

# United States Court of Appeals for the Federal Circuit

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SCRIPTPRO LLC, SCRIPTPRO USA, INC.,  
*Plaintiffs-Appellants*

v.

INNOVATION ASSOCIATES, INC.,  
*Defendant-Appellee*

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2015-1565

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Appeal from the United States District Court for the  
District of Kansas in No. 2:06-cv-02468-CM, Judge Carlos  
Murguia.

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Decided: August 15, 2016

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TRAVIS W. MCCALLON, Lathrop & Gage, LLP, Kansas  
City, MO, argued for plaintiffs-appellants. Also represent-  
ed by ROBERT CAMERON GARRISON; R. SCOTT BEELER,  
Overland Park, KS.

ANGELA DAWN MITCHELL, Shook, Hardy & Bacon,  
LLP, Kansas City, MO, argued for defendant-appellee.  
Also represented by BASIL TRENT WEBB.

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Before MOORE, TARANTO, and HUGHES, *Circuit Judges*.

MOORE, *Circuit Judge*.

ScriptPro, LLC and ScriptPro USA, Inc. (collectively “ScriptPro”) appeal the United States District Court for the District of Kansas’s grant of summary judgment that claims 1, 2, 4, and 8 (“asserted claims”) of U.S. Patent No. 6,910,601 are invalid for lack of written description. We reverse and remand for further proceedings.

#### BACKGROUND

The ’601 patent is directed 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. At issue in this appeal is whether the ’601 patent’s specification limits the invention to a collating unit that sorts and stores prescription containers by patient-identifying information and slot availability. In the decision appealed from, the district court determined that the specification was limiting and that the asserted claims, which are not so limited, are invalid for lack of written description.

The ’601 patent explains that the claimed invention “provides a distinct advance in the art of automated storage units for use with static control centers cooperating with [ADSs].” ’601 patent, 4:15–17. Specifically, it notes that the claimed collating units “may be used with an existing static control center to automatically store prescription containers” and that such storage occurs “according to a storage algorithm that is dependent on a patient name for whom a container is intended and an availability of an open storage position in the collating unit.” *Id.* at 4:19–25. It explains that, “[i]n operation, a prescription for a patient is entered into the control system of the ADS along with identifying information for the prescription, such as the patient’s name.” *Id.* at 5:40–42. After the ADS dispenses the medication, the filled

prescription container is transported to the collating unit, where the control system determines where to store the container by taking into account “whether previous containers for the patient have been stored in the collating unit and not yet retrieved,” *id.* at 5:47–49, and “if the holding area is full,” *id.* at 5:54–59. When an operator wishes to retrieve a patient’s filled prescriptions, “the operator may input the identifying information for the prescription, such as the patient’s name, into the control system,” which can then indicate the holding area for that patient’s prescriptions. *Id.* at 6:11–20. The ’601 patent identifies a number of advantages of the claimed collating unit, including the unit’s ability to automatically store containers, eliminate errors associated with manual retrieval and storage of containers, hold more than one container in a holding area, store containers based on a patient’s name, store multiple containers for a patient together in the same area, and decrease operating costs for pharmacies by eliminating the need for multiple operators to retrieve and store containers. *Id.* at 6:21–45.

The parties agree that claim 8 is representative of the asserted claims. This claim recites:

8. A collating unit for automatically storing prescription containers dispensed by an automatic dispensing system, the collating unit comprising:

- an infeed conveyor for transporting the containers from the automatic dispensing system to the collating unit;
- a collating unit conveyor positioned generally adjacent to the infeed conveyor;
- a frame substantially surrounding and covering the infeed conveyor and the collating unit conveyor;
- a plurality of holding areas formed within the frame for holding the containers;

- a plurality of guide arms mounted between the infeed conveyor and the collating unit conveyor and operable to maneuver the containers from the infeed conveyor into the plurality of holding areas; and
- a control system for controlling operation of the infeed conveyor, the collating unit conveyor, and the plurality of guide arms.

ScriptPro sued Innovation Associates, Inc. (“Innovation”) for patent infringement in 2006.<sup>1</sup> This is the second appeal addressing whether the asserted claims of the ’601 patent are invalid for lack of written description. In the first appeal, we reversed the district court’s grant of summary judgment that the asserted claims are invalid for lack of written description. *ScriptPro, LLC v. Innovation Assocs., Inc.*, 762 F.3d 1355, 1356 (Fed. Cir. 2014) (“*ScriptPro I*”). The district court had erroneously determined that the specification limits the invention to a collating unit that requires use of sensors to determine whether a holding unit is full. We explained that “[t]here is no sufficiently clear language in the specification that limits the invention to a collating unit with the (slot-checking) sensors,” *id.* at 1359, and that other language in the specification “positively suggests that slot sensors are an optional, though desirable, feature of the contemplated collating unit,” *id.* at 1360. We also explained that the original claims that were filed as part of the application

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<sup>1</sup> After ScriptPro filed suit, Innovation petitioned for, and the United States Patent and Trademark Office (“PTO”) instituted, inter partes reexamination. During reexamination ScriptPro amended the asserted claims, adding language to claims 1 and 2, and rewriting claim 4 into independent format. Claim 8 was not amended. The PTO confirmed the asserted claims as amended. These changes do not impact the issues in this appeal.

for the '601 patent did not require sensors. We stated that these original claims, which are part of the specification and can provide written description support for later issued claims, further support reading the specification as describing sensors as optional. *Id.* at 1361. Although not at issue in the first appeal, we noted that it was “not immediately apparent” whether any claim language required tracking which slots are open and what slots are being used for a particular customer. *Id.* at 1359.

On remand, Innovation moved again for summary judgment that the asserted claims are invalid for lack of written description. This time Innovation argued that the specification “unambiguously limits the manner in which the collating unit achieves automated storage of prescription containers . . . based on the availability of an open storage position and patient-identifying information” but the asserted claims “broadly claim a collating unit for ‘automatically storing’ absent any limitation that makes [them] commensurate with the invention” as described in the specification. J.A. 5191–92. In response, ScriptPro argued that the specification describes associating stored containers with a specific patient as one, but not the only, goal of the '601 patent, such that the specification does not limit the claimed invention to sorting and storing based on patient-identifying information.

The district court granted Innovation’s motion. It quoted our concern expressed in *ScriptPro I*, and, citing *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1988) and *ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368 (Fed. Cir. 2009), it concluded that the asserted claims are invalid for lack of written description. *ScriptPro LLC v. Innovation Assocs., Inc.*, 96 F. Supp. 3d 1201, 1205–07 (D. Kan. 2015) (“*ScriptPro II*”). The district court explained that the specification describes the collating unit as using an algorithm based on patient names and availability of open slots to store containers and that “one of [the patent’s] central purposes

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