

NAZOMI COMMUNICATIONS, INC. v. NOKIA CORP., Appeal No. 2013-1165 (Fed. Cir. January 10, 2014). Before Lourie, Dyk, and Wallach. Appealed from N.D. Cal. (Judge Whyte).

Background:

Plaintiff's claims recited a computer processor "capable of" processing specific types of software instructions in a certain manner. Defendants' devices include processors that do not have the associated software to perform those instructions, but could be programmed with such software.

The district court construed the claims to require a hardware *and* software combination (not just hardware alone) because they recite specific claim functionalities that cannot be practiced in hardware alone and require enabling software. As such, because Plaintiff's claims require the hardware to include the software, Defendants' hardware-only processors did not infringe. Plaintiff appealed.

Issue/Holding:

Did the district court err in determining that the asserted claims require a hardware and software combination rather than hardware alone? No, affirmed.

Discussion:

On appeal, the Federal Circuit agreed with the district court's construction as requiring both hardware and software. The Federal Circuit reasoned that because hardware cannot meet the claims' functional limitations in the absence of enabling software, "the claims are properly construed as claiming an apparatus comprising a combination of hardware and software capable of practicing the claim limitations."

In reaching this conclusion, the Federal Circuit distinguished cases involving "programmable" language where the claims cover hardware that *could be programmed* to perform the claimed functionality. In this case, the claims required that the processor be "capable of" executing the stated instruction sets. Since hardware alone cannot do that in the absence of enabling software, the only possibility was that the claims required both hardware and software.

Since Defendants' processors do not have the software required by the claims, the Federal Circuit affirmed the district court's judgment of non-infringement.