MEDTRONIC, INC. v. BARRY, Appeal No. 2017-1169 (Fed. Cir. June 11, 2018) (Taranto, Plager, and Chen). Appealed from the U.S. Patent Trial and Appeal Board.

Background:

Dr. Mark Barry owned two patents, '358 and '072, which cover a method and tool, respectively, for simultaneously spreading corrective derotational forces across multiple vertebrae so as to reduce the risk of vertebrae fracture during derotation. Medtronic petitioned for, and the Board instituted, IPR proceedings for all claims in both patents. In both IPR proceedings, Medtronic challenged the claims over three prior art references relevant to this appeal: (1) '928 Application, (2) a book chapter referred to as "MTOS", and (3) videos and slides that were presented at three conferences.

With respect to the '928 and MTOS, the Board determined that the references did not disclose or would not have rendered obvious the simultaneous derotation of Barry's patents. The '928 Application discloses a method of making small incisions in the skin that are just large enough to insert the portions of a device that engages screws implanted in the vertebrae. MTOS describes placing correcting posts on pedicle screws in the spine and using the posts to apply manipulative force in a spinal derotation procedure. However, the Board determined that the '928 application and MTOS both fail to disclose manipulating multiple posts simultaneously.

With respect to the videos and slides, the Board determined that the videos and slides were not "printed publications" under §102 and therefore did not consider the materials in the Board's prior art evaluations of Barry's patents. Although the videos and slides were presented at three different meetings in 2003, the first meeting was limited to Spinal Deformity Study Group members, and the other two meetings were open only to other surgeons.

Issues/Holdings:

Did the Board err in determining the claims were not obvious over the '928 application and MTOS? No, affirmed.

Did the Board err in determining that the submitted video and slides were not publicly accessible, and thus, not prior art? Yes, vacated and remanded.

Discussion:

First, the Federal Circuit affirmed the Board's finding of non-obviousness because neither reference disclosed the necessary "handle means" that performed the simultaneous rotational functions claimed in the '358 and '072 patents.

Second, the Federal Circuit vacated and remanded the Board's determination that the submitted video and slides were not "publicly accessible" because the Board did not consider all of the relevant factors. The Court outlined six factors used to determine whether materials are sufficiently disseminated to be considered "printed publications": (1) length of time the display was exhibited, (2) expertise of the target audience, (3) the existence of reasonable expectations that the material would not be copied, (4) the ease with which the material displayed could be copied, (5) size and nature of the meetings, and (6) expectations of confidentiality. The Court held that the Board failed to consider the expertise of the audience at the meetings and the expectations of confidentiality regarding the presented materials.

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