

Kratz, Quintos & Hanson, LLP – IP Newsletter

THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT FINDS “PUBLIC ACCESSIBILITY” OF REFERENCES TO QUALIFY THE REFERENCES AS “PRINTED PUBLICATIONS” UNDER U.S. PATENT LAWS

Please look forward to the warmer weather the spring season will bring next month.

By: Mel R. Quintos

Introduction This Newsletter is directed to the case of *M&K Holdings, Inc. v. Samsung Electronics Co., Ltd.* (decided on February 1, 2021), which is an appeal to the U.S. Court of Appeals for the Federal Circuit (“CAFC”) from a U.S. PTO Patent Trial and Appeal Board (“Board”) decision of an *inter partes* review proceeding of U.S. Patent 9,113,163 (“the ‘163 patent”) owned by M&K Holdings. Samsung Electronics challenged the claims of the ‘163 patent as unpatentable. The ‘163 patent is directed to an efficient method for compressing video files. The Board held all claims of the ‘163 patent unpatentable. M&K argues, among other things, that the Board erred by relying on references that do not qualify as prior art printed publications because some of the references relied upon by Samsung Electronics were not publicly accessible.

The issue in this case is whether the references cited by Samsung Electronics against the ‘163 patent were publicly accessible and therefore qualify as printed publications under 35 U.S.C. §102 or §103.

Facts In filing its petition for *inter partes* review, Samsung Electronics relied upon references referred to as “WD4-v3,” Park, and Zhou. These references:

were generated in connection with the work of a joint task force to establish industry standards for high-efficiency video coding (“HEVC”). The task force, known as the Joint Collaborative Team on Video Coding (“JCT-VC”), consists of representatives from technology companies, universities, and research institutions. JCT-VC holds quarterly meetings at which members submit and discuss input documents that propose changes to the HEVC standards. If the JCT-VC members agree to the proposed changes, those changes are incorporated into a working-draft document. **WD4-v3 is a working-draft document, while Park and Zhou are input documents. All three references were uploaded to JCT-VC’s website before the December 13, 2011 priority date of the ‘163 patent.**

M&K did not take issue with Samsung Electronic’s contention that the claims are unpatentable based on the cited references, and did not dispute that the WD4-v3 reference was publicly accessible before the priority date of the ‘163 patent. M&K instead argued that the Park and Zhou references do not qualify as printed publications because a person of ordinary skill in the art could not have located these references by exercising due diligence.

Full copies of input documents, including the Park and Zhou references, were made available to persons prior to attending the JCT-VC meetings, which were attended by between 200 and 300 persons. The distribution of the references to the attendees was accomplished by uploading the references to the JCT-VC website, pursuant to JCT-VC policy, prior to the meetings “to ensure that [they are] available for review by other participants.” Moreover, the Board “found that the JCT-VC website had title-search functionality and that the Park and Zhou references had descriptive titles, thus enabling routine searching of those references by subject matter.”

Analysis In determining whether a reference is a “printed publication,” the CAFC sets forth the following tests. *First*, “the key inquiry is whether or not a reference has been made publicly accessible.” *Second*, “[a] reference will be considered publicly accessible if it was ‘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.’” The CAFC addressed the following M&K arguments in support of its position that skilled artisans could not have accessed the Park and Zhou references with due diligence.

Prominence

M&K argues that although the WD4-v3 (a JCT-VC working draft document) was prominent, the Park and Zhou references were not equally prominent, and were therefore not readily accessible. The CAFC rules that “[t]he relevant inquiry is whether **the channel through which the references were publicized** is prominent or well-known among persons of ordinary skill in the art.” In this case, the JCT-VC organization, which publicized the Park and Zhou references, was itself “prominent among the community of skilled artisans.”

Website’s Structure and Search Capabilities

M&K argues that there was no public access to the Park and Zhou references because the structure and search capabilities of the JCT-VC website require that users click on an “All meetings” link and select a particular meeting in order to access JCT-VC documents. The CAFC rules that “[t]he law regarding public accessibility is not as restrictive as M&K suggests—a **website’s landing page is not required to have search functionality**.” The court further rules that a relevant factor in determining document accessibility in a website is “whether a [website] repository indexes its documents or otherwise categorizes them by subject matter.”

Proof that Interested Artisans Accessed References and References Were Presented at Meetings

Contrary to M&K’s position, the CAFC rules that “Samsung was not required to show that interested artisans actually accessed Park and Zhou on the JCT-VC website.” The court also holds that “even if the presentations did not disclose the exact material relating to Samsung’s obviousness theories, that would not be fatal to the public accessibility of Park and Zhou, because the oral presentations were supplemented by JCT-VC’s publishing Park and Zhou in its document repository. * * * **the public accessibility of Park and Zhou does not depend solely on the comprehensiveness of the oral presentations.**”

CAFC Decision Affirms the Board’s decision of unpatentability. Persons of ordinary skill in the video-coding technology could have accessed Park and Zhou with reasonable diligence through the JCT-VC organization.

Washington D.C. Office:
4th Floor
1420 K Street, N.W.
Washington, DC 20005
U.S.A.
Tel: 202.659.2930
Fax: 202.962.0011
correspondence@kqhpatentlaw.com
www.kqhpatentlaw.com

Tokyo Liaison Office:
21st Floor
Shin-Marunouchi Center Building
1-6-2 Marunouchi, Chiyoda-ku
Tokyo, JAPAN 100-0005
Tel: 03.3216.7188
Fax: 03.3216.7210

DISCLAIMER: This information is intended to provide general information only and should not be construed as a legal opinion or as legal advice. Our firm disclaims liability for any errors or omissions. This newsletter does not establish any form of attorney-client relationship with our firm or with any of our attorneys or agents. Thank you.