Keywords: **printed publication; public disclosure; public dissemination**

General: A reference qualifies as a "printed publication" if it 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.

Medtronic, Inc. v. Mark A. Barry (Fed. Cir. 2018)
Decided June 11, 2018

I. Facts

Mark Barry owns U.S. Patent Nos. 7,670,358 and 7,776,072, which are directed toward ameliorating scoliosis and similar spinal conditions. Medtronic is a manufacturer of surgical systems and tools used in spinal surgeries. Barry sued Medtronic in the Eastern District of Texas for infringement of the '358 and '072 patents. Medtronic then petitioned for, and the Board instituted, IPR proceedings for all claims in the '358 and '072 patents.

During the IPR, Medtronic submitted several alleged prior art references, arguing that the claims in the '358 patent and the '072 patent were obvious over various combinations of the submitted references. Of particular relevance, Medtronic submitted to the Board a video entitled "Thoracic Pedicle Screws for Idiopathic Scoliosis" and PowerPoint slides entitled "Free Hand Thoracic Screw Placement and Clinical Use in Scoliosis and Kyphosis," hereinafter referred to as "Video and Slides," which Medtronic had displayed and distributed at several industry meetings predating the priority dates of the '358 and '072 patents by several years. One of the industry meetings was limited to members of the "Spinal Deformity Study Group" (SDSG), but at least two of the industry meetings were open to other surgeons. Binders containing relevant portions of the Video and Slides were distributed at certain of the industry meetings. The parties do not dispute the fact that the Video and Slides were not distributed, by Medtronic or any other party, at any point after the industry meetings.

Upon review, the Board excluded the Video and Slides as prior art references on the grounds that their display and distribution to industry experts during the industry meetings did not constitute printed publications within the meaning of pre-AIA 35 U.S.C. § 102(b). After excluding the Video and Slides as prior art, the Board held that the claims in the '358 and '072 patents were patentable over the remaining references submitted by Medtronic. Medtronic appealed.

II. Issues

Did the Board err in its analysis of whether Medtronic's display and distribution of the Video and Slides at various industry meetings constituted "printed publications?"

III. Discussion

Yes. Relying on *In re Hall*, the court noted that, since there are many ways in which a reference may be disseminated to the interested public, "public accessibility" is the key criteria in determining whether a reference constitutes a "printed publication." Further, relying on *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, the court noted that a publicly accessible document is one which 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. Since it is not contested that Medtronic's Video and Slides were only displayed and distributed at the industry meetings, the court reasoned, the question here is whether the Video and Slides were sufficiently disseminated at the time of any one of the industry meetings to constitute a "printed publication." Barry's argument, which the Board essentially adopted in its decision, was that the Video and Slides were distributed to expert industry personnel, instead of persons interested and ordinarily skilled in the art. Usually attached to

this argument is the notion that there is an expectation of confidentiality with respect to the distributed documents.

Citing *In re Klopfenstein*, the court noted that determination of whether a document is a "printed publication" is a case-by-case inquiry into the facts and circumstances surrounding the references disclosure to members of the public. That is, whether the document was sufficiently disseminated to constitute a "printed publication" depends on a comprehensive analysis of the case-specific facts. Thus, the court laid out various factors which may be considered when determining whether a document was sufficiently disseminated to constitute a "printed publication" bar. The court relied upon *In re Klopfenstein*, for example, as particularly instructive in its identification of the following relevant factors: (1) the length of time the display was exhibited; (2) the expertise of the target audience; (3) the existence of reasonable expectations that the material displayed would not be copied; and (4) the simplicity or ease with which the material displayed could have been copied. However, the court cited other factors from other cases which may also be considered, such as the size and nature of meetings or conferences having the display at issue.

While the court did not appear to establish a bright-line rule regarding factors requiring consideration (although it did favorably consider the *Klopfenstein* as instructive), the court held that the Board erred in its analysis because it did not properly address the potentially critical differences between the industry meeting requiring SDSG membership and the industry meetings not requiring SDSG membership. For example, Medtronic argued, and the court echoed in its opinion, that the Board's decision improperly suggested only SDSG members had received the Video and Slides, when in reality non-SDSG members who worked in the industry also received relevant portions of the Video and Slides. Further, the court held that even if the Video and Slides had only been distributed to SDSG members, the Board failed to address whether such distribution should remain confidential. That is, while the Board asserted that SDSG members are industry experts, the Board did not address whether dissemination of the Video and Slides to industry expert, SDSG members implied any expectation of confidentiality. Thus, the court vacated the Board's findings regarding the Video and Slides.

IV. Conclusion

The court held that the Board failed to consider critical factors for determining whether Medtronic's Video and Slides had been sufficiently disseminated to constitute "printed publications."