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IP Newsflash



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DISTRICT COURT CASES

Federal Circuit Reverses *ScriptPro* Invalidation Ruling

On Wednesday, a lawsuit between ScriptPro LLC and competitor, Innovation Associates, Inc., was sent back to the U.S. District Court of Kansas after a three-judge panel disagreed with the District Court's summary judgment of invalidity.

In 2012, District Judge Carlos Murguia held that U.S. Patent No. 6,910,601 was invalid for lack of an adequate written description. Specifically, Judge Murguia found that the '601 patent - which involves a robotic prescription pill dispensing system - has a specification that described a machine that needed "sensors" to work, whereas the claims at issue did not recite "sensors."

The Federal Circuit disagreed that sensors were required and held, "[t]here is no sufficiently clear language in the specification that limits the invention to a collating unit with the (slot checking) sensors." The panel found that the portions of the patent relied on by the district court merely describe what "the sensor does when it is used, not that it must be used." For example, the specification describes the sensor as a "security feature" to "determine if any container is located in the [holding] area." This, the panel found, suggests sensors are an optional component. Finding an ambiguity within the specification, the panel concluded that summary judgment was inappropriate.

Additionally, the Federal Court pointed out that the original claims, before amendment following reexamination, did not require sensors. The court stated "[w]hen a specification is ambiguous about which of several features are stand-alone inventions, the original claims can help resolve the ambiguity, though even original claims may be insufficient as descriptions or be insufficiently supported by the rest of the specification."

ScriptPro, LLC et al., v. Innovation Associates, Inc., No. 2013-1561, (Fed. Cir. Aug. 6, 2014) [R. Taranto].

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