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MEANS-PLUS-FUNCTION CLAIMING POST-WILLIAMSON V. CITRIX

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I. Introduction

In 2015, the Federal Circuit’s *en banc* decision in *Williamson v. Citrix Online, LLC*² removed the “strong presumption” that a limitation that did not use the phrase “means for” did not invoke 35 U.S.C. § 112 (f).³ The authors in this paper have attempted to review the impact of *Williamson* by examining district court cases since the decision. Section II reviews the history and background of functional claiming. Section III provides an overview of the *Williamson* case. And, Section IV analyzes the post-*Williamson* district court cases as well as attempts to identify the number of patent applications and issued patents that may be impacted due to *Williamson*. This paper concludes in Section V that *Williamson*’s removal of the “strong” presumption—that limitations that do not contain the phrase “means for” do not invoke § 112 (f)—will likely have a significant impact on claims containing non-structural terms.

II. History & Background of Functional Claiming

Since at least the mid-19th century, inventors have attempted to patent their innovations through the use of functional claiming. Functional claiming allowed patentees to claim an invention without having to include a specific structure in the claim. This was particularly helpful when a patentee felt that using terms that connoted structure in a claim were inadequate. However, the scope of functional claiming was a concern to the courts.⁴ If the functional claim limitation was not tied by the claim language to any particular structure, the patentee might obtain a claim on the function alone; thus, precluding all means for practicing the function, even

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² *Williamson v. Citrix Online, LLC*, 792 F. 3d 1339, 1348-49 (Fed. Cir. 2015) (*en banc*).

³ Formerly, 35 U.S.C. § 112 (6).

⁴ *See, e.g., Gen. Electric Co. v. Wabash Appliance Co.*, 304 US 364, 372-73 (1938) (“The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms.”).

ones the patentee had not conceived or envisioned at the time of invention.⁵ Through the years, the courts have attempted to balance these concerns.

Congress codified functional claiming in the Patent Act of 1952 when it introduced 35 U.S.C. § 112 (f).⁶ This legislation was in response to the Supreme Court coming exceedingly close to wiping out functional claiming in 1946.⁷

As currently written, § 112 (f) 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 support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Id. Although, on its face, § 112 (f) seems to plainly and unambiguously state the procedure for interpreting a means or step plus function claim,⁸ the outcome and analysis of functional

⁵ See e.g., *O'Reilly v. Morse*, 56 U.S. 62 (1853) (holding that a functional claim may be disclaimed under the disclaimer statute after a court has found it to be invalid as functional); *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009) (stating that to allow a patentee to avoid providing specificity as to structure simply because a POSA would be able to devise a means to perform the claimed function “would allow the patentee to claim all possible means of achieving a function.”).

⁶ The America Invents Act renumbered the functional claiming provision to 35 U.S.C. § 112(f). Pub. L. 112–29, § 4(c), Sept. 16, 2011, 125 Stat. 296. When initially passed in the Patent Act of 1952, § 112 (f) was 35 U.S.C. § 112, third paragraph. 66 Stat. 798-99. The provision moved to the sixth paragraph of 35 U.S.C. § 112 after amendments were made to the second sentence of the second paragraph in 1975. Pub. L. 94–131, § 7, Nov. 14, 1975, 89 Stat. 691. Because the language of this provision has not been altered since 1952, other than providing a header and an enumerated paragraph, this paper will refer to this provision as § 112 (f).

⁷ *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). In *Halliburton*, the Supreme Court invalidated a claim that “[did] not describe the invention but use[d] ‘conveniently functional language at the exact point of novelty.’” *Id.* at 8 (citing *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938)). Three years later, the Supreme Court attempted to limit *Halliburton* as proscribing functional claiming only if the “language was too broad at the precise point of novelty,” but allowing it if the invention was due to a novel combination of elements “rather than the novelty of any particular element.” *Faulkner v. Gibbs*, 338 U.S. 267, 268 (1949) (affirming findings of validity and infringement). Prior to reaching the Supreme Court, the Ninth Circuit had restated the Appellants’ invalidity positions as it relates to functional claiming: “the claims do not particularly describe and distinctly claim as invention the part, improvement or combination claimed as invention but merely represent an attempt to patent a function or result[.]” *Faulkner v. Gibbs*, 170 F. 2d 34, 35 (9th Cir. 1948).

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