



Morgan Lewis

IP WEBINAR SERIES

BETTER SAFE THAN SORRY

Means Plus Function

July 24 |

Jitsuro Morishita

jitsuro.morishita@morganlewis.com

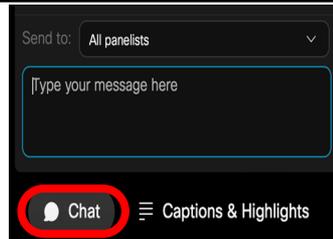
Webinar開始の前に

音声について

- **コンピューターの音声を使用**：ヘッドセットまたはスピーカーを装着したコンピューターを使用します。これは、デフォルトの音声接続タイプです。
- ヘッドセット、スピーカー、およびマイクを変更することができます。
- **コール ミー**：電話を受け取る電話番号を入力または選択します。ウェビナー通話する必要があります。
- **コールイン**：電話からウェビナーに参加。国際コールイン番号は「Show all global call-in numbers」をご確認ください。
- **音声に接続しない**：ウェビナーをコンピュータまたは電話から選択します。次を実行している場合は、このオプションを使用します。コンテンツを共有するためにコンピュータを使用する必要があります。

ご質問がある場合

チャットよりご質問を送信してください



CLE

NY/CA/IL の弁護士資格をお持ちの方でCLEクレジットを取得する場合は、**Webinar終了後のアンケート**で、最後にお伝えする「**Alphanumeric Code**」の**入力が必要**となります

技術的なサポートが必要な場合

- Webex ヘルプセンターをご参照ください
<https://help.webex.com/ja-jp>
- 音声が聞こえない場合
https://help.webex.com/ja-jp/article/ela6i8/ミーティングまたはウェビナーに参加する前に音声とビデオの設定を選択する#id_138213
- 上記で解決できない場合は、貴社 IT 部門にお問い合わせください

Morgan Lewis

MEANS PLUS FUNCTION

35 U.S.C. § 112: Means Plus Function

35 U.S.C. § 112 (f) (AIA)

(f) ELEMENT IN CLAIM FOR A COMBINATION.—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.

35 U.S.C. §112: Means Plus Function

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.

See Williamson v. Citrix Online, LLC, (Fed. Cir. 2015)(en banc)

Example

“A screw” v. “A means for holding together”



The Word “Means”

Use of the word “means” in a claim element creates a **rebuttable presumption** that § 112, para. 6 applies.

See Personalized Media Communications, LLC v. ITC (Fed. Cir. 1998)

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-plus-function element.

See Cole v. Kimberly-Clark Corp., (Fed. Cir. 1996)

The Word "Means"

United States Patent [19]

Cole

[11] Patent Number: 4,743,239

[45] Date of Patent: May 10, 1988

[54] DISPOSABLE BRIEF HAVING AN AREA OF RELATIVELY THIN ABSORBENT MATERIAL AND AN AREA OF RELATIVELY THICK ABSORBENT MATERIAL

[76] Inventor: Shelley K. Cole, 4505 W. North La., Glendale, Ariz. 85302

[21] Appl. No.: 928,021

[22] Filed: Nov. 7, 1986

[51] Int. Cl.² A61F 13/16

[52] U.S. Cl. 604/385 R; 604/396

[58] Field of Search 604/385.1, 394, 396

[56] References Cited

U.S. PATENT DOCUMENTS

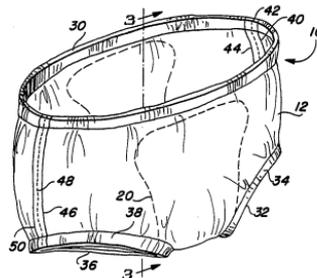
3,237,625 3/1966 Johnson 604/396
4,619,649 10/1986 Roberts 604/396

Primary Examiner—John D. Yasko
Attorney, Agent, or Firm—H. Gordon Shields

[57] ABSTRACT

Disposable brief includes an exterior moisture barrier and an interior area having two different absorbent materials, including a relatively thin layer of absorbent material and a center portion having a relatively thick layer of absorbent material. The sides of the brief are perforated to enable the brief to be easily removed after an accident by the user of the brief. The waist and legs are elasticized.

9 Claims, 1 Drawing Sheet



The Word “Means”

1. A disposable training brief comprising, in combination:

outer impermeable layer means;

first absorbent layer means...;

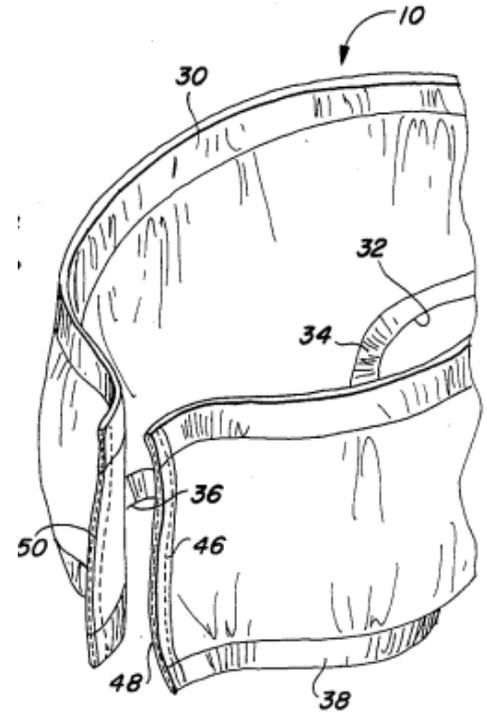
second absorbent layer means...;

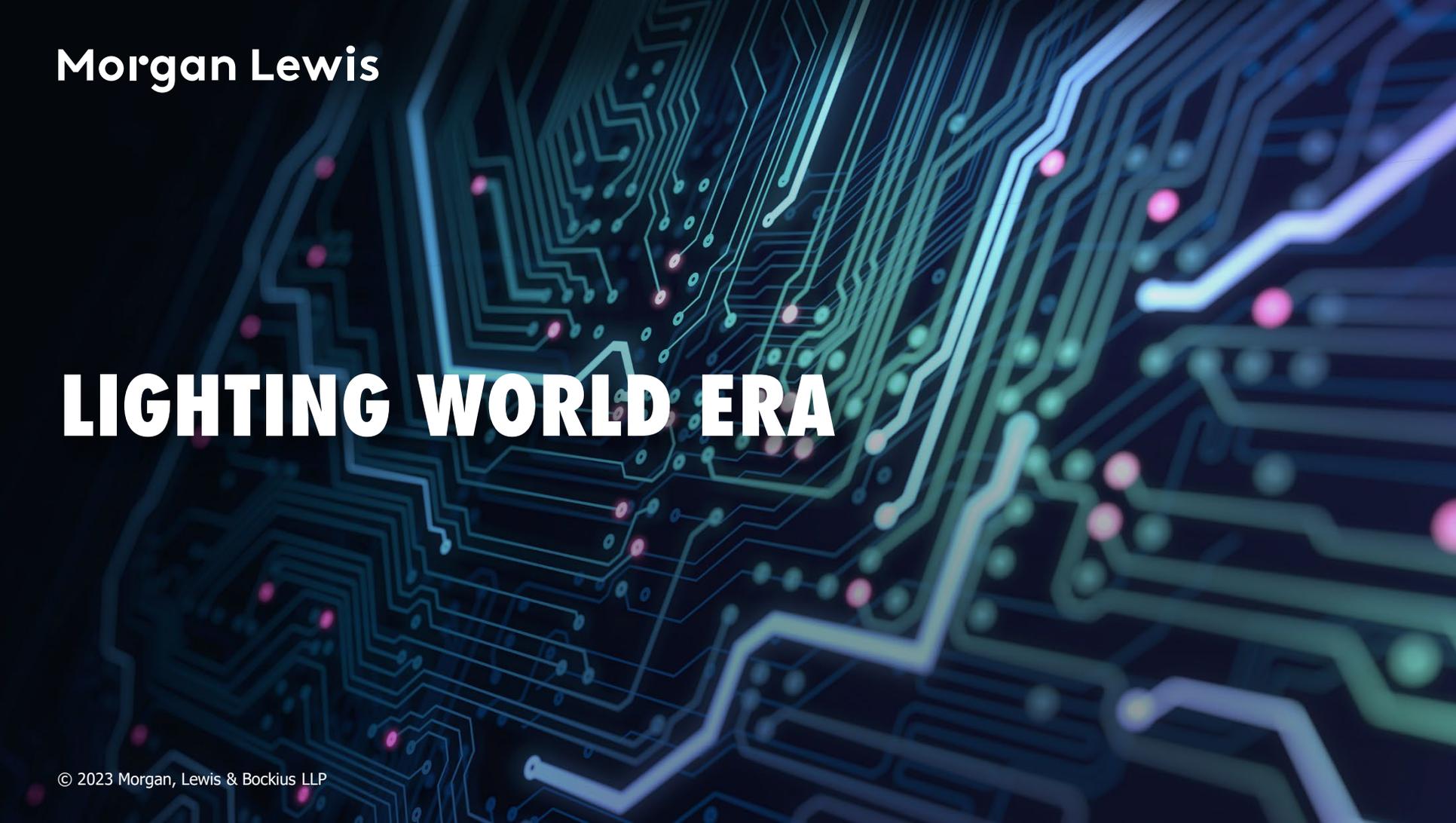
waist band means...;

leg band means...;

perforation means extending from the leg band means to the waist band means through the outer impermeable layer means for tearing the outer impermeable layer means for removing the training brief in case of an accident by the user, and

side zones on the outer impermeable layer means...





Morgan Lewis

LIGHTING WORLD ERA

The Lighting World Era

“[T]he presumption flowing from the absence of the term ‘means’ is **a strong one that is not readily overcome**”

See Lighting World, Inc. v. Birchwood Lighting, Inc. (Fed.Cir.2004)

“[The presumption was] ‘strong’ and ‘not readily overcome’ and **‘seldom’ held that a limitation without recitation of ‘means’ is a means-plus-function limitation**”

See Apple Inc. v. Motorola, Inc., (Fed.Cir.2014)

The Lighting World Era

“When the claim drafter has not signaled his intent to invoke [§ 112 ¶ 6](#) by using the term ‘means,’ **we are unwilling to apply that provision without a showing that the limitation essentially is devoid of anything that can be construed as structure”**

See Flo Healthcare Solutions, LLC v. Kappos (Fed.Cir.2012)

Example

“A screw” v. “A device for holding together”



NO MPF

Morgan Lewis

WILLIAMSON ERA

Williamson v. Citrix Online, LLC (Fed. Cir. 2015)

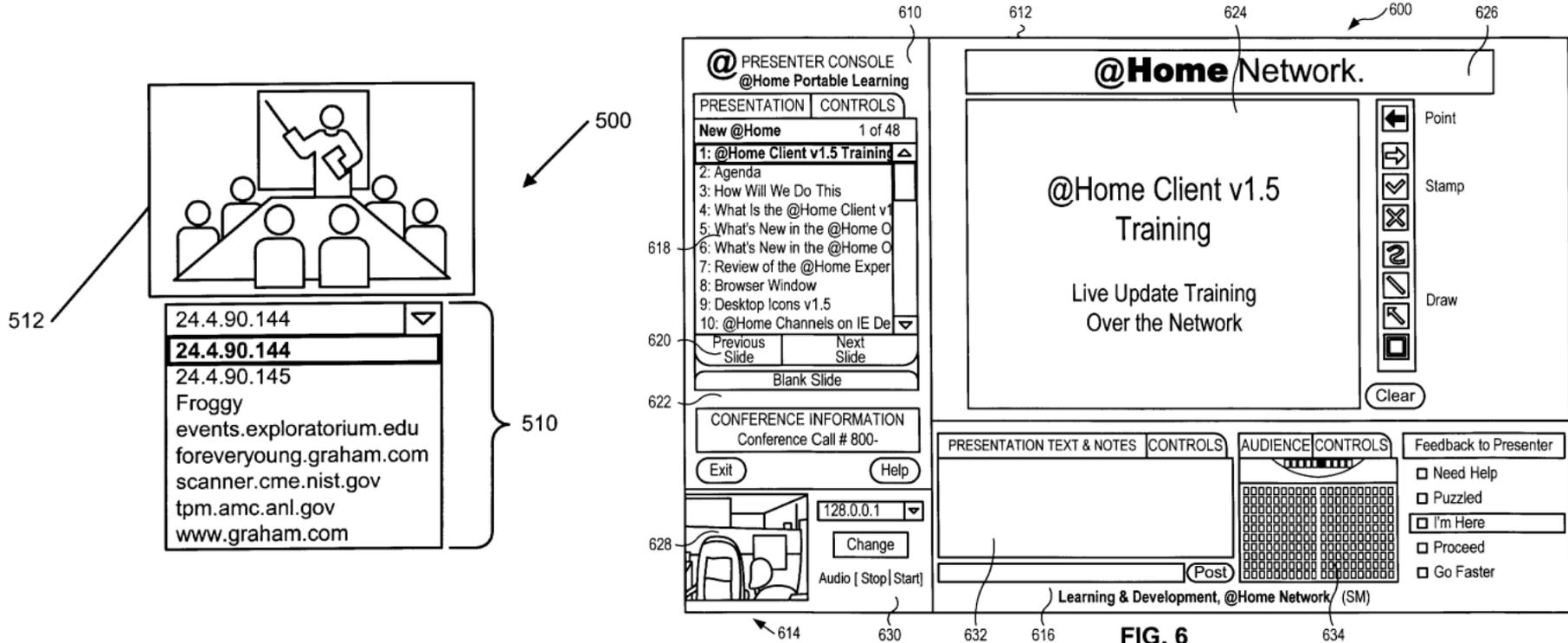


FIG. 6

Williamson v. Citrix Online, LLC (Fed. Cir. 2015)

8. A system for conducting distributed learning among a plurality of computer systems coupled to a network, the system comprising:

a presenter computer system of the plurality of computer systems coupled to the network and comprising: ...

an audience member computer system of the plurality of computer systems and coupled to the presenter computer system via the network, the audience member computer system comprising: ...

a distributed learning server remote from the presenter and audience member computer systems of the plurality of computer systems and coupled to the presenter computer system and the audience member computer system via the network and comprising:...

a 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.

The *Williamson* en banc Decision

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.

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.

Williamson v. Citrix Online, LLC, (Fed. Cir. 2015)(en banc)

Example

“A screw” v. “A module for holding together”



Nonce Words

“Module” is a well-known nonce word that can operate as a substitute for “means” in the context of § 112, para. 6 ... 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.

See Williamson v. Citrix Online, LLC, (Fed. Cir. 2015)(en banc)

Nonce Words - “nothing more than a verbal construct”

Williamson Four

- **Device**
- **Element**
- **Module**
- **Mechanism**

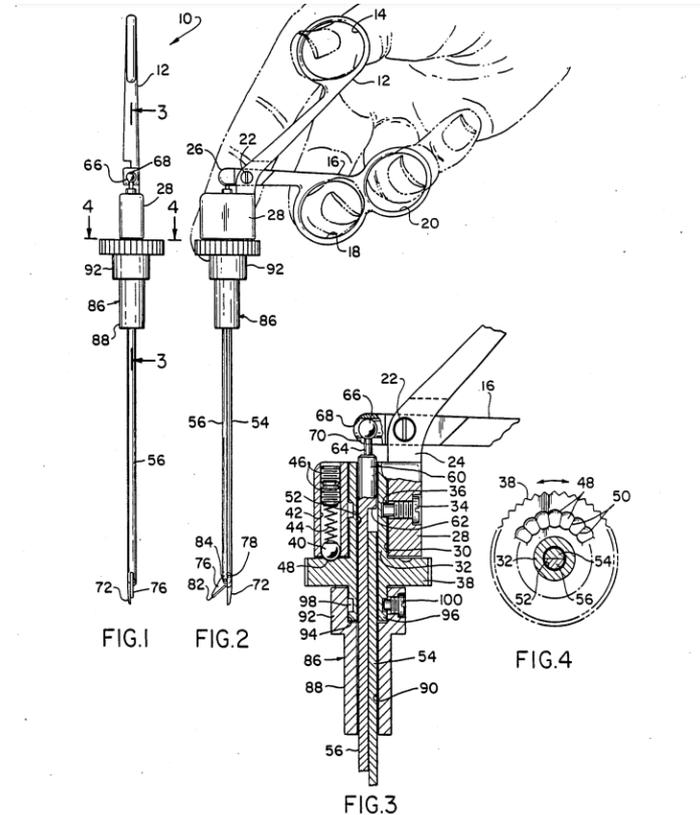
Other Possible Nonce Words

- | | |
|-------------|-----------|
| • Apparatus | Assembly |
| • Code | Component |
| • Engine | Machine |
| • Member | Portion |
| • Processor | Program |
| • Section | Software |
| • System | Unit |

Structural Words having a Functional Origin

- Brake
- Clamp
- Container
- Cutter
- **Detent Mechanism**
- Driver
- Filter
- Grasper
- Lock

Morgan Lewis



Morgan Lewis

INDEFINITENESS

35 U.S.C. § 112: Indefiniteness

35 U.S.C. § 112 para 2 (Pre-AIA)

The specification shall conclude with one or more claims **particularly pointing out and distinctly claiming the subject matter** which the applicant regards as his invention.

35 U.S.C. § 112 (b) (AIA)

(b) CONCLUSION.—The specification shall conclude with one or more claims **particularly pointing out and distinctly claiming the subject matter** which the inventor or a joint inventor regards as the invention.

35 U.S.C. § 112: Indefiniteness

Construing a means-plus-function claim term is a **two-step process**. The court must first identify the claimed function. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012). 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.** *Id.* at 1318–19. **If the patentee fails to disclose adequate corresponding structure, the claim is indefinite.** *Id.* at 1311–12.

Williamson v. Citrix Online, LLC, (Fed. Cir. 2015)(en banc)

Distributed Learning Control Module

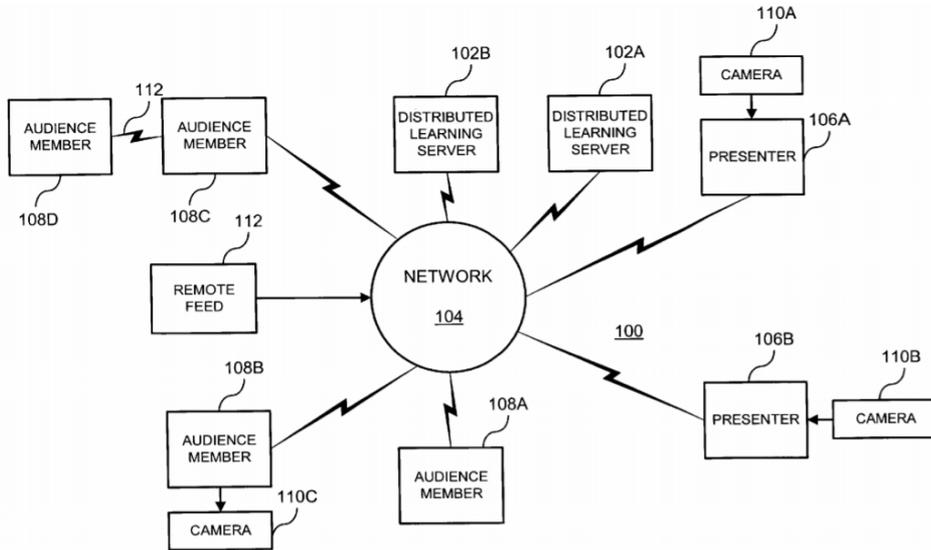


FIG. 1

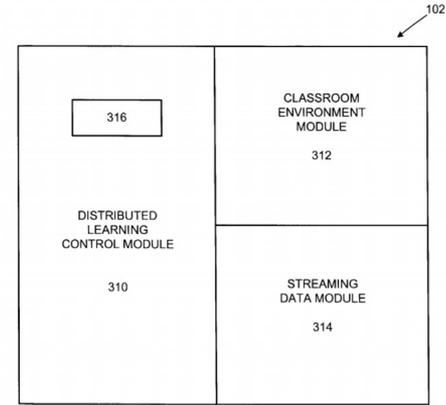


FIG. 3

FIG. 3 is a block diagram illustrating the functional units of the DLS 102, including a distributed learning control module (DLCM) 310, a classroom environment module 312, and a streaming data module 314. The DLCM 310 controls the communications among the various computer systems 106, 108 in the distributed learning system 100 and manages the other modules in the DLS 102. A preferred embodiment of the DLCM 310 executes an operating system like MICROSOFT WINDOWS NT® or SUN MICROSYSTEMS SOLARIS® 2.x and uses a hypertext transport protocol (HTTP)-based web server, like NETSCAPE ENTERPRISE SERVER 2.0 or the APACHE web server, to receive and respond to requests for data from the other computer systems 106, 108.

35 U.S.C. §112: Indefiniteness

- *Williamson* affects software patents since the inherent nature (**lack of structure**) of software makes it easier for challengers to attack the claims applying the MPF theory.
- Structure disclosed in the specification **must be more than** a general purpose computer or microprocessor. Structures can be shown through disclosures of **algorithms performing the claimed function**.
- Computer-implemented function “**must include the algorithm** needed to transform the general purpose computer or microprocessor disclosed in the specification” to a “special purpose computer” programmed to perform the claimed function. Claiming a means for performing a specific computer-implemented function, **without sufficiently disclosing the algorithm to perform that function**, amounts to “pure functional claiming” and warrants a rejection for **indefiniteness** under 35 U.S.C. §112(b).

Aristocrat Techs. Australia PTY Ltd. v. Int’l Game Tech, 521 F.3d 1328 (Fed. Cir. 2008)

Morgan Lewis

ANNOUNCEMENTS

MAY. 2023

發明

THE INVENTION



Special Interview
待映画で知財を知る!? 日越合作映画に向けて

(5) マーキングされていない物品を発見した場合

「被疑侵害者は、自身の特許を実施しているとする物品が特許権者またはそのライセンサーによってマーキングされていない状態で販売されている事実を特許権者に対して通知すれば足り、……被疑侵害者がその責任を果たした場合には、特定された製品が特許実施を実施していないことを証明する責任は特許権者が負うことになる」²²⁴

上記CAFC判例が示すとおり、権利行使を受けた被疑侵害者が特許権者のマーキング義務違反を指摘して過去分の損害賠償を免れるためには、マーキングされていない特許物品が販売されていた証拠をつかむことが重要となります。

前述のとおり、マーキング義務違反は先特許権者までさかのぼって検討することが有効です。特許権発生後、どこかの段階で特許権者もしくはそのライセンサーが特許物品の販売行為を行っていないか調査し、具体的な証拠（実際のマーキングされていない製品等）の特許権者に突きつけることで、過去分の損害賠償を免れられる可能性があります。

米国特許技術論争の論点整理

知的財産なぞかけ

筆者の趣味である落語は読面で演じられませんが、なぜか知らない、いけないも!? ということで、今回は自作、次回以降はセミナー受講者などから募った知財にまつわるなぞかけをご紹介します。お仕事の合間にクスクッと笑っていただければ幸いです。

「図様の白うさぎ」とかかまして、「吾方を重ねた特許出願」とききます。その心は、……どちらもホウタイが分厚いでしょう。 J.M. (法律事務所勤務)

本稿は筆者個人の資格で執筆したものであり、筆者の所属組織を代表する意見等を述べたものではありません。

もりしたじつろう

ジョージワシントン大学ロースクール卒業。米国法務博士。バイオニア(株)および富士フィルム(株)の知財部専門にて渉外・訴訟業務を担当し、両社では長年を要。モルガンレイス法律事務所東京オフィスにて特許出願、鑑定、ライセンス交渉、特許訴訟、特許譲渡等の知財業務を主に担当し、2021年パートナー就任。落語を演じるのを趣味としている。2021年よりIP Webinar: Better Safe Than Sorry と題したセミナーを月例で主催し、各回200人前後の参加者と共に米国特許論争に対する備えについて議論を行っている。

- 注1 35 U.S. Code § 287 (a)
- 注2 35 U.S. Code § 286 - Time limitation on damages
"Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action."
- 注3 35 U.S. Code § 287 (a)
- 注4 *Global Traffic Technologies LLC v. Morgan*, 620 Fed. Appx. 895, 905 (Fed. Cir. 2015)
- 注5 35 U.S. Code § 287 (a)
- 注6 *Mfg. Res. Int'l v. CTVIQ Smartscopes*, 397 F. Supp. 3d 560 (D. Del. 2019)
- 注7 *Lubby Holdings LLC v. Chung*, 11 F.4th 1355, 1359 (Fed. Cir. 2021)
- 注8 <https://mri-inc.net/patents/>
- 注9 *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111 (Fed. Cir. 1996)
- 注10 *American Medical Sys. Inc. v. Medical Eng'g Corp.*, 6 F.3d 1523, 1537 (Fed. Cir. 1993)
- 注11 US4624,060の図1
- 注12 注7の判例のp.1359参照
- 注13 注9の判例のp.1112参照
- 注14 *Horatio Wash. Depot Techs. LLC v. Tolmar, Inc.*, Civil Action No. 17-1086-LPS (D. Del. 2018)
- 注15 35 U.S. Code § 287 (a)
- 注16 *Grain Processing v. Am. Maize-Products*, 185 F.3d 1341 (Fed. Cir. 1999)
- 注17 *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 950 F.3d 860 (Fed. Cir. 2020)
- 注18 35 U.S. Code § 287 (a)
- 注19 *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1345 (Fed. Cir. 2001)
- 注20 *Bundag, Inc. v. Gerrard Tire Co.*, 704 F.2d 1578, 1581 (Fed. Cir. 1983)
- 注21 US4,774,839の図12および14
- 注22 *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 498 F. Supp. 2d 718 (D. Del. 2007)
- 注23 *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308 (Fed. Cir. 2009)
- 注24 注7の判例のp.1359参照

Patent Litigation Bootcamp: Better Safe than Sorry 2023

2023年10月開講予定の全6回の参加型セミナー（定員20名）

10月： Pleading / Scheduling Conference

11月： Contentions / IPR / Motion to Stay

12月： Discovery / **Deposition Role Play**

01月： Markman Hearing

02月： Dispositive Motions / Pretrial Motions

03月： **Jury Trial Role Play** / Appeal

Your CLE Credit Information

For ALL attorneys seeking CLE credit for attending this webinar, please write down the alphanumeric code on the right >>

Kindly insert this code in the **pop-up survey** that will appear in a new browser tab after you exit out of this webinar.

THE CLE CODE IS:

SUBWAY3

IP Webinar Series: Better Safe than Sorry 2023

No. 1: Important IP Cases (2023.01.23)

No. 2: Preamble (2023.03.13)

No. 3: A-C Privilege (2023.05.22)

No. 4: Means Plus Function (2023.07.24)

No. 5: Extraterritorial Activity (2023.09.25)

No. 6: US Litigation Basics (2023.11.20)



THANK YOU

© 2023 Morgan, Lewis & Bockius LLP
© 2023 Morgan Lewis Stamford LLC
© 2023 Morgan, Lewis & Bockius UK LLP

Morgan, Lewis & Bockius UK LLP is a limited liability partnership registered in England and Wales under number OC378797 and is a law firm authorised and regulated by the Solicitors Regulation Authority. The SRA authorisation number is 615176.

Our Beijing and Shanghai offices operate as representative offices of Morgan, Lewis & Bockius LLP. In Hong Kong, Morgan, Lewis & Bockius is a separate Hong Kong general partnership registered with The Law Society of Hong Kong. Morgan Lewis Stamford LLC is a Singapore law corporation affiliated with Morgan, Lewis & Bockius LLP.

This material is provided for your convenience and does not constitute legal advice or create an attorney-client relationship. Prior results do not guarantee similar outcomes. Attorney Advertising.

