

**Summary of**  
**SuperGuide Corporation v. DirectTV Enterprises, Inc.**

By Lyle Kimms

In the past (and to some extent now), patent examiners routinely rejected claims that use the alternative expression “or.” For example, if a claim recited that “a main component of a bicycle frame includes element A, B, C, or D,” the examiners routinely rejected such a claim under 35 U.S.C. §112, second paragraph, as indefinite, because elements “A, B, C, or D” are in the alternative or are not equivalents. To avoid receiving such a rejection, patent practitioners routinely expressed the alternative members using the language “at least one of A, B, C, and D.” Such claim drafting practice was understood by the examiners and practitioners as encompassing A or B or C or D, or any combination of A-D. In other words, the segment “A, B, C, and D” was construed as a list and the segment “at least one of” was construed as modifying the entire list, not the individual members in the list. Not so according to the Federal Circuit, in *SuperGuide Corporation v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). The Federal Circuit decision changes the long-standing traditional meaning.

SuperGuide Corporation’s U.S. Patent No. 5,038,211 claims, in claim 1, an online television program schedule system having “first means for storing at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type.” In other words, it uses the traditional language “at least one of A, B, C, and D.” The trial court (District Court) interpreted this language as requiring storing each of the four criteria, namely storing at least one of A, at least one of B, at least one of C, and at least one of D. On appeal, the Federal Circuit affirmed.

The Federal Circuit, in affirming the lower court, cited the grammatical principle from *The Element of Style* (4th ed. 2000) by William Strunk, Jr. & E. B. White, that an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term. Applying this principle, the Federal Circuit affirmed that the phrase “at least one of” modifies each member in the list because the patentee used the term “and” instead of “or” to separate the category of list, going against well-established traditional meaning.

**Practice Tips**

If we need to recite multiple elements (A and B for example) in the alternative, we can using the following language:

- A or B;
- one of A or B;
- at least one of A or B;
- one of the following: A and B
- at least one of the following: A and B.

We can cite this case and explain that the amendment is to broaden the claim to avoid *Festo* presumption of estoppel.

But how do we deal with issued patents? If a patent is less than two years old, we can file a reissue, and cite this case as the reason for seeking a reissue. But for patents that are older than two years, we will be at the mercy of the courts, if indeed the remaining judges in the Federal Circuit will adhere to the interpretation decided in *SuperGuide*. We do note, however, that in determining what the phrase “at least one of” modifies, the Federal Circuit court considered the disclosure and found that each of the four categories contained subcategories. But if each of the categories in the list did not have subcategories, the Federal Circuit court may have concluded differently even though the grammatical principle applied in *SuperGuide* calls for otherwise. So one possible way to distinguish *SuperGuide* is to argue that the members in the list “A, B, C, and D” do not have subcategories, and that the traditional meaning should prevail.

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