

# All The 102's That's Fit to Print

UNIVERSITY OF DAYTON PROGRAM IN LAW AND TECHNOLOGY

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LARRY HUSTON US AIR FORCE



# 35 USC §102

## Conditions for patentability; novelty

(a) NOVELTY; PRIOR ART.— A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention;

# Generally Fewer NPL Rejections So Why Do We Care about NPL Rejections?

- Often expands into new fields that are not well developed (theses, industry standards)
- Often showcases new technology not yet in the patent publications (industry posters, professional conferences)
- Often has details of trials and examples which can invalidate narrow, dependent claims (technical publications, white papers)

# Inter Parties Review 35 USC 311- 319

- 35 USC 311(b) A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.
- 35 USC 312(a)(3) A Petition filed under section 311 may be considered only if it includes (A) copies of patents and printed publications that the petitioner relies upon in support of the petition;

# Post Grant Review 35 USC 321 - 327

- 35 USC 322(a)(3) A Petition filed under section 321 may be considered only if it includes
  - (A) copies of patents and printed publications that the petitioner relies upon in support of the petition;

# The Policy

"The 'printed publication' provision of §102(b) 'was designed to prevent withdrawal by an inventor... of that which was already in the possession of the public.'"

*Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)(ellipses in original) (internal citation omitted).

# Basis for the Policy

"This rule is grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone." The patent challenger, bears the burden of establishing that a particular document is a printed publication.

*Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018)(internal citation omitted).

# The Deal

“[I]n consideration for the patent grant, something must be given to the public which it did not have before (albeit that the enjoyment of this ‘something’ may be postponed for 17 years). If the public is already possessed of that ‘something,’ or if it is accessible to the public, there is a failure of consideration and no patent may be granted.”

*In re Tenney*, 254 F.2d 619, 624 (CCPA 1958).  
(discussing microfilm technology and its use in the Library of Congress)

“[I]t would seem to be axiomatic that the printing has to be done before the publishing, otherwise the publication will not be of something ‘printed.’”

*Id.* at 628 (J. Rich concurring)(emphasis added).

# 35 USC 7 - Library

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

MPEP 901.06(a) Scientific and Technical Information Center for Books, Periodicals, Translations, Interlibrary Loans

All printed publications may be used as references, the date to be cited being the publication date.

# MPEP 2100 PATENTABILITY

2128 "Printed Publications" as Prior Art

2128.01 Level of Public Accessibility Required

2128.02 Date Publication Is Available as a Reference

# Fair Use of Copyrighted NPL

The USPTO currently obtains much of its NPL through licenses, and has ensured that its licenses permit it to make copies of copyrighted NPL that is used in examination.

The USPTO does, however, occasionally make copies of unlicensed NPL for use in the examination process, and provides copies of this NPL to applicants. The USPTO considers this copying to be protected by the doctrine of fair use.

The USPTO does not provide copies of copyrighted NPL on Public PAIR because of the concern that such NPL could be used and copied for reasons unrelated to patent matters.

- Memorandum from Bernard Knight, Jr. General Counsel, January 19, 2012

# What is a Printed Publication?

"Whether a reference qualifies as a 'printed publication' is a legal conclusion based on underlying factual determinations."  
*Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014)(citation omitted).

The 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).

# BROAD FACTORS TO CONSIDER

“Factors bearing on whether a document was published include the number of copies made, availability, accessibility, dissemination, and even intent.”

Document was a British report disseminated to US companies.

*Garrett Corp. v. United States*, 190 Ct. Cl. 858, 865; 422 F.2d 874 (1970)(per curiam)(internal citation omitted).

# Is it Really a Printed Publication or is it a “Printable” Publication?

“A reference is proven to be a ‘printed publication’ upon a satisfactory showing that such document has been 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.”

*In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)(internal cites omitted)(op. by J. Rich).

# *In re Wyer*, Looking Closer

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A reference is proven to be a "printed publication" "upon a satisfactory showing that:

1. such document
- 2.a has been disseminated or
- 2.b otherwise made available
3. [before the critical date]
4. to the extent that persons interested and ordinarily skilled in the subject matter or art
5. exercising reasonable diligence
6. can locate it.

# PUBLIC ACCESSIBILITY IS THE TOUCHSTONE

“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).”

Case dealt with chips for wireless communication and a reduced power mode.

ITC held GSM standards were not printed publications. Affirmed.

*Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)(citing *Hall*)(remanded to ITC on other grounds).

# Strategy 1

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Can you disqualify the reference?

# 35 USC 102(b) Exceptions

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

# 37 CFR 1.130 Declarations

(a) Affidavit or declaration of attribution. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the disclosure was made by the inventor or a joint inventor, or the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor.

(b) Affidavit or declaration of prior public disclosure. When any claim of an application or a patent under reexamination is rejected, the applicant or patent owner may submit an appropriate affidavit or declaration to disqualify a disclosure as prior art by establishing that the subject matter disclosed had, before such disclosure was made or before such subject matter was effectively filed, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from

<b>DECLARATION RULE</b>	<b>STATUTORY EXCEPTION</b>	<b>USE</b>
<b>130(a)</b> <b>MPEP 717.01(a)</b>	<b>102(b)(1)(A)</b> <b>102(b)(2)(A)</b>	<b>Attribution: Showing the potential prior art subject matter originated with one or more members of the inventive entity</b>
<b>130(b)</b> <b>MPEP 717.01(b)</b>	<b>102(b)(1)(B)</b> <b>102(b)(2)(B)</b>	<b>Prior Public Disclosure: showing that the potential prior art subject matter was preceded by an inventor-originated disclosure of that same subject matter</b>

USPTO Biotechnology, Chemical, and Pharmaceutical Partnership Meeting June 16, 2021

# But Not More Than One Year Old

37 CFR 1.130(c) ***When this section is not available.*** The provisions of this section are not available if the rejection is based upon a disclosure made more than one year before the effective filing date of the claimed invention. (emphasis in original).

# Strategy 2

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Can you disqualify necessary information as hearsay?

# Petitioner's Burden and Hearsay

Thesis cover page has a stamp "ARCHIVES MASSACHUSETTS INSTITUTE OF TECHNOLOGY APR 11 1996 LIBRARIES."

Held: Stamped date, "would appear to be a hearsay statement to the extent that it would be offered for its truth."

"Further ...the stamp does not establish when, if ever, the thesis became publicly accessible."

*Apple, Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 9, p. 12 (PTAB June 25, 2015)(emphasis added).

# Possible Hearsay Exceptions if You Are Petitioner

FRE 803:

(6) Records of a Regularly Conducted Activity

i.e. Business records

(16) Statements in Ancient Documents

i.e. Prepared before Jan. 1, 1998 and established as authentic

(18) Statements in Learned Treatises, Periodicals, or Pamphlets

Relied upon by expert during direct or cross and established as reliable  
authority

# *In re Wyer*, Looking Even Closer

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A reference is proven to be a "printed publication" "upon a satisfactory showing that:

1. such document
- 2.a has been disseminated or
- 2.b otherwise made available
3. [before the critical date]
4. to the extent that persons interested and ordinarily skilled in the subject matter or art
5. exercising reasonable diligence
6. can locate it.

# *Wyer* Factor 1

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What is a document?

# More Publication and Less Printing

“'[P]rinted publication' should be approached as a unitary concept. The traditional dichotomy between 'printing' and 'publication' is no longer valid.”

With "duplication, data storage, and data-retrieval systems, the 'probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836."

*In re Wyer* 655 F.2d 221, 226 (CCPA 1981)(op. by J. Rich).

# CD-ROM ....and Splitting Hairs

A CD-ROM distributed at a conference before the critical date of the patent. The Board determined that the document itself contained no indication of the date of distribution, and declaration testimony only established that the conference took place on the indicated day, not that the document relied upon in the petition is the same document that was distributed.

*Google, Inc. v. ART+COM Innovationpool GMBH*, IPR2015-00789, Paper 8, pp. 6 - 7 (PTAB Sept. 2, 2015).

# Product Video

Kensington ClickSafe® Keyed Laptop Lock video demonstrated use and functionality of the lock.

Continuously available for at least 11 months, starting with launch.

Held: Printed publication. Claims anticipated.

*Acco Brands Corp. v. Think Products, Inc.*, IPR2015-01167, Paper 40, pp. 16 & 23 (Oct. 11, 2016).

# Online Posts

Paper analyzing TCP/IP gateways was posted on open FTP server for 7 days for peer review. Not publicized.

A PhD peer needed directions to find the posting.

Doubtful anyone outside of review committee would be aware of the paper.

Question whether anyone outside of review committee looking for papers would search the subfolder of an SRI File Transfer Protocol Server. But might have been available to anyone with FTP know-how and knowledge of the specific subdirectory.

Held: Analogized to empty poster at a vacant conference.

Case falls “somewhere between Hall and Bayer.” Remanded.

# Spec Sheet for Computer Chip

Patent to IC chip with fewer leads. Plaintiff sued Intel for infringement by the 2920 chip.

Intel presented “extensive uncontroverted evidence of business practice that was sufficient to prove that [the 2920 chip spec sheet] was widely available and accessible to the interested public before the critical date. Evidence of routine business practice can be sufficient to prove that a reference was made accessible before a critical date.”

*Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 - 69 (Fed. Cir. 1988)(emphasis added)(citing *Hall*).

Remember FRE 803(6).....?

# Industry Standards

“[Global System for Mobile Communications (2G)] specifications, though drafted within smaller technical subcommittees, were widely distributed before the critical date.... Versions of the standard were ‘publicly available and released as consistent sets.’ ... U.S. companies took part in the [European Telecommunications Standards Institute] work and had access to the GSM specifications through their European subsidiaries.”

*Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350 - 51 (Fed. Cir. 2008).

Consider using industry standards if you are attacking a SEP.

# *Wyer* Factors 2.a and 2.b Accessibility

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Was it Disseminated  
or  
Otherwise Made Available?

# Public Accessibility

“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 v Groupon*, 815 F.3d 1331, 1348 (Fed. Cir. 2016)(quoting *In re Hall*)(Fed. Cir.1986)(emphases added).

# The Issue – Is Not Who Saw the Reference

“Accessibility goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to....

If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.”

*Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988)(emphasis added).

# Accessibility Does Not Require Receipt

"A reference is considered publicly accessible 'upon a satisfactory showing that such document has been 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. If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.'"

*Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1355-1356 (Fed. Cir. 2018)(emphasis added)(quoting *Constant*).

# *Wyer* Factor 2.a

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Was it disseminated?

# Professional Conferences

Video and slides disseminated at several professional medical conferences.

CD of the video distributed at 3 conferences,

Slides were distributed at 2 of these 3 conferences.

1st conference was limited to exclusive SDSG member surgeons,

2nd, 3rd conferences open to other surgeons, had 20, 55 surgeons.

Board held the video and slides were not printed publications.

Remanded to consider:

Differences between SDSG meeting and the other meetings,

Whether the meeting were open to people interested,

High expertise of the target audiences and

Expectation of confidentiality - could they share disclosures or even publicize the slides?

# Confidentiality Everywhere

Issue: whether the distribution of two 10 page stent monographs to a limited number of entities without a legal obligation of confidentiality renders the monographs printed publications?

[6 professors, 1 lab tech, several colleagues and 2 companies]

1 company agreement stated: it “shall not be committed to keep secret any idea or material submitted.”

Professional norms may support reasonable expectations of confidentiality.

Policy: preserve the incentive for inventors to participate in academic presentations and discussions.

H: Academic norms support an expectation of confidentiality, even with commercial entities.

# Oral Presentations

Paper on cell culture technology was presented orally to 50-500 cell culturalists who were “interested and of ordinary skill” at the First International Cell Culture Congress, “open to all persons interested in the subject matter” and were “informed of its contents by the oral presentation.”

Following the presentation, copies of the paper given to “as many as six persons.”

Held: paper was a printed publication. 50 to 500 people were told of its existence. ITC holding of invalidity affirmed.

Mass. Inst. of Tech. v. AB Fortia, 774 F.2d 1104, 1108 - 09 (Fed. Cir. 1985)(op by J. Rich).

# Extrinsic Evidence

“THESIS Presented to the Faculty of the Graduate School of Engineering of the Air Force Institute of Technology ... March 1999 Approved for public release, distribution unlimited.” Also 2nd page signed and dated March 8, 1999 by four people.

Although the thesis indicates that it was approved for public release, the petition does not provide evidence extrinsic to the thesis showing when the thesis may have been released or distributed to the public, or that the thesis was entered into a publicly accessible database to be sufficiently accessible to the public interested in the relevant art.

Held: “mere defense of a thesis and placement of the document in a library is insufficient to establish that the thesis is a publication.”

Symantec Corp. v. The Trustees of Columbia Univ., IPR2015-00370, Paper 13, pp. 7 - 9 (PTAB June 17, 2015)(citing *In re Bayer*)(emphasis added).

# *Wyer* Factor 2.b

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Or was the reference otherwise  
made available to the public?

# One Thesis Properly Catalogued

Student PhD dissertation submitted to university library.

Library Director and Loan Manager submitted a Declaration that: “in December 1977 copies of the said dissertation were freely made available to the faculty and student body ... as well as to the general public.” Critical date Feb. 27, 1978.

“Our dissertations ... are indexed in a special dissertations catalogue, which is part of the general users' catalogue. In the stacks they are likewise set apart in a special dissertation section, which is part of the general stacks.”

Held: Rejection affirmed.

*In re Hall*, 781 F.2d 897, 898 - 900 (Fed. Cir. 1986).

# One Thesis Uncatalogued and Unshelved

Thesis title was “Coordination Complexes of 2-methyl-5-hydroxy-1,8-naphthyridine.”

Process of thesis was from student’s defense to faculty committee, to submission by student to the library, to public card catalog being available, to the shelves, etc. Multiple steps and could take a year. Critical date was within that period.

“[S]ince appellant's thesis could have been located in the university library only by one ... informed of its existence by the faculty committee, and not by means of the customary research aids available in the library, the ‘probability of public knowledge of the contents of the [thesis],’ was virtually nil....”

# FDA Advisory Committee Materials

Federal Register Notice of Advisory Comm. Mtg., plus link to background materials on FDA website for 2 months:

- (1) the FDA advisory committee meeting transcript and slides;
- (2) an FDA preliminary clinical safety review of Xyrem® ;
- (3) a Xyrem® briefing booklet; and (4) a proposed distribution system for Xyrem®.

Fed. Reg. Table of Contents arranged alphabetically by agency; then listed agency's rules, proposed rules, and notices.

Held: Pharmacist or scientist would have been familiar w Fed. Reg. and been motivated to look for notices, and particularly for this notice of a drug susceptible to abuse.

# Not All Regulatory Filings are NPL

Public regulatory filings available via FOIA-like procedure in Texas Admin. Code.

Held: The regulatory filings are excepted from public disclosure by statute because they might contain confidential information. IPR institution denied.

*Air Liquide Large Industries U.S. LP v. Praxair Technology, Inc.*, IPR2015-01074, Paper 11, pp. 8 - 10 (PTAB Oct. 26, 2015).

# Indexing is not a Prerequisite

"The test for public accessibility is not 'has the reference been indexed?' ...

We have explained that where indexing is concerned, whether online or in tangible media, the 'ultimate question is whether the reference was available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.'"

Acceleration Bay, LLC v. Activision Blizzard, Inc., 908 F.3d 765, 774 (Fed. Cir. 2018)(citing Voter Verified).

# Printed Publications Don't Need Distribution, Indexing or Copying

Total of 14 slides displayed on poster boards

Approx. 5 slides contained the relevant material of soy cotyledon fibers

Presented for less than 1 day at Kansas State Univ. Agricultural Experiment Station  
and

Presented for 2.5 days at American Assoc. of Cereal Chemists

Held: Printed publication

*In re Klopfenstein*, 380 F.3d 1345, 1349 - 52 (Fed. Cir. 2004).

# *Klopfenstein* Factors 1 & 2

1. “The duration of the display is important in determining the opportunity of the public in capturing, processing and retaining the information conveyed by the reference.”
2. “The expertise of the intended audience can help determine how easily those who viewed it could retain the displayed material.”

# *Klopfenstein* Factors 3 & 4

3. “Whether a party has a reasonable expectation that the information it displays to the public will not be copied aids our 102(b) inquiry.”
4. “Finally, the ease or simplicity with which a display could be copied gives further guidance to our 102(b) inquiry.”

# *Wyer* Factor 3

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Before the filing date

# Splitting Hairs on Operating Manuals

Petitioner relied upon an operating manual included with a product sold prior to the critical date. Petitioner stated only that the JAC H440 splint kit “was on sale at least as early as 1992 – the date of publication of the operating manual.”

Held: Petitioner did not provide sufficient evidence that the operating manual was a printed publication before the critical date. The operating manual was not a printed publication.

*Lantz Medical, Inc. v. Bonutti Research, Inc.*, IPR2015-00995, Paper 11, p. 8 (PTAB Oct. 21, 2015).

# ISBN (International Standard Book Number)

The reference has “ISBN 952-90-8115-4 1996-09-30” on its title page.

Held: ISBN identification does not show publication date, because the ISBN may be obtained before the work is published.

*Square, Inc. v. Unwired Planet, LLC*, CBM2014-00156, Paper 11 (PTAB Dec. 24, 2014).

# LCCCN and Copyright Date

Reference has a copyright date of 1997 and a Library of Congress Catalog Card Number (LCCCN). Critical date was Jan. 9, 1999.

Held: The copyright date simply informs readers of the underlying claim to copyright ownership” in the reference. The copyright date does not demonstrate that the reference was available prior to the critical date of the patent.

The LCCCN, even when considered with the copyright date, is insufficient to demonstrate the reference was publicly accessible prior to the critical date.

*Alarm.com Inc. v. Vivint, Inc.*, IPR2016-00155, Paper 14, pp. 11 - 12 (PTAB Apr. 28, 2016).

# Copyright Date or Revision Date?

User's manual for Seiko USB Function Controller had date that contains the notation "Revision: 2.0,"

Held: Date "may suggest that the document was 'revised' on March 24, 1998, but is not evidence that it was published on that date."

Not a printed publication.

*LG Elecs., Inc. v. Advanced Micro Devices, Inc.*, IPR2015-00329, Paper 13, p. 13 (PTAB July 10, 2015).

# Copyright Date Again

Laird Company White Paper dated Apr. 1, 2010 on cover and copyright date 2010 on last page.

Copyright date “is a hearsay statement offered for its truth—that Laird was publicly accessible on or after April 1, 2010. ... Petitioner does not provide sufficient evidence of the significance of that date with respect to the availability of the document to the public. Thus, the date, by itself, does not establish when, if ever, Laird became publicly accessible.”

*Laird Tech. Inc., v. A.K. Stamping Co. Inc.*, IPR2017-02038, Paper No. 6, pp. 9 - 10 (PTAB Mar. 14, 2018).

# Company Website

Same white paper had Laird company logo and [www.laird.com](http://www.laird.com).

To prove public accessibility of this web address, there needs to be evidence that an interested party could navigate to the reference and “would be independently aware of the web address.”

Furthermore, there is no evidence presented to support that the site had a search function which would allow one of ordinary skill in the art to find the Laird document with reasonable diligence once on the site.

*Laird Tech. Inc., v. A.K. Stamping Co. Inc.*, IPR2017-02038, Paper No. 6, pp. 11 - 12 (PTAB Mar. 14, 2018)(emphasis added).

# Which Edition of the Book? Watch the Dicta

Book had legends “Copyright © 2011 by Anselm Bradford and Paul Haine” and “Made in the USA Middletown, DE 13 December 2015,”  
The Copyright Office Registration Certif. was Nov. 8, 2011 and book was for sale on Amazon Dec. 6, 2011.

Priority date was May 9, 2012.

Held: Nov. 8, 2011 “date of first publication, per Copyright Office's Registration Certificate, supports the 2011 copyright date of the copy obtained from the Library of Congress and is consistent with Bradford being for sale on Amazon in December 2011,” and “indicates it was published by an established publisher.”

Dicta: “When there is an established publisher there is a presumption of public

# Citing *Vidstream* Again

Held: we observe that the page following the cover page states that Cartographic Perspectives is "published triannually...."

Also lists of editorial board members. And the cover indicates that this is the 32nd issue of the journal.

"Taken together, this evidence strongly suggests that it was published by an established publisher."

"[W]hen there is an established publisher there is a presumption of public accessibility as of the publication date."

*Tetra Tech Canada Inc. v. Georgetown Rail Eq. Co.*, IPR2019-01409 Paper 15, p. 24 (PTAB Feb. 2, 2021)(citing *Vidstream*)(emphasis added).

# Citing *Vidstream* Again, Same Parties

Reference was an article at pages 173 -181 of a book titled "Proceedings of the ASME//IEEE Joint Rail Conference and the ASME Internal Combustion Engine Division Spring Technical Conference -2007-."

Cover page states that the papers were presented at the named conference on March 13-16, 2007 in Pueblo, Colorado.

The next page of the volume includes the text "ISBM No. 0-7918-4787-X" and "Copyright © 2007 by ASME."

Held: "ASME is a substantial organization engaged in a host of professional activities such as organizing conferences and publishing volumes of professional work. Taken together, these indicia strongly suggest that Choros was published by an established publisher."

*Tetra Tech Canada Inc. v. Georgetown Rail Eq. Co.*, IPR2019-01581, Paper 17, pp 25 - 26 (PTAB Feb. 11, 2021)(citing *Vidstream*)(emphasis added).

# Another Established Publisher

Patent Owner argued: that even if O'Reilly & Associates is “the most established and well regarded publisher in the Nation,” this would not be probative as to “its publishing procedures or when a specific book was printed and made publicly available.”

Petitioner argued No question that O'Reilly's textbooks, generally, are well-known and publicly available to those in the field. Submitted course syllabi with O'Reilly textbooks listed.

Patent Owner sur-reply that Petitioner's submitted evidence does not support that O'Reilly was a well-known publisher as of the priority date.

Held: None of the course syllabi submitted supports the contention that O'Reilly was an established text book publisher, as all syllabi are after the priority date of the

# *Wyer* Factor 4

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Persons Interested and Skilled in  
the Art or Subject Matter

# Directed to Person of Ordinary Skill?

Several weeks of press release for “analyst day for equity analysts and institutional investors” to “deliver presentations regarding business strategies.” “As a leading global provider of discovery and development services and products for pharmaceutical, biotechnology and medical device companies, PPD applies innovative technologies, therapeutic expertise and a commitment to quality to help clients maximize the return on their R&D investments. With proven early discovery through post-market resources, the company also offers unique compound partnering opportunities. [Included hyperlink.](#)

Slides were presented on microsomal triglyceride transport protein inhibitors and statins.

Petitioner - The artisan is an entire drug development team, at least one would be aware of the presentation.

Patent Owner - Investor day presentation directed to business people, not those of skill in the drug art.

Hold: Press release did not mention the actual diseases to be discussed treatments

# Dealer Trade Shows

Annual sports vehicle dealer trade show - 150 vendors and 1,000 attendees.  
No evidence the show was advertised to the public.  
Hundreds of GoPro catalogs distributed.

Patent Owner argued this trade show is for dealers, not the public, focus is extreme sport vehicles.

Held: Attendees were likely more sophisticated than average consumer.

Even if trade show is not open to public, you can have a printed publication.  
PTAB decision vacated and remanded to consider the catalog.

*GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 694-95 (Fed. Cir. 2018).

# The Channel Not the References

WD4-v3 draft for high-efficiency video coding ('HEVC') were posted to the JCT-VC's public website. JCT-VC was a prominent standards-setting organization in the HEVC space. Joint task force meeting attended by 200 - 300 people, no expectation of confidentiality. Meeting reports directed readers to the website.

" A factor relevant to public accessibility is whether a repository indexes its documents or otherwise categorizes them by subject matter."

"While a showing that the references themselves were prominent would likely establish public accessibility *per se*, such a showing is not required. The relevant inquiry is whether the channel through which the references were publicized is prominent or well-known among persons of ordinary skill in the art."

Practice Tip: Is your patent a SEP?

*M&K Holdings, Inc. v. Samsung Electronics, Inc.*, 985 F.3d 1376, 1382 (Fed. Cir. 2021)(citing *Voter Verified and Samsung*)(emphasis added).

# Professional Websites

Reference was available by subscription to 'Risks Digest' and online. Claim was to computer controlled voting machine.

Held:" the Risks Digest [forum] was well known to the community interested in the risks of computer automation, including those concerned with electronic voting technologies, and by 1999 the Risks Digest contained more than 100 articles relating to electronic voting."

"The uncontested evidence indicates that a person of ordinary skill interested in electronic voting would have been independently aware of [this] ... prominent forum for discussing such technologies."

The Risks Digest website has included a search tool that would have retrieved the Benson article in response to search terms such as "vote, voting, ballot and/or election "

# User Manuals on Professional Sites

User manual of a software program had a posting date on two electronic Bulletin Board Systems and copyright date more than one year prior to the critical date.

Held: Manual was posted on a publicly accessible site—the Invention Factory Bulletin Board System— well known to those interested in the art, and could be downloaded and retrieved from that site, and, therefore, is considered a “printed publication.”

*MC Corp. v. Personal Web Technologies, LLC*, IPR2013-00087, Paper 69, pp. 30 - 34 (PTAB May 15, 2014)(emphasis added).

# *Wyer* Factor 5

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What is reasonable diligence to exercise?

# Balancing Test Implied

“[A] printed publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication.”

*Suffolk Techs. LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014).

# Expect to Have to Travel

Inventor submitted manuscript of his golf invention to the Copyright Office before critical date. Invention was using tees throughout course to improve your game.

A researcher could find the manuscript from the Copyright Office title catalog [searching golf and handicap].

Held:

1) Copies generally not allowed at Copyright Office but inventive concept was simple enough that it would be unnecessary to make a copy.

2) a reference can be considered publicly accessible even if gaining access to it might require a significant amount of travel [or hiring someone local].

# And Even Travel Internationally

September 1977 PhD Dissertation submitted to:  
Department of Chemistry and Pharmacy at Freiburg University  
in the Federal Republic of Germany [between Stuttgart and Bern]

“[W]e reject appellant's legal argument that a single cataloged thesis in one university library does not constitute sufficient accessibility to those interested in the art exercising reasonable diligence.”

*In re Hall*, 781 F.2d 897, 900 (Fed. Cir. 1986).

# The Wayback Machine

Petitioner argued archived web pages from the Wayback machine established publication before the critical date.

Patent owner argued archive date from Wayback machine is not the as the web page date.

Held: “web pages and underlying images were archived on the same date for the purpose of institution ... Patent Owner is correct that the Butler Affidavit asserts embedded images *may not* be archived on the same date as the web page that embeds the image, Mr. Butler does not state that such embedded images *cannot be* archived on the same date.

The necessary “web pages locatable by crawlers of the Wayback Machine would have been locatable to interested persons using typical search

# MPEP 2128.II.E - F

Endorses Wayback Machine as “Prior art obtained via the Wayback Machine<sup>®</sup> sets forth a *prima facie* case that the art was publicly accessible at the date and time provided in the time stamp. The burden then shifts to the applicant should they wish to challenge the authenticity, reliability or accessibility of such information.”

Endorses Social Media “Social media websites on the Internet, such as YouTube<sup>™</sup>, Twitter<sup>™</sup>, Facebook<sup>™</sup>, and public forum posts, can be a source of prior art, ... the accuracy of timestamps on social media websites may need to be scrutinized ... the reliability of some websites do [sic] not approach those of other types of Internet publications.... [A]n applicant or patent owner may challenge its public availability and/or date that it became publicly available ... by filing a proper affidavit or declaration under 37 CFR 1.132.”

# *Wyer* Factor 6

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One Can Locate The Reference

# Can't Find the Thesis by Author Only

Professor at Reed College filed an application for chemical described in 3 undergraduate theses.

Undergraduate thesis is a graduation requirement.

A copy of each thesis is filed in the main college library and the department library. Theses are listed on individual cards which show the student's name and the title of the thesis. The cards are filed alphabetically by the author's name. Main library had 6000 cards, Chemistry Dept. had 450 cards, kept in a shoebox.

Held: “[T]he three student theses were not accessible to the public because they had not been either cataloged or indexed in a meaningful way. Although the titles of the theses were listed on 3 out of 450 cards filed alphabetically by author in a shoebox in the chemistry department library, such "availability" was not sufficient to make them reasonably accessible to the public. Here, the only research aid was the student's name, which, of course, bears no relationship to the subject of the student's thesis....”

*In re Cronyn*, 890 F.2d 1158, 1159 (Fed. Cir. 1989)(reversing the BPAI)(citing *Bayer and Hall*).

# No Meaningful Index

Reference was Working Draft 4 of H.265 standard developed by JCT-VC, 250 members.

Draft was mailed to attendees of JCT meeting.

Held: Doc was posted to website with 4 step procedure to find:

1. Go to website
2. Select menu option for meetings.
3. Select Torino meeting.
4. Select the document identified only by number.

Held: The “cases suggest that a work is not publicly accessible if the only people who know how to find it are the ones who created it.”

Draft was not reasonably accessible, even if one knew of the JCT-VC website.

# Commercial Availability

Dissertation was only available to attendees of the student's presentation [student, faculty, general public who expressed prior interest].  
Again, approval for circulation in SMU library does not establish access.

But ProQuest LLC, commercial portfolio third party content, submitted declaration that the dissertation was in the database, indexed and with an abstract. Records were added monthly and available to anyone with a subscription.

Held: Dissertation was commercially available through third party [even if not available from the university].

*Int'l Bus. Machs. Corp. v. Intellectual Ventures II, LLC*, IPR2015-01322, Paper 12, p. 15 (PTAB Dec. 8, 2015).

# Confidentiality = No access

The documents relating to batch processing for a military system were housed in a library at the corporation.

Access to the library was restricted to persons authorized by Mitre Corp.

Distributed to 50 people.

District court “was unable to find” that anyone could access to the documents by the exercise of reasonable diligence.

Affirmed.

*N. Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 936 - 37 (Fed. Cir. 1990).

# Confidential or Not?

Petitioner's declaration was the critical white paper was published on his company's website and was distributed to several major hotel chains as part of an aggressive marketing campaign.

Expert testimony the URL showed publication.

Held: Every page of the white paper was marked "CONFIDENTIAL." Distribution to hotel chains does not establish when the paper was available to the interested public.

Institution denied. Was it really distributed and when?

*Hospitality Core Servs. LLC v. Nomadix, Inc.*, IPR2016-00052, Paper 8, pp. 8 - 9 (PTAB Apr 27 2016)

# Confidentiality

- Practice Tip: Before/During/After
- Before: Employee handbooks, training, labels.
- During: NDAs, Reminders when distributed to employees or vendors, password protection.
- After: Followup, reminder, specify what is confidential.

# 102(a)(1) In Public use, on Sale, or Otherwise Available to the Public

AIA retained the on sale bar and added the catchall phrase 'or otherwise available to the public.'

Held: New language did not refer to the on sale bar. Therefore sale need not make invention available to the public.

The catch-all phrase "or otherwise available to the public" does not require invalidating sales to publicly disclose details of the invention.

Publicly known sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art under § 102.

*Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628, 633 (2019).

# EPO Article 54(2) Novelty

The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application. (emphasis added).

# **EPO Guidelines for Examination, Part G, Chapter IV.7**

Publication date has two aspects: 1) must be assessed separately whether a given date is indicated correctly and 2) whether the content was indeed made available to the public as of that date.

The more reliable a disclosure, the harder it will be for the applicant to prove that it is incorrect [as to both date and content].

# EPO Guidelines Continued

Recognize IEEE, Derwent, Cornell Library.

Internet disclosures recognized, including software manuals and tutorials, Usenet discussion groups, wiki pages.

Internet disclosure with publication date is taken at face value.

But the 'last modified' date can also be treated as the publication date.

Subsequent written description may be deemed to give true account of oral description before the critical date.

# Practice Tips for NPL Rejections or Defenses at the PTAB

Try to disqualify the reference - disclosure by the inventor

Use the phrase “Not Accessible”

Bookend *Hall* and *Bayer*, be closer to *Bayer*

Use the *Klopfenstein* factors

Think in terms of printable, not printed

Look for accessibility, not actual access

# Practice Tips (Continued)

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Argue no one beyond the author could know of the document

Argue no meaningful index

Look for hearsay dates and no extrinsic evidence

Check the current version was available before the critical date

Try to narrow the target audience

One of skill would not seek out that source

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# All the News That's Fit to Print

## First use in commerce 1896

Questions?

