

Keywords: “includes”; doctrine of prosecution disclaimer; judicial estoppel

General: Language of claims directed to “flash” computer memory system that “includes” array of memory cells “partitioned into a plurality of sectors” does not require that every memory cell within device be grouped into sector that is partitioned into “user data” and “overhead data” portions, since term “includes” is equivalent to “comprising,” and thus does not foreclose additional elements that need not satisfy stated claim limitations.

SanDisk Corp. v. Memorex Products Inc.
75 U.S.P.Q.2d 1475 (Fed. Cir. 2005)
Decided July 8, 2005

I. Facts

SanDisk owns U.S. Patent No. 5,602,987 (“the ‘987 patent”), which is directed to flash EEprom systems. More specifically, the ‘987 patent is directed to different ways of organizing the memory storage into “sectors” and allowing a user to select multiple sectors for simultaneous erase. The multi-sector erase function is faster and more efficient than prior art schemes that allow for a single sector to be erased with one operation, or for every single cell in the EEprom to be erased in a single operation. The ‘987 patent is further directed to “partitioning” the sectors into “user data” and “overhead data.” The user data refers to the actual data to be stored, while the overhead data refers to administrative information such as address information, memory cell defect maps, error correction code, etc. Independent claims 1 and 10 each recite:

A method of operating a computer system *including* a processor and a memory system, wherein the memory system *includes* an array of non-volatile floating gate memory cells partitioned into a plurality of sectors that individually include a distinct group of said array of memory cells that are erasable together as a unit, comprising:

. . .

partitioning the memory cells within the individual sectors into at least a user data portion and an overhead portion . . .

In 1998, SanDisk brought an infringement suit against Lexar for infringement of claims 1 and 10 of the ‘987 patent. The trial court issued a claim construction order interpreting the user data and overhead data portions to require that “each non-volatile memory sector must have at least one user data portion and one overhead data portion, but is not limited to only one data user portion and only one overhead data portion.” SanDisk eventually obtained judgment of infringement against Lexar.

In October 2001, SanDisk brought suit against four flash memory system manufacturers, including Memorex, Ritek and Pretec. Among other things, SanDisk sought a preliminary injunction against the defendants based on the district court’s claim construction in the Lexar case. In denying the motion, the trial court asserted that SanDisk specifically limited its claims to include only those devices in which *each* sector within a memory cell array contains both overhead data and user data, and held that SanDisk could not now argue that only some of the sectors of the memory cell array need to contain user data and overhead data.

In September 2003, the District Court construed claims 1 and 10 to require that every cell in the memory device must be grouped into a sector and every sector must be partitioned into user and overhead data portions to infringe the claims. Although the trial court’s claim construction considered the claim language

in the written description, the court relied primarily on a finding of prosecution disclaimer. Specifically, the trial court held “that SanDisk clearly and unmistakably disclaimed coverage of systems in which only some of the sectors in the array were partitioned into at least user data and overhead portions.” With this interpretation in mind, the trial court entered summary judgment of non-infringement for each of the defendants. SanDisk appealed.

II. Issues

- A. Did the trial court err in its claim construction?
- B. Did the trial court err in the summary judgment of non-infringement?

III. Discussion

- A. YES. In finding that the trial court erred in its construction of the claims as requiring that every cell in the memory device be grouped into a sector and that every sector be partitioned into user and overhead data portions, the Federal Circuit looked in turn at (1) the plain language of the claims, (2) the specification, (3) the prosecution history and whether the doctrine of prosecution disclaimer applies in the instant case, and (4) whether the *Lexar* case gave rise to judicial estoppel with regard to the construction of the relevant claim terms.

Claims

After noting that the parties agreed and that the trial court correctly found that the preamble carries weight in the interpretation of claims 1 and 10 and thus, is limiting, the court agreed with SanDisk in finding that the trial court’s claim construction is not supported by the claim language of the independent claims. The Court held that the claims at issue only require that the claimed memory system contain *some* memory cells, grouped into sectors, partitioned into user and overhead data portions. Nothing in the claims precludes additional memory cell configurations in the system, which need not contain such partition sectors. The Court further noted that it is fully consistent with practicing the claimed invention to make additional, unclaimed use of flash EEPROM memory cells, so long as each limitation is satisfied. In so holding, the Federal Circuit noted that the memory system “includes” an array of “non-volatile floating gate memory cells” which are “partitioned into a plurality of sectors.” The claimed method requires “partitioning the memory cells within the individual sectors into at least a user portion and an overhead portion.” In citing prior Federal Circuit law, the Court reiterated that the term “includes” means the same as “comprising,” and thus that neither term forecloses additional elements that need not satisfy the stated claim limitation. Thus, the Court held that nothing in the plain language of the claims prevents the use of flash EEPROMs containing cells that are not grouped into partitioned sectors.

Specification

SanDisk further argued that the ‘987 patent specification is inconsistent with the trial court’s claim construction because it excludes at least two preferred embodiments. In short, the Federal Circuit agreed with SanDisk, which directed the Court to portions of the specification describing an embodiment wherein portions of the flash EEPROM memory would not be partitioned into user data and overhead data as required by the claims. In its brief to the Court, Ritek conceded that in accordance with the identified embodiment, the memory could contain sectors which are not partitioned. Since Ritek conceded this point and both Pretec and Memorex joined in Ritek’s argument, the Court concluded that there was no dispute left to resolve.

Prosecution History

The trial court held that SanDisk clearly and unmistakably disclaimed any method or device in which each of the flash EEPROM memory cells were not grouped into partitioned sectors. SanDisk argued that nothing in the prosecution history provides a clear and unmistakable disclaimer as found by the District Court. Once again, the Federal Circuit agreed with SanDisk. As explained by the Court, the doctrine of prosecution disclaimer precludes patentees from recapturing, through claim interpretation, specific meanings disclaimed during prosecution. The Federal Circuit quoted *Digital Biometrics, Inc. v. Identeks, Inc.* in stating that, “as a basic principle of claim interpretation, prosecution disclaimer promotes the public notice function of the intrinsic evidence and protects the public’s reliance on definitive statements made during prosecution.” The Court further noted that an ambiguous disclaimer, however, 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. Further, the Court reiterated that there is no “clear and unmistakable” disclaimer if a prosecution argument is subject to more than one reasonable interpretation, one of which is consistent with a proffered meaning of the disputed term.

Relying heavily on SanDisk’s statement that “each sector is partitioned into user data and overhead information,” the trial court concluded that SanDisk was referring to *every* sector. In disagreeing with Ritek’s construction and the trial court’s analysis, the Federal Circuit noted that the quoted passage begins with a proviso that “claims are directed to a flash EEPROM system.” If, when viewed in context, SanDisk used this passage to describe the memory cell array and, in particular, the claimed sector organization, there is no reason why that memory cell array or the discussion of it should be presumed to exhaust every cell on every EEPROM in the “memory system” recited in the claim preamble. Given the open language in the claims, there is no reason for the Court to read the prosecution argument with such a presumption in mind. Quite differently, the court stated that the reference to “each sector” means “each sector subject to the claimed method,” and no more. In short, the Federal Circuit concluded that SanDisk did not unmistakably surrender the grouping of flash EEPROM memory cells into non-partitioned sectors, and thus that no prosecution history estoppel exists with regard to the argued claim terms.

Judicial Estoppel

Judicial estoppel is an equitable doctrine that prevents a litigant from “perverting” the judicial process by, after urging and prevailing on a particular position in one litigation, urging a contrary position in a subsequent proceeding against one who relied on the earlier position. The Federal Circuit cited the Supreme Court in identifying factors guiding the decision to apply judicial estoppel: (1) the party’s later position must be “clearly inconsistent” with the earlier position; (2) the party must have succeeded in persuading a court to adopt the earlier position in the earlier proceeding; and (3) the court considers “whether the party seeking to assert an inconsistent position would derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped.” In short, the Federal Circuit agreed with SanDisk that the issue before the trial court in *Lexar* was whether the sectors subject to the claim 1 and claim 10 methods were limited to a single user and data portion, or whether those sectors could be further partitioned. Thus, the Court held that *Lexar* involved a different dispute concerning the claim terms. The Federal Circuit dismissed Ritek’s judicial estoppel argument in summarily applying the factors outlined by the Supreme Court.

- B. YES. Because the Federal Circuit held that the District Court relied on the erroneous claim interpretation in its finding of non-infringement, the Federal Circuit vacated the judgment and remanded for further proceedings.