



## TECHNOLOGY LAW UPDATE

*Free Motion Fitness,  
Inc.*  
v.  
*Cybox Int'l, Inc.*

No. 05-1006

Federal Circuit  
Sept. 16, 2005

*The presence of an undesirable prior art feature in addition to the elements recited in the claim, even when the undesirability of that feature formed the basis of an amendment and argument overcoming a rejection during prosecution, does not limit the claim unless there is a clear and unmistakable disclaimer of claim.*

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On September 16, 2005, the Federal Circuit vacated and remanded the district court's summary judgment that Cybox did not infringe U.S. Patents No. 6,238,323 and No. 6,458,061, which related to exercise equipment. The Federal Circuit stated:

The court must ensure that any reliance on dictionaries accords with the intrinsic evidence: the claims themselves, the specification, and the prosecution history. [T]he rule that "a court will give a claim term the full range of its ordinary meaning" does not mean that the term will presumptively receive its broadest dictionary definition or the aggregate of multiple dictionary definitions. Rather, in those circumstances where reference to dictionaries is appropriate, the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition.

[T]he district court held that the term "a cable linking" in the claims is limited to only a single cable. . . . Cybox admitted that the legal meaning of the term "a" suggests that the claim term "a linking cable" normally should be interpreted to mean one or more cables. That is correct. "[A]" or "an" in patent parlance carries the meaning of "one or more" in open-ended claims containing the transitional phrase "comprising." This convention is overcome only when "the claim is specific as to the number of elements" or "when the patentee evinces a clear intent to . . . limit the article." Cybox argues that here the presumption is overcome because the specification describes the cable as a "single cable." We disagree. The references to a single cable in the specification are found in the description of the preferred embodiments, and do not evince a clear intent by the patentee to limit the article to the singular. – [Thus,] "a cable linking" means "one or more cables linking." [T]he fact that the Cybox device has more than one cable does not show non-infringement.

[W]e need not address the overall availability of the doctrine of equivalents [but comment on] one aspect of [the] doctrine of equivalents analysis because the district court seemed to find a disclaimer of claim scope that could be equally applicable to literal and equivalent infringement. The district court held that Free Motion was estopped from claiming infringement under the doctrine of equivalents because, during prosecution of the '323 patent, the district court found that Free Motion disclaimed a device wherein the axes of rotation of the guide pulleys and extension arms were perpendicular. The district court held that the disclaimer applied to both patents because the '061 patent is a continuation of the '323 patent. . . .

The district court concluded that Free Motion was estopped to assert infringement by a device that – although including extension arms with axes of rotation substantially parallel to the pulleys – also has the undesirable features of [the prior art]. Basic patent law holds that a party may not avoid infringement of a patent claim using an open transitional phrase, such as comprising, by adding additional elements. The presence of an undesirable prior art feature in addition to the elements recited in the claim, even when the undesirability of that feature formed the basis of an amendment and argument overcoming a rejection during prosecution, does not limit the claim unless there is a clear and unmistakable disclaimer of claim scope. Here, there is no such disclaimer. The "comprising" language allows additional features. The disclaimer, if there was one, only applied to the "claimed assembly," not unclaimed features added to the patented device.