Practical Claim and Specification Drafting, Following Williamson v. Citrix - Patent Litigation

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Patent claims that use so-called "nonce words" in lieu of means plus function language can be correctly construed as applying the equivalent of means plus function language under 35 USC §112, sixth paragraph, and can be invalidated as indefinite under 35 USC §112, second paragraph, when the specification doesn't disclose an algorithm, according to the recent (June 16, 2015) _Williamson v. Citrix_ (Fed. Cir. 2015) en banc opinion. What are some practical strategies patent practitioners can implement in claim and specification drafting, now that some words are more likely to be interpreted as nonce word substitutions for means plus function language? Let's look at the opinion.

In page 17, the opinion talks about generic words such as module, mechanism, element, and device describing software or hardware, and on page 18 determines that the case-specific "prefix 'distributed learning control' does not impart structure into the term 'module.' These words do not describe a sufficiently definite structure." On page 15, the court opines "we should abandon characterizing as 'strong' the presumption that a limitation lacking the word 'means' is not subject to §112, para. 6." In practical terms, what this means is that we in the patent community should be aware that the above and other so-called "nonce words" in claims using functional language may well trigger interpretation as means plus function language. Patent practitioners should make certain that the specification discloses as many embodiments, variations and equivalents as befits desired representation of the client's invention. Where, in the past, one could rely on the doctrine of equivalents being applicable to claim language (at least in unamended portions of claims), the reliance appears to now shift to the specification in these types of patent applications. Of course, it has always been good practice to put further embodiments, variations and equivalents in the specification, but now it is more important to do so.

In page 22, the court opines that "The specification does not set forth an algorithm for performing the claimed functions." Particularly, the court looks at figures 4 and 5 which were argued as disclosing an algorithm, and concludes that figure 4 shows a representative display, but no algorithm. From this, we patent practitioners can glean that we should always disclose one or more algorithms in any specification to a claim that might be subject to the means plus function interpretation. This, too, has always been good practice, but is now relatively more important. A flowchart or a flow diagram, and descriptions of steps or actions of a method, have long been considered good disclosures of algorithms. Patent practitioners should make sure these are in the specification when nonce words and functional language are used in the claims. Where formerly we might have put a flow diagram in a software-based specification, a flow diagram may well be useful in hardware, mechanical, or materials-based specifications, etc. Examples of applicable flow diagrams include ones for methods to make an article, device, material or apparatus, or use an article, device, material or apparatus.

Another good practice is to put structure in the claim, so that the person of ordinary skill in the art could recognize the claim as having sufficient structure so as to not invoke means plus function interpretation. It may not be sufficient to just have the word processor there in the claim, or module, etc., but structure could include descriptions of data structures, registers, types of memory, ports, or other pieces of computers or devices, e.g.

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in a network or a machine. On the other hand, in light of these changes in court interpretation of claim language, it may actually be desirable to shift the burden of providing equivalents to the specification, which can be more voluminous than the body of the claim and thus has more room for descriptions of equivalents.

Takeaways

– Structure, structure, structure in the claim may avoid means plus function interpretation.

– Flow diagrams and descriptions of steps of the method may constitute disclosure of an algorithm and avoid negation of a claim construed as using nonce words in means plus function language.

– Further embodiments, variations, and equivalents in the specification play an important role in claims construal, more so with nonce words in the claims.

All part of the art of patenting.

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