

Nobel Biocare Services AG v. Intradent USA, Inc. – When is a Printed Publication Publicly Available?

On September 13, 2018, the Federal Circuit affirmed the final written decision of the Patent Trial and Appeal Board in an *inter partes* review filed by Intradent USA, Inc., in which the PTAB determined claims 1-5 and 19 of Nobel Biocare Services AG's U.S. Patent No. 8,714,977 were unpatentable as anticipated by a catalog prepared by Alpha-Bio Tech Ltd. (the ABT Catalog).

Background

The '977 patent claims a dental implant. Under the PTAB's claim construction, it was undisputed that the prior art ABT Catalog taught the limitations of all IPR claims, except claim 2. However, Nobel did dispute whether Intradent had met its burden of establishing that the ABT Catalog was a "printed publication" under 35 U.S.C. § 102 of the pre-Leahy-Smith America Invents Act.

The critical date for the '977 patent was May 23, 2003. The ABT Catalog bore the date "March 2003," but Nobel disputed that the ABT Catalog was publicly available at that time. Public availability is a requirement for a reference to qualify as a printed publication under 35 U.S.C. § 102.

The ABT Catalog and the ITC Proceedings

Alpha-Bio Tech Ltd. (ABT) was acquired by Nobel in 2008. One of the named inventors of the '977 patent, Dr. Ophir Fromovich, had founded and served as the CEO of ABT.

On October 27, 2014, based on a complaint filed by Nobel, the International Trade Commission instituted an investigation into whether Intradent's importation of certain dental implants infringed, *inter alia*, the '977 patent.

According to the Federal Circuit opinion, during the ITC proceedings, when Dr. Fromovich was asked why the ABT Catalog bore the date "March 2003," Dr. Fromovich "estimated" it was because "in the end of March 2003, normally it's [the International Dental Show] in Cologne, Germany, [which] is a big exposition. And in this exposition we go in looking for distributor[s]." Dr. Fromovich also testified that ABT had a small booth at the March 2003 IDS conference and that he attended the conference. He further testified that he did not recall whether he brought copies of the ABT Catalog to the IDS conference but, if he had brought copies, it was his belief that he would have brought only a "small amount" (estimated by Dr. Fromovich as possibly 200-500 copies) because it would have been the first version of a 62-page document and, as ABT did not ship documents to the IDS conference, Dr. Fromovich would have had to have carried the catalogs in his luggage. Dr. Fromovich also acknowledged that if he had brought the ABT Catalog to the conference, it would have been provided to conference attendees without requiring them to sign a confidentiality agreement.

Based on the above testimony, on October 27, 2015, the ITC's Administrative Law Judge issued an Initial Determination finding claims 1-5 and 19 of the '977 patent anticipated by the ABT Catalog. On May 11, 2016, however, the ITC issued a Commission Opinion finding that Intradent had failed to show by clear and convincing evidence that the ABT Catalog was prior art to the '977 patent, i.e., it found that the testimony failed to establish by clear and convincing evidence that the ABT Catalog was, in fact, available at the IDS conference. On July 19, 2017, the Federal Circuit affirmed the Commission Opinion.

The ABT Catalog and the IPR Proceeding

During the IPR proceeding, in addition to the above ITC testimony, which was made of record, the



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Related Practice Areas

- Intellectual Property

PTAB also received evidence including declarations and deposition testimony of Yechiam Hantman and Zvi Chakir, who in March 2003 co-owned an Israeli dental supply distributor, Chakir Implants, Ltd. Mr. Hantman testified that “it was a specific goal of mine to collect materials from the March 2003 IDS trade show describing the SPI implant [the dental implant described in the ABT Catalog].” Because Mr. Hantman was unable to attend the conference, he requested that Mr. Chakir collect competitor catalogs for him. In the IPR proceeding, Mr. Hantman submitted a declaration in which he stated that: “Based upon my review of the attached materials and my specific recollections of conversations with customer [sic] in later 2002 and early 2003, and examination of the 2003 [ABT] Catalog after receiving it after the IDS trade show, I am certain that the 2003 [ABT] Catalog was publically accessible to the dental industry, including competitors, in March 2003, after the IDS show that year.”

Mr. Chakir submitted a declaration in the IPR proceeding in which he stated that he “collected catalogs and other materials from competitors ... including [ABT]” at the 2003 IDS conference and “gave the materials relating to dental implants to Mr. Hantman upon [his] return.” At deposition, Mr. Chakir testified that the 2003 IDS conference was the only time he collected dental implant brochures (because, according to Mr. Chakir, he had no personal interest in dental implants; he only collected the brochures at Mr. Hantman’s request) and that he did not recall the specific brochures he collected during the 2003 IDS conference. Mr. Chakir further testified that anyone could have collected brochures during the IDS conference because the brochures were not confidential.

Based on the above evidence, the PTAB determined that Intradent had established by a preponderance of the evidence that the ABT Catalog was prior art to, and anticipated, the ‘977 patent claims that were the subject of the IPR proceeding.

The Federal Circuit Decision

Before reaching the merits of the case, the Federal Circuit addressed two preliminary issues: (1) whether the Federal Circuit lacked jurisdiction over the appeal because the PTAB had not addressed all of the claims challenged in the IPR petition; and (2) whether the Federal Circuit was bound by its prior affirmance of the ITC decision finding that Intradent failed to establish that the ABT Catalog anticipated the ‘977 patent claims.

First, the Federal Circuit confirmed that even though the Supreme Court had held in *SAS Institute, Inc. v. Iancu* that the PTAB cannot institute an IPR proceeding on less than all of the claims challenged in an IPR petition, the Federal Circuit had jurisdiction to consider the appeal. The Federal Circuit found that the PTAB’s error in failing to address all claims challenged in the IPR petition had been waived because neither party had raised the issue on appeal, and the court saw no reason why it should remand the case *sua sponte*.

Second, the court concluded that its prior affirmance of the ITC’s judgment was not binding because: (1) the preponderance of the evidence standard in the PTAB proceeding was different than the higher clear and convincing evidence standard in the ITC proceeding; and (2) the PTAB was presented with evidence on the publication issue that was not considered by the ITC.

The court then turned to the merits of the appeal, beginning its analysis by reiterating well-known Federal Circuit law that provides the framework for determining whether a reference qualifies as a printed publication under 35 U.S.C. § 102(b):

The parties dispute whether the ABT Catalog qualifies as a “printed publication” under pre-AIA § 102(b). Whether a reference qualifies as a “printed publication” is a legal conclusion based on underlying factual findings. The underlying factual findings include whether a reference was publicly accessible. 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.” 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. Whether a reference is publicly accessible is determined on a case-by-case basis based on the facts and circumstances surrounding the reference’s disclosure to members of the public.

(citations and internal quotations omitted).

Using this framework as a guide, the Federal Circuit determined that substantial evidence supported the PTAB's decision that the ABT Catalog was publicly available as of March 2003. According to the court, the PTAB reasonably credited the following evidence presented during the IPR proceeding:

- Mr. Chakir's and Mr. Hantman's testimony that Mr. Chakir obtained a copy of the ABT Catalog at the March 2003 IDS Conference and that Mr. Hantman retained that copy in his records thereafter.
- Mr. Hantman's declaration, which included excerpts of his copy of the ABT Catalog.
- Mr. Hantman's copy of the ABT Catalog and the copy offered as prior art by Intradent in the IPR had identical pages (with the exception of handwriting on the cover of Mr. Hantman's copy).
- Messrs. Hantman and Chakir provided specific details as to why Mr. Chakir collected dental implant brochures for Mr. Hantman at the March 2003 IDS Conference.
- Mr. Hantman provided specific details as to why he remembers the circumstances under which he received the ABT Catalog.
- The ABT Catalog has the date "March 2003" on its cover.¹

The court agreed that the above evidence was substantial and supported the PTAB's finding that the ABT Catalog was publicly accessible as of March 2003 and, therefore, an invalidating printed publication under 35 U.S.C. § 102(b).

The Federal Circuit then dismissed Nobel's final argument, i.e., that there was insufficient evidence of corroboration.² Agreeing with the PTAB, the court found that the testimony of Messrs. Hantman and Chakir was sufficiently corroborated not only by each other, but also by the actual copy of the ABT Catalog, which bore a March 2003 date, and Dr. Fromovich's testimony that ABT operated a booth at the March 2003 IDS conference.

Conclusion

This case provides guidance on how a party seeking to use a publication as prior art can establish when that publication became publicly available, which is the paramount requirement for establishing the date on which the printed publication qualifies as prior art. Though this case deals with a patent application filed before enactment of the America Invents Act, there is no reason to believe the result would be any different under the AIA.

To discuss any questions you may have regarding the issues discussed in this Alert please contact Martin Pavane at (212) 883-4994 or mpavane@cozen.com or Darren Mogil at (212) 883-4976 or dmogil@cozen.com.

¹ The Federal Circuit noted that "[a]lthough the ABT Catalog's date is not dispositive of the date of public accessibility, its date is relevant evidence that supports the Board's finding of public accessibility at the March 2003 IDS Conference."

² As the court explained, "corroboration is required of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest." *Finnigan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354, 1369 (Fed. Cir. 1999)."