

WILLIAMSON v. CITRIX ONLINE, LLC, Appeal No. 2013-1130 (Fed. Cir. June 16, 2015).
En banc, opinion by Linn. Appealed from C.D. Cal. (Judge Matz).

Background:

Williamson sued Defendants, alleging infringement of the claims of his patent directed to various systems and methods of online collaboration. In its claim construction order, the district court concluded that the claim limitation “distributed learning control module” invokes the means-plus-function provisions of 35 U.S.C. §112, ¶6. The district court then opined that the specification lacks the necessary algorithms for performing all of the claimed functions of this limitation, and it thus held the claims including this limitation to be invalid under 35 U.S.C. §112, ¶2.

Issue/Holding:

Did the district court err by concluding that the “distributed learning control module” limitation invokes 35 U.S.C. §112, ¶6, and thus holding the claims of Williamson’s patent that include this limitation to be invalid? No, affirmed.

Discussion:

The Federal Circuit began by summarizing its prior decisions addressing means-plus-function claiming. In *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696 (Fed. Cir. 1998), the court held that the use of the word “means” in a claim element creates a rebuttable presumption that §112, ¶6, applies, and it also held that the absence of this term creates a rebuttable presumption that §112, ¶6, does not apply. *Id.* at 703-04. Yet the Federal Circuit then cautioned that it has not blindly elevated form over substance, for in applying §112, ¶6, its cases such as *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580 (Fed. Cir. 1996), emphasized that the essential inquiry is whether the words of the claims are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure. *Id.* at 1583. To that end, the court traditionally held that the presumption against a §112, ¶6, construction in the absence of the term “means” can be overcome if the claim term lacks “sufficiently definite structure” or recites “function without reciting sufficient structure for performing that function.” *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed. Cir. 2000).

The Federal Circuit then expanded this presumption against §112, ¶6, in the absence of the term “means,” first holding that “the presumption flowing from the absence of the term ‘means’ is a strong one that is not readily overcome.” *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004); *see also Inventio AG v. ThyssenKrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1358 (Fed. Cir. 2011). It then further held that “without a showing that the limitation essentially is devoid of anything that can be construed as structure,” it was unwilling to construe a term as invoking §112, ¶6. *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1374 (Fed. Cir. 2012). And in *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286 (Fed. Cir. 2014), the Federal Circuit again observed that the presumption against §112, ¶6, in the absence of the term “means” is a strong one, and the court noted that it has seldom held that a limitation that does not recite “means” is a means-plus-function limitation. *Id.* at 1297.

But eschewing this precedent, the Federal Circuit held in this case that the “strong” presumption against a §112, ¶6, construction in the absence of the term “means” is unjustified, unwarranted, uncertain in meaning and application, and “has the inappropriate practical effect of

placing a thumb on what should otherwise be a balanced analytical scale.” The court further noted that the expansion of this presumption has resulted, contrary to congressional intent, in a proliferation of functional claiming “untethered” to §112, ¶6. The Federal Circuit thus expressly overruled the characterization of that presumption as “strong,” and it stated that this presumption should be applied as done prior to *Lighting World* and its progeny.

Applying this revised standard, the Federal Circuit first drew little distinction between the terms “means” and “module,” which was recited in Williamson’s claims: “‘Module’ is a well-known nonce word that can operate as a substitute for ‘means.’” The court then held that the prefix “distributed learning control” likewise fails to impart sufficient structure into the term “module,” as nothing in the specification or prosecution history would lead the court to construe this expression as the name of a structure sufficiently definite to take the overall claim limitation out of the bounds of §112, ¶6. The Federal Circuit thus held that the limitation “distributed learning control module” is subject to the provisions of §112, ¶6.

The court then turned to Williamson’s specification, concluding that it lacked structure sufficiently corresponding to one function of the recited “distributed learning control module.” It particularly noted the absence in the disclosure of an algorithm for performing this function. The Federal Circuit therefore held that the district court did not err in deeming to be invalid the claims of Williamson’s patent that recite the limitation “distributed learning control module.”

Judge Reyna concurred, arguing that the Federal Circuit should revisit the presumptions that it gives to claim terms that recite “means.” And Judge Newman dissented. She particularly argued that the results of the Federal Circuit’s overruling of its precedent are clear and adverse: “additional uncertainty of the patent grant, confusion in its interpretation, invitation to litigation, and disincentive to patent-based innovation.”