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Two Federal Circuit Rulings Clarify the Standard for Preliminary Injunction Motions and the Use of Online References as Prior Art

Intellectual Property Client Alert

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In two recent cases, the Federal Circuit discussed the standard to apply in deciding whether to grant a preliminary injunction for patent infringement and when an online reference may be used as prior art to invalidate a patent.

Preliminary Injunctions

In the first decision, the Federal Circuit vacated a District Court ruling that applied the Second Circuit's standard to a preliminary injunction motion, holding that the Federal Circuit's less stringent standard applies in patent infringement cases. *Revision Military Inc. v. Balboa Mftg. Co.*, Case No. 2011-1328 (Fed. Cir. Nov. 27, 2012) (available [here](#)).

Revision moved the Vermont District Court for a preliminary injunction to block Balboa from selling its Bravo goggles, which Revision claimed infringed two of its design patents. The trial court denied Revision's motion, applying the Second Circuit's heightened preliminary injunction standard, cited in *Doninger v. Niehoff*, 527 F.3d 41 (2d Cir. 2008), which requires a movant to demonstrate "clear" or "substantial" likelihood of success on the merits when seeking "an injunction that will alter rather than maintain the status quo." *Id.* at 47. The court applied the heightened standard because Balboa was already selling the allegedly infringing goggles, thus a preliminary injunction would alter Balboa's status.

The Federal Circuit rejected the application of the Second Circuit's more stringent standard, holding that Revision need only meet the Federal Circuit's standard of whether success was more likely than not. In so holding, the Court noted that "[s]ubstantive matters of patent infringement are unique to patent law, and thus the estimated likelihood of success in establishing infringement is governed by Federal Circuit law."

This decision clarifies the standard for parties who seek to obtain a preliminary injunction in patent infringement suits, confirming that the standard will not vary based on jurisdiction.

Online References

In the second case, the appellate court held that online references may be invalidating prior art even if they are not indexed. In *Voter Verified Inc. v. Premier Election Solutions Inc.*, (Fed. Cir. Nov. 5, 2012) (available [here](#)), the Federal Circuit recently upheld a District Court's decision that a patent claim was obvious in view of the prior art, because evidence of indexing by a commercial search engine was not an absolute prerequisite to establishing an online reference as an invalidating prior art printed publication.

Voter Verified is the owner of U.S. Reissue Patent RE40,449 (the "449 patent") related to automated systems and methods for voting in an election, featuring a self-verification procedure. The Premier Election Solutions, Inc., Diebold, Inc., and Election Systems & Software, Inc. produce and market automated voting systems. Voter Verified filed two nearly identical infringement complaints based on the '449 patent against the defendants. The defendants denied infringement and sought declaratory judgments of invalidity on various

grounds including anticipation, obviousness and indefiniteness. In a series of summary judgment orders, the District Court held that the claim 49 was invalid as obvious under 35 U.S.C. § 103 in view of a “Benson” article obtained from an online periodical concerned with computer safety and security, known as the *Risks Digest*.

On Appeal, Voter Verified contended that a web-based reference must be “searchable by pertinent terms over the internet” to qualify as a prior art “printed publication” as defined by 35 U.S.C. § 102(b). In response, the defendants argued that the “Benson” article obtained from *Risks Digest* qualified as prior art because it was posted on a public website well known to those interested in the art of voting technologies and could be retrieved from that website by searching the Risks Digests site based on subject matter. The Federal Circuit agreed with the defendants and held that the “Benson” article was a “printed publication” within the meaning of 35 U.S.C. § 102(b) and the “Benson” article also rendered claim 49 obvious under 35 U.S.C. § 103. In reaching its decision, the Federal Circuit noted that the key inquiry to determine whether a given reference qualified as a prior art “printed publication,” was whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date. The Federal Circuit also noted that contrary to its earlier decisions that indexing was a relevant factor in determining accessibility of potential prior art, particularly library-based references, *e.g.*, *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) (holding that a dissertation indexed in a university library catalog was a publicly accessible printed publication) and *In re Bayer*, 568 F.2d 1357 (CCPA 1978) (holding that a thesis housed, but neither shelved nor catalogued, within a university library was not publicly accessible), indexing was not “a necessary condition for a reference to be publicly accessible.” Rather, indexing was but one among many factors that may bear on the determination of public accessibility and indexing was no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media. The Federal Circuit also noted that it had previously decided in *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) that the ultimate question was whether the reference was “available to the extent that persons interested and ordinarily skilled in the subject matter or art[,] exercising reasonable diligence, can locate it.” Here, the *Risks Digest* website was undisputedly open to any Internet user by the critical date. Whether or not the website itself had been indexed by 1999 (through search engines or otherwise), the uncontested evidence indicates that a person of ordinary skill interested in electronic voting would have been independently aware of the *Risks Digest* as a prominent forum for discussing such technologies. And upon accessing the *Risks Digest* website, such an interested researcher would have found the Benson article using that website’s own search functions and applying reasonable diligence. In short, the Benson article was publicly available by the critical date and therefore qualified as a prior art “printed publication” under § 102(b).

Based on this case, clients or practitioners conducting a search for prior art should search all publicly accessible online sources related to the subject matter of their invention. Failure to do so, may lead to the invalidation of patent claims in the future by references available from publicly accessible online sources that may not have been indexed by commercial search engines.

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