

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

GARMIN LTD. and
GARMIN CORPORATION,

Plaintiffs,

ORDER

v.

06-C-0062-C

TOMTOM, INC.,

Defendant,

TOMTOM, INC. and
BALDIVI B.V.,

Counterplaintiffs,

v.

GARMIN LTD.,
GARMIN CORPORATION, and
GARMIN INTERNATIONAL, INC.

Counterdefendants.

Plaintiffs Garmin Ltd. and Garmin Corp. have filed a motion for reconsideration of the order on claim construction, Aug. 24, 2006 Op. and Order, dkt. #65. In their motion, plaintiffs ask the court to reconsider its construction of the eighth subpart of claim 1 in defendant TomTom, Inc.'s U.S. Patent No, 5,550,538, which states:

said second means for selecting including second computing means for computing an optimal restoration route from a plurality of restoration routes each extending from said present position to one of said first plurality of marked points disposed between a deviation point and said destination.

In the August 24 opinion and order, I concluded that the corresponding structure for the underlined portion of the claim is:

A microcomputer 1 with associated software instructions to perform one or more of the following steps and select an optimal restoration route: 1) compute the optimal restoration route from a plurality of restoration routes, each extending from the present position to one of a group of selected marked points between the deviation point and the destination which are nearer to the present position than the other marked points; 2) compute the optimal restoration route from a plurality of restoration routes from the present position to one marked point between the deviation point and the destination that is spaced at a distance from another marked point that is nearest to the present position; 3) compute the optimal restoration route from a plurality of restoration routes from the present position to one marked point between the deviation point and the destination that is spaced at a distance from the deviation point; 4) compute the optimal restoration route from a plurality of restoration routes, each extending from the present position to one of a group of selected marked points which are within a specified distance from the marked point that is nearest to the present position; and 5) compute the optimal restoration route from a plurality of restoration routes, each extending from the present position to one of a group of selected marked points which are within a specified distance from the deviation point.

I adopted this construction because it “encompasses each of the corresponding structures

disclosed in the various embodiments in the specification.” Dkt. #65, at 70-71.

In their motion for reconsideration, plaintiffs offer a substantially different construction, but the only asserted error they point to in the court’s construction is that it does not require that each restoration route end at different marked points. Instead, each of the five structures described involves restoration routes that extend to “one marked point” or “one of a group of selected marked points.” According to plaintiffs, this construction was disclaimed by the inventors during the patent’s prosecution. Dkt. #67, at 6 (citing Rheox, Inc. v. Entact, Inc., 276 F.3d 1319, 1325 (Fed. Cir. 2002)).

Plaintiffs’ position is a curious one because some of the language they object to is almost identical to the language of the claim itself. The claim discloses “a plurality of restoration routes each extending from said present position to one of said first plurality of marked points.” The court’s construction refers to “a plurality of restoration routes, each extending from the present position to one of a group of selected marked points.” The only difference is that the court’s construction refers to a one of a “group” of “selected” marked points instead of one of a “plurality” of “said” marked points. Thus, to the extent that plaintiffs are arguing that the court’s construction is inconsistent with statements made during prosecution history, they are also arguing that the claim itself contradicts these statements. Although statements made during prosecution history can *limit* the meaning of a claim, plaintiffs cite no authority for the proposition that such statements may *override* the

actual claim language when there is a contradiction. This is not surprising, as giving priority to statements buried in the prosecution history over the language of the patent itself would undermine the public notice function of the claims in a perverse manner. PSC Computer Products. v. Foxconn International, 355 F.3d 1353, 1359 (Fed. Cir. 2004) (discussing importance of public notice function of patents).

In any event, the statements plaintiffs point to do not “clear[ly] and unmistakab[ly]” disclaim the construction adopted by the court, as they must if they are to limit the meaning of the claim. SanDisk Corp. v. Memorex Products, Inc., 415 F.3d 1278, 1287 (Fed. Cir. 2005). “An ambiguous disclaimer . . . does not advance the patent's notice function or justify public reliance, and the court will not use it to limit a claim term's ordinary meaning.” Id.

Plaintiffs rely primarily on the following statement: “Applicant’s invention has, in its marked points, multiple possible destinations, from which one is chosen as the restoration point.” Dkt. #56, Ex. V, File History of the ‘761 Application, Amendment, May 10, 1994, at 8. This statement does not state unequivocally that the inventors disclaimed restoration routes that end at the same point. Plaintiffs point to the phrase “multiple possible destinations,” but the use of the adjective “possible” negates plaintiffs’ argument. Any marked point is a “possible” destination. The inventors did not say that each restoration route goes to a different point; they said only that there are available for consideration a

plurality of marked points, or possible destination points, any one of which could be the actual restoration point. Again, this statement is little different from the claim language itself, which discloses restoration routes that extend to one of “a plurality of marked points.”

The other statement plaintiffs point to is no more helpful. Plaintiff cites a comment by the patent examiner regarding a potential amendment to the claims “to include computing restoration routes from present position to a plurality of marked points.” Even if the examiner’s statement could be imputed to the inventors, I cannot conclude that the inventors disclaimed anything through a discussion about possible amendments to a claim. In that case, what is or is not disclaimed is determined by the final version of the claim language, not by previous speculation on what the claims might be amended to state. Here, nothing was disclaimed because it is undisputed that the language of the claim is broad enough to encompass the court’s construction in the August 24 order.

Plaintiffs have not persuaded me that I erred in the construction of these terms. The

motion for reconsideration will be denied.

ORDER

IT IS ORDERED that the motion filed by plaintiffs Garmin Ltd. and Garmin Corporation for reconsideration of the August 24, 2006 Opinion and Order is DENIED.

Entered this 17th day of October, 2006.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge