

Interpretation of a Means-Plus-Function Claim Involves Two Distinct Steps That Must Not Be Conflated: Determining Whether the Limitation Is Drafted in Means-Plus-Function Format, and Then Identifying the Corresponding Structure

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MTD Prods. Inc. v. Iancu, 933 F.3d 1336 (Fed. Cir. Aug. 12, 2019)

The Patent Trial and Appeal Board (PTAB) invalidated a patent as obvious, concluding that the term “mechanical control assembly” was not a means-plus-function term. The Federal Circuit reversed, saying that the PTAB conducted its analysis incorrectly under 35 U.S.C. § 112 ¶ 6, and remanded to reconsider the obviousness question.

Interpretation of an asserted means-plus-function limitation involves two inquiries: (1) is the claim limitation drafted in means-plus-function format—i.e., does the limitation connote sufficiently definite structure to a person of ordinary skill in the art; and (2) if so, what is the corresponding structure identified in the specification.

The patentee introduced expert testimony that the term at issue was a generic one that could be used to describe any number of parts on a vehicle, and so does not connote sufficiently definite structure. The petitioner did not contradict this testimony, but instead argued that statements made in the specification and prosecution history gave the term a specific structure. The PTAB held that the term was not a means-plus-function term based on the structure defined in the specification and prosecution history, despite agreeing that the claim itself favored a means-plus-function interpretation.

The Federal Circuit rejected this analysis for conflating the two distinct inquiries, and for suggesting that disclosure of a corresponding structure in the specification or prosecution history demonstrates that a term is sufficiently definite so as to not invoke § 112 ¶ 6. If this were the standard, § 112 ¶ 6 would have no application, because the statute itself requires that means-plus-function terms have a corresponding structure in the specification. Rather, the specification does play a role in assessing claim language, but only to the extent that it renders the term at issue sufficiently structural to a person of ordinary skill in the art.

[A copy of the opinion can be found here.](#)

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