

## When is a Claim Element a Means-Plus-Function Claim Element?

### Should a bright line be used relating to § 112(f)?

- Yes: Clarity would be much improved if § 112(f) only applied if the word “means” is used. Software limitations recited in the claims in functional terms must include more than just a repeat of the recited function.
- No: Caselaw provides ample clarity of when § 112(f) applies. Nonce words used as a substitute of the word “means” should be treated no differently.

### Background

- An applicant may opt to claim functionally with or without relying on 112(f). If the applicant chooses to claim an element functionally without using 112(f), the claim element simply covers any structure/material/acts capable of performing that function.
- Means-plus-function (MPF) claim limitations have been statutorily authorized since the Patent Act of 1952 overturned *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).
  - § 112(f): 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**.
- *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) held that use of the term “means” creates a rebuttable presumption that a claim term is a MPF limitation. This presumption may be rebutted if the claim recites structure sufficient to perform the described functions in their entirety.

### Example

- A claim directed toward a “fastening means” appears quite broad on its face as covering all conceivable ways of fastening, but the term would likely be quite narrowly interpreted if the patent specification is also narrowly drafted. If the specification disclosed a “nail” as its only example, the court would likely limit “fastening means” to only include nails and their equivalents. *Id.* (“structure ... described in the specification and equivalents thereof.”).

### MPF Usage

- Percentage of patents with MPF limitations declined from about **50%** in the 1980s to less than about **5%** presently, as reported by Dennis Crouch in November 2023. The decline is likely due to MPF claim limitations being given a narrow interpretive scope by being “construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” under § 112(f).
- While some practitioners advocated use of MPF limitations to enhance survival rates in review proceedings, the practice has not been embraced. Dennis Crouch’s data shows use of MPF

limitations dropped by about half since passage of the AIA (from more than 10% to less than about 5%).

### **Implementation of *Williamson***

- Since *Williamson*, examiners interpret limitations under § 112(f) under a three-prong test in MPEP § 2181:
  - (A) claim limitation uses “means” or a similar nonce term;
  - (B) means or nonce term modified by functional language — “such that” or “for”;
  - (C) such term not modified by sufficient structure.
- Anecdotally, MPF limitations complicate prosecution and their rejections likely contribute to declined usage of MPF limitations. MPF limitations may be construed broadly by examiners and result in written description or other 112 rejections. Such constructions are sometimes due to interpretations of “**and equivalents thereof**.”
- A 112 rejection of MPF limitation in biotech case based on reasoning regarding “equivalents thereof” led to USPTO’s motion for remand, which was granted on January 23, 2024 in *In re Xencor*, Fed. Cir. Appeal No. 2023-2048, PTAB Appeal No. 2022-001944. Order indicates a more thorough evaluation is expected from the USPTO.
- *Williamson* provides flexibility so that decision makers can reach correct decision. However, prosecutors may create a confusing record, especially when nonce words are used as a substitute for the word “means” or following “means” while still claiming pure function.
  - In review proceedings, petitioners face navigational task to attack a MPF limitation when the record is unclear about patent owner’s reliance on § 112(f). Below is the guidance on MPF limitations in the Consolidated Trial Practice Guide.

a petitioner must provide a construction that includes both the claimed function and the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function. 37 C.F.R. § 42.104(b)(3). A party may choose to elaborate why § 112(f) should or should not apply to the limitation at issue. . . . A petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).

### **Proposals**

- For any element invoking 112(f), require applicant to clearly point out the corresponding structures/materials/acts. This is already required for appeal briefs (37 CFR 41.37(c)(1)(iii)). It might even help to go so far as requiring that for any claim element containing functional language (regardless of whether it invokes 112(f)), the applicant must clearly point out the structures/materials/acts that perform the recited function.
- In initial examination, assign cases with MPF limitations to Quality Assurance Specialists for each Technology Group to review analysis by examiners to ensure consistency and to ensure that patent applicants are providing sufficient clarity in the record to reduce ambiguity.