United States Court of Appeals for the Federal Circuit

TOMTOM, INC.,
Plaintiff / Counterclaim Defendant-Appellee

v.

MICHAEL ADOLPH,
Defendant / Counterclaimant-Appellant

2014-1699

Appeal from the United States District Court for the Eastern District of Virginia in No. 1:12-cv-00528-TSE-IDD, Judge T. S. Ellis III.

Decided: June 19, 2015

BRIAN PANDYA, Wiley Rein, LLP, Washington, DC, argued for plaintiff/counterclaim defendant-appellee. Also represented by JAMES HAROLD WALLACE, JR., KARIN A. HESSLER, MATTHEW JAMES DOWD, GREGORY ROBERT LYONS.

ANTIGONE GABRIELLA PEYTON, Cloudigy Law PLLC, McLean, VA, argued for defendant/counterclaimant-appellant. Also represented by CLYDE E. FINDLEY.

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of data identified in claim 1 must be stored in a *different* storage device:

> As stated above, the patent specification makes clear that (i) traveled distance data is stored in a "trip storage unit or motion storage unit," (ii) section data is stored in a "section data storage unit," and (iii) the section data file is stored in the "section data file storage unit." Thus, the portion of TomTom's construction that clarifies that each type of data is stored in a different storage device is the correct construction.

Opinion at 27 (referencing '836 patent col. 9 ll. 21–25). Accordingly, "storing section data in the storage device" was construed by the district court to mean "storing section data *in a separate storage device than the traveled distance data*," and "storing the section file data in the storage device" was construed as "storing the section data file *in a separate storage device than the traveled distance data and section data*." Opinion at 27–28 (emphases added). These constructions were erroneous.

As an initial matter, this court has repeatedly cautioned against importing limitations from an embodiment into the claims. *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) ("While we read claims in view of the specification, of which they are a part, we do not read limitations from the embodiments in the specification into the claims. We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances: lexicography and disavowal.") (citing *Liebel–Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904 (Fed. Cir. 2004); *Thorner v. Sony Computer Entm't Am. LLC,* 669 F.3d 1362, 1365 (Fed. Cir. 2012)).

"The starting point for any claim construction must be the claims themselves." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). As

noted, claim terms are generally given their plain and ordinary meanings to one of skill in the art when read in the context of the specification and prosecution history; the only exceptions to this general rule are when the patentee acts as his own lexicographer or when he disavows claim scope. *Golden Bridge*, 758 F.3d at 1365. Here, claim 1 requires section data to be stored in "*the* storage device." '836 patent col. 17 l. 45 (emphasis added). Claim 1 also requires the section data file to be stored in "*the* storage device." *Id.* col. 17 l. 52 (emphasis added). "*The* storage device" can only refer to one thing: the "at least one storage device" found in the first limitation of claim 1. *Id.* col. 17 ll. 38–39 (emphasis added). Nothing in the claim language suggests the section data and the section data file would be stored in any storage device other than "*the* storage device." *Id.* col. 17 l. 45 (emphasis added). Certainly, the claims do not *require* the data be stored on different devices.

Additionally, the specification discloses the different data types can be stored in the *same* storage device, contrary to the district court's interpretation. In explaining how one could interrupt the generation of both traveled distance data and section data if any of that data already exists in the storage unit, one portion of the specification recites:

> To avoid unnecessar[ily] overburdening *the storage device* provided in the mobile unit, additional provisions can be made to permit the generation of *traveled distance data and/or section data* to be interrupted if the newly generated data already exist in *the storage device* of the mobile unit, and to cause said generation to be restarted if the newly generated data have not yet been stored in *the storage device* of the mobile unit.

Id. col. 4 ll. 6–13 (emphases added).

Therefore, these terms should be construed to reflect their plain and ordinary meaning: "storage device" means "storage device." It does not mean the claimed invention must use a different storage device for each type of data, as all three types of data can be stored on the same storage device as described in claim 1.

CONCLUSION

For the reasons set forth above, the appealed constructions of the district court are reversed, and the case is remanded for proceedings not inconsistent with this opinion.

REVERSED AND REMANDED