

# An Introduction to Functional Language and Means Expressions

by *Michael A. Dryja*

*Law Offices of Michael Dryja  
Redmond, Washington*

and *Ann M. McCrackin*

*Schwegman, Lundberg, Woessner & Kluth  
Minneapolis, Minnesota*

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## §8.01 Introduction

Means-plus-function claims have become increasingly important in the drafting of claims that are comprehensive in scope, and thus in the drafting of patent applications that provide the most protection for their inventive subject matter. Means-plus-function claims are especially important in the realm of electronic and software-related patent applications. In some applications, they may represent the only manner in which claims can be drafted to a subject invention. Therefore, a complete understanding of the use of means-plus-function claims in such applications is critical for any patent attorney or agent practicing in this field.

To provide this understanding, this chapter first examines the statute governing means-plus-function claims<sup>1</sup> and the history behind the passage of the statute by Congress. Understanding the history behind a particular statute's appearance in the patent laws is frequently informative. In the case of means-plus-function claims in particular, this history has a great effect on interpretation even today.

This chapter next discusses current Federal Circuit law as it relates to prosecution through the Patent and Trademark Office (PTO) of applications including means-plus-function claims. In particular, one case guides the analysis: *In re Donaldson Co.*<sup>2</sup> The importance of this case is underscored by the fact that the PTO issued guidelines regarding the examination of means-plus-function claims in response to *Donaldson* soon after it was decided by the Federal Circuit.<sup>3</sup> The guidelines also provide a useful overview of the examining procedure for means-plus-function claims generally.

After examining the basics of means-plus-function law, the chapter explains how this legal puzzle piece fits into the special situation of computer software. The chapter examines the usefulness of means-plus-function claims for computer software patent applications and the considerations that should be taken into account when drafting claims for such applications. The discussion looks in particular to one

<sup>1</sup>35 U.S.C. §112, ¶6 (1998).

<sup>2</sup>16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

<sup>3</sup>Examination Guidelines for Claims Reciting a Means or Step Plus Function Limitation Under 35 U.S.C. §112, 6th Paragraph, 1162 OG 59 (1994).

Federal Circuit decision, *In re Alappat*,<sup>4</sup> because of its underlying computer software subject matter. Often there are no alternatives to the inclusion of means-plus-function claims in drafting a patent application covering a computer software invention.

The chapter buttresses the review of means-plus-function claims in the context of electronic and software-related inventions by examining what perhaps is the potential end game for all issued patents: patent litigation. Different considerations are important in patent litigation than in patent prosecution. Knowing these considerations up front ultimately results in stronger patents.

Finally, the discussion of means-plus-function law is concluded with a basic claim-drafting exercise for a typical electronic and software-related invention. The beginning patent practitioner will benefit most from this discussion. However, even for the expert, exposure to different claim-drafting techniques can only serve to increase one's skills as a patent attorney or agent.