Published on *The National Law Review* https://natlawreview.com

What You Say Can and Will be Used Against You – Prosecution History and Prior Infringement Arguments

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Noting patent owner's prior litigation statements, the US Court of Appeals for the Federal Circuit upheld a district court ruling that a clear and unmistakable disclaimer in the prosecution history affected claim construction of an asserted patent. *SpeedTrack, Inc. v. Amazon.com, Inc.*, Case No. 20-1573 (Fed. Cir. June 3, 2021) (Prost, J.)

In 2009, SpeedTrack filed suit against various online retailers alleging infringement of its patent directed to a method for accessing files in a filing system leveraging "category descriptions" to aid in organizing the files. The patent describes associating category descriptions with files using a "file information directory." A "search filter" then searches the files using their associated category descriptions. A limitation that "the category descriptions hav[e] no predefined hierarchical relationship with such list or each other" was added during prosecution to overcome a prior art reference that leveraged hierarchical field-and-value relationships.

The district court initially adopted a proposed claim construction that lacked any reference to a field-and-value relationship, noting that the construction "account[ed] for the disclaimers made during prosecution." Following a motion by SpeedTrack, the court concluded there was still a fundamental dispute about the scope of the claim term. After further analyzing SpeedTrack's prosecution history, the court concluded that the history "demonstrate[d] clear and unambiguous disavowal of category descriptions 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 "category descriptions." SpeedTrack subsequently stipulated to noninfringement under the second claim construction and appealed.

On appeal, the Federal Circuit stressed that prosecution-history disclaimer can arise from both claim amendments and arguments. Here, the prosecution history showed that the applicants "repeatedly highlighted predefined hierarchical field-and-value relationships" as a difference between the prior art and the patent claims in no uncertain terms. That SpeedTrack distinguished the prior art on other grounds did not moot its disclaimer statements.

The Federal Circuit also noted that SpeedTrack argued in litigation against another defendant that the purpose of the amendment was to distinguish the category descriptions from attributes that "have a 'hierarchical' relationship between fields and their values." While the Court agreed with

SpeedTrack that such litigation statements were not a disclaimer on their own (since they were not the inventors' prosecution statements), these litigation statements further supported not accepting SpeedTrack's arguments. The Court reminded SpeedTrack that it has cautioned (in *Aylus* and *Southwall*) that "the doctrine of prosecution disclaimer ensures that claims are not 'construed one way in order to obtain their allowance and in a different way against accused infringers.'"

After assessing SpeedTrack's prior statements, the Federal Circuit considered whether the disclaimer was clear and unmistakable. The Court concluded it was. In rejecting SpeedTrack's argument that prior decisions not expressly finding disclaimer supported that prosecution statements were not clear and unambiguous, the Court noted the construction had not been fully considered in those judgments. Similarly, the Court rejected the notion that the district court's issuance of a second claim construction order showed there was no clear and unmistakable disclaimer—since the initial order accounted for the disclaimer, the second order clarified its effect, and both orders acknowledged the disclaimer.

Practice Note: Patent owners must be vigilant about statements made to the US Patent & Trademark Office during prosecution, and litigators should be mindful of their arguments. While statements may not rise to the level of prosecution-history disclaimer, they can weaken future arguments.

Rodney Swartz, a summer associate in the San Francisco office, also contributed to this case note.

National Law Review, Volume XI, Number 161