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"MEANS" CLAUSES IN PATENT CLAIMS

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1. INTRODUCTION

In an important decision, the Court of Appeals for the Federal Circuit held that both the courts and the United States Patent and Trademark Office must interpret "means" clauses by referring to structures disclosed in the specification and equivalents of those structures. This decision was intended to stop the Patent Office's practice of interpreting "means" clause to cover any and all structures that perform the function given in a means clause, regardless of whether the structure was disclosed in the specification. While intended to bring uniformity to patent practice, the Federal Circuit decision creates significant problems for patent practitioners. This article explores the opportunities and problems for patent practitioners in light of the Federal Circuit's decision.

• WHAT DOES A "MEANS" CLAUSE MEAN?

The use of "means" clauses is explicitly authorized by 35 U.S.C. § 112, ¶ 6 which states:

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.

Means clauses offer a simple method for broadly defining an element by its function rather than by narrowly defining it based on its physical characteristics. Examples of means clauses are:

1. Printing means and means for printing . . . ;
2. Force-generating means adapted to provide . . . ; and
3. Call register means, including a digital display for providing a substantially instantaneous display for . . .

• INTERPRETATION OF "MEANS" CLAUSES

- THE DONALDSON DECISION

The interpretation of "means" clauses has been a matter of controversy between the Federal Circuit and the Patent Office. The Federal Circuit took the position that means clauses must be interpreted identically by both the courts and by the Patent Office. In *re Iwahashi*, 888 F.2d 1379, (Fed. Cir. 1989); In *re Bond*, 910 F.2d 831, (Fed. Cir. 1990). By contrast, the Patent Office refused to accept the Federal Circuit's interpretation of the law, and continued to interpret means clauses to cover any and all structures that perform the function given in means clause, regardless of whether the structure was disclosed in the specification. The Patent Office justified its position asserting that the applicant can always control the meaning of the claim language during prosecution.

The Federal Circuit finally issued an opinion which forced the Patent Office to construe "means" clauses identically in prosecution as the courts do in litigation. In *re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994) (en banc). The Federal Circuit unequivocally stated:

The plain and unambiguous meaning of [35 U.S.C. § 112] paragraph 6 is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the

specification provides such disclosure. Paragraph 6 does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be.

- **WHAT DOES "EQUIVALENT" MEAN IN 35 U.S.C. 112, 146?**

One problem with the Donaldson decision is that the Federal Circuit did not define "equivalent" under 35 U.S.C. 112, and did not state exactly how 35 U.S.C. 112, 146 is to be applied. The Federal Circuit attempted to correct these omissions in its subsequent Valmont Industries decision, but failed to do so. Valmont Industries Inc. v. Reinke Manufacturing Co. Inc., 25 U.S.P.Q.2d 1451 (Fed. Cir. 1993).

According to the Valmont decision, a means-plus- function limitation will read on an accused device only if the accused device (1) performs the identical function specified in the claims, and (2) "employs means identical to or the equivalent of the structures, material, or acts described in the patent specification." In that decision, the Federal Circuit noted that the word "equivalent" is not to be confused with the "Doctrine of Equivalents" stating:

An equivalent under the Doctrine of Equivalents results from an insubstantial change which, from the perspective of one of ordinary skill in the art, adds nothing of significance to the claimed invention.

The Court also noted that the Doctrine of Equivalents involves the familiar three-part inquiry of performing substantially the same overall function or work in substantially the same way to obtain substantially the same overall result.

Then, however, the Federal Circuit confused matters by defining the word "equivalent" as used in 35 U.S.C. 112, 146 as follows:

"[I]nvoles the familiar concept of the insubstantial change which adds nothing of significance."

Thus, "equivalent" under the Doctrine of Equivalents, and "equivalent" under 35 U.S.C. 112, 146 both mean "insubstantial".

In view of the Federal Circuit definition of "equivalent", it is unclear how an accused device can infringe under the Doctrine of Equivalents without also being "equivalent" under 35 U.S.C. 112, 146. No reported case has been found where there was no literal infringement under 35 U.S.C. 112, 146, but there was infringement under the Doctrine of Equivalents. Therefore, there remains a need for clarification of these issues by the Federal Circuit.

In its Guidelines for Examiners on means clauses, the Patent Office attempted to instruct examiners as what the "equivalent" means under 35 U.S.C. 112. The Patent Office Guidelines declare that for prior art to be equivalent to the structure disclosed in a patent application, the prior art structure must perform the identical function recited in the claim. After that test is met, the Patent Office will apply the following indicia to determine whether one element is equivalent to another:

1. Whether the prior art performs the function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification.
2. Whether a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification.
3. Whether the prior art element is a structural equivalent of the corresponding element disclosed in the specification being examined. That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification.
4. Whether the structure, material or acts disclosed in the specification represents an insubstantial change which adds nothing of significance to the prior art element."

Of course, the first indicia relied upon by the Patent Office creates problems, in that it uses the Doctrine of Equivalents standard, even though the Federal Circuit has stated that the word "equivalent" in 35 U.S.C. 112 does not mean the same thing as "equivalent" under the Doctrine of Equivalents.

- **THE EFFECT OF DONALDSON ON PATENT OFFICE EXAMINATION**

Can patent practitioners expect that the Patent Office will no longer broadly interpret means clauses during prosecution? The simple answer to that question is NO!. In spite of verbiage to the contrary in the Guidelines, the net effect of the Guidelines is applicants will receive the same rejections for anticipation/obviousness for "means clause" language that they have always received.

In particular, if the Patent Office finds a prior art element that performs the function specified in means clause, the examiner will then give an anticipation and/or obviousness rejection. The only exception to that procedure will be if there is an "explicit definition provided in the specification for an equivalent". In the absence of that exception, the burden will shift to the applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In other words, if the examiner finds a prior art structure that performs the same function, the examiner has made a prima facie case of non-patentability and the burden shifts to the applicant to prove non-equivalence.

In order to prove to the Patent Office that the prior art structure is not equivalent to applicant's structure, the Patent Office suggests that the following reasons (which are not intended to be inclusive) be presented:

1. Teachings in the specification that particular prior art is not equivalent,
2. Teachings in the prior art reference itself that may tend to show non-equivalence, or
3. Rule 132 affidavit evidence of facts tending to show non-equivalence."

In other words, the only way the Patent Office will issue a claim that has a "means" clause when the prior art has structure, material, or acts that perform the same function, is by the applicant presenting arguments that, unfortunately, create prosecution history estoppel, which will prevent any broad interpretation of the means clause.

Clearly, then, a presentation of a means clause in a patent application involves some risk. If the examiner finds a structure in the prior art that performs the same function, the only way to get the claim allowed will be to establish significant prosecution history estoppel with regard to the breadth of the means clause.

• THE EFFECT OF DONALDSON ON LITIGATION

Until the courts provide some guidance as to what "equivalent" means in § 112, there will unfortunately be some uncertainty in litigation. The district courts may adopt the interpretation of the Patent Office, at least until the Federal Circuit says otherwise.

Practitioners of an earlier generation who broadly interpreted means clauses must be very careful now in bringing suit. Identity between the functional language in a means clause and the function of the accused device is not an enough to find infringement. There needs to be equivalence of structure.

Moreover, there can be an interesting result where two patents issue with identical claims that contain means clauses, where the structures disclosed in the specifications for performing the functions in the two patents are not equivalent to each other.

• CONCLUSION

Whether or not the § 112, § 6 is workable under the Federal Circuit's Donaldson decision remains to be seen. This decision has added complexity to life of the patent practitioner. This has also added uncertainty to the law, which uncertainty is not good for the business person. It makes it more difficult to advise clients.

If the current system turns out to be unworkable, maybe § 6 of § 112 should be amended to allow a means clause to read on all structures that perform the same function. That would certainly simplify matters.