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Intellectual Property Law

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Keywords: prosecution disclaimer; file wrapper estoppel

General: Through a clear and unmistakable disavowal in the prosecution history, a patentee may surrender certain claim scope to which the patentee would otherwise have an exclusive right by virtue of the claim language.

SpeedTrack, Inc. v. Amazon.com, Inc., et al.
U.S. Court of Appeals for the Federal Circuit
Case No. 2020-1573, 2020-1660
Decided June 3, 2021

I. Background

SpeedTrack, Inc. (“SpeedTrack”) owns U.S. Patent No. 5,544,360 (“the ‘360 patent”), which is directed toward a computer filing system for accessing files according to user-designated criteria. The ‘360 patent discloses that prior art systems employ a hierarchical filing structure where stored data is organized into files and directories that are analogous to file folders and hanging files in a paper filing system. According to the ‘360 patent, it may become cumbersome for a user to utilize such filing structures to locate data when a quantity of indexed files becomes large or file categories are not well defined. The ‘360 patent discloses a method that utilizes “hybrid folders” to allow “total freedom from the restrictions imposed by hierarchical and other present day computer filing systems.”¹ In particular, the ‘360 patent discloses that the method includes a three step process of creating a table of category descriptions without any predefined hierarchical relationship, creating a directory of files that includes a set of category descriptions for each file, and creating a search filter that allows a user to pick a set of categories to be searched, where the search filter only allows selection when there is at least one file that matches the selection.

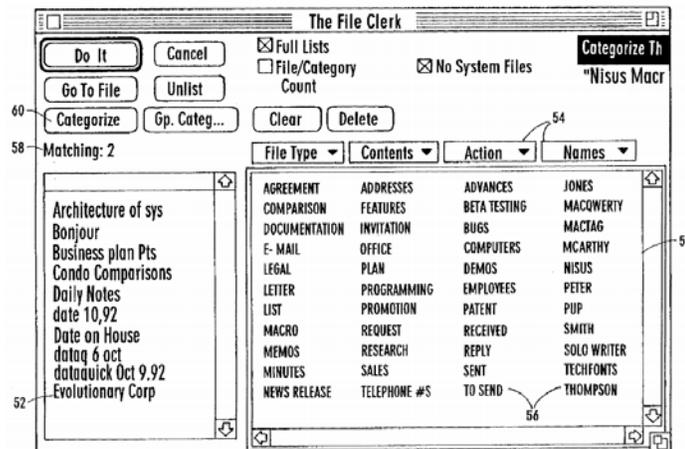


FIG. 5

¹ The ‘360 patent, col. 3, ll. 63-65.

Claim 1 of the '360 patent recites:

1. A method for accessing files in a data storage system of a computer system having means for reading and writing data from the data storage system, displaying information, and accepting user input, the method comprising the steps of:

(a) initially creating in the computer system a category description table containing a plurality of category descriptions, each category description comprising a descriptive name, *the category descriptions having no predefined hierarchical relationship with such list or each other*;

(b) thereafter creating in the computer system a file information directory comprising at least one entry corresponding to a file on the data storage system, each entry comprising at least a unique file identifier for the corresponding file, and a set of category descriptions selected from the category description table; and

(c) thereafter creating in the computer system a search filter comprising a set of category descriptions, wherein for each category description in the search filter there is guaranteed to be at least one entry in the file information directory having a set of category descriptions matching the set of category descriptions of the search filter.

During prosecution of the '360 patent, SpeedTrack amended claim 1 to clarify that the recited "category descriptions" have no predefined hierarchical relationship with respect to each other. SpeedTrack incorporated the aforementioned amendment to distinguish over U.S. Patent No. 5,047,918 ("Schwartz"), which SpeedTrack asserted is directed toward a conventional hierarchical file system in which file fields are defined in a first step and values associated with data files are entered into such file fields in a second step. Specifically, SpeedTrack asserted that, unlike Schwartz, "[n]o pre-existing or pre-defined hierarchical relationship must exist between category descriptions and the list of category descriptions, or between each other" in the '360 patent.²

In September of 2009, SpeedTrack sued various retail website operators, including Amazon.com, Inc. ("Amazon"), for alleged infringement of the '360 patent. The accused systems all include some genus-species or field-value relationships within their categories. The U.S. District Court for the Northern District of California ("the district court") initially adopted a proposed claim construction that lacked any reference to a field-and-value relationship, noting that the construction accounted for the disclaimers made during prosecution of the '360 patent. Following a motion by SpeedTrack, the district court concluded there was still a fundamental dispute about the scope of the claims and proceeded to further analyze the prosecution history of the '360 patent. Upon review, the district court concluded that SpeedTrack's prosecution history demonstrated clear and unambiguous disavowal of category descriptions being based on hierarchical field-and-value systems and issued a second claim construction order explicitly disclaiming predefined hierarchical field-and-value relationships from the scope of the recited "category descriptions." As such, the district court entered a final judgement of noninfringement. SpeedTrack timely appealed.

² SpeedTrack's response to Office Action filed March 17, 1995

II. Issue

Did the district court err in its claim construction of the '360 patent when finding noninfringement?

III. Discussion

No, the Federal Circuit found that the district court correctly interpreted the claims of the '360 patent in light of the statements filed by SpeedTrack during prosecution of the '360 patent.

Prior to its analysis, the Federal Circuit concluded that it is undisputed that Amazon does not infringe under the district court's clarified claim construction. Therefore, the Federal Circuit need only decide whether that claim construction is correct. In the analysis of SpeedTrack's prior statements during prosecution of the '360 patent, the Federal Circuit agreed with the district court's assessment that SpeedTrack had, in no uncertain terms, argued that Schwartz had a hierarchical relationship between fields and values that fell outside of the scope of the amended claims. Therefore, the amended claims exclude predefined field-and-value relationships, as correctly explained by the district court.

SpeedTrack interpreted the prosecution record differently, asserting that the category descriptions of the '360 patent are not equivalent to the fields of Schwartz and that the "hierarchical" limitation precludes predefined hierarchical relationships only among the category descriptions. The Federal Circuit was unpersuaded by SpeedTrack's argument, noting that SpeedTrack's interpretation would lead to the paradoxical result that the claims at issue cover hierarchical relationships between fields and values but not among values, even though Schwartz discloses that exact arrangement. Thus, SpeedTrack's interpretation would have been insufficient to distinguish over Schwartz. SpeedTrack further argued that the applicant distinguished over Schwartz on other grounds as well. In response, the Federal Circuit noted that an applicant's argument that a prior art reference is distinguishable on a particular ground can serve as a disclaimer of claim scope even if the applicant distinguishes the reference on other grounds as well.

IV. Conclusion

The Federal Circuit determined that the district court correctly interpreted the claim limitations of the '360 patent when determining noninfringement of Amazon. The Federal Circuit emphasized that the doctrine of prosecution disclaimer aims to ensure that claims are not construed in one way in order to obtain their allowance and in a different way against accused infringers.