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**Keywords:** limitation in preamble; claim interpretation

**General:** An element of a preamble is limiting when the element is recited in the body of the claim or the body of a claim dependent therefrom.

*Pacing Techs., LLC v. Garmin Int'l, Inc.*  
2014-1396 (Fed. Cir. Feb. 18, 2015).

## **I. Facts**

The patent at issue, U.S. Patent No. 8,101,843, relates to a repetitive motion pacing system configured to provide a user with a sensible tempo (e.g., via the beat of a song or flashes of light). The only independent claim asserted recites:

25. A repetitive motion pacing system for pacing a user comprising:  
a web site adapted to allowing the user to pre-select from a set of user-selectable activity types an activity they wish to perform and entering one or more target tempo or target pace values corresponding to the activity;  
a data storage and playback device; and  
a communications device adapted to transferring data related to the pre-selected activity or the target tempo or the target pace values between the web site and the data storage and playback device.

Pacing asserted the '843 patent against Garmin, alleging that Garmin GPS fitness watches infringe certain claims of the '843 patent. The Garmin fitness watches may be used in conjunction with Garmin Connect, a website that enables users to design a workout and upload the workout to the watch. The watch may display the actual pace, but does not provide the user with a sensible tempo.

The district court found that the preamble element "repetitive motion pacing system" is a limitation of the claim and interpreted "repetitive motion pacing system" to mean "a system for providing a sensible output for setting the pace or rate of movement of a user in performing a repetitive motion activity." Based on these findings, the district court granted Garmin's motion for summary judgment of non-infringement.

## **II. Issue**

1) Is the preamble element "repetitive motion pacing system" a limitation of independent claim 25 of the '843 patent?

2) Does the repetitive motion pacing system require playing back a sensible tempo?

## **III. Holding**

1) Yes. Because a dependent claim recites the repetitive motion pacing system in the body of the claim, the repetitive motion pacing system is a limitation of independent claim 25.

2) Yes. The specification disavows or disclaims any configuration in which the repetitive motion pacing system does not require playing back a sensible tempo.

## **IV. Discussion**

1)

Rules regarding preamble language: "Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim." However, "when

limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”

The preamble element “repetitive motion pacing system” of independent claim 25 establishes antecedent basis for the claim element “repetitive motion pacing system” in the body of dependent claim 28. Thus, the preamble element is “necessary to understand positive limitations in the body of claims in the ‘843 patent.”

28. The repetitive motion pacing system of claim 25, wherein the repetitive motion pacing system can determine a geographic location of the data storage and playback device.

2)

The specification discloses that “objects and features of the present invention are accomplished, as embodied and fully described herein, by a repetitive motion pacing system that includes . . . a data storage and playback device adapted to producing the sensible tempo.” Based on this disclosure, the court found that the repetitive motion pacing system “clearly and unmistakably” includes a data storage and playback device that is adapted to producing a sensible tempo.

## **VI. Conclusion**

Reciting an element from the preamble in the body of the claim or a claim that depends therefrom causes the preamble element to become a necessary element of the claim. As a result, the preamble element limits the claim.