

NEW COURT RULING IMPERILS PATENT RIGHTS OF RESEARCHERS

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The Federal Circuit Court of Appeals, the United States “patent court,” has held that a slide show that was printed, and then displayed, on poster board, at a chemical society meeting and a university, for about three days in total, blocked the patenting of the subject matter of the slide show. The Court reasoned that the slide show, displayed in such a manner more than a year before the patent application, was a blocking “printed publication” and “prior art reference” for patent law purposes. This was the decision of *In re Carol F. Klopfenstein and John L. Brent, Jr.*, Slip Op. No. 03-1583 (Fed. Cir. August 18, 2004). The inventors were researchers at Kansas State University.

This decision is notable because the slide show was not “published” in the common sense of printed copies being disseminated. Also, the show was not catalogued or indexed in any library or database. The *Klopfenstein* decision will likely have an impact on universities, research entities, and the like. For example, university researchers frequently present their work and results at public conferences. Researchers will need to be aware that if they use a slide presentation with their oral presentation, print it, and put it on poster boards, there is a possibility that the slide presentation may be deemed to be a printed publication, when shown.

“Public Accessibility” is the criterion

In reaching its decision, the Federal Circuit stated four factors were relevant to the facts of the case:

- 1) the length of time the display was exhibited,
- 2) the expertise of the target audience,

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- 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.

The Federal Circuit stated that “public accessibility has been the criterion by which a prior art reference will be judged for the purposes of § 102(b).” For example, the Court stated that a public billboard targeted to those of ordinary skill in the art for months may not be “distributed” or “indexed,” but it is surely sufficiently accessible to the interested public, and thus, a “printed publication” under controlling precedent.

The Court acknowledged that one of its earlier decisions, *In re Cronyn*, 890 F.2d at 1158, 1160 (Fed. Cir. 1989), held that “dissemination **and** public accessibility are the keys to the legal determination of whether a prior art reference was ‘published.’” [Emphasis added]. In its decision in *Klopfenstein*, however, the Federal Circuit stated that a reading of the *Cronyn* decision that it required distribution of reproductions or photocopies was not a correct reading.

The Court also distinguished *Cronyn* because the student theses presentations in *Cronyn* were made to only a handful (i.e., four) faculty members and the theses had not been cataloged or indexed in a meaningful way or otherwise made publicly accessible.

The Court went on to distinguish other prior cases relied upon by the inventors. In *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986), the Federal Circuit held that a thesis filed and indexed in a university library was “printed publication.” In its decision in *Klopfenstein*, the Federal Circuit stated that the *Hall* court arrived at this holding after taking into account that copies of the indexed thesis itself were made freely available to the general public by the university more than one year before the filing of the patent application. The Federal Circuit stated that its decision in *Hall* did not rest on merely indexing of the thesis, and that it used indexing as only a factor in determining “public accessibility.”

In *Massachusetts Institute of Technology v. AB Fortia*, 774 F.3d 1104 (Fed. Cir. 1985), the Federal Circuit held that a paper delivered orally to an audience of as many as 500 persons having ordinary skill in the art and where at least six copies of a paper were also distributed, was a printed publication. In its decision in *Klopfenstein*, the Federal Circuit noted that the *MIT* court did not limit future determinations of applicability of the “printed publication” bar to instances in which copies of a reference were actually offered for publication.

In *In re Wyer*, 655 F.2d 221 (CCPA 1981), an Australian patent application kept on microfilm at the Australian Patent Office was held to be “sufficiently accessible to the public and to persons skilled in the pertinent art to qualify as a ‘printed publication.’” In its decision in *Klopfenstein*, the Federal Circuit noted that this finding did not require proof of “actual viewing or dissemination.”

The Federal Circuit concluded its review of prior case law by stating that while courts have found it helpful to rely on distribution and indexing as proxies for public accessibility, this has not been to the exclusion of all other measures of public accessibility.

**An oral presentation alone is
not a “Printed Publication” –
but any displayed materials might be**

The Federal Circuit contrasted its decision in relation to strictly oral presentations, meaning speeches. With regard to such presentations, it said, “it is important to note that an entirely oral presentation at a scientific conference that includes neither slides nor copies of the presentation is without question not a ‘printed publication’” for the purposes of patent law.

The Federal Circuit also said that “a presentation that includes a transient display of slides is likewise not necessarily a ‘printed publication.’” For this point, the Court favorably cited *Regents of the Univ. of Cal. v. Howmedica*, 530 F. Supp. 846, 860 (D. N.J. 1981), *aff’d*, 676 F.2d 687 (3rd Cir. 1982) (unpublished table decision). That earlier case held that “the projection of slides at the lecture” that “was limited in duration and could not disclose the invention to the extent necessary to enable a person of skill in the art to make or use the invention” was not a “printed publication.” Calling this earlier case the *Howmedica* case, the Federal Circuit said that “while *Howmedica* is not binding on this court, it stands for the important proposition that the mere presentation of slides accompanying an oral presentation at a professional conference is not per se a ‘printed publication’” for the purposes of patent law.

In *Howmedica*, two of the inventors gave a lecture to about 30 people at a meeting of the California Medical Association, and displayed projections of certain slides that showed pictures and drawings of the inventive prosthesis. 530 F. Supp. at 859-860. The district court stated that it was important to note that the public did not have access to the slides and that no prints of the slides were made prior to one year before the filing of the patent

application. Thus, the district court in *Howmedica* concluded there was no evidence that the “publication” was disseminated or otherwise made available to the extent that persons interested in the information could locate it and put to use the essentials of the claimed invention. 530 F. Supp. at 860.

The *Klopfenstein* display was of sufficient duration that those who viewed it could retain and easily copy the material

In *Klopfenstein*, the patent application at issue disclosed methods of preparing foods comprising extruded soy cotyledon fiber (“SCF”). The application asserted that feeding mammals foods containing extruded SCF may help lower their serum cholesterol levels while raising HDL (the good cholesterol) levels. While it was known to those of ordinary skill in the art who worked with SCF that extrusion reduces cholesterol, it was not known at the time of invention that double extrusion increases this effect and yielded even stronger results.

More than one year before filing their patent application, the inventors and a colleague presented a slide presentation at a meeting of the American Association of Cereal Chemists. The fourteen-slide presentation was printed and pasted onto poster boards. The printed slide presentation was displayed continuously for 2.5 days at this meeting.

A month later, also more than one year before filing the patent application, the same slide presentation was put on display for less than a day at an Agricultural Experiment Station at Kansas State University.

The Federal Circuit found this 3-day period to be “an extended period of time,” and that the display was shown to members of the public having ordinary skill in the art. The Federal Circuit found that those members of the public were not precluded from taking notes or even photographs of the display. The court noted that the display was “presented in such a way that copying of the information it contained would have been a relatively simple undertaking for those to whom it was exposed – particularly the amount of time they had to copy the information and the lack of any restrictions on their copying of the information.”

Take appropriate action to preserve patent rights

In light of the *Klopfenstein* decision, research entities, such as university technology management offices, should ensure that appropriate steps are taken to protect their respective United States patent rights. Such steps may include keeping a record of presentations by researchers, and incorporating procedures to ensure the filings of patent

applications on disclosed inventions, within one year of each such presentation. Another option is filing the presentation as a “provisional” patent application prior to the presentation to avoid the issue in the United States and to remove any question of the right to pursue international patent rights. When such an approach is followed, the research entity will need to file non-provisional U.S. and/or Patent Cooperation Treaty (PCT) applications within one year of the filing date of the provisional application in order to claim the benefit of the filing date of the provisional application.

In conclusion, a research entity’s patent rights can best be preserved by educating researchers that anything they display without restriction to others outside their organization can give rise to the loss of valuable patent rights. Researchers should be educated on the need to promptly bring to the research entity’s attention any such display or anticipated display so that appropriate action can be taken. University researchers – who in many situations are now entitled to a percentage of any licensing monies procured by the university due to their inventions – will certainly be an attentive audience.