

## Functional Claim Language – To Infringe, Must the Device be *Designed* to Perform the Function, or Just be *Capable* of Performing the Function?

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*Legal Update*

Claiming an apparatus in terms of what it does, referred to as “functional claim language,” rather than the structure of the apparatus itself, is a common and useful claim drafting technique. The way the functional language is recited, however, can determine whether the claim covers any device *capable* of performing the function, or only devices *designed* or *made* to perform the function.

In *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, No. 11-1147 (Fed. Cir. Mar. 14, 2012), the Federal Circuit shed some light on this issue. In that case, one of the disputed issues was the construction of the following claim language:

said arms and said pair of magnetic members adapted to extend  
across respective side portions of a primary spectacle frame

(Emphasis added). The claim was directed to auxiliary sunglass frames that magnetically attach to prescription eyewear (the “primary spectacle frame”). The patent disclosed auxiliary frames that attach to the top of the primary frame, while the auxiliary frames of the accused products attached to the bottom of the primary frame. At issue was whether the disputed claim language was broad enough to capture a device capable of attaching in a top-mounted configuration, or only devices designed to attach in a top-mounted configuration.

The Federal Circuit noted that in claim drafting, “adapted to” can sometimes carry the broader meaning (capable of), and can sometimes carry the narrower one (designed to). In the course of its discussion, the court listed the following terms as having the narrower meaning:

“made to;” “designed to;” “configured to”

(Emphasis added). The court listed the following terms as having the broader meaning:

“suitable for;” “capable of;” “having the capacity to”

The court used intrinsic evidence, claim differentiation, and a construction from an earlier ruling to decide that, in this case, “adapted to” should be construed to have the narrower meaning.

Although not the focus of the case, the court’s treatment of the phrase “configured to” is important. Often during patent prosecution, the USPTO will construe “configured to” to mean “capable of” and reject pending claims over prior art that is not designed to perform the recited function, but may be capable of doing so. However, the *Aspex* case shows that if the prosecuted claims are later asserted in litigation, a court may limit them to only cover devices designed to perform the recited function. Accordingly, applicants seeking to broadly claim a function should consider using phrases such as “suitable for,” “capable of,” and “having the capacity to,” rather than “configured to” to ensure broader coverage. The law, however, is evolving, and applicants should consider using a variety of different terms in the specification and in the claims to help achieve broad claim coverage under the current legal regime and in unknown future legal regimes.

**This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.**

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