

Keywords: mean-plus-function, written description

General: 35 U.S.C. § 112, ¶6 is not invoked, in the absence of reciting the term “means”, if those skilled in the art understand the structural significance of the claim language. Also, in means-plus-function claims, even if a disputed term is not limited to a single structure, the disputed term is not disqualified as a corresponding structure as long as a class of structures is identifiable by a skilled artisan.

EnOcean GmbH v. Face Int’l Corp.
109 USPQ2d 1502 (2014)
Decided January 31, 2014

I. Facts

EnOcean GmbH (“EnOcean”) owns U.S. Patent Application No. 10/304,121 (“EnOcean application”) that includes claims directed to a self-powered switch (i.e., not connected to a battery or an electrical outlet). Some of the claims of the EnOcean application recite a “receiver for receiving” or a “receiver adapted to receiving” particular signals such as electromagnetic or radiofrequency signals. The EnOcean application claims priority to a German application (filed May 24, 2000) and a PCT application (filed May 21, 2001).

Face Int’l Corp. (“Face”) owns U.S. Patent No. 7,084,529 (“529 patent”) that includes claims also directed at a self-powered switch. In response to a suggestion from EnOcean, the Board granted an interference proceeding between EnOcean and Face with regards to the EnOcean application and the ‘529 patent. The Board found the claims at issue in the ‘529 patent were unpatentable under 35 U.S.C. § 103 in view of the Burrows reference (PCT application having priority date of March 5, 2001) in combination with other references. Under 37 C.F.R. § 41.207(c), the claims at issue in the EnOcean application were also found unpatentable for the same reasons. In rebuttal, EnOcean argued the claims of the EnOcean application benefited from the filing dates of the German and PCT application. The filing date of the German application, which the EnOcean application claims priority to, predates the priority date of the Burrows reference. However, the Board found the German application lacked sufficient written description. The Board required that any priority documents must “expressly describe the structure of the receiver.” The Board found the German application only made a single passing reference to a receiver. As a result, the “means for receiving” and “signal reception means for” claims of the EnOcean application were not entitled to the benefit of the earlier filing date and the claims remained unpatentable. In addition, the Board found that claims lacking the “means for” language (e.g., claims 37, 38, 43, 45; “receiver adapted to” and “receiver for” claims) were also mean-plus-function claims because the term “receiver” was solely defined in terms of functional language. Thus, the term “receiver” was interpreted as a “signal receiving means.” EnOcean appealed to the Federal Circuit.

II. Issue

1. Did the Board err in finding the receiver claims invoked 35 U.S.C. § 112, ¶6?
2. Did the Board err in finding that both the means-plus-function claims and the receiver claims were not entitled to claim priority to the German and PCT applications?

III. Discussion

1. Yes. The Federal Circuit applied de novo review to the Board’s claim construction of the receiver claims (the claims reciting a “receiver for receiving” and a “receiver adapted to receive” to determine whether means-plus-function claiming was invoked. Face tried to argue that the Board’s construction was entitled to deference if the interpretation was reasonable in light of the

evidence before the Board. The Federal Circuit noted that even if this more deferential standard were utilized, the outcome would not have changed. First, the Federal Circuit noted claims lacking “means for” language presumably do not invoke 35 U.S.C. § 112, ¶6. Second, the Federal Circuit noted that the inquiry as to whether the claim language invokes 35 U.S.C. § 112, ¶6 “depends on how those skilled in the art would understand the structural significance of that claim language.” EnOcean claimed that the term “receiver” was well understood in the art as a name for a structure that performs the recited function. Face countered that the term “receiver” was only defined in terms of the function it performed, not the structure. The Federal Circuit agreed with EnOcean and agreed that the record indicated that one of skill in art would find that the term “receiver” conveys structure. EnOcean provided evidence of scientific literature and expert declarations that showed that the term “receiver” was well understood in the art. In addition, the Board itself during the interference proceeding made the factual finding that a “skilled worker would have been familiar with the design and principles of the types of components utilized in the claimed invention, *including . . . receivers.*” The Federal Circuit stated that the claim term, when used in common parlance or by ordinary skilled artisans, only needs to designate *sufficiently definite* structure (even if the term covers a broad class of structures). The Federal Circuit further stated that the fact that a term is not limited to a single structure does not disqualify the term as a corresponding structure “as long as the class of structures is identifiable by a person of ordinary skill in the art.”

2. Yes. The Federal Circuit noted that even though the term “receiver” in the receiver claims indicates enough structure to avoid means-plus-function claiming, it does not necessarily indicate that the single reference to a receiver in the German application provides enough structure to support EnOcean’s means-plus-function claims (e.g., “means for receiving” and a “signal reception means for receiving”) to obtain the benefit of claiming priority. However, the Federal Circuit stated that sufficient structure need only “permit one of ordinary skill in the art to know and understand what structure corresponds to the means limitation” so that the bounds of the invention are perceived. For the reasons noted above, the Federal Circuit found that a person of ordinary skill in the art would understand the bounds of the invention merely by reading the term “receiver.” The Federal Circuit also found that the Board’s standard of requiring the priority document to expressly describe the structure of the receiver to be incorrect. If such a standard were used, according to the Federal Circuit, applications would not be concise or focus on what is new. As a result, the Federal Circuit found that both the means-plus-function claims and the receiver claims were entitled to priority dates of the German and PCT applications.

IV. Conclusion

The Federal Circuit vacated the Board’s opinion with regards to the receiver and means-plus-function claims as well as the dismissal of EnOcean’s remaining motions. The Federal Circuit also remanded the case back to the Board to consider EnOcean’s motions in light of the opinion.