Federal Circuit Issues *En Banc* Opinion in *Williamson v. Citrix* Holding That Term "Module" Invokes Means-Plus-Function Treatment under 35 USC 112, Sixth Paragraph

Last year the Federal Circuit issued a decision in *Williamson v. Citrix*, 770 F.3d 1371 (Fed. Cir. 2014) holding that the term "module" does not invoke means-plus-function treatment under 35 USC 112, sixth paragraph, in the pre-AIA statutes, which corresponds to 35 USC 112(f) in the post-AIA statutes.

In light of that decision, NSIP revised its best practices for revisions to include a suggestion that "module" be considered as a replacement for the term "unit" in expressions for which it is difficult to otherwise eliminate "unit" in an attempt to avoid invoking means-plus-function treatment under 35 USC 112, sixth paragraph. For example, terms such as "decoding unit," "control unit," and "processing unit" can be typically changed to "decoder," "controller," and "processor." However, a term such as "output unit" would not typically be changed to "outputter" because that would be an awkward term in English. Instead, a term such as "output module" would be considered based on the holding in *Williamson*.

However, on June 16, 2015, the Federal Circuit issued an *en banc* opinion in the *Williamson v. Citrix* case (*Williamson v. Citrix* (Fed. Cir. 2015)) that replaces the previous decision issued last year as discussed above and holds that the term "module" <u>does</u> in fact invoke means-plus-function treatment under 35 USC 112, sixth paragraph.

In light of this new decision, NSIP no longer recommends considering

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"module" as a replacement for the term "unit."

We further bring to your attention that the Federal Circuit has abandoned the position they adopted in 2004 in *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004), in which they held that the absence of the word "means" in a claim limitation creates a "strong" presumption that the claim limitation does not invoke treatment under 35 USC 112, sixth paragraph, and the position they adopted in 2012 In *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir. 2012), in which they held that "[w]hen the claim drafter has not signaled his intent to invoke § 112, ¶ 6 by using the term 'means,' we are unwilling to apply that provision *without a showing that the limitation essentially is devoid of anything that can be construed as structure*."

The New Standard for Means-Plus-Function Treatment

In the new *Williamson* decision, the Federal Circuit states that the following standard from the 1990's now applies:

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. *Greenberg*, 91 F.3d at 1583. When a claim term lacks the word "means," 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." *Watts,* 232 F.3d at 880. The converse presumption remains unaffected: "use of the word 'means' creates a presumption that § 112, ¶ 6 applies." *Personalized Media*, 161 F.3d at 703.

Unfortunately, this increases the likelihood that the USPTO or a court will treat any element coupled with a functional description as invoking means-plus-function treatment under 35 USC 112, sixth paragraph, or 112(f), and look to the specification for corresponding structure. If that structure is a computer or processor, the USPTO or court will then look for an algorithm with which the computer or processor may be programmed to perform the function.

Please note that in *Williamson*, the Federal Circuit distinguished between a function and an algorithm for implementing the function, i.e., that is, how the function is performed, stating as follows:

The district court was correct that the specification of the '840 patent fails to disclose corresponding structure. The written description of the '840 patent makes clear that the distributed learning control module cannot be implemented in a general purpose computer, but instead must be implemented in a special purpose computer—a general purpose computer programmed to perform particular functions pursuant to instructions from program software. A special purpose computer is required because the distributed learning control module has specialized functions as outlined in the written description. *See, e.g.,* '840 patent col.5 ll.48–64. In cases such as this, involving a claim limitation that is subject to § 112, para. 6 that must be implemented in a special purpose computer, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor. *E.g., Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (citing *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999)). We require that the specification disclose an algorithm for performing the claimed function. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008). The algorithm may be expressed as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure. *Noah*, 675 F.3d at 1312 (citing *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008)).

Williamson points to certain disclosures in the specification that, it claims, meet the § 112, paragraph 6 requirements. Williamson argued that the "distributed learning control module" controls communications among the various computer systems and that the "coordinating" function provides a presenter with streaming media

selection functionality. These disclosures, however, are merely functions of the "distributed learning control module." The specification does not set forth an algorithm for performing the claimed functions.

Possible Implications of the *Williamson* Decision

Some of the descriptions in the applications we receive to revise or file often relates to the *functions* performed by various elements, rather than to an algorithm for implementing the functions on a computer or processor, that is, to how the functions are performed. The law on the line between function and implementation is not very clear, and is still developing, and at this point there is not a lot of clear guidance on what constitutes a sufficiently detailed algorithm for the purposes of complying with 35 USC 112, sixth paragraph, or 112(f).

In light of this, for the time being, NSIP recommends that Applicants include detailed examples of how the functions of various elements may be implemented on a computer or processor when priority applications, such as Korean applications, are prepared for which U.S. applications is planned. The term "module" should no longer be considered as a replacement for the term "unit."