

PTAB Bar Association Webinar
Appeals from the PTAB Federal Circuit Update 2024

October 3, 2024

- Motivation to combine
- Printed publications and public accessibility
- Printed matter

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- *Virtek Vision Int'l ULC v. Assembly Guidance Sys., Inc.*,
97 F.4th 882 (Fed. Cir. 2024)
- *RAI Strategic Holdings, Inc. v. Philip Morris Prod. S.A.*,
92 F.4th 1085 (Fed. Cir. 2024)

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Virtek Vision Int'l ULC v. Assembly Guidance Sys., Inc,
97 F.4th 882 (Fed. Cir. 2024)

Motivation to combine

Virtek Vision: 97 F.4th 882

- Appeal from an *inter partes* review of U.S. Patent No. 10,052,734, owned by Virtek Vision.
- PTAB held certain claims unpatentable as obvious.
- Virtek Vision appealed.
- Federal Circuit reversed, finding a lack of substantial evidence for a motivation to combine.

Virtek Vision: Background

- Relevant art:
 - Lasers project a template image onto a work surface to direct manufacturing processes.
 - To accurately project a template image onto a 3D work surface, the laser projector must be precisely calibrated, *i.e.*, aligned.
- The '734 Patent discloses a method for aligning a laser projector relative to a work surface.
 - Claim 1 recites: “identifying a pattern of the reflective targets on the work surface in a **three dimensional** coordinate system.”

Virtek Vision: PTAB Proceedings

- Aligned Vision petitioned for *inter partes* review of all claims of the '734 Patent.

'734 Patent Claims	Asserted Art	PTAB Decision
1, 2, 7, 10-13	Briggs ¹ and Keitler ²	Unpatentable Appeal
	Briggs and Bridges ³	
3, 4, 6, 8, 9	Briggs, Keitler, Rueb ⁴	Not unpatentable Cross-appeal
	Briggs, Bridges, Rueb	

¹ PCT Pub. No. WO2012/033892 A1, published March 15, 2012.

² U.S. Patent Application Publication No. US 2014/0160115 A1, published June 12, 2014.

³ U.S. Patent US 8,040,525, issued October 18, 2011.

⁴ U.S. Patent Application Publication No. US 2013/0250094 A1, published September 26, 2013.

- Claim 1 requires identifying targets in a **3D coordinate system**.
- Keitler and Bridges disclose the use of an angular direction system.
- Briggs discloses a laser projector system with different embodiments of laser tracker systems.
 - (1) two cameras to determine the 3D coordinates of a target.
 - (2) one camera to determine angular measurements of a target.
- Petitioner relies on Briggs for this missing element.
- PTAB decision: combination is obvious because Briggs discloses both 3D coordinates and angular directions.

Virtek Vision: On Appeal

- Reversed.
- “The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted the one-camera angular direction system...with the two-camera 3D coordinate system disclosed in Briggs.”

Virtek Vision: On Appeal

- Fed. Cir. opinion points out that the Petition does not:
 - provide a reason for substitution, other than the two systems were “known to be used.”
 - does not argue that Briggs provides that reason, or that there would be any advantages to doing so.
 - Petitioner’s expert did not provide any reason to combine.
- No evidence that there are a finite number of identified, predictable solutions.
- No evidence of a design need or market pressure.

“It does not suffice to simply be known. **A reason for combining must exist.**”

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RAI Strategic Holdings, Inc. v. Philip Morris Prod. S.A.,
92 F.4th 1085 (Fed. Cir. 2024)

Motivation to combine

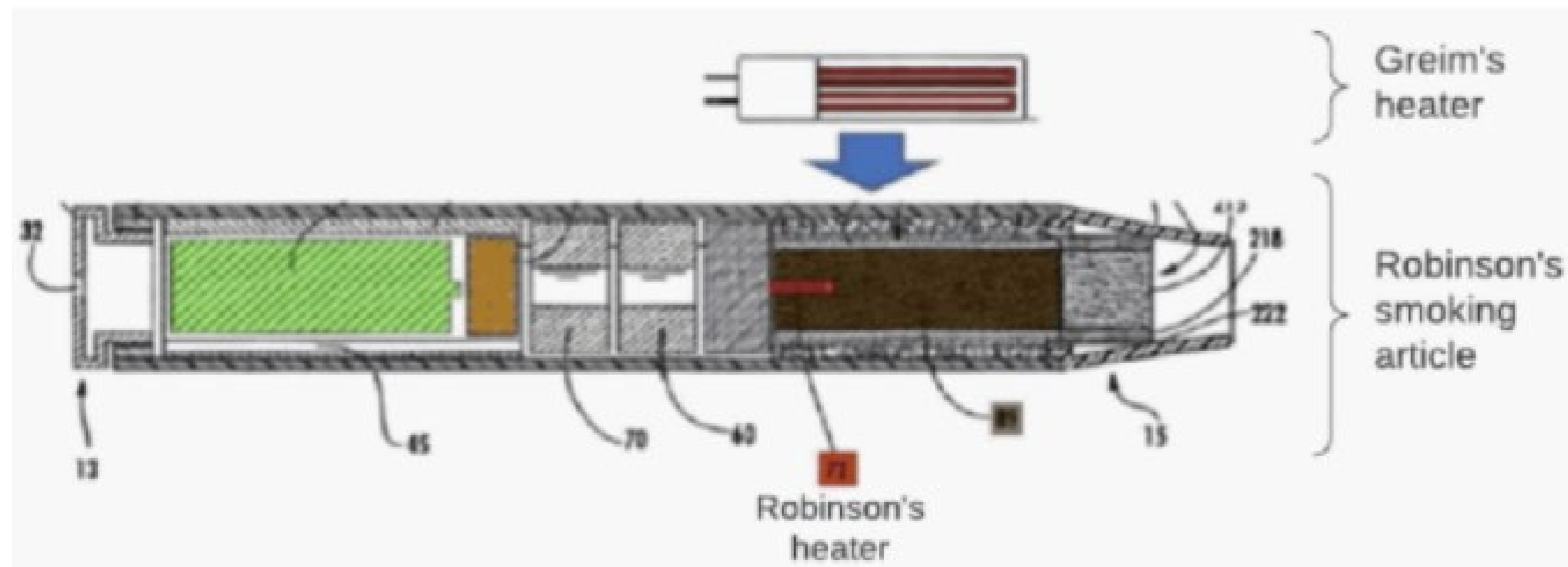
- Appeal from a post grant review of U.S. Patent No. 10,492,542, owned by RAI.
- PTAB held certain claims unpatentable as obvious (among other findings).
- RAI appealed.
- Federal Circuit affirmed as to obviousness.

RAI: Background

- The '542 Patent is directed to electrically powered smoking articles that provide an inhalable substance in vapor or aerosol form by heating substances without significant combustion.
- Claim 1 requires a “heating projection comprising...an electrical connector for providing a flow of electricity to the heating member for heating....”

RAI: PTAB Proceedings

- Philip Morris argued that the combination of Robinson¹ and Greim² discloses all the limitations of claim 1.



¹ U.S. Patent No. 7,726,320.

² WO 2011/050964 A1.

RAI: PTAB Proceedings

- Philip Morris argued that a POSA would have been motivated to combine because:
 - Robinson discloses that its heating element can be altered and selection of resistance heating elements can be a matter of design choice;
 - Greim teaches that its heater configuration has advantages over other heaters.
- RAI argued that Robinson's statements refer to alternate designs presented within Robinson itself.

RAI: PTAB Proceedings

- Board agreed with Philip Morris that the language in Robinson would have “invited” a POSA to select a resistance heating element that could be used with Robinson’s housing.
- Therefore, a POSA would have had reason to look to Greim for a heater.

RAI: On Appeal

- Affirmed.
- Substantial evidence supports a motivation to combine:
 - Robinson’s statements about altering the heating element;
 - Greim expressly discloses advantages of its heater design and Philip Morris’s expert agrees;
 - RAI’s expert opined that a POSA would have appreciated the flexibility in Robinson’s heater design;
 - RAI’s expert opined that implementing Greim’s heater in Robinson’s housing would not have been beyond POSA’s skills.

Weber, Inc. v. Provisur Technologies, Inc.,
92 F.4th 1059 (Fed. Cir. 2024)

Printed Publication – Public Accessibility

35 U.S.C. § 102 (Pre-AIA):

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a **printed publication** in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a **printed publication** in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

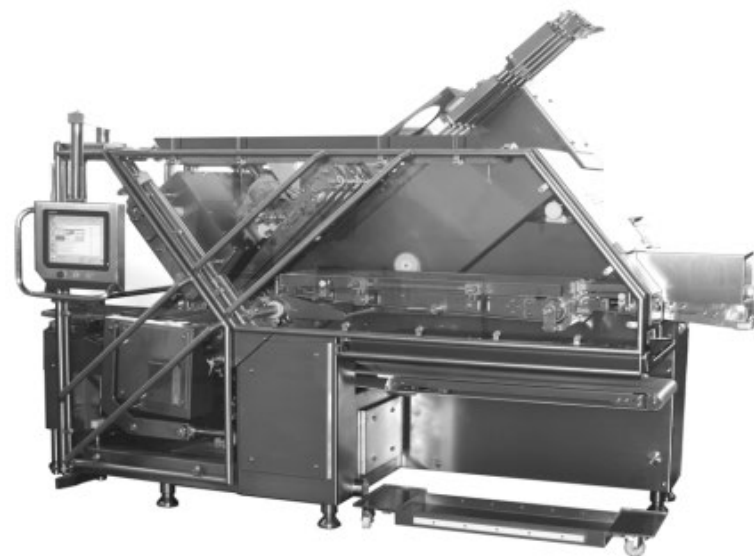
What Is A “Printed Publication”?

“The statutory phrase ‘printed publication’ from § 102 has been defined to mean a reference that was ‘sufficiently accessible to the public interested in the art.’”

“The standard for public accessibility is whether interested members of the relevant public could locate the reference by reasonable diligence.”

The Disputed Prior Art

Operating Manual



for the

Slicer CCS 904-02

(for product lengths to 1200 mm / 1600 mm)

weber[®]
The High Tech Company


- Accompanied sold food slicers
 - 54 total slicers sold (11 in U.S.)
 - 10 unique customers
- Available on request
 - Via advertisements/articles about food slicer
- Allowed inspection of manuals during trade shows

PTAB: Insufficient Public Accessibility

“[W]here a distribution is made to a limited number of entities, a binding agreement of confidentiality may defeat a finding of public accessibility.”



Cordis Corp. v. Boston Sci. Corp., 561 F.3d 1319, 1333 (Fed. Cir. 2009).

PTAB: Insufficient Public Accessibility

“[W]here a distribution is made to a  **limited number of entities**, a binding agreement of confidentiality may defeat a finding of public accessibility.”

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Cordis Corp. v. Boston Sci. Corp., 561 F.3d 1319, 1333 (Fed. Cir. 2009).

1

The German operating manual is the original manual. All other language versions are translations of the original manual.

ASB/English/Verp

Federal Circuit: PTAB Misapplied *Cordis*

Cordis:

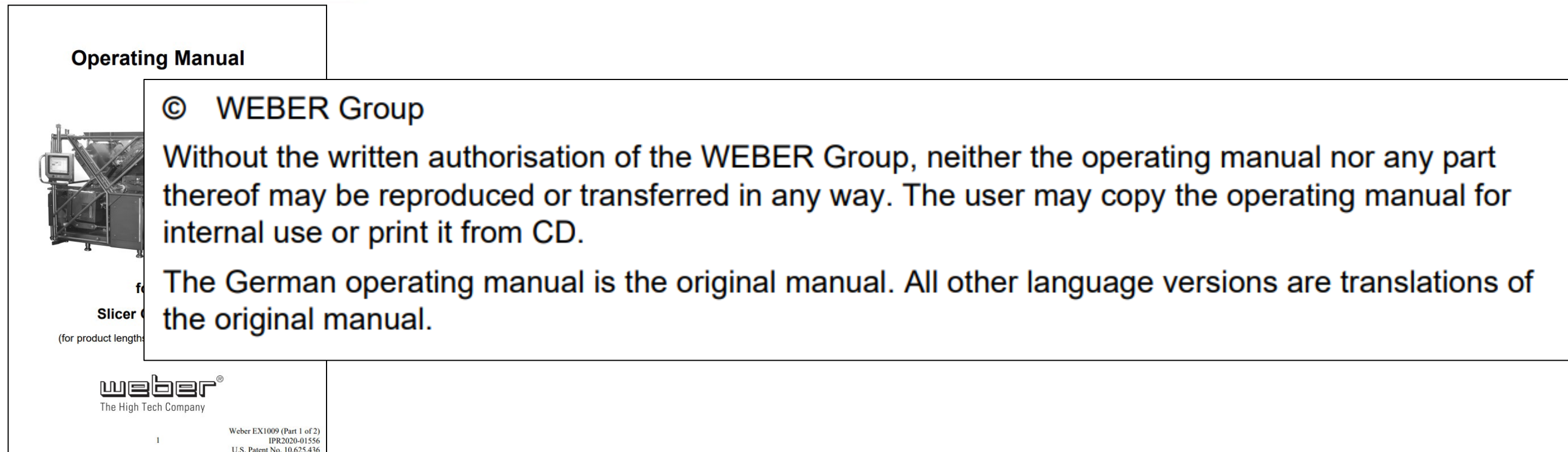
- Two academic monographs
- Distributed to handful of colleagues and two companies interested in commercializing technology
- Evidence that academic norms gave rise to expectation of confidentiality

Weber:

- Operating manuals created for dissemination to interested public
- Publication's purpose is dialogue with the intended audience
- Operating manuals were actually delivered to customers

Weber, Inc., 92 F.4th at 1067-68.

Federal Circuit: Sufficient Public Accessibility



- Allows original owners to copy for internal use
- Expressly instructed re-selling customers to transfer operating manuals to purchasing third parties
- “Weber’s assertion of copyright ownership does not negate its own ability to make the reference publicly accessible.”

Weber, Inc., 92 F.4th at 1068-69.

“The intellectual property rights clause ... has no dispositive bearing on Weber’s public dissemination of operating manuals to owners after a sale has been consummated.”

Other Arguments Federal Circuit Rejected

Argument:	Federal Circuit:
Distribution to 10 unique entities insufficient.	“No minimum number of occasions of access is dispositive of the public accessibility inquiry in all cases.”
High cost of Weber’s commercial slicers means manuals were not reasonably accessible.	“Cost alone cannot be dispositive because the printed publication inquiry is focused on the interested public, not the general public. ... Here, the interested public includes commercial entities that can afford high-cost slicers.”

IOENGINE, LLC v. Ingenico Inc.,
100 F.4th 1395 (Fed. Cir. 2024)

Printed Matter Doctrine

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The Printed Matter Doctrine

- The Federal Circuit has long held that “certain ‘printed matter’ falls outside the scope of patentable subject matter under U.S. patent law.”
- Historically, “printed matter” “referred to claim elements involving actual ‘printed’ material.”
- But that doctrine **has since expanded “to include any information claimed for its communicative content, regardless of medium.”**

Examples of Printed Matter

- FDA label providing dosage instructions
- FDA label instructing a patient to take medication with food
- Instructions for performing a DNA test
- Numbers printed on a wristband

See In re Distefano, 808 F.3d 845, 849-50 (Fed. Cir. 2015) (collecting cases)

Printed Matter Doctrine: 2-Step Test

1) Determine whether the limitation in question is directed toward printed matter.

- A “limitation is printed matter only if it claims the content of information.” In other words, printed matter is “matter claimed for what it communicates.”

2) Determine “whether the printed matter nevertheless should be given patentable weight.”

- “Printed matter is given such weight if the claimed informational content has a functional or structural relation to the substrate.”

In re Distefano, 808 F.3d 845, 848 (Fed. Cir. 2015)

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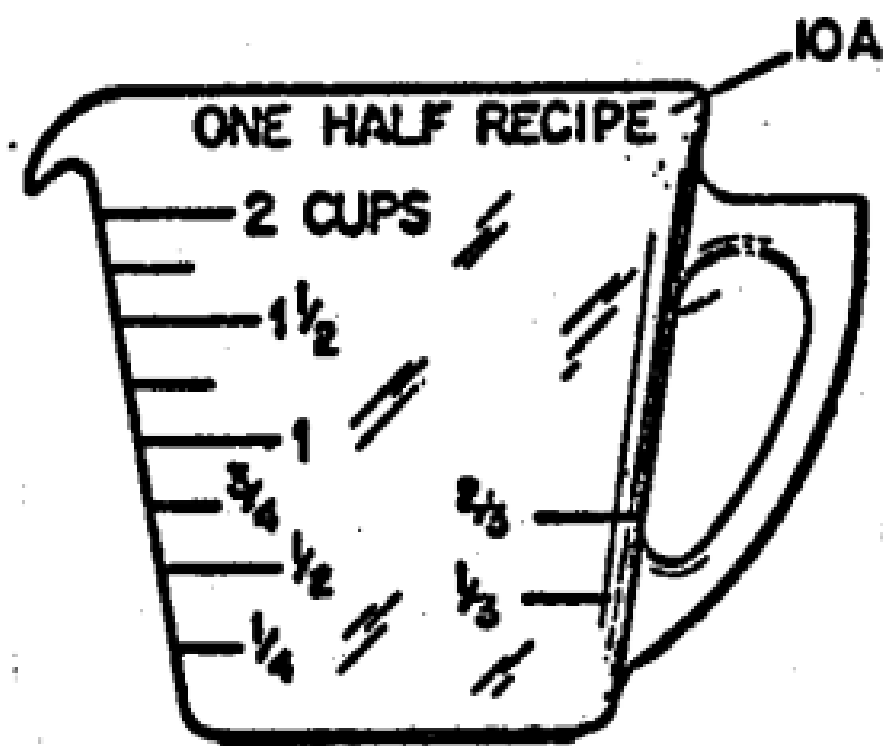


FIG. 2

(A635)

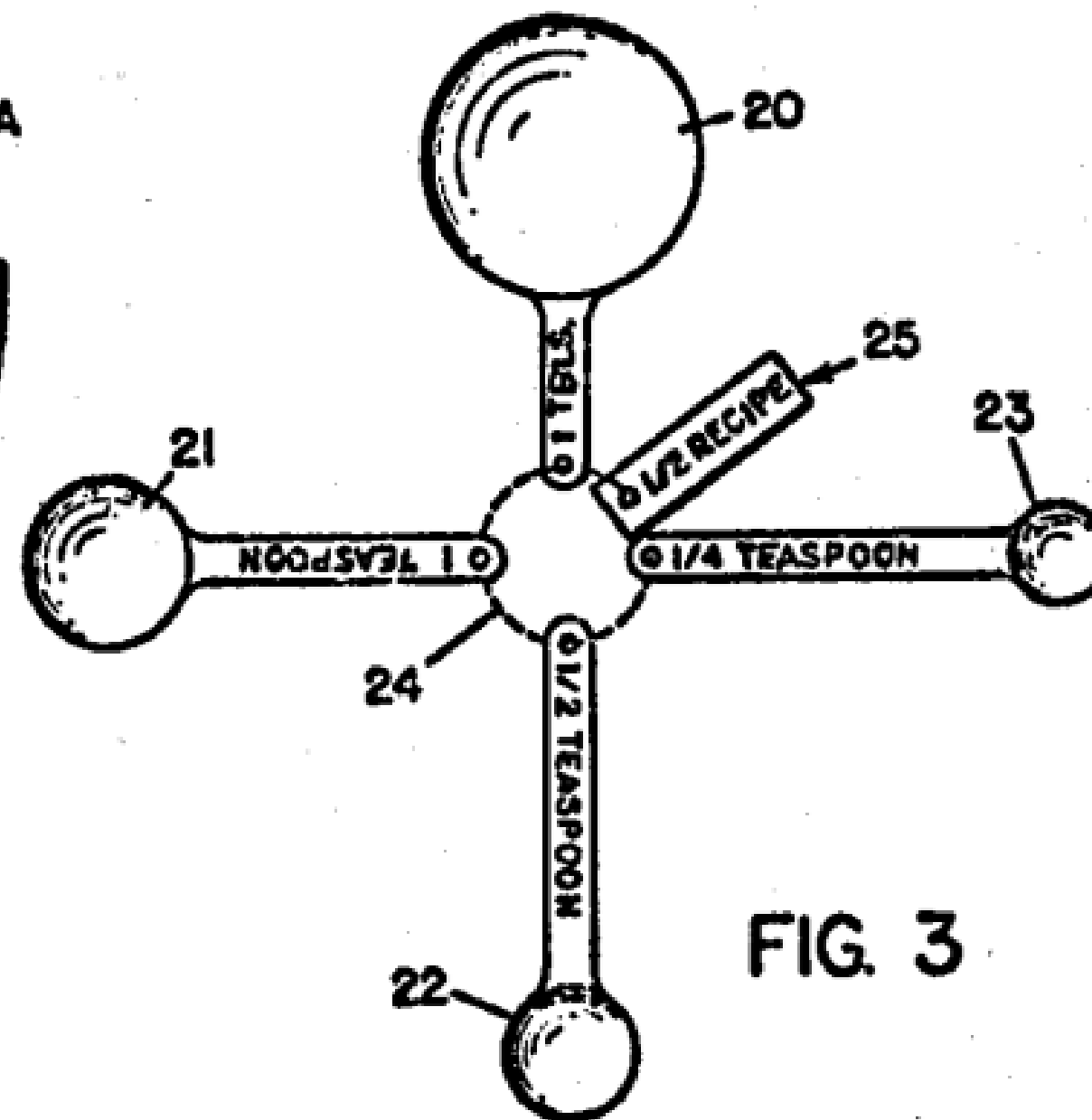
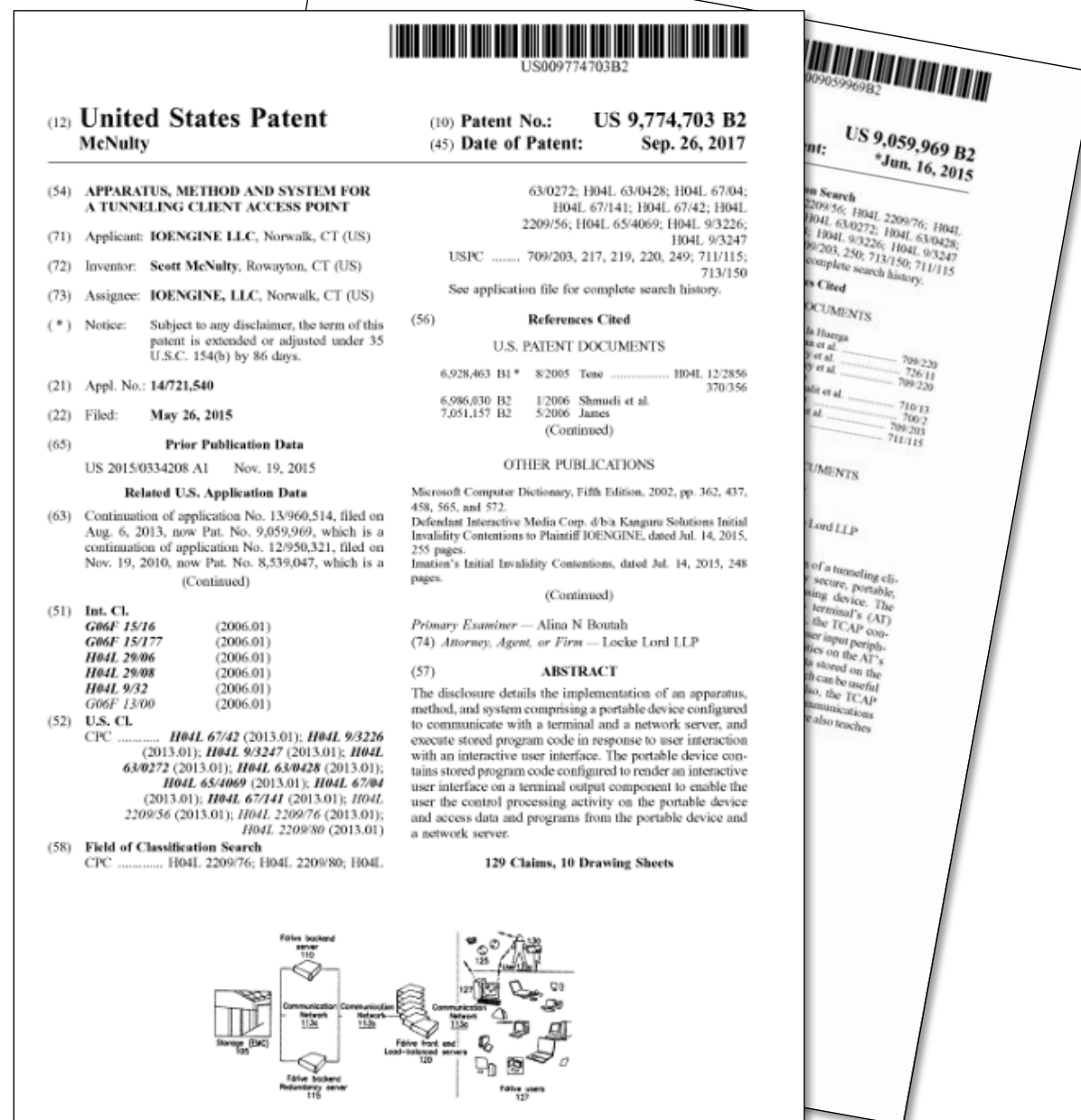


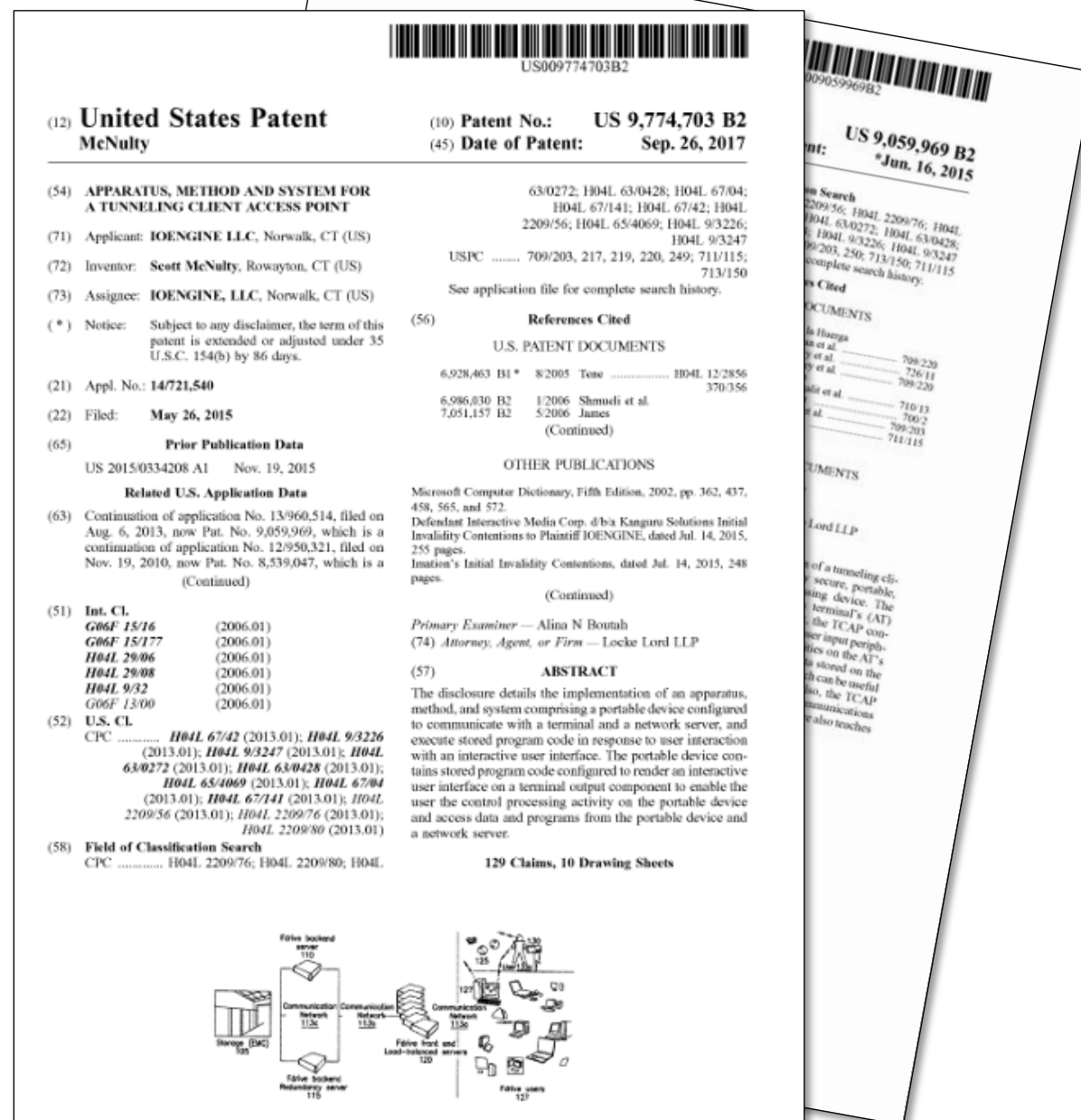
FIG. 3

In re Miller, 418 F.2d 1392 (C.C.P.A.. 1969)

- The challenged claims recited a portable “tunneling” device that, when connected to an access terminal, communicates with the access terminal to facilitate the transmission of encrypted communications or the download of program code so that data stored on the portable device can be provided through the access terminal’s input/output facilities



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Ingenico's Anticipation Arguments

- Ingenico relied on Iida, which did not disclose certain limitations reciting “encrypted communications” and “program code”
- Ingenico argued that such limitations merely recited communicative content with no functional relationship to the substrate and were thus printed matter with no patentable weight

Claim 4 of the '969 Patent

“wherein the communication caused to be transmitted to the communication network node facilitates the transmission of ***encrypted communications*** from the communication network node to the terminal.”

Iida

Disclosed the facilitation of a transmission of communications from a “communication network node” to a “terminal,” but did not disclose that the communications were encrypted.

Ingenico argued the difference was just of the information content

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The Board's Ruling: "Encrypted Communications"

1. The term "claims only communicative content" because **"nothing in the claim [] requires anything beyond sending and receiving data, even if the data is in an encrypted form."**
2. There is "no functional relationship of the encrypted data to the communication carrying it" because **no requirement to process the encrypted data beyond "transmission of the same."**



Claim 61 of the '703 Patent

“wherein the step of executing fourth program code stored on the portable device memory causes a communication to be transmitted to the communications network node to facilitate the download of ***program code*** from the communications network node to the terminal.”

lida

lida disclosed downloading image data, but not program code.

Ingenico argued the difference was just of the information content

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The Board's Ruling: "Program Code"

1. The term "is 'printed matter' because it **claims the content of the information that is downloaded.**"
2. "[T]he downloaded code is merely generic and has **no functional relationship with either the portable device or the terminal.**"



The Federal Circuit's Application of the 2-Step Test

1) Determine whether the limitation in question is directed toward printed matter.

- **Encrypted communication:** The Federal Circuit found that “the encrypted communications here are not being claimed for any content that they are communicating,” and therefore **did not constitute printed matter.**
- “[P]rinted matter is matter that is claimed for its communicative content—i.e., the content specifically being communicated.”
- Act of the communication itself is not the content of information
- Form of the communication is not the content of information

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The Federal Circuit's Application of the 2-Step Test

1) Determine whether the limitation in question is directed toward printed matter.

- **Program code:** “[T]he claim is altogether silent as to the contents of the claimed ‘program code.’ That the code is being downloaded does not change the analysis. Because there is no particular content being claimed, the program code is not printed matter.”

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The Federal Circuit's Application of the 2-Step Test

2) Determine “whether the printed matter nevertheless should be given patentable weight.”

- **N/A:** “Because ‘encrypted communications’ and ‘program code’... are not printed matter,” the Federal Circuit did not address the second step.

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The Federal Circuit Vacated

“Because ‘encrypted communications’ and ‘program code’ are not being claimed here for the content they communicate, they are not printed matter.”

Where Do Things Stand?

The printed matter doctrine is limited, and the Federal Circuit cautions against “impermissibly expand[ing it] far beyond its current scope.”



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Q&A

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