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Federal Circuit Patent Bulletin: *Cox Commc'ns, Inc. v. Sprint Commc'n Co.*

September 26, 2016

"[Where a claim term] does not discernably alter the scope of the claims, it is difficult to see how this term would prevent the claims . . . from serving their notice function under [35 U.S.C.] § 112, ¶ 2."

On September 23, 2016, in *Cox Commc'ns, Inc. v. Sprint Commc'n Co.*, the U.S. Court of Appeals for the Federal Circuit (Prost,* Newman, Bryson) reversed the district court's summary judgment that U.S. Patents No. 6,452,932, No. 6,463,052, No. 6,633,561, No. 7,286,561, No. 6,298,064, and No. 6,473,429, which related to voiceover-IP technology, were invalid as indefinite under 35 U.S.C. § 112, ¶ 2. The Federal Circuit stated:

Section 112 requires that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention." This provision strikes a "delicate balance" which recognizes that, although the definiteness requirement must tolerate "[s]ome modicum of uncertainty" as "the price of ensuring the appropriate incentives for innovation." Accordingly, "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."

This case presents a peculiar scenario: the sole source of indefiniteness that Cox complains of, "processing system," plays no discernable role in defining the scope of the claims. All of the asserted claims are method claims, and the point of novelty resides with the steps of these methods, not with the machine that performs them. "Processing system" is merely the locus at which the steps are being performed. The plain language of the claims proves this point: if claim 1 of the '3,561 patent (which the parties agree is exemplary for the control patents) were revised to remove the word "processing system," the meaning would not discernably change . . . .

If "processing system" does not discernably alter the scope of the claims, it is difficult to see how this term would prevent the claims (the remainder of which Cox does not challenge on indefiniteness grounds) from serving their notice function under § 112, ¶ 2. As *Nautilus* instructs, the dispositive question in an indefiniteness inquiry is whether the "claims," not particular claim terms, "read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." To be sure, we have generally acknowledged that an indefiniteness analysis under 35

U.S.C. § 112, ¶ 2 is "inextricably intertwined with claim construction."

Accordingly, the common practice of training questions of indefiniteness on individual claim terms is a helpful tool. Indeed, if a person of ordinary skill in the art cannot discern the scope of a claim with reasonable certainty, it may be because one or several claim terms cannot be reliably construed. Nevertheless, indefiniteness under § 112, ¶ 2 must ultimately turn on the question set forth by *Nautilus*: whether the "claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." Applied here, "processing system" does not prevent the claims from doing just that.

Cox nevertheless contends that "processing system" is indefinite because the asserted claims only describe it in functional terms. We disagree. Claims are not *per se* indefinite merely because they contain functional language. Further, Cox cannot complain that the specific functional limitations that describe the operation of the "processing system" in the asserted patents fail to provide sufficient clarity under *Nautilus*. . . . Indeed, the claims specify that the claimed functions are achieved through the use of the "processing system," which the parties agree is, as used in the context of the patents here, a general purpose computer. . . . Although the asserted patents describe the operation of the "processing system" in largely functional terms, the recited steps, read in light of the specification, provide sufficient detail such that a person of ordinary skill in the art would understand them with reasonable certainty.