

## 'Printed Publications' In A Digital Age

Law360, New York (October 15, 2010) -- Under 35 U.S.C. § 102, “[a] person shall be entitled to a patent unless ... (a) the invention was ... patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or (b) the invention was patented or described in a printed publication in this or a foreign country ... more than one year prior to the date of the application for patent in the United States ...”

For many years, the concept and meaning of a “printed publication” was clear and included physically printed items, such as published journal articles and issued patents. In the digital age, however, the meaning and scope of a “printed publication” has become more difficult.



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A potential “printed publication” may no longer be limited to tangibly or physically printed articles, but may further include electronic or digital disclosures, such as electronic files or e-mails, that may be stored on a computer or server, sometimes only temporarily and/or with limited accessibility.

These newer forms of electronic disclosure have challenged the traditional definition and forced an expanded interpretation of what constitutes a “printed publication” under § 102.

Digital and electronic files are not the first form of disclosure to fall outside the traditional definition of a “printed publication.” For example, courts have previously determined that a single, obscure library or patent reference may qualify as a “printed publication,” especially if there is an indexing system or some other “road map” for one skilled in the art to locate the reference.

In *Wyer*, microfilm and “diaz copies” of a reference at Australian patent offices were considered a “printed publication” since they were available and equipment for viewing them was provided.[1] In *Hall*, a thesis filed and indexed in a German library was considered a “printed publication” based on a librarian’s affidavit of routine practice for indexing and shelving dissertations.[2] In *Bruckelmyer*, a drawing canceled during prosecution of a patent application was considered a “printed publication” because indexing of patent provided a road map to the application files.[3]

However, other decisions have held that some references are not a “printed publication.” In *Bayer*, a copy of a master’s thesis was not considered a “printed publication” because it was not catalogued until after the critical date.[4] In *Cronyn*, an undergraduate thesis was not a “printed publication” because it was only searchable by name and not actually shelved.[5]

Other courts have addressed whether presentations at meetings with or without dissemination of slides or handouts are sufficient to be a “printed publication.” In *MIT*, a presentation at a meeting combined with limited availability of a paper

constituted a “printed publication.”[6] In *Klopfenstein*, a poster displayed for two-and-a-half days at a meeting, and later for less than a day at a university, was considered a “printed publication.”[7]

Other decisions have addressed whether limited disclosure within an organization or to outside parties constitutes a “printed publication.” Internal or private disclosures within an organization or company, as well as limited disclosures to outside parties with “an injunction of secrecy,” are generally not considered a “printed publication.”[8]

Over the years, courts have had to accommodate the definition of a “printed publication” to changes and advances in technology. The recent trend has been to abandon the earlier approach that “a reference must be both ‘printed’ and ‘published.’”[9]

Instead, the “printed publication” requirement is now viewed as a “unitary concept” relating to “probability of dissemination” or “public accessibility.” In *Wyer*, the court reasoned that the purpose of the “printed publication” requirement is to “prevent withdrawal by an inventor ... of that which was already in the possession of the public.”

Regardless of format, a disclosure may be a “printed publication” if there is “sufficient proof of its dissemination or that it has been available and accessible to persons concerned with the art ...”[10]

Therefore, sufficient “accessibility” or “availability” of a disclosure to persons skilled in the relevant art may be enough to constitute a “printed publication,” even if there is no distribution of copies per se. Indeed, “‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under [§ 102].”[11]

The court in *Klopfenstein* provided a hypothetical example that a public billboard displayed for a sufficient time would likely constitute a “printed publication,” even though there is no distribution or dissemination of copies. The court in *Klopfenstein* distinguished *Cronyn* by stating that the word “disseminate” meant to “make widespread” or “foster general knowledge of” and did not require distribution of copies.[12]

With these considerations in mind, it is apparent that an electronic file stored on a computer, server, etc., may be considered a “printed publication” if sufficiently accessible for viewing or copying by interested persons, especially if made freely available without a reasonable expectation of secrecy. Indeed, an electronic disclosure may be more likely considered a “printed publication” if presented in a way that aids interested persons to locate and identify it.

The determination of whether there is a “printed publication” involves a case-by-case inquiry into the facts of a disclosure to members of the public.[13]

Whether an electronic file is sufficiently accessible to qualify as a “printed publication” may depend on a number of factors, such as 1) length of time the disclosure was displayed; 2) whether the disclosure was available to persons skilled in the respective art; 3) whether indexing, advertising or other direction was provided; 4) simplicity or ease with which the disclosure may be captured, understood and copied; 5) security protections or expectations of confidentiality; 6) actual number of persons having access; 7) intent or purpose in making the disclosure.[14]

With regard to the length of time the electronic disclosure is made publicly available, “[t]he duration of the display is important in determining the opportunity of the public in capturing, processing and retaining the information conveyed by the reference. The more transient the display, the less likely it is to be considered a ‘printed publication.’”[15]

In *Klopfenstein*, a poster displayed at a meeting for only a few days was considered a “printed publication.” The court reasoned that it was viewed by interested persons having ample time to observe and record the information displayed. Therefore, while the length of time is important, whether an electronic disclosure constitutes a “printed publication” may depend on whether the disclosure is made available for a sufficient time to allow interested persons to view and capture it.

Another factor is whether the electronic disclosure is indexed, organized, labeled or otherwise advertised in a way that would assist or lead interested persons in finding and identifying it.

Analogous to Bayer and Cronyn, electronic files having nondescriptive names and stored in unmarked locations with limited access and without clear organization, indexing or other direction to guide interested persons in finding it would be less likely considered a “printed publication,” but electronic files that are publicly accessible and easily located and identified would be more likely considered a “printed publication.”

The simplicity or ease with which relevant portions of a disclosure may be captured, understood and copied is another factor. The more complex a display, the more difficult it will be to effectively capture its information.[16] This factor includes not only the indexing and organization of disclosures but the content of the disclosure itself.

Similar to the poster in Klopfenstein, an electronic file openly displaying relevant information simply and clearly would be more likely considered a “printed publication.”

Yet another factor is whether there is a reasonable expectation that an electronic disclosure is confidential and/or should not be made available to others. As stated in Klopfenstein, “[w]here professional and behavioral norms entitle a party to a reasonable expectation that the information displayed will not be copied, we are more reluctant to find something a ‘printed publication.’”

Thus, a reasonable expectation that an electronic disclosure should be kept secret or confidential by its recipient(s) would be less likely considered a “printed publication.” Any security or password protections would further reduce the likelihood of there being a “printed publication.”

While intent or purpose in making a disclosure may be a factor,[17] it is unlikely that it will often be given dispositive weight. Instead, objective evidence of accessibility or dissemination will usually trump any alleged intent or purpose in making the disclosure available. However, this factor may be relevant in determining whether a disclosure was considered confidential.

The extent of actual access to a disclosure may be another factor. However, “[w]hether a given reference is a ‘printed publication’ depends on whether it was ‘publicly accessible’ during the [relevant period].”[18]

“Accessibility goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to. If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.”[19]

Surprisingly few cases have addressed whether an electronic file stored on a computer, server, etc., may constitute a “printed publication” under § 102. Recently, however, the Federal Circuit decided *SRI International Inc. v. Internet Security Systems Inc.*[20]

In *SRI International*, the inventors submitted the “Live Traffic” paper to a journal for publication more than one year prior to the filing date of a patent application and simultaneously gave instructions to the journal for accessing a copy of the paper on SRI’s publicly accessible FTP server. The copy remained on the FTP server for seven days, during which time there were seven instances in which people were directed to the same subdirectory.

The Federal Circuit vacated and remanded the district court’s ruling that placement of the paper on the server was a “printed publication.” The court reasoned that the paper “was placed ‘on’ the FTP server without an index or catalogue or other tools for customary or meaningful research.” The court stated that it was not shown that an anonymous user would have likely navigated the FTP server and found the paper.

In fact, there was evidence that the journal needed specific instructions to locate it. The court doubted whether anyone outside of the journal was aware of the paper and looked for it.

The court acknowledged that the live traffic paper might have been available to someone having FTP “know-how.” However, the court reasoned that the paper was more analogous to the hypothetical example in Klopfenstein of placing a poster “at an unpublicized conference with no attendees ... but available only to a person who may have wandered into the conference by happenstance or knew about the conference by unpublicized means.”[21]

Therefore, the court concluded that there no specific direction provided to interested persons and the FTP server was “not catalogued or indexed in a meaningful way.”[22]

Although courts will surely provide additional refinement in the future, any analysis for determining whether an electronic disclosure constitutes a “printed publication” will likely begin with the core holding of these decisions.

In other words, an electronic disclosure may be considered a “printed publication,” “upon a satisfactory showing that such 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 and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.”[23]

The factors listed above may provide additional guidance under this analysis. To avoid unduly creating a “printed publication” that may bar patentability of an invention, electronic disclosures containing protectable information should ideally not be made “publicly accessible” prior to the filing of a patent application.

However, if a limited disclosure must be made, steps should be taken to ensure that it is not made available beyond a limited number of necessary recipients. One making such a disclosure should clearly communicate in writing that the disclosure is made under an expectation of confidentiality and that no further disclosure should be made to third parties.

Moreover, a disclosure should not be made available for a longer time than necessary, and security protections, such as login and password, should be utilized where appropriate to provide further protection against public access.

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[1] In re Wyer, supra.

[2] In re Hall, supra.

[3] Bruckelmyer v. Ground Heaters Inc., 445 F.3d 1374, 78 USPQ2d 1684 (CAFC 2006).

[4] In re Bayer, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978).

[5] In re Cronyn, 890 F.2d 1158, 13 USPQ2d 1070 (CAFC 1989).

[6] Massachusetts Institute of Technology v. AB Fortia, 774 F.2d 1104, 227 USPQ 428 (CAFC 1985); cf. Hybridtech Inc. v. Abbott Laboratories, 849 F.2d 1446, 7 USPQ2d 1191 (CAFC 1988).

[7] In re Klopfenstein, supra.

[8] Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (CAFC 1990); Cooper Cameron Corp. v. Kvaerner Oilfield Products Inc., 291 F.3d 1317, 62 USPQ2d 1846 (CAFC 2002); cf. Garrett v. United States, 422 F.2d 874, 164 USPQ 521 (Ct. Cl. 1970).

[9] In re Bayer, supra.

[10] In re Wyer, supra.

[11] In re Klopfenstein, supra.

[12] In re Klopfenstein, supra.

[13] Id.

[14] Id.

[15] Id.

[16] Id.

[17] In re Wyer, supra.

[18] Bruckelmyer v. Ground Heaters Inc., supra.

[19] Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 7 USPQ2d 1057 (CAFC 1988).

[20] SRI International Inc. v. Internet Security Systems Inc., 511 F.3d 1186, 85 USPQ2d 1489 (CAFC 2008).

[21] SRI International, supra.

[22] SRI International, supra.

[23] In re Wyer, supra.