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***En Banc* Federal Circuit Abandons “Strong” Presumption That a Limitation Is Not Subject to 35 U.S.C. § 112, Paragraph 6**

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On June 16, 2015, the Federal Circuit revisited its prior precedent regarding when a claim limitation is subject to 35 U.S.C. § 112, paragraph 6. In *Williamson v. Citrix Online, LLC*, No. 13-1130 (“*Citrix*”),¹ the *en banc* court held that the absence of the word “means” gives rise only to a rebuttable presumption—not a “strong” presumption—that Section 112, paragraph 6 does not apply to the limitation.

BACKGROUND OF SECTION 112, PARAGRAPH 6

Section 112, paragraph 6² allows a patentee to recite a claim limitation as a “means or step for performing a specified function,” but “without the recital of structure, material, or acts in support thereof.” Claim limitations drafted in this format, known as “means-plus-function” limitations, are “construed to cover the corresponding structure, materials, or acts described in the specification and equivalents thereof.”³ If the specification fails to disclose sufficient structure for performing the corresponding function of a means-plus-function limitation, the claim is invalid as indefinite under 35 U.S.C. § 112, paragraph 2.⁴

Under prior Federal Circuit precedent, the absence of the term “means” gave rise to a “strong” presumption that Section 112, paragraph 6 does not apply.⁵ Overcoming this presumption required a “showing that the limitation essentially [was] devoid of anything that [could] be construed as structure.”⁶

THE ORIGINAL PANEL DECISION

Citrix involved U.S. Patent No. 6,155,840, which concerns a method and system for conducting distributed learning over a computer network. Asserted claim 8 of the '840 patent recites the following “distributed learning control module” limitation:

a distributed learning control module for receiving communications transmitted between the presenter and the audience member computer systems and for relaying the communications to an intended receiving computer system and for coordinating the operation of the streaming data module.

¹ *Williamson v. Citrix Online, LLC*, No. 13-1130, Slip Op. at 16 (Fed. Cir. June 16, 2015).

² With the passage of the America Invents Act, paragraph 6 has been relabeled paragraph (f).

³ Section 112, para. 6.

⁴ See *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1338 (Fed. Cir. 2008).

⁵ See, e.g., *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004); *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1358 (Fed. Cir. 2011); *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1297 (Fed. Cir. 2014).

⁶ *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir. 2012).

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In a November 5, 2014 decision, a three-judge Federal Circuit panel held that this limitation was not subject to Section 112, paragraph 6.⁷ Relying on its prior precedent and reversing the district court, the panel reasoned that appellees had failed to rebut the “strong” presumption that the “module” limitation was not a means-plus-function limitation, due to its absence of the word “means.”⁸

THE *EN BANC* CITRIX DECISION

On June 16, 2015, the Federal Circuit withdrew its prior opinion and issued a new decision in the case. In the *en banc* portion of its new opinion, the appellate court “abandon[ed] [its precedent] characterizing as ‘strong’ the presumption that a limitation lacking the word ‘means’ is not subject to § 112, para. 6.”⁹ The court explained that the strong presumption is “unwarranted, is uncertain in meaning and application,” and “has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute.”¹⁰

The *en banc* court “expressly overruled” both its prior characterization of the presumption as “strong” and “the strict requirement of ‘a showing that the limitation essentially is devoid of anything that can be construed as structure.’”¹¹

Returning to much older precedent, the Federal Circuit held that the “standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.”¹² The court explained that, if the word “means” is absent from the claim limitation, “the presumption can be overcome and § 112, para. 6 will apply if the challenger demonstrates that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’”¹³ The court did not disturb the converse presumption that inclusion of the word “means” creates a presumption that Section 112, paragraph 6 applies.¹⁴

Applying this new standard, the panel held that the “distributed learning control module” limitation failed to recite sufficiently definite structure, such that the presumption against means-plus-function language claiming was rebutted.¹⁵ In arriving at this conclusion, the panel described “module” as a “well-known nonce word that can operate as a substitute for ‘means’ in the context of § 112, para. 6.”¹⁶ The panel further found nothing in the specification or prosecution history suggesting that “distributed learning control module” identified a sufficiently definite structure, and it also determined that the patentee’s expert testimony was unpersuasive.¹⁷

⁷ See *Williamson v. Citrix Online, LLC*, 770 F.3d 1371 (Fed. Cir. 2014).

⁸ *Id.* at 1380.

⁹ *Citrix*, No. 13-1130, Slip Op. at 15.

¹⁰ *Id.*

¹¹ *Id.* at 15-16 (quoting *Flo Healthcare Solutions*, 697 F.3d at 1374).

¹² *Id.* at 16 (citing *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996)).

¹³ *Id.* (quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000)).

¹⁴ See *id.*

¹⁵ See *id.* at 20.

¹⁶ *Id.* at 17.

¹⁷ *Id.* at 18-19.

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Because the “module” limitation was subject to Section 112, paragraph 6, but the specification failed to disclose structure corresponding to the recited function, the panel held that claim 8 was invalid as indefinite¹⁸ and affirmed the district court’s related grant of summary judgment. Concluding that the district court had incorrectly construed the “graphical display” limitations of other claims, however, the panel vacated the district court’s judgment of non-infringement of other claims and remanded the case for further proceedings.

CONCURRENCE AND DISSENT

Judge Reyna concurred-in-part and dissented-in-part. He agreed that the “distributed learning control module” limitation was a means-plus-function limitation and indefinite, but disagreed that the majority had correctly construed the “graphical display” limitations of the other claims.¹⁹ Judge Reyna also suggested that the court “revisit [its] judicially-created § 112, para. 6 presumptions.”²⁰

Judge Newman dissented, viewing the signal “means for” as “clear” and “clearly understood.”²¹ In her view, “it is the applicant’s choice during prosecution whether or not to invoke paragraph 6, and the court’s job is to hold the patentee to his or her choice.”²² Judge Newman predicted that the majority’s decision would result in “additional uncertainty of the patent grant, confusion in its interpretation, invitation to litigation, and disincentive to patent-based innovation.”²³ She also remarked that, under the majority’s opinion, “no one will know whether a patentee intended means-plus-function claiming until this court tells us.”²⁴

PRACTICAL IMPLICATIONS

By abandoning the “heightened burden” arising under the former “strong presumption” standard, the Federal Circuit has made it easier for defendants to demonstrate that limitations with “nonce” words like “module” should be construed under Section 112, paragraph 6. And because means-plus-functions are construed to cover the corresponding structure disclosed in the specification for performing the recited function and equivalents, the court’s opinion makes it easier for defendants to argue non-infringement or invalidity. Specifically, if a limitation is deemed a means-plus-function limitation, the defendant can argue that its accused product differs from the corresponding structure disclosed in the specification. Alternatively, if insufficient structure is disclosed, the defendant can argue that the claim is indefinite.

For patent applicants, by contrast, *Citrix* will require careful thinking in the coming months as to how to best craft claims, draft specifications, and prosecute applications to avoid unintended means-plus-function treatment. For example, applicants will need to consider whether a limitation may be characterized as “nonce” terms subject to Section 112, paragraph 6.

¹⁸ *Id.* at 25.

¹⁹ See *Citrix*, concurrence at 2, 5.

²⁰ *Id.* at 8.

²¹ *Citrix*, dissent at 4.

²² *Id.*

²³ *Id.* at 2.

²⁴ *Id.*

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