

*In re McFadden:*

Invocation of § 112(f) means-plus-function saves a claim from patent ineligibility under § 101 (at least for now)

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Usually, patent owners and applicants are trying to avoid means-plus-function treatment when they don't use the term "means." In such cases, we've seen claims invalidated when the specification doesn't contain sufficient structure. Well, in today's *In re McFadden* Federal Circuit decision (nonprecedential), the applicant sought m-p-f treatment of a non-means claim term to save the claim from death via § 101. It worked, at least for now.

The application at issue involves controlling and optimizing information distribution between users on a social network. The Examiner had rejected the claims as indefinite because the claims recited both apparatus limitations and method steps. The Examiner also rejected the claims under § 101 because the claims were directed to pure software without any hardware or structure and thus did not fit into one of the four statutory categories of process, machine, manufacture, or composition of matter.

The Board affirmed, finding that the claims were directed to "software per se" without any structural limitations. The Board also held the claims indefinite for claiming both an apparatus and a method.

The applicant, appearing *pro se*, convinced the Federal Circuit that the Board erred on both grounds. For § 101, the applicant argued for a means-plus-function construction under § 112(f), and the Federal Circuit agreed. The court analyzed one element, as an example, that recited "a subsystem configured to use the method of claim 1." The court noted the rebuttable presumption of m-p-f not applying when the word "means" does not appear, which can be overcome if a claim term fails to recite sufficient definite structure or else recites function without reciting sufficient structure for performing that function. The court stated, "[f]or example, when a claim uses a nonce word analogous to 'means' followed by functional

language, it invokes § 112(f).” The court held that "subsystem" was not a term of art that conveys particular structure. Thus, pursuant to § 112(f), the court determined whether corresponding structure was described in the specification. Sure enough, it was. In fact, the specification described several structures, including "computer coded software operating on a computer system." The court therefore held, "[b]ecause the specification discloses structure that corresponds to the recited subsystem ... we conclude that ... the claims recite tangible structure and fall within one of the statutorily provided categories." The court also held that recitation of generic structure was enough to satisfy the question of "whether the claims at issue contain enough structure such that they do not constitute 'software per se.'" The court therefore remanded for consideration of the two-step *Alice/Mayo* framework. Interestingly, the court specifically directed the Board to determine whether the claims are directed to an abstract idea. Uh-oh, is this a sign of bad things to come? We will have to see.

The court then considered indefiniteness under *IPXL*, which precludes a single claim from covering both an apparatus and a method of use of the apparatus. The court based this determination on whether the limitation is directed to user actions, stating “claim limitations that ‘do not explicitly claim the user’s act .... but rather, claim the system’s capability,’ do not fall within the rationale of *IPXL*.” The court found that the limitation was directed to the functionality of the system and not the user’s actions and therefore reversed.