

Sometimes, Being Methodical May Not be Enough

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It is common practice in patent applications for software implemented inventions to include patent claims of various types, such as method claims, computer readable media (CRM) claims, and system claims. The employment of such claim diversity in a patent application may facilitate a variety of useful outcomes in the areas of licensing, enforcement, invalidation attacks, and royalty bases. As noted in *Finjan v. Secure Computing Corporation et al. v. Secure Computing Corporation et al.*, 626 F.3d 1197 (Fed. Cir. 2009-1576, 1594 (2010) (precedential)), method claims may be problematic in some circumstances due to possible difficulties in determining whether or not an accused product infringes those method claims.

In *Finjan*, method claims, CRM claims, and system claims were all asserted by Finjan. Only the method claims required the performance of processes (“a computer based method comprising the steps of...[processes recited]...”). As the CRM claims and system claims were interpreted by the Court, those claims required only that an accused device be ‘capable of’ performing the recited processes. For example, the asserted CRM claims recited in part “A computer readable storage medium storing program code for causing...[performance of steps]...” Thus, the Court found that because the accused products included code that was executable to perform the processes recited in the asserted CRM/system claims, it made no difference, for the purposes of establishing infringement, that the processes had not actually been performed by the accused products. That is, the fact that the accused products were capable of performing the processes recited in the asserted CRM/system claims was determined by the Court to be sufficient to establish infringement. Notably, Finjan was unable to establish that the asserted method claims had been infringed. Thus, while method claims may be useful as part of a diverse claim set for a software implemented invention, overreliance on method claims could be problematic if the patent is ever asserted.

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