

Applying the Printed Publication Bar in the Internet Age: *Is It as Simple as Googling for Prior Art?*

ERIC W. GUTTAG[†]

ABSTRACT

Applying the “printed publication” bar was fairly easy in the “hard copy” age. But the move to electronically posted documents in the Internet age has added new meaning to the phrase “printed publication.” The case law has created a confusing conflation between “printed publication” bars based on “dissemination” of the document, versus those based on whether the document is “publicly accessible.” These problems first surfaced in the 2008 case of *SRI International, Inc. v. Internet Security Systems, Inc.* and in the later 2009 case of *In re Lister*. These cases have also highlighted other aspects unique to electronically posted documents (e.g., the potential transitory nature of the documents) which make resolution of “printed publication” bars challenging in the Internet age. All that can be safely said now about applying the “printed publication” bar in the Internet age is that it is not yet as simple as “Googling for prior art.”

© 2011 Virginia Journal of Law & Technology Association, at <http://www.vjolt.net>. Use paragraph numbers for pinpoint citations.

[†] Mr. Guttag is in a solo intellectual property law practice, the Eric W. Guttag IP Law Office. He earned his B.A. in Chemistry, *magna cum laude*, Phi Beta Kappa, from Carleton College in 1974 and his J.D. from the University of Richmond, T. C. Williams School of Law, in 1977. The author would also like to gratefully acknowledge the efforts of Professor Michael V. Risch, Villanova University School of Law, in reviewing and providing constructive comments on earlier drafts of this article.

TABLE OF CONTENTS

I. Introduction.....	2
II. Internet Searching and Search Engine Basics Potentially Relevant to “Printed Publication” Bars in the Electronic Age.....	5
III. Origins of the “Printed Publication” Bar of 35 U.S.C. § 102(b): Initial Focus on Format and the “Print” Theory Approach.....	8
IV. Shifting the Focus: The “Publication” Theory Approach in the Hard Copy Age	12
V. The Internet Age Arrives: The Impact of Electronic Posting of Documents on the “Printed Publication” Bar	28
A. Document Temporarily Posted Yet Freely Accessible on FTP Server: <i>SRI International v. Internet Security Systems</i>	28
B. Accessibility of Copyrighted Manuscript by Searching Public and Commercial Databases: <i>In re Lister</i>	41
VI. Conclusion: Making Sense of the “Printed Publication” Bar Morass in the Internet Age.....	45



I. INTRODUCTION

¶1 Section 102(b) of Title 35 bars patenting an invention which was “described in a printed publication” more than one year prior to the filing date of a U.S. patent.¹ Determining what was, and especially what was not, a “printed publication” was fairly easy for many years. What types of documents might qualify as a “printed publication” was also fairly limited in scope. For the most part, the patent applicant need only fear “hard copy” documents.² In addition, the “hard copy” document must either be “disseminated” (e.g., circulated) or at least “publicly accessible” (e.g., in a library) to potentially become a “printed publication” bar.³

¹ 35 U.S.C. § 102(b) (2006) (“A person shall be entitled to a patent unless— . . . (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.”).

² Most “printed publication” bars are the result of the document being authored or created by others, i.e., not the patent applicant. *See, e.g., In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981) (involving a foreign patent case); *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374 (Fed. Cir. 2006). But “printed publication” bars can also be a “self-inflicted” wound where the patent applicant creates or authors the document that becomes the potential bar under 35 U.S.C. § 102(b). *See, e.g., In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004); *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186 (Fed. Cir. 2008); *In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009). *See also* Sean B. Seymore, *The “Printed Publication” Bar After Klopfenstein: Has the Federal Circuit Changed the Way Professors Should Talk About Science?*, 40 AKRON L. REV. 493, 494 (2007) (describing the “printed publication” bar as “terrify[ing] technology transfer offices” at universities because of the propensity of academic researchers to cause such “self-inflicted” wounds by premature disclosure of the results of their research in scientific presentations); Margo A. Bagley, *Academic Discourse and Proprietary Rights: Putting Patents in Their Proper Place*, 47 B.C. L. REV. 217, 221 (2006) (noting the impact of the *In re Klopfenstein* case on potentially “further stifling scholarly discourse prior to the filing of patent applications”).

³ *See infra* Part IV. The determination of what qualifies as a “printed publication” under 35 U.S.C. § 102(b) is a question of law based on the underlying factual determinations. *See, e.g., Kyocera Wireless*

¶2 The electronic age, and more importantly the Internet age, has now added complexity to what may have been the simple meaning of the phrase “printed publication.” For example, what if a potentially novelty-defeating journal article is electronically posted on an obscure, but nonetheless Internet accessible web site? Would it matter whether a search engine (e.g., Google) could locate the journal article posted on the web site by someone using appropriate Internet search criteria? What if the journal article is retrieved by the Internet search, but appears far down in the search results (i.e., hits list)? Does it matter if the journal article is, instead, searchable in an on-line public or commercial database by author, title and/or subject matter? Do any of these fact patterns cause the journal article to qualify as a potential “printed publication” bar?

¶3 Or, what if the article is electronically posted on a File Transfer Protocol (FTP) server? Does it matter whether the directory and subdirectories of that FTP server where the article is located are indexed or catalogued so that someone looking for that article can easily navigate the directory and subdirectories? Does it matter whether access to the FTP server is freely available and to whom? Is it relevant that the patent applicant (or the applicant’s colleague) is the one who posted the document on the FTP server and directed others to it? What if that article is posted only temporarily on the FTP server with the expectation that only a few well-informed persons will retrieve the article for the purpose of prepublication review for subsequent journal publication?

¶4 The potential implications of the Internet age on the “printed publication” bar were explored for the first time by the Federal Circuit in the 2008 case of *SRI International, Inc. v. Internet Security Systems, Inc.*⁴ In *SRI International*, a majority of the Federal Circuit panel determined that there were “genuine issues of material fact” sufficient to preclude a grant of summary judgment that an electronic document (the Live Traffic Paper) temporarily posted but freely accessible on the FTP server of the patentee (SRI International) was a “printed publication” bar. Accordingly, the majority vacated the district court’s ruling⁵ that the Live Traffic Paper constituted a “printed publication” bar, would invalidate the four SRI International patents⁶ in the infringement suit.⁷ Judge Moore, dissenting in part, strongly disagreed and argued that SRI International had failed to introduce any evidence to show that the Live Traffic Paper was not “publicly accessible” and therefore a “printed publication” bar.

Corp. v. Int’l Trade Comm’n, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *Cooper Cameron Corp. v. Kyaerner Oilfield Prod. Inc.*, 291 F.3d 1317, 1321 (Fed. Cir. 2002)); *In re Lister*, 583 F.3d at 1311 (Fed. Cir. 2009) (also quoting *Cooper Cameron*, 291 F.3d at 1321).

⁴ *SRI Int’l*, 511 F.3d 1186

⁵ *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 456 F. Supp. 2d 623 (D. Del. 2006).

⁶ U.S. Patent No. 6,484,203 (filed Sep. 8, 2000) (issued Nov. 19, 2002) (“‘203”), U.S. Patent No. 6,708,212 (filed May 5, 2003) (issued Mar. 16, 2004) (“‘212”), U.S. Patent No. 6,321,338 (filed Dec. 20, 1999) (issued Nov. 6, 2001) (“‘338”), and U.S. Patent No. 6,711,615 (filed Sep. 25, 2002) (issued Mar. 23, 2004) (“‘615”). See *SRI Int’l*, 511 F.3d at 1188.

⁷ The ‘212 patent was also held by the district court to be invalid under a different “printed publication” bar, namely another SRI International paper entitled “EMERALD: Event Monitoring Enabling Responses To Anomalous Live Disturbances.” (EMERALD 1997 Paper). The only question about the EMERALD 1997 Paper was whether it was an “enabling disclosure” of what was covered by the ‘212 patent. The entire Federal Circuit panel upheld the district court ruling that the EMERALD 1997 Paper was an enabling disclosure and thus barred the ‘212 patent. *SRI Int’l*, 511 F.3d at 1192-94.

¶ 5 The *SRI International* case provides a glimmer of the difficulties of determining what is (or is not) a “printed publication” bar in the Internet age. The holding in *SRI International* could simply be viewed as a procedural dispute between the panel members as to whether there was (or was not) a genuine issue of material fact sufficient to support (or deny) the grant of summary judgment. But more likely, and not surprisingly, the split panel decision in *SRI International* suggests that the Federal Circuit is far from expressing a uniformity of thought as to what is a “printed publication” bar in the Internet age, and particularly what facts will establish a “printed publication” bar when the document is posted on an FTP server, as well as a freely accessible (and searchable) web site. In fact, *SRI International*, as well as earlier Federal Circuit cases starting at least with *In re Klopfenstein*,⁸ have now created a perplexing concoction of the “dissemination” doctrine (the more “active” version of the “printed publication” bar) with the “publicly accessible” doctrine (the more “passive” version of the “printed publication” bar, sometimes referred to as “constructive publication”) that makes consistent rulings on “printed publication” bars a serious challenge in the Internet age.

¶ 6 Also, the Live Traffic Paper was posted in 1997 during the early stages of increased Internet usage, not 2006 when the patent infringement suit was filed. Can current advances in Internet search engine capability unduly influence what is considered “publicly accessible” relative to the circumstances under which the “printed publication” bar allegedly occurred? This potential danger of being prejudiced by the hindsight of how effective Internet search technologies are now—versus how primitive those Internet search technologies were say fifteen, ten or even five years ago when the key operative facts occurred—is echoed in the recent case of *In re Lister* which briefly refers to *SRI International*.⁹ In *In re Lister*, the Federal Circuit ruled that a patent applicant’s own manuscript submitted for copyright registration was not a “printed publication” bar because there was “insufficient evidence” that this manuscript was “publicly accessible” (including in the United States Copyright Office’s automated catalog which would only allow searching for the name of the author and the first word of the title) more than one year prior to the filing date of the patent application.¹⁰

¶ 7 The *SRI International* case also leaves open how permanently the document needs to be electronically posted to be a “printed publication” bar. For example, should it matter whether the document is posted on an FTP server or web site in a permanent format, such as a Portable Document Format (pdf) file? Would it be sufficient if the document is in a viewable, but transitory format (e.g., a web page) which may change from day-to-day, or even be removed?

¶ 8 *In re Lister* also briefly mentions (but does not directly address) under what circumstances a potential Internet search would put a particular electronically posted document in the “printed publication” bar zone.¹¹ Instead, in dicta, *In re Lister* obliquely

⁸ *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004). See also *infra* Part IV.

⁹ See *In re Lister*, 583 F.3d 1307, 1314 (Fed. Cir. 2009) (citing *SRI Int'l*, 511 F.3d at 1197, for the proposition that “once accessibility is shown, it is unnecessary to show that anyone actually inspected the reference”).

¹⁰ See discussion of *In re Lister*, 583 F.3d at 1315 in Part V(B), *infra*.

¹¹ See *In re Lister*, 583 F.3d at 1312.

refers to whether such a search would have yielded an “unmanageable number of references” so as to put it outside this zone.¹² Or put differently, when would the number of references in an Internet search “hits list” be “manageable” enough to become a “printed publication” bar? How far up that “hits list” must the reference appear to be in the “printed publication” bar zone? In other words, when will we reach the point where the ability to “Google” for that prior art becomes the standard for what is “publicly accessible” under the “printed publication” bar?

¶ 9 To put it bluntly, the “printed publication” bar has become a confusing, as well as conflicting, jurisprudential morass in the Internet age. For those who feel “Internet-challenged,” Part II of this article provides some relevant technical background on Internet searching, specifically Internet search engine basics and capabilities, including web caching. Part III will then explore the origins of the “printed publication” bar and the original focus on the term “printed.” Next, Part IV will review the later shift to the “publication” theory approach in the “hard copy” age, and particularly the confusing conflation of the “dissemination” and “publicly accessible” doctrinal branches during the case law development of this approach which has created jurisprudential uncertainty in evaluating “printed publication” bars. Part V will then assess the impact of this unfortunate conflation, as well as other aspects unique to the “printed publication” bar for electronically posted documents, in the *SRI International* and *In re Lister* cases. Finally, Part VI will try to make some sense of this jurisprudential morass so that determining the “printed publication” bar in the Internet age might eventually (and hopefully) become as simple as “Googling for prior art.”

II. INTERNET SEARCHING AND SEARCH ENGINE BASICS POTENTIALLY RELEVANT TO “PRINTED PUBLICATION” BARS IN THE ELECTRONIC AGE

¶ 10 The determination of “printed publication” bars in the electronic age requires some knowledge of the technical basics of Internet searching, and particularly how search engines such as Google, Bing, Alta Vista, etc., process search requests (also referred to as queries).¹³

¶ 11 Search engines are designed to search for information on the World Wide Web (Web).¹⁴ Unlike web directories,¹⁵ search engines operate algorithmically or by a mixture

¹² See *id.* at 1316, n.2 (“We need not decide whether in some circumstances an overwhelming number of search results might warrant conclusion that particular reference included in list was not publicly accessible.”).

¹³ Those readers who are familiar with Internet searches, search engines, etc., should feel free to skim over Part II of this article. Part II is primarily designed to educate those who may find the Internet, and especially Internet search engine technology and terminology, a challenge.

¹⁴ See *Web Search Engine*, WIKIPEDIA, http://en.wikipedia.org/wiki/Search_engine (last visited Feb. 7, 2011).

¹⁵ Web or link directories are maintained by human editors and list web sites by category and subcategory. “Most web directory entries are also not found by web crawlers but by humans. The categorization is usually based on the whole web site rather than one page or a set of keywords, and sites are often limited to inclusion in only a few categories. Web directories often allow site owners to directly submit their site for inclusion, and have editors review such submissions for fitness.” See *Web Directory*, WIKIPEDIA http://en.wikipedia.org/wiki/Web_directory (last visited Feb. 7, 2011).

of algorithmic and human input. The data obtained by search engines are usually presented in a list of search results commonly called a “hits list.” These search results may consist of web pages, images, information or other types of files. Some search engines may also analyze the data available in databases or open directories.¹⁶

¶ 12 Search engines store information about many web pages, which the search engine retrieves from the Hyper Text Mark Up Language (HTML)¹⁷ itself. Search engines generally work according to the following order of operations: web crawling,¹⁸ indexing,¹⁹ and searching.²⁰ In web crawling, web pages are retrieved by a “crawler” (also known as a “spider”), which is an automated web browser that follows every link on the web site from which the web pages are being retrieved (crawled). In indexing, the contents of each web page are then analyzed to determine how that page should be indexed (for example, words may be extracted from the titles, headings, or special fields called meta tags²¹). Data about these web pages are then stored in an index database for

¹⁶ See *Web Search Engine*, *supra* note 14.

¹⁷ Briefly, HTML is the predominant markup language for web pages and provides a mechanism to create structured documents by denoting structural semantics for web page text such as headings, paragraphs, lists, links, quotes, etc. HTML allows images and objects to be embedded and can be used to create interactive forms. HTML is written in the form of “HTML elements” consisting of “tags” surrounded by angle brackets (“<” or “>”) within the web page content. HTML can load scripts in languages such as JavaScript which affect the behavior of HTML web pages. HTML can also be used to include Cascading Style Sheets (CSS) to define the appearance and layout of the web page text and other material. See *HTML*, WIKIPEDIA, <http://en.wikipedia.org/wiki/HTML> (last visited Feb. 7, 2011).

¹⁸ “A web crawler is a computer program that browses in a methodical, automated manner, or in an orderly fashion.” Web crawlers are also referred to as “ants,” “automatic indexers,” “bots,” “spiders,” “robots,” etc. Search engines use this process of “crawling” or “spidering” to provide up-to-date data. Web crawlers are mainly used to create a copy of all the visited pages for later processing by a search engine that will index the downloaded pages to provide faster searches. “Crawlers can also be used for automating maintenance tasks on a web site, such as checking links or validating HTML code. Also, crawlers can be used to gather specific types of information from web pages, such as harvesting e-mail addresses (usually for spam).” See *Web Crawler*, WIKIPEDIA, http://en.wikipedia.org/wiki/Web_crawler (last visited Feb. 7, 2011).

¹⁹ “Search engine ‘indexing’ collects, parses, and stores data to facilitate fast and accurate information retrieval. Index design incorporates interdisciplinary concepts from linguistics, cognitive psychology, mathematics, informatics, physics and computer science. An alternate name in the context of search engines designed to find web pages on the Internet is ‘web indexing.’” See *Index (search engine)*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Index_\(search_engine\)](http://en.wikipedia.org/wiki/Index_(search_engine)) (last visited Feb. 7, 2011).

²⁰ See *Web Search Engine*, *supra* note 14.

²¹ Meta tags (also called “meta elements”) are HTML elements used to provide structured metadata about a web page. Meta tags are placed as tags in the head section of a web page and are used to specify page description, keywords, and any other metadata not provided through other head elements and attributes. Because meta tags provide information about a given web page, these tags are often used by search engines to help categorize the web page correctly. In the past (mid- to late-1990s), meta tags were often used by a web site owner to enhance or “bias” search results obtained by search engines so that the web site would appear higher up on the “hits list” of an Internet search by a user. In fact, improper use of trademarks in meta tags became a fertile source of trademark infringement and unfair competition litigation. However, meta tags have significantly less affect on search engine results today. See *Meta Element*, WIKIPEDIA, http://en.wikipedia.org/wiki/Meta_tag (last visited Feb. 7, 2011); see also, e.g., *Brookfield Comm’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036 (9th Cir. 1999) (concerning the use of trademark “MovieBuff” in domain name and meta tags); *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998), *aff’d*, 162 F.3d 1169 (9th Cir. 1998) (concerning a former Playmate of Year’s use of trademarks “Playboy” and “Playmate” in meta tags).

use in later search requests or queries.

¶ 13 The purpose of the index is to allow information to be found as quickly as possible, especially by subsequent queries. Some search engines, such as Google, may store all or part of the source page (referred to as a “web cache”²²), as well as other information about the web pages, whereas other search engines, such as AltaVista, may store every word of every page the search engine finds. This cached page holds the actual search text since the cached page is the one that was actually indexed, and can thus be very useful when the content of the cached page has been updated and the search terms originally used are no longer present in the updated web page.²³

¶ 14 When a user enters a query into a search engine (for example, by using key words), the search engine examines its index and provides a listing of the best-matching web pages according to the search engine’s criteria, usually with a short summary containing the document’s title and sometimes parts of the text of the document. The index is built from the information stored with the data and the method by which the information is indexed.

¶ 15 Most search engines support the use of Boolean operators (e.g., AND, OR, NOT, etc.) to further specify the search query. Boolean operators allow the user to refine and extend the search terms. The search engine looks for the words or phrases exactly as entered, but may also provide an advanced feature called a “proximity search” which allows users to define the distance between keywords, or may provide additional search enhancements to carry out what is called in computing “approximate string matching” (more colloquially called “fuzzy string searching” or “fuzzy searching”) which allows the search to extend beyond the exact phrases or words.²⁴ There is also concept-based searching (similar to fuzzy searching) involving the use of statistical analysis of pages containing the words or phrases to be searched for. Some search engines may provide for natural language queries to allow the user to type a question in the same form one would ask it to a human (e.g., ask.com).²⁵

¶ 16 The usefulness of a search engine often depends on the *relevance* of the search result provided. While there may be millions of web pages that include a particular word or phrase, some pages may be more relevant, popular, or authoritative than others. Most search engines employ methods to rank the results to provide the best results first, thus determining the order of search results in the “hits list.” How a search engine decides

²² A web cache stores copies of web documents (e.g., HTML pages, images, etc.) passing through it so that subsequent requests may be satisfied from the cache if certain conditions are met. Web caching reduces bandwidth usage, server load, and what is usually most visible to the user, the perceived “lag” in retrieving web pages. Web caching should not be confused with a “web archive,” which is a site that keeps old versions of web pages. See *Web Cache*, WIKIPEDIA, http://en.wikipedia.org/wiki/Web_cache (last visited Feb. 7, 2011). One such web archive is called the Wayback Machine (created by Internet Archive). See *Wayback Machine*, WIKIPEDIA, http://en.wikipedia.org/wiki/Wayback_Machine (last visited Feb. 7, 2011).

²³ *Web Search Engine*, *supra* note 14.

²⁴ *Approximate String Matching*, WIKIPEDIA, http://en.wikipedia.org/wiki/Approximate_string_matching (last visited Feb. 7, 2011). Currently no known public search engine allows documents to be searched by date. *Web Search Engine*, *supra* note 14.

²⁵ *Web Search Engine*, *supra* note 14.

which pages are the best matches, and in what order the results should be shown, varies from one engine to another. The methods may also change over time as Internet usage changes and new techniques evolve. The two main methods that have thus far evolved are: (1) a system of predefined and hierarchically ordered keywords that humans have programmed extensively; and (2) a system that generates an “inverted index” by analyzing texts located by the search engine. This second type of search engine relies much more heavily on the computer itself to do the bulk of the search work.²⁶

III. ORIGINS OF THE “PRINTED PUBLICATION” BAR OF 35 U.S.C. § 102(B): INITIAL FOCUS ON FORMAT AND THE “PRINT” THEORY APPROACH

¶ 17 The phrase “printed publication” has been in U.S. patent jurisprudence almost from the beginning. This phrase first appeared in the Patent Act of 1836.²⁷ This phrase was then carried over to the Patent Act of 1870²⁸ and finally to the current Patent Act of 1952, where the “printed publication” bar is now codified as 35 U.S.C. § 102(b).²⁹

¶ 18 Meanwhile, the ways in which documents were being published in significant quantities was changing. At the time of the Patent Act of 1836, the printing press was the primary means for publishing documents to be distributed to a larger audience. While

²⁶ See *id.*

²⁷ See *Gulliksen v. Halberg*, 75 U.S.P.Q. 252, 254 (Pat. Off. Bd. App. 1937) (Edinburg, Examiner in Chief, dissenting) (noting first appearance of “printed publication” in § 7 of Patent Act of 1836, along with “public use”); see also Neal P. Pierotti, *Does Internet Information Count as a Printed Publication?*, 42 IDEA 249, 257 (2002); Seymore, *supra* note 2, 503 n.55 (2007); Cindy Ricks, Note, *The “Printed Publication” Bar as Applied to Presentations Made at Scientific Conferences*, 83 WASH. U. L.Q. 843, 846 (2005).

²⁸ A different section of the Patent Act of 1836 also referred to the invention being described in a “public work” as a potential bar to patenting, which created some uncertainty as to whether “public work” referred to the same thing as “printed publication.” The Patent Act of 1870 dropped the term “public work,” with the phrase “printed publication” being “adopted in place of this term.” See *In re Tenney*, 254 F.2d 619, 625–26 (C.C.P.A. 1958) (quoting *Gulliksen*, 75 U.S.P.Q. at 254–55 (Edinburg, Examiner in Chief, dissenting) (discussing origins of “printed publication” bar)).

²⁹ To constitute a “printed publication” under 35 U.S.C. § 102(b), the publication must also be an enabling disclosure. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988) (citing *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985)); see also *Iovate Health Sciences, Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 586 F.3d 1376, 1382–83 (Fed. Cir. 2009) (finding an advertisement published in magazine was sufficiently “enabling” to be a “printed publication” bar). An “enabling disclosure” in a “printed publication” is one that permits “one of ordinary skill in the art to practice the claimed invention.” *SRI Int’l, Inc. v. Internet Security Sys., Inc.*, 511 F.3d 1186, 1193–94 (Fed. Cir. 2008), (citing *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988) in unanimously affirming the district court’s ruling that the EMERALD 1997 paper was an “enabling disclosure,” and thus anticipatory under 35 U.S.C. § 102(b) of the claimed invention in the ‘212 patent); see also Ricks, *supra* note 27, at 852 n.54 (stating that a publication must also teach all elements of claimed invention and enable a person having ordinary skill in the art to practice the invention without undue experimentation to be a “printed publication” bar). Even a work of fiction can be an enabling disclosure sufficient to be a “printed publication” bar. See Daniel H. Brean, *Keeping Time Machines and Teleporters in the Public Domain: Fiction as Prior Art for Patent Examination*, 7 U. PITT. J. TECH. L. & POL’Y 5, 7 (2007) (noting the story in Robert Heinlein’s famous 1930s science fiction novel, *Stranger in a Strange Land*, describing the concept of a hydraulic bed made of a flexible skin filled with water which barred a much later attempt to patent the “water bed”).

initial versions of the typewriter existed as far back as the early 1800s,³⁰ the typewriter as we know it today did not become a commercial reality until around the time the Patent Act of 1870 was enacted.³¹ In addition, documents were being preserved in different mediums besides paper. One such medium, microfilm,³² was suggested for recording documents as early as the 1850s, but was not used as a means for preserving documents widely until the 1920s and 1930s.³³

¶ 19 So why is the evolution of how documents are printed, or in the case of microfilm, how these documents are preserved/recorded, relevant? It is because of the emphasis and focus in the early cases on what the term “printed” meant in determining whether there was a “printed publication” bar.³⁴ Under this early “print” theory approach,³⁵ the courts had to decide whether the term “printed” would include methods or devices for creating documents beyond a traditional printing press. For example, would a document prepared on a typewriter qualify as a “printed publication?” In the 1937 case of *Gulliksen v. Halberg*,³⁶ the Patent Office Board of Appeals answered “yes.”³⁷ In *Gulliksen*, the Board was confronted with a typewritten thesis,³⁸ and whether the Patent Act of 1870³⁹ contemplated only documents created by the printing press as a “printed publication.” The Board held it did not, ruling that the typewriter formed characters that were essentially the same as those formed by a printing press.⁴⁰

³⁰ See *Typewriter*, WIKIPEDIA, <http://en.wikipedia.org/wiki/Typewriter> (last visited Feb. 7, 2011).

³¹ See *id.* The first commercially successful typewriter was the “Sholes and Glidden Type-Write” (from which the term *typewriter* originated) and which was patented in June 1868 as U.S. Pat. No. 79,265. *Id.*

³² The generic term for microfilm is microform, which also includes microcards and microfiche. See *Microform*, WIKIPEDIA, <http://en.wikipedia.org/wiki/Microfilm> (last visited Feb. 7, 2011).

³³ For example, between 1927 and 1935, the Library of Congress microfilmed more than three million pages of books and manuscripts in the British Library. The American Library Association also endorsed microforms in 1936. See *id.*

³⁴ See Ricks, *supra* note 27, at 846 (“Because of these changes in printing technology and the development of new technologies, courts have needed to develop tests to determine when a reference should be classified as a printed publication for purposes of the Patent Act.”).

³⁵ See Pierotti, *supra* note 27, at 257-58.

³⁶ *Gulliksen v. Halberg*, 75 U.S.P.Q. 252 (Pat. Off. Bd. App. 1937)..

³⁷ *Id.* at 253. In dissent, Examiner in Chief Edinburg would have answered “no.” *Id.* at 254.

³⁸ A bound copy of a typewritten thesis prepared by F. J. Zak at the Massachusetts Institute of Technology (MIT) and placed on the shelves of the MIT library. *Id.* at 253. Interestingly, the party against whom the Zak thesis was cited as a “printed publication” bar conceded that this thesis was “readily accessible to public” even though there is no discussion of whether the Zak thesis was properly indexed or catalogued. See “thesis/library” cases discussed in Part IV, *infra* notes 119–28.

³⁹ The “printed publication” provision of the Patent Act of 1870 was later codified in Revised Statute 4886 (June 22, 1874), the predecessor to 35 U.S.C. § 102(b).

⁴⁰ *Gulliksen*, 75 U.S.P.Q. at 253 (emphasis added):

While there are certain superficial differences between a typewritten and a printed page, still for the purposes of use, there are really no differences at all. In a typewritten page, the letters are all of uniform size and shape, as in printing, and the words are arranged in lines and spaces in exactly the same manner. The fact that the matter is formed by impressing one type at a time against the paper is deemed to be immaterial. *We should look at the results obtained rather than the process by which the imprint is made.*

In other words, as long as the thesis was prepared in a manner (i.e., typewriting) that looked like a document from a printing press, the number of copies prepared was irrelevant. See Pierotti, *supra* note 27,

¶ 20 The courts had a more difficult time applying the “print” theory approach to the “printed publication” bar when the documents were preserved or recorded on a medium other than paper, such as microfilm. The status of microfilm as a “printed publication” bar was first confronted in the 1958 case of *In re Tenney* by the Court of Customs and Patent Appeals (CCPA), the predecessor to the Federal Circuit.⁴¹ A copy of a German patent application for a fog-producing machine was obtained after World War II from Germany’s patent office and then recorded on microfilm. The microfilm was indexed in the Library of Congress under the heading “German patent applications on aircraft.”⁴²

¶ 21 The CCPA in *In re Tenney* determined that the microfilm was not a “printed publication” bar under the current version of 35 U.S.C. § 102(b).⁴³ The CCPA agreed that a publication must be “printed” to qualify under 35 U.S.C. § 102(b).⁴⁴ But the CCPA also observed that “printing” of the document was alone insufficient for a “printed publication” bar to occur.⁴⁵ Instead, the term “printed publication” in 35 U.S.C. § 102(b) required that the “description not only be printed but be published as well.”⁴⁶ This “published” requirement would ensure the “probability of public knowledge of the

at 251–52 (discussing *Gulliksen* case). In dissent, Examiner in Chief Edinburg disagreed, arguing that a distinction had been drawn between “printing” (making multiple copies of the document) versus “writing” (making copies letter by letter). *Gulliksen*, 75 U.S.P.Q. at 255 (citing *Keene v. Wheatley*, 14 F. Cases 180 (C.C.E.D. Pa) (No. 7644)). Examiner in Chief Edinburg further argued that, if “printed” and “publication” were to be considered together, the “printed publication” bar required the “making [of] a large number of copies so as to ensure general distribution of copies.” *Id.* at 255. In other words, in Examiner in Chief Edinburg’s view, only “printing” (i.e., by a printing press) would likely be able to make such a large number of copies; by contrast, a typewriter likely could not. *Id.* at 255. In *Ex parte Hershberger*, 96 U.S.P.Q. 54, 57 (Pat. Off. Bd. App. 1952), the Patent Office Board of Appeals later held that a thesis in typewritten, *as well as handwritten form*, was a “printed publication” in part because of the permanent character of the ink. *See also* Pierotti, *supra* note 27, at 270 n.174.

⁴¹ *In re Tenney*, 254 F.2d 619 (C.C.P.A. 1958).

⁴² In disputing the status of this German patent application as a “printed publication” bar, the appellant’s brief asserted that the “cited frames of the microfilm have no relation to aircraft.” *Id.* at 621. In fact, the Board of Patent Appeals conceded that “the faulty indexing of the [Office of Technical Services of the Department of Commerce] bibliography would be apt to mislead the public as to the contents of the reel of microfilm in question.” *Id.*

⁴³ *Id.* at 621. In so ruling, the CCPA observed: “Irreconcilable conflicts exist as between the holdings of a number of [cases in the reports on the question of what is or is not a printed publication] and few have set forth sufficient reasoning to be of any assistance to us. In reaching our conclusion we of necessity must disagree with at least several of these cases.” *Id.* at 622. The CCPA also observed that the courts and the United States Patent and Trademark Office had “consistently held that a foreign *typewritten* patent application file which has been opened to public inspection in a foreign patent office” was not a “printed publication” bar. *Id.* at 627 (emphasis added).

⁴⁴ *See id.* at 625 (“No one would dispute the fact that a wholly handwritten publication is not embraced within the phrase ‘printed publication.’”). In fact, the CCPA observed that the microfilmed German patent application in *In re Tenney* had to be “printed” to qualify as a bar under 35 U.S.C. § 102(b) based on the very fact of it being a foreign patent application: “[T]he reason [that] foreign patent applications were not applied as bars by the courts is found in the requirement that the publication, to be a bar, must be ‘printed.’” *Id.* at 624, n.7 (citing *Ex parte Haller*, 103 U.S.P.Q. 332 (Pat. Off. Bd. App. 1953), and *Carter Prods., Inc. v. Colgate-Palmolive Co.*, 104 U.S.P.Q. 314, 320-21 (D. Md. 1955)).

⁴⁵ *Id.* at 626.

⁴⁶ *Id.* In the vernacular of “print” theory, the CCPA treated the term “publication” as reflecting how the document must to be “published” to be “printed,” i.e., the mode or manner must normally make or produce numerous or multiple copies. And only those documents that were “published” in a mode or manner that was likely to provide numerous or multiple copies would be considered by the CCPA to be “printed.”

contents of the publication.”⁴⁷ The CCPA reasoned that, unlike a printing press that would normally be used to mass produce copies, there was no “probability” that multiple copies would be made of microfilm.⁴⁸ Accordingly, the CCPA ruled the microfilmed German patent application was not a “printed publication” bar because it was not “printed” in a manner that would normally provide multiple copies.⁴⁹

¶ 22 Twenty-three years later, the CCPA reversed course, and held in 1981 in *In re Wyer*⁵⁰ that a microfilmed copy of a laid-open patent application in the Australian Patent Office⁵¹ was a “printed publication” bar. In rejecting the “print” theory approach of *In re Tenney*, the CCPA observed that the “traditional dichotomy between ‘printing’ and ‘publication’ is no longer valid.”⁵² Instead, “[g]iven the state of technology . . . the ‘probability of dissemination’ of an item very often has little to do with whether or not it is ‘printed’ in the sense of that word when it was introduced into the patent statutes in 1836.” Instead, the “printed publication” bar “should be approached as a unitary concept.”⁵³ Accordingly, the CCPA in *In re Wyer* reasoned that the “printed publication”

⁴⁷ *Id.* at 626. The CCPA in *In re Tenney* also made clear that it was the *probability* of such “public knowledge” that mattered, not the *actuality* that such “knowledge” had been received: “[O]nce it has been established that the item has been both printed and published, it is not necessary to further show that any given number of people actually saw it or that any specific number of copies have been circulated.” *Id.* at 626–27.

⁴⁸ *Id.* at 627; see Pierotti, *supra* note 27, at 252–53. In essence, the CCPA adopted the reasoning of Examiner in Chief Edinburgh’s dissenting opinion in *Gulliksen* that the document must be reproduced in a mode or manner (e.g., by a printing press) that was *likely to be used to make multiple copies*: “one would be more likely than not to produce a number of copies of printed material.” *In re Tenney*, 254 F.2d at 627 (emphasis added). By contrast, microfilming, while *capable* of making multiple copies, *was not normally used* to make multiple copies: “one producing an item by microfilming would be as apt to make one copy as many.” *Id.* (emphasis added).

⁴⁹ The Third Circuit expressly rejected the “print” theory reasoning of *In re Tenney* for why microfilm was not a “printed publication.” See *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elec. Indus., Inc.*, 450 F.2d 1164, 1169–71 (3d Cir. 1971) (finding that German patent application microfilmed, indexed, and accessible in Library of Congress, Stockholm library, and British Patent Office was “sufficiently disseminated” to be a “printed publication” and noting that the “traditional process of ‘printing’ is no longer the only process synonymous with ‘publication’”). *Philips Electronic* relied upon the holding and rationale of *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738 (S.D.N.Y. 1966) (holding that “printed publication” includes microfilm), which also rejected the “print” theory reasoning for “printed publication” bars. See Ricks, *supra* note 27, at 850 n.45 (2005); see also *Vetco Offshore Indus., Inc. v. Rucker Co.*, 448 F. Supp. 1203 (N.D. Cal. 1978) (holding that blueprints and technical drawings were “printed publications”).

⁵⁰ *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981).

⁵¹ This Australian patent application (for a cable junction box) was another instance of a self-inflicted “printed publication” bar wound because the patent applicant had filed this Australian patent application, which published more than two years prior to his filing the corresponding U.S. patent application. See *id.* at 222.

⁵² *Id.* at 226. In rejecting the “print” theory approach of *In re Tenney*, the CCPA in *In re Wyer* adopted the “publication” theory approach to the “printed publication” bar espoused by the Third Circuit in the *Philips Electronics* case and the Southern District of New York in the *I.C.E. Corp.* case. See *id.* (“The traditional process of ‘printing’ is no longer the only process synonymous with ‘publication.’”) (quoting *Philips Elec.*, 450 F.2d at 1170). See Ricks, *supra* note 27, at 851 (CCPA in *In re Wyer* adopted Third Circuit’s *Philips Electronics* rationale); discussion in Part IV *infra*.

⁵³ *In re Wyer*, 655 F.2d at 225–26 (characterizing *Philips Electronic* and *I.C.E. Corporation* as eschewing the “two-tiered” approach of *In re Tenney* in favor of the “unitary concept” of the “printed publication” bar). Interestingly, the CCPA viewed its decision in *In re Wyer* that the Australian patent

bar should now be examined as a question of “accessibility to at least the pertinent part of the public, of a perceptible description of the invention, in whatever form it may have been recorded.”⁵⁴

¶ 23 While *In re Wyer* and other cases⁵⁵ discarded the “print” theory approach of *In re Tenney*, this approach, as expressed in *Gulliksen*, might still be of value in evaluating (and determining) “printed publication” bars in the Internet age for electronically posted documents. Specifically, the *Gulliksen* approach to the “print” theory considered the changes which had occurred in how documents were being “printed” (i.e., printing press versus typewriter) in evaluating the “printed publication” bar, as well as whether those changes created documents which corresponded essentially to how those documents had been previously “printed” (i.e., were similar in character). Given that electronically posted documents are still “printable,” albeit using modern laser and ink jet printers and techniques, the “print” theory approach of *Gulliksen* might still have some value in recognizing that, as the methods for “printing” (and storing) documents change, so must the approach to the “printed publication” bar change. Even so, Federal Circuit cases after *In re Wyer* have not cited to the “print” theory approach of *Gulliksen* in resolving “printed publication” bars where changes in the methods of printing, and especially storing, documents have occurred, including in both the *SRI International* and *In re Lister* cases which involved electronically posted documents.⁵⁶

IV. SHIFTING THE FOCUS: THE “PUBLICATION” THEORY APPROACH IN THE HARD COPY AGE

¶ 24 In contrast to the “print” theory approach, another line of cases shifted the focus to the “publication” aspect of the “printed publication” bar; that is, was the document adequately “disseminated” and/or “publicly accessible” to the relevant audience?⁵⁷ This shift in focus to the “dissemination/accessibility” of the document has been referred to as the “publication” theory approach for determining the “printed publication” bar.⁵⁸ In fact, the 1981 ruling in *In re Wyer* that a microfilmed copy could be a “printed publication”

application (“a foreign patent application laid open for public inspection”) was a “printed publication” bar to be at odds with other cases that had held such foreign patent applications not to be a “printed publication” bar (including a somewhat mystifying citation to *Philips Electronics* which held the microfilmed, indexed, and accessible foreign patent application in that case to be a “printed publication” bar). See *id.* at 226–27.

⁵⁴ *Id.* at 226. In this regard, the CCPA in *In re Wyer* referred to the purpose of the “printed publication” bar as being “designed to prevent withdrawal by an inventor, as the subject matter of a patent, of that which was already in the possession of the public.” *Id.* For additional discussion of *In re Bayer* and related thesis/library cases, see Part IV *infra* at notes 119–128.

⁵⁵ *In re Wyer*, 655 F.2d at 225–26; see also *Philips Elec.*, 450 F.2d at 1169–71; *Vetco Offshore Indus., Inc. v. Rucker Co.*, 448 F. Supp. 1203 (N.D. Cal. 1978); *I.C.E. Corp.*, 250 F. Supp. at 738.

⁵⁶ When *In re Wyer* came out in 1981, documents were already being printed from and stored on electronic “word processors,” a role later taken over by personal computers. See *Word Processor*, WIKIPEDIA, http://en.wikipedia.org/wiki/Word_processor (last visited Feb. 7, 2011).

⁵⁷ Some cases appear to rely upon both the “print” and “publication” theories. See *Ex parte Hershberger*, 96 U.S.P.Q. 54, 57 (Pat. Off. Bd. App. 1952) (ruling that a typewritten and handwritten thesis was a “printed publication” bar based also on its availability to the public).

⁵⁸ See *Pierotti*, *supra* note 27, at 267–68.

bar was the point where the CCPA merged the terms “printed” and “publication” into its “unitary concept” of the “printed publication” bar⁵⁹ by focusing on the “probability of dissemination” and “public accessibility” of the document.⁶⁰

¶25 The “dissemination” and “publicly accessible” components of the “publication” theory approach for determining “printed publication” bars have also developed as parallel but complimentary doctrinal branches of this approach. Of the two branches, the “dissemination” branch (i.e., the more “active” version of the “publication” theory approach) has the earlier and longer pedigree. In the “dissemination” cases, the courts focused primarily on the following three factors: (1) *who received* the document (i.e., who was the “relevant audience”); (2) *how widely* was the document circulated (i.e., how many copies of the document were disseminated to the relevant audience); and (3) *how long* (or temporarily) was the document in circulation.⁶¹

¶26 The “dissemination” branch can be traced at least as far back as the 1928 case of *Jockmus v. Leviton*.⁶² In *Jockmus*, Judge Learned Hand addressed all three of the “dissemination” factors in holding that a widely circulated trade catalogue, “however ephemeral its existence,” could be a “printed publication” bar.⁶³ Even though the trade catalogue describing the claimed invention was “meant to pass current for a season and to be superseded,” Judge Hand ruled that this trade catalogue qualified as a “printed publication” bar because it was distributed to between 50 and 1000 persons.⁶⁴ In *Jockmus*, Judge Hand also found the transitory existence of this catalogue did not disqualify it from being a “printed publication” bar:

While it is true that the phrase, ‘printed publication,’ presupposes enough currency to make the work part of the possessions of the art, it demands no more. A single copy in a library, though more permanent, is far less fitted to inform the craft than a catalogue freely circulated, however ephemeral its existence; for the catalogue goes direct to those whose interests make them likely to observe and remember whatever it may contain that is new and useful.⁶⁵

⁵⁹ See *In re Wyer*, 655 F.2d at 226.

⁶⁰ See Seymore, *supra* note 2, at 505 n.7 (2007); see also G. Andrew Barger, *Lost in Cyberspace: Inventors, Computer Piracy and “Printed Publications” Under Section 102(b) of the Patent Act*, 71 U. DET. MERCY L. REV. 353, 362 (1994) (“It was not until the landmark case of *In re Wyer* that all lines of distinguishment in the traditional dichotomy between ‘printing’ and ‘publication’ ceased to exist. The Court of Customs and Patent Appeals defined ‘printed publication’ in light of modern technology. The entire emphasis was placed solely on ‘publication.’”).

⁶¹ See *Iovate Health Sciences, Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 586 F.3d 1376, 1380 (Fed. Cir. 2009) (holding an ad published in magazine “accessible to those interested in the art” was a “printed publication” bar); *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). For further discussion, see also *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004), discussed *infra* at notes 93–118.

⁶² *Jockmus*, 28 F.2d 812.

⁶³ *Id.* at 813-14.

⁶⁴ *Id.* at 814.

⁶⁵ *Id.* at 813–14. That the trade catalogue was widely circulated to the relevant audience (thus satisfying the first two factors) was apparently considered by Judge Hand to far outweigh the limited circulation time (third factor) in ensuring sufficient “dissemination” of the catalogue.

¶27 The 1941 case of *Tampax, Inc. v. Personal Products Corp.*⁶⁶ is another early example of a “dissemination” branch case. In *Tampax*, tampons were sold which contained a printed instructional leaflet inside the carton for the product. The Eastern District of New York in *Tampax* held that these leaflets (over 2,000 of them) were “printed publication” bars, reasoning, similar to Judge Hand in *Jockmus*, that the leaflet was “extensively distributed and its use unrestricted, and as easily obtainable as a trade catalogue.”⁶⁷

¶28 Another early “dissemination” case is the 1969 case of *Deep Welding, Inc. v. Sciaky Bros., Inc.*⁶⁸ In *Deep Welding*, conferences on vacuum technology were conducted in Namur, Belgium. The conferences were open to the public, Americans were in attendance, and paper summaries of the presentations were distributed to those in attendance. The Seventh Circuit Court of Appeals held such hard copy conference summaries to be “printed publications” based on these summaries being “distributed at public meetings of persons skilled in the art.”⁶⁹

¶29 Other later “dissemination” cases also appear to be consistent with Judge Hand’s ruling in *Jockmus*. In the 1972 case of *Jursich v. J.I. Case Co.*,⁷⁰ the Northern District of Illinois held that a telephone engineer’s report which was read at an inter-company meeting of engineers, incorporated into the printed meeting minutes, and “disseminated to engineers of at least eleven affiliated but independent telephone companies” was a “printed publication” bar.⁷¹ Even the United States Patent and Trademark Office found in the 1963 case of *Ex parte Brimm*⁷² that an advance proof of a paper that was “printed, widely circulated . . . and discussed at meetings attended by 200 people” qualified as a “printed publication” bar.⁷³

⁶⁶ *Tampax, Inc. v. Personal Products Corp.*, 38 F. Supp. 663 (E.D.N.Y. 1941).

⁶⁷ *Id.* at 671. See Pierotti, *supra* note 27, at 272-73 (discussing *Tampax* case). The patent on this tampon was also considered invalid by virtue of an “on sale” bar under 35 U.S.C. § 102(b) due to these products being put on sale at a single drug store. *Tampax*, 38 F. Supp. at 672. Multiple bases for invalidity (including multiple statutory bars under 35 U.S.C. § 102(b)) is also a fairly common feature of “dissemination” cases like *Tampax*. That there can be “multiple bases” for invalidity in “dissemination” cases may also create precedential ambiguities as to whether the “printed publication” bar is the primary basis for the court’s ruling or simply dicta.

⁶⁸ *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227 (7th Cir. 1969).

⁶⁹ *Id.* at 1235. Pierotti, *supra* note 27, at 271, also observes that the Seventh Circuit “did not account for the possibility that conference summaries could not be accessed by those not in attendance,” require that “those having copies [might] share the conference summaries with those not having copies,” or that the presenter be “required to furnish copies of the summaries upon late requests.” In other words, the potential “temporary availability” did not affect these summaries as being “disseminated,” and thus a “printed publication” bar.

⁷⁰ *Jursich v. J.I. Case Co.*, 350 F. Supp. 1125 (N.D. Ill. 1972). The patent in *Jursich* was also held to be invalid because of a demonstration of the patented machine more than one year before the filing of the patent which was deemed to be a “public use” bar under 35 U.S.C. § 102(b). *Id.* at 1127. See *supra* text accompanying note 67 regarding “multiple” bases for invalidity under 35 U.S.C. § 102(b) in “dissemination” cases.

⁷¹ *Jursich*, 350 F. Supp. at 1128; see also Ricks, *supra* note 27, at 853 n.5.

⁷² *Ex parte Brimm*, 147 U.S.P.Q. 72, 73 (Pat. Off. Bd. App. 1963).

⁷³ See Ricks, *supra* note 27, at 853 n.5. In *Ex parte Brimm*, the patent applicant argued that the advance proof was not a “printed publication” bar because those receiving it were only those registered for the

¶30 *Deep Welding*, as well as *Brimm*, also represents a subcategory of the “dissemination” cases where the document is shared or distributed at a “public conference,” such as a scientific meeting or trade show. The 1985 case of *Tyler Refrigeration Corp. v. Kysor Industrial Corp.*⁷⁴ is another example of this “public conference” subcategory. In *Tyler Refrigeration*, the claimed invention was disclosed in photographs and the accompanying textual description was prominently displayed in a booth at two trade shows in Japan. The same information was also disclosed in brochures that were distributed to customers and others involved in the trade. The District Court of Delaware found that the claimed invention was “widely and publicly disclosed” by the display at the trade shows and that “the disclosure was disseminated in the form of the . . . brochures.” Accordingly, District Court of Delaware had no trouble concluding that these “disseminated” materials qualified as a “printed publication” bar.⁷⁵

¶31 In the same year as *Tyler Refrigeration*, the Federal Circuit dealt with its first “public conference” dissemination case involving a paper that was orally delivered to the First International Cell Culture Congress. In *Massachusetts Institute of Technology v. AB Fortia (MIT)*,⁷⁶ 50 to 500 cell culturists attending that Congress heard the oral presentation of this paper and at least six copies of this paper were distributed. The Federal Circuit in *MIT* ruled that this orally delivered paper was a “printed publication” bar.⁷⁷

¶32 There are other cases in the “public conference” subcategory that have ruled that no “printed publication” bar occurred. In the 1981 case of *Regents of the University of California v. Howmedica, Inc.*,⁷⁸ the District Court of New Jersey held a projection of slides at a lecture did not trigger a “printed publication” bar. There are several key factual findings in *Howmedica* that suggest this ruling is completely consistent with the later “public conference” dissemination rulings in *Tyler Refrigeration* and *MIT*. First, the “projection of slides” at this lecture in *Howmedica* “was limited in duration,” i.e., was a transitory event.⁷⁹ More significantly, the District Court of New Jersey found that the slides shown “could not disclose the invention to the extent necessary to enable a person of ordinary skill in the art to make or use the invention.” In other words, the slides were insufficient to provide an “enabling disclosure” as required by the “printed publication” bar.⁸⁰

¶33 In 2004, the Federal Circuit affirmed a district court ruling in *Norian Corp. v. Stryker Corp.* which held that an abstract taken to a professional conference was not a “printed publication” bar because it was unclear whether copies of the abstract were

conference, and “not as members of the general public,” but that was deemed immaterial by Patent Office Board of Appeals and Interferences. *Ex parte Brimm*, 147 U.S.P.Q. at 74.

⁷⁴ *Tyler Refrigeration Corp. v. Kysor Industrial Corp.*, 601 F. Supp. 590 (D. Del. 1985).

⁷⁵ *See Tyler Refrigeration*, 601 F. Supp. at 601–04; *see also* Ricks, *supra* note 27, at 855–56 (discussing the *Tyler Refrigeration* case).

⁷⁶ *Mass. Inst. Tech. v. AB Fortia*, 774 F.2d 1104, 1108–09 (Fed. Cir. 1985).

⁷⁷ *See id.* at 1109.

⁷⁸ *Regents of the University of California v. Howmedica, Inc.*, 530 F. Supp. 846, 863 (D.N.J. 1981), *aff’d*, 676 F.2d 687 (3d Cir. 1982) (unpublished table decision).

⁷⁹ *See id.* at 859–60.

⁸⁰ *Id.* at 859. *See supra* note 29 and accompanying text.

actually disseminated.⁸¹ While it was “general practice” at this professional conference for presenters to distribute abstracts to “interested attendees,” there was no evidence that the abstract disclosing the invention was actually distributed to anyone.⁸² Accordingly, the patentee’s motion for summary judgment that the abstract was not a “printed publication” bar was granted by the Northern District of California because the abstract was “available only upon individual request to the authors,” and because “such request and dissemination had not been shown.”⁸³ The Federal Circuit agreed, finding that the Northern District of California’s decision in granting the patentee’s motion for judgment as a matter of law was supported by “the lack of substantial evidence of actual availability of the [a]bstract.”⁸⁴

¶ 34 The one decision in this “public conference” subcategory which may be difficult to reconcile is the 1960 case of *Browning Manufacturing Co. v. Bros, Inc.*⁸⁵ which ruled that several drawings displaying the claimed invention at a trade show were not a “printed publication” bar. In *Browning Manufacturing*, the inventors displayed an embodiment of the patented invention, an earth compaction roller (a large fifty ton component), along with at least three drawings of parts of the roller (attached to its side) at a 1948 “road show” held by the American Road Builders Association for at least one week.⁸⁶ A pamphlet describing the patented roller (including two drawings of the roller on the back page which had been attached to the sides of the displayed roller) was also allegedly distributed at this “road show.”⁸⁷

¶ 35 The District Court for Minnesota also observed that “[a] great many people” attended this “road show,” and “a substantial number must have seen the [inventors’] display.”⁸⁸ Even so, the District Court for Minnesota, citing *In re Tenney*, ruled that these drawings were not a “printed publication” bar because there was no evidence on how the drawings were produced and whether “the process used tended to create many such reproductions with minimal time and effort.”⁸⁹ In addition, the District Court for Minnesota observed that “there was no evidence that any copies of these or other

⁸¹ *Norian Corp. v. Stryker Corp.*, 252 F. Supp. 2d 945 (N.D. Cal. 2002), *rev’d on other grounds*, 363 F.3d 1321 (Fed. Cir. 2004).

⁸² *Norian*, 363 F.3d at 1330. One of the co-authors of the abstract (Dr. Chow) “testified that he had attended the meeting and had taken a copy of the abstract to give to a meeting organizer,” but “could not recall whether he attended the presentation and could not recall whether copies of the [a]bstract were actually available to hand out.” *Id.* Another co-author (Dr. Tagaki) “testified that he had attended the presentation,” but “was not questioned about the availability of the [a]bstract.” *Id.* See Ricks, *supra* note 27, at 854-55, which discusses the “printed publication” bar issue in the *Norian* case.

⁸³ *Norian*, 363 F.3d at 1330.

⁸⁴ *Id.* As will be discussed, evidentiary issues can make proof of “dissemination” of the document a challenge in establishing a “printed publication” bar. *Cf. infra* Part V(B), at notes 254–259 discussing evidentiary issues in proving the date of “accessibility” in *In re Lister*.

⁸⁵ *Browning Mfg. Co. v. Bros, Inc.*, 126 U.S.P.Q. 499 (D. Minn. 1960).

⁸⁶ It was also asserted that this display of the patented roller at this “road show” was an invalidating “public use,” as well as “on sale” bar under 35 U.S.C. § 102(b). *Browning Mfg.* 126 U.S.P.Q. at 502. See *supra* note 67 and accompanying text about “multiple bases” for invalidity under 35 U.S.C. § 102(b) in “dissemination” cases.

⁸⁷ *Browning Mfg.*, 126 U.S.P.Q. at 503-4.

⁸⁸ *Id.* at 501.

⁸⁹ *Id.* at 503.

drawings had been ‘distributed or otherwise published.’”⁹⁰

¶ 36 In citing *In re Tenney*, it is clear that the District Court for Minnesota in *Browning Manufacturing* relied at least partially upon the earlier “print” theory approach for determining “printed publication” bars. But with *In re Tenney* being later overruled by the CCPA in *In re Wyer*, a significant basis for the ruling in *Browning Manufacturing* that there was no “printed publication” bar was effectively undermined.⁹¹ Nonetheless, the alternative basis for the ruling in *Browning Manufacturing* relied upon the lack of evidence that copies of the displayed drawings had been distributed or published.⁹² Indeed, other “public conference” cases such as *Howmedica* and *Norian* suggest that the lack of disseminated copies of these displayed drawings might still avoid a “printed publication” bar, even under the “publication” theory approach.

¶ 37 In the 2004 case of *In re Klopfenstein*,⁹³ the Federal Circuit knocked out this alternative basis (i.e., no showing that displayed drawings were distributed or published) for the ruling in *Browning Manufacturing*.⁹⁴ The applicants in *In re Klopfenstein* filed for a patent on methods for preparing foods comprising of extruded soy cotyledon fiber (SCF) on October 30, 2000.⁹⁵ In October 1998, the applicants, along with a colleague (M. Liu), presented a printed slide presentation (the “Liu Slide Presentation”) entitled “Enhancement of Cholesterol-Lowering Activity of Dietary Fibers By Extrusion Processing” at a meeting of the American Association of Cereal Chemists (“AACC”).⁹⁶ The Liu Slide Presentation was a fourteen-slide presentation which was then printed and pasted onto poster boards for the AACC meeting.⁹⁷ The poster boards of the Liu Slide Presentation were displayed continuously for two and a half days at the AACC meeting. The following month (November), the same Liu Slide Presentation was put on display for less than a day at an Agriculture Experiment Station (AES) at Kansas State University.⁹⁸

⁹⁰ *Id.* The “printed publication” bar based on these drawings and pamphlet was asserted in *Browning Manufacturing* on a motion for summary judgment. The District Court for Minnesota considered the evidence presented on both the drawings and pamphlet “conflicting,” and thus did not “conclusively establish” that the drawings were “printed publications,” or that the pamphlets had been distributed at the “road show” to support, as a matter of law, a “printed publication” bar. *Id.* at 505; *see also* *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1158-59 (Fed. Cir. 2004) (conflicting and insufficient evidence of whether undated one page document was “disseminated” at trade show to support grant of motion for summary judgment that document was “printed publication” under 35 U.S.C. § 102(b)).

⁹¹ *See infra* note 94.

⁹² *See supra* note 84 and accompanying text about the evidentiary problems in proving “dissemination.” It should be noted that the evidentiary problem asserted by the District Court of Minnesota in *Browning Manufacturing* related to whether the drawings had been distributed or published, and not whether those drawings had been displayed at the “road show” or were likely seen by those attending the “road show.” *See supra* notes 82 and 90 and accompanying text.

⁹³ *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004).

⁹⁴ In addition, the holding in *Browning Manufacturing* that there was no “printed publication” bar was based primarily on “conflicting” and “inconclusive evidence” to support the grant of motion for summary judgment. *See supra* note 90. After a trial on the merits, the District Court for Minnesota might have reached a different conclusion whether the drawings, the pamphlet or both were a “printed publication” bar.

⁹⁵ *In re Klopfenstein*, 380 F.3d at 1346.

⁹⁶ *Id.* at 1347.

⁹⁷ *Id.*

⁹⁸ *Id.*

¶ 38 The applicants, as well as the PTO, agreed on the following facts: (1) the Liu Slide Presentation presented to the AACC meeting and at the AES in 1998 disclosed every limitation of the claimed invention; (2) at neither the AACC meeting nor the AES presentation was there any disclaimer or notice to the intended audience prohibiting note-taking or copying of the Liu Slide Presentation; (3) no copies of the Liu Slide Presentation were disseminated either at the AACC meeting or at the AES presentation; and (4) the Liu Slide Presentation was never catalogued or indexed in any library or database.⁹⁹ The Examiner rejected the claimed invention as anticipated under 35 U.S.C. §102(b) by the Liu Slide Presentation, or as obvious under 35 U.S.C. §103(a)¹⁰⁰ in view of the Liu Slide Presentation, in combination with other references.¹⁰¹ The applicants appealed to the Board of Appeals and Interferences (The Board), again arguing that the lack of distribution and lack of evidence of copying precluded the Liu Slide Presentation from being considered a “printed publication.” The Board rejected these arguments and affirmed the Examiner’s finding that the Liu Slide Presentation was a “printed publication.”¹⁰²

¶ 39 Before the Federal Circuit, the applicants again advanced their arguments about the lack of distribution and copying of the Liu Slide Presentation, relying on, amongst other cases, the “dissemination” cases of *MIT* and *In re Wyer*,¹⁰³ as well as the “thesis/library” cases¹⁰⁴ of *In re Cronyn*¹⁰⁵ and *In re Hall*.¹⁰⁶ But the Federal Circuit found these arguments unconvincing in *In re Klopfenstein*. Instead, the Federal Circuit provided the example of a public billboard targeted to those of ordinary skill in the art that describes all of the limitations of the claimed invention and which was on public display for months. While this public billboard was neither “distributed” nor “indexed,” it is “sufficiently accessible to the public interested in the art” to be a “printed publication.” Put differently, the applicants’ assertion that “distribution and/or indexing” are the key components to a “printed publication” inquiry “fails to properly reflect what our precedent stands for.”¹⁰⁷

¶ 40 The Federal Circuit then reviewed, in turn, the cases of *In re Cronyn*, *In re Hall*, *MIT*, and *In re Wyer*. The observations by the Federal Circuit on the basis for the *MIT*

⁹⁹ *Id.* at 1347. Agreed-to factual statement (3) is particularly relevant with respect to the continued validity of the alternate basis for the ruling in *Browning Manufacturing*.

¹⁰⁰ In addition to being novelty defeating under 35 U.S.C. § 102(b), “printed publications” (alone or in combination with other “prior art” references) may also serve as “prior art” under 35 U.S.C. § 103 to defeat patentability for those inventions deemed obvious to “one of ordinary skill in the art.” *See, e.g., Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (holding that a 1973 article that failed to disclose certain features of claimed invention still rendered it obvious in view of two other articles and a patent). *See also Ricks, supra* note 27, at 845 n.18 (“printed publication” one form of “prior art” for purposes of 35 U.S.C. § 103, citing *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986)).

¹⁰¹ *In re Klopfenstein*, 380 F.3d at 1347.

¹⁰² *Id.*

¹⁰³ *See id.* at 1348. The applicants apparently did not cite *Browning Manufacturing*.

¹⁰⁴ *See infra* notes 119-128 and accompanying text.

¹⁰⁵ *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989).

¹⁰⁶ *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986).

¹⁰⁷ *In re Klopfenstein*, 380 F.3d at 1349 (citing *Mass. Inst. Tech. v. AB Fortia (MIT)*, 774 F.2d 1104, 1108-10 (Fed Cir. 1985)).

ruling, which was deemed to be the closest factually to *In re Klopfenstein*, are especially worthy of note. The Federal Circuit admitted in *In re Klopfenstein* that a key to the *MIT* ruling was the finding that actual copies of the presentation were distributed. But the Federal Circuit also construed the ruling in *MIT* as not limiting “future determinations of the applicability of the ‘printed publication’ bar to instances in which copies of a reference were actually offered for distribution.”¹⁰⁸

¶41 The Federal Circuit in *In re Klopfenstein* then articulated three factors¹⁰⁹ to consider in determining whether or not a “reference” was “printed publication” bar: (1) was the “reference” shown for an extended period of time¹¹⁰ to members of the public having the relevant level of knowledge (i.e., “ordinary skill in the art”);¹¹¹ (2) were those members of the public precluded from taking notes or even photographs of the “reference;”¹¹² and (3) was the “reference” presented in such a way that copying of the information it contained would be a relatively simple undertaking for those to whom it was exposed?¹¹³ The Federal Circuit ruled that the Liu Slide Presentation was such a “reference” because it was shown: (1) to a wide variety of viewers, a large portion of which possessed the requisite knowledge to understand it; (2) for approximately three cumulative days; (3) with no stated expectation that the displayed information would not be copied or reproduced by those viewing it. Accordingly, the Federal Circuit held that

¹⁰⁸ *Id.* This portion of the Federal Circuit’s opinion in *In re Klopfenstein* directly refutes the alternate basis for the ruling in *Browning Manufacturing* about the lack of dissemination of copies. See *supra* note 94 and accompanying text.

¹⁰⁹ See *id.* at 1350-52. Some have considered *In re Klopfenstein* to articulate a four-factor test. See Seymore, *supra* note 2 at 509. The factors are: (1) “the length of time the display was exhibited;” (2) “the expertise of the target audience;” (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 main difference in calling *In re Klopfenstein* a “four factor” test is treating “the length of time the display was exhibited” and “the expertise of the target audiences” as separate factors. See also discussion of *In re Klopfenstein* as four-factor test in Judge Moore’s partially dissenting opinion in the *SRI International* case *infra* Part V(A), notes 218–226.

¹¹⁰ The Federal Circuit observed that the “duration of the display is important in determining the opportunity of the public in capturing, processing and retaining the information conveyed by the reference” and also that the “more transient the display, the less likely it is to be considered” a “printed publication” bar, citing the *Howmedica* case. *In re Klopfenstein*, 380 F.3d at 1350-51.

¹¹¹ The Federal Circuit observed that the “expertise of the intended audience can help determine how easily those who viewed it could retain the displayed material,” citing to Judge Learned Hand’s opinion in the *Jockmus* case. *Id.* at 1351.

¹¹² The Federal Circuit observed that “[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 to be” a “printed publication” bar, noting that this “helps preserve the incentive for inventors to participate in academic presentations or discussions.” *In re Klopfenstein*, 380 F.3d at 1351. The Federal Circuit also observed that “[w]here parties have taken steps to prevent the public from copying temporarily posted information, the opportunity for others to appropriate that information and assure its widespread public accessibility is reduced.” *Id.* These protective measures “could include license agreements, non-disclosure agreements, anti-copying software or even a simple disclaimer informing members of the viewing public that no copying of the information will be allowed or countenanced.” *Id.*

¹¹³ The Federal Circuit observed that the “more complex a display, the more difficult it will be for members of the public to effectively capture its information.” *Id.* By contrast, the “simpler a display is, the more likely members of the public could learn it by rote or take notes adequate enough for later reproduction.” *Id.*

the Liu Slide Presentation was a “printed publication” bar.¹¹⁴

¶42 In a footnote, the Federal Circuit in *In re Klopfenstein* left open the possibility that an entirely oral presentation at a scientific conference that included neither slides nor copies of the presentation might not be considered a “printed publication” bar.¹¹⁵ Similar to what occurred in the *Howmedica* case, there is also the evidentiary issue of exactly what was revealed by the oral presentation; that is, was the oral presentation an “enabling disclosure?”¹¹⁶ Unlike a printed presentation which is relatively fixed in terms of what is disclosed, it may be much more difficult to establish exactly what was revealed by an oral presentation, especially as time goes by.

¶43 The Federal Circuit in *In re Klopfenstein* was undoubtedly correct in ruling that the Liu Slide Presentation was a “printed publication” bar under a “dissemination” approach. Like the orally delivered paper in the *MIT* case, the Liu Slide Presentation was, after all, displayed to the “target audience” at the AACC meeting, which fits squarely within the “dissemination” line of cases. But what is very troubling about the *In re Klopfenstein* opinion is how much discussion and reference was made to the “thesis/library” cases such as *In re Cronyn* and *In re Hall*.¹¹⁷ As will be discussed shortly, the “thesis/library” cases like *In re Cronyn* and *In re Hall* really have nothing to do with “active” publication (i.e., “dissemination”) as occurred in *In re Klopfenstein*, but are instead the more “passive” version of the “publication” theory approach where the focus is instead on whether the document is “publicly accessible.” This potentially confusing conflation of “dissemination” cases with “publicly accessible” cases in *In re Klopfenstein* may be an unfortunate by-product of the “unitary concept” doctrine enunciated in *In re Wyer*.¹¹⁸

¹¹⁴ At least one writer has suggested that *In re Klopfenstein* represents a “departure, or at least a change in direction, from previous case law” regarding the “printed publication” bar, specifically pointing to the *Norian* and *Browning Manufacturing* cases. Ricks, *supra* note 27, at 861. The *Norian* case can be distinguished on at least the evidentiary ground that there was no proof that the abstract was seen by anyone, much less distributed, at the conference. See *supra* note 82 and accompanying text. As indicated by text at note 91 *supra*, the *Browning Manufacturing* decision relies at least partially upon the *In re Tenney* “print” theory approach for “printed publication” bars which was effectively overruled by the CCPA in *In re Wyer*. As pointed out in notes 90 and 94, the ruling in *Browning Manufacturing* that there was no “printed publication” bar was also based on what was viewed by the District Court of Minnesota as “inconclusive” and “conflicting” evidence to support a motion for summary judgment. If anything, the ruling in *Browning Manufacturing* is at odds with “previous case law,” not the Federal Circuit’s ruling in *In re Klopfenstein*. See Seymore, *supra* note 2, at 495 (*In re Klopfenstein* is consistent with prior 35 U.S.C. § 102(b) case law).

¹¹⁵ *In re Klopfenstein*, 380 F.3d at 1349, n.4. The Federal Circuit specifically cited the situation in the *Howmedica* case which, while “not binding on this court, [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” bar. *But see* *Mass. Inst. Tech. v. AB Fortia (MIT)*, 774 F.2d 1104, 1108–09 (Fed. Cir. 1985), where an orally delivered paper was ruled by the Federal Circuit to be a “printed publication” bar.

¹¹⁶ See *supra* notes 80 and 29.

¹¹⁷ The discussion of the “thesis/library” line of cases, along with the resulting conflation with the “dissemination” line of cases, may also have been due in part to the patent applicants’ arguments on appeal. See *In re Klopfenstein*, 380 F.3d at 1348. where the patent applicants supported their arguments by citation to *In re Cronyn* and *In re Hall* (clearly “thesis/library” cases), *In re Wyer* (a “publicly accessible” case analogous to *In re Cronyn* and *In re Hall*), and *MIT* (clearly a “dissemination” case).

¹¹⁸ See *supra* Part III at note 53.

¶44 The cases addressing the other, “publicly accessible” branch of the “publication” theory approach have focused on those situations where the documents are stored, catalogued, and indexed at a particular stationary location, such as a library. The CCPA, followed by the Federal Circuit, developed most of the boundaries for the “publicly accessible” branch in a trilogy of “thesis” or “library” cases known as *In re Bayer*,¹¹⁹ *In re Hall*,¹²⁰ and *In re Cronyn*.¹²¹ In the 1978 *In re Bayer* case, the thesis at issue was uncatalogued and unshelved, and could be found in the library at the University of Toledo “only by one having been informed of its existence by the [author’s] faculty committee, and not by means of the customary research aids available in the library.”¹²² The CCPA ruled in *In re Bayer* that this uncatalogued and unshelved thesis was not “publicly accessible.” By contrast, in the 1986 *In re Hall* case, the dissertation at issue was shelved, as well as indexed in a catalog at the Freiburg University library. The Federal Circuit held that this dissertation, by being shelved, and especially indexed in the catalog at a university library, was “publicly accessible.”¹²³

¶45 In the 1989 *In re Cronyn* case, the Federal Circuit was confronted with reconciling what appeared to be inconsistent views expressed in *In re Bayer* and *In re Hall*. In *In re Cronyn*, the three student theses at issue were housed in the main campus library, as well as the chemistry department library at Reed College. Each library contained a collection of the student theses and a corresponding set of index cards that listed the title and author of each thesis.¹²⁴ These index cards were filed alphabetically by the author’s last name, which, as the Federal Circuit noted, “bears no relationship to the subject of the student’s thesis.”¹²⁵ As later observed in *In re Lister*,¹²⁶ the Federal Circuit in *In re Cronyn* reconciled this potential conflict between *In re Bayer* and *In re Hall* as follows: “the critical difference between [*In re Bayer* and *In re Hall*] that explains the different results is that on the critical date in *Bayer* the thesis was ‘uncatalogued and unshelved’ and therefore not accessible to the public, whereas in *Hall* the ‘dissertation was accessible’ because it had been indexed, cataloged and shelved.”¹²⁷ Accordingly, while the student theses and the corresponding index cards for them were available for public examination at Reed College, the Federal Circuit in *In re Cronyn* ruled that these theses were not “publicly accessible” because “they had not been either cataloged or indexed in a meaningful way.”¹²⁸

¹¹⁹ *In re Bayer*, 568 F.2d 1357 (C.C.P.A. 1978).

¹²⁰ *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986).

¹²¹ *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989).

¹²² *In re Bayer*, 568 F.2d at 1361.

¹²³ *In re Hall*, 781 F.2d at 899-90.

¹²⁴ *In re Cronyn*, 890 F.2d at 1159.

¹²⁵ *Id.* at 1161.

¹²⁶ *See infra* Part V(B).

¹²⁷ *In re Cronyn*, 890 F.2d at 1161.

¹²⁸ *Id.* Another feature of the “thesis/library” cases that makes cataloguing/indexing in a “meaningful way” critical is that, as exemplified in the *In re Bayer*, *In re Hall*, and *In re Cronyn* cases, there is often only one copy of the document in existence. *See also* *Hamilton Labs., Inc. v. Masegill*, 111 F.2d 584 (6th Cir. 1940) (single indexed copy of a dissertation placed in a university library a “printed publication” bar); *Ex parte Hershberger*, 96 U.S.P.Q. 54 (Pat. Off. Bd. App. 1952) (typewritten/handwritten thesis deposited and properly indexed in University of Michigan library held to be “printed publication” bar); Pierotti, *supra* note 27, at 263–65. (discussing *Hamilton Labs* and *Ex parte Hershberger* cases in comparing ease of

¶46 The 1990 case of *Northern Telecom, Inc. v. Datapoint Corp.*¹²⁹ further clarified what sort of “access” to the documents located in a library was sufficiently public. In *Northern Telecom*, the patented invention related to a mode of “batch processing” of data. One of the defenses raised by the alleged infringer was a “printed publication” bar based on certain “AESOP-B” documents.¹³⁰ AESOP-B was a complex military system for on-line distributed computer processing of logistical data such as the positions of aircraft. The “AESOP-B” documents in question were four reports identified as exhibits DX-2 through DX-5. These reports were not under security classification, and were distributed to approximately fifty persons or organizations involved in the AESOP-B project. Report DX-5 contained the following legend: “Reproduction or further dissemination is not authorized . . . not for public release.”¹³¹ Reports DX-2 through DX-5 were housed in a library at Mitre Corporation, the company with principal responsibility for developing AESOP-B. Access to this library was restricted to persons authorized by Mitre.¹³²

¶47 Citing to the cases of *MIT* and *In re Wyer*, the Federal Circuit observed in *Northern Telecom* that, for a document to be a “printed publication,” it “must be generally available.”¹³³ But the district court had referred to “the uncertainties of public access to the AESOP-B documents” in ruling that it was “unable to find that anyone could have had access to the documents by the exercise of reasonable diligence.”¹³⁴ In other words, the restricted access to the AESOP-B documents meant they were not “publicly accessible.” Accordingly, the Federal Circuit affirmed the district court’s ruling that there was no “printed publication” bar.¹³⁵

¶48 Crucial to the holding of no “public accessibility” in *In re Cronyn* was that the cataloguing and indexing of the thesis had to be in a “meaningful way.” Unfortunately, and just two years prior to *SRI International*, the 2006 case of *Bruckelmyer v. Ground Heaters, Inc.*¹³⁶ provided a perplexing answer to what cataloguing and indexing in a

“ability to find” theses deposited and indexed in library versus Internet searches of information located on a web site.)

¹²⁹ *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 520 (1990).

¹³⁰ *Id.* at 936.

¹³¹ *Id.* The district court (Northern District of Texas) found that documents DX-2 through DX-4 “may have” contained such notices, also finding that they “were of the class of documents that would have been distributed with such a notice.” *Id.*

¹³² *Id.*

¹³³ *Id.* (The Federal Circuit in *Northern Telecom* also cited to the Court of Claims case of *Garrett Corp. v. United States*, 422 F.2d 874, 878 (Ct. Cl. 1970) which observed that “[w]hile distribution to government agencies and personnel alone may not constitute publication . . . distribution to commercial companies without restriction on use clearly does.”). The portion of the case that substantiates this seems to directly cite *Garrett Corp.* itself, not *Northern Telecom*.

¹³⁴ *Northern Telecom*, 908 F.2d 931, at 936-37.

¹³⁵ *Id.* at 937.

¹³⁶ See *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374 (Fed. Cir. 2006). The *Bruckelmyer* case was issued prior to *SRI International*. For a ruling after *SRI International* which implicitly addresses indexing in a “meaningful way,” see *In re Natures Remedies, Ltd.*, No. 2008-1436, slip op. at 5-8 (Fed. Cir. Mar 12, 2009) (non-precedential) which held that an application submitted to the Scientific-Ethical Committee of Copenhagen seeking approval for clinical testing of certain drug capsules that was listed in

“meaningful way” means in the context of a foreign patent and its respective file wrapper. In *Bruckelmyer*, the patentee (Bruckelmyer) stipulated that if two drawing figures in a Canadian patent application which issued as a Canadian patent (the ‘119 application/patent) were a “printed publication,” it would render its patents invalid as obvious under 35 U.S.C. § 103.¹³⁷ The problem was that these two drawing figures were *cancelled* during the Canadian prosecution of the ‘119 application, and thus were *not published* with the issued ‘119 patent. But these two cancelled drawing figures *remained in the file wrapper* of the ‘119 patent.¹³⁸

¶ 49 The District Court for Minnesota ruled that the ‘119 application was a “printed publication” bar. First, the District Court noted that the ‘119 application/patent was available for public inspection at the Canadian Patent Office. Second, the District Court determined, “albeit in a conclusory manner” that the contents of the file wrapper (i.e., the two cancelled drawing figures) of the ‘119 application/patent were “sufficiently accessible to the relevant and interested public” to be a “printed publication” bar.¹³⁹

¶ 50 Relying upon *In re Klopfenstein*, the patentee argued on appeal that the ‘119 application was not “publicly accessible” just because it was laid open for inspection to the general public during the relevant prior art time frame. Instead, to be “publicly accessible,” the ‘119 application must either be: (1) published to those interested in the art for a sufficient amount of time to allow them to “captur[e], process[] and retain[] the information conveyed by the reference; or (2) those interested must be able to locate the material [contained in the ‘119 application] in a meaningful way.”¹⁴⁰ Because “there was no evidence in the record indicating that the contents of [the ‘119 application] file wrapper were disseminated,” and because “there were no copies known to have been made and sent elsewhere during the [relevant] prior art period,” the patentee asserted that the two cancelled drawing figures in the ‘119 application file wrapper were not “publicly accessible.”¹⁴¹

¶ 51 The patentee additionally argued on appeal that “a person of ordinary skill in the art” would not have been able to locate the two cancelled drawing figures “because the Canadian Patent Office did not index or catalogue the ‘119 application.”¹⁴² First, there was no printed abstract of the ‘119 application that was classified and published to allow one skilled in the art to locate the two cancelled drawing figures. Second, the ‘119 patent itself would not have guided a person of ordinary skill in the art to locate the two cancelled drawing figures because those figures were “removed” from the ‘119 application during prosecution.¹⁴³

an “index of the notification of clinical trials” which was open to public inspection was “publicly accessible,” and therefore a “printed publication” bar.

¹³⁷ See *Bruckelmyer*, 445 F.3d at 1375. See also *supra* note 100 and cases cited therein.

¹³⁸ See *Bruckelmyer*, 445 F.3d at 1376.

¹³⁹ See *id.* at 1376-77.

¹⁴⁰ See *id.* at 1377-78.

¹⁴¹ *Id.*

¹⁴² *Id.* at 1378.

¹⁴³ *Id.*

¶ 52 But a majority of the Federal Circuit panel agreed with the District Court for Minnesota that the ‘119 application, as well as the two cancelled drawing figures, were “publicly accessible.”¹⁴⁴ While the two cancelled drawing figures “were not [asserted to be] actually disseminated,” the patentee had conceded that these cancelled drawing figures “were in the [‘119] patent file and were enabling.”¹⁴⁵ Accordingly, “the only question that remains for us to answer is whether [an interested] person of ordinary skill in the art . . . exercising reasonable diligence would have been able to locate the ‘119 application.” If the answer to that question was “yes,” then the two cancelled drawing figures were “publicly accessible.”¹⁴⁶

¶ 53 The majority opinion ruled that the *In re Wyer* case was controlling because the Australian patent application in that case, like the ‘119 application, was also laid open for public inspection.¹⁴⁷ In addition, the published abstract of the Australian application in *In re Wyer* “would have allowed one skilled in the art exercising reasonable diligence to locate the [Australian] patent application” which was classified and indexed in the [Australian] patent office.”¹⁴⁸ This was deemed by the majority opinion in *Bruckelmyer* to be central to the holding in *In re Wyer* that the Australian application was “publicly accessible.”¹⁴⁹

¶ 54 In fact, the majority opinion in *Bruckelmyer* went one step further and asserted that the published ‘119 patent was “even more of a roadmap to the [‘119] application file” than the *abstract* of the Australian application was in *In re Wyer*.¹⁵⁰ This assertion was based on the ‘119 patent stating uses that were “the same use contemplated by the methods claimed” by the patentee in *Bruckelmyer* such that “a person of ordinary skill in the art interested in the subject matter of the patents in suit and exercising reasonable diligence” would have located the ‘119 application, including the two cancelled drawing figures.¹⁵¹ In affirming the District Court of Minnesota’s ruling that the two cancelled drawing figures were “publicly accessible,” the majority opinion concluded by stating that there was “no genuine dispute that the ‘119 patent was classified and indexed, as the abstract was in *In re Wyer*, further providing the “roadmap that would have allowed one skilled in the art to locate the ‘119 application.”¹⁵²

¶ 55 Where the majority opinion in *Bruckelmyer* is on very shaky ground is how it “factually distinguished” (or more aptly glossed over) the “meaningfully catalogued or indexed” requirement of *In re Cronyn*. The majority opinion characterized this *In re*

¹⁴⁴ *See id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 1378-79.

¹⁴⁸ *Id.* at 1379.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.* The majority of the Federal Circuit panel in *Bruckelmyer* further asserted that “it would be inconsistent to determine that one skilled in the art could have located a foreign patent application based on information in a published abstract, as our predecessor court found in *In re Wyer*, but not here, where there was an issued patent. After all, an issued patent is presumably more informative of the content of its application file than a mere abstract of the patent application.” *Id.*

¹⁵² *Id.*

Cronyn requirement as “whether [the] theses were meaningfully catalogued or indexed [so that] one skilled in the art could locate them.”¹⁵³ But the majority opinion then glossed over this *In re Cronyn* requirement by saying “it does not matter whether the ’119 application was catalogued or indexed ‘in a meaningful way’ because the ’119 patent was indexed and could serve as a ‘research aid.’”¹⁵⁴

¶⁵⁶ The majority opinion also dismissed the patentee’s argument that the two cancelled drawing figures were “removed” from the ’119 application during prosecution, observing that these cancelled drawing figures were not physically removed, but were “still in the file, although they did not appear in the issued [‘119] patent.”¹⁵⁵ The majority opinion asserted that it was irrelevant that these cancelled drawing figures failed to appear in the issued ’119 patent because there was sufficient disclosure in the ’119 patent “to allow one skilled in the art to locate the [two cancelled drawing] figures contained in the [‘119] application.”¹⁵⁶

¶⁵⁷ Judge Linn dissented, taking issue with the majority’s basis for distinguishing *In re Cronyn*, and especially for relying upon *In re Wyer* to assert that the issued ’119 patent was “even more of a roadmap to the application file than an abstract, [by] inferring that the issued [‘119] patent can take the place of [the classified and indexed abstract in *In re Wyer*].”¹⁵⁷ Instead, Judge Linn argued that “it is not entirely sound to view the issued ’119 patent as a roadmap to the underlying file history.”¹⁵⁸ As Judge Linn saw it, an “abstract, which is similar in many respects to a library index card, is a brief statement of the contents of something else, i.e., the more extensive text to which it refers.”¹⁵⁹ In contrasting the abstract contained in an issued patent (“a summary of the technical information contained in the specification”) with the printed text of that same patent (the “abstract, written description, and claims”), Judge Linn also observed that the printed text of the issued patent is “not necessarily looked to as a summary or index of the underlying file history.”¹⁶⁰ As Judge Linn further observed:

While it is commonplace for parties to examine patent file histories for guidance on matters of claim interpretation, surrender, estoppel, disclaimer, or disavowal, researchers normally expect the text of printed patents to correspond to and be coextensive with the applications from which they have been issued. In that sense, the text of an issued patent

¹⁵³ *Id.*

¹⁵⁴ *Id.* (citing *In re Cronyn*, 890 F.2d at 1161). The citation by the majority opinion to the “research aid” statement in the *In re Cronyn* case is out of context. As this statement in *In re Cronyn* makes clear, even these “research aids” must provide the public with knowledge of what the relevant “contents” are in the document of interest. While indexing of the ’119 patent might tell one skilled in the art what subject matter was *generally* described in the ’119 patent, it still would not tell or even suggest to that person the *existence* of the two cancelled drawing present in the ’119 patent file wrapper.

¹⁵⁵ *Id.* at 1379-80..

¹⁵⁶ *Id.* at 1380.

¹⁵⁷ *Id.* (Linn, J., dissenting).

¹⁵⁸ *Id.*

¹⁵⁹ *Id.* (further noting that an abstract “is intended to serve as a tool to steer researchers to the content of a larger and more comprehensive work”).

¹⁶⁰ *Id.*

does not generally serve to guide researchers to the file history for a more expansive disclosure of the described invention, and it certainly does not lead researchers to the file history for disclosure of subject matter not described in the issued text.¹⁶¹

¶ 58 Even if the issued '119 patent “may be considered a form of index to the underlying file history,” Judge Linn rightly took the majority opinion to task for suggesting that, from “the text of the issued '119 patent,” additional relevant disclosure (i.e., the two cancelled drawing figures) might be “found in the underlying '119 application.”¹⁶² The presence of the two cancelled drawing figures was “a matter of sheer happenstance nowhere indicated in the issued ['119] patent.”¹⁶³ Instead, in Judge Linn’s view, the holding in *In re Cronyn* controlled because these two cancelled drawings were “not accessible to the public because they have not been cataloged or indexed in a meaningful way.”¹⁶⁴ In addition to not being “meaningful indexed,” Judge Linn observed that “no copies [of the '119 application file] were known to have been made or distributed during the critical period, and the '119 application was available for viewing only at the Canadian Patent Office.”¹⁶⁵ In other words, there was no “dissemination” of the '119 application file wrapper, including the two cancelled drawing figures.

¶ 59 That the '119 application file was “publicly accessible” and that the two cancelled drawing figures were present in the '119 application file appears to be undisputed. But one has to agree with Judge Linn that characterizing these two cancelled drawing figures as being “publicly accessible” so as to constitute a “printed publication” bar is an entirely different matter. As phrased by the majority opinion, “whether [an interested] person of ordinary skill in the art . . . exercising reasonable diligence would have been able to locate the '119 application”¹⁶⁶ is not the crucial question. Nor is it whether “the '119 patent was classified and indexed” to provide a “roadmap that would have allowed one skilled in the art to locate the '119 application.”¹⁶⁷

¶ 60 Instead, the crucial question in *Bruckelmyer* is this: *based on what was described in the issued '119 patent*, would a person of “ordinary skill in the art” even know (or even be put on notice) that there was anything *additionally relevant* in the '119 application file, much less the two cancelled drawing figures? Or as Judge Linn alternatively challenged,¹⁶⁸ was the majority opinion correct in saying that the “issued '119 patent [a] roadmap to the underlying file history?” The answer to either of these questions has to be an emphatic “no” unless the “person of ordinary skill in the art” is also considered clairvoyant. There is *absolutely nothing* in the facts presented by the majority opinion that would indicate from the issued '119 patent the existence of these two cancelled

¹⁶¹ *Id.*

¹⁶² *Id.* at 1381

¹⁶³ *Id.*

¹⁶⁴ *Id.* (citing *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989)).

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* at 1378.

¹⁶⁷ *Id.* at 1379.

¹⁶⁸ *Id.* at 1380.

drawing figures. Instead, as Judge Linn also aptly noted,¹⁶⁹ the presence of these two cancelled drawing figures in the ‘119 application file was “sheer happenstance” which provided absolutely no clue to the existence of these cancelled drawings in this application file. And without any indication in the issued ‘119 patent that these two cancelled drawing figures existed, it is very hard to reconcile the majority opinion in *Bruckelmyer* with *In re Cronyn*’s “meaningfully catalogued or indexed” requirement.¹⁷⁰

¶ 61 Even Judge Linn’s dissenting opinion in *Bruckelmyer* has a troublesome aspect by again suggesting that *In re Klopfenstein* is a “publicly accessible” branch case when it is not.¹⁷¹ Judge Linn’s affirming references to “public accessibility” in *In re Klopfenstein* would not be as worrisome if he had also pointed out that the holding in *In re Klopfenstein* could be and should be squarely based on “dissemination” case law jurisprudence. By not making that distinction, Judge Linn’s dissenting opinion contributes to the confusing conflation created by *In re Klopfenstein* between the “publicly accessible” and “dissemination” branch cases. In fact, by being apparently

¹⁶⁹ *Id.* at 1380.

¹⁷⁰ A petition for rehearing en banc in *Bruckelmyer* was also denied with Judge Newman writing a dissenting opinion which was joined by Judge Linn. See *Bruckelmyer v. Ground Heaters, Inc.*, 453 F.3d 1352 (Fed. Cir. 2006) (denying petition for rehearing en banc). With reference to the two cancelled drawing figures in the ‘119 application, Judge Newman was blunt: “This excised and unpublished and unreferenced material is not a ‘printed publication,’ no matter how generously that concept is defined.” *Id.* at 1353 (Newman, J., dissenting). Judge Newman also observed the distinction between “prior art” in the United States (which includes “knowledge” and “use”) and in foreign countries (“knowledge” is not “prior art” unless “patented or described in a printed publication”). *Id.* at 1353-54 (Newman, J., dissenting) (citing *In re Tenney*, 254 F.2d 619, 626-27 (C.C.P.A. 1958)). Judge Newman also referred to the earlier CCPA “printed publication” bar cases (including *In re Wyer* which was specifically cited. See *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981)) which understood the term “printed” to mean “multiple copies that were made in order to disseminate the information.” See *Bruckelmyer*, 445 F.3d at 1354 (Newman, J., dissenting). As Judge Newman saw it, based on these earlier CCPA “printed publication” bar cases, “[t]he idea was that there must be some likelihood that the information would, at least in principle, be available to interested persons in the United States.” *Id.* at 1354. But unlike *In re Wyer* which was relied upon by the panel majority in *Bruckelmyer*:

The drawings in the Canadian patent application were not available in multiple locations, could not be ordered from the Canadian patent office, were not indexed or cataloged, and their presence cannot be divined from the Canadian patent that eventually issued. As Judge Linn observes in his dissent, a person searching for prior art cannot be reasonably expected to look in the prosecution history of a foreign patent that does not disclose the invention, on the off chance that its inventor might have invented something relevant to the search, and then cancelled it from the application before grant. *Id.* at 1355 (Newman, J., dissenting).

¹⁷¹ See *Bruckelmyer*, 445 F.3d at 1381 (Linn, J., dissenting) (“In *Klopfenstein*, this court discussed that the requirement of public accessibility can be satisfied under a variety of conditions, including when there has been a meaningful distribution, indexing, or display of the material to the public interested in the art.”). This statement, by combining the phrases “distribution” and “display” (i.e., “dissemination” case terminology) with “indexing” (i.e., “publicly accessible” case terminology) further muddles the important distinctions between the “dissemination” and “publicly accessible” branches of the “printed publication” bar. In fact, by including the term “meaningful” to describe when “distribution,” “indexing,” or “display” of the material becomes relevant as a “printed publication” bar, Judge Linn’s dissent adds further confusion to the conflation created by *In re Klopfenstein*.

oblivious to this distinction between these two branches of cases,¹⁷² Judge Linn potentially undercuts the persuasiveness of his dissent that the '119 patent application was not “meaningfully catalogued or indexed” so as to be a “printed publication” bar.

V. THE INTERNET AGE ARRIVES: THE IMPACT OF ELECTRONIC POSTING OF DOCUMENTS ON THE “PRINTED PUBLICATION” BAR

A. Document Temporarily Posted Yet Freely Accessible on FTP Server:¹⁷³ *SRI International v. Internet Security Systems*

¶ 62 Somewhat ironically, the Federal Circuit’s first venture in applying the “printed publication” bar to electronically posted documents in the *SRI International* case involved four patents (the '203, the '212, the '338, and the '615 patents) covering cyber security and intrusion detection technology. As described in the abstract of the '203 patent, this technology was directed at a “computer-automated method of hierarchical event monitoring and analysis within an enterprise network including deploying network monitors in the enterprise network, detecting, by the network monitors, suspicious network activity based on analysis of network traffic data.” In more common language, this technology (known as the “EMERALD” project) provided “a tool for tracking malicious activity across large networks.” All four patents originated from a single patent application filed November 9, 1998.¹⁷⁴

¶ 63 In 1997, the two inventors listed on these patents authored an article entitled “Live Traffic Analysis of TCP/IP Gateways” (the “Live Traffic Paper”). All four patents incorporated the Live Traffic Paper by reference. The Live Traffic Paper, as published in the December 12, 1997 proceedings of the 1998 Symposium on Network and Distributed

¹⁷² *See id.*:

In *Klopfenstein*, we held that a reference was made sufficiently publicly accessible because, despite that it was not indexed and copies were not distributed to the public, it was prominently displayed for several days to a wide variety of interested viewers who were free to take notes or photographs, and copying would have been a simple undertaking.

Judge Linn’s dissent does try to dissipate some of the potential adverse impact of the holding in *In re Klopfenstein* on the importance of “meaningfully catalogued and indexed” in his statement that follows: “In this case, in addition to not being meaningfully indexed, as discussed above, *no copies were known to have been made or distributed during the critical period*, and the '119 application was available for viewing only at the Canadian Patent Office in Hull, Quebec.” *Id.* (emphasis added). But as indicated by the underlined language, even this further clarifying statement by Judge Linn conflates (again) “dissemination” doctrine with “publicly accessible” doctrine.

¹⁷³ FTP servers are basically computers that use the File Transfer Protocol (FTP) for transferring electronic files and may function as repositories (hosts) for storing electronic files which may be retrieved through an electronic network (e.g., the Internet) by using, for example, a web browser, and then copied to other, usually remote locations (e.g., a personal computer). *See File Transfer Protocol*, WIKIPEDIA, http://en.wikipedia.org/wiki/FTP_server (last visited Feb. 7, 2011); *See also infra* note 222. (Judge Moore discussing the meaning and purpose of the File Transfer Protocol as it relates to the Internet).

¹⁷⁴ *SRI Int'l. Inc. v. Internet Sec. Sys., Inc.* 511 F.3d 1186, 1188 (Fed. Cir. 2008).

Index of ftp://ftp.csl.sri.com/pub/emerald

Up to higher level directory

 <u>BBN</u>		2/27/2006	8:34:00 AM
 <u>I3P_T4</u>		1/3/2006	11:02:00 AM
 <u>UnivOfMaryland</u>		2/27/2006	8:32:00 AM
 <u>custom</u>		11/5/2001	12:00:00 AM
 <u>BSM</u>		4/24/2002	12:00:00 AM
 <u>emerald.avi</u>	11262 KB	9/3/2001	12:00:00 AM
 <u>presentations</u>		6/4/2002	12:00:00 AM
 <u>private</u>		2/27/2006	9:46:00 AM

¶ 66

¶ 67 There were seven instances where Porras had previously directed people to the “emerald” subdirectory to find other papers related to the EMERALD project.¹⁷⁹ In every one of these seven instances, Porras directed the people to a specific paper, which included the term “emerald” in the filename. In fact, in four of those instances, Porras provided the full path and filename of the paper.¹⁸⁰

¶ 68 SRI International sued Internet Security Systems, Inc. (“ISS”) and Symantec Corporation (“Symantec”) for infringing all four patents. ISS and Symantec moved for summary judgment arguing that each of these four patents was invalid based on the Live Traffic Paper being a “printed publication” bar.¹⁸¹ The District Court for Delaware ruled that Live Traffic Paper was a “printed publication” bar to all four patents.¹⁸²

¶ 69 Judge Rader wrote the majority opinion for the Federal Circuit, holding that there were sufficient factual issues regarding “public accessibility” of the Live Traffic Paper to prevent the grant of summary judgment as a “printed publication” bar.¹⁸³ In reversing the grant of summary judgment, Judge Rader observed that the District Court of Delaware based its “printed publication” bar ruling on the following facts: (1) the

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 1192. ISS and Symantec also moved for partial summary judgment on the ‘212 patent based on the EMERALD 1997 Paper being a “printed publication” bar which was also granted. *See supra* note 5.

¹⁸² *SRI Int’l, Inc. v. Internet Security Sys., Inc.*, 456 F. Supp.2d 623 (D. Del. 2006). SRI International, ISS and Symantec all agreed that, if the Live Traffic Paper was a “printed publication” bar, all four patents were invalid under 35 U.S.C. § 102(b). *SRI*, 511 F.3d at 1194.

¹⁸³ *SRI Int’l*, 511 F.3d at 1188. Senior Judge Mayer joined Judge Rader’s majority opinion. Upon remand and after a trial on the merits, the jury found that the ISS and Symantec had failed to demonstrate by clear and convincing evidence that the Live Traffic Paper was a “printed publication” bar. The District Court of Delaware upheld the jury verdict as being supported by “substantial evidence” that suggested: (1) persons of ordinary skill in the art required navigational direction through the SRI International FTP site; and (2) Porras intended to keep the Live Traffic Paper confidential and was successful in doing so. *See SRI Int’l, Inc. v. Internet Security Sys., Inc.*, 647 F. Supp.2d 323, 346–48 (D. Del. 2009).

ftp://ftp.csl.sri.com site (the FTP site) was “publicly accessible”; (2) Porras provided the FTP site to other members of the intrusion detection community both in presentations and via e-mail; (3) the SRI International’s FTP server directory structure gave access to the article to a person of ordinary skill in the art; and (4) one of ordinary skill would know that the SRI International FTP server contained information on the EMERALD project and therefore would navigate through the folders to find the Live Traffic Paper.¹⁸⁴

¶ 70 In ruling that “this court perceives factual issues that prevent entry of summary judgment of invalidity based on the Live Traffic [Paper],” Judge Rader pointed to “one line of cases illustrating a lack of public accessibility” (i.e., *In re Bayer* and *In re Cronyn*), as well as “another line of cases pointing out public accessibility” (i.e., *In re Wyer*, *In re Klopfenstein*, and *Bruckelmyer*).¹⁸⁵ In discussing each of these lines of cases, Judge Rader observed that “this case falls somewhere between *In re Bayer* and *In re Klopfenstein*.”¹⁸⁶ Like the “uncatalogued thesis” of the *In re Bayer* case, the Live Traffic Paper was placed on the SRI International FTP server, yet this FTP server “did not contain an index or catalogue or other tools for customary and meaningful research.”¹⁸⁷ Judge Rader additionally observed that “neither the directory structure nor the README file in the [‘pub’ directory] identifies the location of papers or explains the mnemonic structure for files in the [‘emerald’] subdirectory, or any subdirectory for that matter. In fact, the [‘emerald’] subdirectory does not contain a README file.”¹⁸⁸

¶ 71 In further ruling that the “facts militate against a finding of public accessibility,” or “[at least] warrant examination upon remand,” Judge Rader also commented on the lack of a showing that “an anonymous user skilled in the art in 1997 would have gained access to the [SRI International] FTP server and would have freely navigated through the

¹⁸⁴ *SRI Int’l*, 511 F.3d at 1195. In asking for reversal of the ruling by the District Court of Delaware on appeal, SRI International asserted that: (1) the Live Traffic Paper sent to Dr. Bishop via e-mail was placed on the SRI International FTP server for seven-days as a backup to this e-mail and was therefore “a private prepublication communication”; (2) the District Court of Delaware misread the Federal Circuit’s jurisprudence with respect to the ability of a person of ordinary skill to navigate the SRI International FTP server directory structure to find the Live Traffic Paper; and (3) the ndss98.ps file name for the Live Traffic Paper “was not indexed or catalogued in any meaningful way to enable a person of ordinary skill to locate the paper.” *Id.* In support of the District Court of Delaware’s ruling that the Live Traffic Paper was a “printed publication” bar (and in response to SRI International’s assertions), ISS and Symantec made the following counterarguments: (1) the posting of the Live Traffic Paper to “a publicly accessible FTP server” made the Live Traffic Paper “publicly available to persons interested and skilled in the art”; and (2) the posting of the Live Traffic Paper to a publicly accessible FTP server “could not constitute a private transmission.” *Id.*

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 1196.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* In computer parlance, a “Readme” or “README” file contains information about other files in a directory or archive. See *README*, WIKIPEDIA, <http://en.wikipedia.org/wiki/README> (last visited Feb. 7, 2011). Apparently, it was Judge Rader’s belief that, if the README file did not identify the location of the papers (i.e., the Live Traffic Paper) or describe the mnemonic structure for the files in the relevant directory (i.e., there was no “meaningful indexing”), someone searching would not know of the existence of the Live Traffic Paper and/or might be unable to locate it on the SRI International FTP server. *Id.* Judge Rader further observed that “only one non-SRI [International] person, Dr. Bishop, specifically knew about the availability of the Live Traffic [Paper], similar to the knowledge of the thesis’s availability by the three professors in *Bayer*.” *Id.*

directory structure to find the Live Traffic [Paper].”¹⁸⁹ Judge Rader also noted that it was “doubtful that anyone outside the review committee would have been aware of the [Live Traffic Paper] or looked for it at all in early August 1997.”¹⁹⁰ In fact, Judge Rader found the “public accessibility” factors “less compelling for the Live Traffic [Paper]” than “for the thesis in *Bayer*” because, unlike the *In re Bayer* thesis which “was complete and ready for public consumption,” the Live Traffic Paper was “still subject to prepublication review,” and was “posted on the [SRI International] FTP server solely to facilitate peer review in preparation for later publication.”¹⁹¹

¶72 In noting how close this case was to being a “printed publication” bar, Judge Rader also observed that, “similar to the posters in *In re Klopfenstein*, the Live Traffic [P]aper was ‘posted’ on an open FTP server and might have been available to anyone with FTP know-how and knowledge of the [‘emerald’] subdirectory.”¹⁹² However, unlike the posters in *In re Klopfenstein*, “the Live Traffic [P]aper was not publicized or placed in front of the interested public.”¹⁹³ Instead, Judge Rader characterized the posting of the Live Traffic Paper on the SRI International FTP server as “most closely analogous to placing posters at an unpublicized conference with no attendees,” and thus “available only to a person who may have wandered into the conference by happenstance or knew about the conference via unpublicized means.”¹⁹⁴ While Judge Rader acknowledged that “actual retrieval of a publication is not a requirement for public accessibility,” there was still no evidence that “anyone accessed the Live Traffic [P]aper via the [SRI International] FTP server during the seven days in which it was posted,” “suggesting an absence of actual public accessibility.”¹⁹⁵

¹⁸⁹ *Id.* at 1196-97. This comment by Judge Rader suggests some recognition that “accessibility” to the Live Traffic Paper should be judged by 1997 Internet standards when this paper was originally posted on SRI International’s FTP server (i.e., 1997), and not current (i.e., 2006-2008) Internet standards.

¹⁹⁰ *Id.* In pointing out the difficulty of one of ordinary skill in the art finding the Live Traffic Paper, Judge Rader further observed that Porras felt it was necessary to provide Dr. Bishop who “would have qualified as one of ordinary skill in the art in 1997” with the “full FTP address for the file.” *Id.* at 1196. In other words, “despite his knowledge of the field, FTP servers, and the [Live Traffic Paper], Dr. Bishop apparently would not have found [this Paper] without [Porras] precise directions,” and that it was “doubtful that anyone outside the review committee looking for papers submitted to the Internet Society’s Symposium would search a subfolder of an SRI International FTP server.” *Id.*

¹⁹¹ *Id.* at 1197. What Judge Rader says here is certainly consistent with the Live Traffic Paper not being posted on the SRI International FTP server for general viewing and access by the public at large, i.e., the Live Traffic Paper was unpublicized. But Judge Rader’s suggestion that posting of the Live Traffic Paper on the SRI International FTP server was less compelling for “public accessibility” than in the *In re Bayer* case because the *In re Bayer* thesis “was complete and ready for public consumption” whereas the Live Traffic paper was “still subject to prepublication review” is not a very persuasive argument. Nothing in these cases (including *In re Bayer*) suggest that the completeness of the paper is in anyway relevant to it being “publicly accessible,” only whether the paper is catalogued or indexed in a “meaningful way.” See also *id.* at 1204 n.5 (Moore, J., dissenting) (“[T]his issue [i.e., incompleteness of the Live Traffic Paper] is irrelevant to our inquiry of whether the paper as posted on the [SRI International] FTP server was publicly accessible for all that it disclosed.”).

¹⁹² *Id.* at 1197 (majority opinion).

¹⁹³ *Id.*

¹⁹⁴ *Id.* Judge Rader’s reference to “happenstance” is coincidentally the same as that used in Judge Linn’s dissenting opinion in the *Bruckelmyer* case regarding the presence of the two cancelled drawing figures in the ‘119 application file. See *supra* notes 163 and 164 and accompanying text.

¹⁹⁵ *Id.* (citing *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988)).

¶ 73 Judge Rader also pointed to the seven instances where Porras had previously directed people to the “pub” directory and “emerald” subdirectory of the SRI International FTP server to find other papers related to the EMERALD project, including the four instances where Porras provided the full path and filename of the paper.¹⁹⁶ By contrast, with regard to the Live Traffic Paper, “there was no such specific direction, and the filename did not mimic the subdirectory or publicized project name.”¹⁹⁷ Judge Rader went on to explain that “the record offers no suggestion that because people had been told that they could find other papers in the past in the /pub/emerald subdirectory, they would—unprompted—look there for an unpublicized paper with a relatively obscure filename.”¹⁹⁸ That left the Live Traffic Paper on the *In re Bayer* “lack of accessibility” side,¹⁹⁹ rather than the *In re Klopfenstein* “public accessibility” side of the “printed publication” bar.¹⁹⁹ While the FTP server’s directory structure is “a well-known institution in the intrusion detection community and the acronym of ‘ndss98.ps’ might have hinted at the path to the Live Traffic [P]aper,” Judge Rader nonetheless found that “an *unpublicized paper* with an acronym file name posted on an FTP server resembles a poster at an *unpublicized conference* without a conference index of the location of the various poster presentations.”²⁰⁰ Accordingly, “[w]ithout evidence as to the details of the 1997 SRI [International] server accessibility,” Judge Rader felt compelled to vacate and remand the grant of summary judgment by the District Court of Delaware that the Live Traffic Paper was a “printed publication” bar.²⁰¹ In essence, Judge Rader was treating the Live Traffic paper as not being “meaningfully indexed” as required by *In re Cronyn*. Judge Rader also repeated his earlier observation that “the peer-review feature suggests no intent to publicize.” This is consistent with the posted Live Traffic Paper being known only to a few select individuals, such as Dr. Bishop, who were informed of the paper’s existence or were guided to it and were arguably under at least implicit restrictions with regard to the use of the paper.

¶ 74 Judge Moore filed a vigorous and detailed partial dissent which ultimately concluded that SRI International had “failed to introduce *any* evidence showing a genuine issue of material fact as to the public accessibility of the Live Traffic Paper” and that

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* As put differently by Judge Rader, “the record offers no suggestion that because people had been told that they could find other papers in the past in the /pub/emerald subdirectory, they would—unprompted—look there for an unpublicized paper with a relatively obscure filename.” *Id.*

¹⁹⁸ *Id.*

¹⁹⁹ *Id.*

²⁰⁰ *Id.* at 1197-98 (emphasis added). In essence, Judge Rader was treating the Live Traffic paper as not being “meaningfully indexed” as required by *In re Cronyn*. *See id.* at 1197: “this court finds that the prepublication Live Traffic paper, though on the FTP server, was not catalogued or indexed in a meaningful way” (citing *In re Weyer*, *In re Bayer* and *In re Klopfenstein*). Judge Rader also repeated his earlier observation that “the peer-review feature suggests no intent to publicize” (511 F.3d at 1198) which is again consistent with the posted Live Traffic Paper being known only to a few select individuals, such as Dr. Bishop, who were informed of the paper’s existence and/or were guided to it, and who were also arguably under at least implicit restrictions with regard to the use of this paper. *See also* note 227, *infra* for Judge Moore’s rebuttal to this “unpublicized” argument by Judge Rader.

²⁰¹ *Id.* at 1198 (Judge Rader’s comment about the lack of “evidence as to the details of the 1997 SRI [International] server accessibility” further suggests his concern as to whether “public accessibility” of the Live Traffic Paper on the SRI International FTP server was sufficiently demonstrated factually to conclusively support a grant of summary judgment).

“attorney argument, no matter how good, simply cannot fill this void.”²⁰² Like Judge Rader, Judge Moore also noted the seven instances where Porras had directed people to the SRI International FTP server “prior to the critical date as a place to find materials on EMERALD in presentations and e-mails.”²⁰³ In contrast to Judge Rader, Judge Moore characterized these seven instances as adequately supporting “the district court’s conclusion that the [SRI International] FTP server was widely known and easily navigable,” thus also supporting the District Court of Delaware’s grant of ISS and Symantec’s motion for summary judgment.²⁰⁴

¶ 75 It appears that Judge Moore may be stretching a bit in characterizing these seven instances as demonstrating “no factual dispute” as to the SRI International FTP server being “widely known and easily navigable” to support a motion for summary judgment. In fact, Judge Moore suggests a fairly startling conclusion by conflating evidence presented by ISS and Symantec that the SRI International FTP server “was navigable in 2006” with respect to these “emails and presentations” to “indicate that the SRI International FTP server “was similarly navigable in 1997.”²⁰⁵ One has to wonder whether the Judge Moore was viewing this evidence through the appropriate 1997 “lens.” In pointing to the December 31, 1996 e-mail where Porras sent Lunt to ftp.csl.sri.com and then “told her to go to the ‘pub directory’” Judge Moore is also unclear as to why “this email would be meaningless” if the SRI International FTP server “was not navigable.”²⁰⁶

¶ 76 Judge Moore agreed with Judge Rader that the placing of a paper on an FTP server “is not clearly governed by either our library cases [citing *In re Bayer*, *In re Hall*, and *In re Cronyn*], or our dissemination cases [citing *In re Klopfenstein*].”²⁰⁷ Regarding the “library cases,” Judge Moore observed that, like a library thesis, the Live Traffic Paper “was placed on the [SRI International] FTP server,” but unlike the “library cases,” the Live Traffic Paper “was in a navigable directory structure.”²⁰⁸ Judge Moore pointed to the conclusion by the District Court of Delaware that “a person of ordinary skill in this art, *having the FTP host address available to him/her*, could readily navigate through two

²⁰² *Id.* (Moore, J., dissenting-in-part) (emphasis in the original).

²⁰³ *Id.* at 1199-1200.

²⁰⁴ *See id.* at 1200. In my opinion, Judge Moore may be stretching it a bit to characterize these seven instances as demonstrating “no factual dispute” as to the SRI International FTP server being “widely known and easily navigable” to support a motion for summary judgment. *See* discussion in note 232 *infra* regarding “benefit of doubt” on factual inferences going to non-moving party on a motion for summary judgment. In fact, Judge Moore suggests a fairly startling conclusion by conflating evidence presented by ISS and Symantec that the SRI International FTP server “was navigable in 2006” with respect to these “emails and presentations” to “indicate that the SRI International FTP server “was similarly navigable in 1997.” *See SRI Int’l*, 511 F.3d at 1200. One has to wonder whether the Judge Moore was viewing this evidence through the appropriate 1997 “lens.” In pointing to Lunt’s December 31, 1996 e-mail where Porras directed Lunt to ftp.csl.sri.com and then told her to go to the “pub directory,” Judge Moore is also unclear as to why “this email would be meaningless” if the SRI International FTP server “was not navigable.” *See Id.*

²⁰⁵ *See SRI Int’l*, 511 F.3d at 1200.

²⁰⁶ *See id.*

²⁰⁷ *Id.* at 1201.

²⁰⁸ *Id.* Judge Moore also pointed to the conclusion by the District Court for Delaware that “a person of ordinary skill in this art, *having the FTP host address available to him/her*, could readily navigate through two subfolders on a simple website and access the Live Traffic paper.” *Id.* (emphasis added).

subfolders on a simple website and access the Live Traffic [P]aper.”²⁰⁹

¶ 77 Judge Moore also disagreed with Rader’s opinion on the file name (“ndss98.ps.”) for the Live Traffic Paper being “relatively obscure.”²¹⁰ Judge Moore asserted that, “even if the filename were obscure and did not convey the nature of the subject matter, the file existed in the [‘emerald’] subdirectory. . . . [M]embers of the relevant cyber community had been repeatedly directed to the [‘emerald’] subdirectory to find files related to computer intrusion detection,” and “the cyber community had repeatedly cited the [‘emerald’] subdirectory in USENET and other articles as a source for intrusion detection materials.” Judge Moore then analogized that “[i]f a librarian directed a researcher to a particular shelf of books on intrusion detection, even if a book on that shelf had an obscure title, the fact that the librarian referred to the shelf as containing books on intrusion detection would provide enough direction for the researcher to know that the book was related to intrusion detection.”²¹¹ Judge Moore then characterized the “navigable directory” on the SRI International FTP server as meeting the case law standard of being a “research aid” or “customary research tool” with the Live Traffic Paper “ndss98.ps” being located in the emerald subdirectory, “which was known to be a source for materials related to intrusion detection.”²¹²

¶ 78 Judge Moore further observed that, “unlike the uncatalogued, unshelved thesis in a general university library in [*In re Bayer*]. . . . [T]he Live Traffic [P]aper existed on an FTP server that was used for cyber security work, in a subdirectory named for a specific,

²⁰⁹ *Id.* (emphasis added).

²¹⁰ *See id.*:

There is no evidence to suggest that the filename was obscure—it is the acronym for a conference (1998 Network and Distributed System Security Symposium sponsored by the Internet Society. By 1997, the NDSS Symposium was in its fifth year and the record evidence demonstrated that its program committee included representatives from important government, corporate and academic institutions in the intrusion detection field The Internet Society website’s ‘call for papers’ referred to the 1998 conference as ‘NDSS’ and the link to the website’s call for papers used ‘ndss’ in its file path (‘<http://www.isoc.org/conferences/ndss/98/cfp.shtml>.’).

Judge Moore also asserted that, “even if the filename were obscure and did not convey the nature of the subject matter, the file existed in the [‘emerald’] subdirectory,” “members of the relevant cyber community had been repeatedly directed to the [‘emerald’] subdirectory to find files related to computer intrusion detection,” and “the cyber community had repeatedly cited the [‘emerald’] subdirectory in USENET and other articles as a source for intrusion detection materials.” *Id.* Judge Moore then asserted that “[i]f a librarian directed a researcher to a particular shelf of books on intrusion detection, even if a book on that shelf had an obscure title, the fact that the librarian referred to the shelf as containing books on intrusion detection would provide enough direction for the researcher to know that the book was related to intrusion detection.” *Id.* Judge Moore then characterized the “navigable directory” on the SRI International FTP server as “[meeting] the [case law] standard” of being a “research aid” or “customary research tool” with the Live Traffic Paper “ndss98.ps” being located in the [‘emerald’] subdirectory, “which was known to be a source for materials related to intrusion detection.” *Id.*

²¹¹ *Id.* at 1201.

²¹² *Id.*

well-known cyber security project (EMERALD).²¹³ Also unlike *In re Cronyn* “where the court held that three theses in a shoebox in the chemistry department library filed by author’s name did not make them readily accessible to the public,” the Live Traffic Paper was located in a navigable directory in a subdirectory entitled EMERALD, “which the record evidence indisputably shows people in the industry understood as a project related to computer software for intrusion detection—the same subject matter as the Live Traffic [Paper].” Accordingly, under the library cases of *In re Bayer* and *In re Cronyn*, it was Judge Moore’s view that “the district court properly ruled on [the grant of] summary judgment because the navigable directory was a research aid which rendered the Live Traffic paper readily accessible to the computer security community (the relevant public).”²¹⁴

¶ 79 Judge Moore’s discussion of the “dissemination” cases, such as *In re Klopfenstein*, initially agreed with Judge Rader’s view that the determination of whether a reference is a “printed publication” bar in this situation “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to the public.”²¹⁵ Judge Moore then articulated the four *In re Klopfenstein* factors for guiding that “inquiry.”²¹⁶ Judge Moore found that the Live Traffic Paper satisfied the first factor (length of time the reference was available): “It is undisputed that the Live Traffic paper was available on the FTP server for seven days” which was “more than double the amount of time found sufficient in *In re Klopfenstein*” for a “printed publication” bar.²¹⁷

¶ 80 Regarding the second factor (expertise of the target audience), Judge Moore observed that ISS and Symantec “introduced evidence to show that the target audience of the Live Traffic [P]aper is persons interested and skilled in cyber security.”²¹⁸ It is hard to

²¹³ *Id.* at 1202. Judge Moore also noted, like the District Court of the Delaware, the irony that SRI International, which was in the intrusion detection business, “argues that those skilled in the art of intrusion detection could not detect information purposefully posted on the internet by a member of the cyber security community.” *Id.*

²¹⁴ *Id.*

²¹⁵ *Id.*

²¹⁶ *Id.* (The four factors are “(1) the length of time the reference was available; (2) the expertise of the target audience; (3) the existence (or lack) of reasonable expectations that the reference would not be copied; and (4) the simplicity with which the reference could have been copied” (citing *In re Klopfenstein*, 380 F.3d 1345, 1350-51 (Fed Cir. 2004))).

²¹⁷ *Id.* Judge Moore also noted that the Live Traffic Paper “was available twenty-four hours a day, as opposed to the poster in *In re Klopfenstein*, which was only available during conference hours.” *Id.* at 1202. In addition, Judge Moore observed that “because the Live Traffic [Paper] was available on an FTP server, it could be accessed from anywhere, as opposed to *Klopfenstein* where the display was at a conference in a single physical location.” *Id.* As Judge Moore put it, SRI International “failed to introduce any evidence that seven days was not sufficient time to give the public the opportunity to capture information conveyed by the Live Traffic [Paper].” *Id.* at 1203.

²¹⁸ *Id.* SRI International apparently conceded at oral argument that the target audience “included sophisticated members of the internet security community.” *Id.* (referring to Oral Arg. at 6:12-32, available at <http://www.cafc.uscourts.gov/oralarguments/mp3/2007-1065.mp3>). Judge Moore also referred to “evidence showing that in 1996 and 1997, the inventor advertised the FTP server to let people of ordinary skill in the art locate his research in the field of cyber security, using both e-mails to colleagues in the field and presentations to the cyber security community,” as well as “evidence showing the cyber security community included sophisticated computer scientists who knew how to use the FTP server, and who in fact often used the FTP server to share information. SRI presented no evidence to the contrary.” *Id.* But

dispute Judge Moore's conclusion that the posting of the Live Traffic Paper on the SRI International FTP server satisfied the third factor (reasonable expectation that the reference would not be copied). The most significant evidence in this regard²¹⁹ (which even Judge Rader did not dispute) was that SRI International (including the inventor Porras) "took absolutely no protective measures with regard to the FTP server or the Live Traffic [Paper], such as license agreements, non-disclosure agreements, anti-copying software, or even simple disclaimers."²²⁰

¶ 81 It was also fairly easy for Judge Moore to find the fourth factor (simplicity with which the reference could have been copied) satisfied. ISS and Symantec "introduced evidence that the FTP server existed for the sole purpose of allowing members of the cyber security community to post and retrieve information relevant to their research."²²¹ The inventor (Porras) "stuck a copy" of the Live Traffic Paper on the SRI International FTP server for seven days "where others could view and copy the paper with great ease."²²² As Judge Moore correctly observed, "at the touch of a button, the entire Live Traffic [P]aper could be downloaded or printed. Copying could not be simpler."²²³ Accordingly, in Judge Moore's view, the Live Traffic Paper was a "printed publication" bar "[w]hether the case is analyzed under the rubric of the library thesis cases or the temporary dissemination cases."²²⁴

¶ 82 Besides the opposing opinions by Judges Rader and Moore, what makes *SRI International* even more complicated and potentially confusing is that it is actually a hybrid "printed publication" bar case. As in *In re Klopfenstein*, it has aspects of active "dissemination" in that the Live Traffic Paper was identified by one of the inventors so that certain members of the "target audience" could get copies of it. However, similar to *In re Bayer* and the other thesis/library cases, the Live Traffic Paper was also passively "accessible" on the SRI International FTP server, assuming an interested individual could

there also appears to be a fundamental disagreement between Judge Moore and Judge Rader as to the degree of knowledge and sophistication of this "target audience" regarding its ability to locate the SRI International FTP server, as well as to know what is or might be present in the directories and subdirectories on that FTP server. That disagreement again suggests a "factual dispute" sufficient to deny a grant of summary judgment on the Live Traffic Paper being a "printed publication" bar. See discussion at note 232 *infra*.

²¹⁹See *SRI Int'l*, 511 F.3d at 1203. Judge Moore also pointed to "evidence that the public FTP server where the Live Traffic paper was posted was widely known in the cyber security community and accessible to any member of the public," and that "the inventor had specifically advertised the FTP server to persons particularly interested in his research and skilled in the art, using emails and presentations." See *id.* This "other evidence" appears to be far less relevant than the other apparently undisputed evidence that the inventor (Porras) permitted and even encouraged copying of posted materials (including Live Traffic Paper) by those persons directed to the SRI International FTP server. See *id.*

²²⁰*Id.* There also appeared to be no "confidentiality notices" or even "no copying notices" posted on the SRI International FTP server with regard to the Live Traffic Paper. *Id.*

²²¹*Id.* at 1204 (further observing that "FTP" stands for "File Transfer Protocol" which is "an Internet tool which exists for the purpose of moving files from one computer to another," or, in other words, for copying computer files).

²²²*Id.*

²²³*Id.* Not surprisingly, SRI International did not even argue the point "that papers on an FTP server are [not] difficult for a user to copy or print." *Id.*

²²⁴*Id.* at 1205.

find it via the Internet, and then navigate to its location in the “pub” directory and “emerald” subdirectory.

¶ 83 As a hybrid “printed publication” bar case, *SRI International* again provided ample opportunity for Judge Rader, as well as Judge Moore, to unfortunately seize on the “never-ending” saga of conflating “dissemination” case law jurisprudence with “public accessibility.” In discussing “public accessibility,” the majority opinion simply (and indiscriminately) cites *In re Bayer* and *In re Cronyn* to illustrate “lack of” public accessibility, versus *In re Wyer*, *In re Klopfenstein*, and *Bruckelmyer* to illustrate public accessibility. Consider also Judge Rader’s reference to *SRI International* as “fall[ing] somewhere between *Bayer* and *Klopfenstein*.”²²⁵ Possibly the starkest instance of this conflation is Judge Rader’s perhaps inapt analogy of the Live Traffic Paper to “placing posters at an unpublicized conference with no attendees,” an analogy whose correctness Judge Moore strongly disputed.²²⁶

¶ 84 In addition, the disagreement between Judge Rader’s majority opinion and Judge Moore’s partial dissent has much to do with their differing views of the “sufficiency of the evidence” to support the grant of summary judgment based on the Live Traffic Paper as a “printed publication” bar. Compared to Judge Moore’s dissent, Judge Rader’s majority opinion evidences a greater degree of caution in accepting the evidence presented in support of the Live Traffic Paper as a “printed publication” bar as being conclusive as a matter of law. *SRI International* was certainly a case of first impression for the Federal Circuit in applying the “printed publication” bar to electronically posted documents. Add the hybrid nature of the “printed publication” bar being asserted in *SRI International*, thus making an already unusual and complex factual situation more so, and it would seem that Judge Rader’s extreme judicial caution is justified. In fact, Judge

²²⁵ *Id.* at 1195 (majority opinion).

²²⁶ *Id.* at 1197. In disputing Judge Rader’s analogy, Judge Moore pointed to evidence showing: (1) the inventor (Porras) publicized the SRI International FTP server to the cyber security community (thus the conference was “publicized”); and (2) the FTP server was widely known and frequently used in the cyber security community (thus there were “lots of attendees” rather than “no attendees”). *Id.* at 1199, n.1 (Moore, J., dissenting-in-part). But while Judge Rader’s analogy may not be the most apt, Judge Moore’s reliance upon this “evidence” suggests she may have missed the point of Judge Rader’s analogy which is that the Live Traffic Paper posted on the FTP server was unpublicized and thus unknown to the general attendees at the SNDSS conference. That the Live Traffic Paper was unpublicized/unknown to these attendees at this SNDSS conference (i.e., the “target audience”) goes directly to whether those attendees would have sufficient information to be “guided” (as the “thesis/library” cases such as *In re Bayer*, *In re Hall* and especially *In re Cronyn* require) to the Live Traffic Paper. In fact, footnote 4 of Judge Moore’s opinion again appears to miss this “guidance” point for the “publicly accessible” branch by suggesting that Judge Rader’s majority opinion unduly focuses on “whether the paper was publicized or whether the existence of the paper was known beyond the peer-review committee for the conference.” *Id.* at 1203-4. Even the majority opinion in the *Bruckelmyer* case cited by Judge Moore in footnote 4 of her opinion recognizes that there must be at least some “guidance” provided to the “target audience” for even an “unpublicized” document to be “publicly accessible.” In addition, characterizing the laid open Australian patent application in the *In re Wyer* case (also relied upon by Judge Moore in footnote 4 of her opinion) as “unpublicized” ignores Judge Rader’s appropriate quote from *In re Wyer* that this Australian patent application was “properly classified, indexed or abstracted” to enable (“guide”) public access to this foreign patent application. *Id.* at 1196 (majority opinion). If nothing else, this footnote 4 is the clearest evidence of Judge Moore’s opinion confusingly conflating “dissemination” doctrine with “publicly accessible” doctrine.

Moore's criticism of Judge Rader accepting *SRI International's* argument that "this record does not evince that the Live Traffic [Paper] was accessible to anyone other than the peer-review committee" may be missing the Judge Rader's point, namely that there was simply insufficient evidence to *conclusively* demonstrate that the Live Traffic Paper was "publicly accessible" to be a "printed publication" bar on a motion for summary judgment.²²⁷

¶ 85 Another point of dispute between Judge Rader and Judge Moore was how "navigable"²²⁸ the directory structure of the SRI International FTP server was. Judge Moore asserted that "the 1997 version of the [SRI International] FTP server had navigable directories and subdirectories exactly the same as the 2006 version of the FTP server."²²⁹ This assertion by itself may not be significant; however, coupled with her comments about how "computer savvy" the ordinarily skilled artisan was,²³⁰ one may wonder whether Judge Moore was looking at the "accessibility" issue of the SRI International FTP server through the "proper glasses" (i.e., through 1997 "lenses," not 2006 or 2008 "lenses"). That people such as Dr. Bishop were "computer savvy" does not necessarily mean the directory structure of SRI International FTP server was sufficiently informative and especially "searchable" by those looking for the Live Traffic Paper back in 1997. In fact, that one of the inventors (Porrás) felt it necessary to give someone like Dr. Bishop the "full FTP address for the file" is at least consistent with the directory structure of SRI International FTP server *not being sufficiently informative* (or "searchable") for even "computer savvy" individuals back in 1997.²³¹

²²⁷ *Id.* at 1197. In support of her disagreement with this quoted statement from Judge Rader's majority opinion, Judge Moore argued that "the record shows the [Live Traffic Paper] was available to *any* member of the general public, and *not* just the peer-review committee (emphases added)." *Id.* at 1204 (Moore, J., dissenting-in-part). But Judge Moore's quote of what Judge Rader said fails to include Judge Rader's contextual statements that "actual retrieval was not required" and that the record only showed the Live Traffic Paper was actually accessed by the SNDSS peer-review committee, "thus further suggesting an absence of actual public accessibility." *Id.* at 1197 (majority opinion). Put in its appropriate context, Judge Rader was (perhaps without sufficient clarity) not saying that the Live Traffic Paper was "inaccessible" (as may be suggested by Judge Moore), but that the record evidence was insufficient to establish "public accessibility" of the Live Traffic Paper as a "printed publication" bar for the purpose of summary judgment.

²²⁸ See *supra* note 206 as to whether "navigability" of the SRI International FTP servers is the appropriate focus for whether the Live Traffic Paper was "publicly accessible" in 1997 so as to be a "printed publication" bar.

²²⁹ *SRI Int'l*, 511 F.3d at 1199 (Moore, J., dissenting-in-part)..

²³⁰ *Id.* at n.1. Judge Moore specifically disputed the factual basis in Judge Rader's majority opinion regarding the following: (1) the implication that a sophisticated computer security researcher would need a "README" file to find a file in an FTP server; (2) doubting that anyone outside the review committee looking for papers submitted to the ISS would search a subfolder of the SRI International FTP server, or would have been aware of the paper or looked for it at all in early August 1997. Instead, "[g]iven that the EMERALD subdirectory was publicized to the cyber security community as a source of information related to projects on intrusion detection," Judge Moore viewed the Live Traffic Paper "like everything else in the EMERALD subdirectory, [as being] publicly accessible to anyone interested in material on intrusion detection." *Id.* The dispute as to factual point (2) is particularly relevant as to who should be characterized as "a person of ordinary skill in the art" for the purposes of the "printed publication" bar. See *supra* notes 227–29 and accompanying text.

²³¹ *Id.* Judge Moore's view might have been on more solid ground if the District Court of Delaware's ruling of invalidity based on a "printed publication" bar had been after a full trial on the merits. But that

¶ 86 Indeed, Judge Moore's discussion about the "navigability" of the directory structure located on the SRI International FTP server (relative to the "thesis/library" cases such as *In re Bayer*, *In re Hall* and *In re Cronyn*) highlights another fundamental disagreement with Judge Rader's majority opinion, namely *the degree of knowledge* the "person of ordinary skill in the art" (i.e., in terms of 35 U.S.C. §103(a) or the "target audience" in *In re Klopfenstein* terms) would have to have about this directory structure, and especially *what is or might be present in that directory structure*. Judge Moore's view presupposes that this "person of ordinary skill in the art" would be a fairly well informed user who would know beforehand something about the location of the SRI International FTP server, as well as what is or might be present in the directories and subdirectories on that FTP server. By contrast, Judge Rader suggests that this "person of ordinary skill in the art" would be "an anonymous user" who might not know the location of the SRI International FTP server, and would certainly not know or even suspect what was contained in the directory structure of that FTP server (including the Live Traffic Paper) without being told by someone (e.g., one of the inventors such as Porras) beforehand²³².

¶ 87 If, as Judge Rader suggests, this "person of ordinary skill in the art" was an "uninformed anonymous user," the directory structure of the SRI International FTP server might not be "meaningfully catalogued and indexed." Perhaps more significantly, it is unclear from the evidentiary record in *SRI International* how such an "uninformed user" might possibly be able to carry out an Internet search during the 1997 time frame to locate a document posted on an FTP server containing information such as that present in the Live Traffic Paper. In other words, the differing views of Judges Moore and Rader on the knowledge and sophistication of this "person of ordinary skill in the art" again suggests a "factual dispute" sufficient to deny a grant of summary judgment on the Live Traffic Paper was a "printed publication" bar.

¶ 88 Where Judge Rader's majority opinion is potentially at its most vulnerable is in addressing how access by the general public to the SRI International FTP server, and especially the Live Traffic Paper, was in any way restricted.²³³ Judge Moore rightly

was not the case as the ruling that the Live Traffic Paper was a "printed publication" bar was on a motion for summary judgment. That means the "non-moving party" (SRI International) was entitled to the "benefit of the doubt" as to any genuine factual dispute. *See, e.g., Gemmy Indus. Corp. v. Chrisha Creations Ltd.*, 452 F.3d 1353, 1358 (Fed. Cir. 2006) (on motion for summary judgment "all reasonable factual inferences are drawn in favor of the non-movant" (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986))); *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 1379 (Fed. Cir. 2007) (grant of summary judgment reviewed without deference "drawing all justifiable inferences in favor of the nonmovant" (citing *Genetech, Inc. v. Amgen, Inc.*, 289 F.3d 761, 767 (Fed. Cir. 2002))); *Nazomi Communications, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1367 (Fed. Cir. 2005) ("A summary judgment motion is proper if there are no genuine issues of material fact, while viewing the facts in a light most favorable to the non-moving party."); Fed. R. Civ. P. 56(c) (no genuine issue as to any material fact and moving party is entitled to a judgment as a matter of law). Judge Rader's majority opinion presents a sufficient "factual dispute" on the "public accessibility" issue of the Live Traffic Paper to suggest that the District Court of Delaware's grant of summary judgment based on the Live Traffic Paper as a "printed publication" bar was problematic.

²³² *SRI Int'l.*, 511 F.3d at 1196 (majority opinion).

²³³ *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990), discussed *supra* notes 129-35 regarding when "access" is sufficiently restricted to no longer be "public."

challenged this “omission” in Judge Rader’s opinion.²³⁴ Without any notices on the SRI International FTP server that such access was restricted or confidential, or that “no copies” could be made of what was posted on the SRI International FTP server, it is difficult to argue with Judge Moore that the general public did not have at least some “access” to the Live Traffic Paper. But whether that “access” was sufficient to make the “[Live Traffic Paper] *as posted* on the [SRI International] FTP server “publicly accessible” so as to be a “printed publication” bar “for all it disclosed” as was asserted by Judge Moore is an entirely different question.²³⁵

B. Accessibility of Copyrighted Manuscript by Searching Public and Commercial Databases: *In re Lister*

¶ 89 Soon after *SRI International*, the Federal Circuit had to deal with the issue of an inventor’s own manuscript which was submitted for copyright registration becoming “publicly accessible” on either a public or commercial (i.e., private) computerized database in the 2009 case of *In re Lister*.²³⁶ In *In re Lister*, Dr. Richard Lister, a Ph.D. clinical psychologist and an avid sportsman, grew weary of the “horrendously slow pace of a game of golf.” In response, Lister developed a method for playing recreational golf where the participant could “tee up their balls on every shot except for those taken from designated hazard areas or the putting green.” On August 5, 1996, he filed a patent application (the Lister Patent Application) for this method of playing golf.²³⁷

¶ 90 But Lister found out that patent prosecution can take place at a horrendously slow pace too. For thirteen years, Lister went through “several rounds of rejections and amendments” in trying to patent his method of playing golf. Lister was finally confronted by the U.S. Patent and Trademark Office with a hazard of his own making: his own manuscript entitled “Advanced Handicap Alternatives for Golf” (the Lister Manuscript) which he submitted to the U.S. Copyright Office on July 4, 1994, and for which a certificate of registration was issued on July 18, 1994. The Lister Manuscript also described the same method of playing golf as the Lister Patent Application.²³⁸

¶ 91 This Lister Manuscript became the focal point of the “printed publication” bar in *In re Lister*. The Examiner, as well as the Board of Appeals and Interferences (Board),

²³⁴ *SRI Int’l.*, 511 F.3d at 1203 (Moore, J., dissenting-in-part); *supra* notes 221-22 and accompanying text.

²³⁵ See *SRI Int’l.*, 511 F.3d at 1204, n.5. While Judge Moore is correct that access to the Live Traffic Paper on the SRI International FTP server was not restricted (unlike the *Northern Telecom* case), that access was *unrestricted* to the SRI International FTP server also does not necessarily mean the Live Traffic Paper was “publicly accessible.” None of the thesis/library cases such as *In re Bayer* or *In re Cronyn* suggest that access must be restricted to prevent the document (e.g., thesis or paper) from being “publicly accessible.” Instead, “public accessibility” in these thesis/library cases is squarely based on whether the document is catalogued or indexed in a “meaningful way.” In other words, the document may not be “publicly accessible” because of one or both of the following: (1) access to the document is restricted (as in the *Northern Telecom* case); or (2) the document is not catalogued or indexed in a “meaningful way” (as in the *In re Bayer* or *In re Cronyn* cases).

²³⁶ *In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009).

²³⁷ *Id.* at 1309-10.

²³⁸ *Id.* at 1310.

was prepared to disqualify the Lister Patent Application based on the Lister Manuscript being “publicly accessible” and thus a “printed publication” bar. But in an opinion by Judge Prost,²³⁹ the Federal Circuit ruled that there was insufficient evidence that the Lister Manuscript was “publicly accessible” more than one year prior to the filing date of the Lister Patent Application.²⁴⁰ As a result, Lister was barely able to avoid a potentially fatal “printed publication” bar due to his own (and prior) copyrighted manuscript.

¶92 In *In re Lister*, Judge Prost observed how *In re Cronyn* had reconciled the decisions in *In re Bayer* and *In re Hall* as requiring the indexing or cataloguing of the document(s) to be “in a meaningful way.”²⁴¹ But reminiscent of *SRI International*, Judge Prost also pointed out in *In re Lister* that “neither cataloging nor indexing is a necessary condition for a reference to be publicly accessible,” citing *In re Klopfenstein*.²⁴² Instead, Judge Prost said “we must consider all of the facts and circumstances surrounding the disclosure and determine whether an interested researcher would have been sufficiently capable of finding the reference and examining its contents.”²⁴³

¶93 The key facts that the parties agreed upon in *In re Lister* were as follows: (1) the Lister Manuscript disclosed the claimed invention; (2) the Copyright Office issued a certificate of registration for the Lister Manuscript on July 18, 1994; and (3) absent limited special circumstances, the Copyright Office does not provide copies of the manuscript, or permit individuals inspecting the document to make copies of them. But the crucial point which they disagreed upon was “when, if ever, the manuscript was listed in a catalog or index that would have permitted an interested researcher to learn of its existence and locate it for inspection.”²⁴⁴

¶94 Lister’s first argument that the Lister Manuscript was not “publicly accessible” because of the burden of traveling to Washington, D.C., and navigating what he described as the “cumbersome procedures” necessary to gain access to the Lister

²³⁹ Writing for a panel that included Judges Gajarsa and Linn.

²⁴⁰ *Id.* at 1309.

²⁴¹ *See id.* at 1312. *See also* “thesis/library” cases *supra* Part IV.

²⁴² *In re Lister*, 583 F.3d at 1312. Fortunately, Judge Prost’s reference to *In re Klopfenstein* was not too reminiscent. *See discussion infra* note 244. Judge Prost also cited to and noted the opposing views of the majority (issued patent served as a “roadmap to the application file” (citing *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1379 (Fed. Cir. 2006)) and Judge Linn (“text of an issued patent does not generally serve to guide researchers to the file history for a more expansive disclosure of the described invention, and it certainly does not lead researchers to the file history for disclosure of subject matter not described in the issued text” (citing *id.* at 1380 (Linn, J. dissenting))) in the *Bruckelmyer* case on the “public accessibility” of the Canadian ‘119 patent/patent application. *Id.*; *see also* discussion of opposing opinions in the *Bruckelmyer* case *supra* Part IV.

²⁴³ *In re Lister*, 583 F.3d at 1312. Judge Prost also cited *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340 (Fed. Cir. 2008) for the proposition that “public accessibility” includes persons interested and ordinarily skilled in the subject matter (i.e., the *In re Klopfenstein* “target audience”), by “exercising reasonable diligence,” being able to “locate” the reference of interest. *Kyocera Wireless* held that a collection of technical specifications (Global System for Mobile Communications or GSM standard) were “publicly accessible” to the “target audience” to be a “printed publication” bar because these collected specifications comprising the GSM standard were not “secluded under a similar veil of secrecy,” thus distinguishing the *Northern Telecom* case based on a lack of “restricted access” to these collected specifications. *Kyocera*, 545 F.3d at 1350–51.

²⁴⁴ *In re Lister*, 583 F.3d at 1312–13.

manuscript did not convince Judge Prost. For this first argument, Lister tried to analogize his situation to that in the *Northern Telecom* case.²⁴⁵ But Judge Prost correctly distinguished *Northern Telecom*, noting that in that case there was “restricted access” to the documents. By contrast, in *In re Lister*, “any member of the public who submits a proper request is capable of gaining access to the manuscript without any need for special authorization.”²⁴⁶ Lister’s “travel difficulty” argument fared no better as Judge Prost pointed to the *In re Hall* case (where the barring dissertation was located in the Freiburg University library in Germany) as holding that “a significant amount of travel” was no impediment to a document being “publicly accessible.”²⁴⁷

¶95 While Judge Prost concluded that the Lister Manuscript was available at the Copyright Office for inspection by any interested person, he also noted that such a conclusion “does not end our inquiry” as to “whether anyone would have been able to learn of its existence and potential relevance prior to the critical date.”²⁴⁸ Lister had asserted that “the catalogs and databases relied upon by the Board were not sufficiently searchable to lead an interested researcher to the manuscript.”²⁴⁹ But Judge Prost was also unpersuaded by this argument.²⁵⁰ Of the three relevant databases, the Copyright Office’s automated catalog, as well as two commercial databases (Westlaw and Dialog), the two commercial databases permitted searching of titles by keyword (unlike the Copyright Office’s automated catalog which would only allow searching for author and the first word of the title). Judge Prost also agreed with the Board that a researcher could have found the Lister Manuscript by searching the two commercial databases for the word “golf” in combination with the word “handicap” in the title.²⁵¹ That made the Lister Manuscript “publicly accessible” once the title was listed on either of the two commercial databases.

¶96 But Lister finally asserted that there was no evidence that either of the two commercial databases listed the title of the Lister Manuscript prior to the critical date (August 5, 1995).²⁵² That became the “winning” argument, which the Board was unable to refute.²⁵³ First, the Board argued that Lister’s Information Disclosure Statement (IDS)²⁵⁴ provided substantial evidence that the manuscript was listed in the commercial databases prior to the critical date. But Judge Prost said that nothing in the IDS “speaks to

²⁴⁵ *Id.* at 1313. See also discussion of *Northern Telecom* case in *supra* Part IV.

²⁴⁶ *In re Lister*, 583 F.3d at 1313.

²⁴⁷ *Id.* at 1313–14.

²⁴⁸ *Id.* at 1314.

²⁴⁹ *Id.*

²⁵⁰ Judge Prost characterized Lister’s argument as imposing “too rigid of a test for whether an interested researcher could find a reference,” and then cited with approval *Kyocera Wireless*’ “interested persons by exercising reasonable diligence are able to locate the relevant reference” test. *Id.* at 1315.

²⁵¹ *Id.* at 1315–16.

²⁵² *Id.* at 1316.

²⁵³ The government even argued that Lister waived this argument by failing to raise it before the Board. But Judge Prost found no waiver of this argument because Lister’s appeal brief filed before the Board “sufficiently expressed Dr. Lister’s disagreement with the examiner’s finding that the manuscript was listed in a keyword searchable database prior to the critical date.” *Id.* at 1316, n.3.

²⁵⁴ See *supra* note 176, which discusses citations of relevant information through submissions of Information Disclosure Statements (IDSs) per 37 C.F.R. §§ 1.97–1.98 (2000).

the date on which the Lister [M]anuscript was incorporated into the Westlaw and Dialog databases.”²⁵⁵

¶ 97 The Board next argued that it had “made a prima facie showing that the [Lister Manuscript] was included in the commercial databases shortly after the Copyright Office granted the certificate of registration and the burden has shifted to Dr. Lister to present evidence that it was *not* in either database before the critical date.” That argument also went nowhere. As Judge Prost observed, all that the evidence showed is “that at some point in time Westlaw and Dialog incorporated the Copyright Office’s automated catalog information about the Lister [M]anuscript into their own databases.” But “[t]here is no indication as to when that occurred or whether it was prior to the critical date.”²⁵⁶

¶ 98 In desperation, the Board finally urged it was appropriate to presume the information on the Lister Manuscript was added to the Westlaw and Dialog databases prior to the critical date because it was more than a year after the certificate of registration was granted. However, as Judge Prost put it, “absent any evidence pertaining to the general practices of the Copyright Office, Westlaw, and Dialog, or the typical time that elapses between copyright registration, inclusion in the Copyright Office’s automated catalog, and subsequent incorporation into one of the commercial databases, *any presumption along those lines would be pure speculation.*”²⁵⁷ And with that, the Board’s ruling on the “printed publication” bar was vacated and remanded by the Federal Circuit.²⁵⁸

¶ 99 *In re Lister* is a much more relevant and cleaner case than is *SRI International* in laying out the criteria for when an electronically posted document is “publicly accessible” from the Internet to qualify as a “printed publication” bar. With the exception of the one brief citation to *In re Klopfenstein* noted previously, the Federal Circuit panel wisely

²⁵⁵ *In re Lister*, 583 F.3d at 1316; cf. *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (submission of manuals in Information Disclosure Statement (IDS) in unrelated reexamination proceeding not admission that manuals were “printed publication” bar), citing *Abbott Labs v. Baxter Pharm. Prods. Inc.* 334 F.3d 1274, 1279 (Fed. Cir. 2003) (mere submission of IDS to USPTO does not constitute admission that any reference in IDS is material prior art).

²⁵⁶ *In re Lister*, 583 F.3d at 1316–17.

²⁵⁷ *Id.* at 1317 (emphasis added). The “evidentiary” problems in proving “public accessibility” under the “printed publication” bar are not limited to electronic databases. See *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (no proof that software manuals alleged to be “printed publication” bar were “ever published or disseminated to the public”). But see *Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 974–75 (Fed. Cir. 2010), where a Federal Circuit panel overturned the denial by the district court of JMOL of invalidity, and held that an electronic parts catalog was a “printed publication” bar based on testimony (unrebutted by the patentee) at trial of a former manager of the distributor of the parts catalog that the parts catalog was published in 1987 (the critical bar date was November 10, 1988), was used by 150 to 200 sales persons, and that the manager had personally demonstrated the alleged prior art steps based on this parts catalog (even though the manager’s testimony at trial was over twenty years after the catalog was allegedly published), citing the *Iovate Health* case (see notes 29 & 60 *supra*). See also *supra* notes 82 and 91 (noting evidentiary issues in proving “printed publication” bars).

²⁵⁸ As noted by Judge Prost, that Lister survived a potentially fatal and self-inflicted “printed publication” bar wound did not mean Lister would prevail in the end. See *In re Lister*, 583 F.3d at 1317, n.4 (“Additionally, we note that our decision is limited to the question of whether the Board properly affirmed the examiner’s [35 U.S.C.] § 102(b) rejection. Other bars to patentability are not before us and may be raised during the proceedings on remand.”).

steered clear of the “dissemination” branch cases, and based its decision squarely on the “publicly accessible” line of case law doctrine.²⁵⁹ *In re Lister* also answers several questions about when electronically posted documents may qualify as “printed publication” bars, including: (1) documents listed in public as well as private commercial databases that are searchable may qualify; (2) the relevant posted document must be “meaningfully” indexed (i.e., a significant portion of the title must be searchable) so that, for example, a key word search might locate the document; and (3) the date when the relevant document is listed in the database so that it can be “meaningfully” searched does matter and will not be presumed without probative evidence of that date.

¶ 100 But *In re Lister* also leaves unanswered many issues about when electronically posted documents qualify as “printed publication” bars. One such issue in footnote 2 of Judge Prost’s opinion relates to when the results of an Internet search would suggest that an electronically posted document qualifies as “printed publication” bar:

Because there is no evidence in the record suggesting that such a search would have yielded an *unmanageable number of references*, we need not decide whether in *some circumstances an overwhelming number of search results* might warrant a conclusion that a particular reference included in the list was not publicly accessible.²⁶⁰

¶ 101 Two components of the above statement (“unmanageable number of references” and “overwhelming number of search results”) are interrelated. But because Judge Prost’s opinion in *In re Lister* provides no specifics about what “search results” (if any) were part of the “record,” we are currently left with no specific guidance by the Federal Circuit as to when the number of references becomes “unmanageable,” as well as when the search results become an “overwhelming number” to preclude the posted document of interest from qualifying as a “printed publication” bar. Another component of this statement (“in some circumstances”) also leaves us guessing as to whether “unmanageable” and “overwhelming number” are to be the exception, not the rule, for when electronically posted documents retrieved by an Internet search qualify as a “printed publication” bar.

VI. CONCLUSION: MAKING SENSE OF THE “PRINTED PUBLICATION” BAR MORASS IN THE INTERNET AGE

¶ 102 As the Federal Circuit (and its predecessor court, the CCPA) have progressed from the “hard copy” age to the Internet age, the “stress” in applying the “printed

²⁵⁹ In fact, it was the Board that relied extensively upon *In re Klopfenstein* for holding the *Lister* Manuscript to be a “printed publication bar. *See id.* at 1310; *see also id.* at 1311 where *Lister* argued that the Board erred by relying “heavily” on *In re Klopfenstein*, instead of the “more factually analogous cases” such as *In re Hall* and *In re Cronyn*.

²⁶⁰ *Id.* at 1316, n.2 (emphasis added). Footnote two was in response to *Lister*’s criticism that the Board failed to take into account “the possibility that such a search would have either inundated the researcher with hundreds or thousands of irrelevant results or failed to retrieve relevant documents that happened not to include both words in their title.” *Id.* at 1315.

publication” bar to documents electronically posted on an FTP server, web site, or other Internet-accessible computerized database is starting to show. The Federal Circuit panels have shifted back and forth between the “publicly accessible” cases and the “dissemination” cases in trying to apply the “printed publication” bar in the Internet age. In fact, what the various panel opinions also show is that the Federal Circuit has yet to develop complete and uniform criteria for applying the “printed publication” bar to electronically posted (and potentially electronically searchable) documents in the Internet age. In short, the “printed publication” bar currently appears to be a jurisprudential morass when applied to electronically posted documents.

¶ 103 The most recent cases of *In re Klopfenstein*, *Bruckelmyer*, *SRI International*, and *In re Lister*, which have addressed what the “printed publication” bar means, have each involved different panels of Federal Circuit Judges. But more significantly, two of those cases, *Bruckelmyer* and *SRI International*, each had vigorous dissenting opinions.²⁶¹ That suggests an en banc ruling by the Federal Circuit on what “printed publication” bar means in the Internet age is needed to reach a consensus.

¶ 104 In addition to an en banc ruling, the Federal Circuit needs to develop at least the following six “guidelines” if the “printed publication” bar is to make any sense in the Internet age:

¶ 105 1. Avoid conflating “dissemination” case law doctrine with “publicly accessible” case law doctrine, and with limited exception, rely only on “publicly accessible” criteria in judging whether electronically posted documents qualify as “printed publication” bars.²⁶²

¶ 106 A clear demarcation between “dissemination” case law doctrine and “publicly accessible” case law doctrine is imperative to avoid the continuing conflation of and confusion between these two distinct lines of cases in applying the “printed publication” bar to electronically posted documents. As shown especially by the *In re Klopfenstein*, *Bruckelmyer*, and *SRI International* cases, the Federal Circuit has created significant interpretational confusion and difficulties by mixing together the “printed publication” bar criteria from the active “dissemination” (e.g., “public conference”) cases with that of the passive “publicly accessible” (e.g., “thesis/library”) cases. Situations involving documents electronically posted on FTP servers or web sites (as in *SRI International*), or on other Internet-accessible computerized databases (as in *In re Lister*), are more analogous to a stationary library. Therefore the criteria governing what is “publicly accessible” in these “thesis/library” cases should normally be applied exclusively to documents electronically posted on FTP servers, web sites or other Internet-accessible computerized databases, and not the criteria used in the “dissemination” cases. Put

²⁶¹ In the denial of rehearing en banc in *Bruckelmyer*, there was also a vigorous dissenting opinion by Judge Newman which was joined by Judge Linn. See *supra* note 171 .

²⁶² See U.S. DEP’T COMMERCE, PATENT & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 2128 [hereinafter MPEP] (“An electronic publication, including an on-line database or Internet publication, is considered to be a “printed publication” within the meaning of 35 U.S.C. [§§] 102(a) and (b) provided the publication was *accessible* to persons concerned with the art to which the document relates” (citing the *In re Wyer* case) (emphasis added.)).

differently, the “unitary concept” doctrine expressed in *In re Wyer* on “printed publication” bars requires modification to separate the “publicly accessible” cases (i.e., those involving “passive” Internet-accessible FTP servers/web sites as in *SRI International* or Internet-accessible computerized databases as in *In re Lister*) from the “dissemination” cases (i.e., those involving “active” distribution, display or presentation as in the “public conference” cases such as *In re Klopfenstein*). The rare exception would be a hybrid case (such as in *SRI International*), and even then, the “dissemination” and “publicly accessible” criteria should each be applied *separately without commingling the facts* to render consistent and uniform decisions.

¶ 107 2. Until there are meaningful “guidelines” to assess when electronically posted and searchable documents qualify as “printed publication,” and because of the factual intensity required to resolve such bars for such documents, summary judgment should rarely be granted.²⁶³

¶ 108 At the present time, resolution of “printed publication” bars involving electronically posted documents is not yet as simple as “Googling for prior art.” The verbal sparring between Judge Rader and Judge Moore in the *SRI International* highlights the jurisprudential, as well as factual, disagreements arising between the members of the Federal Circuit on what the appropriate standards and guidelines are for applying the

²⁶³ In my opinion (based on empirical reading of many cases), courts today grant summary judgment under Fed. R. Civ. P. 56 too readily based on insufficient or disputed factual records, possibly due to the pressure to move their case volume along which has admittedly grown quite large (and without additional judicial resources to cope with that growing case volume). This rush to summary judgment has not infrequently created district court rulings with sparse or insufficient factual records that cause problems in resolving the appealed issues. See, for example, the following lament by the Federal Circuit in *Madey v. Duke Univ.*, 307 F.3d 1351, 1360 (Fed. Cir. 2002), *cert. denied*, 156 L.Ed.2d 656 (2003) (commenting on the basis for the district court applying 28 U.S.C. 1498(a) as a defense to patent infringement):

[B]y failing to explain or demonstrate precisely how the ONR grant authorizes the government’s consent to suit or authorizes Duke to use or manufacture the patented articles for the government, *the district court has provided no findings or analysis upon which we can base our review* of the issue appealed from the [district] court’s *Dismissal Opinion*. Although a research grant may not meet the requirements of § 1498(a), from the *limited record presented by the parties*, it cannot be determined whether the ONR grant may authorize the necessary predicates for § 1498(a).” (Emphasis in original and emphasis added).

Another problem with rushing to summary judgment is denying a party their requested right to have the facts determined by a jury. See, e.g., *Dorel Juvenile Group, Inc. v. Graco Children’s Prods., Inc.*, 429 F.3d 1043, 1047 (Fed. Cir. 2005) (“The district court has invaded the province of the finder of fact, here a jury requested by Dorel, in deciding the infringement question.”) I am also of the opinion (also based on empirical reading of many cases, Federal Circuit and otherwise involving grants of summary judgment) that the admonition that all factual inferences are to be made in favor of the non-moving party on a motion for summary judgment is too much honored in the breach rather than the observance. This phenomena appears to be driven by the Supreme Court’s decision in *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986) which is often cited by the Federal Circuit in rebutting inferences urged by the non-moving party. See *Madey*, 307 F.3d at 1363, citing *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1206-7 (Fed. Cir. 1991) (alleged inferences were mere speculation and thus not supportable). In fact, the Federal Circuit’s particular failure to heed this admonition may have led to the very complaint made in, for example, the *Madey* case about the insufficiency of the factual record.

“printed publication” bar to electronically posted documents. Once you add to this jurisprudential disagreement in *SRI International* the unanswered questions in *In re Lister*, especially those raised in footnote 2 in Judge Prost’s opinion relating to assessment of Internet search results, as well as the factual intensity of cases involving electronically posted documents, it becomes apparent that determinations of “printed publication” bars are not yet ripe for grants of summary judgment other than in the clearest and simplest of factual situations. Instead, a much more cautious and deliberate approach is warranted until the Federal Circuit works out the kinks and, more importantly, develops clear Internet search criteria for how to apply “printed publication” bars to electronically posted documents.

¶ 109 3. Resolve the issue of what “unmanageable” and “overwhelming numbers” of search results means, and under what “circumstances,” as quickly as possible.

¶ 110 Following up on the Internet search criteria issue above raised in footnote 2 of the *In re Lister* case, what an “unmanageable number of references” and “overwhelming number of search results” means, and especially under what “circumstances,” is a high priority for the Federal Circuit to resolve. In fact, without clearly articulating the criteria for when the Internet search results become a “manageable number,” it is virtually impossible to apply the “printed publication” bar rationally and consistently to electronically posted documents searchable via the Internet. Developing such criteria will also most likely require an evaluation of several different factual situations. That would again suggest a very cautious initial approach until the appropriate Internet search results criteria become a reality, not theory, again making grants of summary judgment inadvisable in most cases.

¶ 111 4. Care should be taken to assess Internet search capabilities as of the time the “printed publication” bar allegedly occurred and without reference to those capabilities at the time the case is decided.

¶ 112 The *SRI International* case hints at the inherent danger of being potentially influenced and unduly prejudiced by current knowledge of Internet search capabilities. The capabilities of current Internet search technologies are likely to be different and much better than what those technologies were fifteen, ten or even five years ago when the relevant operative facts of the alleged “printed publication” bar occurred. There is thus a significant risk of being unduly biased by such current Internet search technology capabilities in judging what was, or might be, “publicly accessible” in the past on an FTP server, web site or other Internet-accessible computerized database. This risk is very similar to that of being unduly influenced by hindsight in making obviousness determinations under 35 U.S.C. § 103.²⁶⁴

²⁶⁴ See *KSR Int’l., Inc. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007): “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning” (citing the warning in *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) about the “temptation to read into the prior art the teachings of the invention in issue,” as well as instructing courts to “guard against slipping into the use of hindsight”). See also *In re Vaidyanathan*, 381 F. App’x 985, 994 (Fed. Cir. 2010) (non-precedential), where Judge Newman said: “Obviousness is determined as a matter of foresight, not hindsight.”

¶ 113 5. It is the *Internet search skills* of the “target audience” (i.e., the “person of ordinary skill in the art”) that matters most to what is “publicly accessible,” and not their knowledge of the relevant “art.”

¶ 114 The *SRI International* case suggests challenges in correctly assessing and determining what the Internet search skills are of the relevant “person of ordinary skill in the art” who might be accessing the document electronically posted on the FTP server, web site, or other Internet-accessible computerized database. That the “target audience” is fairly knowledgeable and sophisticated about the “art” described in the electronically posted document (for 35 U.S.C. § 103 purposes) is not necessarily the appropriate standard for judging such Internet search skills for “printed publication” bar purposes under 35 U.S.C. § 102(b). Instead, that “target audience” must be fairly and reasonably evaluated for their knowledge and sophistication with regard to the Internet search skills they might use in accessing the relevant electronically posted documents.²⁶⁵ This “Internet search skills” issue again militates against ready grants of summary judgment based on “printed publication” bars involving electronically posted and searchable documents.

¶ 115 6. Resolve under what circumstances the electronic posting of a document is sufficiently permanent to be “publicly accessible.”

¶ 116 The Federal Circuit must also determine what permanency means in the Internet age. What is electronically posted on an FTP server, web site, or other Internet-accessible computerized database may be transitory rather than permanent, in nature. For example, a web page can be removed without warning, or its content can change each day, each minute or even each second. Realistically evaluating the “public accessibility” of such transitory content could be a significant challenge. The issue of permanency may thus make application of “printed publication” bars inappropriate in certain situations where the document is posted for too short a period of time, or where the document can change or morph too readily to be fixed for a sufficient period of time.²⁶⁶

²⁶⁵ Some may wonder why Internet search skills of the “target audience” are or should be relevant to the question of whether electronically posted documents constitute a “printed publication” bar. In the reported cases in the “hard copy” age (i.e., before the Internet), the search skills of the “target audience” appear to completely irrelevant to (or at least are not mentioned in) determining whether the document is “publicly accessible” and thus a “printed publication” bar. But, as reflected by the extensive discussion by both Judge Rader and Judge Moore in the *SRI International* case about the search skills of the “target audience” in finding the Live Traffic Paper posted on the FTP server, that view appears to have changed. This change in view may reflect how differently electronic and “hard copy” documents are stored, and more importantly, how differently those documents are indexed/catalogued/searched in the Internet age, versus the “hard copy” age.

²⁶⁶ See *Disclosure of Technical Information on the Internet and Its Impact on Patentability*, WIPO STANDING COMMITTEE ON THE LAW OF PATENTS, part III, sec. 5 (Fourth Session, Geneva, November 6 to 10, 2000):

[the] quick-and-easy publication facility of the Internet raises additional issues related to the prior art effect of technical information disclosed on the Internet. The authenticity, veracity and integrity of information are critical issues for prior art in cyberspace. Compared with conventional paper publications, alteration and modification of content are easier, and more frequently occur, in the Internet environment. This means that

¶ 117 All that can be safely said now about applying the “printed publication” bar to electronically posted documents in the Internet age is that it is not yet as simple as “Googling for prior art.” Once the Federal Circuit grapples with and resolves “guidelines” one through six above, we may reach the stage where applying the “printed publication” bar to such electronic documents becomes as simple as what can be “Googled.” Even so, the term “printed publication” recited in 35 U.S.C. § 102(b) sounds very strange and archaic in the Internet age.²⁶⁷ Perhaps it is time for Congress to develop a new word or phrase for “printed publication” that more accurately reflects what form those electronic “publications” are taking, how those electronic “publications” are made available to the “target audience,” and how those electronic “publications” may be searched in the Internet age.

information that was available one day can change without notice, or even disappear ‘without any trace.’

Cf. Bagley, *supra* note 2, at 221 (commenting on the *In re Klopfenstein* case): “There the court expanded the scope of patent- invalidating prior art by broadly interpreting the phrase ‘printed publication’ to include fairly ephemeral scientific poster presentations.” Archived web pages (e.g., such as those provided in the Wayback Machine, see *supra* note 22) may also test the limits of permanency and especially the evidentiary value of such web pages to prove a “printed publication” bar. Supposedly the United States Patent and Trademark Office has accepted date stamps as evidence of when a given web page was “publicly accessible.” See *Wayback Machine*, WIKIPEDIA, http://en.wikipedia.org/wiki/Wayback_Machine (last visited Feb. 7, 2011); see also MPEP § 2128:

Prior art disclosures on the Internet or on an on-line 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 35 U.S.C. [§§] 102(a) or (b). However, it may be relied upon to provide evidence regarding the state of the art.

But whether a court will accept (and under what circumstances) such archived web pages as proof of a “printed publication” bar remains to be seen. *Cf.* *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151 (Fed. Cir. 2004) (conflicting and insufficient evidence of when undated one page document was “disseminated” to support summary judgment that document was “printed publication” under 35 U.S.C. § 102(b)).

²⁶⁷ Others have suggested the “printed publication” bar is outmoded for other reasons. See Barger, *supra* note 60, at 382–83 (growing problem of industrial espionage by computer piracy and potential abuse of modern technology makes 35 U.S.C. § 102(b) “outdated”).