



## **ARE PTO & PTAB Alert: PTO Updates Guidelines Concerning Examining Computer-Implemented Functional Claim Limitations**

Author(s): Charles R. Macedo, Benjamin M. Halpern, Keith J. Barkaus,

(February 15, 2019) On January 7, 2019, the USPTO issued its latest guidance on Computer Implemented Functional Claim Limitations. 2019 Examining Computer-Implemented Functional Claim Limitations for Compliance With 35 U.S.C. § 112, USPTO, 84 Fed. Reg. 57 (Jan. 7, 2019), *available at*, <https://www.govinfo.gov/content/pkg/FR-2019-01-07/pdf/2018-28283.pdf> (“the 2019 Guidelines”). The 2019 Guidelines, which do not fundamentally change the current framework for analyzing means-plus-function claims, are meant to “assist [USPTO] personnel in the examination of claims in patent applications where functional language is used to claim computer-implemented inventions.”

The 2019 Guidelines have two parts. The first part “addresses issues related to the examination of computer-implemented functional claims having means-plus-function limitations” (issues related to means (or step) plus function limitations under 35 U.S.C. 112(f) and definiteness under 35 U.S.C. 112(b)). The second part “addresses written description and enablement issues related to the examination of computer-implemented functional claims that recite only the idea of a solution or outcome of a problem, but fail to recite details of how the solution or outcome is accomplished” (issues related to proper written description and enablement support under 35 U.S.C. 112(a)).

### **Part I**

The first part of the 2019 Guidelines requires Examiners to determine whether to apply 35 U.S.C. § 112(f) by first determining the broadest reasonable interpretation of the claim consistent with the specification and one of ordinary skill in the art. Examiners are then asked to implement the following three-pronged test:

1. Determine whether the claim uses the term “means” or “step” or another generic placeholder;
2. Determine whether the claim term is modified by functional language; and



3. Determine whether the claim term is modified by sufficient disclosure, material, or acts for performing the function

Any of the prongs and/or required structure analysis can cause an examiner to apply an analysis under 35 U.S.C. § 112(f) (e.g., if a claim uses the term “means,” the examiner may employ an analysis under 35 U.S.C. § 112(f); if the specification provides a description sufficient to inform one of ordinary skill in the art that the term or phrase denotes structure, then the examiner may determine an analysis under 35 U.S.C. § 112(f) is unnecessary). With respect to the third prong, to determine whether a claim term or phrase coupled with a function denotes a structure, examiners are required to analyze whether:

- (a) the specification provides a description sufficient to inform one of ordinary skill in the art that the term or phrase denotes structure;
- (b) general and/or subject matter dictionaries provide evidence that the term or phrase is recognized as a noun denoting structure; and
- (c) the prior art evidences that the term or phrase is recognized in the art as a structure to perform the claimed function.

If the examiner determines that the claim at issue is to be analyzed under 35 U.S.C. § 112(f), the new guidelines require this be expressly stated in the Office Action. In response to the Office Action which states the claims are being analyzed under 35 U.S.C. § 112(f), the applicant, if he or she wishes to argue that 35 U.S.C. § 112(f) should not be used, must either present a sufficient showing to establish that the claim limitation recites sufficient structure, or amend the claim limitation.

With regard to computer functions analyzed under 35 U.S.C. § 112(f), the guidelines require the specification to disclose an algorithm for performing the claimed function. Failure to do so will result in an indefiniteness rejection under 35 U.S.C. § 112(b). An algorithm is defined as a “finite sequence of steps for solving a logical or mathematical problem or performing a task.” The new guidelines require the algorithm to be sufficient to perform the entire claimed function. Mathematical formulas, prose, a flow chart, or any understandable terms may be employed to satisfy the new algorithm requirement.



## **Part II**

The 2019 Guidelines emphasize that 35 U.S.C. § 112(a) requires a disclosure to satisfy both the written description requirement and the enablement requirement, regardless of whether an Examiner reviews the claim term or phrase under 35 U.S.C. § 112(f).

With respect to the written description requirement, Examiners are to determine whether the scope of enablement is commensurate with the scope of protection sought by the claims. Thus, when examining computer-implemented, software-related claims, the 2019 Guidelines make it clear that Examiners “should determine whether the specification discloses the computer and the algorithm(s) that achieve the claimed function in sufficient detail that one of ordinary skill in the art can reasonably conclude that the inventor possessed the claimed subject matter at the time of filing.”

With respect to the enablement requirement, the new guidelines state that Examiners “should consider (1) how broad the claim is with respect to the disclosure and (2) whether one skilled in the art could make and use the entire scope of the claimed invention without undue experimentation.” It is important to note here that the new guidelines also make it clear that “the high level of skill in the art and the similarly high level of predictability in generating programs to achieve an intended result without undue experimentation” may obviate the need to disclose aspects of an invention that are not considered novel (i.e., aspects that are generally well known in the art) in order to meet the enablement requirement.

The USPTO is accepting written comments from the public regarding the 35 U.S.C. §112(f) guidelines until March 8, 2019.

For more information on patent office practice, please feel free to contact one of our attorneys.

\* Charles R. Macedo Benjamin M. Halpern are partners, and Keith Barkaus and Michael Jones are associates at Amster Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues. They may be reached at [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com), [bhalpern@arelaw.com](mailto:bhalpern@arelaw.com), [kbarkaus@arelaw.com](mailto:kbarkaus@arelaw.com), and [mjones@arelaw.com](mailto:mjones@arelaw.com).