

Invention Prototypes Displayed at Industry Trade Shows May Preclude Patent Protection

By Daniel J. Melman

In a precedential decision issued on February 14, 2023, the United States Court of Appeals for the Federal Circuit clarified the “public use” bar to patentability. *Minerva Surgical, Inc. v. Hologic, Inc. et al.* (2021-2246). The appellate court affirmed a lower court’s summary judgment ruling that invalidated Minerva’s patent based on Minerva’s display of a prototype gynecologic device at an industry expo more than one year before the patent’s priority date.

Minerva’s patent, directed to “endometrial ablation” for stopping or reducing abnormal uterine bleeding, was filed on November 2, 2012, and claimed a priority date of November 7, 2011. Since Minerva’s patent was filed before March 16, 2013, the pre-America Invents Act (AIA) version of the patent statute regarding the conditions for patentability applied in this case.

Under the pre-AIA public use bar, “a person shall be entitled a patent unless . . . the invention was . . . in public use . . . in this country, more than one year prior to the date of the application for patent in the United States.” As the Federal Circuit noted, the public use bar is triggered “where, before the critical date [(i.e., more than one year before the priority date)], the invention is [(1)] in public use and [(2)] ready for patenting.”

In the district court, the defendants were awarded judgment as a matter of law that the relevant claims of Minerva’s patent were anticipated under the public use bar of the pre-AIA of Section 102(b) of the patent statute. The district court found that, in 2009, Minerva displayed its “Aurora” device, which disclosed every limitation of the asserted patent claims, at the 38th Global Congress of Minimally Invasive Gynecology sponsored by the American Association of Gynecologic Laparoscopists (AAGL 2009). Minerva also gave a presentation, and distributed a brochure of the Aurora device, and made a pitch to a potential acquirer. Therefore, the district court determined that Minerva’s 2009 activities invalidated its patent.

On appeal, Minerva argued that the disclosure of the Aurora device at AAGL 2009 did not qualify as an invalidating “public use” for a number of reasons including:

- it “merely displayed” the device
- there was no disclosure of the invention because the Aurora device disclosed at AAGL 2009 lacked a key claim limitation or feature; and
- the invention was not “ready for patenting” because Minerva was still improving the technology at the time of AAGL 2009.

The Federal Circuit addressed and rejected each of these arguments.

Citing its precedent, the court reiterated that “the ‘in public use’ element of the bar is met if the invention was accessible to the public or was commercially exploited by the inventor.” Considering the “nature of and public access” of Minerva’s activities involving its Aurora device, the Federal Circuit found that:

“AAGL 2009 was the Super Bowl of the industry and was open to the public. It included attendees who were critical to Minerva’s budding business—such as potential investors and physicians—and Minerva had every incentive to showcase the Aurora devices to these attendees as best as it could. The record shows that Minerva brought 15 fully functional Aurora devices to AAGL 2009. And Minerva’s disclosure of

these fifteen devices spanned several days and included Minerva showcasing them at a booth, in meetings with interested parties, and in a technical presentation.”

The Federal Circuit distinguished Minerva’s cited prior caselaw in which an inventor’s display of his patented keyboard to various third parties did not rise to the level of a “public use.” *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376 (Fed. Cir. 2007). The court noted that in *Motionless Keyboard*, the disclosures “only provided a visual view of the new keyboard design without any disclosure of the claimed technology, which involved entering data into a system.” In contrast here:

“Minerva’s disclosure at AAGL 2009 went well beyond that at issue in *Motionless Keyboard*. At AAGL 2009, as evidenced by the records of the event (such as the feedback Minerva documented), Minerva pitched the Aurora device to various sophisticated industry members, who were allowed to scrutinize the Aurora device closely and see how it operated.”

Further, the Federal Circuit dismissed Minerva’s dispute with the district court’s finding that attendees observed and physically handled the Aurora device as irrelevant:

“Regardless of whether the Aurora devices were closely observed or physically handled, our standard for disclosure rising to the level of public use is not predicated on a device being physically handled by the public. Rather, public use may also occur where, as here, the inventor used the device such that at least one member of the public without any secrecy obligations understood the invention. The inescapable conclusion of the detailed feedback Minerva received on the Aurora device is that Minerva allowed knowledgeable individuals to scrutinize the invention enough to recognize and understand the... technology Minerva later sought to patent.”

As for Minerva’s argument that the Aurora devices shown at AAGL 2009 did not disclose a key claim limitation or feature, the Federal Circuit observed that “Minerva’s documentation about the Aurora device from before and shortly after the event expressly discloses the Aurora device having the [feature] or touts benefits that are derived from the device having the [feature].” Additionally, “the record establishe[d] that it was this device disclosing the [feature] that Minerva brought to AAGL 2009” and Minerva brought “fully functional” devices to AAGL 2009.

The Federal Circuit also rejected Minerva’s arguments that the invention was not ready for patenting at the time of AAGL 2009 because: “(1) Minerva reduced the invention to practice and (2) Minerva had enabling documentation describing the invention.” On the first point, “Minerva reduced the invention to practice by creating working prototypes that embodied [the claimed invention] and worked for the intended purpose of performing endometrial ablations.”

The court was unpersuaded by Minerva’s assertion that it “was still working to improve the Aurora device at the time of AAGL 2009” and that the Aurora device did not function to perform ablations on “live human” uteri. “Contrary to Minerva’s argument, our case law does not require imposing the ‘live human’ requirement here. Minerva points to nothing in the intrinsic record indicating that the ... patent is limited to devices only usable on live human tissue.” In any event, the record showed that “the Aurora device would be considered acceptable for use in clinical trials on live humans.”

As for Minerva’s later improvements to the invention, the Federal Circuit held that these amounted to “mere later refinements or fine turning which are more that reduction to practice requires.”

Lastly, in addition to being reduced to practice, “there was documentation sufficiently specific to enable a person skilled in the art to practice the invention . . .” at the time of AAGL 2009. “This documentation include[d] drawings

and detailed descriptions in the 2009 lab notebook pages disclosing a device with the [key invention feature].” Accordingly, the Federal Circuit affirmed the district court’s summary judgment ruling.

TAKEAWAY

Although the Federal Circuit’s decision in *Minerva* applied the pre-AIA version of the patent statute, the public use provision under the AIA has the same substantive scope. Therefore, the court’s analysis likely would apply equally to patents governed by the AIA. Thus, the *Minerva* decision should serve as a continuing cautionary reminder that individuals and entities seeking to display and demonstrate new and innovative technology at trade shows or similar public events must remain vigilant and cognizant about the status of their patent filings.

Likewise, parties considering or involved in litigation should investigate and remain on guard for potential trade show activities rising to the level of invalidating prior uses.