

ROBERT BOSCH, LLC. v. SNAP-ON INCORPORATED, Appeal No. 2014-1040 (Fed. Cir. October 14, 2014). Before Prost, Taranto, and Hughes. Appealed from E.D. Mich. (Judge Cleland).

Background:

Plaintiff owns a patent directed to a diagnostic tester that determines whether the control unit in a vehicle needs to be reprogrammed. Plaintiff sued Defendant for patent infringement. Defendant asserted that two claim terms appearing in the independent claim of the patent were both means-plus-function terms under §112, ¶6 and were both indefinite.

Regarding the first claim term, the district court adopted a rebuttable presumption that the term invokes §112, ¶6 based on the presence of the phrase "by means of." The district court then found that the rebuttable presumption it had applied was not overcome and that the term was indefinite because the patent did not disclose the requisite corresponding structure. Regarding the second claim term, the district court adopted the rebuttable presumption that the second claim term did not invoke §112, ¶6 based on the lack of the word "means" in the claim term at issue, but concluded that the rebuttable presumption it had applied was overcome and the term was an indefinite means-plus-function term because the patent did not disclose the requisite corresponding structure. The parties then stipulated to a final judgment of invalidity, and this appeal followed.

Issues/Holdings:

(1) Did the district court err in determining that the rebuttable presumption that §112, ¶6 governs the construction of a claim term is triggered by a claim's use of the expression "by means of." Yes, reversed. (2) Did the district court err in its ruling that the disputed claims were invalid under §112? No, affirmed.

Discussion:

The Federal Circuit indicated that the claim term at issue does not use the term "means" at all, much less the classic phrase "means for." The Federal Circuit also indicated that it was not aware of any precedent stating that the rebuttable presumption is triggered by a claim's use of the expression "by means of." Thus, the Federal Circuit determined the district court erred in adopting a rebuttable presumption that the first claim term is a means-plus-function term based on the presence of the phrase "by means of" in the independent claim.

However, the Federal Circuit determined that this error was harmless, as even without the benefit of the rebuttable presumption, the first claim term still invokes §112, ¶6 (because the language of the first claim term did nothing more than identify functions for the recited device to perform), and when construed in light of the specification fails to provide sufficiently definite structure to one of skill in the art. The language of the second claim term in the patent was also solely functional, and thus, like the first claim term, the Federal Circuit determined that the second claim term invoked §112, ¶6.

Accordingly, because the specification failed to identify corresponding structures that are required where §112, ¶6 applies, the Federal Circuit held that the first and the second claim terms are indefinite. Thus, the Federal Circuit affirmed the district court's holding that all claims in the patent are invalid as indefinite.