



National Recovery Techs. Inc. v. Magnetic Separation Sys. Inc., 166 F.3d 1190 (Fed. Cir. 1999)

Author: Ken Aoki, Patent Agent, Japan

CASE HISTORY

Appeal from the district court's decision granting summary judgment to MSS. The district court held NRT's patent invalid for lack of enablement.

CASE FACTS

- '576 patent covers an automated recycling system. (Fig.1) The system distinguishes materials by measuring the penetration of electromagnetic radiation.
- The problem of the prior art is misidentification of materials due to the irregularities in container thickness. (Fig.2)
- The ideal solution to this problem is to use, as thresholds, measurements that do not pass through an irregularity.
- NRT's invention presumes the highest measurements to be those that do not pass through an irregularity. (Fig.2)
- '576 claim states, "...selecting for processing those of said process signals which do not pass through irregularities in the bodies of said material items...."

ISSUE

Whether '576 patent satisfies the enablement requirement?

HOLDING

No, '576 patent does not enable POSA to practice the full scope of the invention without undue experimentation.

ANALYSIS

- The scope of the claims must be less than or equal to the scope of the enablement.
- The specification does not describe how to perform the selection step. (Even the inventor admits that additional research is necessary to perform the selection step.)

- POSA cannot construct a machine capable of performing the selection step without undue experimentation.

NOTE

Whether a claim is enabled under 35 USC § 112 1 is a question of law, although based upon underlying factual findings.