

EON CORP. IP HOLDINGS LLC v. AT&T MOBILITY, Appeal No. 2014-1392 (Fed. Cir. May 6, 2015). Before Prost, Newman, and Bryson. Appealed from D. Del. (Judge Andrews).

Background:

Eon sued AT&T for infringing claims of its patent, and AT&T moved for summary judgment on the basis that the claims of the patent were invalid. Eon's patent involved software embodied in a data processing station that included a number of computer-implemented means-plus-function elements.

The district court found that the specification of Eon's patent failed to disclose an algorithm to provide structure for the various computer-implemented means-plus-function elements in the claims. As a result, the district court granted AT&T's motion for summary judgment, holding that all of the claims of Eon's patent were invalid as indefinite. Eon appealed.

Issue/Holding:

Did the district court err in holding that Eon's patent claims were invalid for indefiniteness? No, affirmed.

Discussion:

On appeal, the parties agreed that all the means-plus-function terms in the patent claims were governed by 35 U.S.C. §112, sixth paragraph, and thus, the means-plus-function terms must satisfy the definiteness requirement under 35 U.S.C. §112, second paragraph. The parties also agreed that the claimed functions were all performed by computer software.

In view of this, the Federal Circuit noted that the corresponding structure for a function performed by a software algorithm is the algorithm itself. The Federal Circuit further noted that in cases involving a computer-implemented method invoking means-plus-function claiming, it is required that the structure disclosed in the specification be more than a general purpose computer or microprocessor.

Eon did not dispute that its patent failed to disclose an algorithm while only disclosing a microprocessor; rather, Eon relied on an exception to the algorithm rule created in *In re Katz* and argued that the claimed functions do not involve special programming. *Katz* held that a standard microprocessor can serve as sufficient structure for functions that can be achieved by any general purpose computer without special programming. The Federal Circuit disagreed and found that the narrow *Katz* exception did not apply because the "control means" and "controlling" in Eon's patent claims could not be performed by a general purpose computer without any special programming.

The Federal Circuit further found that a microprocessor can serve as structure for a computer-implemented function only where the claimed functions are "coextensive" with a microprocessor. Borrowing from *Katz*, the Federal Circuit provided the functions of "receiving" data, "storing" data, and "processing," as examples of functions that are coextensive with a microprocessor. Because Eon's claimed functions required much more than these standard coextensive functions, the Federal Circuit held that a general purpose computer or the disclosed microprocessor of Eon's patent was insufficient to limit the claims to a particular structure. Thus, the Federal Circuit affirmed the district court's grant of summary judgment of invalidity for indefiniteness.