Keywords: **prior art; 35 U.S.C. § 102(b); publically accessible; critical date**

General: **The Federal Circuit reverses a rejection that was based on a manuscript submitted by the inventor to the U.S. Copyright Office more than one year before the filing of the patent application because the Office did not establish when the manuscript was indexed and publicly accessible.**

In re Lister
92 U.S.P.Q.2d 1225 (Fed. Cir. 2009)
Decided September 22, 2009

I. Facts

Dr. Lister appeals from a decision of the Board of Patent Appeals and Interferences that affirmed the Examiner's rejection of claims 21-25 under 35 U.S.C. § 102(b). Dr. Lister is a clinical psychologist and avid sportsman. Dr. Lister used to compete in organized golf tournaments where he observed that casual golfers had great difficulty hitting balls that were not teed up. Dr. Lister recognized that casual golfers could improve their scores in a shorter time if they were able to tee up each time they hit the ball, except in hazard areas and the putting green. In order to protect his idea, Dr. Lister wrote a manuscript covering the idea and filed a copy with the United States Copyright Office on July 4, 1994. Learning that copyright law would not prevent others from using his idea, Dr. Lister on August 5, 1996 filed for patent protection in the U.S.P.T.O. For the next thirteen years Dr. Lister fought with the U.S.P.T.O. for a patent on his method for playing golf. On January 31, 2003 the Examiner rejected claims 21-25 under 35 U.S.C. § 102(b), with Dr. Lister's copyrighted manuscript. Dr. Lister appealed the Examiner's decision to the B.P.A.I. but was unsuccessful. The B.P.A.I. found that the copyright registration for Dr. Lister's manuscript was issued on July 18, 1994, more than one year prior to the filing of the application with the U.S.P.T.O. and that an interested researcher would have been able to find the manuscript by researching the United States Copyright Office's automated catalog. Dr. Lister subsequently appealed the decision to the Federal Circuit.

II. Issues

A. Was the manuscript publically accessible?

B. Did the U.S.P.T.O. establish a *prima facie* case that the manuscript was publically accessible prior to the critical date?

III. Discussion

A. Yes. The Federal Circuit found that the manuscript was publically accessible within the meaning of 35 U.S.C. § 102(b). First, Dr. Lister argued that the manuscript was inaccessible to the public because it required that the public travel to the Copyright Office, located in Washington D.C., in order to inspect a copy. The Federal Circuit rejected this argument and stated that "a reference can be considered publicly accessible even if gaining access to it might require a significant amount of travel." *In re Lister*, 92 U.S.P.Q.2d at 1229.

Second, Dr. Lister argued that because no one had inspected the manuscript combined with the difficulty of reaching the Copyright Office made the manuscript unavailable to the public. Again, the Federal Circuit rejected Dr. Lister argument and stated that "once accessibility is shown, it is

unnecessary to show that anyone actually inspected the reference." *In re Lister*, 92 U.S.P.Q.2d at 1229.

Finally, Dr. Lister argued that the catalogs and databases relied on by the Examiner were insufficiently searchable to lead an interested researcher to the manuscript, making it inaccessible to the public. The Federal Circuit found that there were three databases that could be searched in order to find Dr. Lister's manuscript. The first database was the Copyright Office's automated catalog. Dr. Lister argued that the automated catalog did not catalog or index the manuscript in a meaningful way so as to permit an interested researcher to locate it. The Copyright Office's automated catalog can only be searched by using the first word in the title or by the last name of the author. Furthermore, the automated catalog cannot be searched by subject matter or keyword. The Federal Circuit agreed with the Government that the automated catalog alone was insufficient to support a finding of public accessibility. While the automated catalog of the Copyright Office was incapable of leading an interested person to the manuscript, the Federal Circuit found that the Westlaw and Dialog databases were sufficient. In contrast to the automated catalog the Westlaw and Dialog databases are capable of performing keyword searches of titles. Dr. Lister argued that searching words in the manuscript's title would have inundated the researcher with irrelevant results making the manuscript inaccessible. The Federal Circuit rejected this, holding that the test is not whether a researcher could have executed a single search that would have yielded all relevant results but rather whether it could be located by one interested and ordinarily skilled in the subject matter. *In re Lister*, 92 U.S.P.Q.2d at 1230. The Federal Circuit found that a reasonably diligent researcher in this case, with access to the databases, could have performed several title keyword searches and found the manuscript. *Id*.

B. No. The Federal Circuit found that the U.S.P.T.O. did not establish that the manuscript was publically accessible prior to the critical date. Dr. Lister argued that without evidence showing that the title was included in the Westlaw or Dialog databases prior to the critical date, the manuscript could not be considered a printed publication publically accessible prior to the critical date. The court agreed with Dr. Lister and quoted the M.P.E.P. § 2128 which states "prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publically posted. Absent evidence of the date that the disclosure was publicly posted…it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)." First, the Federal Circuit rejected the government's position that Dr. Lister's IDS disclosed the date that the manuscript was incorporated into the Westlaw or Dialog databases. In fact, Dr. Lister's IDS did not identify a specific date that the manuscript title was incorporated into the databases but stated "the information in the commercial databases came directly from the Library of Congress." *In re Lister*, 92 U.S.P.Q.2d at 1231. The court found that "directly" was not a sufficiently identifiable date. Second, the Federal Circuit rejected the government's argument that the title of the manuscript was included in the commercial databases shortly after the Copyright Office granted the certificate of registration. The court found that the government did not present evidence about the general practices of the Copyright Office, Dialog or Westlaw that would have indicated when the manuscript title was publically available. The court stated that general practices can demonstrate when a printed publication became publically accessible, but that in this case the government had failed to do so. *In re Lister*, 92 U.S.P.Q.2d at 1231. Without evidence of an actual date that the printed publication was published or general practices of the Copyright Office, Westlaw, or Dialog, Dr. Lister's manuscript was not considered a printed publication more than one year prior to the filing date.