

RAIN COMPUTING, INC. v. SAMSUNG ELECTRONICS AMERICA, INC., Appeal Nos. 2020-1646, -1656 (Fed. Cir. March 2, 2021). Before Lourie, Dyk and Moore. Appealed from D. Mass. (Judge Stearns).

Background:

Rain sued Samsung for infringing the claims of its patent directed to delivering apps to client terminals using web-based app stores. The patent discloses using a user identification device, such as an IC card, provided to the user's electronic device to authenticate the user and control the user's access to the apps.

The district court construed the claim term "user identification module" as a means-plus-function element but found the term to be sufficiently definite and thus valid due to the patent disclosing computer-readable media such as the IC card. At the same time, the district court determined Samsung did not infringe any of the claims. Rain then appealed the determination of noninfringement, and Samsung cross-appealed the determination of validity.

Issue/Holding:

Did the district court err in holding that the term "user identification module" is not indefinite? Yes, reversed-in-part, dismissed-in-part.

Discussion:

On appeal, the Federal Circuit first confirmed that "user identification module" is a means-plus-function term because "module" is a well-known nonce word, and "user identification" merely describes a function. Rain argued that an amendment made during prosecution to change "a user identification module *for accessing*" to "a user identification module *configured to control access*" avoided invocation of §112 ¶6. However, the Federal Circuit concluded that the phrase "configured to" does not imply any structure. Rain further attempted to rely on the Patent Office's explicit statement during prosecution that "user identification module" is not a mean-plus-function term when recited in a method claim; but the Federal Circuit merely concluded that the Patent Office incorrectly applied the §112 ¶6 analysis to method claims.

Having confirmed that "user identification module" is a means-plus-function term, the Federal Circuit then looked to the patent to determine whether sufficient structure is disclosed for the function of controlling access. The district court had relied on the patent's disclosure of computer-readable media in finding the term sufficiently definite. The Federal Circuit, however, found that computer-readable media amount to nothing more than a general-purpose computer. The patent therefore needed to disclose programming, such as an algorithm, without which a general-purpose computer could not perform the claimed function of controlling access. Because the patent provides no flowchart or any other form of algorithm explaining how to perform the claimed function, the disclosure of computer-readable media did not amount to sufficient structure to render the term "user identification module" definite.

The Federal Circuit determined the claims were invalid as indefinite and therefore did not reach the merits of Rain's appeal.