Keywords: 35 U.S.C. §112; broad claims

General: Federal Circuit finds the specification's description of a certain embodiment cannot limit the invention when other embodiments are also described.

ScriptPro LLC, ScriptPro USA, Inc. v. Innovation Associates, Inc.
No. 2015-1564 (Fed. Cir. August 15, 2016)

I. Background

U.S. Patent No. 6,910,601 (Assignee: ScriptPro LLC) relates generally to a "collating unit" for use with a control center and an automatic dispensing system ("ADS") for storage of prescription containers in slots once the containers have been filled.

The parties agreed that the following claim 8 is representative of the asserted claims:

> 8. A collating unit for automatically storing prescription containers dispensed by an automatic dispensing system, the collating unit comprising:
> an infeed conveyor for transporting the containers from the automatic dispensing system to the collating unit;
> a collating unit conveyor positioned generally adjacent to the infeed conveyor;
> a frame substantially surrounding and covering the infeed conveyor and the collating unit conveyor;
> a plurality of holding areas formed within the frame for holding the containers;
> a plurality of guide arms mounted between the infeed conveyor and the collating unit conveyor and operable to maneuver the containers from the infeed conveyor into the plurality of holding areas; and
> a control system for controlling operation of the infeed conveyor, the collating unit conveyor, and the plurality of guide arms.

In 2006, ScriptPro, LLC and ScriptPro USA, Inc. ("collectively, ScriptPro") originally sued Innovation Associates, Inc. ("Innovation") for patent infringement. The case was stayed pending an *inter partes* reexamination. Later, the district court asserted that the claims were invalid for failing the written description requirement under 35 U.S.C. §112, paragraph 1. For this particular case, the district court asserted that the claims were broader than the limits of the specification. The district court said that invention includes slot-checking sensors according to the specification whereas the claims did not include this limitation. More pertinently, the absence of the sensors in the claims would result in collating machines with and without sensors to be infringing.

In 2014, upon appeal, the Federal Circuit reversed and remanded the district court's grant of summary judgment that the claims were invalid for failing the written description requirement. The Federal Court explained that the district court erroneously determined the specification to require the invention to have these sensors, and that although the desirable, language in the specification instead deems the sensors as optional.

Once again, Innovation moved for summary judgment that the claims fail to comply with the written description requirement. This time, Innovation's argument was that the specification specifically limits how the collating machine achieves the automated storage of the prescription containers in that the storage is based on patient-identifying information. ScriptPro, in turn, argued that the specification does not limit the invention to collating and storing based solely patient-identifying information.

The district court granted Innovation's motion for summary judgment. It asserted that the claims are rendered invalid for lack of written description. Seeing that the claim itself does not expressly state what the

collating is based on and that the specification continuously indicates that the prescription container will be collated by patient name and open storage positions, the district court agreed with Innovation.

II. Issue

Did the district court err in finding that the claims of the ’601 patent failed the written description requirement under 35 U.S.C. §112?

III. Discussion

Yes. The appellate court for the Federal Circuit held that the district court erred in finding that the claims of the ’601 patent failed the written description requirement under U.S.C 35 U.S.C. §112. In determining whether the written description was met, the court considered “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)

In the appeal, ScriptPro argued that the district court incorrectly only focused on one of the goals of the ‘601 patent, which is to track use of the slots based on availability and patient-identifying information (specifically by patient name). ScriptPro further argued that the claims would only be too broad if the specification is read to limit the claimed invention to collating based on patient-identifying information. ScriptPro asserted that the specification does not limit the scope of the invention in such a way.

The court agreed with ScriptPro in that regard. For example, the ‘601 patent discloses other problems that the invention solves such as storing the containers in slots, sorting multiple containers of a patient in a single slot, collating based on name (as appose to prescription number), and grouping together multiple prescription containers of a patient for easy retrieval. While many of these problems are solved with patient-identifying information, not all of them are. The ‘601 patent even explicitly states the prescription containers can be stored, “by patient, prescription, or *other predetermined storage scheme* without input or handling by the operator.” ‘601 patent, 8:21-24 (emphasis added). Furthermore, the original claims did not limit to collating and storing based on prescription containers. The court explained, “[o]riginal claims are part of the specification and in many cases will satisfy the written description requirement.” *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1380 (Fed. Cir. 2011) (citing *Ariad Pharm.*, 598 F.3d at 1349).

The court also conceded that Innovation’s argument that, a lot of the ‘601 patent’s specification deals with using a sorting and storage scheme based on patient-identifying information, is true. However, the court further stated, “a specification’s focus on one particular embodiment or purpose cannot limit the described invention where that specification expressly contemplates other embodiments or purposes.”

Moreover, the ‘601 patent’s specification clearly stated that, in the prior art, automated control centers that sorted and stored based on prescription number rather than patient-name are “inconvenient,” as Innovation also argued. However, the court further stated that a specification’s recognition of an “inconvenient” element in the prior art does not necessarily limit the invention to not including the “inconvenient” element, especially when the specification specifically describes embodiments with the “inconvenient” element.

The court also pointed out how this case is different from the cases of *Gentry Gallery* and *ICU Medical*. In *Gentry Gallery*, “the disclosure clearly identifies the console as the only possible location for the controls.” *Gentry Gallery*, 134 F.3d at 1479. (The claims here did not limit the location for the controls.) And in *ICU Medical*, “the specification describes only medical valves with spikes.” *ICU Med.*, 558 F.3d at 1378. (The claims did not include this spike limitation either.)

Overall, if the specification does not explicitly limit the invention to including/excluding an element, and discusses alternative embodiments, the claims do not need to be narrow in that regard.

IV. Conclusion

The Federal Circuit reversed and remanded the judgment of the district court as to the '601 patent.

V. Practice Tips

Include alternative embodiments in the specification so that the claims will not be broader than the specification.