

Fed. Circ. Pushes Flexible Approach On 'Printed Publications'

By **Matthew Bultman**

Law360 (August 21, 2018, 8:49 PM EDT) -- The Federal Circuit has in recent decisions emphasized the need for the Patent Trial and Appeal Board to use a flexible approach when deciding whether materials distributed at conferences and other meetings are publicly available “printed publications” that can be used to challenge patents, increasing the odds that patent owners will have to contend with these types of materials in review.

Companies challenging a patent in inter partes review at the PTAB typically argue that the claimed invention is anticipated or obvious based on earlier patents, but they can also argue it was previously described in a printed publication.

On various occasions over the past few months, most recently in a case involving action camera maker GoPro Inc., the Federal Circuit has been asked to consider whether a reference was publicly accessible, a requirement for it to be considered a printed publication.

The court has, at times, come down on the PTAB for taking too rigid an approach.

“We see the Federal Circuit continuing to make rulings on whether something is a printed publication in a very flexible way, generally in favor of finding that a document that could have been found, even through very difficult searches, would be a printed publication or even minor public dissemination is enough,” Byron Pickard of Sterne Kessler Goldstein & Fox PLLC said.

Questions about when a reference is publicly accessible often arise in the context of materials stored in libraries, the Federal Circuit wrote in a recent decision. In those cases, it often comes down to whether the reference was sufficiently indexed or cataloged.

GoPro and some other recent cases have presented a different question: whether the distribution of materials to people at a meeting, such as a trade show or conference, makes those materials publicly accessible.

GoPro filed petitions for inter partes review challenging two patents that cover action sports video cameras. The patents are owned by Contour IP Holdings LLC, the IP arm of GoPro rival Contour LLC, which has accused GoPro of infringement.

GoPro argues that parts of the patents are obvious based, in part, on one of its own sales catalogs.

Hundreds of copies of the catalog had been distributed at a 2009 trade show for motorcycles, all-terrain vehicles and other action sports vehicles in Fort Worth, Texas. Yet the PTAB found the catalog wasn't publicly accessible and couldn't be used as evidence in the proceedings.

The board emphasized that the trade show was not open to the general public — only to dealers — and said a person that works with point-of-view cameras wouldn't have been interested in the show because it wasn't an academic conference or camera industry conference.

Vacating that decision July 27, the Federal Circuit **said** the PTAB interpreted the case law on accessibility too narrowly. The court said the expertise of the audience was just one factor to be considered, while adding it was "more likely than not" that someone skilled in POV cameras was at the show.

"The ruling reconfirms that the question of whether a document qualifies as a printed publication is determined under a very flexible standard," Pickard said.

The Federal Circuit has in the past found even relatively obscure documents qualify as prior art, something the court noted in its decision. Bryan Wheelock of Harness Dickey & Pierce PLC has what he calls a "Table of Obscure Prior Art" for a class he teaches at the Washington University School of Law (St. Louis).

The table includes, among other things, a report available at the Ontario Power Generation Resource Center. There is also a presentation that was displayed on poster boards at an American Association of Cereal Chemists meeting and later at the Agriculture Experiment Station at Kansas State University.

"The type of things the Federal Circuit has considered prior art in the past are really kind of obscure," Wheelock said. "So it's not too surprising the Federal Circuit would get to this result. The surprise was the patent office wasn't already there."

The ruling came on the heels of other Federal Circuit decisions that considered whether material distributed at meetings were printed publications.

In mid-July, the appeals court upheld a PTAB decision invalidating parts of several Jazz Pharmaceuticals Inc. patents on Xyrem after finding materials from a Food and Drug Administration meeting about a computer system to track patient abuse of the narcolepsy drug were publicly accessible.

A few weeks earlier, the Federal Circuit ordered the board to reconsider a challenge Medtronic Inc. brought against a spine-straightening patent that the company has been accused of infringing.

Medtronic contends the patent is obvious based on a video and slide presentation that it previously made to spinal surgeons at conferences. The PTAB found the video and slides were not accessible to the public, but the Federal Circuit **said** the record needed to be further developed.

Similar to the GoPro ruling, the court said the PTAB didn't consider all the relevant factors.

"The patent office seems to be a little more hesitant to declare things a printed publication, and the Federal Circuit is broadening that out," Wheelock said.

A common theme throughout the decisions is the Federal Circuit's emphasis on the need for a multi-

factor test when determining public accessibility in the context of materials distributed at conferences or meetings, attorneys said.

The factors include not just the expertise of the intended audience, but also the size and nature of the meetings or whether there were restrictions on public disclosures or expectations that the information would be shared.

“They’re stressing that it’s a very case-specific inquiry and you don’t have these rigid factors that you have to cross a specific threshold in order to show public accessibility,” Joel Sayres of Faegre Baker Daniels LLP said.

That said, whether there was an expectation that the material would be kept confidential appears to carry weight with the court, attorneys said. In GoPro, the court emphasized the catalog was handed out without restrictions and was intended to reach the general public.

“Whenever information — a catalog, a paper or any type of printed publication, as the case law describes it — is disseminated without some type of [nondisclosure agreement] or confidentiality agreement, it’s more likely than not that the publication is going to be considered eligible for prior art,” Joseph Herndon of McDonnell Boehnen Hulbert & Berghoff LLP said.

This worked to GoPro’s advantage in its challenge to Contour’s patent. But looking at it from the other side, the case is a reminder to those preparing to file a patent application about the potential pitfalls of revealing an invention too soon.

Herndon said it is a general rule not to publish anything about an invention before the application is filed, and in the event something is revealed, such as to investors, to consider protecting the information with a confidentiality agreement.

“Be cognizant of times when you do disseminate publications, because it can be used to invalidate patents,” Herndon said.

The GoPro case was also notable in that it presented the court with an opportunity to answer a lingering question about public accessibility, attorneys said.

In printed publication cases, the Federal Circuit has at times said material will be considered publicly accessible if it was made available to “the extent that persons interested and ordinarily skilled in the subject matter or art” can locate the material exercising reasonable diligence.

Other times, the court has indicated it is looking to see whether people interested in the art could locate the material, dropping the “ordinarily skilled” language.

With GoPro, the Federal Circuit had a chance to clarify whether material that was accessible to an interested person was still is a printed publication if it wasn’t also shown to be accessible to a person skilled in the art, according to Sayres.

“This is the first case to bring that issue to a head,” said Sayres, adding that “the Federal Circuit could have come out and said, here’s what we really mean by that and here’s what it requires or doesn’t require.”

The appeals court didn't exactly do that. What the court did say was that the expertise of the target audience is not dispositive. While that doesn't squarely address the issue, Sayres said it can offer some comfort to a patent challenger.

"It at least seems to suggest that showing dissemination or accessibility to persons of ordinary skill in the art specifically is not a requirement," he said.

--Editing by Philip Shea and Alanna Weissman.