

## Patents

### Interpretation of Functional Features of a Patent Claim in Taiwan

By **May Chen**, Lee and Li, Taipei; e-mail: maychen@leeandli.com

Patent claims rely solely on text. However, it can be difficult to define the scope of a patent right by describing an inventive concept or feature by text alone. It is not uncommon for a patent claim to involve not only structure, ingredients and/or movement, but also function. Appropriate interpretation of the scope of features defined by functional description has been a matter of longstanding controversy.

Taiwan's Patent Examination Guidelines (issued in 2013) that is currently in effect, do not deny the legitimacy of such claims employing functional descriptions. The guidelines only stress that a claim employing solely functional description without any other technical feature will fail to meet the requirements for clarity/definiteness.

The current guidelines only provide two kinds of functional features, namely “object defined by function” and “means-plus-function” .

“Object defined by function” is exemplified by claim language such as “storage device” and “output circuit”<sup>1</sup> which has been commonly used or recognized by persons in the art over a period of time and can easily be understood.

---

<sup>1</sup> See Taiwan IP Court judgment No. 103-Civil-Patent-Suit 48.

---

Interpretation of the claim language for an “object defined by function” should include all objects/means which can perform such function.

“Means-plus-function” must meet the following two requirements:

- (i) The claim language is in the form of “means for...” ; and
- (ii) The claim language does not cover all necessary structures, materials and/or movements for performing the claimed function. In addition, interpretation of means-plus-function language must include the structures, materials and/or movements for performing the function as its limitations and the equivalent scope thereof.

However, in the case where a functional description in a claim was not apparently drafted in the form of “object defined by function” or “means-plus-function” , how should it be interpreted?

The Amended Points of Patent Infringement Assessment document, which is undergoing public consultation prior to final drafting by the Taiwan Intellectual Property Office, provides for a third type of functional feature — “functional clause” .

For example, in the claim description “a changing direction device ... comprising ... whereby ... to quickly change the operation direction,” the language “whereby ... to quickly change the operation direction” would be a functional clause, rather than “object defined by function” or “means-plus-function” .

The question arises however, as to whether a “functional clause” might be considered a limitation of the scope of the claim scope. The Amended Points of Patent Infringement Assessment provides the following two different opinions:

- Opinion 1. If the functional clause is only to describe the result that the technical feature is intended to achieve, it should not be considered a limitation of the claim scope.
- Opinion 2. Since the functional clause is part of the claimed features, it apparently relates to the limitations of the claim scope.

IP Court Judgment No. 99-Civil-Patent-Suit-58 adopted Opinion 2 because it indicates that “a functional clause relates to the limitations of claim scope; according to the All-Elements Rule, it has to be taken into consideration when the claim is compared with prior art and the accused product.”

Though the Amended Points of Patent Infringement Assessment provide definition of a functional clause, it remains unclear whether a claimed feature drafted as a functional clause would be considered means-plus-function language if it does not contain all necessary structures, materials and/or movements for performing the claimed function. Interpretation of functional features/descriptions will merit scrutiny of future practice of the court and patent office.