PACING TECHNOLOGIES v. GARMIN INT'L. INC., Appeal No. 2014-1396 (Fed. Cir. February 18, 2015). Before Lourie, Moore and Reyna. Appealed from S.D. Cal. (Judge Benitez).

Background:

Pacing owned a patent related to systems for pacing users during activities having repeated motions, such as running and cycling, by providing a user with a tempo. Garmin sells fitness watches to and from which a user may transfer workouts via Garmin's website. Garmin's workouts display intervals to which a user may assign a target pace value. Based on Garmin's pacing system, Pacing sued Garmin for patent infringement.

Garmin filed a motion for summary judgment, arguing that Garmin's watches did not infringe the claims of Pacing's patent because Garmin's watches were not sensory playback devices, as construed by the district court. The district court agreed and granted the motion for summary judgment. Pacing appealed.

Issue/Holding:

Did the district court err in granting Garmin's motion for summary judgment of non-infringement? No, affirmed.

Discussion:

The district court made two pivotal claim constructions: (i) that the preamble was a limitation of the claim and was narrowly defined by the specification, and (ii) that the term "playback device" required a sensory playback, such as audio, video, or visible signals. The Federal Circuit agreed.

The Federal Circuit held that the "repetitive motion pacing system for pacing a user" recited in the preamble limited the claims because both the "system" and the "user" were recited in the bodies of the claims, and these terms relied on the preamble for antecedent basis. The Federal Circuit agreed with the district court's narrow construction of the term "repetitive motion pacing system" in light of the specification which included an "unmistakable disclaimer" that the various embodiments of the disclosed invention were accomplished by a repetitive motion pacing system that included a playback device ***adapted to produce a sensible tempo***. Although the court recognized that merely listing "an object of the present invention" will not always rise to a disclaimer requiring that the claimed invention achieve that object, the disclaimer in the specification at hand was clear. Specifically, the specification stated that "[the above objects of the invention are accomplished] by a repetitive motion pacing system that includes…a data storage and playback device adapted to producing the sensible tempo." The Federal Circuit found that this statement alerted the reader that the invention accomplished ***all*** of its objectives with a pacing system that produced a "sensible tempo." Because Garmin's watches did not produce a "sensible tempo" but merely displayed the workouts on the watch screens, the Federal Circuit held that summary judgment of non-infringement was proper.