

Cite as: 12 TECH. L. REV., Dec. 2015, at 71.

Definiteness of Means/Steps-Plus-Function Clams—A Cases Study of Taiwan’s Courts Decisions

Jung-Kuang Kuo^{*}, Wan-Tsui Chiang^{**}

Abstract

Article 19(4) of Taiwan’s Enforcement Rules of the Patent Act permits means-plus-function and steps-plus-function claims. However, without reciting the structure, material or acts performing the claimed function, claims may face challenges about the definiteness requirement. One of the related debates is whether the specification should recite the corresponding structure, material or acts of the claimed function. This issue has been brought up both in Taiwan and U.S. jurisdictions. This study compares Taiwan court decisions with the U.S. decisions which touch on the definiteness of means-plus-function and steps-plus-function claims. We find that while the U.S. courts require that the specification has to recite the corresponding structure, material or acts of means-plus-function and steps-plus-function claims to satisfy the definiteness requirement, Taiwan courts do not adopt the same standard. This study argues that by requiring specifications disclose the corre-

* LL.M. candidate, National Chiao Tung University School of Law; LL.B., College of Law, National Taipei University.

** Assistant Professor, National Chiao Tung University School of Law; S.J.D., Indiana University – Maurer School of Law, U.S.A.

sponding structure, material or acts implementing claimed function to satisfy the definiteness requirement, the standard made by U.S. court decisions limits the metes and bounds of means-plus-function and steps-plus-function claims to a more reasonable extent in order to prevent the abuse of functional claims. This study further suggests that Taiwan's legislative and judicial branches of the government should adopt the same standard to prevent future definiteness disputes. Additionally, this study contends that means-plus-function can be used for device claims while steps-plus-function can be used for method claims. Due to this distinction, this study concludes that the corresponding disclosure of means-plus-function claims in the specification should be structures or materials which have concrete forms, while the corresponding disclosure of steps-plus-function claims in the specification should be acts which should have no concrete forms.

Keywords: Means-plus-function, Steps-plus-function, Functional Claim, Definiteness, Full Disclosure