



Videos as a Printed Publication in Inter Partes Review



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December 5, 2016

Print Article



Of the several varieties of post-grant challenges created by the Leahy-Smith Americas Invent Act (AIA), challenges under *inter partes* review (IPR) are characterized by the requirement that they be based only on patents and printed publications. See 35 U.S.C. § 311(b). By contrast, in other proceedings such as post grant reviews, the challenge may rely on any form of prior art or any basis for invalidity, including public

prior use.

In a handful of IPRs, the Petitioner has relied on a video, and asserted that the video constitutes a printed publication.

One example is *Intex Recreation Corp. v. Bestway Inflatables & Material Corp.*, IPR2016-00180, which has been instituted but as of this writing has not yet reached a final decision. The patent in *Intex* involved an air purge valve used to discharge excess air from a swimming pool pump system. As part of its challenge, the Petitioner in *Intex* relied on an instructional video, which it asserted had been packaged with sales of its filter pumps. See *Intex*, IPR 2016-00180, Paper No. 1 at page 46 (March 9, 2016). Citing to *In re Wyer*, a 1981 decision from the former CCPA, the Petitioner asserted that the instructional video was a printed publication because it was both “printed” and had been sufficiently disseminated to those of ordinary skill in the art. See *id.*, Paper No. 1 at Page 47.

In *Wyer*, the court determined that a patent application maintained only on microfilm was sufficiently accessible to the public to qualify as a “printed publication.” According to the court, the determination of whether prior art is or is not a “printed publication” is not a two-tiered test involving separate showings that the art is both “printed” and also a “publication.” Rather, the two-tiered approach was rejected in favor of a unitary concept, involving a showing that the prior art had been disseminated and/or otherwise made available and accessible to the interested public.

In its decision on institution, the Patent Trial and Appeal Board (PTAB) conceded that there was considerable dispute as between the Petitioner and the Patent Owner over material facts surrounding public dissemination of the instructional video. It nevertheless instituted on the basis of the video. It reasoned that at the institution stage, it was not necessary to reach the dispute or to resolve it, without a more complete development of the factual record. See *Intex*, IPR 2016-00180, Paper No. 13 at page 13 (June 6, 2016).

Mode of Distribution

One factor raised in these cases is the mode by which the video was distributed. Two different modes can be identified: a first in which the video was actively distributed on a physical medium such as a CD; and a second in which the video was passively accessible as by availability on the internet.

In the *Intex* case, the instructional video was distributed on a CD packaged together with the purchase of pump filters. As such, the instructional video would seem to fall more squarely within the holding of *In re Wyer*.

Wyer is cited at MPEP § 2128, which also relies on other cases to reach a somewhat broader conclusion: that “an on-line database or Internet publication is considered to be a printed publication”. Per MPEP § 2128, a video that is passively accessible on the Internet, such as a YouTube video or a video published on a company website, could constitute a printed publication, so long as *Wyer* is satisfied by producing sufficient proof of dissemination and/or accessibility to the interested public.

One example of such a video is found in *Acco Brands Corp. v. Think Products, Inc.*, IPR2015-01167. The patent in *Acco* involved an anti-theft locking assembly for securing portable electronic devices such as tablet computers and the like. As part of its invalidation challenge, the Petitioner in *Acco* relied on a ClickSave product video said to demonstrate an anti-theft lock for laptops.

According to evidence introduced by the Petitioner, the ClickSave video was viewable by clicking a link on the ClickSave website, which was continuously available to the public for about a year beginning in late 2010. Without any significant discussion of this mode of dissemination, the PTAB concluded that the ClickSave video was a printed publication, citing to *In re Wyer* and MPEP § 2128. See *Acco*, IPR 2015-1167, Paper No. 40 at page 23 (Final Written Decision, October 11, 2016).

Having determined that the ClickSave video was a printed publication, the PTAB then further determined that the video disclosed all limitations of the challenged claims, and invalidated the claims as anticipated. See *id.* at pages 23-24.

Foundation and Proof of Public Accessibility

In light of cases like *Intex* and *Acco*, it appears that the PTAB is willing to accept videos as printed publications, at least under the right circumstances. Those circumstances include, of course, the establishment of a proper foundation of the video, including authentication of the content of the video and dates of dissemination and accessibility. For content, the PTAB, in cases like *Acco*, seems willing to rely on annotations of printed screen shots from the video, such as annotated still frames.

Establishing the degree of the video's public accessibility is often a difficult task, perhaps more difficult than for other — and more traditional — forms of printed publications. An example where public accessibility was not established to the PTAB's satisfaction is found in *Medtronic, Inc. v. Mark A Barry*, IPR 2015-00780.

The patent in *Medtronic* concerned bone screws that are implantable into the pedicle region of individual vertebrae as part of a system for amelioration of aberrant spinal column deviation conditions, such as scoliosis. As part of its invalidation contentions, the Petitioner in *Medtronic* relied on a video entitled "Thoracic Pedicle Screws for Idiopathic Scoliosis," which it asserted it had been distributed on the physical medium of a CD to interested surgeons at a series of professional medical conferences. Citing to *Wyer* and MPEP § 2128, the PTAB agreed with the Petitioner that even though the video might not have been distributed on a physical medium such as CD, the video was not excluded from the scope of § 311(d) simply because it might not be "printed." See *Medtronic*, IPR 2015-00780, Paper No. 51 at page 9 (Final Written Decision, September 7, 2016).

On the other hand, the PTAB disagreed with the Petitioner on accessibility, and determined that the video had not been adequately disseminated so as to satisfy the requirement of accessibility to the interested public. Rather, the PTAB sided with the Patent Owner and

determined that the video was not made available to persons of ordinary skill, but rather only to selected surgeons who qualified through an application and approval process, or to surgeons considered as leaders within their field based on demonstrated excellence. Such surgeons, according to PTAB, were far more qualified than those of ordinary skill. As a result, the PTAB determined that the video was not a printed publication for purposes of the IPR proceeding. See *id.* at pages 9 to 13.

Successful reliance on a video as a printed publication, in the context of an IPR proceeding, would thus seem to require careful explanation of the details for public accessibility and dissemination. In the *Acco* case, in which claims were invalidated using the on-line ClickSave video, the Petitioner provided declaration testimony from a ClickSave director responsible for launching the ClickSave line of computer lock products. The testimony included an explanation of the development of the ClickSave website used to promote the line of computer lock products, an explanation of the content of the website, which included a link to the ClickSave video demonstrating use and functionality of the ClickSave lock, and an explanation of the continuous availability of the ClickSave website to the public for the year beginning in late 2010. See *Acco*, Paper No. 40 at page 16. Taken together, this evidence was persuasive to the PTAB in its determination that the ClickSave video constituted a printed publication.

Only a handful of IPR proceedings have been found in which a video was asserted as a printed publication. With increasing use of on-line video, however, it seems likely there will be more.

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Prizzi's Glory December 5, 2016 9:22 am

Aren't a printed diagram or a printed graphic (including digital and analog pictures as well as printed power point presentations) examples of printed publications?

Once pictures are allowed as printed publications, it is hard to see why a public web video is not a printed publication. After all we used to call videos by the term movies, which is short for moving picture. Movies are to this day also called motion pictures, to wit, pictures with motion. When sound dialogue was first added to movies/moving pictures/motion pictures (initially silent movies used

subtitles of inserted frame titles), the new moving (or motion) pictures with audio dialogue were called talking motion pictures or talking movies (as well as talkies).

Obviously movies whether at the cinemplex or on the web are printed publications. Analog and digital still pictures have generally been printed in books and in other publications. The old analog movie reels consisted of a sequence of printed projection transparencies.

It is somewhat anachronistic terminology today, but movies are often described as distributed to cinemplexes as prints (even if they are really sent out as DVDs).

I can only consider it the height of silliness to propose that something is not a printed publication when it was routinely considered a printed publication before the switch to digital technology that made it possible to include far more information in the printed publication and to distribute it far more easily.

BTW, isn't it obvious that a talking book or audio book that I might purchase at Barnes & Nobles is a printed publication as much as pure text book? The last published Bible (the first Western printed publication) that I purchased came with digital and audio CDs.

To tell the truth, I would consider codices of antiquity to be printed publications. They were printed by hand typically in non-cursive print scripts (usually Roman, Greek, or Square Hebrew/Aramaic letters) essentially on manual assembly lines and distributed or published to target communities via ancient trade networks.