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FEDERAL CIRCUIT SPLIT DECISION ON 'PUBLIC ACCESSIBILITY' OF INTERNET POSTING

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Do Internet postings constitute "printed publications" that are available as prior art under 35 U.S.C. §102(b)? Most practitioners and examiners behave as though this were a settled question. It is not. The Court of Appeals for the Federal Circuit recently addressed this issue in SRI International v. Internet Security Systems and Symantec, 2008 WL 68679 (Fed. Cir. 2008). After much discussion of the principle of "public accessibility," the majority of the panel determined that there was a genuine issue of material fact as to whether a paper that SRI posted on its internet server was a printed publication.

The Case

SRI sued Internet Security Systems and Symantec for infringement of its cyber security and intrusion detection patents. On summary judgment, the district court judge held that SRI's patents were invalid under 35 U.S.C. §102(b) because they were anticipated by SRI's posting of its own unfinished paper, the "Live Traffic" paper, on the SRI Web site. In a 2-1 split panel decision, the Federal Circuit vacated the district court's summary judgment ruling of invalidity based on the Live Traffic paper, finding that there were unresolved issues of fact about the public accessibility of the paper.

'Public Accessibility'

Although public accessibility is not a statutory requirement under 35 U.S.C. §102(b), it has played an important role in defining if and when information has been published. "Because there are many ways in which a reference may be disseminated to the interested public, "public accessibility" has been called the touchstone in determining whether a reference constitutes a "printed publication" bar under 35 U.S.C. 102(b)." In re Hall, 781 F.2d 897, 898-99 (Fed. Cir. 1986). The Federal Circuit has found that a reference is publicly accessible when there is "a satisfactory showing that such document has been 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." Bruckelmyer v. Ground Heaters, Inc., 445 F.3d 1374, 1378 (Fed. Cir. 2006). Moreover, in Hall, the Federal Circuit has stated that the determination of whether a given reference is a printed publication must be approached on a case-by-case basis.

In analyzing public accessibility under §102(b), the Federal Circuit has found public accessibility to be lacking in some cases, yet sufficient in others. For example, in Application of Bayer, 568 F.2d 1357 (C.C.P.A. 1978), the court found that a graduate student's thesis -- which was sent to a university library but had neither been catalogued nor placed on the shelves -- did not constitute a printed publication because it was not reasonably accessible, even to a person who knew it existed. In a similar case, three undergraduate theses had been placed in a library and indexed according to the author's name. The court found no public accessibility because "the only research aid [in finding the theses] was the student's name, which, of course, bears no relationship to the subject of the student's thesis." In re

Cronyn, 890 F.2d 1158, 1161 (Fed. Cir. 1989).

On the other hand, in In re Wyer, the court found an Australian patent application that was "properly classified, indexed or abstracted" was sufficient to enable public accessibility. In re Wyer, 655 F.2d 221, 226-27 (C.C.P.A. 1981). Furthermore, in In re Klopfenstein, 380 F.3d 1345 (Fed. Cir. 2004), the court found that posters displayed at professional conferences were sufficiently publicly accessible to be printed publications because the main purpose of the posters was to communicate information to the interested public.

The Court's Findings

In the SRI International opinion, the Federal Circuit determined that the facts lay somewhere between those in Bayer and Klopfenstein: "Like the uncatalogued thesis placed 'in' the library in the Bayer case, the Live Traffic paper was placed 'on' the [SRI]... server. Yet, the... server did not contain an index or catalogue or other tools for customary and meaningful research." The court noted that only one non-SRI person specifically knew about the availability of the Live Traffic paper, and questioned the ability of members of the public to effectively search for the paper. In fact, "[t]he Live Traffic paper was not a finished thesis, but was posted on the... server solely to facilitate peer review in preparation for later publication." Although actual retrieval of a publication is not a requirement for public accessibility, the court found that the record did not demonstrate that the Live Traffic paper was accessible to anyone other than the peer-review committee, thus further suggesting an absence of public accessibility.

Nonetheless, like the posters in Klopfenstein, the Live Traffic paper was "posted" on an open Internet server and might have been accessed by anyone who knew how to use the internet. Unlike the Klopfenstein posters, however, the majority of the panel found that the Live Traffic paper was not in fact publicized or displayed to the interested public: "[i]n effect, the Live Traffic paper on the... server was most closely analogous to placing posters at an unpublicized conference with no attendees." Thus, the majority determined that the Live Traffic paper fell on the Bayer side of no public accessibility rather than on the Klopfenstein side of public accessibility. Consequently, the district court's summary judgment ruling of invalidity based on the Live Traffic paper was vacated.

The lone dissenter in SRI International chided SRI on procedural grounds for failing to present any evidence showing a genuine issue of material fact, instead relying merely on attorney argument. Substantively, the dissent agreed with the district court's finding that the evidence demonstrated the public accessibility of the Live Traffic paper. Moreover, the dissent argued that the majority's conclusions were based on unsupported facts and that the defendants had indeed carried their burden on summary judgment.

Conclusion

What can we take away from SRI International? There is little doubt that an Internet posting can be construed as a printed publication and a bar to patentability under 35 U.S.C. §102(b). The key is whether the Internet posting, or "publication," is publicly accessible. Postings that are indexed and catalogued or that can be easily searched by the interested public are likely to be found to be sufficiently publicly accessible to be printed publications. Those that are simply placed on an Internet server without being publicized or made reasonably searchable may not be found to be printed publications and thus may not qualify as prior art. Of course, in the age of the ever-widening information super-highway, the safest bet remains not to "post" until post-filing.

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