

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF
CALIFORNIA

Omnitracs, LLC v. Motive Technologies, Inc.

Omnitracs · No. 23-cv-05261-RFL · Decided April 23, 2025

SUMMARY

The United States District Court for the Northern District of California held that the phrase "configured to be mounted in a vehicle" in the preamble of Claim 1 of the '253 patent is not a claim limitation. The court concluded that the claim describes a structurally complete invention without the phrase and that the phrase merely states the intended use of the vehicle event recorder system.

CASE DETAILS

COURT	United States District Court for the Northern District of California
WRITING FOR THE COURT	Rita F. Lin
JURISDICTION	United States District Court for the Northern District of California
DECIDED	April 23, 2025
DOCKET	23-cv-05261-RFL
DISPOSITION	other
PROCEDURAL POSTURE	Claim construction order issued during argument concerning jury instructions in a patent infringement action.
PRECEDENTIAL VALUE	unknown

TOPICS

- patent law
- patent infringement
- intellectual property
- commercial litigation

PRACTICE AREAS

- patent law
- patent infringement
- intellectual property
- commercial litigation

QUESTIONS PRESENTED

- Whether the phrase "configured to be mounted in a vehicle" in the preamble of claim 1 of the '253 patent is a claim limitation.

HOLDINGS

1. The phrase "configured to be mounted in a vehicle" does not limit the claims because claim 1 describes a structurally complete invention without that phrase and the phrase merely states the intended use of the claimed system.

KEY QUOTATIONS

“A preamble is not regarded as limiting, however, “when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.””

“Instead, the clause at issue describes the purpose or intended use of the invention—that is, the system is “configured to be mounted in a vehicle.””

FACTUAL BACKGROUND

Claim 1 of the '253 patent claims a vehicle event recorder system containing components including a camera, memory, sensors, and a controller. Its preamble states that the system is "configured to be mounted in a vehicle," and the parties disputed whether that phrase limited the claim.

PROCEDURAL HISTORY

The parties asked the district court for the first time during argument concerning jury instructions to determine whether the phrase "configured to be mounted in a vehicle" in the preamble of claim 1 of the '253 patent was a claim limitation. The court held that the phrase was not limiting and issued a corresponding jury instruction.

DISPOSITION

other

CASES CITED

- Am. Med. Sys., Inc. v. Biolitec, Inc., 618 F.3d 1354, 1358 (Fed. Cir. 2010)
- Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808-09 (Fed. Cir. 2002)
- Arctic Cat Inc. v. GEP Power Prods., Inc., 919 F.3d 1320, 1329 (Fed. Cir. 2019)

OPINION

Omnitracs, LLC v. Motive Technologies, Inc.

PER CURIAM.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OMNITRACS, LLC, et al., Case No. 23-cv-05261-RFL Plaintiffs,

CLAIM CONSTRUCTION ORDER

v. RE: PREAMBLE OF CLAIM 1 OF

THE '253 PATENT

MOTIVE TECHNOLOGIES, INC.,

Re: Dkt. No. 460 Defendant. The preamble of Claim 1 of the '253 Patent states that what is claimed is “[a] vehicle event recorder system configured to be mounted in a vehicle, the vehicle event recorder system comprising” the various claimed elements. '253 Patent, cl. 1. During argument concerning jury instructions, the parties requested for the first time that the Court determine whether the phrase “configured to be mounted in a vehicle” is itself a claim limitation. For the reasons below, the Court concluded that the phrase does not limit the claims, and issued a corresponding jury instruction. “Generally, . . . the preamble does not limit the claims.” *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010). A preamble may be construed as limiting “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). A preamble is not regarded as limiting, however, “when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.” *Id.* at 809. Here, the claim would still describe a structurally complete invention if the clause at issue were deleted from the claim, and the claim instead read: “A vehicle event recorder system comprising: a camera....” Specifically, the claim describes the “vehicle event recorder system” that contains the components listed in the limitations, such as the camera, memory, sensors, and controller. '253 Patent, cl. 1. Nothing in the remaining limitations contains an antecedent reference to the preamble. Nor has Motive identified anything in the specification or prosecution history that would require treating the preamble as limiting. Instead, the clause at issue describes the purpose or intended use of the invention—that is, the system is “configured to be mounted in a vehicle.” That is directly analogous to *Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1329 (Fed. Cir. 2019). There, when the preamble recited a “power distribution module for a personal recreational vehicle,” the phrase “personal recreational vehicle” was not limiting, because the preamble simply stated the intended use. *Id.* The same logic applies to the preamble at issue here. IT IS SO ORDERED. Dated: April 23, 2025
RITA F. LIN

United States District Judge