EXHIBIT A

2021 WL 786361
Only the Westlaw citation is currently available.
United States Court of Appeals, Federal Circuit.

RAIN COMPUTING, INC., Plaintiff-Appellant

v.

SAMSUNG ELECTRONICS AMERICA, INC., Samsung Electronics Co., Ltd., Samsung Research America, Inc., Defendants-Cross-Appellants

2020-1646
|
2020-1656
|
Decided: March 2, 2021

Synopsis

Background: Patent owner sued competitor for infringement of patent for method of delivering on-demand software packages. United States District Court for the District of Massachusetts, Richard G. Stearns, J., 2020 WL 708125, entered stipulated judgment in competitor's favor, stating that asserted claims were neither infringed nor invalid for indefiniteness. Owner appealed, and competitor cross-appealed.

Holdings: The Court of Appeals, Moore, Circuit Judge, held that:

[1] term "user identification module" was a means-plus-function claim term, and

[2] term "user identification module" lacked sufficient structure and rendered the claims indefinite.

Reversed in part, and dismissed in part.

West Headnotes (14)

[1] **Patents** Construction and Operation of Patents

Whether claim language invokes patent statute governing means-plus-function claim limitations, is a question of law that is reviewed de novo. 35 U.S.C.A. § 112.

[2] **Patents** Questions of fact, verdicts, and findings in general

In patent cases, Court of Appeals reviews any of district court's underlying findings of fact for clear error.

[3] **Patents** Functions, means, and results of invention

Means-plus-function patent claims are construed to cover only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof. 35 U.S.C.A. § 112.

[4] **Patents** Functions, means, and results of invention

To determine whether patent statute governing means-plus-function claim limitations applies to a claim limitation, court must inquire whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure; if those lack a sufficiently definite meaning, the statute applies. 35 U.S.C.A. § 112.

[5] **Patents** Functions, means, and results of invention

If patent claim limitation uses word "means," there is rebuttable presumption that means-plus-function statute applies; if not, there is rebuttable presumption that provision does not apply, but that presumption can be overcome

and statute will apply if challenger demonstrates that claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function. 35 U.S.C.A. § 112.

[6] **Patents** Functions, means, and results of invention

Term "user identification module," in patent for method of delivering on-demand software packages, was a means-plus-function claim term; "module" was a substitute for "means," and patent owner failed to point to any claim language providing any structure for performing the module's claimed function of being configured to control access, nor did prefix "user identification" impart structure, as it merely described the function of the module, to identify a user, and further, term "user identification module" had no commonly understood meaning and was not generally viewed by one skilled in the art to connote a particular structure. 35 U.S.C.A. § 112.

[7] **Patents** Functions, means, and results of invention

The word "module" in patent claim is a well-known nonce word that can operate as a substitute for "means," so as to invoke rebuttable presumption that means-plus-function statute applies. 35 U.S.C.A. § 112.

[8] **Patents** Functions, means, and results of invention

First step in construing a means-plus function claim is to identify the claimed function. 35 U.S.C.A. § 112.

[9] **Patents** Functions, means, and results of invention

After identifying claimed function of means-plus-function claim, the court determines what structure, if any, disclosed in the specification corresponds to that function; under this second step, structure disclosed in the specification is corresponding structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. 35 U.S.C.A. § 112.

[10] **Patents** Functions, means, and results of invention

Under means-plus-function form of claiming, if the function is performed by a general purpose computer or microprocessor, then the specification must also disclose the algorithm that the computer performs to accomplish that function; however, in rare circumstances where any general-purpose computer without any special programming can perform the function, an algorithm need not be disclosed. 35 U.S.C.A. § 112.

[11] **Patents** Ambiguity, Uncertainty, or Indefiniteness

If the patentee fails to disclose adequate structure corresponding to the claimed function, in a means-plus-function claim, then the claim is indefinite. 35 U.S.C.A. § 112.

[12] **Patents** Patentability and Validity

In patent cases, the Court of Appeals reviews the district court's indefiniteness determination de novo.

[13] **Patents** Particular products or processes

Patent for method of delivering on-demand software packages lacked sufficient structure, and thus was indefinite, in absence of an algorithm to achieve the claimed function of a "user identification module," which controlled access to one or more software application packages to which the user had a subscription; function required specialized programming, but nothing in the claim language or written description provided it. 35 U.S.C.A. § 112.

[14] **Patents** In general; utility

US Patent 9,805,349. Invalid.

Appeals from the United States District Court for the District of Massachusetts in No. 1:18-cv-12639-RGS, Judge Richard G. Stearns.

Attorneys and Law Firms

Stephen Yee Chow, Hsuanyeh Law Group, PC, Boston, MA, argued for plaintiff-appellant. Also represented by Hsuanyeh Chang.

Michael J. Mckeon, Fish & Richardson PC, Washington, DC, argued for defendants-cross-appellants. Also represented by Christopher Dryer.

Before Lourie, Dyk, and Moore, Circuit Judges.

Opinion

Moore, Circuit Judge.

***1** Rain Computing, Inc. appeals a final judgment of noninfringement of the asserted claims of U.S. Patent No. 9,805,349 and Samsung Electronics America, Inc.; Samsung Electronics Co., Ltd.; and Samsung Research America, Inc. (collectively Samsung) cross-appeal the final judgment that the asserted claims of the '349 patent are not invalid as indefinite. For the reasons below, we reverse the district court's judgment on indefiniteness and dismiss Rain's appeal.

Background

Rain sued Samsung for infringement of claims of the '349 patent. The '349 patent is directed to delivering software application packages to a client terminal in a network based on user demands. *See* '349 patent at Abstract, 1:59–2:14. The claimed invention purports to deliver these packages more efficiently by using an operating system in a client terminal rather than a web browser. '349 patent at 1:49–55, 1:59–2:14. Claim 1 is representative:

> 1. A method for providing software applications through a computer network based on user demands, the method comprising:
>
> accepting, through a web store, a subscription of one or more software application packages from a user;
>
> sending, to the user, a user identification module configured to control access of said one or more software application packages, and coupling the user identification module to a client terminal device of the user;
>
> a server device authenticating the user by requesting subscription information of the user from the user identification module through the computer network;
>
> upon authentication of the user, the server device providing, to the client terminal device of the user, a listing of one or more software application packages subscribed through the web store in accordance with the subscription information;
>
> the server device receiving, from the client terminal device and through the computer network, a selection of a first software application package from said listing of one or more software application packages;
>
> the server device transmitting the first software application package to the client terminal device through the computer network; and
>
> executing the first software application package by a processor of the client terminal device using resources of an operating system resident in a memory of the client terminal device.

In a February 12, 2020 order, the district court construed various claim terms. Relevant here, it construed "executing the [first/second] software application package ... in a memory of the client terminal device" and "user identification module configured to control access of ... software application packages." *Rain Computing, Inc. v. Samsung Elecs. Co.*, No. 18-12639-RGS, 2020 WL 708125, at *3–7 (D. Mass. Feb. 12, 2020). The district court determined "user identification module" was a means-plus-function term subject to 35 U.S.C. § 112 ¶ 6 and was not indefinite. *Id.* at *3–5. Following that order, the district court entered judgment, based on the parties' joint stipulation, that the asserted claims were neither infringed nor invalid for indefiniteness. Rain appeals and Samsung cross-appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

Discussion

***2** Rain challenges the district court's construction of the "executing" term. Samsung challenges the court's determination that "user identification module" does not render the claims indefinite. Because we agree with Samsung that "user identification module" renders the claims indefinite, we do not reach the merits of Rain's appeal.

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[1] **[2]** **[3]** Whether claim language invokes 35 U.S.C. § 112 ¶ 6 is a question of law we review de novo. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346 (Fed. Cir. 2015). We review any underlying findings of fact for clear error. *Id.* Under § 112 ¶ 6, a patentee may draft claims "as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof." But such claims are construed to cover only "the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof." *Williamson*, 792 F.3d at 1347.

[4] **[5]** To determine whether § 112 ¶ 6 applies to a claim limitation, we must inquire "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Id.* at 1349. If those words lack a sufficiently definite meaning, § 112 ¶ 6 applies. If the limitation uses the word "means," there is a rebuttable presumption that § 112 ¶ 6 applies. *Id.* at 1348–49. If not, there is a rebuttable presumption that the provision does not apply. *Id.* But that "presumption can be overcome and § 112 para. 6 will apply if the challenger demonstrates that the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function." *Id.* at 1348 (quotations and brackets omitted).

[6] **[7]** We first determine whether "user identification module" is a means-plus-function term. Because the term does not include the word "means," there is a rebuttable presumption that § 112 ¶ 6 does not apply. " 'Module' is a well-known nonce word that can operate as a substitute for 'means.' " *Id.* at 1350. In *Williamson,* we held that the word "module" in the claim term "distributed learning control module" "does not provide any indication of structure because it sets forth the same black box recitation of structure ... as if the term 'means' had been used." *Id.* Likewise, "module" here does not provide any indication of structure, and Rain fails to point to any claim language providing any structure for performing the claimed function of being configured to control access. Nor does the prefix "user identification" impart structure because it merely describes the function of the module: to identify a user. *See id.* at 1351 ("The prefix 'distributed learning control' does not impart structure into the term 'module.' "). Thus, the claim language fails to provide any structure for performing the claimed functions.

The parties do not dispute that "user identification module" has no commonly understood meaning and is not generally viewed by one skilled in the art to connote a particular structure. In *Media Rights Technologies, Inc. v. Capital One Financial Corp.*, we held that the written description of a "copyright compliance mechanism," including how it was connected to various parts of the system, how it functioned, and its potential functional components, was not enough to provide sufficient structure to the claimed "compliance mechanism." 800 F.3d 1366, 1372–73 (Fed. Cir. 2015). Here, the specification does not impart any structural significance to the term; in fact, it does not even mention a "user identification module." "Without more, we cannot find that the claims, when read in light of the specification, provide sufficient structure for the [ ] term." *Id.* at 1373. Accordingly, we hold "user identification module" is a means-plus-function term subject to § 112 ¶ 6.

***3** Rain argues an amendment made during prosecution of "a user identification module *for accessing ...*" to "a user identification module *configured to control access of ...*" prevents "user identification module" from being a means-plus-function term. Appellant Resp. & Reply Br. at 12–13, 56–57 (emphases added). According to Rain, replacing "for" with "configured to" removed the means-plus-function language. *Id.* But the purely functional claim language reciting what the "user identification module" is configured to do provides no structure. *See MTD Prods. Inc. v. Iancu*, 933 F.3d 1336, 1343 (Fed. Cir. 2019) (construing "a mechanical control assembly ... configured to actuate ..." as a means-plus-function limitation).

Rain also argues that an appellate brief filed by Patent Office examiners defending a final rejection of the applicant's claims supports its position that the term is not a means-plus-function term. The examiners' brief states, in relevant part:

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