

# Recalibrating functional claiming: A way forward

By George W. Jordan III, *2020 Perspective* — February 05, 2020

**Functional claiming—often viewed as describing subject matter in terms of what it does (its function) rather than what it is (its “structure”)—has been frowned upon, feared, and misconceived by the patent bar for a very long time. Now is an opportune time to question the status quo of overbroad claiming, claim-defeating surprises, and linguistic impediments to legitimate lexicography. To identify the best way forward, two questions are key: What are the misconceptions, and what should be done to recalibrate functional claiming standards accordingly?**

## Misconceptions

All functional claiming is not the same. Unlike functional claiming that only recites a function, means-plus-function claiming generically recites a “means” for performing a “specified function.” As a “price” for this “convenience,” 35 U.S.C. § 112(f) restricts the literal scope of a means-plus-function term to the corresponding structure disclosed in the specification and equivalents thereof.<sup>1</sup> If the specification fails to disclose that corresponding structure, the purely functional claim is invalid for indefiniteness under § 112(b).<sup>2</sup> Result claiming is a different form of generic claiming that recites a function coextensive with the result accomplished, making compliance with patent eligibility and written description requirements especially important.<sup>3</sup>

Another key misconception is that structural claiming is always preferable to functional claiming. Depending on the technology and the specific invention, functional claiming may be preferable and even unavoidable. At times an invention (e.g., one software based) may be inherently functional or at least functional at the point of novelty. In the context of software, the law currently treats an “algorithm” as “structure,” but the “algorithm” definitions relied upon by the US Supreme Court and US Patent and Trademark Office leave no doubt that an algorithm is inherently functional too.<sup>4</sup> Because functional claim language can describe what a functionally based invention is, we should jettison use of the misleading words that a claim term is “functional” when it recites a feature “by what it does rather than by what it is.”

It is also a misconception to consider functional claiming inherently unclear. Although the famous eighth claim in *O’Reilly v. Morse* broadly covering telegraphic communication was rendered void for overbreadth, the US Supreme Court acknowledged the claim term was understandable: “It is impossible to misunderstand the extent of this claim.”<sup>5</sup> Similarly, in *In re Swinehart*, the US Court of Customs and Patent Appeals held the term “transparent to infrared rays” was “sufficiently clear” in light of the specification.<sup>6</sup>

## Recalibration

*Halliburton* and § 112(f) are essential context for charting a way forward free of misconceptions. In *Halliburton Oil Well Cementing Co. v. Walker*, Walker asserted an acoustical resonator claim reciting means-plus-function language.<sup>7</sup> Claims that recited the acoustical resonator structurally were not asserted against Halliburton. In explaining that Walker had claimed the “most crucial element” in terms of “what it will do” rather than its “physical characteristics” or “arrangement,” the Supreme Court held that the functional claim lacked definiteness.<sup>8</sup> The Court had previously condemned the use of “conveniently functional language at the exact point of novelty,” but means-plus-function language was not at issue.<sup>9</sup> Here the Supreme Court imprecisely blamed the “broadness, ambiguity, and overhanging threat” of functional claim language.<sup>10</sup> Having upheld means-plus-function claims before, the Court distinguished its holding in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*,<sup>11</sup> noting the claims in that case “structurally described the physical and operating relationship of all the crucial parts.”<sup>12</sup>

George W. Jordan, III is a senior counsel in the Intellectual property practice group at Norton Rose Fulbright US LLP.

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In response to the Supreme Court's prohibition on means-plus-function claiming at the point of novelty, Congress enacted § 112(3)—later § 112(6) and now § 112(f)—to statutorily overrule the *Halliburton* holding.<sup>13</sup> Unfortunately, § 112(f), which authorized means-plus-function claiming irrespective of the point of novelty, led to new problems. Instead of a simple application of § 112(f), before long we gained a rebuttable presumption in favor of applicability when “means” (or another generic placeholder term) is recited and a rebuttable presumption against applicability when absent.<sup>14</sup> As a result of this presumption-driven uncertainty, § 112(f) has persisted as a trap for the unwary even after the elimination in *Williamson v. Citrix Online, LLC* of a “strong” presumption of not invoking § 112(f) when “means for” is not explicitly recited.<sup>15</sup>

As a fix, § 112(f) could be amended to strictly apply whenever a claim term recites a function together with a “magic word”—whether “means” or not—without reciting structure for performing the function. Presumption-driven uncertainty would disappear; § 112(f) would largely cease to catch patent drafters and others off guard, as it would no longer apply to nonce or other borderline terms, making them fair game for indefiniteness challenges; and accidental claim death by indefiniteness for lack of corresponding structure in the specification would become a thing of the past. Especially given the limits of structural claiming, means-plus-function claiming should be a

chosen endeavor. When patent drafters choose to not invoke § 112(f), § 112(a) and (b) requirements are reason enough to accept that choice.

Result claiming is a different story. Unlike mean-plus-function claiming, result claiming can be so open-ended that there is no corresponding structure as a potential tether. Accordingly, the law should clarify that § 112(f) does not apply to result claiming. Without the remedial protection of § 112(f), result claiming can be held more accountable to § 112 as a whole. This clarification can be accomplished, for example, by interpreting or defining “specified function” in § 112(f) to exclude any function that is coextensive with a recited result.

In keeping with our mission of advancing the development of intellectual property laws and their fair and just administration, the ABA Section of Intellectual Property Law has a 125-year history of forward thinking in areas where most fear to tread. Functional claiming should be no different. We welcome those of you who would like to participate in a Section roundtable discussion on this important subject. I would love to hear from you directly.

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George W. Jordan, III is a senior counsel at **Norton Rose Fulbright** in Houston. He can be reached at [george.jordan@nortonrosefulbright.com](mailto:george.jordan@nortonrosefulbright.com).

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### Endnotes

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1. *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997).

2. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1336 (Fed. Cir. 2012); *Aristocrat Techs. Austral. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1330–31 (Fed. Cir. 2008).

3. See, e.g., *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017) (applying the patent eligibility requirement to result-based functional language in a method claim for routing information); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016) (observing that “essentially result-focused” and functional language “has been a frequent feature of claims held ineligible under § 101”); *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993) (applying the written description requirement to a DNA claim including result-based functional language).

4. *Gottschalk v. Benson*, 409 US 63, 65 (1972) (“A procedure for solving a given type of mathematical problem is known as an ‘algorithm.’”); US PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2181 (9th ed. Rev. 08.2017, Jan. 2018) (“An algorithm is defined, for example, as ‘a finite sequence of steps for solving a logical or mathematical problem or performing a task.’ Microsoft Computer Dictionary, Microsoft Press, 5th edition, 2002.”); Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112, 84 Fed. Reg. 57, 59 (Jan. 7, 2019) (same).

5. 56 US 62, 112 (1853).

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6. 439 F.2d 210, 214 (C.C.P.A. 1971).

7. 329 US 1 (1946).

8. *Id.* at 9, 12.

9. *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 US 364, 371–72 (1938).

10. *Halliburton*, 329 US at 12.

11. 210 US 405 (1908).

12. *Halliburton*, 329 US at 13.

13. *In re Donaldson Co.*, 16 F.3d 1189, 1194 (Fed. Cir. 1994).

14. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015); *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 703–04 (Fed. Cir. 1998).

15. *Williamson*, 792 F.3d at 1349.

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