In *Ex parte Rodriguez et al.,* Appeal 2008-000693, Oct. 1, 2009, the Board of Patent Appeals and Interferences (BPAI) reviewed final rejections by an Examiner to a patent application relating to a first, apparatus, a method, and a computer readable medium to (a) generate a random system configuration file of a structurally variable and complex system; (b) build a system level netlist in response to the random system configuration file; (c) verify the structurally variable and complex system in response to the system level netlist; and (d) provide automatic random verification of the system in response to the random system configuration file. The Examiner had found each of the limitations in the pending claims was described in a prior art application. The BPAI overturned the Examiner's rejection but raised new, non-final grounds for rejection in this precedential opinion.

Follow up:

During prosecution, the PTO gives claims their "broadest reasonable interpretation" because judges, post-issuance, operate under the assumption that the patent is valid. To determine the meaning of "reasonable" under these circumstances, BPAI analyzed the claims to see whether they were sufficiently definite under 35 U.S.C. 112, second paragraph, and whether the claims included a means for performing a function under 35 U.S.C. 112, sixth paragraph. The test under 35 U.S.C. 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. Section 35 U.S.C. 112, sixth paragraph has just as much application during proceedings before the U.S. Patent and Trademark Office as it does in district court cases for infringement matters. Section 112, sixth paragraph operates to cut back on they types of "means" that can literally satisfy the claim language.

When a claim uses the term "means" to describe a limitation, a presumption inheres that the inventor used the term to invoke section

112, paragraph 6. This presumption can be rebutted when the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety. Conversely, a claim term that does *not* use the term "means" will trigger the rebuttable assumption that section 112, paragraph 6 does not apply. The assumption can be rebutted when there is no structural context for determining the characteristics of the claim element other than to describe its function. For a claim to a programmed computer, a particular algorithm may be structure under section 112, paragraph 6. However, a mere reference to using "appropriate programming" imposes no limitation whatever on a general purpose computer, as any general purpose computer must be programmed.

In the claims at issue in this case, claim 10 contained four means plus function elements, but did not recite any structure that would perform the claimed functions in their entirety. Hence, the presumption that section 112, sixth paragraph applies was not rebutted by structure recited in the claim. Moreover, the specification did not provide an algorithm by which the system is able to perform the functions in claim 10 to provide automated random verification of complex and structurally variable systems. All that was said with regard to one of the functions was that "appropriate software coding can readily be prepared by skilled programmers." Thus, the BPAI found claim 10 unpatentable under 35 U.S.C. 112, second paragraph, in that application failed to adequately describe sufficient structure for performing the functions recited in the means elements contained in claim 10 so as to render the claim definite.

The other pending apparatus claims were also rejected as being indefinite under 35 U.S.C. 112, second paragraph. These claims did not recite "means plus function" elements, so there was a rebuttable presumption that section 112, paragraph six does not apply. However, the terms "system configuration generator," "system builder," and "simulation verification environment" used in these claims had not achieved recognition as a noun denoting structure. The specification also

did not provide a sufficient description to inform one of ordinary skill in the art the meaning of these terms, and the appellants, in their appeal brief, argued in support of patentability that the prior art fails to teach these elements. Among other things, the specification failed to disclose the algorithm that transformed the general purpose processor into a specific purpose computer programmed to perform the disclosed functions of the elements of claim 1.

The BPAI found that the recitation of a "system configuration generator," "system builder," and "simulation verification environment" did not recite structure, and that, for these elements, section 112, sixth paragraph applied because the rebuttable presumption that it did not apply had been rebutted. In the alternative, if section 112, sixth paragraph did not apply, the BPAI made an alternative rejection for lack of enablement under section 112, first paragraph because the claim elements are purely functional and there is no particular structure to support the function being performed.

The breadth of the functional limitation must be commensurate with the scope of the supporting disclosure. The BPAI found that the scope of the functional claim language of claim 1 was so broad and sweeping that it included all structures or means that can perform the function. It was not limited to any corresponding structure, material, or act disclosed in the specification and equivalents thereof. The BPAI contrasted the lack of enablement rejection of these claims with claim 10, which was written as a series of means-plus-cunction elements and was therefore of much more limited scope under section 112, sixth paragraph. Claim 10 was therefore not rejected for lack of enablement.

The BPAI also rejected method claims 11-17 under section 112, first paragraph, as not being enabled for the scope of the claims. These claims had two extremely broad claim steps directed to a highly complex invention for which no working examples had been provided, and it was argued that working examples of these steps were not found in the prior art. Computer readable medium claim 18 was also not enabled for the

scope of the claims because it explicitly incorporated steps of claim 11 and thus was invalid for the same reason.

This decision is precedential, but not final, and therefore must be further prosecuted before any further appeal, if any, is taken.

Ex parte Rodriguez, et al., Appeal 2008-000693, Application No. 10/132,492, decided Oct. 1, 2009