

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

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August 7, 2014

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On August 6, 2014, in *ScriptPro LLC v. Innovation Assocs., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Taranto,\* Bryson, Hughes) reversed the district court's summary judgment that certain claims of U.S. Patent No. 6,910,601, which related to a collating unit for use with an automatic dispensing system to automatically fill and label pill bottles or other prescription containers, were invalid for inadequate written description under 35 U.S.C. § 112(a). The Federal Circuit stated:

We have a narrow issue: whether the absence of sensors from the claims at issue means that those claims are unsupported by the written description as a matter of law. We do not have before us other questions that might be raised by the generality of the claim language. We note one such question because it is related to what ScriptPro, in making its present argument, stresses as a central purpose of the invention described in the specification: to keep track of what slots are open and what slots are being used for a particular customer. It is not immediately apparent how the claim language, properly construed, requires any means of achieving that purpose. We simply assume, for present purposes, that it does.

On the sole issue presented, the starting point is that the specification's description of embodiments having sensors for providing information about slot allocations and availability does not necessarily mean that the only described invention is a collating unit with such sensors. It is common, and often permissible, for particular claims to pick out a subset of the full range of described features, omitting others. A specification can adequately communicate to a skilled artisan that the patentee invented not just the combination of all identified features but combinations of only some of those features (subcombinations)—which may achieve stated purposes even without omitted features.

The specification in this case does not preclude that result as a matter of law. ScriptPro could establish that the written description conveys to the relevant skilled artisan that “the inventor[s] actually invented the invention claimed” in claims 1, 2, 4, and 8. There is no sufficiently clear language in the specification that limits the invention to a collating unit with the (slotchecking) sensors. And considering what the specification does say, and what ScriptPro highlights as a central purpose of the claimed advance in technology, it cannot be said as a matter of law that claims 1, 2, 4, and 8 have a scope incommensurate with what is described as the invention.

Neither the specification’s declaration that “[t]he collating unit of the present invention broadly includes . . . a plurality of sensors” nor the “broadly comprises” language of the Abstract is enough to support the invalidity ruling on summary judgment. The term “broadly” qualifies the assertion of inclusion. Like “generally,” the qualifier “broadly” suggests that exceptions are allowed to the assertion of what occurs most (perhaps even almost all) of the time. The combination “broadly includes” might have a more absolute meaning when followed by an enumeration of examples of what precedes the phrase, e.g., “The term ‘law’ broadly includes constitutional provisions, statutes, regulations, . . . .” When followed by a list of individual components of the subject preceding “broadly includes,” however, the phrase, which is unusual, does not plainly convey such an absolute meaning. Indeed, a less than absolute meaning tends to be suggested by the very fact that the word “broadly” has been included: what is the word doing in the phrase if not to moderate an otherwise-straightforward assertion that the inventive collating unit “includes” the enumerated items? We conclude that the “broadly includes”/“broadly comprises” phrases are less than a clear statement of limitation that a skilled artisan, if being reasonable, would have to read as requiring the slot sensors at issue. . . .

We note one last point: as originally filed, the application that matured into the ‘601 patent had claims that did not include a requirement of sensors. When 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. Here, original claims omit a sensor requirement, an omission that fits the bases in the specification for deeming sensors to be merely optional. . . . For the foregoing reasons, we reverse the district court’s grant of summary judgment that claims 1, 2, 4, and 8 of the ‘601 patent are invalid under 35 U.S.C. § 112 for lack of an adequate written description.