

Patenting Function

Eileen M. Herlihy

The connection between function and invention is a complicated one. In fact, the relationship between the two has been the subject of controversy for years in patent law.

One issue that has received significant attention in this area is the use of functional language in patent claims. While the use of functional language in claims was prohibited by the courts for a time, it has been authorized by statute since the enactment of the 1952 Patent Act. Pursuant to § 112, ¶ 6, a patent applicant may employ language describing "means for" accomplishing a functional task in product claims and "steps for" accomplishing a functional task in process claims. The application of § 112, ¶ 6, however, has not proceeded without difficulties.

This paper examines a number of theoretical issues associated with patenting products or processes that are tied in whole or in part to functional concepts. First, the paper examines the underlying concerns related to overbreadth and ambiguity that caused the courts to initially reject claims written in functional terms and later led to the enactment of the statutory provisions currently codified at § 112, ¶ 6. The paper also analyzes the difficulties that have arisen in the application of § 112, ¶ 6. Finally, the paper relates the problems that led to the enactment of § 112, ¶ 6 with current problems in patent law in the areas of definiteness and patentable subject matter, especially with regard to the patenting of genes.