

Patent Drafting Strategies: Terms to Use (or Not Use)

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How do certain terms affect patent prosecution?

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Methodology

JURISTAT

Results from Juristat Database for:

- Patent applications filed since September 2017
- Terms used in claims or detailed description
- Result: Frequency of different rejections in Office Actions

Terms Correlated with 35 U.S.C. §112(f) Interpretation

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35 U.S.C. § 112(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.

Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1349 (Fed. Cir. 2015) held that “[t]he standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.”

Terms Correlated with 35 U.S.C. §112(f) Interpretation

Under MPEP 2181, examiners are instructed to apply § 112(f) to a claim limitation if it meets the following 3-prong test:

- (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.

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"Advanced Patent Drafting: Strategies and Tactics"