



American Intellectual Property Law Association

June 17, 2024

The Honorable Kathi Vidal
Undersecretary of Commerce for Intellectual
Property and Director of the United States
Patent and Trademark Office
600 Dulany Street Alexandria, VA 22314
Submitted electronically via: Federal eRulemaking Portal (www.regulations.gov)

**Re: Docket No. PTO-P-2023-0045 Request for Comments on Resources for
Examining Means-Plus-Function and Step-Plus-Function Claim Limitations
(March 20, 2024)**

Dear Director Vidal:

AIPLA appreciates the opportunity to reply to the request for comments of March 20, 2024, from the United States Patent and Trademark Office (“USPTO” or “Office”) regarding “Resources For Examining Means-Plus-Function And Step-Plus-Function Claim Limitations (35 U.S.C. 112(f)).”

AIPLA is a national bar association of approximately 7000 members that include patent attorneys, patent agents, and other IP professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

On March 18, 2024, the USPTO issued a memorandum to all Patent Examiners entitled “Resources For Examining Means-Plus-Function And Step-Plus-Function Claim Limitations (35 U.S.C. 112(f))” (the “Memorandum”). The Memorandum is intended to provide guidance to examiners in reviewing and properly addressing means-plus function (“MPF”) and step-plus-function (“SPF”) claim limitations and to ensure clarity of the record for applicants, the public, and the courts.

AIPLA agrees with the Office that it is important for examiners to apply consistent analysis to MPF and SPF claim limitations to produce a clear prosecution record and clear communications on the examiner’s interpretation of these claim limitations. AIPLA believes that the Memorandum is helpful in this regard but can be improved to ensure the guidance more directly addresses any ongoing uncertainty surrounding MPF and SPF claim limitations.

Executive Summary of Comments

First, AIPLA suggests that the Memorandum be updated to reflect the May 18, 2024 decision of the Appeals Review Panel of the Patent Trial and Appeal Board (the “ARP”) in *Ex parte Chamberlain*.¹ The ARP disagreed with the Board that a patent specification must disclose or describe the equivalents of the corresponding structure...for a means-plus-function claim limitation to meet the requirements of written description and definiteness under 35 U.S.C. § 112.

Second, AIPLA is concerned about the uncertainty surrounding clarity and scope interpretation in determining both the applicability of § 112(f) and the § 112(a) requirements for MPF and SPF claim limitations and recommends that clarification is needed on this point.

Update of Memorandum Recommended in View of Ex Parte Chamberlain Decision

In May 2024, the ARP released its decision in *Ex parte Chamberlain*² (referred to in proceedings as *In re Xencor*³). The case revolved around a patent application filed by Xencor Inc. The dispute centered on a claim in Jepson format and another utilizing means-plus-function language. Following the final written decision of the USPTO’s Patent Trial and Appeal Board (“PTAB”) rejecting the two relevant claims, Xencor appealed the decision to the Federal Circuit. Subsequently, the Director of the USPTO moved to remand the case back to the ARP to “clarify the USPTO’s position on the proper analysis of...means-plus-function claims in the field of biotechnology.”⁴

Prior to the ARP proceedings, on October 6, 2023, AIPLA filed an amicus brief with the CAFC in *In re Xencor*, at that time on appeal from the PTAB. Among the issues argued in *In re Xencor* was the question of whether the specification provided sufficient disclosure to satisfy the written description requirement of a MPF claim where the patentee disclosed only a single structure and no potential equivalents. In its brief, AIPLA submitted that for claims invoking § 112(f), the specification need only disclose a single structure for each means limitation, not “equivalents thereof.” 35 U.S.C. § 112(f) states:

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 PTAB had ruled that, under § 112(f), equivalents require explicit written description support. AIPLA took the contrary position in its amicus brief, writing that “adequate disclosure of a single structure corresponding to the means limitation satisfies the requirements for “the

¹ *Ex parte Chamberlain*, Appeal No. 2022-001944.

² *Id.*

³ *In re Xencor Inc.*, No. 23-2048 (Fed. Cir. Jan. 23, 2024).

⁴ *Id.* at 1.

apparatus disclosed . . . and [the] equivalents thereof.” *In re Knowlton*, 481 F.2d 1357, 1362 (C.C.P.A. 1973).⁵ AIPLA further explained:

The disclosure requirement for claims invoking Section 112(f) contrasts with the disclosure requirement for genus claims, i.e., “[a] claim encompassing two or more disclosed embodiments.” *Billups-Rothenberg, Inc. v. Associated Reg'l & Univ. Pathologists, Inc.*, 642 F.3d 1031, 1037 (Fed. Cir. 2011). Unlike a claim invoking Section 112(f), a genus claim may be construed to encompass structures that are not structural “equivalents.” See *id.* [...]

By contrast, a claim invoking Section 112(f) need only disclose a single structure for each means limitation because the disclosed structure is necessarily representative of and/or has structural features common to its “equivalents.” See, e.g., *D.M.I., Inc. v. Deere Co.*, 755 F.2d at 1574; *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999).⁶

The CAFC granted the USPTO’s motion to remand the case. On remand, the ARP “disagree[d] with the Board that the Specification must disclose or describe the equivalents of the corresponding structure, in this case 5 G 1.1, for a means-plus-function claim limitation under 35 U.S.C. § 112 ¶ 6, in order to meet the requirements of § 112 ¶ 1 (written description) and ¶ 2 (definiteness).”⁷ The ARP stated:

It is true that § 112 ¶ 6 provides that a means-plus-function element “shall be construed to cover the corresponding structure, material, or act described in the specification and equivalents thereof” *Id.* That is, the claim is interpreted to cover both the corresponding structure, material, or act described in the Specification, as well as equivalents of that structure, material, or act. Notably, § 112 ¶ 6 does not state that the Specification must also describe equivalents of that structure. If Congress had intended the statute to require a description of equivalents, it could have placed “and equivalents thereof” before “described in the specification,” which it did not do.⁸

While the *Ex Parte Chamberlain* ARP decision has not yet been designated as precedential or informative,⁹ noting the decision is consistent with AIPLA’s position in its amicus brief in *Xencor*, AIPLA encourages the Office to update the Memorandum with guidance in accordance with this decision.

Update of Memorandum Recommended Due to Lack of Clarity on 35 U.S.C. § 112(a) Requirements for MPF and SPF Claim Limitations

AIPLA suggests that the Memorandum is unclear and thus potentially misleading because examiners are not provided with sufficient guidance on *how* to apply the written description requirements under 35 U.S.C. § 112(a) to § 112(f) limitations. For example, the Memorandum does not address how equivalents under § 112(f) should be considered. Moreover, the Memorandum does not remind examiners that the disclosure requirement for

⁵ [2023.10.06-\(18\)-brief-aipla.pdf](#)

⁶ *Id.*

⁷ *Ex parte Chamberlain*, Appeal No. 2022-001944.

⁸ *Id.*

⁹ [Precedential and informative decisions | USPTO](#)

claims invoking § 112(f) contrasts with the disclosure requirement for genus claims as discussed by AIPLA in its amicus brief in *Xencor* (referenced above)¹⁰ The Memorandum references aspects of § 112(a) in its discussion on indefiniteness under § 112(b):

It is important to note that when § 112(f) is invoked, the scope of the claim is limited to the particular structure disclosed, together with equivalents. Definiteness is not the same as enablement, which requires only the disclosure of sufficient information so that a person of ordinary skill in the art could make and use the invention.¹¹

However, additional guidance on the application of § 112(a) to § 112(f) limitations is vague. AIPLA recommends that the Memorandum be updated to clarify the impact of the decision in *Ex Parte Chamberlain* when considering the fulfilment of § 112(a) requirements regarding equivalents. AIPLA also recommends that the Memorandum be updated to remind examiners of the differences between the application of § 112(a) to § 112(f) claims versus a genus claim encompassing two or more embodiments of an invention.

Update of Memorandum Recommended Due to Lack of Clarity on Claim Scope Interpretation

Finally, the Memorandum addresses claim scope considerations to be made when determining the applicability of § 112(f) to a claim limitation:

Drafting claims with limitations that comply with § 112(f) can be beneficial to applicants by allowing them to recite a function in a claim and rely on the specification for the corresponding structure, material, or acts that perform the function and equivalents thereof. [...] Under this statutory construction, when an examiner determines the broadest reasonable interpretation of a claim, a limitation that invokes § 112(f) must be limited to the structure, material, or acts described in the specification as performing the entire claimed function and equivalents to the disclosed structure, material, or acts. As a result, § 112(f) limitations will, in some cases, be afforded a narrower interpretation than a limitation that is not crafted in means-plus-function or step-plus-function format. This is an important distinction when searching for and applying prior art.¹²

AIPLA believes this section would benefit from additional clarity and attention. For example, the Memorandum implies that examiners might apply a narrower interpretation of a claim to § 112(f) limitations when reviewing claims under the “broadest reasonable interpretation” (BRI) standard. AIPLA believes this guidance is confusing. We encourage the Office to remind examiners that they must conduct an examination according to applicable law and current examination policy as found in the MPEP and training materials, not the Memorandum. MPF interpretation is grounded in statutory law, and during examination, the determination that claim

¹⁰ [2023.10.06-\(18\)-brief-aipla.pdf](#)

¹¹ [Resources for Examining Means-Plus-Function and Step-Plus-Function Claim Limitations \(35 U.S.C. 112\(f\)\) \(uspto.gov\)](#)

¹² *Id.*

scope is limited by virtue of its MPF or SPF attribute is heavily context-dependent, and should not be presumed, lest it affect the later-stage analysis of § 112(a) requirements regarding equivalents. Moreover, how does the examiner determine the breadth of a claim with a § 112(f) limitation absent more guidance, particularly in view of the discussion above regarding equivalents and the decision in *Ex parte Chamberlain*? Clarity is needed to ensure these pitfalls are consistently avoided, and that examiners understand how to properly apply prior art and §§ 112(a) and 112(b) to MPF and SPF claims.

Summary

Ensuring consistency and predictability in § 112(f) determinations is important, as are clear prosecution records and communications between the USPTO and applicants. We believe, however, that the Memorandum has not presented enough to alleviate stakeholders' concerns regarding the uncertainty surrounding the protectability of § 112(f) claims in light of recent USPTO decisions. Rather, the Memorandum introduces further uncertainty on clarity and scope interpretation in determining both the applicability of § 112(f) and the § 112(a) requirements for MPF and SPF claim limitations. We therefore strongly urge the Office to provide further clarification regarding considerations of scope interpretation and § 112(a) requirements for MPF and SPF claim limitations, particularly in view of the recent ARP decision in *Ex parte Chamberlain*.

Conclusion

AIPLA gratefully acknowledges the efforts by the USPTO to improve patent prosecution and appreciates the opportunity to provide our views on these important issues. We are happy to discuss these matters further or respond to any questions you may have.

Sincerely,

A handwritten signature in cursive script that reads "Ann M. Mueting".

Ann M. Mueting
President
American Intellectual Property Law Association