

CENTRAK, INC. v. SONITOR TECHNOLOGIES, INC., Appeal No. 2017-2510 (Fed. Cir. February 14, 2019). Before Reyna, Taranto, and Chen. Appealed from D. Del. (Judge Andrews).

Background:

CenTrak sued Sonitor for infringing claims directed to real time location (RTL), which allows users to locate and identify portable devices in a facility. The asserted claims generally recited ultrasonic base stations. Sonitor filed a motion for summary judgment for lack of written description and enablement. Sonitor argued that the two sentences in the specification dedicated to ultrasound did not show that the inventors had possession of an ultrasound-based RTL system, and that the majority of the specification was instead directed to an infrared RTL system. The district court ruled that while the specification "contemplated" ultrasound, "mere contemplation ... is not sufficient to meet the written description requirement." The district court reasoned that because the patent's written description does not discuss how to address propagation delays or interference in ultrasonic systems, the patent does not show that the inventors had possession of the claimed invention as of the filing date. The district court did not rule on the issue of enablement. CenTrak appealed.

Issue/Holding:

Did the district court err in finding a lack of written description? Yes, reversed and remanded.

Discussion:

The Federal Circuit held that, based on the evidence of record, there was a material dispute of fact as to whether the named inventors actually possessed an ultrasonic RTL system at the time they filed their patent application. The Federal Circuit found that the district court erred by not considering the testimony of the CenTrak expert that the differences between IR and ultrasound are incidental to carrying out the claimed invention. Sonitor argued that "the specification is entirely silent about the structure of ultrasonic base stations or receivers." However, the Federal Circuit determined that the CenTrak expert's testimony, ignored by the district court, suggests that the details surrounding the ultrasonic base stations and receivers were not overly complex or unpredictable, and Sonitor does not explain why a person of ordinary skill in the art would need to see such details to carry out the claimed system. The court explained that the written description is about whether the skilled reader of the patent can recognize that what was claimed corresponds to what was described; it is not about whether the patentee has proven to the skilled reader that the invention works, which is an enablement requirement. Thus the Federal Circuit found that the specification's relative lack of attention to its ultrasonic embodiment compared to its IR embodiment did not show that the inventors failed to constructively reduce to practice an ultrasonic RTL system at the time they filed their patent application.