February 29, 2024

No Magic Number: Understanding Public Accessibility in IPR Proceedings Weber, Inc. v. Provisur Technologies, Inc., 92 F.4th 1059 (Fed. Cir. Feb. 8, 2024)

by Justin L. Krieger

Under 35 U.S.C. § 311(b), a Petitioner may challenge the validity of an issued patent in an IPR proceeding "only on the basis of prior art consisting of patents or printed publications." Public accessibility has been held to be the touchstone for whether a reference constitutes a printed publication. *Jazz Pharms., Inc. v. Amneal Pharms., LLC*, 895 F.3d 1347, 135 (Fed. Cir. 2018). In *Weber, Inc. v. Provisur Technologies, Inc.*, the Federal Circuit clarified that dissemination of a reference for determining public accessibility does not require any magic number of recipients.

In this case, Weber filed IPR petitions against Provisur challenging the validity of U.S. Patent Nos. 10,639,812 and 10,625,436, relating to high speed mechanical slicers used in food-processing plants to slice and package food such as meats and cheeses. As prior art, Weber relied primarily upon its commercial food slicer operating manuals in combination with various patent publications. According to Weber, the operating manuals were created and disseminated to accompany and explain how to use Weber's commercial food slicer products. In a final written decision, the PTAB found that the operating manuals were distributed to just ten unique customers and were subject to confidentiality restrictions. For these reasons, and citing *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319 (Fed. Cir. 2009), the PTAB concluded that the operating manuals were not printed publications and upheld the challenged claims. IPR2020-01556, Paper 67; IPR2020-01557, Paper 67.

On appeal, the Federal Circuit disagreed and clarified the public accessibility requirement for printed publications. In its analysis, the court reiterated that the standard for public accessibility is "whether interested members of the relevant public could locate the reference by reasonable diligence." The court distinguished the operating manuals from the academic monographs in *Cordis* stating that academic norms gave rise to an expectation of confidentiality with the academic monographs. In contrast, Weber's operating manuals "were created for dissemination to the interested public" to provide instructions on how to use its slicer products. Thus, the court focused on the *purpose* of the operating manuals as a "dialogue with the intended audience," which supported public accessibility. The court also noted that although the parties disagreed as to how widely the manuals were distributed (from 10 to 40+ entities), it did not need to resolve that dispute because "[n]o minimum number of occasions of access is dispositive of the public accessibility inquiry…."

The court also held that the PTAB had placed an inordinate emphasis on confidentiality restrictions contained in the operating manuals' copyright notice, which stated that the manuals could not "be reproduced or transferred in any way" and in an intellectual property rights clause contained in sales documents stating "[c]ost estimates, drafts, drawings and other documents remain the property of [Weber]." The Federal Circuit held that the copyright notice did not convert the public accessibility of the manuals into a non-disclosure. Similarly, Weber's sales conditions had no dispositive bearing on Weber's otherwise public dissemination of the operating manuals.

Practitioner Takeaway:

IPRs are not limited to patents and published patent applications as prior art. In preparing invalidity arguments, Petitioners should consider non-patent literature including client documents that were prepared for the purpose of communicating with a public audience, including customers. Additionally, although the dissemination of documents to wide audiences may be beneficial in proving public accessibility, in some situations a very limited distribution may still satisfy the public accessibility requirement for printed publications.