

COX COMMUNICATIONS v. SPRINT, Appeal No. 2016-1013 (Fed. Cir. September 23, 2016).
Before Prost, Newman, and Bryson. Appealed from D. Del. (Judge Robinson).

Background:

Sprint sued Cox for infringement of its method claims directed to Voice over internet Protocol technology.

However, Cox argued that the term "processing system" in Sprint's method claims was indefinite because Sprint's claim language and specification did not provide structural limitations for "processing system." The "processing system" limitation in the claims violates a core tenet of patent law, Cox argued: a "system" that "processes" could mean anything.

The district court agreed with Cox that "processing system," as used in Sprint's patent, is indefinite because "processing system" only describes the function it performs and, without any structural limitations disclosed in the patent, "it does not inform those skilled in the art about the scope of the invention with reasonable certainty," as required by *Nautilus*.

Accordingly, the district court held that Sprint's patents were invalid. Sprint appealed.

Issue/Holding:

Did the district court err in holding that the term "processing system" rendered Sprint's claims indefinite? Yes, reversed.

Discussion:

The Federal Circuit first stated that "claims are not *per se* indefinite merely because they contain functional language."

However, the Federal Circuit then stated that this case presents a "peculiar scenario" because the term "processing system" "plays no discernable role in defining the scope of the claims." The novelty of the invention lies in methods for transmitting phone calls over the internet, and if the claims of the patent removed the phrase "processing system," their meaning would be the same, according to the Federal Circuit.

The Federal Circuit stated that "[i]t follows then that, because it has little impact on this ultimate question, it would be difficult for 'processing system' to be a source of indefiniteness," concluding that the patent provides "sufficient detail such that a person of ordinary skill in the art would understand them with reasonable certainty." Thus, because "processing system" is inconsequential to the definiteness of the whole claim, the Federal Circuit asserted that the claims were not indefinite and reversed the district court's ruling.

Judge Newman concurred with the finding that the claims are not indefinite but sharply criticized the majority's analysis, which she said "is not in accordance with law and should be rejected." She argued that the ruling "creates an interesting, but flawed, new mode of analysis," whereby judges remove a challenged term from a claim and hold that if the claim means the same thing without it, the claim is not indefinite.