BARNES & THORNBURG LLP

ALERTS

Intellectual Property Law Alert - Future Of Means-Plus-Function Claim Interpretation Now Less Clear

June 19, 2015 | Atlanta | Chicago | Los Angeles | Columbus | Delaware | South Bend | Elkhart | Dallas | Grand Rapids | Indianapolis | Minneapolis | Fort Wayne

The Federal Circuit has weakened the presumption against means-plus-function claim interpretation in its recent *en banc* decision in *Williamson v. Citrix Online, LLC*, issued on June 16.

Diverging from a line of precedent dating back to 2002, the majority opinion (written by Judge Richard Linn) held that there is no “strong” presumption that the term “means” is required in the claims to signal that a patent applicant intended interpretation under 35 U.S.C. 112(f) (35 U.S.C. 112 para six, prior to the America Invents Act). That line of Federal Circuit cases established a heightened bar to overcome the presumption against interpreting a functional claim element, which lacked the word "means," as a means-plus-function claim element.

On appeal, the Federal Circuit reviewed de novo and concluded that the district court had erred in its construction of various claim limitations; as a result, the Federal Circuit vacated a non-infringement ruling for various claims of U.S. Patent No. 6,155,840 (‘840 Patent) and remanded that issue back to the district court. However, more significantly, the Federal Circuit affirmed the district court’s interpretation of the claim limitation “distributed learning control module” as a means-plus-function claim and affirmed the district court’s judgment of invalidity of other claims of the ’840 Patent.

Means-plus-function claiming occurs when a claim term is drafted in a manner that invokes §112(f), which enables a patentee to draft claims specifying function without the express recital of the corresponding structure disclosed in the specification. Congress carefully crafted the law that enables functional claiming to restrict the scope of resulting claim limitations to “only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof.”

The ‘840 Patent discloses and claims methods and systems for “distributed learning” that utilize industry standard computer hardware and software linked by a network to provide a classroom or auditorium-like metaphor—i.e., a “virtual classroom” environment. The district court concluded that the limitation “distributed learning control module,” was a means-plus-function term and analyzed whether the specification of the ‘840 Patent disclosed sufficient structure or an algorithm corresponding to the claimed functions. In affirming the district court’s holding that the specification lacked disclosure of required structure or an algorithm, the majority discounted expert witness testimony that one of ordinary skill in the art would understand the term “distributed learning control module” to connote structure. The majority further concluded that the specification failed convey how the distributed learning control module is structure “by

RELATED PRACTICE AREAS

Intellectual Property

its interaction with the other components in the distributed learning control server."

Voicing concern that the majority opinion is a misstep, Judge Jimmie Reyna (concurring in part and dissenting in part) recommended revisiting judicially created presumptions that now underpin means-plus-function analysis.

Further, in her dissent, Judge Pauline Newman alluded to concern among the majority judges regarding the potential for overly broad interpretation of software claims. She expressed serious concern regarding the shift in standards as a disincentive to patent-based innovation resulting in additional uncertainty and litigation. "[T]he court erases the statutory text, and holds that no one will know whether a patentee intended means-plus-function claiming until this court tells us."

In urging the court to recognize invocation of §112, para. 6 as the patentee's choice and merely the court's job to uphold, Newman argued the majority's ruling effectively transforms statutorily dictated analysis into a tool to confound certainty, wherein §112(f) may be invoked in litigation even though the patentee chose otherwise during examination, wrote the specification and claims on a different legal standard and was examined by the USPTO accordingly.

In lowering the barrier to invoking §112(f), the Federal Circuit has altered the expectations of, and requirements on, patentees seeking to claim protection for their innovations using functional language, in particular, software implemented inventions. Indeed, this Federal Circuit opinion now places §112(f) in the same cache of weapons as §101 (the requirement that a claim be directed to statutory subject matter) for defendants attacking software patent claims issued by the U.S. Patent and Trademark Office (USPTO).

Thus, the validity of a large number of applications drafted and examined based on the prior standard for applying means-plus-function interpretation may be called into question because the specification may not disclose sufficient structure corresponding to claimed functions.

For more information, contact the Barnes & Thornburg attorney with whom you work or a member of the firm's Intellectual Property Law Department in the following offices: Atlanta (404-846-1693), Chicago (312-357-1313), Columbus (614-628-0096), Delaware (302-300-3434) Elkhart (574-293-0681), Fort Wayne (260-423-9440), Grand Rapids (616-742-3930), Indianapolis (317-236-1313), Los Angeles (310-284-3880), Minneapolis (612-333-2111), South Bend (574-233-1171), Washington, D.C. (202-289-1313).