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*Edited by Gregory J. Battersby  
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## Patent Litigation

Dan Cooley and Alex Harding<sup>1</sup>

### The Role of Intrinsic Evidence in Construing Means-Plus-Function after *Williamson*

Under 35 U.S.C. § 112(f) (or pre-AIA § 112 ¶ 6), claims can be written in a “means-plus-function” format. In a typical case, means-plus-function claims recite a “means for [performing some function]” and cover only those structures in the patent’s specification capable of performing that function.<sup>2</sup> Limitations that do not use the word “means” can still be treated as means-plus-function limitations if they do not “recite sufficiently definite structure.”<sup>3</sup> This can be a problem if the patent drafter did not intend its claim terms to be treated as “means-plus-function” and failed to disclose the necessary structure in the specification. In such cases, a means-plus-function construction can be fatal.<sup>4</sup>

Until 2015, there was a “strong presumption” that claim limitations which did not expressly recite the word “means” or “step” should not invoke means-plus-function treatment under § 112(f).<sup>5</sup> But in the face of increasingly functional software claiming, an *en-banc* Federal Circuit in *Williamson v. Citrix Online, LLC* removed the heightened evidentiary showing.<sup>6</sup> Under *Williamson*, “the presumption can be overcome

and § 112, ¶ 6 will apply if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’”<sup>7</sup> In the immediate aftermath of *Williamson*, some practitioners noted the court’s holding may “affect the scope and validity of claims for tens of thousands of patents in a way unintended by the drafters of those claims.”<sup>8</sup>

Now five years later, various cases have relied on *Williamson* and applied *Williamson’s* standards to specific fact patterns. This article explores the nuances of two such cases where the Federal Circuit analyzed the intrinsic record—the claim language, specification, and prosecution history—to reach different conclusions under 35 U.S.C. § 112(f).

### A “Mechanical Control Assembly . . . Configured to [Perform Certain Functions]” Falls within 35 U.S.C. § 112(f)

In *MTD Prods. Inc. v. Iancu*, the Federal Circuit reversed the Board’s decision and held that limitations containing a “mechanical control assembly” should be construed as

means-plus-function.<sup>9</sup> The court agreed with the Board that the term “mechanical control assembly” was “similar to other generic . . . nonce terms” that favor means-plus-function treatment.<sup>10</sup> But the court did not agree with the Board in finding that an embodiment described in the specification imbued “mechanical control assembly” with sufficient structure to render the term structural.<sup>11</sup>

The court explained that there are two halves to the *Williamson* analysis and that in this case the Board “conflated” the two:

First, we determine if the claim limitation is drafted in means-plus-function format. As part of this step, we consider whether the claim limitation connotes “sufficiently definite structure” to a person of ordinary skill in the art. If we conclude that the limitation is in means-plus-function format, the second step requires us to review the specification to identify the structure that performs the claimed function(s) and thus “corresponds to” the claimed means.<sup>12</sup>

The Board’s error was allowing structural detail in the specification to entirely remove “mechanical control assembly” from the ambit of 112 para. 6. “Indeed, this view would seem to leave § 112, ¶ 6 without any application: any means-plus-function limitation that met the statutory requirements, i.e., which includes having corresponding structure in the specification, would end up not being a means-plus-function limitation at all.”<sup>13</sup> Although the panel agreed that the specification “plays a role” in assessing whether a particular claim term invokes means-plus-function treatment, a specification that only described the “preferred embodiment” of the claim term was insufficient in this case.<sup>14</sup>

The court was also unpersuaded by the Board's interpretation of the patent's prosecution history as favoring a structural construction. The court found that "stating that the limitation connotes structure and has weight is not inconsistent with claiming in means-plus-function format since means-plus-function limitations connote structure (i.e., corresponding structure and their equivalents)."<sup>15</sup> The court therefore found that the term "mechanical control assembly" was governed by § 112, ¶ 6.<sup>16</sup>

## "Conduit" Is Structural Language that Does Not Fall under 35 U.S.C. § 112(f)

In *TEK Glob., S.R.L. v. Sealant Sys. Int'l*, the appellant argued that claim language to "conduits connecting [a] container" and a "container connecting conduit" should be construed as means-plus-function limitations "because the term conduit is a nonce word."<sup>17</sup> The Federal Circuit disagreed and held that the terms containing "conduit" should be construed as structural.

The court relied on three findings in the intrinsic record to reach its conclusion. First, "the dependent

claims suggest that § 112, ¶ 6 does not govern. Indeed, they 'add limitations that either describe particular structural features or flesh out whether the term has a particular structural meaning.' For example, dependent claim 27 recites 'at least one of said conduits . . . comprises a hose.'<sup>18</sup> Second, the specification "clearly contemplates a conduit having physical structure. Indeed, the disclosed conduits serve to physically connect a container of sealing liquid to a compressor and to connect the compressor to tires such that '[t]he liquid is fed into the [tire] for repair by means of compressed air, e.g., by means of a compressor.'<sup>19</sup> Finally, panel noted that "[w]hen adding new claim 26 to its patent application, the applicant explained that '[n]ew claim 26 is similar to claim 10 but defines the connections in structural terms rather than 'means for' language."<sup>20</sup>

The panel complemented these intrinsic factors with an extrinsic definition for "conduit" from Webster's Third New International Dictionary: "a natural or artificial channel through which water or other fluid passes or is conveyed: aqueduct, pipe."<sup>21</sup> The panel "conclude[d] that the intrinsic and extrinsic evidence in this case establishes that the term 'conduit' recites sufficiently definite structure to avoid classification as a nonce term and agree with the district court

that [the appellant] did not meet its burden to overcome the presumption against applying § 112, ¶ 6."<sup>22</sup>

## Conclusion

These cases portray what can be a challenging and context-specific analysis under *Williamson*. Claim language, disclosure, and prosecution activity that may avoid § 112, ¶ 6 in some contexts may fall within it in others—with significant consequences. The often-fatal nature of means-plus-function treatment imposes great importance on claim drafting to avoid (or embrace) *Williamson*.

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*As a partner with Finnegan, Daniel Cooley helps companies litigate intellectual property disputes in US district courts, the International Trade Commission (ITC), and the Patent Trial and Appeal Board (PTAB). Mr. Cooley also frequently practices before the US Court of Appeals for the Federal Circuit where he has participated in dozens of appeals and petitions, arguing several as lead counsel.*

*Alex Harding is an associate at Finnegan, Henderson, Farabow, Garret & Dunner, where his practice encompasses many aspects of patent law, with an emphasis on litigation in district courts and at the International Trade Commission (ITC).*

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1. The authors are attorneys at the intellectual property firm of Finnegan, Henderson, Farabow, Garrett & Dunner LLP. This article is for informational purposes, is not intended to constitute legal advice, and may be considered advertising under applicable state laws. This article is only the opinion of the authors and is not attributable to Finnegan, Henderson, Farabow, Garrett & Dunner LLP, or the firm's clients.  
2. 35 U.S.C. § 112(f) (2018).  
3. *Watts v. XL Sys.*, 232 F.3d 877, 880 (Fed. Cir. 2000).  
4. See, e.g., *Diebold Nixdorf, Inc. v. ITC*, 899 F.3d 1291 (Fed. Cir. 2018) (holding limitations to a "cheque standby unit" indefinite for lack of

corresponding structure after construing them as means-plus-function).

5. See, e.g., *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1297 (Fed. Cir. 2014) (A pre-*Williamson* case describing the presumption as "strong," "not readily overcome" and that the Federal Circuit has "seldom held that a limitation without recitation of means is a means-plus-function limitation.")  
6. See 792 F.3d 1339, 1348–50 (Fed. Cir. 2015).  
7. *Id.* (citing *Watts*, 232 F.3d at 880).  
8. Dori J. Hines, *The Future of Functional Claiming, Part 1: Practical Implications of the Williamson Decision for Software Patents*, FINNEGAN (October 2015) (<https://www.finnegan.com/en/insights/>

[the-future-of-functional-claiming-part-1-practical-implications.html](https://www.finnegan.com/en/insights/the-future-of-functional-claiming-part-1-practical-implications.html)).

9. 933 F.3d 1336 (Fed. Cir. 2019).  
10. *Id.* at 1343.  
11. *Id.* at 1344.  
12. *Id.*  
13. *Id.*  
14. *Id.*  
15. *Id.* at 1345.  
16. *Id.*  
17. 920 F.3d 777, 785 (Fed. Cir. 2019).  
18. *Id.* at 786. (internal citations omitted).  
19. *Id.* (internal citations omitted).  
20. *Id.* (internal citations omitted).  
21. *Id.* (internal citations omitted).  
22. *Id.*

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