

Memorandum

To: Patent Practice Group
From: David Gulbransen
Title: Means-Plus-Function Analysis

35 U.S.C. § 112 provides that, “[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure” 35 U.S.C § 112 ¶ 6.

Typically, the statute is invoked by using the words “means for,” followed by a recitation of the function performed. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 530-31. This creates a rebuttable presumption that the drafter intended to invoke 35 U.S.C § 112 ¶ 6. The presumption is effectively rebutted if the claim uses the word “means,” but fails to specify a corresponding function, or if the claim elaborates a sufficient structure, material, or act within the claim itself to perform entirely the recited function. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584; *Sage Products, Inc. v. Devon Industries*, 126 F.3d 1420, 1428. Also, failing to use the means language does not preclude the element from being construed as a means-plus-function element, and the courts may look to prosecution history in the course of analysis. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531.

With respect to U.S. Patent No. 5,720,200 (issued Feb. 24, 1998), Claim 18 employs the “means for” language five times:

“ . . . means for sensing the acceleration of the foot”

“ . . . means for sensing the deceleration of the foot”

“ . . . means for receiving the foot push off signal and the food strike signal and calculating a performance parameter”

“ . . . means for communicating at least one performance parameter to the person”

“ . . . means for synthesizing human speech and translating the at least first performance parameter into human speech.”

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In each instance, the “means” language is followed by a corresponding function, and in no instance does the claim elaborate any structure, material, or act sufficient to perform the recited function.

Claim construction of a means-plus-function claim element is a two step process: first, identification of the claimed function; second, to look to the specification and identify the corresponding structure. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (*internal citations omitted*). The requirement that a particular structure is clearly linked to the claimed function is necessary to satisfy the statutory requirement that an invention must be particularly pointed out and distinctly claimed. *Id.* at 1211.

Under 35 U.S.C § 112 ¶ 6, the courts look to the specification to interpret the claim language in light of the corresponding structure, material, or acts described and their equivalents. *In re Donaldson*, 16 F.3d 1189, 1193; *See also S3 Inc. v. nVidia Corp.*, 259 F.3d 1364, 1368. Failure to adequately set forth in the specification an adequate disclosure showing what is meant by the claim language is a failure to point out and distinctly claim the invention as required by the statute. *In re Donaldson*, 16 F.3d 1189, 1195.

The '200 patent, in the “Brief Summary and Objects of the Invention” and “Detailed Description of the Preferred Embodiments” sections, outlines a system of membrane switches, positioned at the heel and ball of the foot, that are in turn connected to a calculation and display unit. These descriptions, in combination with the illustrations,

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appear to constitute corresponding structure linked to Claim 18 under the statutory requirements of § 112 ¶ 6.

However, a “means” clause will not cover any means for performing a specified function. Determination of a claim limitation requires that the court compare the disclosed structure with the accused structure, and the court must find equivalent structure as well as identity of the claimed function for that structure. *Laitram Corp. v. Rexnord, Inc.* 939 F.2d 1533, 1536. To prove literal infringement, the patentee must prove that the means in the accused device is the structural equivalent of that described in the specification. *Id.* at 1537.