

## ***DISCLOSURES UNDER THE AIA***

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### ***A. Introduction***

There are two categories of prior art under the America Invents Act (AIA). 35 U.S.C. §102(a)(1) prior art disclosures, including patents, which are considered prior art as of their grant date; printed publications, which are considered prior art as of their publication date; and evidence that the claimed invention was in public use, on sale, or otherwise available to the public, which are eligible as prior art as of the date of public use or offer for sale. 35 U.S.C. §102(a)(2) prior art includes U.S. patents, U.S. pre-grant patent application publications and WIPO published applications that designate the United States. These patents and patent publications are eligible as prior art as of their effective filing date. This article will discuss each type of prior art disclosure set forth in §102(a)(1) based on the Manual of Patent Examination Procedure (MPEP) and recent case law. The article will not discuss prior art under §102(a)(2).

### ***B. Differences between Pre-AIA §102 and AIA §102***

Pre-AIA §102 defines prior art using many of the same terms "patented," "printed publication," "public use," and "on sale" that are used in in pre-AIA §102. Thus, the meaning of these terms may be reasonably understood in view of the extensive case law developed prior to the effective date of the AIA. The MPEP provides discussions as to these terms based on such case law developed prior to the effective date of the AIA. However, under pre-AIA 35 U.S.C. 102(b), an invention that was "in public use" or "on sale" was considered prior art only if the

public use or sale occurred “in this country,” i.e., in the United States. Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation where prior public use or sales occur. MPEP 2152.02(c).

Another difference between pre-AIA disclosures and AIA disclosures is that inventor-originated pre-AIA disclosures made one year before the *U.S. filing date* of the claimed invention under 35 U.S.C. §102(b) are considered prior art. Under AIA 35 U.S.C. § 102(b)(1), inventor-originated disclosures made one year before the "effective filing date," which may include a foreign filing date, are considered prior art. AIA 35 U.S.C. § 100(i) defines the "effective filing date" as including both U.S. and foreign filing dates.

### ***C. Exceptions***

#### **Grace Period Inventor Disclosure Exception**

A disclosure that would otherwise qualify as prior art under AIA 35 U.S.C.102(a)(1) may be disqualified as prior art under 35 U.S.C. §102(b)(1)(A) if the disclosure is made: (1) "one year or less before the effective filing date of the claimed invention;" and (2) "by the inventor or a joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor." MPEP 2153.01(a) explains that USPTO examiners will not apply a disclosure as prior art under AIA 35 U.S.C. 102(a)(1) if it is apparent from the disclosure itself that it is by the inventor or a joint inventor. Applicants may include a statement designating any grace period inventor disclosures in the specification. Due to the language "or a joint inventor" in the statute, in circumstances where an application names additional persons as joint

inventors relative to the inventors or authors of a publication (e.g., application names joint inventors A, B, and C, and reference names authors A and B), and the publication is one year or less before the effective filing date, the disclosure will be considered a grace period inventor disclosure by examiners, and the publication would not be treated as prior art. However, if the application names fewer joint inventors than a publication (e.g., application names joint inventors A and B, and reference names authors A, B and C), it would not be readily apparent from the publication was made by only "joint inventors." Therefore, examiner will presume that the publication is as prior art unless the applicant is able to provide evidence that the authorship of the reference is not the same as its inventor.

#### Grace Period Inventor Disclosure Before Intervening Disclosure by Third Party

AIA §102(b)(1)(B) provides another exception in which a third party's intervening disclosure is not considered prior art if the "inventor or a joint inventor, or another who obtained the subject matter directly or indirectly from the inventor or joint inventor" disclosed the same subject matter before the subject matter was disclosed by the third party. We are not aware of a court decision or a PTAB decision discussing this exception.

MPEP 2153.02 explains that the inventor's prior disclosure could potentially prevent some of the third party's disclosure from being considered as prior art: "For example, if the inventor or a joint inventor had publicly disclosed elements A, B, and C, and a subsequent intervening grace period disclosure discloses elements A, B, C, and D, then only element D of the intervening grace period disclosure is available as prior art under AIA §102 (a)(1)."

Regarding a genus-species relationship between inventor disclosure and the third party disclosure, MPEP 2153.02 also explains that a third party's disclosure of a species will be

considered prior art over the inventor's prior disclosure of a genus: "if the inventor or a joint inventor had publicly disclosed a genus, and a subsequent intervening grace period disclosure discloses a species, the intervening grace period disclosure of the species would be available as prior art under AIA 35 U.S.C. 102(a)(1)."

#### ***D. Patented***

If a claimed invention was patented in the United States or a foreign country before the effective filing date of the claimed invention, §102(a)(1) precludes the grant of a patent on the claimed invention. MPEP 2152.02(a). The effective date of the patent for purposes of determining whether the patent qualifies as prior art under §102(a)(1) is the grant date of the patent. *Id.* If the patent is secret as of the date the rights are awarded, the patent is available as prior art as of the date the patent was made available to the public by being laid open for public inspection or disseminated in printed form. *See In re Carlson*, 983 F.2d 1032, 1037, 25 USPQ2d 1207 (Fed. Cir. 1992).

#### ***E. Printed Publication***

For many references, such as U.S. and foreign pre-grant publications or widely disseminated publications, there is no question regarding whether a reference qualifies as a "printed publication" and the date of publication is easily understood. However, for many non-patent literature references, there may be a factual dispute regarding whether the reference qualifies as a "printed publication," and what date the reference was "published." A reference is a prior art "printed publication" if the reference it is publicly accessible. *See* MPEP 2128(I). In

particular, a reference is proven to be a printed publication “upon a satisfactory showing that the 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, 210 USPQ 790 (CCPA 1981).

## **1. MPEP Examples**

### Electronic publications

An electronic publication, including an online database or Internet publication (e.g. discussion group, forum, digital video, and social media post), is considered to be a “printed publication” within the meaning of §102(a)(1) provided the publication was accessible to persons concerned with the art to which the document relates. *See In re Wyer*, 655 F.2d 221, 227, 210 USPQ790, 795 (CCPA 1981).

Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. Absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art under §102(a)(1). MPEP 2128(II).

### Available as prior art whether or not someone actually looked at a publication

One need not prove someone actually looked at a publication when that publication is accessible to the public through a library or patent office. *See In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986).

### Thesis placed in a library

MPEP 2128.01 explains the level of public accessibility required to be eligible as printed publication based on case law. For instance, a doctoral thesis indexed in a manner that was

meaningful to a searcher and shelved in a library is sufficiently accessible to the public to constitute prior art as a “printed publication.” *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986).

In contrast, the court held that students’ theses were not accessible to the public when doctoral theses were shelved and indexed by index cards which only listed the student name and title of the thesis. *In re Cronyn*, 890 F.2d 1158, 13USPQ2d 1070 (Fed. Cir. 1989). The court reasoned that the theses had not been either cataloged or indexed in a meaningful way since thesis could only be found if the researcher’s name was known, but the name bears no relationship to the subject of the thesis.

#### Oral presentation of paper

A paper which is orally presented in a forum open to all interested persons constitutes a “printed publication” if written copies are disseminated without restriction. *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985). With regard to an oral presentation itself, MPEP 2128.01(II) indicates that it may be prior art under 35 U.S.C. 102(a)(1)’s provision: “otherwise available to the public.”

#### Internal documents intended to be confidential

MPEP 2128.01(III) indicates that documents and items only distributed internally within an organization which are intended to remain confidential are not “printed publications” no matter how many copies are distributed. There must be an existing policy of confidentiality or agreement to remain confidential within the organization. Mere intent to remain confidential is insufficient. *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Inter. 1987).

### Publicly displayed documents

MPEP 2128.01(IV) states that a publicly displayed document where persons of ordinary skill in the art could see it and are not precluded from copying it can constitute a “printed publication,” even if it is not disseminated by the distribution of reproductions or copies and/or indexed in a library or database.

### Date of accessibility

Specific evidence showing when the specific document actually became available is not always necessary. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), cert. denied, 988 U.S. 892 (1988) (Court held that evidence submitted by Intel regarding undated specification sheets showing how the company usually treated such specification sheets was enough to show that the sheets were accessible by the public before the critical date.). Evidence showing routine business practices can be used to establish the date on which a publication became accessible to the public. MPEP 2128.02(I).

### Available as prior art on date of it is received by a member of public

A publication disseminated by mail is not prior art until it is received by at least one member of the public. MPEP 2128.02(II). Thus, a magazine or technical journal is effective as of the date when first person receives it, not the date it was mailed or sent to the publisher. *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956).

## **2. Recent Examples - Federal Circuit and PTAB**

### Sales catalog was used in a dealer show

***GoPro, Inc. v. Contour IP Holding LLC*, 2017-1894, 2017-1936 (Fed. Cir. July 27, 2018)**

A sales catalog was used in a dealer show. In an IPR proceeding regarding a patent directed to a point of view ("POV") digital camera system, the Board found that the sales catalog did not qualify as a prior art printed publication because the dealer show was only open to dealers but not to the public. In particular, the Board indicated that there is no evidence that the dealer show was advertised or announced to the public, such that a person interested and ordinarily skilled in the art from the public would have known about it. Specifically, the Board found that a person ordinarily skilled in the art would not be interested in the dealer show because it was not an academic conference or camera industry conference, but rather a dealer show for action sports vehicles like motorcycles, motorbikes, ATVs, snowmobiles, and watercraft. The CAFC did not agree. In particular, the CAFC stated that the fact that the dealer show is focused on action sports vehicles is not preclusive of persons ordinarily skilled in the art from attending to see what POV digital cameras were being advertised and displayed. The CAFC noted that as described in the patents, a primary purpose of POV cameras is for use on vehicles in extreme action environments, such as the ones advertised at the dealer show. Therefore, the CAFC stated that it is more likely than not that persons ordinarily skilled and interested in POV action cameras were in attendance or at least knew about the trade show and expected to find action sports cameras at the show. As such, the CAFC found that the sales catalog constitutes a prior art printed publication.

#### Video and slide presentation

#### ***Medtronic, Inc. v. Mark A. Barry, 2017-1169, 2017-1170 (Fed. Cir. June 11, 2018)***

The patent was directed to a method for ameliorating aberrant spinal column deviation conditions, such as scoliosis. The issue was whether a video demonstration and a related slide



presentation to spinal surgeons at various industry meetings and conferences constitutes a prior art printed publication. The CAFC indicated that a printed publication “need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication.” Since the parties here did not allege that the Video and Slides were stored somewhere for public access after the conferences, the CAFC stated that the question becomes whether such materials were sufficiently disseminated at the time of their distribution at the conferences. The Court indicated that an expectation of confidentiality is an important factor in cases where copies of presentation materials were distributed. For instance, the Court explained that as for the doctor’s presentation of his work to his university and hospital colleagues, there was an expectation that disclosures would remain confidential in view of the academic norms. The Court further explained that several factors should be considered when copies of presentation materials were not distributed. Such factors are (1) “the length of time the display was exhibited,” (2) “the expertise of the target audience” (to determine how easily those who viewed the material could retain the information), (3) “the existence (or lack thereof) 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. Since the Board did not consider or analyze such relevant factors, the CAFC vacated the Board finding.

Russian State Library

***Global Foundries v. Zond*, IPR2014-008211, Paper 47 (Sept. 25, 2015)**

The cited reference was a doctoral thesis at Moscow Engineering Physics Institute. The petitioner proffered a copy of the catalog entry for the Thesis at the Russian State Library and a certified English-language translation. The petitioner alleged that the thesis was cataloged by the

Russian State Library either by the imprint date of 1994, or at least by 1995, as shown on the catalog entry. These dates are well before the critical date of the patent, November 4, 2002.

The petitioner explained that the Russian State Library is an institution by definition established to share the information that it houses with any interested person. The patent owner argued that the petitioner provided no evidence that the phrase "Imprint Moscow 1994" appearing on the catalog entry means that the thesis was cataloged on that particular date. The Board found that evidence establishing a specific date of cataloging and shelving before the critical date would have been desirable, but it is not required in a public accessibility determination. Therefore, the Board held that the thesis is a printed publication.

#### Copyright notice

"A 'printing date' [on a reference] is not, however, without more, sufficient evidence of public accessibility as of that particular date." *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00690, Paper 43 at 19 (PTAB Oct. 19, 2015) (Final Written Decision). Indicators of a copyright date "have been regarded as sufficient to establish a threshold showing that a document was a printed publication as of the date of the copyright notice." *Ford Motor Co. v. Cruise Control Technologies LLC.*, IPR2014-00291, Paper 44 at 8 (PTAB June 29, 2015) (Final Written Decision).

#### ***F. Public Use***

##### Test for public use

The proper test for the public use is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. The test for the public use prong includes the

consideration of evidence relevant to experimentation, as well as, *inter alia*, the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 76 USPQ2d 1744 (Fed. Cir. 2005). To constitute the public use of an invention it is not necessary that more than one of the patent articles should be publicly used, and one well defined case of such use is just as effectual to annul the patent as many. Likewise, it is not necessary that more than one person use the invention. *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881).

### **1. MPEP Examples**

MPEP 2133.03(a) explains that “public” is not necessarily synonymous with “non-secret.” In addition, the same section explains that when the inventor or someone connected to the inventor puts the invention on display or sells it, there is a “public use” even though by its very nature an invention is completely hidden from view as part of a larger machine or article, if the invention is otherwise used in its natural and intended way and the larger machine or article is accessible to the public. In contrast, there is no public use if inventor restricted use to locations where there was a reasonable expectation of privacy and the use was for his or her own equipment. Moreover, the presence or absence of a confidentiality agreement is not dispositive of the public use, but is one factor to be considered in assessing all the evidence. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc.*, 386 F.3d 1371, 1380-81, 72 USPQ2d 1901, 1909 (Fed. Cir. 2004).

If the inventor allows another to use the invention without restriction or obligation of secrecy, an invention is in public use. MPEP 2133.03(a). In addition, any nonsecret use of an

invention by someone unconnected to the inventor, such as someone who has independently made the invention, in the ordinary course of a business for trade or profit may be a public use. *Bird Provision Co. v. Owens Country Sausage, Inc.*, 568 F.2d 369, 374-76, 197 USPQ 134, 138-40 (5th Cir. 1978). Furthermore, even a secret use by another inventor of a machine or process to make a product is public if the details of the machine or process are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 114 F.2d 28, 46 USPQ 430 (2d Cir. 1940).

## **2. Recent Examples - Federal Circuit and PTAB**

### Invention used in vehicle models

#### ***Arkema Inc. v. Honeywell Int'l Inc., PGR2016-00012, Paper 13 (PTAB Sep. 2, 2016)***

The petitioner argued that the patent invention was in commercial use prior to the effective filing date since four vehicle models used the features of the invention. In particular, the petitioner submitted a witness testimony which shows that the four vehicle models used the claimed refrigerant-lubricant composition. The Board found that the invention was in public use prior to the effective filing date.

### Corroboration required for witness testimony

#### ***Netsirv v. Boxbee, Inc., PGR2015-00009, Paper 10 (PTAB Aug. 4, 2015)***

The petitioner alleged that the patent invention was in public use based on a witness testimony which is offered to show that he has been performing the claimed method steps using Netsirv software system in conjunction with the operation of his storage business named Local MN, LLC. The Board indicated that the testimony of witnesses alleging prior public use, or any other theory of invalidity under 35 U.S.C. § 102, must be corroborated to prove the credibility of

the testimony by clear and convincing evidence. The Board found that the testimony alone is insufficient to establish prior public use since the witness is an interested party (the president and CEO of one of the petitioner's entities) and does not offer corroboration for his testimony and no explanation was given for why corroborative evidence was not provided.

## ***G. On Sale***

### **1. *Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 586 U.S. \_\_\_\_ (2019)**

Under pre-AIA §102, the on-sale bar applied to a secret sale as well as a public sale. However, practitioners were unsure whether a secret sale constitute a prior art under the AIA due to the catch all phrase "or otherwise available to the public" next to the term "on sale" in AIA 35 U.S.C. 102(a)(1). In *Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, the Supreme Court unanimously found that such a secret sale qualifies as prior art under the AIA. The Court commented that the catch all phrase "or otherwise available to the public" does not provide a sufficient ground to conclude that Congress intended to alter the meaning of the term "on-sale."

### **2. MPEP Examples**

MPEP 2133.03(b) explains what qualifies as sale under the on-sale bar. To be on sale, a product must be the subject of a commercial sale or offer for sale. According to the MPEP, a sale need not be for profit to bar a patent, and the fact that the party realized no profit from the sales does not demonstrate the contrary. In addition, even a single sale or offer to sell may bar a patent. However, a sale of right in the invention and the potential patent right is not a sale of the invention. In addition, a sale or offer for sale must take place between separate entities, and thus where the parties to the alleged sale are related, whether there is a statutory bar depends on

whether the seller so controls the purchaser that the invention remains out of the public's hands. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1566, 33 USPQ2d 1512, 1515 (Fed.Cir. 1995).

According to the MPEP, only an offer which rises to the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale.” *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041,1048, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001). Since the statute creates a bar when an invention is placed “on sale,” a mere offer to sell is sufficient commercial activity to bar a patent. *In re Theis*, 610 F.2d 786, 791, 204 USPQ 188, 192 (CCPA 1979). In addition, the offer need not even be actually received by a prospective purchaser. *Wende v. Horine*, 225 F. 501 (7th Cir. 1915). Moreover, delivery of the offered item is not required. And thus, a signed purchase agreement prior to the critical date constituted a commercial offer, and it was immaterial that there was no delivery of later patented caps and no exchange of money until after critical date. *Weatherchem Corp. v. J.L.Clark, Inc.*, 163 F.3d 1326, 1333, 49 USPQ2d 1001, 1006-07 (Fed.Cir. 1998).

### **3. Recent Example - PTAB**

***C&D Zodiac, Inc. v. B/E Aerospace, Inc., PGR2017-00019, Paper 37 (PTAB Oct. 23, 2018)***

The petitioner asserted that the patent owner's "Spacewall," the alleged commercial embodiment of the claimed design was sold to Being, Delta, Airlines, and United Airlines prior to the effective filing date. The petitioner pointed to evidence from a slide-show presentation, which occurred prior to the effective filing date. This was corroborated by a news release and a URL link to the live audio broadcast of the presentation. Further corroborating the evidence of an existing contract and sale was presented. In addition, the evidence is further corroborated by

a declaration from a corporate account executive at the patent owner company. The Board found that Spacewall was subjected to a commercial offer for sale prior to the effective filing date.

***H. Otherwise available to the public***

AIA 35 U.S.C. 102(a)(1) provides a “catch-all” provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. MPEP 2152.02 (e) indicates that even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the “otherwise available to the public” provision of AIA 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public. We are not aware of any court decisions or PTAB decisions discussing this type of prior art.