

It Is Improper To Read a Claim in a Grammatically Incorrect Way Simply To Include a Disclosed Embodiment

FEBRUARY 11, 2021

SIMO Holdings Inc. v. Hong Kong uCloudlink Network Technology Ltd. et al., 19-2411 (Fed. Cir. Jan. 5, 2021)

The patentee sued for infringement, asserting claims directed to apparatuses and methods for reducing roaming charges on cellular networks. At issue was whether the claims' preamble was limiting. The preamble recited a series of technological components, including "a plurality of memory, processors, programs, communication circuitry . . . and non-local calls database." If the preamble was limiting, then the inquiry became that the phrase "a plurality of" meant that the claimed invention requires a plurality of each of the listed components.

The parties cross-moved for summary judgment on infringement. The district court granted summary judgment to the patentee, and denied the alleged infringer's cross-motion. The district court reasoned that although the preamble was in fact limiting, the "plurality" phrase did not require a plurality of each of the listed components. The court found that "although grammatically appealing, [such a reading] would contradict the specification," which characterized the non-local calls database as an optional component. Following a jury determination of willful infringement, the alleged infringer appealed.

The Federal Circuit reversed the summary judgment rulings, concluding that the district court erred in its claim construction. The court found that "a plurality of" requires at least two of each of the listed items in the preamble's phrase. The district court's construction departed from traditional principles of grammar and was based on a misunderstanding of Federal Circuit precedent. While construing claims to encompass disclosed embodiments is generally favored, that rule is not absolute. For example, "we should not infer that any particular embodiment is included in a claim when there is probative evidence that sufficiently indicates the contrary." Here, the claim language and intrinsic evidence demonstrate that a particular embodiment is in fact excluded from the scope of the claim. Therefore, the Federal Circuit held that the patentee failed to show a triable issue of fact with respect to infringement and that under the correct claim construction, the alleged infringer was entitled to summary judgment of noninfringement.

Read the Federal Circuit's order [here](#).

Related Locations

Charlotte

Chicago

Los Angeles

Silicon Valley

Related Topics

Patent Litigation

Patent Infringement

Summary Judgment

Related Capabilities

Patent Litigation

Intellectual Property

Related Regions

North America

Related Professionals



David Enzminger



Ivan Poullaos



Mike Rueckheim



Danielle Williams