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# Locke Lord QuickStudy: USPTO Releases Memorandum Regarding Resources for Examining Claim Language Invoking 35 U.S.C. §112(f)

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On March 18, 2024, the United States Patent and Trademark Office (USPTO) released a memorandum including guidelines and resources to assist Examiners in interpreting claims under 35 U.S.C. §112(f). This memo comes on the back of newly released guidance on obviousness rejections under §103 in an apparent effort to refresh Examiners' understanding of the law and promote clarity on the record as to what should be considered when interpreting the claims under §112, and when making rejections under §102 and §103.

The memo directs Examiners to follow the steps set forth in the Manual of Patent Examination Procedure (MPEP) when making their interpretations, for example, rather than simply copying and pasting §112(f) form language into an Office Action, which often leads to lack of clarity due to the genericness of such language. In the refreshed guidance the USPTO urges Examiners to be precise when making such interpretations, pointing to the specific claim language invoking §112(f) or their reasons for interpreting the claim language in a manner that overcomes the presumption that §112(f) does not apply.

Additionally, the Office reminds Examiners that adequate support is needed, either in the claim language or in the specification-as-filed, in order to invoke §112(f) e.g., by including "means," "step," or a generic place holder followed by functional language and not modified by sufficient structure. But, in cases where this explicit invoking language is not present in the claim, the Examiner should show that the specification-as-filed does not disclose sufficient structure in a way that one skilled in the art would understand that structure will perform the entire recited function to properly interpret the claims under §112(f).

The guidance reminds Examiners to be sure to take into consideration the application as a whole, and how one having ordinary skill in the art would interpret the claim language in view thereof, when making a determination as to whether there is sufficient structure to perform the claimed function. If after taking this into account the Examiner still believes there is insufficient structure, the Examiner will interpret the claims under §112(f) and find the claims indefinite under §112(b).

For computer related applications, the Office reminds Examiners that computer implemented §112(f) claim recitations must be supported in the specification by an algorithm for performing the claimed computer function, or else the claim will be found indefinite.

It remains to be seen whether this memo will have an impact on the way Examiners address their interpretations under §112(f) going forward. Until then, the hope is memos like this will help to improve clarity of the record, making responding to office actions more efficient.

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