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Federal Circuit Patent Bulletin: *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*

May 7, 2015

"A microprocessor or general purpose computer lends sufficient structure only to basic functions of a microprocessor. All other computer-implemented functions require disclosure of an algorithm."

On May 6, 2015, in *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, the U.S. Court of Appeals for the Federal Circuit (Prost,* Newman, Bryson) affirmed the district court's summary judgment that U.S. Patent No. 5,663,757, which related to software embodied in a local subscriber data processing station that operates in tandem with a television to interconnect various interactive features of the television, was invalid as indefinite. The Federal Circuit stated:

The parties agree that the claim terms at issue are all means-plus-function terms governed by 35 U.S.C. § 112 ¶ 6. . . . Means-plus-function claim limitations under § 112 ¶ 6 must satisfy the definiteness requirement of § 112 ¶ 2. The parties also agree that the functions claimed in the terms at issue are all performed by computer software. It is well-established that the corresponding structure for a function performed by a software algorithm is the algorithm itself. Accordingly, "[i]n cases involving a computer-implemented invention in which the inventor has invoked means-plusfunction claiming, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor."

[A] standard microprocessor can serve as sufficient structure for "functions [that] can be achieved by any general purpose computer without special programming." . . . . Taken in context, then, "special programming" does not denote a level of complexity. On this point, the district court erred in holding that "special programming" does not encompass commercially available off-the-shelf software. To the contrary, . . . "special programming" includes any functionality that is not "coextensive" with a microprocessor or general purpose computer. [In other words.] the general purpose computer becomes a special purpose computer when loaded with the special programming, so a general purpose computer or microprocessor no longer lends sufficient structure to the claim. . . . A microprocessor or general purpose computer lends sufficient structure only to basic functions of a microprocessor. All other computer-implemented functions require disclosure of an

algorithm. [T]he disclosure of a general purpose computer or a microprocessor as corresponding structure for a software function does nothing to limit the scope of the claim and "avoid pure functional claiming." As such, when a patentee invokes means-plusfunction claiming to recite a software function, it accedes to the reciprocal obligation of disclosing a sufficient algorithm as corresponding structure.

EON also argues that a microprocessor can serve as sufficient structure for a software function if a person of ordinary skill in the art could implement the software function. This argument is meritless. In fact, we have repeatedly and unequivocally rejected this argument: a person of ordinary skill in the art plays no role whatsoever in determining whether an algorithm must be disclosed as structure for a functional claim element. . . . EON's argument, identical to many we have previously rejected, "conflates the definiteness requirement of section 112, paragraphs 2 and 6, and the enablement requirement of section 112, paragraph 1." "Enablement of a device requires only the disclosure of sufficient information so that a person of ordinary skill in the art could make and use the device. A section 112 paragraph 6 disclosure, however, serves the very different purpose of limiting the scope of the claim to the particular structure disclosed, together with equivalents." Accordingly, "[t]he question before us is whether the specification contains a sufficiently precise description of the 'corresponding structure' to satisfy section 112, paragraph 6, not whether a person of skill in the art could devise some means to carry out the recited function."

In light of the foregoing discussion, resolution of this case is straightforward. The district court made explicit factual findings, based on expert testimony, that each of the eight claim terms at issue recited complicated, customized computer software. We see no clear error in any of the district court's factual findings, nor any error in the district court's ultimate conclusion of indefiniteness.