Means Plus (Computer) Function Covers Corresponding (Program) Structure?

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While the effects of *Bilski*, i.e. that method claims need to be tied to a tangible result or thing, settle in, developments in method patent law march on as the Board of Patent Appeals and Interferences (BPAI) takes on issues related to means for carrying out computer functions.

In *Ex Parte Caitlin*, the BPAI was asked to review an Examiner's final rejection of claims reciting a method for implementing an online incentive system. Independent Claim 1 recited, in pertinent part, a step including "providing, at a merchant's web site, <u>means for</u> a consumer to participate in an earning activity to earn value from a merchant."

Initially, the BPAI upheld the rejections of the United States Patent and Trademark Office (USPTO) under 35 U.S.C. § 103 for claims 9, 11, 15, 18 and 19, finding these claims obvious in view of the art of record, but reversed the rejection with regards to claims 1, 12, 16, 17, 20 and 22. The USPTO then sought reconsideration by arguing that the BPAI erred in interpreting the step of "providing." In particular, the USPTO asserted that the claim construction of the BPAI with regards to the "means" limitation was improper in view of § 112, ¶ 6.

Claim limitations reciting "means" presumptively invoke § 112, ¶ 6. "Means" followed by a desired result are generally referred to as "means plus function" limitations. Means plus function language is construed to cover corresponding structures as described in the specification as well as any equivalents. Once invoked, § 112, ¶ 6, construction of the "means plus function" limitation is determined as follows: first, the Court must identify the limitation's function; second, the Court must identify corresponding structure for the function in the specification. If no corresponding structure exists, the claim is indefinite.

Ultimately, the BPAI held all of the claims invalid under § 112, ¶ 6, as it could not find any corresponding structure in the specification. Specifically, the BPAI noted that "the Specification does not disclose any specific algorithm that could be implemented on a general purpose computer to allow a consumer to participate in an earning activity and earn value from an earning activity."

It seems prudent that any patent applications concerned with computer programs and including "means plus function" language include sufficient disclosure to describe a machine for running the program and an algorithm, i.e. a step-by-step procedure, for executing the program.

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