

# In a patent claim, does 'one' or 'a' of something mean only one?

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Patent claims are supposed to be clear so that a competitor of the patent owner can reliably know whether or not its competing product infringes upon a patent.<sup>1</sup>

If a competitor's product contains each and every element recited in a claim, it literally infringes upon that patent claim. If even one element is not present in the competitor's product, the product does not literally infringe upon that patent claim.<sup>2</sup>

So if a claim says that element A is connected to *one* of elements B, C, D and E, is there literal infringement if element A is connected to *both* elements B and C; i.e., element A is connected to not one but two of the specified elements?

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## An applicant may disclaim a plural interpretation before the U.S. Patent and Trademark Office.

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Unfortunately, the answer is, it depends. The U.S. Court of Appeals for the Federal Circuit recently stated that the black letter law is the following: "Exceptions to the general rule that 'a' or 'an' [or one] means more than one arise only when 'the language of the claims themselves, the specification, or the prosecution history necessitate a departure from the rule.'" *Celgene Corp. v. Peter*, 931 F.3d 1342, 1350 (Fed. Cir. 2019).<sup>3</sup>

When do these sources necessitate such a departure? Summary judgment of noninfringement was granted where the claim specified a body coupled to a "respective one" of four identified components, but in the allegedly infringing product, the body was coupled to two of these components.

The Federal Circuit reversed, saying, "Nor are we persuaded that the asserted claim language explicitly requires that each elongated operator body be coupled to one and only one operator element. Nothing in the claim language compels that result. It is true that 'each' operator body must be coupled to 'a respective one' of the gripper, knotter, cutter, and cover. But that does not necessarily prevent an elongated operator body from being coupled to a second or even a third operator element as well."<sup>4</sup>

So the appellate court, reversing the trial court, found that "one" in this claim does not necessarily mean "only one." It could mean two or even three.

### THE LANGUAGE OF THE CLAIMS THEMSELVES

The claim structure itself is of utmost importance. For example, when the claim recites "comprising" a [or one] specific component, the law is clear that this language means that additional components may be included.<sup>5</sup>

The Federal Circuit recently explained: "The use of 'a' or 'an' in an open-ended 'comprising' claim connotes 'one or more.'" And "[t]he subsequent use of definite articles 'the' or 'said' in a claim to refer back to the same claim term does not change the general plural rule, but simply reinvokes that non-singular meaning."<sup>6</sup>

### THE SPECIFICATION

The court in the case quoted above about "respective one," stated: "At first glance, the term 'one' appearing directly after the phrase 'a respective' might be viewed as limiting. In this case, however, the specification substantiates a construction that allows for an elongated operator body to be operably coupled to one or more operator elements."<sup>7</sup>

In so finding, the court also relied on previous holdings that stated the general rule that "a" and "an" mean one or more of a specified element. For example, the court stated the following in the *KCJ Corp.* case:

This court has repeatedly emphasized that an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' in open-ended claims containing the transitional phrase 'comprising.' [Citations omitted.] Under this conventional rule, the claim limitation 'a,' without more, requires at least one.

The Federal Circuit has encountered "a" or "an" in patent claims on several occasions. It has uniformly applied the general rule for indefinite articles.

For instance, in *Abtox Inc. v. Exitron Corporation*, the court applied the rule and amplified it: "The written description supplies additional context for understanding whether the claim language

limits the patent scope to a single unitary [element] or extends to encompass a device with multiple [elements].”<sup>8</sup>

Moreover, standing alone, a disclosure of a preferred or exemplary embodiment encompassing a singular element does not disclaim a plural embodiment. “[A]lthough the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.” (*Electro Med. Sys. S.A. v. Cooper Life Sciences Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994)).

“Thus, as the rule dictates, when the claim language or context calls for further inquiry, this court consults the written description for a clear intent to limit the invention to a singular embodiment.”<sup>9</sup>

### THE PROSECUTION HISTORY

An applicant may disclaim a plural interpretation before the U.S. Patent and Trademark Office and thus lose the benefit of the customary meaning of indefinite articles in patent claims. See *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1220-21 (Fed. Cir. 1996). The court has stated that prosecution history also may assist claim interpretation.

Indeed, prosecution history “limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance.” *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).

Thus, in an appropriate case, the Federal Circuit has limited “one” to “only one” where the intrinsic evidence shows this is the proper construction. For example, in *Insituform Technologies Inc. v. Cat Contracting Inc.*, 99 F.3d 1098, 1106 (Fed. Cir. 1996), the claim language itself belied a singular meaning.

Thus, the court undertook an examination of all of the intrinsic evidence and held the following: “In light of the language found in the claims, specification and file history, we conclude the only correct and indeed the reasonable interpretation of claim 1 limits the scope of that claim to a process using only one vacuum cup which inherently creates a discontinuous vacuum.” *Id.*

In that case, the court restricted the claim to a singular interpretation because “the claim is specific as to the number

of elements (one cup) and adding elements eliminates an inherent feature (discontinuous vacuum) of the claim” *Id.*

### Notes

<sup>1</sup> *Markman v. Westview Instruments Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995). See also *Texas Digital Systems Inc. v. Telegenix*, 308 F.3d 1193, 1202 (Fed. Cir. 2002) (“The terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.”).

<sup>2</sup> *Mannesmann DeMag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279, 1282 (Fed. Cir. 1986)

<sup>3</sup> Quoting *Baldwin Graphic Systems Inc. v. Siebert Inc.*, 512 F.3d 1338 (Fed. Cir. 2008). The specification, the patent’s file history and the cited prior art comprise what the courts call “intrinsic evidence.”

<sup>4</sup> *Accent Packaging Inc. v. Leggett & Platt Inc.*, 707 F.3d 1318, 1326 (Fed. Cir. 2013)

<sup>5</sup> “Comprising” is open-ended in a claim. Conversely, “consisting of” and “consisting essentially of” are more restrictive. See e.g., *Invitrogen Corp. v. Biocrest Mfg. LP*, 327 F.3d 1364, 1368 (Fed. Cir. 2003) and *In re Gray*, 53 F.2d 549 (C.C.P.A. 1976).

<sup>6</sup> *Celgene Corp.*, 931 F.3d at 1350.

<sup>7</sup> *Accent Packaging Inc.*, 707 F.3d at 1326

<sup>8</sup> *Id.* at 1024, 122 F.3d 1019 (Fed. Cir. 1997).

<sup>9</sup> *KCJ Corp. v. Kinetic Concepts Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000).

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