



Federal Circuit Finds Patent Not Infringed After Reversing Claim Construction That Violated “Grammatical Principles” to Cover All Embodiments

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The '689 Patent—owned by SIMO Holdings Inc. ("SIMO")—discloses a variety of apparatuses and methods for avoiding cell phone roaming charges. In 2018, SIMO asserted claim 8 of the '689 Patent against Hong Kong uCloudlink Network Technology Limited *et al.* (collectively, “uCloudlink”) in the Southern District of New York. At issue in the parties’ cross-motions for summary judgment on infringement was the preamble of claim 8, which reads:

A wireless communication client or extension unit comprising a plurality of memory, processors, programs, communication circuitry, authentication data stored on a subscribed identify module (SIM) card and/or in memory and non-local calls database, at least one of the plurality of programs stored in the memory comprises instructions executable by at least one of the plurality of processors for

While the parties agreed that the preamble is limiting, they disagreed on whether it requires a “non-local calls database.” SIMO argued that such a database was not required and, accordingly, did not offer any evidence in its motion or in response to uCloudlink’s motion that the accused products included that element. uCloudlink disagreed, arguing that the grammar and plain language of the preamble indicated that a “plurality of . . . non-local calls database[s]” was required and that its accused products did not include any such databases.

The district court agreed with SIMO and granted summary judgment of infringement. First, the district court held that the preamble is limiting because “the preamble is the only part that identifies the physical components of the apparatus.” Second, it explained that the preamble does not require a “non-local calls database” because the word “and” preceding

that language can and should be treated as “and/or.” The district court reasoned that —“although grammatically appealing”—considering the “non-local calls database” as non-optional would “contradict the specification” because the patent describes it as optional and includes embodiments with and without such a database. The district court relied heavily on *Oatey Co. v. IPS Corp.*, in which the Federal Circuit stated “where claims can reasonably [be] interpreted to include a specific embodiment, it is incorrect to construe the claims to exclude that embodiment, absent probative evidence [to] the contrary.” 14 F.3d 1271, 1276–77 (Fed. Cir. 2008) (brackets in original). After SIMO was awarded damages at trial, uCloudlink appealed.

On appeal, the Federal Circuit rejected the district court’s construction and reversed the infringement finding. As an initial matter, the court agreed that the preamble was limiting. It rejected, however, the district court’s interpretation of the preamble because Federal Circuit law and principles of grammar dictate that “modifier” phrases like “a plurality of” and “at least one of” generally apply to each component in a subsequent list—especially one that ends with “and” instead of “or.” Accordingly, the claim requires “a plurality of . . . non-local calls database[s].”

Additional claim language in and surrounding the list of components in the preamble confirmed to the court that the “plurality of” modifier applies to each component. For example, following the list, the preamble refers to “at least one of **the plurality of** programs” and “at least one of **the plurality of** processors,” which shows that “programs” and “processors”—and, by extension, the other listed components—were previously defined as “pluralities.” Moreover, according to another grammatical principle, the fact that no item in the list is preceded by an article (such as “a”) indicates that all items should be treated uniformly with respect to an initial modifier.

The Federal Circuit also explained that the district court interpreted *Oatey* too rigidly. *Oatey* explained that claims should be construed to cover an embodiment **only** when it is “reasonable” to do so and when there is no “probative evidence [to] the contrary.” But, while claims should generally cover an embodiment—particularly a preferred embodiment—**each** claim need not cover **every** embodiment. Here, (1) the claim language itself was probative evidence that embodiments lacking a “non-local calls database” were excluded from claim 8, (2) its construction does cover a disclosed embodiment, and (3) there was no preferred embodiment in the specification. In short, the Federal Circuit’s construction is consistent with the case law.

Finally, the Federal Circuit held that because *SIMO* did not address the correct interpretation, it failed to rebut as a matter of law uCloudlink’s assertion that the accused products do not infringe because they do not include a “non-local calls database.” Accordingly, instead of remanding the case, the Federal Circuit ordered the district court to enter a judgment of noninfringement.

Practice tip: *SIMO* demonstrates that a patent claim should, first and foremost, be construed according to its plain language. In particular, a claim should not be construed inconsistent with grammatical principles in an effort to cover each and every embodiment disclosed in a patent’s specification. Moreover, *SIMO* shows that a preamble of a claim will likely be held as limiting if it provides “structure” to the claim, regardless of whether doing so excludes certain embodiments. Finally, the case is a reminder that, when feasible, practitioners should address **all** competing and alternative constructions in their contentions and expert reports so as to avoid summary judgment if their proposed construction is not adopted.

SIMO Holdings Inc., v. Hong Kong uCloudlink Network Technology LTD, No. 19-2411 (Fed. Cir. Jan. 5, 2021).

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