MINERVA SURGICAL, INC. v. HOLOGIC, INC., Appeal No. 2021-2246 (Fed. Cir. February 15, 2023). Before Prost, Reyna, and Stoll. Appealed from D. Del. (Judge Bataillon).

Background:

Hologic sought summary judgment for invalidity of Minerva's patent directed to a surgical device. Hologic argued that the asserted claims were anticipated under the public use bar of pre-AIA 35 U.S.C. § 102(b) because Minerva showcased the device at a tradeshow approximately two years before the priority date.

The district court granted summary judgment finding that the display and demonstration of the device at the tradeshow constituted public use.

Issue/Holding:

Did the district court err in granting summary judgment and holding that the asserted claims were anticipated under the public use bar? No, affirmed.

Discussion:

The Federal Circuit found that the claims were anticipated under the public use bar because the device was "in public use" and was "ready for patenting."

The patented device was "in public use" because the device was accessible to individuals without any obligation of confidentiality during the tradeshow. Minerva showcased fifteen "fully functional" devices for several days at the tradeshow to physicians and investors. The tradeshow was dubbed the "Super Bowl" of the industry by the inventor and was open to the public. Minerva argued that the mere display of the devices at the tradeshow does not constitute public use. The Federal Circuit rejected this argument because attendees were allowed to scrutinize the devices closely and see how they operated. For example, one of Minerva's employees stated the devices were showcased so thoroughly that one device broke. Minerva argued that there was no evidence the attendees physically handled the devices. The Federal Circuit stated this does not matter because public use may occur when a device is used such that a member of the public, without any secrecy obligation, understands the invention. The Court found that detailed feedback from attendees provides an inescapable conclusion that knowledgeable individuals were allowed to scrutinize the invention closely enough to recognize and understand the claimed technology.

Minerva argued there was no disclosure at the tradeshow because the showcased devices lacked a feature of the representative claim, the frame. The Court identified documents from Minerva before and shortly after the tradeshow, showing the claimed feature was developed at that time. The Court then pointed to detailed feedback from attendees to demonstrate that the devices disclosed the claimed feature, as some feedback even highlighted the device's superior frame flexibility, one of the benefits of the claimed feature.

The Federal Circuit also found that the device was "ready for patenting" at that time because prototypes performed their intended purpose. Minerva argued that the device was not ready for patenting because it was not ready for procedures on live patients. However, the Court stated nothing in the intrinsic record of the patent limits its use to live human tissue, and evidence even stated the device was ready for live trials.