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Federal Circuit Patent Bulletin: *Robert Bosch LLC v. Snap-On, Inc.*

October 14, 2014

"[For purposes of 35 U.S. C. § 112(f),] the phrase 'by means of' [does not alone invoke the means-plus-function] presumption."

On October 14, 2014, in *Robert Bosch LLC v. Snap-On, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Prost,* Taranto, Hughes) affirmed the district court's judgment that U.S. Patent No. 6,782,313, which related to a diagnostic tester that determines whether the computerized control unit in a motor vehicle needs to be reprogrammed, was invalid as indefinite. The Federal Circuit stated:

Section 112, ¶ 6 (now § 112(f)) allows a patentee to express a claim limitation as "a means or step for performing a specified function without the recital of structure, material, or acts in support thereof," and the section provides that claim limitations expressed in this manner "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." The framework under which we determine if a claim limitation invokes § 112, ¶ 6 is a two-step process. First, we must determine if the claim limitation is drafted in the means-plus-function format. The use of the term "means" triggers a rebuttable presumption that § 112, ¶ 6 governs the construction of the claim term. Alternatively, where the claim language does not recite the term "means," we presume that the limitation does not invoke § 112, ¶ 6. When a claim term lacks the word "means," the presumption can be overcome 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.'" If we conclude that a claim term invokes § 112, ¶ 6,we proceed to the second step and attempt to construe the disputed claim term by identifying the "corresponding structure, material, or acts described in the specification" to which the claim term will be limited. If we are unable to identify any "corresponding structure, material, or acts described in the specification," the claim term is indefinite.

Claim 1 of the '313 patent includes two references to a "program recognition device": "the external diagnostic tester comprising, a [1] program recognition and program loading device, wherein a program version contained in a connected control unit is queried and recognized by means of the [2] program recognition device . . . ." We are unaware of any precedent stating that the presumption is triggered by a claim's use of the expression "by means of." In the past we have applied the presumption when a claim uses the word "means" as a noun in the claim: a "means" for doing something. We have not done so for the phrase "by means of." Therefore, we conclude that the district court erred in adopting a presumption that "program recognition device" is a means-plus-function term based on the phrase "by means of" in claim 1. However, [this] error was harmless, as even without the benefit of the presumption, "program recognition device" still invokes § 112, ¶ 6.

Although both "program recognition device" and "program loading device" are presumed not to invoke § 112,¶ 6, we must next turn to the issue of whether this "strong" presumption against means-plus-function claiming is overcome. In undertaking this analysis, we ask if the claim language, read in light of the specification, recites sufficiently definite structure to avoid § 112, ¶ 6. [T]his court has found the word "device" to be a non-structural, "nonce" word. And the other words do nothing more than identify functions for the "device" to perform. [T]he '313 patent's specification does not contain a single reference to the structure of the "program recognition device" itself; all of the proffered citations from the specification merely explain its function. . . . The specification is, therefore, also silent about any interaction between the "program recognition device" and other components of the system, including the external diagnostic tester. [T]he '313 patent is silent on what such a "program loading device" consists of; the loading could be achieved by using any type of device that comprises hardware, software, or both. And the specification is again silent about how the "program loading device" receives and processes signals; the lone mention of a serial communication protocol is actually in reference to the "diagnostic/test plug." Because the '313 patent's disclosures of "program recognition device" and "program loading device" are solely functional, one of ordinary skill in the art could not find in the specification a definition of the terms as referring to a particular structure. . . .

[M]erely listing examples of possible structures is insufficient to avoid invocation of § 112, ¶ 6. Indeed, means-plus-function language that defines a category in functional terms will typically cover examples of structures that fall within it. This is not a basis for distinguishing structural language from § 112, ¶ 6 language. Although Bosch was entitled to a presumption against means-plus-function claiming, for the foregoing reasons we agree with the district court and Snap-On that this presumption was overcome. The claim terms, construed in light of the specification, fail to provide sufficiently definite structure to one of skill in the art. The claim terms "program recognition device" and "program loading device" invoke § 112, ¶ 6. . . .

Bosch did not argue to this court that, even if the claim language at issue is within § 112, ¶ 6, the language is definite because the specification sufficiently discloses corresponding structure. And we also see no such disclosure. [I]n the limited number of instances that the specification even mentions these claim terms, it offers no further guidance about their structures. Therefore, we conclude that "program recognition device" and "program loading device" are indefinite. Since these terms are found in the only independent claim of the '313 patent, we conclude that all claims in the '313 patent are invalid.