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**Arguing Application of the Means-Plus-Function Limitation To Claim Elements
Without Traditional “Means” Language**

D. Joshua Smith
(January 2004)

The means-plus-function clause, 35 U.S.C. § 112, ¶ 6, has been one of the most litigated sections of the Patent Act. The means-plus-function clause applies to both patentability determinations in the United States Patent and Trademark Office and infringement proceedings.¹ Therefore, knowledge of when and how the means-plus-function limitation applies is essential whether working as a litigator or a patent prosecutor.

Title 35 of the United States Code, Section 112, paragraph 6, provides:

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 supports thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Accordingly, a patentee may generically define a structure for performing a particular function through the use of a means expression, provided that the specified structures corresponding to the means are disclosed in the patent specification.² In other words, although an applicant may choose “means-plus-function” claim language rather than specifically describing the structures of his invention, the scope of the “means” for performing the stated function must be limited to the structure he specifically disclosed in the specification, and equivalents thereof. The limitation is generally known as the “means-plus-function” or “step-plus-function” limitation.

A claim that uses the word “means” or “step for” invokes a rebuttable presumption that § 112, ¶ 6 applies. On the other hand, a claim that does not use such language, including the

¹ *In re Donaldson*, 16 F.3d 1189, 1193, 29 U.S.P.Q. 1845 (Fed. Cir. 1994).

² *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 28 (1997).

words “step of,” will create a rebuttable presumption that § 112, ¶ 6 does *not* apply.³ The Patent and Trademark Office has rejected the argument that only the term “means” will invoke § 112, ¶ 6, 1162 O.G. 59 N.2 (May 17, 1994), while the Federal Circuit has explained that traditional means language does not automatically invoke the means-plus-function limitation. However, lack of such language does not *prevent* a limitation from being construed as a means-plus-function limitation.⁴ Specifically, a claim element without express means-plus-function language may be a means-plus functional element if the element invokes purely functional terms, without the additional recital of specific structure or material for performing the function.⁵

If the claimed element is written to describe a function rather than an act, or contains no act, then the absence of definite structure to perform the claimed function requires an application of § 112, ¶ 6.⁶ In *Seal-Flex, Inc. v. Athletic Track and Court Construction*, the Federal Circuit provided guidance in distinguishing between an “act” and a “function.”⁷

For example, in *Mas-Hamilton Group v. La Gard, Inc.*, the claim required “a substantially non-resilient lever moving element for moving the lever from its disengaged position for engaging the protrusion of the lever with the cam surface on the cam wheel so that the rotation of the cam wheel thereafter in the given direction chances the locking mechanism from the locked condition to the unlocked condition.”⁸ Despite the lack of traditional means-plus-function language, the district court determined the claim to be of means-plus-function

³ *CCS Fitness, Inc. v. Bruswick Corp.*, 62 U.S.P.Q.2d 1658, 1664 (Fed. Cir. 2000) (emphasis added); *see also Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 839, 50 U.S.P.Q.2d 1225 (Fed. Cir. 1999) (determining method claims using “step of” as not invoking a presumption that § 112, ¶ 6 applies).

⁴ *See Mas-Hamilton Group v. La Gard, Inc.*, 156 F.3d 1206, 1214 (Fed. Cir. 1998).

⁵ *Id.*

⁶ *See Seal-Flex, Inc.*, 172 F.3d at 849–50.

⁷ *See id.* (the “underlying function” of a method claim element corresponds to what that element ultimately accomplishes in relationship to what the other elements of the claim and the claim as a whole accomplish; while, “acts,” correspond to how the function is accomplished).

⁸ *Mas-Hamilton Group*, 156 F.3d at 1213.

format.⁹ Specifically, the district court determined that a “lever moving element” did not have a “generally understood structural meaning in the art.”¹⁰ Accordingly, the means-plus-function limitation must apply. The Federal Circuit determined the “lever moving element” was described in terms of its function not its mechanical structure affirming the finding of the district court.¹¹

In *Cummins-Allison Corp. v. Glory Ltd.*, the invention related to a method and apparatus for counting and recognizing currency.¹² The claims at issue were method claims containing the disputed phrase—“automatically denominating.”¹³ The dictionary meaning of “denominating” is “to name or to designate.”¹⁴ Cummins conceded “automatically denominating” to mean than merely to name, but also to identify the denomination of currency and to discriminate genuine bills from non-genuine bills.¹⁵ The court determined that “denominating” required “multiple acts to achieve the end result of identification and discrimination [of the currency].”¹⁶ Therefore, the multiple acts constituted the underlying function for the entire invention.¹⁷ Applying the *Seal-Flex* test, the court determined the term “automatically denominating” corresponded to what that element ultimately accomplishes in relation to what the other elements of the claim and the claim as a whole accomplish.¹⁸ Therefore, the court held that the means-plus-function limitation must apply.¹⁹

In the two examples, both the Federal Circuit and Northern District of Illinois District Court supported their conclusions that the means-plus-function claim limitation should apply by

⁹ *Id.*

¹⁰ *Id.*

¹¹ *Id.* at 1214.

¹² 2003 WL 355470 (N.D. Ill. 2003).

¹³ *Id.* at *14.

¹⁴ *Id.* at *15 (citing Merriam Webster’s Collegiate Dictionary, 308–09 (10th ed.1997)).

¹⁵ *Id.* at *15.

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.*

reaffirming that a claim “cannot be construed so broadly to cover every conceivable way or means to perform” that function.²⁰ For example, in *Cummins-Allison Corp.*, without applying the limitation the claim would cover any method for identifying and discriminating among a plurality of U.S. currency.²¹ Therefore, the patentee would have a monopoly in the currency evaluation device market.²² Similarly, the *Mas-Hamilton* court noted that if it did not apply the means-plus-function limitation the “lever moving element” could be any device that causes the lever to move.²³

In *TM Patents, L.P. v. International Business Machines Corp.*, the court held that a claim *only* qualifies for § 112, ¶ 6 when it covers any and all means for achieving a desired result.²⁴

Part of the claim elements at issue stated:

(iv) ... an adapter connected to said parallel data bus, said data storage units and said correction bit storage unit for, in response to a storage request, (i) generating an error correction code for each data word, (ii) dividing each data word into a plurality of multi-bit portions, and (iii) transmitting said multi-bit portions and error correction code to respective data storage units and said correction bit storage unit for storage.²⁵

The District Court determined that the claim limitation did not cover any “conceivable means” for dividing the data words, generating error codes and sending the data associated with the error codes.²⁶ On the contrary, the claim requires the adapter to provide the structure to carry out such functions.

Although, the Southern District of Illinois has applied the Federal Circuit’s holding more narrowly, it is clear that courts are more likely to invoke the means-plus-function clause, if not

²⁰ See *Mas-Hamilton Group v. La Gard, Inc.*, 156 F.3d 1206, 1214 (Fed. Cir. 1998).

²¹ *Cummins-Allison Corp.*, 2003 WL 355470, at *15.

²² *Id.*

²³ *Mas-Hamilton Group*, 156 F.3d at 1214.

²⁴ *TM Patents, L.P. v. Int’l Business Machines Corp.*, 72 F. Supp. 2d 370 (S.D.N.Y. 1999) (citing *Davies v. U.S.*, 31 Fed. Cl. 769, 776 (Fed. Cl.1994)).

²⁵ *Id.* at 390.

²⁶ *Id.*

applying the means-plus-function clause will allow the patentee all means to carry out an essential function.

The Federal Circuit has also limited the application of the means-plus-function limitation where claim term has a well-known or well-understood meaning to those skilled in the art.²⁷

The scope and proper interpretation of means-plus-function language may be difficult to determine. Because of the various interpretations of means-plus-function language, patent attorneys should be familiar with the different rules of regarding the language when drafting patent applications. On the other hand, the uncertainty surrounding this language may cause potential infringers to avoid litigation fearing how a court may apply the means-plus-function clause. However, patent attorneys should strive to minimize unintended interpretations of means-plus-function language; as a result, limit the uncertainty clients may face.

²⁷ See *Personalized Media Comm. LLC v. Intl. Trade Comm'n*, 161 F.3d 696, 704–05 (Fed. Cir. 1998) (finding that “digital detector” could not be construed as means-plus-function limitation; “detector” is not generic structural term, but rather had well-known meaning to those skilled in the art); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91F.3d 1580, 1583 (Fed. Cir. 1996) (§ 112, ¶ 6 could not apply to “detent mechanism” simply because claim took its name from function; “detent” had well understood meaning in the art).