Keywords: **enablement; 35 U.S.C. § 112; anticipate; enable full scope of the claimed invention**

General: **The Court considers the extent to which patent claims should be interpreted to cover embodiments that are not enabled by the specification.**

Liebel-Flarsheim Company and Mallinckrodt, Inc., v. Medrad, Inc.
No. 06-1156,-1157 (Fed. Cir. 2007)
March 22, 2007

I. Facts

Liebel-Flarsheim Company and Mallinckrodt Inc. (collectively "Liebel") appeal from a district court decision granting Medrad's motion for summary judgment that four of Liebel's patents are invalid under 35 U.S.C. § 112 and 102. The four patents include U.S. Patent No. 5,456,669 ("the '669 patent), U.S. Patent No. 5,658,261 ("the '261 patent"), U.S. Patent No. 5,662,612 ("the '612 patent"), and U.S. Patent No. 5,928,197 ("the '197 patent"). The '669 and '261 patents (hereinafter "the front-loading patents") share a common specification and are directed to a front-loading fluid injector with a replaceable syringe capable of withstanding high pressures for delivering a contrast agent to a patient. The '612 and '197 patents (hereinafter "the syringe-sensing patents") share a common specification and are directed to a computer-controlled injector wherein a motor advances and retracts a plunger located within the syringe.

Regarding the front-loading patents, the claims in the originally-filed application explicitly recited a pressure jacket in front of the syringe receiving opening. However, during prosecution, Liebel removed reference to a pressure jacket in the claims. The district court found that Liebel became aware of Medrad's jacketless injector system and then deleted the limitations relating to the pressure jacket in order to encompass Medrad's injector. The examiner allowed the claims, and the issued claims do not contain an explicit recitation of a pressure jacket.

The district court initially found that the claims of the front-loading patents implicitly included a pressure jacket and thus Medrad's accused devices did not infringe the claims. However, in a previous appeal, the Federal Circuit reversed the district court's claim construction and determined that the front-loading patents do not require a pressure jacket. The Federal circuit based its decision on the fact that the specification did not clearly disavow embodiments lacking a pressure jacket and based on indications in the prosecution history that the asserted claims purposefully did not include a pressure jacket limitation. Medrad previously argued that the claims should be construed more narrowly to preserve validity. However, the Federal Circuit stated that validity was a separate issue that could be addressed on remand.

On remand, the district court concluded that Medrad's devices did infringe the claims of the front-loading patents, but that those claims were invalid for lack of compliance with the written description and enablement requirements of 35 U.S.C. § 112. Regarding the written description requirement, the district court based its decision on a finding that the specification did not describe a jacketless injector. Regarding the enablement requirement, the district court based its decision on observations, testimony, the state of the art at the time of filing, and the lack of a prototype at the time of filing.

Regarding the syringe-sensing patents, the interpretation of the term "physical indicia" was in question. Specifically, Medrad asserted that to preserve validity the interpretation of the term "physical indicia" should be limited to indicia representing the length of the extender. However, the district court properly concluded that the claim language was broader because the claims

recited properties other than the length of the extender. In view of this construction, the district court found that Medrad's accused devices infringed the asserted claims of the syringe-sensing patents but were invalid under 35 U.S.C. §§ 102 and 112.

II. Issues

Did the district court err in determining that the asserted claims of the front-loading patents are invalid for lack of enablement?

Did the district court err in determining that the asserted claims of the syringe-sensing patents are invalid for anticipation?

III. Discussion

No. The applicant's specification must enable one of ordinary skill in the art to practice the full scope of the claimed invention. Further, the enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation. Based on the claim construction, the full scope of the claims of the font-loading patents includes injectors with and without a pressure jacket. That full scope must be enabled, and the district court was correct in finding that it was not enabled. For example, the specification does not describe a disposable syringe without a pressure jacket. Indeed, the specification teaches away from such a syringe by stating that any syringe that could withstand high pressures without a pressure jacket would be impractical. This teaching away is evidence of a significant amount of required experimentation. Further, the inventors admitted that they tried unsuccessfully to produce a pressure-jacketless system and that producing such a system would have required more experimentation and testing. Indeed, the inventors testified that they decided not to pursue such a system because it was "too risky."

No. A determination that a patent is invalid as anticipated under 35 U.S.C. § 102 requires that a prior art reference disclose every limitation of the claimed invention, either explicitly or inherently. The district court correctly determined that Liebel was anticipated by a prior art reference. Liebel argued that the prior art reference failed to disclose the closed control circuit that computes the location of a plunger. Although the prior art reference expressly mentions an injector controller, it does not discuss the details of the control circuit and its interaction with the plunger. However, the prior art reference incorporates a patent by reference that clearly discusses such details. Further, Liebel argued that the prior art reference failed to disclose detecting physical indicia related to various parameters or properties of the syringe. However, based on the claim construction, the physical indicia include capacity of the syringe and so forth, and the prior art reference clearly discloses detecting such physical indicia.

IV. Conclusions

Beware of Pyrrhic victories.