

REPORT

PTO GUIDELINES CONCERNING IN RE DONALDSON AND APPLICATION OF 35 U.S.C. §112, SIXTH PARAGRAPH DURING PATENT PROSECUTION

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Further to the Federal Circuit's en banc decision in In re Donaldson, a PTO Notice on Means or Step Plus Function Limitations Under 35 U.S.C. §112, 6th Paragraph (hereinafter "the Guidelines") was distributed to U.S. Patent Examiners in late April following the Donaldson decision. The Guidelines set forth the manner in which the United States Patent and Trademark Office (PTO) will be examining all limitations falling under §112, ¶6.

The following are brief summaries of Donaldson and the Guidelines, and our comments on the Guidelines.

Summary of Donaldson

In Donaldson, the Federal Circuit instructed the PTO to follow the provisions of §112, ¶6 when examining claims having means-plus-function limitations. The Federal Circuit stated that a reasonable interpretation of the scope of means (and step)-plus-function limitations is only made by considering the embodiments disclosed in the specification and their equivalents.

PTO Examination Guidelines for Following Donaldson

Examiners will initially identify limitations that fall within the scope of §112, ¶6. As set forth in the Guidelines, no special language or form, such as "means for ..." or "step of" must appear for a limitation to fall within the scope of §112, ¶6. The Guidelines provide some examples, including: "Jet driving device to drive the rotor," "force generating means adapted to provide," "call cost register means for providing," and "reducing the coefficient of friction of the resulting film."

Thus, the PTO will broadly construe what constitutes a means/step-plus-function (hereinafter collectively

"means-plus-function") limitation. If a recitation of structure merely serves to render the means more definite and specific (e.g., "jet driving device"), the claim limitation will be found to fall within §112, ¶6. See footnote 2 of the Guidelines; see also The Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 19 USPQ2d 1367 (Fed. Cir. 1991) (§112, ¶6 applies where the structural recitation merely serves to further specify the claimed function, i.e., only tells what the means does, not what the means is structurally). On the other hand, structural modifiers of the term "means" that specify no function to be performed (e.g., "plate means" or "wing means") fall outside the scope of §112, ¶6, according to the Guidelines.

If a limitation is determined to be in means-plus-function form, then prior art elements will be examined to determine whether they perform a function identical to that specified in the limitation. If a prior art element performs the identical function, then under Donaldson the Examiner carries the initial burden of proof of showing that the prior art structure or step is the same as, or equivalent to, the structure, material or acts described in the specification that correspond to the means-plus-function limitation in the claim.

If the Examiner finds that a prior art element is not identical to the disclosed structure, material or acts but performs the claimed function, and the prior art element is not explicitly excluded in the specification as an equivalent, the Examiner will find that the prior art element is prima facie equivalent to the disclosed structure, material or acts. The PTO then shifts the burden of proof to the applicant to show that the prior art element is not an equivalent (structural equivalent in the case of a means (i.e., apparatus) limitation).

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The applicant must then provide reasons why the prior art element is not an equivalent to the structure, material or acts disclosed in the specification. Such reasons may include: 1) a teaching in the specification itself, 2) a teaching in the prior art reference itself, or 3) Rule 132 affidavit evidence of facts tending to show non-equivalence. The Guidelines specify several indicia sufficient to support the conclusion that one element is or is not an equivalent of an element in the context of §112, ¶6.

The Examiner should then consider the evidence presented by the applicant, and should determine whether, on balance, the applicant has met the burden of proving non-equivalence. Under no circumstances is an Examiner supposed to accept, as persuasive, a bare conclusory statement that the prior art element is not an equivalent embraced by the claim limitation.

The Guidelines also provide that, if it is unclear whether a claim limitation falls within the scope of §112, ¶6, or if a means-plus-function limitation is not supported by corresponding structure, material or acts disclosed in the specification, then the Examiner should consider rejections under §112, first and second paragraphs. For example, without corresponding structure, material or acts, the specification may not provide an adequate enabling disclosure. Additionally, the means-plus-function limitation may be indefinite because the means or step is not defined in the specification.

The Guidelines also caution against confusing §112, ¶6 equivalence with the doctrine of equivalents.¹ This is in accord with a number of Federal Circuit decisions that have all recognized that a distinction exists. However, the Guidelines do not squarely confront the differing views that have been expressed by different panels of the Federal Circuit on the nature of the distinction. In particular, different panels of the Federal Circuit have respectively rejected and endorsed application of the tripartite test in a §112, ¶6 equivalency analysis. Compare Valmont (Guidelines, footnote 21) with Polumbo (Guidelines, footnote 15). Further, the Guidelines cite Valmont in support of the admonition that decisions involving the

doctrine of equivalents should not "unduly influence" a §112, ¶6 equivalency determination during ex parte examination, but nonetheless list the tripartite test as the first indicia for determining §112, ¶6 equivalency.

Our Comments Regarding These Guidelines

It appears that the PTO will not significantly alter its prior initial examination procedure to comply with Donaldson. However, Examiners will now at least look to the specification to confirm whether the prior art discloses the same embodiments and whether the specification expressly excludes certain embodiments as equivalents. Where the prior art element is different but performs the claimed function, the Examiner will as a matter of course allege a prima facie case of equivalence, unless the specification expressly excludes the assertion of equivalence.

The Guidelines reinforce our previously held view that means-plus-function claims should not be the only form of claims presented. Rather, to provide a varying scope of protection, an invention preferably should be claimed both in means-plus-function form and otherwise. Thus, if unable to overcome a prima facie case of equivalence, the applicant will be able to rely on claims that are not in means-plus-function form. However, it may be difficult to draft broad limitations that are not structure-specific but fall outside the PTO's broad interpretation of what constitutes a means-plus-function limitation. Two potential alternative approaches are to include limitations in which the functions are more specifically recited, and to use "hybrid" limitations in which both structure and function are recited.

Additionally, patent specifications should be drafted with greater care to avoid any potential problems caused by the PTO examination procedure. Specifically, the specification should be drafted to ensure that the structure, material or acts corresponding to the claimed means or step are clearly described. This will help avoid problems under §112, first and second paragraphs.

Additional Federal Circuit decisions on this subject in the future are likely. Any such decisions will hopefully help us to better respond to Patent Office actions involving means-plus function limitations. Contrary to the Guidelines, even doctrine of equivalents decisions may help to clarify the propriety and best manner of applying the tripartite test in §112, ¶6 equivalency analyses.

¹ As noted in the Guidelines, in order to do equity among the parties, infringement is sometimes decided under the doctrine of equivalents, typically using the tripartite test of Graver Tank --whether an accused device performs substantially the same function, in substantially the same way, to obtain substantially the same result as the claimed invention.

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