PROTECTING SOFTWARE INVENTIONS:
SYSTEM AND/OR COMPUTER-READABLE MEDIUM CLAIMS

FINJAN, INC. v. SECURE COMPUTING CORP.

Decided: November 4, 2010

Computer-Readable Medium Claim (or Beauregard Claim)[1]*:*

A claim that covers a computer-readable storage medium such as floppy disks, CD-ROMs, or DVD-ROMs, containing a set of instructions that causes a computer to perform a process.

Since the decision of the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), the Computer-Readable Medium Claims have been almost always accepted by the U.S. Patent and Trademark Office (USPTO) and the courts.

In *In re Beauregard*, the Board of Patent Appeals and Interferences (Board) rejected computer program product claims of Beauregard's patent application on the basis of the printed matter doctrine.[2] Beauregard appealed the Board's rejection to the Federal Circuit. On appeal, the Commissioner for Patents (Commissioner) acknowledged that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. §101 …." Accordingly, the Federal Circuit remanded the case for reconsideration in accordance with the Commissioner's acknowledgement.

In a recent case, *Finjan, Inc. v. Secure Computing Corp.* (*Finjan*), the Federal Circuit's opinion presents an example of the usefulness of the Beauregard claims. *Finjan* presents a number of issues, but this article will focus on the Federal Circuit's non-infringement decision against Finjan, Inc. (Finjan) in its method claims.

In *Finjan*, the plaintiff owned three patents related to methods directed to detecting and defeating previously unknown internet based viruses. The patents include *method* claims and corresponding *system* and *computer-readable storage medium* claims for performing the claimed methods.

In 2006, Finjan filed a patent infringement case against Secure Computing Corporation (Secure) alleging that Secure directly infringed Finjan's patents by testing and selling the accused products. The jury found that the defendants, including Secure, willfully infringed all asserted claims.

On appeal, the Federal Circuit affirmed the decision of the U.S. District Court for the District of Delaware for infringement in the *system* and *computer-readable storage medium* claims, but reversed the infringement decision in the *method* claims. In its opinion, the Federal Circuit reiterated that a person must have practiced *all* steps of a method claim in the United States in order to infringe the claimed method[3] (emphasis added).

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[1] *See* Victor Siber and Marilyn S. Dawkins, Claiming Computer-Related Inventions As Articles of Manufacture, 35 IDEA 13 (1994).

[2] The Printed Matter Doctrine is a doctrine stating that printed matter may not be patented unless it is a physical part of a patentable invention.

[3] *Lucent Techs. v. Gateway, Inc.*, 580 F.3d 1301, 1317 (Fed. Cir. 2009).

Here, the steps of the claimed method had only been performed during testing that occurred in Germany. In addition, the testing was also performed on the product that was made in Germany. Accordingly, the Federal Circuit stated that Finjan failed to provide evidence that the defendants infringed the method claims by testing or operating any accused products in the United States. Thus, the defendants did not infringe the method claims.

Note:

In our 2010 Winter E-newsletter, we wrote a brief commentary on the "Subject Matter Eligibility of Computer Readable Media"[4] released by the USPTO. It should be noted that there are certain limitations in drafting computer-readable medium claim (or Beauregard claim).

For more information, visit the website at http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

[4] Subject Matter Eligibility of Computer Readable Media (signed January, 2010 by Director Kappos).