

GREER, BURNS & CRAIN, LTD.

An intellectual property law firm

**The Pros and Cons of using
Means Plus Function language
in U.S. Patent Claims**

Patrick G. Burns

January 2006

Patents, copyright, trademark, trade secret, unfair competition and related areas of the law

300 South Wacker Drive | Chicago, Illinois 60606 | T 312 360 0080 | F 312 360 9315 | mail@gbclaw.net

History of § 112(6)

- In *Halliburton*, the U.S Supreme Court said claims cannot only define the function – “tuning means” was indefinite
- Congress overruled *Halliburton* by passing § 112(6), but limited the scope of functional claim element language to embodiments in the specification and equivalents thereof
- § 112 (6) provides that an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

When does § 112(6) Apply in Apparatus Claims?

- The word “means” creates a rebuttable presumption that § 112(6) applies
- The presumption is rebutted if significant structure is recited in the claim limitation
- Even without the word “means”, § 112(6) applies if a function is defined without structure

Examples:

- Means for _____ ing
- Spring means tending to keep the door closed
- A substantially non-resilient lever moving element for moving the lever from ...to...and for engaging...

When does § 112(6) NOT Apply in Apparatus Claims?

- Not using the word “means” creates a presumption that § 112(6) does not apply
- The presumption is overcome if function is recited without significant structure

Examples:

- baffle means
 - means disposed inside the shell for increasing its load bearing capacity comprising internal steel baffles extending inwardly from the steel walls
- perforation means extending from...to...for tearing...and removing...
- a first circuit for monitoring a signal from the output terminal to generate a first feedback signal

When does § 112(6) Apply in Method Claims?

- the words “step for” create a rebuttable presumption that § 112(6) applies
- claim must define function, not acts

Examples:

None

When does § 112(6) NOT Apply in Method Claims?

- Absence of the words “step for” creates a rebuttable presumption that Section 112(6) does not apply

Examples:

- Passing [liquid] through a passage...
- Transmitting a force...to the lever...to drive the lever...

How Do We Define The Function for Infringement Purposes?

- Function is usually recited in the means plus function element
- Additional functions should not be included in the definition

How do We Define the Structure for Infringement Purposes?

- Include only the structure that is necessary to perform the recited function
- Structure must actually perform the recited function, not merely enable the pertinent structure to operate as intended
- Specification or prosecution history must link the structure to the recited function

Examples:

- Function: “time domain processing means”

Structure: microprocessor programmed with algorithm described in specification

- Function: “a status means for measuring...vacuum in the intake manifold”

Structure: a box in Fig. 3 labeled “VACUUM SENSOR”

How do We Determine whether the Claim Limitation is Satisfied by a Competitive Device?

- Identify the structure in the competitive device that performs the claimed function
- Compare the patented structure “as a whole” with the corresponding structure in the competitive device “as a whole”

What are Some Disadvantages of Using Means Plus Function?

- § 112(6) limits claim scope to equivalents of the embodiments in the specification
- The range of available equivalents is narrow in many cases

What are Some Advantages of Using Means Plus Function?

- Means plus function covers all embodiments (disclosed but unclaimed embodiments in the specification are dedicated to the public)
- Structural claim limitations are being construed more narrowly, often covering only the preferred embodiment
- Means plus function language gives us statutory authority to cover more than the preferred embodiment

Judge Lourie of the CAFC

[The claims] must be interpreted in light of the written description, but not beyond it, because otherwise they would be interpreted to cover inventions or aspects of an invention that have not been disclosed. Claims are not necessarily limited to preferred embodiments but, if there are no other embodiments and no other disclosure, then they may be so limited. One does not receive entitlement to a period of exclusivity for what one has not disclosed to the public.

Does § 112(6) Apply?

Limitation

Y

N

1. Means for supporting the door with respect to the frame
2. Mechanism for supporting the door with respect to the frame
3. Means connected between the door and the frame
4. Supporting means for supporting the door with respect to the frame

Limitation

Y

N

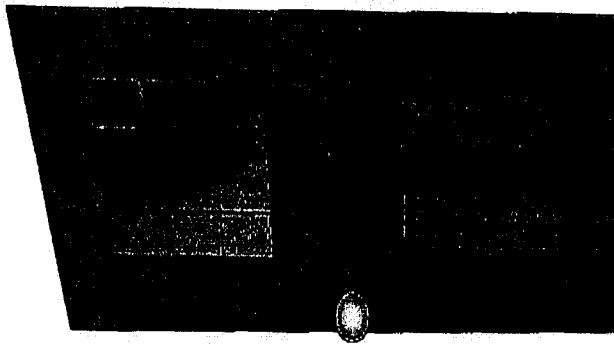
5. Means, connected between the frame and the door, for supporting the door with respect to the frame
6. A hinge for supporting the door with respect to the frame
7. A hinge mechanism for supporting the door with respect to the frame
8. Hinge means for supporting the door with respect to the frame

Limitation

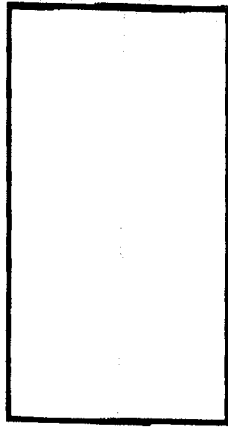
Y

N

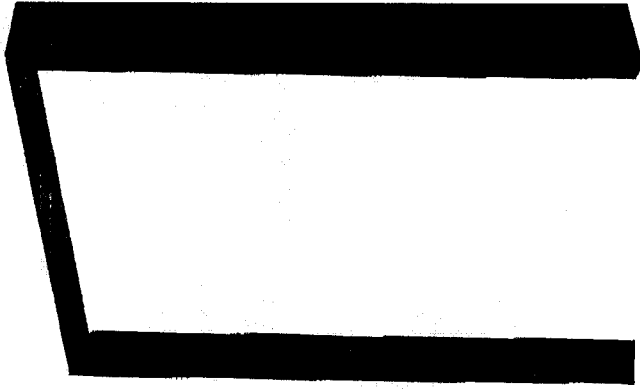
9. Means including at least one hinge for supporting the door with respect to the frame
10. Means hingedly connecting the door to the frame



DOOR



MEANS



DOOR CASING