

Precedential Patent Case Decisions During February 2021

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I. Introduction

This paper abstracts what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Abstracts and New Points of Law

Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).

This is a decision on an appeal from PTAB case 95/001,702. The PTAB held the original and newly presented claims obvious. Synqor appealed. The Federal Circuit majority vacated the PTAB decision that the original claims were obvious, based upon preclusion. The Federal Circuit majority vacated the PTAB decision that the newly presented claims were obvious, based upon mootness. Judge Dyk dissented.

In dissent, Judge Dyk began:

The majority holds that collateral estoppel (or issue preclusion) applies to inter partes reexamination proceedings at the United States Patent and Trademark Office (USPTO). The majority's holding is incorrect because these proceedings are examinational (or inquisitorial) rather than adjudicatory, do not include court-like adjudicatory procedures, and do not satisfy the requirements of *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138 (2015), for application of collateral estoppel. The majority's decision conflicts with decisions of the Supreme Court and our sister circuits. I respectfully dissent. [Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).]

Legal issue: Non-statutory collateral estoppel, applicability to pre-AIA inter partes reexamination

The Federal Circuit majority held that collateral estoppel applies to inter partes reexamination proceedings.

The Federal Circuit majority summarized:

SynQor makes four arguments on appeal. First, SynQor argues that common law issue preclusion arising from the '702 and '290 patent reexaminations should have collaterally estopped the Board from finding that an artisan would be motivated to combine Steigerwald and Cobos.[1] *** Because we agree with SynQor as to its first argument that issue preclusion compelled a finding that an artisan would not combine Steigerwald and Cobos—which resolves the parties' dispute for claims 1–19, 28, and 31—we address only this

argument and SynQor’s fourth argument as to the mootness of the Board’s decisions regarding claims 34–38. [Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).]

In footnote 1, the Federal Circuit majority stated:

Vicor argues that SynQor forfeited its issue preclusion argument by not raising it before the Board despite having the opportunity to do so. Appellee’s Br. 30. But SynQor could not have raised issue preclusion because neither the ’702 nor ’290 patent reexaminations became final until after the Board’s decision regarding claims 1–19, 28, and 31. “[I]ssue preclusion applies even though the precluding judgment . . . comes into existence while the case as to which preclusion is sought (this case) is on appeal.” *MaxLinear, Inc. v. CF Crespe LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) (quoting *Soverain Software LLC v. Victoria’s Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1315 (Fed. Cir. 2015)). [Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).]

The Federal Circuit majority concluded that:

...The statutory scheme governing inter partes reexaminations is fully consonant with common law estoppel *** Inter partes reexamination indisputably meets factors one, three, and four *** [and] the procedural mechanisms used in inter partes reexamination are sufficient to apply collateral estoppel arising from a first reexamination to a second reexamination.” [Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).]

The Federal Circuit majority then applied the law to the facts of the case, and found estoppel.

Here, the issues are identical between the ’190 patent reexamination and the ’290 and ’702 patent reexaminations. “Our precedent does not limit collateral estoppel to patent claims that are identical. Rather, it is the identity of the issues that were litigated that determines whether collateral estoppel should apply.” *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013); *see also B & B Hardware*, 575 U.S. at 157 (citing the Restatement (Second) of Judgments § 27 cmt.c, at 252–53, that an “issue” must be understood broadly enough “to prevent repetitious litigation of what is essentially the same dispute”(emphasis added)). In the ’190 patent reexamination here, as in the ’702 and the ’290 patent reexaminations, the relevant issue was whether “Cobos’ and Steigerwald’s circuits are mutually incompatible because of their switching frequency.” *Vicor*, 2016 WL 2344371, at *6. *Compare id. with Vicor*, 2015 WL 1871498, at *11 (addressing whether an artisan would have failed to combine Steigerwald and Cobos “due to the incompatible switching frequencies of the two circuits”) and *Vicor*, 2016 WL

2344380, at *6 (deciding the issue of whether an artisan would have “overcome” “the frequency incompatibility of Cobos and Steigerwald” to combine the two references). [Synqor, Inc. v. Vicor Corporation, 2019-1704 (Fed. Cir. 2/22/2021).]

John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).

This is a decision on an appeal from the E.D. Ark. case 4:14-cv-00368-BRW. The district court granted-in-part Morris’s motion for summary judgment as to equitable intervening rights, denied-in-part its motion as to prosecution laches, and dismissed the case. John Bean appealed the district court decision as to equitable intervening rights and Morris cross-appealed the decision as to prosecution laches.

Legal issue: Doctrine of Equitable Intervening Rights, applicable factors, not limited to monetary recoupment of investments made prior to the grant of reissue.

The Federal Circuit held that monetary recoupment of investments made prior to the grant of reissue was not the sole objective of 35 USC 252’s protection of “investments made or business commenced” before the claim’s alteration.

John Bean argues that this court should deem monetary recoupment of investments made prior to the grant of reissue as sufficient to protect investments and defeat the grant of the equitable remedy. We disagree. [John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).]

This court has not yet had the opportunity to examine the boundaries of the phrase “protection of investments” in § 252. The statute’s text does not specify when the protection begins and ends or precisely which types of investments are entitled to protection. [John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).]

But recoupment is not the sole objective of § 252’s protection of “investments made or business commenced” before the claims’ alteration. *See* also 35 U.S.C. § 252; Oral Arg. at 1:19–55. We see no indication in the statute that monetary investments made and recouped before reissue are the only investments that a court may deem sufficient to protect as an equitable remedy. To be clear, recoupment is a factor that a court may consider, as it did in this case, in weighing the equities before making a determination on entitlement to equitable intervening rights. But it is not the sole factor a district court must consider, nor is it a factor that must be weighed more heavily, when the court balances the equities. Determining entitlement to equitable intervening rights is an analysis broader than simply determining whether a party claiming intervening rights has fully recouped its monetary investment. [John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).]

On the facts of the case, the Federal Circuit concluded that the district court did not abuse its discretion in granting the relief of equitable intervening rights.

Here, the district court considered seven different factors in making its determination and decided the facts sufficiently demonstrated that Morris was entitled to an affirmative defense of equitable intervening rights. The court found that John Bean had engaged in bad faith and that Morris's investment was more than just a financial investment. Given our standard of review in this appeal and the broad equity powers a trial court has to fashion an appropriate remedy, we do not conclude that the district court abused its discretion in its application of 35 U.S.C. § 252. [John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).]

Legal issue: 35 USC 284, increased damages, willful infringement, effect of equitable intervening rights.

The Federal Circuit concluded that a precondition for willful infringement was infringement, and equitable intervening rights resulted in no infringement, and therefore no willful infringement.

John Bean also argues that genuine issues of material fact remain as to willful infringement. We disagree. If there is no infringement, there cannot be willful infringement. See 35 U.S.C. § 284. Once the district court granted Morris's motion for summary judgment on the affirmative defense of equitable intervening rights, it did not have to reach the question of willful infringement. To reach its decision the district court relied on findings of fact—e.g., the eleven-year delay before seeking reexamination and the re-structuring of Morris's business to the accused product—to support its determination. See, e.g., Decision, 2019 WL 7176779 at *3. Thus, once the district court granted Morris equitable intervening rights, John Bean was left with no basis to pursue a willful infringement claim. [John Bean Technologies Corporation v. Morris & Associates, Inc., 2020-1090, 2020-1148 (Fed. Cir. 2/19/2021).]

Canfield Scientific, Inc. v. Melanoscan, LLC, 2019-1927 (Fed. Cir. 2/18/2021).

This is a decision on an appeal from PTAB case IPR2017-02125. The PTAB ruled that all challenged claims “are unpatentable” [sic; were not found to be unpatentable]. Canfield appealed. The Federal Circuit reversed as to independent claims 1 and 51 and vacated and remanded as to dependent claims.

Legal issue: 35 USC 103, motivation to combine, failure to recognize facts showing motivation to combine.

The Federal Circuit concluded that claims obvious, citing facts that the Board failed to mention in concluding the claims non-obvious, which facts provided for a combination of familiar elements that provided predictable results.

The Federal Circuit stated:

The Board made no mention of the placement of the subject at the center of the multi-camera system as in Hurley and Crampton. *** In Voigt the object is placed against a wall of the enclosure, and Hurley and Crampton show the object placed at the center of the enclosure. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. [Canfield Scientific, Inc. v. Melanoscan, LLC, 2019-1927 (Fed. Cir. 2/18/2021).]

Here, the references show various placements of the subject being imaged, in Voigt placed against a wall, and in Hurley, Crampton, and Daanen centrally placed within the framework. Voigt at 982; Hurley at 212; Crampton at 1, 6; Daanen at 113. The references show the cameras laterally and vertically spaced to each other about a center-line. Voigt at 981; Hurley at 212–13; Crampton at 11; Daanen at 115. [Canfield Scientific, Inc. v. Melanoscan, LLC, 2019-1927 (Fed. Cir. 2/18/2021).]

Claims 1 and 51 place the subject within the enclosure, as in the prior art, and place multiple cameras and lights within the enclosure, as in the prior art. We conclude that the subject matter described in claims 1 and 51 would have been obvious to a person of ordinary skill in the field of the invention. The Board’s ruling of patentability as to these claims is reversed. [Canfield Scientific, Inc. v. Melanoscan, LLC, 2019-1927 (Fed. Cir. 2/18/2021).]

Synchronoss Technologies, Inc. v. Dropbox, Inc., 2019-2196, 2019-2199 (Fed. Cir. 2/12/2021).

This is a decision on appeals from N.D. Cal case 4:16-cv-00119-HSG. The district court found the claims either invalid under 112, second paragraph or not infringed. Synchronoss appealed and Dropbox cross-appealed. The Federal Circuit affirmed the claims to be invalid under 112, second paragraph.

Legal issue: 28 USC 1295(a)(1), jurisdiction, exception to the final judgement rule, cure to a jurisdictional defect by waiver on appeal.

The Federal Circuit restated its law avoiding lack of jurisdiction due to a appeal of a non-final judgement, by allowing a party to waive its right during appeal to the undecided issues.

We first address a threshold question of jurisdiction. Absent extraordinary circumstances, for a district court judgment to be appealable to this court under 28 U.S.C. § 1295(a)(1), the judgment must resolve all claims and counterclaims or make an express determination under Rule 54(b) of the Federal Rules of Civil Procedure that there is no just reason for delay. *SafeTCare Mfg., Inc. v. Tele-Made, Inc.*, 497 F.3d 1262, 1267 (Fed. Cir. 2007); *see also Int’l Elec. Tech. Corp. v. Hughes Aircraft Co.*, 476 F.3d 1329, 1330 (Fed. Cir. 2007) (concluding

no final judgment, and thus a lack of jurisdiction, where the defendants' counterclaims were never dismissed and thus remained extant). [Synchronoss Technologies, Inc. v. Dropbox, Inc., 2019-2196, 2019-2199 (Fed. Cir. 2/12/2021).]

In its order granting summary judgment of non-infringement on the '757 patent, the district court denied as moot Synchronoss's motion for summary judgment of validity of the '757 patent. A finding of non-infringement, however, does not by itself moot a request for declaratory judgment of invalidity. *See Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 98 (1993). Therefore, Dropbox's invalidity counterclaims survived the judgment of non-infringement, and the district court's purported "final judgment" based on its summary judgment decision did not constitute a final decision under 28 U.S.C. § 1295(a)(1). [Synchronoss Technologies, Inc. v. Dropbox, Inc., 2019-2196, 2019-2199 (Fed. Cir. 2/12/2021).]

In *Amgen Inc. v. Amneal Pharmaceuticals LLC*, 945 F.3d 1368, 1374 (Fed. Cir. 2020), we held that a party can "cure" a jurisdictional defect stemming from its unresolved invalidity counterclaim if it agrees to "give up" the claim regardless of the outcome of the appeal. We held that such a representation, even made at oral argument, effectively "nullifie[s]" the outstanding issues, rendering the court's judgment as to infringement "final" for purposes of our jurisdiction. *Id.* During oral argument, Dropbox agreed to give up its invalidity counterclaims with respect to the '757 patent. Oral Arg. at 6:27–13:08, <http://oralargu-ments.cafc.uscourts.gov/default.aspx?fl=19-2196.mp3>. Based on Dropbox's representation as to its counterclaims, we deem the district court's judgment final and we assert jurisdiction under § 1295(a)(1). [Synchronoss Technologies, Inc. v. Dropbox, Inc., 2019-2196, 2019-2199 (Fed. Cir. 2/12/2021).]

Legal issue: 35 USC 112, definiteness, regards test, claims that require an impossibility.

The Federal Circuit restated its law that a claim that a PHOSITA would have understood to not set forth what the inventor regarded as their invention, such as a claim that required an impossibility, is invalid for indefiniteness.

In *Allen Engineering Corp. v. Bartell Industries, Inc.*, we explained that where a person of ordinary skill in the art would understand based on the specification that the claims do not set forth what the inventor regards as his invention, the claims are invalid under § 112, paragraph 2. 299 F.3d 1336, 1349 (Fed. Cir. 2002) (rejecting the argument that "perpendicular" would be understood as "parallel" in light of the specification's teachings). In *Trustees of Columbia University in City of New York v. Symantec Corp.*, we held the claims indefinite

because they nonsensically “describe[d] the step of extracting machine code instructions from something that does not have machine code instructions.” 811 F.3d 1359, 1367 (Fed. Cir. 2016). Here, the asserted claims of the ’446 patent are nonsensical and require an impossibility—that the digital media file contain a directory of digital media files. Adopting Synchronoss’s proposal would require rewriting the claims, but “it is not our function to rewrite claims to preserve their validity.” *Allen*, 299 F.3d at 1349. We therefore hold that the claims are indefinite as a matter of law under § 112, paragraph 2. [*Synchronoss Technologies, Inc. v. Dropbox, Inc.*, 2019-2196, 2019-2199 (Fed. Cir. 2/12/2021).]

Mojave Desert Holdings, LLC v. Crocs, Inc., 20-1167 (Fed. Cir. 2/11/2021).

This is a decision on an appeal from PTAB case 95/002,100. The PTAB held the subject claim patentable and denied Mojave’s motion to substitute USA. USA appealed. The Federal Circuit granted the motion to substitute.

Legal issue: PTAB discretion to deny a motion to substitute a successor-in-interest.

The Federal Circuit concluded that the PTAB erred in denying a successor-in-interest’s motion to substitute itself for the named party, despite the fact that the party’s notice of change in real party-in-interest was belated.

We do not read 37 C.F.R. § 41.8(a) as permitting the Board to ignore a transfer of interest in an inter partes reexamination that has been assigned to a successor-in-interest. The purpose of the rule is to detect conflicts of interest and to enable enforcement of inter partes reexamination estoppel provisions. [6] The rule is not directly related to substitution. *** If the Board were permitted to preclude substitution on the basis of a transfer in interest because of a late filing, this would defeat the important interest in having the proper party before the Board. The Board erred by not substituting Mojave as the third-party requester while the inter partes reexamination was pending before the Board. [*Mojave Desert Holdings, LLC v. Crocs, Inc.*, 2020-1167 (Fed. Cir. 2/11/2021).]

Note: 41.8(a) is a mandatory notice provision requiring timely identification of changes in a real party-in-interest, and not a rule limiting the time to move to substitute a party.

Infinity Computer Products V. Oki Data Americas, Inc., 20-1189 (Fed. Cir. 2/10/2021).

This is a decision on an appeal from the D. Del. district court case 1:18-cv-00463-LPS. The district court held the claims invalid for lack of enablement. Infinity appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 112, definiteness, effect of inconsistent arguments.

The Federal Circuit agreed with the district court that the claims were indefinite in view of the plaintiff’s contradictory statements (that the claimed “passive link” did and did not extend from computer port to computer bus.)

Indefiniteness may result from inconsistent prosecution history statements where the claim language and specification on their own leave an uncertainty that, if un-resolved, would produce indefiniteness. *** At first, Infinity argued that a “passive link” does not allow for intervening circuitry, like a fax modem, between the fax machine and the I/O bus of the computer. *** Later, Infinity reversed course. During reexamination, Infinity contended that the passive link was coextensive with the RJ-11 cable in the embodiments of Figures 2b–d—embodiments which do include intervening circuitry (such as fax modems) between the fax machine and the computer’s I/O bus—indeed, within the “box containing the computer” like Perkins’s device 3. *** The public-notice function of a patent and its prosecution history requires that we hold patentees to what they declare during prosecution. *Teva*, 789 F.3d at 1344. But holding Infinity to both positions results in a flat contradiction, providing no notice to the public of “what is still open to them.” *Nautilus*, 572 U.S. at 909. Here, one of ordinary skill cannot determine with any reasonable certainty, for instance, whether or not the claims cover arrangements like the internal-card embodiment of Perkins and the internal-modem embodiments of Figures 2b–d. On the record before us, therefore, we agree with the district court that the intrinsic evidence leaves an ordinarily skilled artisan without reasonable certainty as to where the passive link ends and where the computer begins. [*Infinity Computer Products V. Oki Data Americas, Inc.*, 2020-1189 (Fed. Cir. 2/10/2021).]

Amgen Inc. v. Sanofi, 20-1074 (Fed. Cir. 2/11/2021).

This is a decision on an appeal from the D. Del. district court cases 1:14-cv-01317-RGA, 1:14-cv-01349-RGA; 1:14-cv-01393-RGA; and 1:14-cv-01414-RGA. The district court found the claims lacked enablement. Amgen appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 112, enablement, functional claiming of structures.

The Federal Circuit held that “It is appropriate, however, to look at the amount of effort needed to obtain embodiments outside the scope of the disclosed examples and guidance” in determining whether the claim is enabled.

As the district court noted, the only ways for a person of ordinary skill to discover undisclosed claimed embodiments would be through either “trial and error, by making changes to the disclosed antibodies and then screening those antibodies for the desired binding and blocking properties,” or else “by discovering the antibodies de novo” according to a randomization-and-screening “roadmap.” *Id.* Either way, we agree with the district court that the required experimentation “would take a substantial amount of time and effort.” *Id.* at *12. We do not hold that the effort required to exhaust a genus is dispositive. It is appropriate, however, to look at the amount of effort needed to obtain embodiments outside the scope of the disclosed examples and guidance. The functional limitations here are broad, the disclosed examples and guidance are narrow, and no reasonable jury could conclude under these facts that anything but

“substantial time and effort” would be required to reach the full scope of claimed embodiments. We therefore conclude that, after weighing the *Wands* factors, the court did not err in concluding that undue experimentation would be required to practice the full scope of these claims. [*Amgen Inc. V. Sanofi*, 2020-1074 (Fed. Cir. 2/11/2021).]

***Cxloyalty, Inc. v. Maritz Holdings Inc.*, 20-1307 (Fed. Cir. 2/8/2021).**

This is a decision on an appeal from PTAB case CBM2018-00037. The PTAB determined that the substitute claims were patent eligible under 101, whereas the patented claims were patent ineligible under 101.

Federal Circuit reversed the PTAB’s judgement that the substitute claims were patent eligible.

Legal issue: 35 USC 101, eligibility, meaning of unconventionality.

The Federal Circuit held that mere unconventionality due to mere novelty is insufficient to conclude a claim is patent eligible.

Although this expert testimony invokes the words “well-understood, routine, or conventional,” the type of unconventionality described by Maritz’s expert does not spare the claims. To be sure, a patent claim may be eligible under § 101 if it, for example, “reflects something more than the application of an abstract idea using well-understood, routine, and conventional activities.” *Cellspin*, 927 F.3d at 1315–16 (internal quotation marks omitted). But the expert testimony relied upon by Maritz does not establish that. At most, the testimony describes the claimed subject matter as not conventional only in the sense that the subject matter as a whole was novel. Indeed, novel subject matter is necessarily not well-understood, routine, or conventional. But, as explained previously, our cases are clear that a patent claim is not eligible under § 101 merely because it recites novel subject matter. *See, e.g., SAP*, 898 F.3d at 1163. [*Cxloyalty, Inc. v. Maritz Holdings Inc.*, 2020-1307 (Fed. Cir. 2/8/2021).]

***Chudik v. Hirshfeld*, 20-1833 (Fed. Cir. 2/8/2021).**

This is a decision from on an appeal from the E.D. Va. district court case 1:19-cv-01163-AJT-JFA. The district court held that was no “C” PTA in this case. Chudik appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 154(b)(1)(C), patent term adjustment, delay for successful appellate review.

The Federal Circuit held that the examiner reopening prosecution in response to a notice of appeal did not result in any “C” PTA time, because jurisdiction never passed to the PTAB and no PTAB decision issued.

We now affirm. The statutory language regarding C delay for “appellate review” requires a “decision in the review reversing an adverse determination of patentability.” 35 U.S.C. § 154(b)(1)(C)(iii). That language, we conclude, is

reasonably interpreted—indeed, is best interpreted—to require a reversal decision made by the Board or a reviewing court, thus excluding time spent on a path pursuing such a decision when, because of an examiner reopening of prosecution, no such decision is ever issued. [Chudik v. Hirshfeld, 2020-1833 (Fed. Cir. 2/8/2021).]

M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).

This is a decision on an appeal from PTAB case IPR2018-00696. The PTAB held all claims of the patent unpatentable. M&K, the patentee, appealed. The Federal Circuit affirmed on all claims, except claim 3, and vacated and remanded with respect to claim 3.

Legal issue: 35 USC 102, printed publication, whether something is a printed publication, public accessibility factors.

M&K’s contention was as follows:

M&K contends, however, that the Board erred by concluding that Park and Zhou qualify as printed publications. Specifically, M&K argues that a person of ordinary skill could not have located the Park and Zhou references by exercising reasonable diligence, and thus the Board erred by holding those references to be publicly accessible. [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-11601 (Fed. Cir. 2/1/2021).]

The Federal Circuit’s restated the legal framework:

Whether a reference qualifies as a “printed publication” under section 102 is a legal conclusion based on underlying factual findings. *Jazz Pharms., Inc. v. Amneal Pharms., Inc.*, 895 F.3d 1347, 1356 (Fed. Cir. 2018). We review the Board’s findings on public accessibility for substantial evidence. *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 693 (Fed. Cir. 2018). [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-11601 (Fed. Cir. 2/1/2021).]

Determining whether a reference is a “printed publication” under section 102 involves a case-by-case inquiry into the circumstances under which the reference was disclosed to the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). “[T]he key inquiry is whether or not a reference has been made ‘publicly accessible.’” *Id.* at 1348; *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018) (public accessibility “has been called the touch-stone” in determining whether a reference qualifies as a printed publication). “A reference will be considered publicly accessible if it was ‘disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.’” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed.

Cir. 2016) (quoting *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)). [*M & K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 2020-1160 (Fed. Cir. 2/1/2021).]

One line of cases on public accessibility relates to the presentation of documents at a conference, trade show, or group meeting. *See, e.g., Klopfenstein*, 380 F.3d at 1347–52; *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1369–70 (Fed. Cir. 2000). Another line of cases relates to documents that are available in a repository, whether on the Internet or at a brick-and-mortar location such as a library. *See, e.g., SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008); *In re Wyer*, 655 F.2d 221, 223 (CCPA 1981); *In re Bayer*, 568 F.2d 1357, 1357–62 (CCPA 1978). [*M & K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 2020-1160 (Fed. Cir. 2/1/2021).]

Occasionally, those two lines of cases overlap. *See, e.g., Mass. Inst. of Tech. v. AB Fortia*, 774 F.2d 1104 (Fed. Cir. 1985) (“MIT”). In the MIT case, the reference at issue was presented orally at a conference to between 50 and 500 attendees. *Id.* at 1108. Afterward, copies of the reference were made available to interested persons without restrictions as to confidentiality. *Id.* at 1108–09. This case, like MIT, concerns both oral presentations and publicly available documents. [*M & K Holdings, Inc. v. Samsung Electronics Co., Ltd.*, 2020-1160 (Fed. Cir. 2/1/2021).]

The Federal Circuit observed that the public accessibility, prominence inquiry, related to the channel, not to the reference.

First, M&K argues that although the record established the prominence of JCT-VC’s working-draft documents, it did not show that input documents such as Park and Zhou were equally prominent. That argument misunderstands the Board’s finding of prominence. While a showing that the references themselves were prominent would likely establish public accessibility per se, such a showing is not required. The relevant inquiry is whether the channel through which the references were publicized is prominent or well-known among persons of ordinary skill in the art. *See Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1372 (Fed. Cir. 2019); *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1381 (Fed. Cir. 2012) (upholding district court finding that an interested person of ordinary skill “would have been independently aware of the Risks Digest as a prominent forum And upon accessing the Risks Digest website, such an interested researcher would have found the Benson article using that website’s own search functions and applying reasonable diligence”). Contrary to M&K’s suggestion, the Board found that the JCT-VC organization as a whole was prominent among the community of skilled artisans. *See M & K Holdings*, 2019 WL 4196594, at *15–16, *21–22. That finding is supported by

substantial evidence and bolsters the Board’s ultimate finding that the Park and Zhou references were publicly accessible. [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).]

The Federal Circuit observed that the public accessibility, website inquiry, was whether interested users of the website could have located the reference using reasonable diligence.

The law regarding public accessibility is not as restrictive as M&K suggests—a website’s landing page is not required to have search functionality. Instead, given the prominence of JCT-VC, the dispositive question is whether interested users of the JCT-VC website could have located Park and Zhou through reasonable diligence. *See Infobridge*, 929 F.3d at 1369; *Voter Verified*, 698 F.3d at 1381. The Board found that they could have, and that conclusion is supported by substantial evidence. [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).]

It is also not dispositive that the “All meetings” label does not explicitly describe a document repository. A skilled artisan browsing the JCT-VC website would understand that the website is structured to serve the purpose of the JCT-VC organization, i.e., to develop HEVC standards through member meetings and communications, not to function as a passive digital library. Hence, a skilled artisan browsing the JCT-VC website would realize that documents are hosted under the meeting pages. The Board found that a skilled artisan browsing the JCT-VC website would have known to navigate to the page of the most recent meeting, to search documents on that page, and to continue navigating backward in time until the user’s search was satisfied. *M & K Holdings*, 2019 WL 4196594, at *25. [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).]

The Federal Circuit observed that the public accessibility, indexing inquiry, included whether references were otherwise categorized.

M&K’s argument emphasizing the lack of full-content search capability on the JCT-VC website also misses the mark. A factor relevant to public accessibility is whether a repository indexes its documents or otherwise categorizes them by subject matter. *See Blue Calypso*, 815 F.3d at 1349. The Board found that the documents in question on the meeting pages of the JCT-VC website were effectively indexed by subject matter in light of the title-search functionality and the fact that Park and Zhou featured descriptive titles. That finding supports the Board’s conclusion that Park and Zhou were publicly accessible. *See In re Lister*, 583 F.3d 1307, 1314–17 (Fed. Cir. 2009) (concluding that a reference with a descriptive title was publicly accessible as of the date it was posted to an Internet database on which users “could perform keyword searches of the titles, but not the

full texts, of the works”). [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).]

The Federal Circuit observed that the public accessibility factor did not require proof of actual access.

Contrary to M&K’s suggestion, Samsung was not required to show that interested artisans actually accessed Park and Zhou on the JCT-VC website. *See Infobridge*, 929 F.3d at 1374; *Jazz*, 895 F.3d at 1356 (“[T]here is no requirement to show that particular members of the public actually received the information.” (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988))). Nor was Samsung required to show that Park was uploaded to the website before the development meeting. *See MIT*, 774 F.2d at 1108 (“The Birmingham paper was orally presented Afterward, copies were distributed on request, without any restrictions.” (emphasis added)). [M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., 2020-1160 (Fed. Cir. 2/1/2021).]