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Two Recent Federal Circuit Opinions Illustrate Risk of Product Demonstrations for Patent Validity

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Section 102 of the Patent Act holds that an invention may not be patented if it was in public use before the effective filing date of the patented invention.[1] The public use bar to patenting is triggered if the invention is both "in public use" and "ready for patenting."[2] US Court of Appeals for the Federal Circuit precedent holds that an invention is in public use if it is "accessible to the public or commercially exploited."[3] Put another way, an invention is in public use if it is "shown to or used by an individual other than the inventor under no limitation, restriction, or obligation of confidentiality."[4]

Courts also look to contextual factors, such as "the nature of and public access to activities involving the invention [and] confidentiality obligations imposed upon observers."[5] An invention is "ready for patenting" when either the subject matter of the claimed invention is in the possession of the inventor and known to work for its intended purpose, which can be shown by the existence of a working prototype, or the inventor has prepared drawings or other descriptions of the invention that are specific enough to enable a skilled artisan to practice the invention.[6]

Importantly, depending on the nature of the invention, the "mere display" of a prototype or sample may not constitute an invalidating public use. For example, the display of a later-patented new keyboard design was not a public use because the public was only provided with a visual view of the keyboard without any disclosure of the technology that actually sought to be patented, which involved data entry using the keyboard.[7] On the other hand, it is not a requirement that inventors physically handle or operate the invention on display; all that is required is that the inventor use the invention in public such that a skilled observer who is not under any confidentiality obligation can understand the invention.[8]

An invention also can be considered ready for patenting even if it is still undergoing testing or improvement.[9] For example, Food and Drug Administration (FDA) approval of an invention is not a prerequisite for considering a therapeutic invention ready for patenting.[10] All that is necessary is that the inventor was in possession and knew the invention to work, or had prepared documentation sufficient to enable a skilled artisan to practice the invention.

Minerva v. Hologic: When is a product demo of a medical device invalidating?

Minerva Surgical, Inc. v. Hologic, Inc. serves as a potent reminder of both the "in public use" and "ready for patenting" prongs of the public use bar.[11] In this case, patentee Minerva owned a patent directed to an endometrial ablation device that stops or reduces abnormal uterine bleeding. More than one year before the effective priority date of the patent, Minerva showcased "15 fully functional" devices at a public trade show. After the trade show, Minerva continued to refine the device, but the devices it showcased were working prototypes of the claimed invention. The district court granted summary judgment, holding that Minerva's patent was invalid for prior public use.

On appeal, Minerva made two arguments on "in public use." Minerva argued that demonstration of the device at the trade show was "mere display," and that because the showcased device lacked a key limitation of the patent claim at issue, it had not disclosed "the invention."

The court rejected both arguments. On the first, it found that Minerva showcased the devices over several days at the "Super Bowl" of the industry, where sophisticated industry members –who were under no obligation of

confidentiality – were permitted to closely scrutinize the device. These events exceeded "mere display." And, contrary to Minerva's position, the court found that evidence of "handling" of the device was not required; instead, all that was required was disclosure in a way that at least one member of the public, without any obligations of confidentiality, would understand it. On Minerva's second argument, the court found that Minerva documents from before and after the trade show described the device with the key feature, while feedback Minerva received from the trade show further established that the disclosed device likely had that feature.

Minerva also argued that the disclosed device was not "ready for patenting," both because it did not yet function for its intended purpose of ablation in "live human" uteri and because Minerva was continuing to refine it with better materials since the time of the trade show. Again, the court disagreed, noting that the "ready for patenting" standard is not as exacting as FDA approval for use in humans, and that "fine-tuning" of an invention does not preclude that the showcased working prototypes were "ready for patenting." Moreover, Minerva documents – including drawings and detailed descriptions in lab notebooks – were sufficiently specific to enable a skilled artisan to practice the invention.

Patentees and patent challengers should heed the lessons of Minerva for display of patented inventions at conferences and trade shows. While the court did not draw precise boundaries between activities that rise to "public use" versus "mere display," disclosures that lack obligations of confidentiality and permit skilled artisans to understand the invention may be invalidating. And, an invention may be ready for patenting even if the patentee continues to fine-tune the invention.

In re Wingen: When is disclosure of ornamental plants invalidating?

The public use bar can be especially consequential in the world of agriculture, which often involves "trialing" and other potentially public demonstrations of plants and crops, including ornamental flowers. In the case of *In re Wingen*,[12] a utility patent reissue application for the "Cherry Star" variety of petunia was rejected on the basis of public use of the patented variety at a "Proven Winners" demonstration event at Home Depot more than one year before the filing date of the application. Although event attendees were not permitted to take cuttings, seeds or plant tissue samples of Cherry Star, and further were not provided with genetics or breeding history information, they also were under no obligation of confidentiality as to what they saw.

There was no dispute that Cherry Star was "ready for patenting" by the time of the event, thus Wingen was left with only the argument that the Home Depot demonstration did not qualify as an invalidating public use. Wingen argued that mere display of the plant itself did not put all claimed features of the invention in public use, because aspects that are not observable to the naked eye – such as plant genetics – were not made available to attendees. Without this information, Wingen argued, a member of the public could not exploit or recreate the Cherry Star variety. Wingen relied on the only Federal Circuit authority concerning public use of a plant variety, *Delano Farms Co. v. Cal. Table Grape Comm'n*, which held that pre-filing growth of a later-patented grape variety was not public, in part because the grapes were not labeled and thus could not be recognized by the public as the patented variety.

The court disagreed with Wingen, arguing that the cases were distinct, in part because the Cherry Star variety was clearly labeled as such at the Home Depot event, including in an advertisement with the name and photo of the variety. The court also distinguished Delano Farms on the basis that petunias are purely ornamental, while grapes are not – meaning that in this case, the petunias were put into public use for their ultimate intended purpose, namely ornamental display.

Wingen maintained its argument that the public still did not have sufficient access to the invention to be put "in possession" of it. Without the undisclosed genetics or breeding history, Wingen argued, the public could not recreate Cherry Star, as attendees were prevented from taking parts of the plants themselves. The court refused to address this issue, however, because Wingen failed to "meaningfully present" the argument and thus forfeited the ability to make that argument.

Thus, this nonprecedential Federal Circuit opinion leaves unaddressed the important question of how an ornamental plant developer can participate in demonstration events without risking the ability to later patent the plant, even if they take appropriate steps to prevent demonstration attendees from taking samples of the plant material or learning the necessary genetics or breeding information that would be required to actually exploit or recreate the variety. Patent applicants and litigants can learn from this decision how to challenge or protect

intellectual property based on prior displays of ornamental flowers – and how (and when) to muster relevant evidence to prove those allegations.

Notes

1. The 2011 America Invents Act modified the text of 35 USC § 102 to remove the "more than one year" safe harbor for pre-filing public uses, but it did not otherwise materially change the substantive law with respect to the public use bar to patentability. See generally *Helsinn Healthcare S.A. v. Teva Pharmaceuticals, USA, Inc.*, 139 S.Ct. 628 (2019) and this January 2019 Cooley client alert on the Helsinn case.
2. *Polara Eng'g Inc. v. Campbell Co.*, 894 F.3d 1339, 1348 (Fed. Cir. 2018).
3. *Delano Farms Co. v. California Table Grape Comm'n*, 778 F.3d 1243, 1247 (Fed. Cir. 2015); *Dey, L.P. v. Sunovion Pharms., Inc.*, 715 F.3d 1351, 1355 (Fed. Cir. 2013).
4. *Am. Seating Co. v. USSC Grp., Inc.*, 514 F.3d 1262, 1267 (Fed. Cir. 2008).
5. Id.
6. *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67-68 (1998); *Helsinn Healthcare S.A. v. Teva Pharms., USA, Inc.*, 855 F.3d 1356, 1372 (Fed. Cir. 2017); *Hamilton Beach Brands, Inc. v. Sunbeam Prods., Inc.*, 726 F.3d 1370, 1379 (Fed. Cir. 2013).
7. *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376 (Fed. Cir. 2007).
8. *Netscape Commc'ns Corp. v. Konrad*, 295 F.3d 1315, 1319-21 (Fed. Cir. 2002).
9. *Atlanta Attachment Co. v. Leggett & Platt, Inc.*, 516 F.3d 1361, 1367 (Fed. Cir. 2008).
10. *Helsinn Healthcare*, 855 F.3d at 1372-73.
11. *Minerva Surgical, Inc. v. Hologic, Inc.,* Case No. 2021-2246 (Feb. 15, 2023).
12. *In re Wingen LLC*, Case No. 2021-2322 (Feb. 2, 2023) – nonprecedential opinion.

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