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Federal Circuit Patent Bulletin: *Williamson v. Citrix Online, LLC*

June 17, 2015

"[The] heightened bar to overcoming the presumption that a limitation expressed in functional language without using the word 'means' is not subject to § 112, para. 6 . . . is unjustified [and] we should abandon characterizing as 'strong' [that] presumption."

On June 16, 2015, in *Williamson v. Citrix Online, LLC*, the U.S. Court of Appeals for the Federal Circuit en banc (Prost, Newman, Lourie, Linn,* Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes) affirmed-in-part, vacated-in-part, and remanded the district court's judgment that Citrix did not infringe certain claims of U.S. Patent No. 6,155,840, which related to a virtual classroom environment, and that other claims of the '840 patent were invalid for indefiniteness. The Federal Circuit stated:

Means-plus-function claiming occurs when a claim term is drafted in a manner that invokes 35 U.S.C. § 112, para. 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. In enacting this provision, Congress struck a balance in allowing patentees to express a claim limitation by reciting a function to be performed rather than by reciting structure for performing that function, while placing specific constraints on how such a limitation is to be construed, namely, by restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof.

To determine whether § 112, para. 6 applies to a claim limitation, our precedent has long recognized the importance of the presence or absence of the word "means." [T]he use of the word "means" in a claim element creates a rebuttable presumption that § 112, para. 6 applies. Applying the converse, we stated that the failure to use the word "means" also creates a rebuttable presumption—this time that § 112, para. 6 does not apply. We have not, however, blindly elevated form over substance when evaluating whether a claim limitation invokes § 112, para. 6: Merely because a named element of a patent claim is followed by the word "means," however, does not automatically make that element a "means-plus-function" element under 35 U.S.C. § 112, ¶ 6. . . . The converse is also true; merely because an element does not include the word "means" does not automatically prevent that element from being construed as a means-plusfunction element.

In making the assessment of whether the limitationin question is a means-plus-function term subject to the strictures of § 112, para. 6, our cases have emphasized that the essential inquiry is not merely the presence or absence of the word "means" but whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure. When the claim uses the word "means," our cases have been consistent in looking to the meaning of the language of the limitation in assessing whether the presumption is overcome. We have also traditionally held that when a claim term lacks the word "means," the presumption can be overcome and § 112, para. 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." [Our precedent has] established a heightened bar to overcoming the presumption that a limitation expressed in functional language without using the word "means" is not subject to § 112, para. 6.

Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as "strong" the presumption that a limitation lacking the word "means" is not subject to § 112, para. 6. That characterization is unwarranted, is uncertain in meaning and application, and has the inappropriate practical effect of placing a thumb on what should otherwise be a balanced analytical scale. It has shifted the balance struck by Congress in passing § 112, para. 6 and has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute. Henceforth, we will apply the presumption . . . without requiring any heightened evidentiary showing and expressly overrule the characterization of that presumption as "strong." We also overrule the strict requirement of "a showing that the limitation essentially is devoid of anything that can be construed as structure." The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure. When a claim term lacks the word "means," the presumption can be overcome and § 112, para. 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." The converse presumption remains unaffected: "use of the word 'means' creates a presumption that § 112, ¶ 6 applies."

[T]he claim limitation in question is not merely the introductory phrase "distributed learning control module," but the entire passage "distributed learning control module for receiving communications transmitted between the presenter and the audience member computer systems and for relaying the communications to an intended receiving computer system and for coordinating the operation of the streaming data module." This passage, as lengthy as it is, is nonetheless in a format consistent with traditional means-plus-function claim limitations. It replaces the term "means" with the term "module" and recites three functions performed by the "distributed learning control module." "Module" is a well-known nonce word that can operate as a substitute for "means" in the context of § 112, para. 6. As the district court found, "'module' is simply a generic description for software or hardware that performs a specified function." Generic terms such as "mechanism," "element," "device," and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word "means" because they "typically do not connote sufficiently definite structure" and therefore may invoke § 112, para. 6.

Here, the word "module" does not provide any indication of structure because it sets forth the same black box recitation of structure for providing the same specified function as if the term "means" had been used. . . . The prefix "distributed learning control" does not impart structure into the term "module." These words do not describe a sufficiently definite structure. Although the "distributed learning control module" is described in a certain level of detail in the written description, the written description fails to impart any structural significance to the term. At bottom, we find nothing in the specification or prosecution history that might lead us to construe that expression as the name of a sufficiently definite structure as to take the overall claim limitation out of the ambit of § 112, para. 6. While Williamson is correct that the presence of modifiers can change the meaning of "module," the presence of these particular terms does not provide any structural significance to the term "module" in this case.

While portions of the claim do describe certain inputs and outputs at a very high level (e.g., communications between the presenter and audience member computer systems), the claim does not describe how the "distributed learning control module" interacts with other components in the distributed learning control server in a way that might inform the structural character of the limitation-inquestion or otherwise impart structure to the "distributed learning control module" as recited in the claim. [T]he fact that one of skill in the art could program a computer to perform the recited functions cannot create structure where none otherwise is disclosed. For the foregoing reasons, we conclude that the "distributed learning control module" limitation fails to recite sufficiently definite structure and that the presumption against means-plus-function claiming is rebutted. We therefore agree with the district court that this limitation is subject to the provisions of 35 U.S.C. § 112, para. 6. . . .

Construing a means-plus-function claim term is a two-step process. The court must first identify the claimed function. Then, the court must determine what structure, if any, disclosed in the specification corresponds to the claimed function. Where there are multiple claimed functions, as we have here, the patentee must disclose adequate corresponding structure to perform all of the claimed functions. If the patentee fails to disclose adequate corresponding structure, the claim is indefinite. . . . Structure disclosed in the specification qualifies as "corresponding structure" if the intrinsic evidence clearly links or associates that structure to the function recited in the claim. Even if the specification discloses corresponding structure, the disclosure must be of "adequate" corresponding structure to achieve the claimed function. Under 35 U.S.C. § 112, paras. 2 and 6, therefore, if a person of ordinary skill in the art would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim, a meansplus-function clause is indefinite. . . .

The written description of the '840 patent makes clear that the distributed learning control module cannot be implemented in a general purpose computer, but instead must be implemented in a special purpose computer—a general purpose computer programmed to perform particular functions pursuant to instructions from program software. A special purpose computer is required because the distributed learning control module has specialized functions as outlined in the written description. In cases such as this, involving a claim limitation that is subject to § 112, para. 6 that must be implemented in a special purpose computer, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor. We require that the specification disclose an algorithm for performing

the claimed function. The algorithm may be expressed as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure. . . . The specification does not set forth an algorithm for performing the claimed functions. . . . Because the '840 patent fails to disclose any structure corresponding to the "coordinating" function of the "distributed learning control module," we affirm the judgment that claims 8–16 are invalid for indefiniteness under 35 U.S.C. § 112, para. 2.