



# THINK FORWARD

## Distinguishing Capability from Action

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In *Mastermine Software, Inc. v. Microsoft Corp.*, Appeal 16-2465, 2017 U.S. App. LEXIS 21479 (Fed. Cir. Oct. 30, 2017) the Federal Circuit reversed the District Court's finding of indefiniteness. The District Court found that Mastermine's patent improperly claimed both an apparatus and a method of using a claimed apparatus. The Federal Circuit held, in part, that the mere inclusion of method functional language in an apparatus claim was insufficient on its own to render the apparatus claim indefinite. *Id.* at 17.

The Federal Circuit distinguished *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), which held that a single claim covering both an apparatus and a method of use of that apparatus is indefinite under section 112, paragraph 2. The indefiniteness problem identified in *IPXL Holdings* arises when it is "unclear whether infringement ... occurs when one creates a[n infringing] system, or whether infringement occurs when the user actually uses [the system in an infringing manner]." *IPXL Holdings*, 430 F.3d at 1384.

Conversely, the Federal Circuit characterized the claims at issue in *Mastermine* as "simply apparatus claims with proper functional language." *Id.* at 11. For example, claim 8 recites a system with a reporting module that includes functions including that the module *presents* fields, *receives* a selection, and *generates* a query. The Court found that the active verbs (presents, receives, and generates) are "permissible functional language used to describe capabilities of the 'reporting module.'" *Id.* at 16. The Court also noted that the claims do not claim activities performed by the user and focus on the system's capability to receive and respond to user selection. *Id.* at 17.

The divining rod for determining the definiteness of claims containing both system/apparatus elements and active verbs distills down to whether the actions describe what the system/apparatus is capable of doing. When a system/apparatus claim describes what it is capable of doing by employing functional language, it limits the claimed structure and clearly alerts the skilled artisan that the act of infringement occurs when one makes, uses, offers to sell, or sells the claimed system/apparatus, as opposed to requiring usage of the system/apparatus for infringement.

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