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## Paragon V. Timex: Functional Vs. Structural Claiming

*Law360, New York (September 28, 2009)* -- Claim Drafting Tip: When seeking to patent an invention, one should include apparatus claims that are drafted to avoid a potential pitfall around "contextual infringement."

In the case of inventions in which software is one embodiment, in particular, functional language is frequently employed in such a claim. Here, a drafter should take extra care or infringement may require actual, which is not typically desirable.

In *Paragon Solutions v. Timex*, decided by the Federal Circuit on May 22, 2009, the court raises the tricky question of whether an apparatus claim can be construed in such a way that infringement depends on the particular use of the apparatus.

Specifically, the district court construed "displaying real-time data" to mean "displaying data substantially immediately without contextually meaningful delay so that the information is displayed in a time frame experienced by people."

The issue with this construction is that whether or not a product infringes may turn on how the user uses it. In one use context, a long delay may be acceptable whereas in another use context a short delay may be required.

In general, one specific point to take from the case may be to avoid the term "real-time" altogether or to define the term "real-time" if you intent to use it in a claim.

However, a key takeaway from the case is to be aware that apparatus claims should not be written so that whether or not something infringes depends on the particular use.

This violates a basic tenet of how apparatus claims work (see discussion in the case on page 24 — "... apparatus claims cover what a device is, not what a device does ...). It would seem that having such a situation for a method claim may not violate that same tenet since it is limited to apparatus claims.

However, take care, because the method claim could still be held to be indefinite if it is drafted in such a way that infringement changes with the use in a way so that one of ordinary skill in the art would not necessarily know what was covered and what was not covered by the claim.

This case in a more subtle way raises the challenge of functional versus structural claiming in connection with apparatus claims. Technically, functional claiming is permissible. Both the CCPA and the Federal Circuit has stated that.

However, this case suggests it may be important to take care how you draft such functional limitations so as to avoid this trap. That is, the functional limitation should not be such that whether or not one infringes turns on how the device is used. It is noted that this is poor claim drafting practice even without this case.

Consider for example, the following: memory to store coefficients; receiver to receive GPS signals.

These examples illustrate poor drafting because a memory as a structural device is not limited in what it can store just like a receiver as a structural device is not limited as to the signals it receives (versus how it processes signals once they are received).

This case now suggests another reason to avoid these approaches — it may affect the construction of the claim in an adverse way by suggesting that how the device is used affects whether or not it infringes.

A related point to consider has to do with a claim of the following standard form:

An apparatus comprising: A, B and C.

The question is this: Is this claim limited to covering an apparatus where A, B and C are combined physically or would the claim also cover where A, B and C are combined functionally, but not necessarily physically?

One may have a preferred answer to this question but my answer is make sure that the specification includes language so that this does not become a hotly contested Markman issue if you are relying on the claim being construed functionally.

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