

SPEEDTRACK, INC. v. AMAZON.COM, INC., Appeal Nos. 2020-1573, 2020-1660 (Fed. Cir. June 3, 2021). Before Prost, Bryson, and Reyna. Appealed from N.D. Cal. (Judge White).

Background:

Speedtrack owned a patent directed to a computer file access method that used categories and labels instead of a traditional hierarchical structure. In other words, prior computer filing systems used a directory/file approach with a hierarchy. On the contrary, according to the Speedtrack patent, a user would select a category description from a list and receive a list of matching file search results.

In order to overcome a prior art reference, Speedtrack added "the category descriptions having no predefined hierarchical relationship with such list or each other" to the claims during prosecution. The prior art reference in question allowed a user to enter values in various description fields for a file (e.g. entering an author name in an author field describing a file). Speedtrack argued that there was an inherent hierarchy between the field (e.g. author) and the value (e.g. author name) in the prior art. Speedtrack argued that in its method, the values could be associated with multiple fields, avoiding the hierarchy of the prior art reference. Speedtrack argued that the above added claim feature embodied this distinction over the prior art.

The district court held that Speedtrack's amendments and arguments during prosecution were a disclaimer of any system using category descriptions with a hierarchy between the field and the value. Based on this, the district court adopted a claim construction that both parties agreed precluded a finding of infringement. Speedtrack appealed.

Issue/Holding:

Did the district court err in finding that Speedtrack disclaimed an infringing claim construction during prosecution? No, affirmed.

Discussion:

The Federal Circuit held that in spite of the fact that there was no clear disavowal of the desired claim scope during prosecution, prosecution history estoppel did apply. Most importantly, the proposed claim construction that Speedtrack sought would have fallen within the scope of the prior art reference it distinguished over during prosecution. The Federal Circuit dismissed Speedtrack's argument that it had distinguished over the prior art reference on other grounds as well, citing legal precedent that this would not preclude a finding of prosecution history estoppel.

The Federal Circuit also pointed to Speedtrack's inconsistent statements concerning the claim scope during both prosecution and litigation. Based on these inconsistencies, the Federal Circuit maintained that Speedtrack had attempted to construe the claims in one way to obtain allowance, and another way against accused infringers. Accordingly, Speedtrack's actions had clearly fallen within the doctrine of prosecution history estoppel.