



District Court: Means-Plus-Function Limitations Must Appear in Combination with Other Elements to Meet Enablement Requirement

September 17, 2025

Reading Time : **3 min**

By: Shivani Prakash, Matthew George Hartman, Rachel J. Elsby

A magistrate judge in the District of Delaware issued a Report and Recommendation, that found the sole asserted claim was a “single means” claim and therefore invalid for lack of enablement. In reaching that conclusion, the magistrate judge rejected the patentee’s argument that the preamble of the claim disclosed a second element that satisfied the combination requirement of Section 112, paragraph 6 because the preamble simply recited a descriptor of the very apparatus that was the subject of the means-plus-function limitation in the body of the claim. The district court judge presiding over this case has scheduled a hearing to review the magistrate’s ruling.

In this district court litigation and following a long history, Plaintiff ultimately accused Defendant of infringing a single dependent claim generally directed to a panoramic objective lens comprising an optical means for projecting a panorama into an image plane. The asserted claim further specifies the manner in which the panoramic object lens functions.

In a motion for judgment on the pleadings, Defendant argued the asserted claim was invalid for lack of enablement because it was improperly directed to a “single means” while means-plus-function limitations are statutorily limited to elements that appear ***in a claim for a combination***.

In addressing Defendant’s argument, the district court started out by distinguishing the statutory requirements for a proper means-plus-function claim and an improper “single means” claim. As the district court noted, the text of § 112, ¶ 6 states that means-plus-function language may be used to express “[a]n *element* in a claim for a *combination*[.]” In

other words, means-plus-function limitations can only appear in claims that include a combination of two or more elements. “Single means” claims are those that recite only the means-plus-function limitation by itself. The Federal Circuit has held that “single means” claims are typically invalid because they purport to cover every means for achieving a particular result. That is, because they are not constrained by the manner in which they interact with other elements of the combination, they broadly cover a functional result, while the specification only discloses those means that were known to the inventor.

The parties’ primary dispute concerned whether the asserted claim, including the limitations of the independent claim from which it depended, was directed to a single element or included multiple elements. In resolving this dispute, the district court noted that because the issue was a purely legal question, it need not apply the clear and convincing evidence standard. Instead, the district court resolved the motion by determining whether the claim included multiple elements as a matter of law without importing any standards of proof.

To determine whether the asserted claim included multiple elements, the district court first considered the plain language of the claims, and concluded the claim recited only a single element—the optical means. The district court noted that complete claim language appeared to recite one “means” element—“optical means”—while the rest of the words following the word “comprising” served only to “further describe[] the characteristics” of that optical means. Plaintiff argued that while the body of the claim included only a single element, the preamble added a second element by defining the invention as a panoramic objective lens. According to Plaintiff, figures in the specification showed that the panoramic objective lens included multiple features. The district court disagreed, and found the panoramic objective lens referred to in the preamble was just a descriptor of the optical means, not a separate element. Thus, it “simply does not make sense” to count the preamble of the claim as “being a separate element of that very apparatus,” and further that it “defies logic” to consider the “optical means” to be “in combination with” the lens, but also be a part of the lens.

Turning to the question of enablement, the district court explained that “single means” claims are not subject to the traditional enablement analysis. Instead, the fact that a claim is directed to a single means-plus-function element is determinative of the enablement inquiry. And for this reason, the district court recommended granting Defendant’s motion for judgment on the pleadings.

Practice Tip: When drafting claim language, patent applicants should make sure that any means-plus-function claims contain multiple “means” elements sufficient to meet the “combination” requirement of 35 U.S.C. § 112, ¶ 6. Conversely, parties accused of patent infringement should carefully review any means-plus-function claims in the asserted patents to see if they qualify as improper “single means” claims when crafting their invalidity arguments.

ImmerVision, Inc. v. Apple Inc., 1-21-cv-01484 (D. Del Jul. 24, 2025)

Categories

Patent Litigation

Patent Infringement

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.