

Federal Circuit Weakens the Presumption against Means-Plus-Function Claim Interpretation—Structural Support Significant for Functional Claiming

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For the past ten years, there has been a strong presumption against interpreting a functional claim element lacking the word “means” as a means-plus-function claim element under § 112(f) (previously § 112 ¶ 6). One could rebut this strong presumption only by showing that the functional claim element is essentially “devoid of anything that can be construed as structure”—no easy task.¹ In *Williamson v. Citrix Online, LLC*, an en banc Federal Circuit abolished its characterization of this presumption as “strong,” thereby lowering the barrier to invoking § 112(f).² Following this decision, expect a more liberal application of § 112(f) to functional claim elements lacking the word “means.” This will likely have two consequences: (1) more claims being invalidated as indefinite because the specification does not disclose sufficient structure corresponding to claimed functions, and (2) more claims being construed to have a scope of protection narrower than previously thought.

In *Williamson*, the court lowered the standard for rebutting the presumption against applying § 112(f) to a functional claim element lacking the word “means.” Now the inquiry is “whether the words of the claim [element] are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.”³ If the functional claim element recites “sufficiently definite structure,” it avoids § 112(f). If not, § 112(f) applies, and the claim will be limited to cover structures disclosed in the specification that perform the claimed function(s) and any equivalents thereof. If § 112(f) applies and the specification does not disclose any corresponding structure, the claim is invalid under § 112(b) (previously § 112 ¶ 2) as being indefinite.

The court applied this new standard to interpret the functional claim element “distributed learning control module for [three functions].” The court found the word “module”—like the words “means,” “mechanism,” “element,” and “device”—to “cannot[e] a generic ‘black box’ for performing the recited ... functions” and “not provide any indication of structure.”⁴ The court also determined that the prefix “distributed learning control” lacked any structural significance.⁵ The court thus held that the functional claim element lacked “sufficiently definite structure,” and interpreted it as a means-plus-function claim element.⁶ The court then invalidated the claims including this functional claim element as indefinite under § 112 ¶ 2 because the specification did not describe sufficient structure corresponding to one of the claimed functions.⁷

Williamson’s eradication of the strong presumption against applying § 112(f) to a functional claim element that lacks the word “means” will result in § 112(f) applying to a higher percentage of functional claim elements, many (if not most) of which were not intended to invoke § 112(f).

¹*Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (2012).

²No. 2013-1130 (Fed. Cir. June 16, 2015).

³*Id.*, slip op. at 16.

⁴*Id.* at 17.

⁵*Id.* at 18.

⁶*Id.* at 18–19.

⁷*Id.* at 21–22.

One likely consequence of the more liberal application of § 112(f) is that more claims will be invalidated under § 112(b) as being indefinite because the specification does not disclose sufficient structure corresponding to a claimed function. Going forward, applicants should consider eliminating functional claim elements or, alternatively, should ensure that each functional claim element includes “sufficiently definite structure” and not a generic “black box” term plus a function. As a backup in case § 112(f) is determined to apply, applicants should describe the structures that correspond to the claimed functions in great detail to ensure sufficient support. For software/computer-implemented claims, this would entail including detailed flow charts and/or algorithms that distinguish a special-purpose computer implementation from an otherwise generic computer implementation.

Another likely consequence is that more claims will have a narrower-than-desired scope of protection, since means-plus-function claims only cover structures disclosed in the specification that perform the claimed function and any equivalents thereof. This is particularly true for patents and pending patent applications in which applicants relied on the existence of the strong presumption against applying § 112(f) and therefore did not include extensive descriptions of structural components or lists of alternatives. Going forward, if a pending patent application includes functional claim elements and the application of § 112(f) is not desired, applicants should consider amending the claims to either remove the functional claim elements or ensure that they include “sufficiently definite structure.” For new patent applications in which functional claim elements are desired or unavoidable, applicants should describe the structure that corresponds to the claimed functions in great detail to ensure a broad a scope of protection.

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