

**Keywords:** 35 U.S.C. § 112, means-plus-function, indefiniteness

**General:** The Board found that structure in a means-plus-function claim was not satisfied by disclosure of a general purpose computer.

*Ex parte Catlin*

90 U.S.P.Q.2d 1603 (B.P.A.I. 2009) (precedential)

Decided February 3, 2009

## I. Facts

Appellant filed a patent application (the '315 application) directed to a method for implementing an on-line incentive system at a merchant's web site. Claim 1 is reproduced below.

1. A method for implementing an on-line incentive system, said method comprising the steps of:  
providing, at a merchant's web site, means for a consumer to participate in an earning activity to earn value from a merchant; and transferring value from said merchant to said consumer for participation in said earning activity, if said consumer qualifies, without re-directing said consumer away from said merchant's web site, whereby said consumer's focus of activity remains at said merchant's web site.

During prosecution, the Examiner rejected claims 1-25 of the '315 application under 35 U.S.C. § 103 as being obvious over two references in combination, Eggleston and Wolff. Catlin appealed the final rejection to the Board. The Board affirmed the rejection of claims 9-11, 15, 18, and 19 and reversed the rejection of claims 1-8, 12-14, 16, 17, and 20-25. The SPE filed a Request for Rehearing of the Board decision, arguing that the Board erred in its interpretation of certain claims.

The Board, in considering the Request for Rehearing, reviewed its original interpretation of the claims in view of the arguments presented by the SPE.

## II. Issue

Are claims 1-25 of the '315 application sufficiently definite in scope under § 112, second paragraph such that consideration of the claims under § 103 is possible?

## III. Discussion

No. The Board found that claims 1-25 are indefinite for failing to disclose sufficient structure under § 112, sixth paragraph.

The Board began by reviewing the language of the claims and determining whether the claims, for example claim 1, were properly interpreted under § 112, paragraph 6. The limitation at issue was present in independent claims 1, 9, and 20 and recited "means for a consumer to participate in an earning activity to earn value from a merchant." Because claim 1 specifically used the term "means," a rebuttable presumption was invoked that this limitation should be interpreted as a means-plus-function limitation. After determining that the claims were properly interpreted as means-plus-function claims, the Board turned to the specification of the '315 application to determine what, if any, corresponding structure to the means-plus-function limitation was disclosed. The Board determined that the

specification discloses that a customer can access an earning activity through the merchant's web site. For example:

In one embodiment, to receive value, the consumer 110 surfs up to a web site of merchant 120, and the consumer 110 enters an "earning activity", specified by the merchant 120.

Specification, p. 9, lines 1-3.

However, the Board determined that this disclosure, in addition to other disclosure specifying types of incentive programs, such as "points"-based programs, did not disclose any algorithm by which the customer could participate in the earning activity. Citing *Aristocrat*, the Board determined that although a general purpose computer was disclosed in the '315 application, the absence of any disclosure of a particular algorithm constituted a lack of disclosure of supporting structure for the means-plus-function limitation at issue. *Aristocrat Techs. Austl. PTY Ltd. v. Int'l Game Tech* 521 F.3d 1328 (Fed. Circ. 2008). In *Aristocrat*, the Federal Circuit noted that "(f)or a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming." *Id.*

After determining that the mean-plus-function limitation was inadequately supported by the specification, the Board vacated its previous decision and issued a new rejection of all of the pending claims under § 112, second paragraph, as being indefinite.

#### **IV. Conclusion**

Disclosure of a general purpose computer, without additional structure or algorithms, is insufficient structure to support a means-plus-function limitation.