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DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2023-0045]

Resources for Examining Means-Plus-Function and Step-Plus-Function Claim Limitations

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) issued a memorandum to the patent examining corps to assist patent examiners in addressing means-plus-function and step-plus-function claim limitations, and to create a clearer record for the applicant, the public, and the courts. The issued memorandum will help ensure consistent analysis by USPTO employees in addressing means-plus-function and step-plus-function limitations and will result in clearer communications to applicants from the USPTO as to the interpretation of means-plus-function and step-plus-function limitations and any related deficiencies. Clearer USPTO communications provide both the applicant and the public with notice as to the claim interpretation used by the patent examiner during prosecution, and if the applicant intends a different claim interpretation, the issue can be clarified early in prosecution.

DATES: Comment Deadline: Written comments must be received on or before [INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE **FEDERAL REGISTER**], to ensure consideration.

ADDRESSES: Comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, enter docket number PTO-P-2023-0045 on the homepage and select “Search.” The site will provide a search results page listing all documents associated with this docket. Find a reference to this document

and select the “Comment” icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in Adobe® portable document format (PDF) or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Carolyn Kosowski, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents, at Carolyn.Kosowski@uspto.gov or 571-272-7755; or Brannon Smith, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents, at Brannon.Smith@uspto.gov or 571-270-1601.

SUPPLEMENTARY INFORMATION:

On March 18, 2024, the USPTO issued a memorandum to the patent examining corps titled “Resources for Examining Means-Plus-Function and Step-Plus-Function Claim Limitations (35 U.S.C. 112(f))” (memorandum). The memorandum is available at www.uspto.gov/patents/laws/examination-policy/memoranda-examining-corps.

As background, means-plus-function limitations appear in many claims across a wide variety of technologies, while step-plus-function limitations appear less frequently. It is critical to proper examination that patent examiners appreciate the unique statutory construction of means-plus-function and step-plus-function limitations and make the record clear as to the same. It is also incumbent upon patent examiners to make the prosecution history record clear for applicants, the public, and the courts (and for the USPTO for any post-grant determinations) when claims are examined under a means-

plus-function or step-plus-function construction, as the invocation of 35 U.S.C. 112(f) affects claim scope. Drafting claims with limitations that comply with 35 U.S.C. 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 to the disclosed structure, material, or acts. This technique permits the claim drafter to avoid specific identification of the means or step for performing a claimed function in the claim itself by offering a shorthand that can point to a more robust description of the means or step in the specification.

When a patent examiner determines that, under the broadest reasonable interpretation of a claim, a limitation invokes 35 U.S.C. 112(f), the limitation 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, 35 U.S.C. 112(f) limitations will, in some cases, be afforded a narrower interpretation than a limitation that is not crafted in means-plus-function format. This is an important distinction when searching for and applying prior art. The memorandum highlights the special considerations for the examination of claims with 35 U.S.C. 112(f) limitations.

The memorandum also reminds patent examiners that the Manual of Patent Examining Procedure (MPEP) (9th Edition, Rev. 07.2022, February 2023) includes the latest examination guidance concerning 35 U.S.C. 112(f) in sections 2181-2187. The memorandum to patent examiners provides a summary of important points related to examining claims having 35 U.S.C. 112(f) limitations and provides the specific MPEP sections noted for more thorough information on each topic. The memorandum addresses: (1) the applicability of 35 U.S.C. 112(f); (2) claim interpretation and the importance of a clear record; and (3) adequate support, specifically to satisfy the requirements of definiteness, written description, and enablement.

Additionally, the memorandum explains that refresher training on 35 U.S.C. 112(f) is available to patent examiners. Training is also available to the public at www.uspto.gov/patents/laws/examination-policy/examination-guidance-and-training-materials.

Feedback on 35 U.S.C. 112(f) guidance is welcome. Instructions for submitting feedback are provided in the **ADDRESSES** section of this notice.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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