

SCRIPTPRO LLC v. INNOVATION ASSOCIATES, INC., Appeal No. 2015-1565 (Fed. Cir. August 15, 2016). Before Moore, Taranto, and Hughes. Appealed from D. Kan. (Judge Murguia).

Background:

This is the second appeal in this case from a summary judgment of invalidity for lack of written description support. The first appeal was reversed and remanded.

In the present case, the district court again found the claims invalid for lack of written description support. The district court found that the specification limited ScriptPro's "collating unit" to one that sorted and stored prescription medication containers based on patient-identifying information and slot availability. However, the claims did not require the collating unit to have these features. The district court granted Innovation's motion for summary judgment of invalidity for lack of written description support, and ScriptPro appealed.

Issue/Holding:

Are the claims invalid for a lack of written description support? No, reversed and remanded.

Discussion:

The Federal Circuit found that the specification did not require the claimed collating unit to sort and store medication containers solely using patient-identifying information, and also did not identify the single purpose of the invention as sorting and storing medication containers by patient-identifying information. Rather, the specification indicated that the medication containers can be sorted and stored by patient, prescription, or other predetermined storage scheme. The Federal Circuit found that although the specification included a majority of embodiments focused on sorting and storing using patient-identifying information, this does not limit the claims because the specification expressly contemplates other embodiments or purposes.

In addition, the Federal Circuit pointed to the claims as originally filed for written description support. The Federal Circuit noted that original claims are considered part of the specification and can be used to satisfy the written description requirement. Here, the original claims were not limited to sorting and storing medication containers using patient-identifying information, and thus provide further written description support for the issued claims.

Therefore, the Federal Circuit found that because the specification does not limit the claims to sorting and storing medication containers using patient-identifying information, the claims are not invalid for lacking such a limitation.