



[ELBEX VIDEO, LTD. v. SENSORMATIC ELECTRONICS CORP.](#)

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2007-1097 DECIDED: November 28, 2007

JUDGES: Before DYK, MOORE and COTE

OPINION BY: MOORE

Procedural Posture:

Elbex Video, Ltd. (“Elbex”) appeals the District Court’s grant of summary judgment of non-infringement in favor of Sensormatic Electronics Corp. (“Sensormatic”), where part of the decision was based on prosecution history estoppel.

Overview:

The Federal Circuit provided a safety net against narrowing a patent’s scope based on arguments made during prosecution. The CAFC held that, while arguments made during prosecution history can limit the scope of patent coverage, those arguments cannot be interpreted such that the claimed invention would be inoperable.

Facts:

- Claim 1 of Elbex patent US 4,989,085, (“the ‘085 patent”), expressed in means plus function format, is directed to a closed circuit television (“CCTV”) apparatus comprising: “a plurality of remote-controlled television cameras for generating video signals and first code signals; receiving means for receiving said video signals and first code signals... said receiving means including a monitor for displaying images corresponding to the video signals received in said receiving means....”
- According to the specification, the function of the “receiving means” is to receive video signals and first code signals, and the structures thereof include an input line, a low pass filter, an interface and a television receiver or monitor. The specification does not disclose that the monitor of the receiving means receives first code signals and returns a corresponding code to the cameras. According to the specification, the low pass filter is solely to prevent the high frequency output signals (i.e. second code signals) of the controller device from passing.
- During prosecution of ‘085 patent, an inventor of the ‘085 patent stated that: “To ensure a no-error operation the camera generates a code signal, which is received

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by the monitor, based upon which, a code is sent back to the camera along with the control signal. Only coincidence of the original camera code and the code returned to the camera will allow the control signals to operate the camera. The principle of the present invention is, therefore a transmission of a code from the camera to the monitor of the receiving means and back to the camera.”

Also, the inventor made an additional statement in the same document that: “The Bellman reference fails to suggest that the code received by a display device is sent back to the camera along with the control signal and that the camera is operated by control signals only upon the coincidence of the original camera code with the code returned to the camera.” According to the specification, the term “display device” is equated to the term “receiving means”.

- Based on the inventor’s first statement, the District Court found that the inventor had limited the “receiving means” to a “monitor” during the prosecution. Based on this, the District Court held that summary judgment was appropriate because, in Sensormatic’s CCTV systems, no data (which means ‘first code signals’) is ever sent from the camera to the monitor.

Issue: Whether the inventor’s statement made during prosecution with respect to the scope of claim terms “receiving means” is a clear and unmistakable surrender of claim scope so as to be prosecution disclaimer.

Held: The Federal Circuit reversed, finding that said inventor’s statement did not amount to “a clear and unmistakable” surrender of claim scope as required by *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323, because, *inter alia*, surrender of claim scope in this case would leave the invention inoperable.

Analysis: The facts do not support a clear and unmistakable surrender of claim scope. There is an absence of support in the specification or drawings for a monitor that receives code signals from and returns code signals to the cameras, e.g., there is nothing in the specification to suggest that the first code signal ever reaches the monitor. The ambiguity created by other statements in the same prosecution document, e.g., the inventor’s other statement being present two paragraphs after the alleged disclaimer, is fully supported by the written description and provides further indication that the earlier statement in the same document was not a clear and unmistakable surrender. And the inoperability of a device constructed in accordance with the incorrect statement precludes

unmistakable surrender. Even if the monitor contained the necessary hardware to receive and generate a second code signal corresponding to the first code signal to be sent back to the cameras, which is not at all supported by the specification, the second code signals would not reach the camera since the low pass filter is positioned between the monitor and the cameras. The sole purpose of the low pass filter is to “prevent high frequency output signals, i.e., the second code signals” of the controller device 14 from passing. Hence, the second code signals would be filtered out before it ever reached the camera.

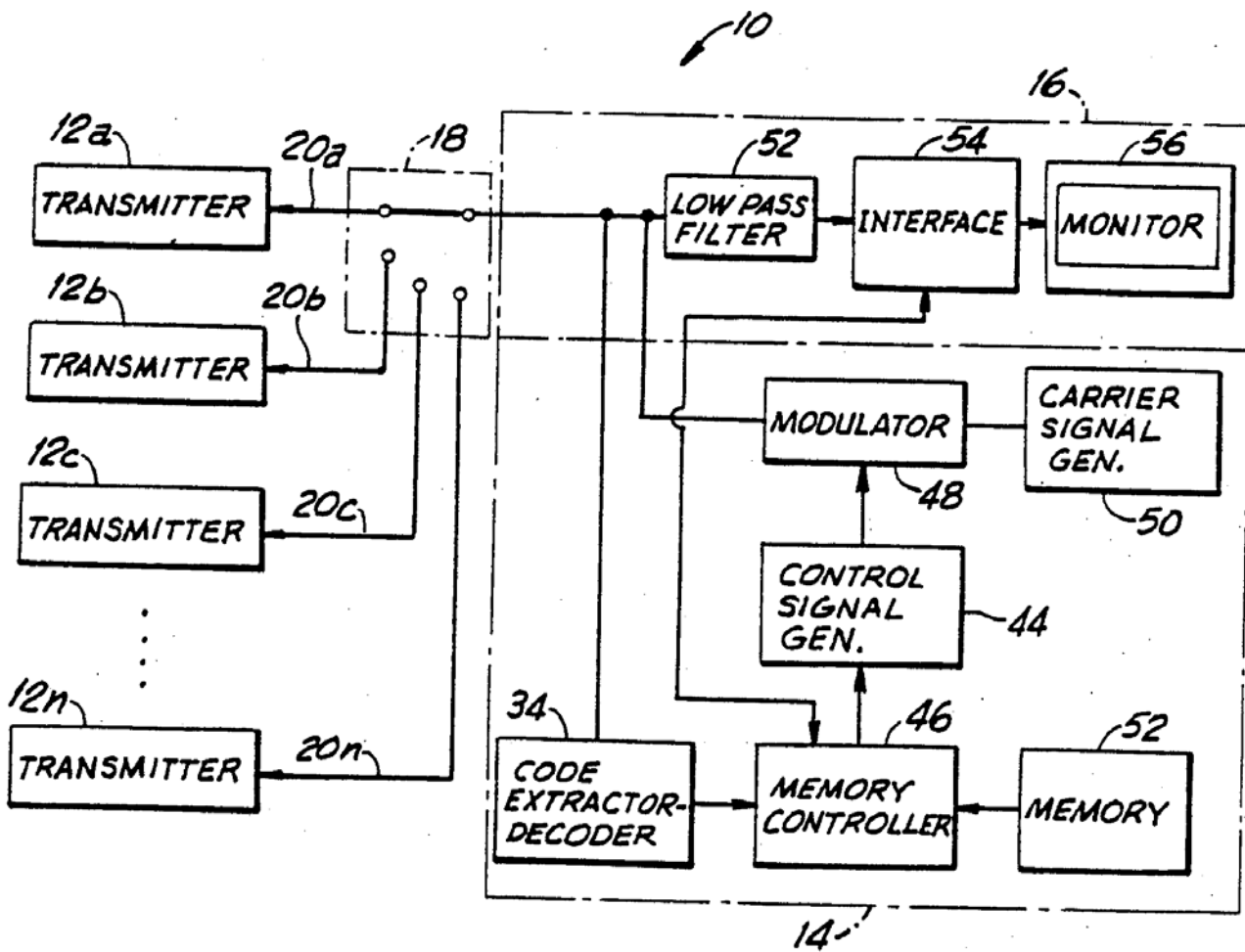


Fig. 1 of Elbex Patent