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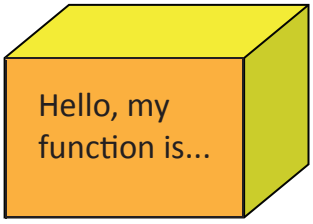
A 'Means' to a Patentable End: Recent Developments in Means-Plus-Function Claiming



Means-plus-function claims, previously on the decline, have recently raised important issues based on U.S. Patent and Trademark Office (USPTO) changes regarding the treatment of these claims. A means-plus-function claim recites elements defined in terms of the functions they serve, rather than the structures or steps they use to accomplish those functions. For example, a means-plus-function element might be "means for amplifying an audio signal" rather than "an audio signal amplifier."

Traditionally, claims describe structures or steps that define the metes and bounds of an invention, and such elements are considered on their own merits. However, 35 U.S.C. §112(f), previously the sixth paragraph of 35 U.S.C. §112 prior to the America Invents Act (AIA), specifies "[a]n 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."

The USPTO has recently revised its approach to considering "means-plus-function" claims. When considering applying 35 U.S.C. §112(f), the USPTO focuses on three main issues: 1) whether a claim limitation invokes 35 U.S.C. §112(f); 2) how the functional limitation is supported in the Specification; and 3) whether the claim is definite and supported under 35 U.S.C. §112(a)-(b).

Recently, the Office adopted a three-part test for deciding whether 35 U.S.C. §112(f) is invoked. To invoke 35 U.S.C. §112(f), the claimed feature may recite "means" or "step," but it may also recite a generic placeholder, such as "device for" or "unit for." As for the other prongs, "means" or "step" or the placeholder must be modified by functional language (second prong) but also must not be modified by structure, material, or acts for achieving the specified function (third prong).

When prosecuting claims, it has often been desirable to argue that a claim feature does not invoke 35 U.S.C. §112(f), because then the claim feature is not limited to "the corresponding structure, material, or acts described in the specification and equivalents thereof." To avoid invoking §112(f), it is important not to recite the terms "means for" or "step for," as these terms are presumed to invoke §112(f). Absent these terms, the presumption is that §112(f) does not apply. However, the Office may still argue that there is a generic placeholder, modified by functional language, without structure, material, or acts for achieving the specified function. To counter these possible arguments, it is important to refer to elements that clarify that the feature is more than purely functional, such as by using adjectives to qualify an element or reciting how an element performs its functions.

When a claim invokes 35 U.S.C. §112(f), it is drafted with the understanding that it refers to the entire Specification for interpretation. The corresponding structure must be disclosed in the Specification itself in a way that one skilled in the art will understand what structure will perform the recited function, as explicitly disclosed or a clear equivalent. As a result, the scope of means-plus-function claims may be considerably narrower than claims that do not invoke 35 U.S.C. §112(f). However, there are reasons why invoking 35 U.S.C. §112(f) may be desirable. For example, as described below, one may be able to secure patent protection for an invention that may have otherwise been deemed directed to patent-ineligible subject matter.

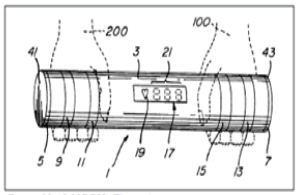
For example, certain Federal Circuit decisions have clarified 35 U.S.C. §112(f) interpretations in the context of computer-implemented means-plus-function claims. The Federal Circuit has recently held that in order for a means-plus-function to be sufficiently definite in the context of software, the function must disclose an algorithm for performing the function, such as a formula or flowchart. Merely reiterating the function or citing a general group of algorithms is insufficient disclosure. These decisions emphasize that in order for software to be protectable using a means-plus-function approach, it is necessary to provide sufficient disclosure of an algorithm by reciting specific, detailed steps in the specification rather than merely referring to generalized, broad steps or units.

As a result, means-plus-function claims are being reconsidered as a way to claim such inventions while withstanding §101 scrutiny. Using "means-plus-function" claims supported by comprehensive disclosures may help

emphasize the technological basis of inventions. While previously, claiming an invention using "means-plus-function" claims may have unduly narrowed the scope of claims, now "means-plus-function" claims may allow protection, albeit less broad, for inventions not otherwise protectable.

— Jonathan D. Schlaifer

U.S. Supreme Court Attempts to Clarify the "Definiteness" Requirement for Patentability



Patent No. 5,337,753, Figure 1

In a recent unanimous decision, the United States Supreme Court in the case of Nautilus, Inc. v. Biosig Instruments, Inc., sought to clarify the "definiteness" requirement of the Patent Act, under which the detailed specification of a patent application must "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, par. 2 (now §112(b)). In particular, the Supreme Court's decision determined the proper reading of this statute's "clarity and precision demand," pertaining to the claiming of an invention or ornamental design. This decision has important implications, because if the definiteness requirement is not met, then a claimed invention or ornamental design is not patentable, and an issued patent may be found invalid.

The U.S. Court of Appeals for the Federal Circuit previously set the standard for meeting the definiteness requirement of Section 112(b). According to the Federal Circuit, a patent claim, which defines the patented invention or ornamental design, passes the definiteness threshold as long as the claim is "amenable to construction," and that the claim, as interpreted, is not "insolubly ambiguous."

However, in the Nautilus case, the Supreme Court reviewed the Federal Circuit's formulation of this legal standard and found that it does not satisfy the statute's definiteness requirement. In place of the Federal Circuit's "insolubly ambiguous" standard, the Supreme Court held that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."

U.S. Patent No. 5,337,753

The Nautilus case involved U.S. Patent No. 5,337,753 ("the '753 Patent"), titled "Heart Rate Monitor," and claims such as a monitor for use during exercise that electronically filters out electromyogram (EMG) signals generated by the user's arms, legs and other body parts, which interfere with the detection of electrocardiograph (ECG) signals, generated by the user's heart, which is what the monitor is intended to measure. This EMG interference had affected the accuracy of prior heart rate monitors.

Claim 1 of the '753 patent, which contained the limitations critical to this dispute, refers to a "heart rate monitor for use by a user in association with exercise apparatus and/or exercise procedures." The claim "comprise[s]," among other elements, an "elongate member" (cylindrical bar) with a display device; "electronic circuitry including a difference amplifier"; and, on each half of the cylindrical bar, a live electrode and a common electrode "mounted . . . in spaced relationship with each other."

The claim sets forth additional elements, including that the cylindrical bar is to be held in such a way that each of the user's hands "contact[s]" both electrodes on each side of the bar. Further, the EMG signals detected by the two electrode pairs are to be "of substantially equal magnitude and phase" so that the difference amplifier will "produce a substantially zero [EMG] signal" upon subtracting the signals from one another. In this way the patented heart rate monitor filters out the interfering EMG signal.

The Supreme Court's Analysis of the Definiteness Standard

The major issue in this case concerned whether the limitation recited in Claim 1 of the '753 Patent that the live electrode and common electrode be "mounted … in spaced relationship to each other" was sufficiently definite to support the patenting of the claim. The Federal District Court, which originally heard the case, interpreted this claim limitation, and found that those words "did not tell [the court] or anyone what precisely the space should be." Therefore, the District Court found the '753 Patent to be invalid for indefiniteness.

The Federal Circuit disagreed, and reversed the District Court's ruling, finding instead that the '753 Patent survived indefiniteness review because it was amenable to construction and was not "insolubly ambiguous." The Federal Circuit determined that because the claim language, specification and prosecution history provided "certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of 'spaced relationship,'" i.e. that it

cannot be greater than the width of a hand, or be infinitesimally small so that the live and common electrodes are effectively merged.

The Supreme Court began its analysis by reaffirming that definiteness must be evaluated from the perspective of someone of ordinary skill in the relevant art at the time that the invention was made, and that the allegedly indefinite claim language must also be read in light of the specification and prosecution history. The parties' dispute then centered on their articulation of just how much imprecision Section 112(b) tolerates before a claim is indefinite.

The Supreme Court determined that Section 112(b) requires a "delicate balance" that considers, on the one hand, the inherent limitations of language to provide precise descriptions, and that a modicum of uncertainty is the "price of ensuring the appropriate incentives for innovation." On the other hand, a patent must be precise enough to afford clear notice of what is claimed, thereby "appris[ing] the public of what is still open to them." In articulating the new standard for definiteness, the Supreme Court emphasized that it "mandates clarity, while recognizing that absolute precision is unattainable."

In criticizing the Federal Circuit's standard, the Supreme Court noted that "to tolerate imprecision just short of rendering a claim 'insolubly ambiguous' would diminish the definiteness requirement's public notice function, and foster the innovation-discouraging 'zone of uncertainty' against which this Court has warned." In light of this analysis, it is open to question whether the Supreme Court has, in fact, injected any clarity, certainty or precision into the standard for determining whether a patent claim is sufficiently definite, or whether this standard will actually remain "insolubly ambiguous." However, it can be anticipated that the Supreme Court's restatement of the legal standard for patent claim definiteness will likely generate additional litigation over the validity of issued patents, and affect the patentability of pending patent applications for years to come.

Tips For Avoiding the Pitfalls of the Nautilus Case

With respect to utility patents, draft the specification so that it describes each component and function of the invention in clear detail so that the connections and interactions of each component and function may be clearly seen and understood. Draft patent claims which use precise language specifically supported by the specification in order to describe the components and functions of each element of the claimed invention, and their connections and interactions with each other. Avoid using broad, generic and undifferentiated descriptions of components or features, such as "processor," "memory," "controller," or "filter" in either the description of the invention in the specification, or in the claims. Avoid using broad, subjective, or undefined functional language to describe the operation of the invention in either the specification or the claims. Strike a conscious balance between the desire to claim the broadest invention possible, with the need to recite a clear, precisely defined, and definite invention. Perhaps consider a range of claims, from the broadest claim possible to an acceptably narrow claim.

With regard to design patents claiming ornamental designs, provide drawing figures using black & white line drawings that define the ornamental appearance of the claimed design using clear, heavily weighted solid and broken lines so that the claimed (solid line) and unclaimed (broken line) features may be clearly seen, understood and distinguished from one another. Provide drawing figures in the form of color or black & white photographs, or grayscale/CAD renderings that are of the highest clarity, sharpness and resolution possible, in order to avoid any design features that are shown to be blurry or pixilated. Provide a sufficient number of drawing figures that will provide a complete disclosure of all of the visible, ornamental design features from front, rear, top, bottom and side views. Provide a cross-sectional or expanded view of any ornamental design features that are not clearly and completely visible from a standard viewing perspective, such as features that are curved, recessed, protruding or partially obscured by other design features, so that their height, depth and contours may be clearly seen. Provide a written description in the design patent specification of the purpose of any use of color, color contrast, sequence of animated images, unclaimed broken lines, or special surface shading or ornamentation so that the viewer will understand the scope of the design claim.

— Rusty Briggs

Patent Cooperation Treaty (PCT) Practice: Pros and Cons of PCT Filings

Patent Cooperation Treaty (PCT) applications can be filed in the United States using one of two routes—as a US national stage filing of a PCT application under 35 U.S.C. § 371, and as a continuation filing under 35 U.S.C. § 120. This article describes the framework governing the PCT, both these types of filings, and describes some benefits and drawbacks of each of the routes.

The PCT is an international agreement administered by the World Intellectual Property Organization (WIPO) and covers about 148 member countries as of August 2014. Under the PCT, an applicant can file a single international application (PCT application), which is treated as an initial patent application in each member country of the PCT. The PCT application may claim priority to an earlier filed national application, but the PCT application has to be filed within 12-months of the filing of the national application. To avoid abandonment of the PCT application in the United States, the U.S. national phase should commence not later than 30 months from the filing date of the PCT application. See 37 C.F.R. § 1.495. Thus, an applicant has 30 months from the filing of the PCT application to decide whether patent protection is desired in the United States.

The PCT process consists of two main phases—the International Phase and the National/Regional Phase. The International Phase begins with the filing of the PCT application. After the PCT application is filed, the International Searching Authority (ISA), which is generally the national/regional patent office, will search the relevant prior art and prepare an International Search Report (ISR) and a Written Opinion of the International Search Authority (WOISA). The WOISA can be challenged by filing a Demand under Chapter II.

The optional Chapter II Phase includes the filing of a Demand, usually with amendments and arguments to address any objections raised in the WOISA, and the subsequent preparation of the International Preliminary Report on Patentability (IPRP) under Chapter II. The Examination under Chapter I is without interaction between the applicant and the Examiner, and the examination under Chapter II may be with interaction between the applicant and the Examiner. The deadline for filing the Demand is the later of 22 months from the priority date, and 3 months from the issuance of the WOISA. Examination under Chapter II can also be used to put the claims in better condition for the National/Regional Phase.

The National/Regional Phase, begins when the PCT application is converted into a national stage application in each country where patent protection is desired. The requirements for entering the National/Regional Phase vary, and after the PCT application enters the National/Regional Phase, further prosecution is handled according to local practice of the nation or region.

In the United States, it is possible to file a "bypass" application, in addition to the national stage application. A United States national stage application is filed under 35 U.S.C. § 371, while a "bypass" application is filed under 35 U.S.C. § 111(a) claiming benefit to the PCT through 35 U.S.C. § 120 as a continuation or continuation–in-part (CIP). See MPEP 1895. As discussed below, both routes have their own benefits and drawbacks.

An applicant can revise a bypass application under §120 prior to filing. This contrasts with a national stage filing under §371, where no revision is possible because the statutes require the application to be filed as a literal translation of the PCT application. See PCT Article 46; MPEP §1893.01(d); and 35 U.S.C. §375(b). The revision of the bypass application, however, has to be limited to what is reasonably disclosed in the PCT application. If additional revision is desired, the revised application can be filed as a continuation-in-part of the PCT application.

A bypass application may obtain an earlier prior art date under 35 U.S.C. §102(e) than a national stage application. The §102(e) prior art date of a national stage application is the date that the requirements of 35 U.S.C. §371(c) are met. If a national stage application is filed without an inventor declaration, applicable fees, or other required documents, the USPTO will issue a Notice of Missing Requirements. The prior art date of the national stage application will only be established after the USPTO issues the Notice of Missing Requirements and after the applicant has completely responded to the Notice. However, the prior art date of the bypass applica-

tion is the date the PCT application is filed. See MPEP §1896. This may not matter in some cases because the PCT application is published after the expiration of 18 months from the priority date. The published PCT application will generally have an earlier prior art date than the §102(e) date of the U.S. patent.

— S. Mahmood Ahmad

POM Wonderful, LLC v. The Coca-Cola Co.: When Minute Maid Does Not Have It Made

In an unfair competition quandary,
lies statutory harmony;
When a question of competitor mislabeling,
gather facts and consider the Lanham Act.

In a recent unanimous decision, the United States Supreme Court held that the Federal Food, Drug, and Cosmetic Act (FDCA) did not preclude a cause of action under the Lanham Act when a competitor sues another competitor for unfair competition arising from false or misleading product descriptions. 134 S. Ct. 2228 (2014)(8-0 decision with Justice Breyer not participating in the consideration or the decision of the case)

Background Facts

POM Wonderful produces, markets, and sells pomegranate products including a pomegranate and blueberry juice blend. One of POM Wonderful's competitors in the pomegranate-blueberry juice market is Coca-Cola's Minute Maid. Coca-Cola created a Minute Maid juice blend that contained 99.4% apple and grape juices, 0.3% pomegranate juice, 0.2% blueberry juice, and 0.1% raspberry juice. However, the Minute Maid label displayed in all capital letters and on two separate lines, "POMEGRANATE BLUEBERRY". Coca-Cola's Minute Maid label also illustrated blueberries, grapes, and raspberries in front of a halved pomegranate and a halved apple.

POM Wonderful sued Coca-Cola under §43 of the Lanham Act alleging that Coca-Cola's label "tricks and deceives consumers" resulting in competitive injuries to POM Wonderful. POM alleged that, "the name, label, marketing, and advertising of Coca-Cola's juice blend mislead consumers into believing that the product consists predominantly of pomegranate and blueberry juice" when Coca-Cola's juice blend consists primarily of less expensive apple and grape juices. POM Wonderful argued that this led to its loss of sales. Coca-Cola responded that POM Wonderful's Lanham Act claim was preempted by the FDCA because the FDCA governs product labeling and Coca-Cola was in compliance with any such labelings.

Supreme Court Holding

The Court reviewed whether a private party may bring a cause of action under the Lanham Act challenging a food label that is regulated by the Federal Food, Drug, and Cosmetic Act (FDCA). The Court answered "yes" while concluding that the statutes complement each other in the Federal regulation of misleading food and beverage labels. Competitors such as POM Wonderful, may therefore bring Lanham Act claims that challenge food and beverage labels regulated by the FDCA. The Court reviewed the traditional rules of statutory interpretation and history of the statutes and found that the Lanham Act and the FDCA are in harmony with each other.

Significantly, the Court found that while both the Lanham Act and the FDCA complement each other in the sense that they concern food and beverage labeling, the Lanham Act protects commercial interests against unfair competition while the FDCA protects public health and safety. The Food and Drug Administration (FDA), which governs the FDCA, does not have the same perspective about market dynamics that competitors' possess. Competitors in a given market have knowledge about consumer reliance on certain sales and marketing strategies. Lanham Act suits rely upon this expertise by empowering competitors to protect their interests and prevent the public from being deceived.

Implications and Recommendations

While the POM Wonderful decision permits challenges under the Lanham Act even when there may be 'compliance' with the FDCA/FDA, one should carefully review one's current and any future-planned product labeling to prevent a potential Lanham Act cause of action, even when the labeling complies with FDCA/FDA requirements. In addition, while the POM Wonderful decision applies to the issue of juice mislabeling, the decision could have far reaching impacts upon all market sectors other than just the market for juices.

The perspective of the consumer should always be considered. If a consumer may reasonably be deceived by a label, and this deception could potentially result in a competitor's loss of sales, it may be worth reconsidering how the product's label reads to avoid a potential Lanham Act cause of action. Perhaps, in ambiguous circumstances, it might be prudent to conduct surveys of a prospective product's label before the product actually

goes to market to get a sense of the consumer's perception of the label. Although such surveys may be costly, where the product is projected to generate high sales, such surveys could be extremely valuable in the long run.

In addition, where there are statutes that complement each other and no provision of one statute precludes a cause of action with respect to the other statute, one must comply with both statutes, and preferably, with the most rigorous standards. When in doubt, it could be prudent to comply with the most rigorous standards for product labeling for each 'purpose' of labeling, for example, health and safety versus consumer confusion and unfair competition. At least in this regard, one will have demonstrated that there was no deliberate "misleading" with respect to the product labeling. Investing in efforts to foresee potential issues, and taking steps to prevent such issues, will pay off in the long run.

— Jeanne Di Grazio

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NSIP Law is a full service IP firm that specializes in the procurement of enforceable IP rights to protect innovations and investments pertaining to patents, trademarks, and copyrights.

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