

New Jersey Law Journal

VOL. CLXXVIII – NO. 4 – INDEX 416

OCTOBER 25, 2004

ESTABLISHED 1878

IN PRACTICE

INTELLECTUAL PROPERTY LAW

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Preserving Patent Rights Just Got Tougher

In light of a Federal Circuit ruling, companies must be careful not to make patent-invalidating presentations

Does your company or institution display its technology at trade shows, conferences or learned symposia? If so, a recent decision by the highest patent court in the country, the United States Court of Appeals for the Federal Circuit, directly impacts your ability to disclose technology while preserving patent rights. *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004).

U.S. Statute Bars Patentability

In the United States, an inventor is entitled to a patent unless, among other things, the invention is described in a printed publication in this country or a foreign country more than one year prior to the date that an application for patent is filed. 35 U.S.C. § 102(b). The statutory phrase “printed publication” has been interpreted to mean that, before the critical date, the reference must have been sufficiently available to the public interested in the technology to find that the reference was “published.” *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988)), *In re Hall*,

781 F.2d 897 (Fed. Cir. 1986).

The patent community had believed that to qualify as a “printed publication,” the reference must have been distributed to members of the relevant public, and/or have been indexed to provide public access. However, on Aug. 18, 2004, the Federal Circuit reduced the requirements for finding a reference “publicly accessible” for purposes of qualifying as a printed publication.

In the recent case of *In re Klopfenstein*, a three-judge panel announced for the first time that neither dissemination nor indexing (cataloging) is required to establish the availability of a printed publication as a statutory bar under 35 U.S.C. § 102(b). Specifically, the Federal Circuit found “publication” sufficient based on applicants’ slide presentation printed and pasted onto poster boards and continuously displayed (i) for two-and-one-half days at a meeting of the American Association of Cereal Chemists (AACC), and, one month later, (ii) for less than a day at an Agriculture Experiment Station (AES) at Kansas State University. The slide presentation was made two years before the application filing date, and disclosed every element of the invention claimed in the subject application. There was no dis-

claimer or notice to the intended audience that prohibited either note taking or copying of the presentation.

The Federal Circuit found that the Patent and Trademark Office was correct in finding that the poster board display was sufficiently publicly accessible to qualify as a “printed publication” under the statute even though (i) no copies were disseminated at either the AACC meeting or at the AES, and (ii) the presentation was never cataloged or indexed in a library or database. The Federal Circuit, therefore, held the presentation to be a “printed publication.”

Previous Cases

In the *Klopfenstein* decision, the Federal Circuit explained that the publication bar is based on the principle that once the invention is in the public domain, it is no longer patentable. According to the court, there are many ways in which a reference can be made known to the public. “Public accessibility” was said to be the touchstone in determining whether a reference can constitute a “printed publication” bar under 35 U.S.C. § 102(b). The court referred to several previous cases in support of its decision.

For example, the court referred to the case of *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989). In *Cronyn*, college students presented undergraduate theses to a committee of four faculty members. These theses were later cataloged in an

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index in the main college library. The index included thousands of individual cards that contained only a student's name and the title of his or her thesis. The actual theses were not included in the index or made publicly accessible. The Federal Circuit held in *Cronyn* that, since the theses were only presented to a handful of faculty members, and had not been catalogued or indexed in a meaningful way, they were not sufficiently publicly accessible for the purposes of 35 U.S.C. § 102(b). *In re Cronyn*, 890 F.2d at 1161.

In *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986), the Federal Circuit found that a thesis filed and indexed in a university library qualified as a "printed publication" under 35 U.S.C. § 102(b). In *Hall*, the indexed theses were on file and made freely available to the general public by the university more than one year before the filing date of the relevant patent application. According to the *Klopfenstein* decision, the court in *Hall* did not rest its holding merely on the indexing of the thesis, but used it as a factor in determining "public accessibility." *In re Hall*, 781 F.2d at 898-99.

Similarly, in *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104 (Fed. Cir. 1985), a paper delivered orally to the First International Silk Culture Congress was considered a "printed publication." At least 500 persons having skill in the art heard the presentation. A key to the court's finding was that actual copies of the presentation were distributed. The court in *Klopfenstein*, however, held that the *MIT* court did not limit its determination of public accessibility to instances in which copies of the references were actually offered for distribution. *MIT*, 774 F.2d at 1108-10.

Finally, the Federal Circuit referred to *In re Wyer*, 655 F.2d 221 (CCPA 1981). In *Wyer*, the court determined that an Australian patent application kept on microfilm at the Australian Patent Office was sufficiently accessible to the public to qualify as a "printed publication." *In re Wyer*, 655 F.2d at 226. The Federal Circuit in *Klopfenstein* noted that the court in *Wyer* came to this conclusion whether

or not there was actual viewing by the public or dissemination of the application. It was sufficient that the records of the application were kept so that the public could access them at any time.

In sum, the Federal Circuit in *Klopfenstein* considers public accessibility to be the criterion by which a prior art reference is judged for the purpose of a bar under 35 U.S.C. § 102(b). The court will apparently rely on facts such as distribution and indexing, but not to the exclusion of all other measures of public accessibility. Thus, distribution and indexing were not the only factors considered by the court in *Klopfenstein* to be relevant in a "printed publication" enquiry.

Public Accessibility Factors

According to the Federal Circuit in *Klopfenstein*, the determination of whether a reference is a "printed publication" involves a case-by-case enquiry of the facts and circumstances regarding the reference's disclosure to the public. The *Klopfenstein* court found that the applicants' slide presentation was a printed publication and, thus, a statutory bar because of the following factors:

- The reference was displayed to the public approximately two years before the application was filed;
- The reference was shown to a wide variety of viewers, a large portion of whom possessed skill in the art of cereal chemistry and agriculture (the subject matter of the application);
- The reference was prominently displayed for approximately three cumulative days at the AACC and the AES; and
- The reference was shown with no stated expectation that the information would not be copied or reproduced by those viewing it.

As mentioned above, it was not controlling that the reference was not distributed or that the display was not later indexed in a database, catalog or library.

Thus, in its analysis, the Court relied on (i) the length of time the display was exhibited, (ii) the expertise of the audience, (iii) the lack of notice or

reasonable expectation that the material displayed would not be copied and (iv) the simplicity with which the material could have been copied, as contributing to finding the subject reference a "printed publication" under 35 U.S.C. § 102(b).

Preventing Inadvertent Publication

Don't distribute. If the cases are consistent on any factor, it's the requirement to refrain from distributing copies of the reference. This would include availability on the Internet. In addition, your company or institution should have firm control of any copies of the printed material which constitutes the reference. In that way, an attack on the patent based on an argument of unauthorized dissemination of the presentation may be rebutted.

Don't index or catalogue. Simply stated, don't place the printed reference in a location (e.g., repository, library, database, etc.) where access can be had by research or investigation. Even if buried in an archival environment, availability to the public by index or catalogue may be sufficient for a finding of "public accessibility."

Disclose only a short time. The duration of the display plays a part in determining the importance of the public capturing, processing and retaining the information conveyed by a reference. The more transient the display, the less likely it is to be considered a "printed publication." For example, in *Regents of the Univ. of Cal. v. Howmedica, Inc.*, 530 F.Supp. at 846, 860 (D.N.J. 1981), it was held that a presentation of lecture slides of limited duration was insufficient to constitute a publication under 35 U.S.C. § 102(b).

The expertise of the intended audience is also a factor. Even though a display may be so short in duration as to be "ephemeral," it may be sufficient if the audience is able to observe and identify that which is new and useful. *Jockmus v. Leviton*, 28 F.2d 812, 813-14 (2d Cir. 1928).

Don't permit copying. The possibility of copying is also important to a determination of public accessibility. Thus, where a publication is not able to

be copied or if steps are taken to prevent the public from copying temporarily posted information, it may be held that the publication is not public for the purposes of a statutory bar. Protective measures could also be put into place, e.g., license agreement, nondisclosure agreements, anti-copying software or even a simple disclaimer informing members of the viewing public that no copying of

information is allowed.

Conclusion

Thus, it may be possible to prevent a patent-invalidating presentation or disclosure. At a minimum, permit no dissemination of the disclosed material, and do not make the material available through an index or catalogue.

And if making a presentation, the display of written materials should be relatively short, with a requirement that the viewers not be entitled to make notes or copy any information contained therein. Based on the Federal Circuit's most recent analysis, one could expect at least to minimize the risk of a statutory bar under 35 U.S.C. § 102(b). ■