

MEDTRONIC, INC. v. BARRY, Appeal Nos. 2017-1169 & 2017-1170  
(Fed. Cir. June 11, 2018). Before Taranto, Plager, and Chen. Appealed from Patent Trial and  
Appeal Board. (Prior Art; Printed Publications)

Background:

Medtronic successfully sought inter partes review of all claims of two of Barry's patents, which were alleged to have been obvious over various combinations of the '928 patent, a book chapter, and a certain video and associated slides. The claims of Barry's patents relate to aligning vertebrae, including simultaneously rotating multiple vertebrae with a single motion using a derotation tool. The '928 patent discloses a tool for moving vertebrae closer or further apart from each other during spinal surgery. The book chapter describes a spinal derotation procedure including multiple separate derotation maneuvers to derotate the spine. The video and slides relating to derotation surgery were presented to spinal surgeons at several industry meetings. The PTAB concluded that the '928 patent and the book chapter did not disclose the simultaneous rotation features recited by the claims, and that the video and slides were not prior art because they were not a publication available to the public. The PTAB held that Medtronic failed to prove that the challenged patent claims were unpatentable.

Issues/Holdings:

1. Did the PTAB err in finding Medtronic failed to prove that the claims of the Barry's patents were unpatentable over the '928 patent and the book chapter? No, affirmed.
2. Did the PTAB err in concluding that the video and slides were not prior art printed publications? Yes, remanded.

Discussion:

With regard to Issue 1, the Federal Circuit noted the lack of disclosure of simultaneous rotation and other features in the '928 patent and the book chapter, the conflicting expert testimony, the absence of any mention of scoliosis or twisting of the spine in the '928 patent, and significant differences between the '928 patent and the disclosure in the book chapter. The Federal Circuit held that there was substantial evidence to support the PTAB's conclusions.

With regard to Issue 2, whether a reference qualifies as a printed publication under 35 U.S.C. §102(b) involves a case-by case inquiry into the facts and circumstances surrounding the disclosure to members of the public. Public accessibility is a touchstone in determining whether or not a reference qualifies as a printed publication. The Federal Circuit surveyed several previous cases involving distribution of materials and identified common considerations relevant to the status of materials that are distributed at conferences. These include the size and nature of the meetings, whether or not they are open to people interested in the subject matter, and whether or not there is an expectation of confidentiality. The Federal Circuit found that the PTAB did not fully consider all of the relevant factors with respect to all of the conferences. In particular, the PTAB was completely silent with respect to two of the conferences at which distribution occurred. Thus, further development in the record is needed, and the Federal Circuit vacated this portion of the PTAB's decision and remanded for further proceedings.