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Federal Circuit *En Banc* Decision in *Williamson v. Citrix* Overrules Long Line of Precedent Regarding Functional Claiming and § 112, Para. 6

On June 16, 2015, the Federal Circuit issued its decision in *Williamson v. Citrix Online*, overruling *en banc* a long line of precedent regarding functional claiming and affirming a District Court decision finding asserted claims 8-16 of U.S. Patent Number 6,155,840 (“the ‘840 Patent”) are subject to the requirements of 35 U.S.C. § 112, para. 6, despite a lack of “means” or “step for” language. In so doing, the Court affirmed the District Court’s determination that those claims are indefinite for lack of definite structure. In the same decision, a panel of the Court also reversed the District Court’s construction of the term “graphical display,” vacated the underlying non-infringement judgment, and remanded the case, holding that the District Court improperly read a limitation of a disclosed embodiment into the claims. Judge Linn authored the Court’s opinion.

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The ‘840 Patent describes methods and systems for creating a virtual classroom for geographically remote audience participants via a computer network that includes conventional industry-standard computer hardware and software. On appeal, the Federal Circuit reviewed the District Court’s constructions of two claim terms: “graphical display” and “distributed learning control module.”

First, a Federal Circuit panel consisting of Judges Moore, Linn and Reyna reversed the District Court’s construction of “graphical display,” which had required a “pictorial map.” The Court held that the claims of the ‘840 Patent do not require a pictorial map and that the specification discloses a pictorial map as merely an example, not as a limitation.

The Court next turned to Claim 8’s “distributed learning control module” limitation. The District Court had construed “distributed learning control module” as a “means-plus-function” element subject to the requirements of 35 U.S.C. § 112, para. 6. Having done so, the District Court had determined that the specification of the ‘840 Patent fails to disclose the necessary algorithms for performing all of the claimed functions. The District Court found claims 8-16 indefinite.

On appeal, the Federal Circuit was faced with the threshold question of whether the claims in question, which did not recite the word “means,” are nonetheless governed by § 112, para. 6. On this question, the Court recognized that its decision would require revisiting and possibly overruling prior precedent. Accordingly, this issue was considered by the Court *en banc*, with a majority of judges joining Judge Linn’s opinion.

At the outset, the Court reiterated that “the use of the word ‘means’ in a claim element creates a rebuttable presumption that § 112, para. 6 applies.” Slip op. at 13. But this does not end the analysis: “the failure to use the word ‘means’ also creates a rebuttable presumption—this time that § 112, para. 6 does *not* apply.” *Id.* (emphasis added). Thus, in evaluating claim language, “the essential inquiry is not merely the presence or absence of the word ‘means’ but whether the words of the claim are understood by a person of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.”

Through a series of decisions beginning with *Lighting World, Inc., v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1348 (Fed. Cir. 2004), the Court had established a standard by which “the presumption flowing from the absence of the term ‘means’ is a *strong one that is not readily overcome.*” *Williamson*, slip op. at 14 (emphasis in original). Following *Lighting World*, the Federal Circuit confirmed this high burden, including holding in *Flo Healthcare*

Solutions, LLC v. Kappos, 697 F.3d 1367, 1374 (Fed. Cir. 2012), that § 112, para. 6 will not be applied in the absence of “means for” or “step for” language, “without a showing that the limitation essentially is devoid of anything that can be construed as structure.” *Williamson*, slip op. at 15 (emphasis in original). Then, just last year, in *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1297 (Fed. Cir. 2014), the Federal Circuit “yet again observed that this presumption is ‘strong’ and ‘not readily overcome’ and noted that, as such, we have ‘seldom’ held that a limitation without recitation of ‘means’ is a means-plus-function limitation.” *Williamson*, slip op. at 15 (collecting cases).

Rejecting this line of cases, the *en banc* Court in *Williamson* concluded that “such a heightened burden is unjustified.” “Henceforth, we will apply the presumption as we have done prior to *Lighting World*, without requiring any heightened evidentiary showing and expressly overrule the characterization of that presumption as ‘strong.’” Slip op. at 15-16. The Court also overruled “the strict requirement of ‘a showing that the limitation essentially is devoid of anything that can be construed as structure.’” *Id.* at 16.

Addressing the specific claim language at issue in this appeal, the Federal Circuit found that “module” is a “nonce” word that can substitute for “means” in the context of § 112, para. 6. Because the ’840 Patent fails to disclose any structure corresponding to the “distributed learning control module,” the Court affirmed the District Court’s finding of indefiniteness of Claims 8-16.

Judge Reyna joined the *en banc* opinion with respect to the § 112, para. 6 issue but provided additional views. In particular, Judge Reyna expressed his concerns regarding the state of functional claiming generally, regardless of whether the word “means” was recited. Judge Reyna stated his view “that perhaps [the Federal Circuit] need[s] to revisit [its] judicially-created § 112, para. 6 presumptions” more broadly. Concurrence at 8.

Judge Newman dissented, voicing her disapproval regarding the Court’s § 112, para. 6 holding and arguing that the inevitable results of this opinion are additional uncertainty, confusion, and an invitation to further litigation. In Judge Newman’s view, it is up to the applicant to choose whether to recite the word “means” in a claim. Thus, applying § 112, para. 6 to “nonce” words and claims that do not expressly state the statutory “means for” language violates the clear language of the statute. Pushing back against what she viewed as “legislation by footnote,” she concluded that “Paragraph 6 has morphed from a clear legal instruction into a litigator’s delight.” Dissent at 4, 10.

The tension between the majority opinion, Judge Reyna’s additional views and Judge Newman’s dissent highlights the ongoing debate within the Federal Circuit regarding how § 112, para. 6 should be applied (and how § 112(f) should be applied for post-AIA patents). Notably, this decision aligns Federal Circuit precedent more closely with the USPTO’s current Guidelines surrounding prosecution of possible § 112, para. 6 claims. *See* 76 Fed. Reg. 7,167 (Feb. 9, 2011) (“When the claim limitation does not use the phrase ‘means for’ or ‘step for,’ examiners should determine whether the claim limitation uses a nonstructural term (a term that is simply a substitute for the term ‘means for’)). When analyzing patents in anticipation or in the context of litigation, counsel should review claims carefully for functional language and “nonce” words and should be prepared to craft arguments about whether § 112, para. 6 applies, regardless of the presence of “means” or “step for” language.

A copy of the decision is available [here](#). For further information, please contact your usual Ropes & Gray attorney or one of the Ropes & Gray attorneys listed above.