

TOMTOM, INC. v. ADOLPH, Appeal No. 2014-1699 (Fed. Cir. June 19, 2015). Before Wallach, Hughes and Fogel (N.D. Cal., by designation). Appealed from E.D. Va. (Judge Ellis).

### Background:

Adolph is the inventor for a patent that covers a method and device for generating, merging and updating data that can be used to provide a mobile unit with current network, route and traffic information. Adolph's company accused TomTom of infringing its European patent, and filed a suit in Germany seeking damages and injunctive relief. Thereafter, TomTom filed a declaratory judgment action in district court, alleging that the U.S. patent was invalid as obvious and anticipated, and there was no infringement. The district court issued its claim construction opinion and based on the claim construction, TomTom moved for summary judgment and Adolph moved for reconsideration of the claim construction. The district court denied Adolph's motion, and entered a judgment of noninfringement in favor of TomTom. Adolph appealed.

### Issue/Holding:

Did the district court err in its claim construction of the following limitations: "method for generating and updating data" and "destination tracking system of at least one mobile unit"? Yes, reversed and remanded.

### Discussion:

The preamble of claim 1 recites, "[a] method for generating and updating data for use in a destination tracking system of at least one mobile unit comprising . . . ." The district court held that because "at least one mobile unit" provides antecedent basis for later use of the terms "said mobile unit" and "the mobile unit" in the body of the claim, the entire preamble must be construed. However, the Federal Circuit found that the entire preamble should not have been construed. Rather, the recitation, "method for generating and updating data for use in . . ." is language stating a purpose or intended use, and thus should not be considered a claim limitation.

The district court concluded that the recitation "destination tracking system of at least one mobile unit" disclaims methods performed on systems that (i) contain information relating to existing road networks, (ii) rely on an initial database, and (iii) require initial input of road data for operation. The district court made this conclusion because during prosecution, "Dr. Adolph overcame the . . . prior art by limiting claim 1 to a method that necessarily does not include an initial map database." Based on this, the district court construed the phrase to be "a destination tracking system of at least one mobile unit that does not contain initial information relating to existing road networks." Adolph argued that the court incorrectly interpreted the prosecution history, and should replace "does not contain" maps with "does not require" maps. The Federal Circuit found that during prosecution, Adolph did stress his assertion that a map is not required by stating "[t]he present invention allows even a single mobile unit to commence generating and storing data without the need for any initial information relating to existing road networks." The Federal Circuit concluded that there was no "clear and unambiguous" disclaimer that the tracking system does not contain an initial map database. Thus, the Federal Circuit construed the recitation "a destination tracking system of at least one mobile unit" to be "a destination tracking system of at least one mobile unit that does not require initial information relating to existing road networks."