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Patently Enabled February 2026 - Form Follows Function...Except in Apparatus Claims

Key Takeaways

- For apparatus claims, patentability turns on structure – what a device is, not merely what it is intended to do.
- Functional phrasing can be useful, but only when it reflects real structural limitations.

Patent claims are the legally operative part of a patent and define the boundaries of what an inventor owns. Claims come in different types, each aimed at protecting a different facet of an invention. Apparatus claims cover a physical thing, whereas method claims protect a series of actions. A single patent often includes those two claim types, and those differences matter when drafting claims that will withstand scrutiny during examination or litigation.

For apparatus claims, the law focuses on a thing's structure (i.e., what it *is*) rather than what an applicant intends it to do. During examination or any post-issuance review, statements of purpose or intended use generally carry little weight. A structurally identical device does not become novel merely because it is put to a different use. For example, a claim to "a clamp for holding medical tubing" may not avoid prior art disclosing the same clamp for use in an industrial setting if the clamp is *structurally* identical.

Apparatus claims turn on structure, which incentivizes applicants to express functionality without committing to specific structural implementations. If a claim recites excessive structural detail, it may be unduly narrow and fail to cover the invention's full conceptual scope and thus make it easier for competitors to design around the claims. In contrast, if a claim recites only what a device is "for" and little more, the limitation may risk being rejected as intended use.

To appropriately capture the full scope of the invention, patent drafters often use phrasing that suggests capability rather than purpose, most commonly by stating that a device is "configured to" ¹ perform a particular operation (e.g., "a widget configured to spin"). However, *configured to* is not a magic phrase, and courts have repeatedly emphasized that its legal effect depends on substance rather than wording. When a claim recites a device configured to perform a function, the key issue is whether that language actually requires a meaningful structural difference or merely describes what an otherwise ordinary device is capable of doing. If a third party's same structure could perform the claimed function regardless of what your claim is configured to do, then the phrase may be treated as little more than intended use and given minimal limiting effect.

For example, a "door lock configured to open in response to a biometric signal" may meaningfully limit a claim if, based on language elsewhere in the claim or even in the specification, configured to necessarily requires, e.g., a fingerprint sensor and a controller coupled to a mechanical interface that prevents non-biometric opening. In such a case, configured to (here, "open") would likely carry patentable weight. In contrast, "a container configured to store medical waste" may not be meaningfully narrow unless the configuration requires structural features beyond those found in conventional containers.

Stated differently, pairing a structure with a function does not always distinguish a claim for patentability purposes. Functional language has legal effect for an apparatus claim to the extent it reflects specific structural features. Thoughtful claim drafting, informed by how courts and U.S. Patent Office examiners construe such language, is essential to ensuring that a patent provides robust and predictable protection.

¹ Also sometimes used are "capable of," "adapted to," "designed to," "for performing" and similar phrases.

Authors



Jacob Golan, Ph.D.
Associate

Stamford, CT | (203) 977-7320
Boston, MA |
jgolan@daypitney.com



George Chacras
Partner

Providence, RI | (401) 283-1226
gchacras@daypitney.com