicant may: (1) amend the claim limitation(s) to remove the structure, materials, or acts that performs the claimed function; or (2) present a sufficient showing that the claim limitation(s) does/do not recite sufficient structure, materials, or acts to perform the claimed function.