



**FOGG & POWERS** LLC

INTELLECTUAL PROPERTY LAW

5810 West 78th Street, Suite 100

Minneapolis, MN 55439

[www.fogglaw.com](http://www.fogglaw.com)

## Examining Corps and BPAI at Odds Over Means-Plus-Function Claims

### Sample Terms deemed by the BPAI to invoke 35 U.S.C. 112, 6th paragraph

- Generic claim terms such as 'unit' or 'device'
- Applicant created claim terms such as nouns formed from combining verbs with an 'er' ending (e.g. initializer)

The Board of Patent Appeals and Interferences (BPAI) and the Patent Examining Corps apply different standards to identify means-plus-function claims under 35 U.S.C. 112, 6th paragraph. In particular, the most recent memorandum<sup>1</sup> to the Patent Examining Corps regarding means-plus-function language was issued in September 2008 by the Deputy Commissioner for Patent Examination Policy. The memorandum addressed both when claims invoke 35 U.S.C. 112, 6th paragraph as means-plus-function claims as well as analysis of such means-plus-function claims under 35 U.S.C. 112, 2nd paragraph. With respect to invoking 35 U.S.C. 112, 6th paragraph, the memorandum reiterated the 3-prong test set forth in MPEP 2181 which requires the use of “means for” or “step for” language to invoke 35 U.S.C. 112, 6th paragraph. Although the Patent Examining Corps has been given direction regarding when to interpret a limitation as a mean-plus-function limitation, the BPAI is under no obligation to adhere to the instructions in the memorandum. Indeed, our review of recent decisions of the BPAI

revealed that the BPAI continues to take a broader view of when to invoke 35 U.S.C. 112, 6th paragraph. For example, the list provided to the left summarizes some general terms which the BPAI has deemed invoke 35 U.S.C. 112, 6th paragraph without the use of ‘means for’ or ‘step for’ language. In determining whether to appeal a rejection to the BPAI, it may be beneficial to analyze rejected claims for such claim terms even if the examiner has not invoked 35 U.S.C. 112, 6th paragraph.

<sup>1</sup> Memorandum to Patent Examining Corps, *Rejections under 35 U.S.C. 112, second paragraph, when examining means (or step) plus function claim limitations under 35 U.S.C. 112, sixth paragraph*, September 2, 2008.

**Please feel free to contact us at 952.465.0770 if you would like to discuss our findings in more detail.**



**FOGG & POWERS** LLC  
INTELLECTUAL PROPERTY LAW