



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***E-Pass Techs.
v.
3Com Corp.***

No. 02-1593
Federal Circuit
Aug. 20, 2003

"[The district court may not] limit claim language to exclude particular devices because they do not serve a perceived "purpose" of the invention."

On August 20, 2003, the Federal Circuit vacated and remanded the district court's summary judgment that 3Com did not infringe U.S. Patent No. 5,276,311, which related to a single electronic multifunction card encoding multiple credit card data. The Federal Circuit stated:

Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims "in view of the specification" without unnecessarily importing limitations from the specification into the claims. [I]n determining whether a statement by a patentee was intended to be lexicographic, it is important to determine whether the statement was designed to define the claim term or to describe a preferred embodiment.

[The district court reasoned] that the disclosed card is a functional replacement for a credit card; i.e., the devices (checking terminals) that accept single-purpose cards must interchangeably accept the disclosed card. [I]n order for this interchangeability to be possible, the disclosed card would necessarily have to comply with the ANSI standard, as that is the standard used to design "checking terminals" (including ATMs) that accept credit cards. This interpretation requiring interchangeability, however, is directly contradicted by the '311 patent Because embodiments of the disclosed card interface with checking terminals differently from the standard single purpose cards, it would not have been necessary for the disclosed card to share identical interface characteristics with the single purpose cards; i.e., the district court's premise that the electronic multi-function card must be accepted interchangeably with standard credit cards is not correct.

[T]he district court sought to limit the claims in light of the perceived purpose served by the invention; i.e., the court concluded that a bulky card could not be within the claim language because a bulky card would not serve the purpose of the invention. The court's task is not to limit claim language to exclude particular devices because they do not serve a perceived "purpose" of the invention. Rather, the district court's function is to interpret claims according to their plain language unless the patentee has chosen to be his own lexicographer in the specification or has clearly disclaimed coverage during prosecution. An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them.

Thus, the ordinary meaning of the word "card" here, as used in the phrase "electronic multi-function card," is the proper construction. Because the grant of summary judgment of no literal infringement was based upon an incorrect construction, the grant of summary judgment was not proper. [U]nder the correct construction of "card" in this context -- a flat rectangular piece of stiff material -- it may be or may not be that the accused Palm Pilot devices literally infringe. At this stage in the proceedings, however, we need not address and do not decide this issue.