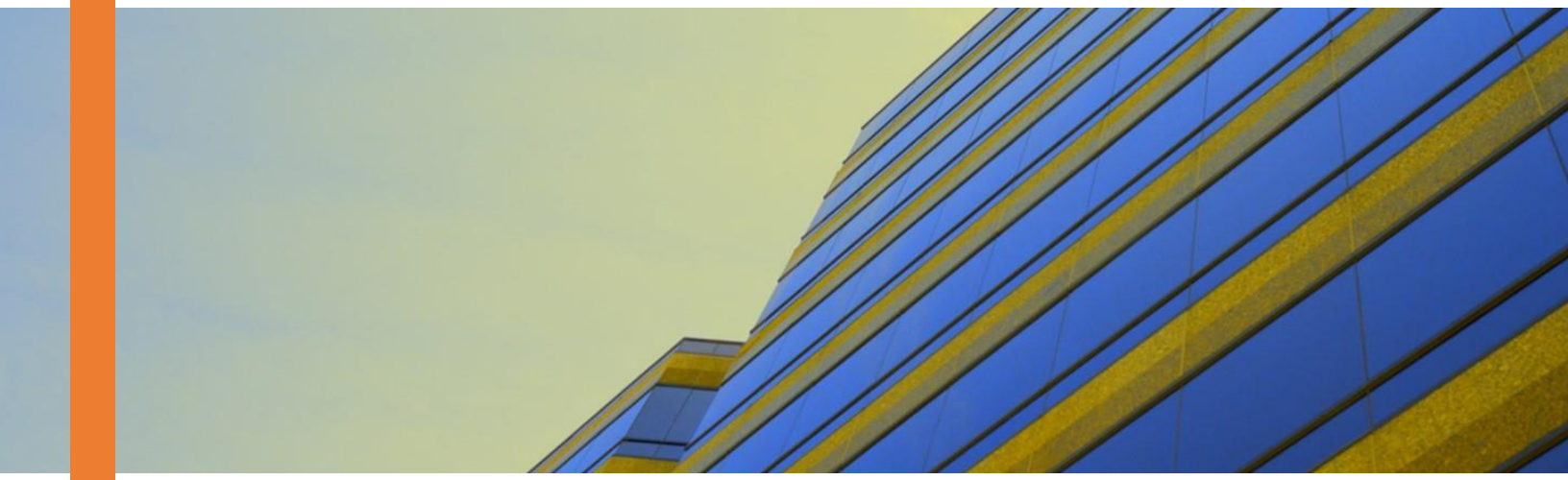
CASE SUMMARY OF *MEDTRONIC, INC. V. BARRY*



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Medtronic, Inc. v. Barry, C.A. No. 2017-1169 (Fed. Cir. June 11, 2018)

Background

This is an appeal from two related decisions of the U.S. Patent and Trademark Office's Patent Trial and Appeals Board (Board) in *inter partes* review (IPR) proceedings. The Board concluded that the petitioner, Medtronic, Inc., had not proven that the challenged patent claims are unpatentable. The Federal Circuit affirmed-in-part and vacated-in-part the decision.

Dr. Mark Barry sued Medtronic for patent infringement in the Eastern District of Texas. Barry alleged that Medtronic's products infringed U.S. Patent Nos. 7,670,358 (the 358 Patent) and 7,776,072 (the 072 Patent). Medtronic petitioned for, and the Board instituted, IPR proceedings for all claims in both patents.

During the IPR proceedings, Medtronic asserted that the claims of the patents were obvious over three references: (1) U.S. Patent Application No. 2005/0245928 (the 928 Application), (2) a book chapter which appears in Masters Techniques in Orthopaedic Surgery: The Spine (2d ed.) (MTOS); and (3) a video entitled "Thoracic Pedicle Screws for Idiopathic Scoliosis" and slides entitled "Free Hand Thoracic Screw Placement and Clinical Use in Scoliosis and Kyphosis Surgery" (Video and Slides). The Board determined that the claims of the patents were not obvious over the 928 Application and MTOS, and that the Video and Slides were not prior art since they were not publicly accessible.

The primary dispute is whether the Video and Slides were publicly accessible, and thus, prior art to the 358 patent and the 072 patent.

Patents at Issue

The 358 patent relates to a method for ameliorating aberrant spinal column deviation conditions, such as scoliosis. The 072 patent is a continuation-in-part of the application that led to the 358 patent and shares substantially the same specification.

Analysis

The Federal Circuit affirmed the Board's determination that the claims of the patents were not obvious over the 928 Application and MTOS. However, Federal Circuit held that the Board erred in concluding that the Video and Slides were not accessible to the public.

On appeal, the parties disputed whether the Video and Slides constituted printed publications within the meaning of 35 U.S.C. § 102(b). A CD containing the Video was distributed at three separate programs in 2003: (1) a meeting of the "Spinal Deformity Study Group" (SDSG) in Scottsdale, Arizona, (the Scottsdale program); (2) the Advanced Concepts in Spinal Deformity Surgery meeting in Colorado Springs, Colorado (the Colorado Springs program); and (3) the Spinal Deformity Study Symposium meeting in St. Louis, Missouri.

Binders containing relevant portions of the Slides were also distributed at the Colorado Springs and St. Louis programs. The earliest of the three 2003 programs, the Scottsdale program, was limited to 20 SDSG members (e.g., experts within the field of spinal deformity), and the other two programs were attended by 20 and 55 surgeons at the Colorado Springs and St. Louis programs, respectively.

The Federal Circuit found that the determination of whether a document is a "printed publication" under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public (citing *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004)). A reference will be considered publicly accessible if it 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.

The Federal Circuit held that the question becomes whether such materials were sufficiently disseminated at the time of their distribution at the conferences. The Federal Circuit pointed to *Massachusetts Institute of Technology v. AB Fortia (MIT)*, where a paper that was orally presented at a conference to a group of cell culturists interested in the subject matter was considered a "printed publication." 774 F.2d 1104, 1109 (Fed. Cir. 1985). In that case, between 50 and 500 persons having ordinary skill in the art were told of the existence of the paper and informed of its contents by the oral presentation, the document was disseminated without restriction to at least six persons, and whether the copies were freely distributed to interested members of the public was a key consideration in the analysis.

The Federal Circuit also pointed to *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319 (Fed. Cir. 2009), where the issue pertained to whether a set of research papers distributed by a doctor to certain colleagues and two commercial entities rendered the documents printed publications. In that case, the Federal Circuit concluded that such documents were not publicly accessible since academic norms gave rise to an expectation that disclosures would remain confidential, and there was an expectation of confidentiality between the doctor and each of the two commercial entities.

Finally, the Federal Circuit identified *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004), where a reference in dispute was a printed slide presentation that was displayed prominently for three days at a conference to a wide variety of participants. The reference was shown with no stated expectation that the information would not be copied or reproduced by those viewing it, but copies were never distributed to the public and never indexed. In that the case, the Federal Circuit identified the relevant factors to include: (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. After reviewing these factors, the Federal Circuit determined that the reference was sufficiently publicly accessible to count as a "printed publication" for the purposes of § 102(b).

The Federal Circuit held that the size and nature of the meetings and whether they are open to people interested in the subject matter of the material disclosed are important considerations. The Federal Circuit further held that another consideration is whether there is an expectation of confidentiality between the distributor and the recipients of the materials.

The Federal Circuit found that the Board did not fully consider all of the relevant factors. For example, the Board did not address the potentially-critical difference between the SDSG meeting in Arizona and the programs in Colorado Springs and St. Louis, which were not limited to members of the SDSG but instead were attended by at least 75 other surgeons, collectively. The Board's analysis was silent on the distribution that occurred in the two non-SDSG programs. Further, even if the Board were correct in its assumption that Medtronic only gave the Video and Slides to the SDSG members, it did not address whether the disclosures would remain confidential.

Accordingly, the Federal Circuit held that whether dissemination of the Video and Slides to a set of supremely-skilled experts in a technical field precludes finding such materials to be printed publications warrants further development in the record. For these reasons, the Federal Circuit vacated the Board's finding that the Video and Slides are not printed publications and remanded for further proceedings.

Practice Insights

Consider counseling inventors and clients regarding the appropriate factors to consider when presenting materials at conferences and distributing materials without a legal obligation of confidentiality. It may be wise to file a provisional patent application before presenting or distributing materials related to an invention. Also, one may enter non-disclosure agreements with parties viewing a presentation or receiving distributed materials.