

ALERT

Federal Circuit Patent Bulletin: *Pacing Techs., LLC v. Garmin Int'l, Inc.*

February 19, 2015

"[W]here the patent includes a long list of different 'objects of the present invention' that correspond to features positively recited in one or more claims, it seems unlikely that the inventor intended for each claim to be limited to all of the many objects of the invention."

On February 18, 2015, in *Pacing Techs., LLC v. Garmin Int'l, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Lourie, Moore,* Reyna) affirmed the district court's summary judgment that Garmin did not infringe U.S. Patent No. 8,101,843, which related to methods and systems for pacing users during activities that involve repeated motions, such as running, cycling, and swimming. The Federal Circuit stated:

"Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim." However, "[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." That is the case here. . . . Because the preamble terms "user" and "repetitive motion pacing system" provide antecedent basis for and are necessary to understand positive limitations in the body of claims in the '843 patent, we hold that the preamble to claim 25 is limiting.

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The plain and ordinary meaning of the phrase "repetitive motion pacing system for pacing a user" does not require the claimed system to pace the user by playing back the pace information using a tempo. However, claim terms are construed in light of the specification and prosecution history, not in isolation. The specification and prosecution history compel departure from the plain meaning in only two instances: lexicography and disavowal. The standards for finding lexicography and disavowal are "exacting." To act as a lexicographer, a patentee must "clearly set forth a definition of the disputed claim term" and "clearly express an intent to define the term." Similarly, disavowal requires that "the specification [or prosecution history] make [] clear that the invention does not include a particular feature."

We have found disavowal or disclaimer based on clear and unmistakable statements by the patentee that limit the claims, such as "the present invention includes . . ." or "the present invention is . . ." or "all embodiments of the present invention are . . ." We have found disclaimer when the specification indicated that, for "successful manufacture," a particular step was "require[d]." We have found disclaimer when the specification indicated that the invention operated by "pushing (as opposed to pulling) forces," and then characterized the "pushing forces" as "an important feature of the present invention." We also have found disclaimer when the patent repeatedly disparaged an embodiment as "antiquated," having "inherent inadequacies," and then detailed the "deficiencies [that] make it difficult" to use. Likewise, we have used disclaimer to limit a claim element to a feature of the preferred embodiment when the specification described that feature as a "very important feature. . . in an aspect of the present invention," and disparaged alternatives to that feature. When a patentee "describes the features of the 'present invention' as a whole," he alerts the reader that "this description limits the scope of the invention."

Here, the specification similarly contains a clear and unmistakable statement of disavowal or disclaimer. In a section entitled "Summary and Objects of the Invention," the '843 patent states that "it is a principal object of the present invention to provide a computer-implemented, network-based system having a networked server, database, client computer, and input/output device for use by individuals engaged in repetitive motion activities . . ." It then lists 18 additional features, each time preceding the feature with the phrase "[i]t is another object of the present invention" or "[i]t is still another object of the present invention." This is a common practice in patent drafting. Many times, the patent drafter will cast certain features as "an object of the present invention," and often those "objects of the present invention" correspond to features recited in the claims. That is the case here, as many of the different "objects of the present invention" disclosed in the '843 patent are recited as features in one or more independent or dependent claims. The characterization of a feature as "an object" or "another object," or even as a "principal object," will not always rise to the level of disclaimer. In this case, where the patent includes a long list of different "objects of the present invention" that correspond to features positively recited in one or more claims, it seems unlikely that the inventor intended for each claim to be limited to all of the many objects of the invention. However, the '843 patent goes further, and includes additional language that constitutes unmistakable disclaimer when considered in the context of the

patent as a whole. Immediately following the enumeration of the different objects of the present invention, the '843 patent states that "[t]hose [listed 19 objects] and other objects and features of the present invention are accomplished, as embodied and fully described herein, by a repetitive motion pacing system that includes . . . a data storage and playback device adapted to producing the sensible tempo." With these words, the patentee does not describe yet another object of the invention—he alerts the reader that the invention accomplishes all of its objects and features (the enumerated 19 and all others) with a repetitive motion pacing system that includes a data storage and playback device adapted to produce a sensible tempo. In the context of this patent, this clearly and unmistakably limits "the present invention" to a repetitive motion pacing system having a data storage and playback device that is adapted to producing a sensible tempo.