In March 2013, the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB) issued three informative opinions in Ex parte Erol, Ex parte Lakkala, and Ex parte Smith. In each opinion, the same PTAB panel of five administrative patent judges construed a “processor” as a means-plus-function claim limitation despite both the presumption against such an interpretation when the term “means” is not explicitly used and the U.S. Patent and Trademark Office’s historical treatment of “processor” claims. Specifically, the Board found that the “processor” elements overcame the presumption against means-plus-function treatment and that the claims were indefinite pursuant to 35 U.S.C. §112, second paragraph, (pre-AIA) because the specifications disclosed insufficient structure for the processors to perform the recited functions. The Board’s designation of these opinions as “informative” sends a signal regarding the Board's intent to provide guidance on how “processor” claims will be interpreted by the U.S. Patent and Trademark Office (USPTO) going forward.

In order to overcome the presumption against means-plus-function treatment (since none of the claims uses the term “means”) the Board looked at how a person having ordinary skill in the art would understand the term “processor.” This inquiry included determining whether the limitation recites sufficient structure, material, or acts for achieving the recited functions; and whether the term “processor” is modified by functional language. The Board found that the term “processor” is devoid of structure and “simply a nonce word or a verbal construct that is not recognized as the name of structure.” Instead, the Board found the term to be a mere substitution for “means for” and noted that commercially available, off-the-shelf processors would not be able to perform the recited functions. Additionally, the Board found that in the claims at issue there was insufficient structure, material, or acts for achieving the specified functions, and there was no structural modifier (e.g., a “height-adjustment” processor).

The Board seemingly contradicted itself by noting that the presumption against means-plus-function treatment can be overcome by “a verbal construct that is not recognized as the name of structure,” while also noting that the treatment is not invoked “if persons of ordinary skill in the art reading the specification understand the term to be the name for a structure that performs the function, even when the term covers a broad class of structures or identifies the structures by their function.” Though the Board construed “processor” to be non-structural, the term arguably covers a broad class of structures identified by their function.

Practitioners would be well-served by considering how best to protect their “processor” claims against means-plus-function interpretations, which may overly limit claims depending on specific structure disclosed in a particular application. The Board’s opinions imply that the use of structural modifiers that refer to function may save processor claims from means-plus-function treatment. Inclusion of algorithms and/or structure in the specification can also be helpful as backup positions. While the Board’s opinions offer some guidance on how to draft “processor” claims going forward, these informative opinions undoubtedly affect pending claims as informing the USPTO position...
regarding “processor” claims. Patent applicants and patent owners with affected claims should analyze the recent developments because, in at least some cases, corrective action may be necessary to salvage “processor” claims from overly-limiting means-plus-function treatment.

This advisory was prepared by Nutter’s Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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