



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Asyst Techs.,
Inc.***
v.
Empak, Inc.

No. 00-1194
Federal Circuit
Oct. 10, 2001

***“The
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On October 10, 2001, the Federal Circuit reversed and remanded the district court’s summary judgment of noninfringement of U.S. Patents No. 4,974,166 and No. 5,097,421. The patented technology related to systems used in processing semiconductor wafers into integrated circuits. In considering whether the disputed claim limitations corresponded to a structure described in the specification of both patents as “a local control processor 20 connected to the second two-way communication means 50 via a line 51 over which an electronic signal can be transmitted in either direction,” the Federal Circuit noted:

[I]n construing a means-plus-function limitation [one must] identify the function explicitly recited in the claim. The next step is to identify the corresponding structure set forth in the written description that performs the particular function set forth in the claim. Section 112 paragraph 6 does not “permit incorporation of structure from the written description beyond that necessary to perform the claimed function.” Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claim limitations.

[A]lthough line 51 enables the second microcomputer means to perform its recited functions, it does not actually perform any of those functions. The fact that a means of transferring data between the second microcomputer means and the second two-way communication means enables the claimed device to work does not mean that the communication line 51 is necessarily part of the claimed structure corresponding to one or the other of those functional limitations.

“[I]t is not necessary to claim in a patent every device required to enable the invention to be used.” An electrical outlet enables a toaster to work, but the outlet is not for that reason considered part of the toaster. The corresponding structure to a function set forth in a means-plus-function limitation must actually perform the recited function, not merely enable the pertinent structure to operate as intended, which is the case for the structure identified as line 51. We therefore disagree with the district court that line 51 should be regarded as part of the structure corresponding to the functions set forth in the “microcomputer means” limitation. . . .

The district court entered summary judgment of noninfringement after concluding that no reasonable jury could conclude that a communication path that includes information processing by the Ridian server found in the IridNet system is the equivalent of the communication path identified in the specification as line 51. . . . While it is true that the addition of features does not avoid infringement if all the limitations of the patent claim are found in the accused device, that principle is not dispositive here, because the question in this case is whether, in light of the role played by the Ridian server, the means used in the IridNet system for controlling activities on the workstation and transmitting information to the transportable container are equivalent to the means described in the specification of the ’166 patent. Even if the Ridian server is considered merely an additional feature, it would be sufficient to defeat an infringement claim under section 112 paragraph 6 if it significantly changes the way the control and communication functions are performed.