

System Claims May Be Superior/Diminished by Jens Jenkins

The claims of a patent are infringed, in general, when an entity ‘without authority makes, uses or sells the patented invention.’ 35 U.S.C. § 271(a). Determining infringement, however, is not a trivial matter. This is particularly true when the infringement involves ‘use’ of a distributed process performed by more than one party.

One strategy to bolster protection for computer-related processes is to pursue claims of different formats, including system claims, method claims and Beauregard claims. System claims are particularly beneficial, for example, because they can sometimes provide more options than method claims for asserting infringement against an accused infringer that is using a claimed process in a distributed computing environment. System claims are enforceable against an infringer using a distributed process because the courts have clarified that an entity ‘uses’ and infringes a claimed system when that entity puts the invention into service for its behalf, even if it is not implementing every aspect of the process, provided the entity both controls the system and receives a benefit based on the control (*Centillion Data Systems, LLC v. Qwest Communications International, Inc.*, 631 F.3d 1279 (Fed. Cir. 2011)).

However, the strategic advantages afforded system claims for distributed computing processes may be diminishing. On Sept. 13, 2017, the United States Court of Appeals for the Federal Circuit qualified how the term ‘use’ is to be interpreted for infringement analysis of system claims. As clarified by the Court, ‘use’ now requires that an accused infringer benefits from all elements of the system claim in order to infringe. (*Intellectual Ventures I LLC v. Motorola Mobility LLC*, No. 2016-1795 (Fed. Cir. Sep. 13, 2017)). While concurring in part and dissenting in part, Judge Newman disagreed that an infringer must benefit from each and every individual claim element in order to infringe.

It will be interesting to watch the decisions that follow, to see whether system claims continue to provide enhanced enforcement opportunities relative to method claims for distributed processes or not.