In *Simo Holdings v. Hong Kong UCloudlink Network* (January 5), the Federal Circuit emphasized the outcome-determinative importance of grammar in claim construction (and of care in claim drafting).

Background: Facts & The Issue

The claim at issue recited, in relevant part: "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 . . . ." The issue was whether this poorly-crafted language required (a) two or more of the listed items, or (b) two or more of *each* of the listed items.

The accused device did not include a "local calls database," so under reading "(a)" it *might* infringe (*e.g.,* if it included two or more of any of the other listed items), but under reading "(b)" it definitely did *not* infringe.

The district court construed the claim per option "(a)" and a jury found infringement and awarded Simo a little over $8 million in damages. UCloudlink appealed.

Background: Relevant Black Letter Law

1. <u>Established meanings of particular words/phrases</u>.

    a. The phrase "a plurality of" means "the state of being plural,"[1] *i.e.,* "at least two."[2]

2. <u>Role of grammar in claim construction</u>.

    a. In general, "the grammatical structure and syntax" of claim language "may be instructive" regarding the meaning and scope of a claim.[3]

    b. Lists, series, and parallel constructions.

        i. In general, as a matter of interpretation of legal texts (*e.g.,* statutes, contracts, patents, etc.), prepositive and postpositive modifiers apply to the entire series – *i.e.,* absent an indication to the contrary (such as determiners preceding members of the series), parallel construction applies to the entire series.[4]

            1) *E.g.,* in the phrase "charitable institution or society," *charitable* modifies *both* institution and society.

            2) *E.g.,* in the phrase "the charitable institution or the society," *charitable* modifies only institution.[5]

        ii. Conjunctive joinder of the members of a list/series (*e.g.,* "x, y, *and* z"): Because the modifier preceding the list modifies each member of the list or series, "at least one of x, y, and z" means "at least one x *and* at least one y *and* at least one z." [6]

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[1] *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.,* 99 F.3d 1568, 1575 (Fed. Cir. 1996)(citing to AMERICAN HERITAGE DICTIONARY SECOND COLLEGE EDITION 955 (2d ed. 1982)).

[2] *ResQNet.com, Inc. v. Lansa, Inc.,* 346 F.3d 1374, 1382 (Fed. Cir. 2003); *August Technology Corp. v. Camtek, Ltd.,* 655 F.3d 1278, 1286 (Fed. Cir. 2011).

[3] *Credle v. Bond,* 25 F.3d 1566, 1571 (Fed. Cir. 1994); *SuperGuide Corp. v. DirecTV Enterprises, Inc.,* 358 F.3d 870, 886 (Fed. Cir. 2004)(applying grammar rules to claim construction); *see also* Antonin Scalia & Bryan A. Garner, READING LAW: THE INTERPRETATION OF LEGAL TEXTS § 17, 140-41 (2012)(herein "Scalia & Garner")(In legal writing, "[w]ords are to be given the meaning that proper grammar and usage would assign them" and explaining that although drafters of legal documents, "like other writers and speakers, sometimes perpetuate linguistic blunders, they are presumed to be grammatical in their compositions.").

[4] Scalia & Garner, § 19, p. 147; *SuperGuide,* 358 F.3d at 886 (citing to William Strunk, Jr. & E.B. White, THE ELEMENTS OF STYLE 27 (4th ed. 2000)).

[5] Scalia & Garner, § 19, p. 148 ("The typical way in which syntax would suggest no carryover modification is that a determiner (*a, the, some,* etc.) will be repeated before the second element.").

[6] *SuperGuide,* 358 F.3d at 886 ("Applying this grammatical principle here, the phrase 'at least one of' modifies each member of the list, *i.e.,* each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category; that is, at least one of a desired program start time, a desired program end time, a desired program service, and a desired

iii.   Disjunctive joinder of the members of a list/series (*e.g.,* "x, y, *or* z"): Although the modifier preceding the list modifies each member of the list or series, because of the disjunctive syntax the phrase "at least one of x, y, or z" means "at least one x *or* at least one y *or* at least one z." [7]

What *Simo Holdings* Adds or Changes:

The Federal Circuit reversed, holding that "a plurality of" requires "at least two of each of the listed items in the phrase at issue," including a plurality of "non-local calls databases."   Because the accused device did not have even a single non-local calls database, the court ordered that "[j]udgment of noninfringement shall be entered for uCloudlink."

This case does not change the law; rather, it provides a useful example of how the degree of care exercised in claim drafting can be outcome determinative (which is no small problem in light of the wide-spread use of low-cost, low-quality "patent mill" law firms and in-house patent departments).

Grammar.

The Federal Circuit cited the rule of the *SuperGuide* case as well as Strunk & White and Scalia & Garner, to determine that the phrase "a plurality of" applies to each of the members of the group of limitations introduced by that phrase.

- The court explained that, "[a]s *SuperGuide* makes clear, the principle has particular force when the term joining the items in a series is 'and.'" This is because a series joined in the disjunctive dissipates the effect of the grammar rule by making the members of the series independent alternatives (such that the grammar rule would only compel a plurality of the members of the disjunctive series to be present, rather than a plurality of each member as would be the case in a conjunctive series).

Context.

"Although context can affect the force of the more general form of the grammatical canon, *see* Scalia & Garner, Reading Law § 19, at 150, here context cements the canon's applicability in its particular *SuperGuide* form."

- First, the court cited the lack of an article (*i.e.,* a determiner) before the phrase "non-local calls database," which means that there is no "article negating the applicability of 'a plurality of' to each list item."

- Second, and what the court characterized as "decisive," the court cited "the words that come immediately after the list," which "make clear that the 'a plurality of' phrase applies to the individual items in the list, just as the *SuperGuide* canon indicates."

   o   For example, after the reference to the series that includes "non-local calls database," the claim recites "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: . . . ." By subsequently referring to "pluralities of" two of individual members of the series (albeit not "non-local calls database"), the claim itself confirms that at least those members of the series are independently subject to the "plurality" modifier.

   o   Because "SIMO has suggested no grammatical basis for reading a phrase like 'a plurality of' to apply to some but not other items in the list," the court determined that there was no basis for distinguishing the *SuperGuide* rule.

Care in Drafting.

The Federal Circuit expressly called out the poor drafting of the claim at issue: "To be sure, the mix of plural, singular, and mixed-use forms of words in the list following 'a plurality of' ('memory,' 'processors,' 'programs,' 'circuitry,' 'data,' 'database') leaves the phrase 'a bit of a mess grammatically.'" The court also explained that "SIMO had the obligation as the patent drafter to avoid . . . the textual sloppiness."

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program type."). *See also* Scalia & Garner, § 12, p. 116 ("Under the conjunctive/disjunctive canon, *and* combines items while *or* creates alternatives.").

[7]   *Superguide,* 358 F.3d at 886 (Fed. Cir. 2004)(explaining that a disjunctive list or series such as "in spring, summer, or winter" means "in spring, or in summer, or in winter."). *See also* Scalia & Garner, § 12, p. 116 ("Under the conjunctive/disjunctive canon, *and* combines items while *or* creates alternatives."). The disjunctive series could also be read as meaning "at least one of x or y or z," but there is no practical difference in this context. Note that *Markush* limitations are correctly drafted only by using particular syntax that takes them outside of the *SuperGuide* rule. *See, e.g.,* Sheldon, How To Write a Patent Application, §6.4.4, page 6-75 (PLI 2008).