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Federal Circuit Patent Bulletin: *ScriptPro, LLC v. Innovation Assocs., Inc.*

August 15, 2016

"[M]ere recognition in the specification that an aspect of a prior art system is 'inconvenient' does not constitute 'disparagement' sufficient to limit the described invention—especially where the same specification expressly contemplates that some embodiments of the described invention incorporate the 'inconvenient' aspect."

On August 15, 2016, in *ScriptPro, LLC v. Innovation Assocs., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Moore,* Taranto, Hughes) reversed and remanded the district court's summary judgment that U.S. Patent No. 6,910,601, which related to a collating unit used with a control center and an automatic dispensing system (ADS) to store prescription containers after a medication has been dispensed into the containers, was invalid for lack of written description under 35 U.S.C. § 112. The Federal Circuit stated:

In determining whether the written description requirement is met, we consider "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."

In this appeal, ScriptPro argues that the district court erred by interpreting the '601 patent's specification as limited to sorting by patient-identifying information. The problem, according to ScriptPro, is that the district court's focus on one purpose of the '601 patent—to "keep[] track of slot use by particular customers and slot availability," —caused it to erroneously conclude that the '601 patent's invention is limited to a collating unit that "achiev[es] the singular purpose of storing prescription containers" by patient-identifying information, specifically by patient name. According to ScriptPro, only if the specification is read to limit the claimed invention to sorting and

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storing prescription containers by patient-identifying information can the asserted claims be "too broad" for failing to include such a limitation. ScriptPro argues that the specification does not limit the invention in this manner.

We agree with ScriptPro that the specification does not limit the claimed invention to sorting and storing prescription containers by patient-identifying information. The '601 patent discloses multiple problems that the invention solves, including working with existing ADSs, "stor[ing] more than one container in a holding area," "collat[ing] multiple containers for a patient in one holding area," "stor[ing] a container for a patient based on the patient's name, as opposed to a prescription number associated with the patient," and grouping together "multiple prescriptions for a patient, whether in the form of prescription vials, unit-of-use packages, or a combination thereof" for easy retrieval. And while some, indeed many, of these solved problems involve sorting prescription containers by patient-identifying information, not all of them do. For example, storing more than one prescription container in a holding area does not necessarily require that all the containers in that holding area be for the same patient. The prescription containers could be sorted into different holding areas based on the medicament dispensed (e.g., sorting all containers for a specific antibiotic into the same holding area, regardless of the patient for whom it is prescribed), by the date the prescription was filled, or some other sorting scheme. In fact, the '601 patent expressly states that containers can be sorted and stored "by patient, prescription, or other predetermined storage scheme without input or handling by the operator."

Consistent with this express disclosure, the original claims filed as part of the application from which the '601patent issued were not limited to sorting and storing prescription containers by patient-identifying information. Rather, these original claims, like the asserted claims, recite a collating unit that automatically stores prescription containers dispensed by an ADS. As we have explained, "[o]riginal claims are part of the specification and in many cases will satisfy the written description requirement."

It is true, as Innovation argues, that much of the '601 patent's specification focuses on embodiments employing a sorting and storage scheme based on patient-identifying information. And it is also true that the specification explains that prior art automated control centers that store containers "based on a prescription number associated with the container, as opposed to storing the container based on a patient name" are "especially inconvenient for several reasons." But a specification's focus on one particular embodiment or purpose cannot limit the described invention where that specification expressly contemplates other embodiments or purposes. This is especially true in cases such as this, where the originally filed claims are not limited to the embodiment or purpose that is the focus of the specification. Similarly, mere recognition in the specification that an aspect of a prior art system is "inconvenient" does not constitute "disparagement" sufficient to limit the described invention—especially where the same specification expressly contemplates that some embodiments of the described invention incorporate the "inconvenient" aspect. . . .

Multiple purposes are described, including storing multiple prescription containers together according to some storage scheme and creating a collating unit that is easy to install with existing ADSs. It is certainly reasonable that different claims could be directed to covering these different aspects of the invention. Not every claim must contain every limitation or achieve every disclosed purpose. Here, the original claims filed as part of the application for the '601 patent did not include a requirement that sorting and storing be done

by use of patient-identifying information. The district court erred when it determined that the specification limited the invention to storing prescription containers based on patient name and slot availability. Because the specification does not limit the scope of the invention in the manner the district court described, the asserted claims are not invalid for lacking such a limitation.