

Keywords: Negative claim limitations, claim construction, “such as” language, claim preamble

General: Silence on a topic is not enough to disclose absence of a claim feature.

International Business Machines Corp. v. Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
(2018-1066 Fed. Cir. 2019)
April 1, 2019 (Non-precedential)

I. Facts and Procedural History

IBM owns U.S. Patent No. 7,631,346, entitled "Method and System for a Runtime User Account Creation Operation Within a Single-Sign-On Process in a Federated Computing Environment" (hereinafter "the '346 patent"). At the behest of several companies, the U.S. Patent and Trademark Office (USPTO), acting as delegee of the USPTO Director Iancu, instituted two related inter partes reviews (IPRs) of various claims of the '346 patent. In the first IPR, the Board found that claims 1, 3, 12, 14, 15, and 18 are unpatentable because they are anticipated by Japanese Publication No. Tokkai 2004-302907A (hereinafter "Sunada"). In the second IPR, the Board found that claims 1, 3, 12, 13, 15, and 18 are unpatentable because they are anticipated by U.S. Patent No. 7,680,819 (hereinafter "Mellmer").

The disputes focuses on "federated computing environment" and "single-sign-on" claim limitations. The Board and the parties agreed that both phrases are limiting, even though the first phrase appears only in the preamble. The specification of the '346 patent states that "In the context of the present invention, a federation is a set of distinct entities, such as enterprises, organizations, institutions, etc., that cooperate to provide a single-sign-on..." (Emphasis added). The specification also states "A federation is a loosely coupled affiliation of enterprises which adhere to certain standards of interoperability..." (Emphasis added). The private parties agreed on a claim interpretation of "federated" to apply to "enterprises." The Board interpreted the "federated" more broadly, as applying to "entities." Using the broader interpretation, Sunada would disclose a "federated computing environment" because it teaches two computers (i.e., entities) within the same enterprise.

The Board construed "single-sign-on operation" to mean "a process by which a user is authenticated at a first entity and subsequently not required to perform another authentication before accessing a protected resource at a second entity." Mellmer teaches techniques for securely logging in to multiple sites with a single password and doing so from any machine on the network. More particularly, Mellmer describes a "DigitalMe" system that, for a user with a DigitalMe ID, eases access to various independent websites (DigitalMe partners) that participate in the system. The Board interpreted Mellmer's teaching to include that the user is not required to perform further authentication after a first login even though this was not explicitly stated by Mellmer. Under the Board's interpretation Mellmer would teach "single-sign-on" operations. The Board then found anticipation of the '346 patent in both the first and the second IPRs.

II. Issues

- 1) Did the Board err in finding the phrase "federated computing environment" to apply to entities as opposed to enterprises?
- 2) Did the Board err in finding the phrase "'single-sign-on operation" as being taught by Mellmer?

III. Discussion

1) Yes. The court noted that even though the term “etc.” was used in the specification stating that “a federation is a set of distinct entities, such as enterprises, organizations, institutions, etc.” it is clear within the context of the specification that “federation” would only apply to things of a type similar to those listed. The court listed as examples that would fit the type things such as ventures, other establishments, firms, and the like. Under this interpretation it would be overbroad to include computers (e.g., entities) in the list of things of a similar type to “enterprise.” More specifically, the court stated “We have recognized that “such as” and “etc.” sometimes have just that meaning. (“rule of ejusdem generis).” That understanding would only be reasonable given the plain meaning of the terms in the list. Finally, the court noted that the specification defined the term federated as including enterprises and that the Board used the definitional passage but altered the term enterprises for entities. The court found that the definition demands that the term federated computing environment be construed as set forth in the definition unless something else in the specification contradicts its plain meaning. The portions of the specification that recited entities did not operate to contradict the plain meaning of the definition provided for federated. Accordingly, the court vacated the decision by the Board.

2) Yes. The Federal Circuit looked at the claim language’s negative limitation of “not required to perform another authentication before accessing a protected resource at a second entity” and decided that silence in the prior art does not disclose the negative limitation. More specifically, the Federal Circuit stated that “Even if the Board were correct that Mellmer is “silent”...that characterization would not alone support a finding that there was no user authentication action.... Silence in that sense would not by itself suffice for the Petitioner to meet its burden to prove, by a preponderance of the evidence, that there was no user authentication action in this scenario.” The Federal Circuit found that the Board unreasonably viewed Mellmer and took a login scenario in isolation and out of context. Once the context was added in order to understand the whole operation in more detail, substantial evidence did not support a finding that there is no user action triggering an authentication at the target site.

IV. Conclusion

When performing claim construction on formulation claims that include “such as”, “etc.”, in a list, one must look at the type of items in the list and not include items that would not be of the same type. When looking at prior art for a teaching of negative limitation, the prior art must include some teaching of the negative limitation, and silence alone does not suffice.