

ENOCEAN GMBH v. FACE INT'L CORP., Appeal No. 2012-1645 (Fed. Cir. January 31, 2014). Before Rader, Lourie, and Prost. Appealed from Board of Patent Appeals and Interferences.

Background:

During an interference proceeding between EnOcean and Face, the Board of Patent Appeals and Interferences found that EnOcean's claims were unpatentable under 35 U.S.C. §103(a). EnOcean argued that its claims were patentable because it could eliminate the primary reference as prior art by the benefit of its priority application.

The Board found that EnOcean's claims were means-plus-function claims despite lacking "means for" language because the term "receiver" was defined in the claims using only functional language. The Board also found that the priority application's disclosure of a "receiver" did not adequately support the "means for receiving" limitation in the application at issue because the priority application did not describe the structure of the receiver.

Because it found that the claims were not supported by the disclosure of the priority application, the Board held that all of EnOcean's claims were unpatentable over the applied references.

Issues/Holdings:

- (1) Did the Board err in treating EnOcean's claims as means-plus-function claims? Yes.
- (2) Did the Board err in finding that some of EnOcean's claims lacked support in the priority applications? Yes.

Vacated-in-part and remanded.

Discussion:

If a claim does not recite the term "means," then the claim will be interpreted as a means-plus-function claim *only if* the claim fails to recite "sufficiently definite structure." A claim recites "sufficiently definite structure" if the intended class of structures is identifiable, even if the term is not limited to a single structure. The ultimate determination rests on how one of ordinary skill in the art would interpret the claim language.

Here, the Federal Circuit held that EnOcean's "receiver" claims were not means-plus-function claims. The court held that the term "receiver" would be understood by persons of ordinary skill in the art as identifying a structure that performs the recited function. In coming to this conclusion, the court considered scientific literature and expert declarations submitted by EnOcean.

In order for the application to receive the benefit of its priority application, the priority application must disclose "sufficient structure" so that one of ordinary skill in the art would understand the metes and bounds of the invention. Where a structure is well known in the art, an application may concisely refer to the structure without providing a detailed description. Here, the court concluded that a "receiver" is well known in the art, and the mere reference to the term "receiver" was a sufficient disclosure to provide the benefit of priority.

The court held that both the "receiver" claims and the "true" means-plus-function claims were entitled to the benefit of the priority application. Because the claims received the benefit of the priority application, the primary reference was eliminated as prior art.