

Fed. Circ. In Feb.: Using Prior Products To Invalidate A Patent

By **Sean Murray and Jeremiah Helm** (February 29, 2024, 5:05 PM EST)

When a company is accused of patent infringement, its lawyers' first instinct is often to scour the world for prior art that can invalidate the asserted patent. But sometimes the best evidence is right at hand, in the form of the accused company's own prior products.



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The U.S. Court of Appeals for the Federal Circuit recently made it easier for companies to invalidate patents using documentary evidence of their own prior products.

In the Feb. 8 Weber Inc. v. Provisur Technologies Inc. decision, **the court ruled** that operating manuals distributed with the defendant's prior products constituted printed publications that could invalidate the plaintiff's patents in an inter partes review proceeding.



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The dispute arose when Provisur sued its competitor Weber for infringement of two patents relating to high-speed mechanical slicers used in food processing plants to slice meats and cheeses. Weber responded by petitioning the Patent Trial and Appeal Board for inter partes review of Provisur's patents, and the board instituted the IPRs.

Provisur's patents disclosed slicing machines in which food articles are initially loaded onto a horizontal platform. The platform is then rotated upward so that the food articles may slide downward until reaching a slicing blade.

The complex device uses conveyor belts and servomotor-driven grippers to precisely control the movement of food through the machine.

Before the board, Weber argued that Provisur's patents were obvious in view of operating manuals for its own commercial food slicers. Those food slicers also received food on a horizontal platform that was then rotated upwards to an angled position.

The board ruled that Weber's operating manuals did not constitute printed publications. It found that Weber had provided the manuals to only 10 customers and that the manuals were subject to confidentiality restrictions in Weber's copyright notice and sales contracts.

Because the operating manuals were not printed publications, they did not qualify as prior art to Provisur's patents. The board therefore concluded that Weber had failed to show that Provisur's claims were unpatentable.

The Federal Circuit reversed the board's determination that the operating manuals were not printed publications. The governing legal standard was not in dispute. A document is a printed publication if it is publicly accessible, that is, if interested members of the relevant public could locate the document through reasonable diligence.[1]

The Federal Circuit ruled that the board had misapplied this standard.

In concluding that Weber's operating manuals were not printed publications, the board

relied on the Federal Circuit's 2009 Cordis Corp. v. Boston Scientific Corp. decision,[2] which held that two academic monographs on intravascular stents were not publicly accessible.

The author of the academic monographs provided them to only a handful of university colleagues and two companies interested in commercializing the technology. The board considered this similar to Weber's operating manuals, which Provisur argued had been provided to only 10 customers.

The Federal Circuit rejected the board's reliance on Cordis. The academic monographs in that case were not publicly accessible because of academic norms that obligated the recipients of the monographs to keep them confidential.

By contrast, Weber's operating manuals "were created for dissemination to the interested public to provide instructions about how to assemble, use, clean, and maintain Weber's slicer," according to the decision. The court stressed that, where a publication's purpose is dialogue with the intended audience, that purpose indicates the document was publicly accessible.

Applying the governing standard, the Federal Circuit found that members of the interested public could have obtained Weber's operating manuals through reasonable diligence.

First, they could have obtained a manual by purchasing one of Weber's commercial slicers. Second, they could have requested a manual directly from Weber.

On this latter point, Weber submitted evidence that it had actually received such requests and responded by delivering copies of its manuals.

Finally, the Federal Circuit addressed Weber's copyright notice, which stated that the manuals could not "be reproduced or transferred in any way," and Weber's sales terms, which likewise limited the ability of Weber's customers to transfer the manuals.

The court ruled that limits on the ability of Weber's customers to further disseminate the manuals, even if effective, did not negate the fact that Weber made the manuals publicly accessible by providing them with its products and upon request.

The Weber decision is good news for companies that have an established history of selling products in a particular field or product space. When sued in district court, as Weber was, such companies have always been able to defend against claims of patent infringement by pointing to their own prior products.

Invalidating a patent, though, is much more expensive in district court than in an IPR proceeding. IPR proceedings, however, can only be instituted based on paper prior art.

While an IPR petitioner cannot rely on its prior products to invalidate a patent, it can rely on printed publications disclosing those products, such as operating manuals and brochures. The Weber decision makes that easier to do.

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[1] Valve Corp. v. Ironburg Inventions Ltd., 8 F.4th 1364, 137/1-/23 (Fed. Cir. 2021).

[2] Cordis Corp. v. Boston Scientific Corp., 561 F.3d 1319 (Fed. Cir. 2009),