

Keywords: 35 U.S.C. § 112, first paragraph; written description requirement; broadened claim language

General: In view of the specification and testimony that the inventor had not, at the time the patent application was filed, considered a particular structural arrangement encompassed by claims broadened during prosecution, the Federal Circuit invalidates these claims based on the written description requirement.

Gentry Gallery Inc. v. Berklinc Corp.
45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)
Decided January 27, 1998

I. Facts

Gentry Gallery (“Gentry”) owns U.S. Patent No. 5,064,244 (“the ‘244 patent”), which is directed to a unit of a sectional sofa in which two independent recliners face in the same direction. Sectional sofas are typically arranged in an L-shape with “arms” at the exposed ends of the linear sections of the L-shape. According to the ‘244 patent, because recliners usually include adjustment controls on their arms, sectional sofas were only able to contain two recliners if the recliners were located at the outer ends of the linear sections. Accordingly, due to the L-shaped configuration of typical sectional sofas, including two recliners in a typical sectional sofa required that they face in different directions. This arrangement was described by the ‘244 patent as undesirable in certain situations. For example, occupants of two such recliners could not comfortably engage in intimate conversation because of the distance between them.

The ‘244 patent is directed to addressing these supposed issues with typical sectional sofas by placing a “console” between two recliners that face in the same direction. Such a console accommodates controls for both recliners, thus eliminating the need to position each recliner on opposite ends of a sectional sofa. The ‘244 patent only describes the controls for each recliner as being located on the console. Indeed, the ‘244 patent provides for only the most minor variation in the location of the controls, noting that the controls “may be mounted on top or side surfaces of the console rather than on the front wall ... *without departing from this invention.*” (Emphasis added). Further, the ‘244 patent indicates that the only purpose relevant to the console is to accommodate the controls. However, after observing competitors including controls in different locations for recliners in sectional sofas similar to that of the ‘244 patent, Gentry made a broadening amendment to read on such features.

During prosecution of the ‘244 patent, Gentry argued that the term “console” was not met by a sofa section having a seat back that folds down to serve as a table top. Specifically, with regard to the Brennan reference, which disclosed such a seat back/table top, Gentry argued that rather than disclosing a console, the Brennan reference merely discloses “a complete center seat with a tray unit in its back.”

Gentry sued Berklinc Corp. (“Berklinc”) in district court alleging that Berklinc infringed the ‘244 patent by manufacturing and selling sectional sofas having two recliners facing in the same direction. In the allegedly infringing sofas, the recliners were separated by a seat which had a back cushion that could be pivoted down onto the seat, such that the seat back functioned as a tabletop between the two recliners.

Berkline requested a motion for summary judgment of non-infringement, and asserted that the '244 patent was invalid and unenforceable. The district court granted Berkline's motion for summary judgment of non-infringement. However, the district court held that the '244 patent was not invalid or unenforceable. Gentry and Berkline appealed.

II. Issues

- A. Did the district court err in granting the motion of summary judgment of non-infringement?
- B. Did the district court err in holding that the '244 patent was not invalid or unenforceable?

III. Discussion

- A. No. The judgment that Berkline does not infringe the '244 patent was affirmed because the prosecution history indicates that the term "console" is not met by a sofa section having a seat back that folds down to serve as a table top, as disclosed by the Brennan reference and included in Berkline's sofa. Indeed, the statements in the prosecution history were found to unambiguously indicate that Berkline's sofa does not include a "console" as that term is used in the '244 patent, regardless of the term's ordinary meaning.
- B. Yes. The '244 patent only describes sofas having controls disposed on a console. Further, the '244 patent indicates that an object of the invention is to provide a sectional sofa "with a console ... that accommodates the controls for both the reclining seats." The inventor even testified that he did not consider placing the controls outside the console until he became aware that some of Gentry's competitors were doing so. Accordingly, the claimed sofas are not described within the meaning of 35 U.S.C. §112, para. 1.

While an applicant may generally be allowed claims that cover more than specific embodiments shown, the claims cannot broaden a specific and essential element of the invention. For example, in the present case, because the inventor considered the location of the recliner controls on the console as an essential element of his invention, his original disclosure served to limit the permissible breadth of his later-drafted claims.