

Claims Incorporating Functional Language and a Means for Accomplishing the Function Must Supply a Related Structure for Doing So

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Synchronoss Tech., Inc. v. Dropbox, Inc., Appeal No. 19-2196 (Fed. Cir. Feb. 12, 2021)

The patentee appealed the district court's decisions that all asserted claims from three patents are either invalid under 35 U.S.C. § 112, paragraph 2, or not infringed. The accused infringer cross-appealed, asserting that all claims at issue are patent ineligible subject matter under § 101. The patents relate to technology for synchronizing data across multiple devices.

The Federal Circuit reviewed *de novo*, as patent eligibility under § 101 is ultimately a question of law, which may contain underlying issues of fact. First, some of the terms at issue, deemed indefinite by the district court, were phrases incorporating functional language with terms appended to them such as "user identifier module," "authentication module identifying a user coupled to the synchronization system," and "transaction identifier module." The Federal Circuit agreed that these terms were subject to 35 U.S.C. § 112, paragraph 6, because they recited pure functions and means for accomplishing those functions, but failed to supply an associated structure in the specification that a person of ordinary skill in the art would be able to recognize and associate with the corresponding claimed function. Second, some asserted claims were found to recite an impossibility, which patentee's expert conceded. Specifically, the claims that required "generating a [single] digital media file" that itself "compris[es] a directory of digital media files" were deemed nonsensical and impossible.

Accordingly, the Federal Circuit affirmed the district court's conclusions of invalidity under § 112 and non-infringement, and did not reach the question of patent eligibility.

Read the Federal Circuit's opinion [here](#).

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