# §112 SUBCommittee RESPONSES TEMPLATE

Here we maintain a template of responses to 35 U.S.C. § 112 rejections from the United States Patent and Trademark Office. Each response is directed to a rejection under § 112. These responses are exemplary; a sample response included here might not be ideal for every situation. Use them at your own risk.\*

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**AIPLA TEMPLATE § 112 RESPONSES**

**Rejection Under 35 U.S.C. § 112(a) or 35 U.S.C. §112 (pre-AIA), First Paragraph, as Allegedly Failing to Comply with Enablement Requirement**

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

**(a) In General.—**The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

At pages \_\_ [PAGE Number] of the Office Action, claims \_\_ [Claim Numbers] were rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as allegedly failing to comply with the enablement requirement. According to the Office, “….” [citing relevant assertions made by the Office].

With respect to claims \_\_, this rejection has been rendered moot by the cancellation of these claims.

Or,

With respect to claims \_\_, Applicant respectfully disagrees and traverses the rejection for the following reasons.

1. **Legal Standard**

The enablement requirement under 35 U.S.C. § 112(a) or 35 U.S.C. §112, first paragraph, requires that “[t]he information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to make and use the claimed invention” without “undue experimentation.” M.P.E.P. § 2164.01. (citing In re Wands*,* 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 (Fed. Cir. 1988)). As the Office is aware, “[d]etailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention.” M.P.E.P. § 2164.01(b). “As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied.” M.P.E.P. § 2164.01(b) (citing In re Fisher, 427 F.2d 833,839,166 U.S.P.Q. 18, 24 (C.C.P.A. 1970)).

The Federal Circuit in In re Wands *(*858 F.2d 731 (Fed. Cir. 1988)) set forth eight factors that must be considered when determining if a disclosure would not require undue experimentation and thus satisfy the enablement requirement:

1. The breadth of the claims;
2. The nature of the invention;
3. The state of the prior art;
4. The level of one of ordinary skill in the art;
5. The level of predictability in the art;[[1]](#footnote-1)
6. The amount of direction provided by the inventor;
7. The existence of working examples; and
8. The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In order to make a rejection, the Office has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

Thus, the issue is whether Applicants’ disclosure, considering the level of those skilled in the art as of the date of Applicants’ application, would have enabled a person of such skill to make Applicants’ invention without undue experimentation. The threshold step in resolving this issue as set forth above is to determine whether the Office has met its burden of proof by advancing acceptable reasoning inconsistent with enablement. See Ex parte Hicks, 2007-2715 (Nov. 13, 2007)[Informative]. This the Office has not done.

Enablement requires that the specification teach those in the art to make and use the invention without 'undue experimentation. “That *some* experimentation may be required is not fatal; the issue is whether the amount of experimentation required is not 'undue."' In re Vaeck, 947 F.2d 488, 495 (Fed. Cir. 1991) (citation omitted, emphasis in original). "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." In re Wands, 858 F.2d 73 1, 737 (Fed. Cir. 1988). The factual considerations discussed in Wands are: (1) the quantity of experimentation necessary to practice the invention, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

1. **Claims \_\_ are Enabled**

Applicant submits that the specification enables the claimed [product or method] for at least the following reasons.

1) The breadth of the claims and the nature of the invention and 2) the nature of the invention

Claims \_\_ are directed to …[claimed subject matter]. The nature of the invention is simple for a skilled artisan in the relevant art to practice.

3) the state of the prior art; 4) the level of one of ordinary skill in the art; 5) the level of predictability in the art [BEWARE: PITFALL – many arguments we make here may be used by the Examiner in an obviousness rejection]

The structures and properties of the [composition or product] recited in the claims are known to those skilled in the art, [or, “all the methods needed to practice the invention were well known”]. Those skilled in the art can easily identify the [composition, product, or methods needed to practice the invention], covered by the claims, as the Office did at pages \_\_ in the Office Action.

The art involving the [composition or product]. As supported by the evidence cited by the Office, those skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains. For example, as noted by the Office, “\_\_\_\_\_\_\_\_\_\_\_” [citing prior art teachings asserted by the Office]. The [composition or product] of the claimed invention share [a common feature] with the [composition or product] of the prior art. Those skilled in the art would be able to predict that, if the [composition or product] of prior art has a structure or a property, then the claimed [composition or product], which sharing the [common feature], is likely to have the same structure or property.

6) The amount of direction provided by the inventor; 7) the existence of working examples; and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure

The specification provides sufficient amount of guidance for one skilled in the art to be able to practice the full scope of the claims. For instance, examples \_\_ disclose \_\_\_\_\_\_\_\_. The process as claimed and described in the specification does not involve any complex procedures. Any experimentation necessary to practice the claimed method, if any, is, in fact, routine. \_\_\_\_ [can add some examples here]. [A declaration of \_\_\_\_\_\_ submitted herewith demonstrates that \_\_\_\_ prepared according to the claimed invention based on the disclosure in the specification.] By disclosing \_\_\_\_\_, the specificaiton provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. Therefore, the amount of experimentation,if any, required for those skilled in the art to make and practice the full scope of the claims is not undue. Thus, the claims are enabled.

For at least the reasons outlined above, Applicant respectfully requests withdrawal of the rejection.

Or,

In the Office Action, at pages \_\_\_, the Office rejects claims \_\_\_ for allegedly failing to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. In making this rejection, the Office asserts that \_\_\_\_\_\_\_[for example, “The instant application only teaches \_\_\_[AAA]. No working example and guidance are provided to indicate that \_\_\_[BBB] can be made without AAA present. There is no other example teaching that such \_\_\_[BBB] can be formed with any other [polymer]. It is also well known in the art that not all polymers comprise \_\_\_\_[group]. The specification does not provide any guidance for making any or all synthetic polymer to obtain such active groups and form a \_\_\_\_ [BBB]. Therefore, specification does not provide sufficient evidence and guidance to support the broadly scope of claims \_\_\_”].

In contrast to the Office’s assertion, however, Applicant submits that the full scope of the present claims is enabled. Those skilled in the art would be able to make and use the present disclosure without undue experimentation. While it is believed that \_\_\_, the as-filed application provides a procedure for testing \_\_\_[formation by \_\_\_\_]. Therefore, those skilled in the art would be able to determine without undue experimentation \_\_\_. Further, the Office has not shown support for the conclusion that \_\_\_.

For at least the reasons outlined above, Applicant respectfully requests withdrawal of the rejection.

**Rejection Under 35 U.S.C. § 112, First Paragraph, as Allegedly Failing to Comply with Written Description Requirement**

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

**(a) In General.—**The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

At pages \_\_ of the Office Action, claim \_\_ was rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Office asserts that “\_\_\_\_” The Examiner thus concludes that “the limited example is not reasonably representative of \_\_\_[e.g., genus] in its claimed scope” and “the specification does not adequately describe the claimed invention [product, composition, etc.].” [PROVIDE SUMMARY OF THE REJECTION]

Without conceding the propriety of this rejection and solely to expedite prosecution of the application, claim \_\_ has been canceled, and thus the rejection has been rendered moot.

Or,

Without conceding the propriety of this rejection and solely to expedite prosecution of the application, claim \_\_ has been amended to recite \_\_\_. It is believed that the rejection to claim \_\_ under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, has been overcome by the above amendments, and withdrawal of the rejection is respectfully requested.

Or,

With respect to claims \_\_, Applicant respectfully disagrees and traverses the rejection for the following reasons.

The first paragraph of Section 112 provides that “the specification shall contain a written description of the invention . . .”. “The description requirement’s purposes are to assure that the applicant was in full possession of the claimed subject matter on the application filing date and to allow other inventors to develop and obtain patent protection for later improvements and subservient inventions that build on applicant’s teachings.” See In re Barker, 559 F.2d 588, 194 U.S.P.Q. 470 (C.C.P.A 1977), cert. denied, 434 U.S. 1064 (1978); Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991); and In re Dossel, 115 F.2d 942, 42 U.S.P.Q.2d 1881 (Fed. Cir. 1997).

Thus, the issue is whether Applicants’ disclosure in the patent application relied upon “reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter”. The threshold step in resolving this issue as set forth above is to determine whether the Office has met his burden of proof by advancing acceptable reasoning inconsistent with the written description. The Office bears the initial burden of presenting a prima facie case of unpatentability. In re Alton, 76 F.3d 1168, 1175 (Fed. Cir. 1996). Insofar as the written description requirement is concerned, that burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." Wertheim, 541 F.2d at 263, 191 U.S.P.Q. at 97. In re Alton, 76 F.3d 1168, 1175 (Fed. Cir. 1996).[[2]](#footnote-2) This the Office has not done.

The Specification clearly states, on page \_, lines \_\_\_\_\_\_\_\_\_\_, that [PROVIDE DESCRIPTION]. FIG. \_\_\_, in the attached drawing, clearly shows that the \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ [PROVIDE ELEMENTS FROM DESCRIPTION AND A REPRESENTATIVE NUMBER OF EMBODIMENTS/SPECIES WITHIN THE CLAIM SCOPE OR CLAIMED GENUS]. Further, claims \_\_\_\_\_\_\_\_\_\_ have been amended to clarify that the [PROVIDE CLAIM LIMITATIONS].

Based on the above, Applicants’ disclosure reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter. Contrary to the Examiner’s assertion, Applicants’ have adequately described that the \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_ [PROVIDE DESCRIPTION]. Therefore, the claims comply with the written description.

For at least the reasons outlined above, Applicant respectfully requests withdrawal of the rejection.

Or, [ARGUMENT FOR NEWLY ADDED CLAIMS]

The proscription against the introduction of new matter in a patent application (35 U.S.C. § 132 and 251) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See *In re Rasmussen,* 650 F.2d 1212, 1214, 211 U.S.P.Q. 323, 326 (C.C.P.A. 1981); see also M.P.E.P. §§ 2163.06 through 2163.07 for a more detailed discussion of the written description requirement and its relationship to new matter. The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno,* 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985). Thus, the written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims which introduce elements or limitations that are not supported by the as-filed disclosure violate the written description requirement. See, e.g.,*In re Lukach,* 442 F.2d 967, 169 U.S.P.Q. 795 (C.C.P.A. 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith,* 458 F.2d 1389, 1395, 173 U.S.P.Q. 679, 683 (C.C.P.A. 1972) (an adequate description of a genus may not support claims to a subgenus or species within the genus).

Or, [ARGUMENT FOR INHERENCY]

It is well established that “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” M.P.E.P. § 2173.05(e). For instance, an element need not be recited in ipsisimis verbis where it is clear to a person of ordinary skill in the art what is meant. See, for example Ex parte Porter, 25 U.S.P.Q. 2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). Applicant respectfully submits that “\_\_\_\_\_\_\_\_\_” is inherently present although not specifically recited.

For at least the reasons outlined above, Applicant respectfully requests withdrawal of the rejection.

**Rejection Under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), Second Paragraph as Allegedly Indefinite**

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

**(b)Conclusion.—** The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

At pages \_\_ of the Office Action, claims \_\_ were rejected under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. Solely to expedite prosecution of this application, claims \_\_ have been amended. Support for the amendments may be found in the specification, for example, at ¶ [xxxx]. Based on the foregoing amendment, Applicant believes that the claims are clear, and that the rejections should be withdrawn.

Or,

With respect to claims \_\_, this rejection has been rendered moot by the cancellation of these claims.

Or,

At pages \_\_ of the Office Action, Claims \_\_ were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Office asserts that “….” The Office further indicates that the rejection of these claims may be overcome by amending claim \_\_ to [remove, change, or recite a term or phrase].Solely to expedite prosecution of this application, independent claim \_\_ has been amended to [remove, change, or recite a term or phrase], in accordance with the Examiner's suggestion. As a result, it is believed that the rejection to independent claim \_\_ has been overcome. With respect to dependent claims \_\_\_, a separate ground for rejecting these claims under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as allegedly being indefinite is not provided in the Office Action. Accordingly, dependent claims \_\_\_ appear to have only been rejected for the same reason as independent claim \_\_ was rejected. Therefore, the rejection of dependent claims \_\_ under 35 U.S.C. § 112(b) or 35 U.S.C.§ 112 (pre-AIA), second paragraph, has also been overcome by the above amendment to independent claim \_\_.

Based on the foregoing amendment, Applicant respectfully requests withdrawal of the indefiniteness rejection of claims \_\_.

Or,

With respect to claims \_\_, Applicant respectfully disagrees and traverses the rejection for the following reasons.

At pages \_\_ of the Office Action, claims \_\_ were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Office asserts that “\_\_\_\_\_\_.” Applicant respectfully traverses the rejection for the following reasons.

Those skilled in the art would understand that the composition recited in claim \_\_ could include \_\_\_\_[for example, a compound], and that compound could be, for example, \_\_\_\_\_. Those skilled in the art would also understand that the composition may include \_\_\_\_\_\_\_\_. Such claim interpretation is both clear from the language of claim \_\_, and is supported by the as-filed specification, which provides a definition for the term at pages \_\_ and describes that \_\_\_\_\_. Therefore, the meaning of claim \_\_ is clear and the claim is definite.

Accordingly, it is respectfully requested that the rejection be withdrawn.

Or,

At pages \_\_ of the Office Action, claims \_\_ were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Office asserts that “\_\_\_\_\_\_” lacks antecedent basis. Applicant respectfully traverses the rejection for the following reasons.

[ARGUMENT FOR INHERENT STRUCTURES]

It is well established that “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” M.P.E.P. § 2173.05(e). For instance, inherent components of elements recited have antecedent basis in the recitation of the components themselves. M.P.E.P. § 2173.05(e). Thus, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. M.P.E.P. § 2173.05(e). See, also, Bose Corp. v. JBL, Inc., 274 F.3d 1354, 1359, 61 U.S.P.Q.2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter"). Applicant respectfully submits that “\_\_\_\_\_\_\_\_\_” is inherent in the recited “\_\_\_\_\_\_\_\_\_\_” and needs no explicit antecedent.

Or, [ARGUMENT FOR SLIGHTLY DIFFERENT WORDING}

It is well established that “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” M.P.E.P. § 2173.05(e). For instance, an element need not be recited in ipsisimis verbis where it is clear to a person of ordinary skill in the art what is meant. See, for example Ex parte Porter, 25 U.S.P.Q. 2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). Applicant respectfully submits that “\_\_\_\_\_\_\_\_\_” provides adequate antecedent for “\_\_\_\_\_\_\_\_\_\_”.

Or, [ARGUMENT REGARDING COMPUTER-IMPLEMENTED MEANS-PLUS-FUNCTION LIMITATIONS]

At pages \_\_ of the Office Action, claim \_\_ was rejected under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as allegedly being indefinite for failing to disclose an algorithm for performing the specific computer function of the computer-implemented claim limitation \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_, which was determined to be a means-plus-function limitation pursuant to 35 U.S.C. § 112(f) or 35 U.S.C. § 112 (pre-AIA), sixth paragraph. *See* M.P.E.P. § 2181 II (B) (“Computer-Implemented Means-Plus-Function Limitations”).

In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function may be demonstrated by showing an “algorithm” capable of transforming a general purpose computer or microprocessor disclosed in the specification into a special purpose computer programmed to perform the disclosed algorithm. *Id.* As defined by the MPEP, an algorithm is “a finite sequence of steps for solving a logical or mathematical problem or performing a task.” *Id.* And the MPEP describes that an Applicant may express the algorithm in any understandable terms including as “a mathematical formula, in prose, in a flow chart, or ‘in any other manner that provides sufficient structure.’” *Id.* (citing Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340 (Fed. Cir. 2008)).

Accordingly, Applicant references, by way of non-limiting example, at least Figures \_\_\_ and paragraphs \_\_\_ of the present application, which demonstrate an algorithm in the form of “a mathematical formula, in prose, in a flow chart, and/or in any other manner that provides sufficient structure” for the identified computer-implemented claim limitation, which was determined to be a means-plus-function limitation pursuant to 35 U.S.C. § 112(f) or 35 U.S.C. § 112 (pre-AIA), sixth paragraph.

**Interpretation Under 35 U.S.C. § 112(f) or 35 U.S.C. § 112 (pre-AIA), Sixth Paragraph as Allegedly Means Plus Function**

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.

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 those skilled 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 M.P.E.P. § 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.

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.

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: “\_\_\_\_\_\_\_\_\_\_\_\_" in claims \_\_\_\_\_\_\_\_\_\_.

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.

As discussed in M.P.E.P. § 2181.I.A., 35 U.S.C. § 112(f) will not apply if those skilled in the art reading the specification understand the term to have a sufficiently definite meaning as the name for the structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function.  See Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1364 (Fed. Cir. 2003); Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) ("Many devices take their names from the functions they perform.").

Applicant submits that the specification describes the terms “\_\_\_\_\_\_” and “\_\_\_\_\_\_\_\_” with sufficiently definite meaning such that persons of ordinary skill in the art reading the specification would understand the terms “\_\_\_\_\_” and “\_\_\_\_\_\_\_\_\_” as the name for the structure.

Accordingly, Applicant asserts that claims \_\_\_\_\_\_\_\_ recite limitations that include the structure necessary to perform the recited functions. Accordingly, Applicant asserts that the recitations of claims \_\_\_\_\_\_ do not invoke 35 U.S.C. § 112(f).

Or,

Applicant respectfully traverses the assertion by the Examiner that the recitations of claims \_\_\_\_\_ invoke 35 U.S.C. § 112(f). Specifically, the Applicant traverses the assertion by the Examiner that the terms “\_\_\_\_\_\_\_” and “\_\_\_\_\_\_\_\_\_\_\_” are generic placeholders sufficient to invoke treatment under 35 U.S.C. § 112(f) as a “means-plus-function” limitation.

Applicant asserts that the above-referenced analysis is not met by the recitations of claims \_\_\_\_\_\_\_\_.

For example, claims \_\_\_\_\_\_\_\_ do not recite the terms “means” or “step”, which creates a presumption that 35 U.S.C. § 112(f) does not apply.

In addition, as discussed in M.P.E.P. § 2181.I.A., 35 U.S.C. §112(f) will not apply if persons of ordinary skill in the art reading the specification understand the term to have a sufficiently definite meaning as the name for the structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function. See Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1364 (Fed. Cir. 2003); Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1583, 39 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1996) ("Many devices take their names from the functions they perform.").

Applicant submits that the specification describes the terms “\_\_\_\_\_\_\_\_\_\_” and “\_\_\_\_\_\_\_\_\_” with sufficiently definite meaning such that those skilled in the art reading the specification would understand the terms “\_\_\_\_\_\_\_\_\_\_” and “\_\_\_\_\_\_\_\_” as the name for the structure.

For example, paragraphs \_\_\_\_\_\_\_\_\_\_ of the specification describes “[PROVIDE DESCRIPTION]”.

Accordingly, Applicant asserts that claims \_\_\_\_\_\_\_\_ recite limitations that include the structure necessary to perform the recited functions. Accordingly, Applicant asserts that the recitations of claims \_\_\_\_\_\_ do not invoke 35 U.S.C. § 112(f).

**Rejection that the Claim Improperly Uses Purely Functional Language without Invoking 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶6][[3]](#footnote-3)**

Claims limitations that that are purely functional and purport to encompass each and every means for performing the specified function are contrary to the rule in Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1, 71 U.S.P.Q. 175 (1946). There is nothing wrong with using functional claim language, where the means-plus function provision of 35 U.S.C. § 112(f) applies or where such functional language further limits structure or composition already defined in the claim. See, e.g., In re Swinehart, 439 F.2d 210, 212, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971) (“[T]here is nothing intrinsically wrong with the use of such a technique [functional language] in drafting patent claims.”). Merely because a claim requirement does not include the word “means” does not meant that it does not invoke it may still invoke 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶6]. The failure to use the word “means” creates a presumption that § 112(f) [35 U.S.C. § 112, ¶6], does not apply, but that presumption can be rebutted. Where, as here the claim element does not have a definite structural meaning, and further includes language describing the function the element performs, without describing any structure that performs the function, the element should be constructed under 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶6], and is proper.

**Rejection/Statement that the Claim Invokes 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6]**

Applicant respectfully submits that the Office has mistakenly identified the language “\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_” as invoking 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6]. There is a presumption that a claim element that does not include the word “means” does not invoke 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6], and that presumption cannot be rebutted where, as here, the element “\_\_\_\_\_\_\_\_” has is not a nonce word, but denotes structure to those skilled in the art. Furthermore, the claim language describing the function includes structure, namely \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_.

Furthermore, even if this element did invoke 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6]. There is corresponding structure for the function of “\_\_\_\_\_\_\_\_\_” in the specification at least paragraphs [XXXX]-[XXXX] as required by 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6] and thus this element covers at least the structures set further in these paragraphs of the specification, and their equivalents.

Or,

There is corresponding structure for the function of “\_\_\_\_\_\_\_\_\_\_” in the specification namely a programmed general purpose computer, and the algorithm is disclosed in (Paragraphs [XXXX]-[XXXX and/or in Figs. X and Y).

**CONSTRUING MEANS PLUS FUNCTION CLAIMS**

A claim is construed under 35 U.S.C. § 112(f) [35 U.S.C. § 112, ¶ 6] when:

1. The claim element uses the phrase “means for” or “step for” or a non-structural term that does not have a structural modifier (a so-called nonce word).
2. The phrase “means for” or “step for” or the non-structural term recited in the claim is modified by functional language.
3. The phrase “means for” or “step for” or the non-structural term recited in the claim is not modified by sufficient structure, material, or acts for achieving the specified function.



**CONSIDERATIONS IN DRAFTING CLAIMS TO AVOID § 112(f) [§112, ¶6]**

* Pick terms carefully: (1) Pick terms that general and subject-matter-specific dictionaries show as the terms denoting structure; (2) Pick terms that the prior art shows as denoting structure. (3) Make sure that the specification provides a description sufficient to indicate to one of ordinary skill in the art that the term denotes structure.
* Surround the terms with detail.
* Connect the term to other structures.
* Have a Plan B: Provide corresponding structure in the specification so that the claim element is not indefinite.

1. Please note that there is a challenge when making predictability arguments to overcome an enablement rejection, since such arguments may make it difficult to rely on the arguments of high level of unpredictability when addressing obviousness rejections. To minimize the enablement rejections, it is better to carefully draft the claims, and include one or more examples in the application. In the areas of biotechnology and pharmaceuticals, it is better to include efficacy data in the applications. [↑](#footnote-ref-1)
2. Ex parte Gleave, 2005-2447 (Jan. 31, 2006)(It is the examiner's initial burden to present evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims, citing Wertheim, 541 F.2d at 263, 191 U.S.P.Q. at 97).[Informative]. [↑](#footnote-ref-2)
3. Sanada v. Reynolds, Int. 105,029, Paper 21 (March 19, 2003) [Informative]. [↑](#footnote-ref-3)