Intellectual Property Alert: When is a Disclosure Considered a Prior Art "Printed Publication"?

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On appeal from the Patent Trial and Appeal Board, the Federal Circuit affirmed-in-part and vacated-in-part the board's decision in two related *inter partes* review (IPR) proceedings that Petitioner, Medtronic, Inc., failed to establish obviousness of the claims in U.S. Patent No. 7,670,358 (the '358 Patent) and U.S. Patent No. 7,776,072 (the '072 Patent).[1] The Federal Circuit held that the board erred in concluding that a video and a binder containing relevant portions of certain slides, which were distributed at various programs in 2003, are not prior art on the grounds that the video and slides were not sufficiently accessible to the public. The Court asserted that the board failed to consider all of the relevant factors in determining whether or not the video and slides are a printed publication within the meaning of 35 USC § 102.

Briefly, Medtronic challenged the validity of claims 1-5 of the '358 patent and claims 1-4 of the '072 patent, both owned by Mark A. Barry, in separate IPRs. Medtronic argued that the claims were invalid over, among other publications, a video entitled "Thoracic Pedicle Screws for Idiopathic Scoliosis" and slides entitled "Free Hand Thoracic Screw Placement and Clinical Use in Scoliosis and Kyphosis Surgery" (collectively the video and slides). The video was distributed on three occasions in 2003, the first of which was a meeting of the "Spinal Deformity Study Group" (SDSG), which was limited to SDSG members. However, the video was also distributed at Medtronic sponsored educational programs opened to surgeons more generally in Colorado Springs and St. Louis. The slides were also distributed during the Colorado Springs event.

Medtronic argued that the board erred by concluding that the video and slides were not sufficiently available to the public because the Colorado Springs and St. Louis events were not limited to SDSG members. In addition, Medtronic argued that even if dissemination of the video and slides were limited to SDSG members, they were still made available to the "interested public," which it argues meets the requirement of public accessibility.

Barry, on the other hand, maintained that the board was correct in finding that the dissemination of the video and slides did not rise to the level of public accessibility necessary to be considered a printed publication because they were only provided to members of SDSG, i.e., experts who are part of a group limited to members only, and not those of ordinary skill.

The Court found that the board failed to fully consider all of the relevant factors in determining whether or not the video and slides are, in fact, "printed publications." As noted by the Court:

> [t]he determination of whether a document is a "printed publication" under 35 U.S.C. § 102(b) "involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public." *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). "Because there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication' bar under 35 U.S.C. § 102(b)." *Blue Calypso*, 815 F.3d at 1348 (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). "A reference will be considered publicly accessible if it was 'disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence[] can locate it.'" Id. (quoting *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

After reviewing relevant precedent on public accessibility, the Court found that the board failed to fully evaluate whether or not dissemination of the video and slides was sufficient to meet the legal requirements for public accessibility. Specifically, the Court noted that the board did not address the differences in the meeting limited to SDSG members with the later meetings opened to a more broad audience. In addition, the Court chided the board for not addressing whether or not there were any confidentially restrictions placed on the materials provided to the attendees of any of the events. In view of this, the Court remanded the case to the board for further consideration as to "whether dissemination of the video and slides to a set of supremely-skilled experts in a technical field precludes finding such materials to be printed publications...."

PRACTICE TIP:

While this case focuses on a potential prior art disclosure by a third party, the principles are equally applicable to disclosures by innovators themselves. Innovators should approach every disclosure of an inventive concept with the utmost care to ensure that the disclosure will not be considered prior art against its own later filed patent application. As noted by the Court, factors, such as the size and technical expertise of an audience must be considered along with a determination of whether there is an expectation of confidentially. In situations where confidentially is necessary, disclosures should not be made without some form of confidentiality agreement. Regardless, it is always a good idea to seek the advice of counsel prior to making any disclosure.

[1] *Medtronic, Inc. v. Barry*, Nos. 2017-1169 & 2017-1170 (Fed. Cir. June 11, 2018).