

McCombs, Goryunov and Vu in *The Patent Lawyer*: Evolving Contours of Prior Art

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PRACTICES Patent Litigation, Patent Office Trials, Patents, Patent Prosecution and Counseling

Recent Federal Circuit rulings clarify the complexities surrounding the definition of prior art in patent law, specifically addressing cases involving public disclosures and the implications for inter partes review proceedings at the Patent Trial and Appeal Board. Read more from Haynes Boone attorneys [David McCombs](#), Eugene Goryunov and [Laura Vu](#) in their article for *The Patent Lawyer*, excerpted below:

In 2024, Petitioners at the Patent Trial and Appeal Board (PTAB) continued to test the bounds of what constitutes prior art in inter partes review (IPR) proceedings. The Court of Appeals for the Federal Circuit was recently called in to clarify what is, in fact, “public” disclosure prior art. In *Weber v. Provisur*, the court determined that operating manuals – that carried a copyright notice prohibiting reproduction and included a clause indicating ownership – were sufficiently “public” to constitute prior art printed publications. And in *Sanho v. Kaijet*, the court concluded that a private sale of a product was not “public” disclosure for purposes of prior art. These cases demonstrate that there are still nuances in what constitutes prior art, despite the core concepts of prior art being well understood.

Weber v. Provisur

The Weber case began with an IPR. The Petitioner filed an IPR petition challenging claims of a patent asserted against it in district court as obvious. The challenge was based on disclosure in Petitioners’ own operating manuals describing its commercial food slicer in combination with other prior art references. The PTAB instituted trial, but ultimately decided that the manuals were not sufficiently “public” to constitute prior art.

According to the PTAB, the manuals were only distributed to 10 unique customers and, even when distributed, were subject to confidentiality restrictions. These restrictions were expressed in (1) a copyright notice contained within the manual that prohibited reproduction or transfer of the manual to others, and (2) an intellectual property rights clause within the terms and conditions underlying the sale of each food slicer that expressly provided that “[c]ost estimates, drafts, drawings and other documents remain the property of [Weber].”

[Read the full article in *The Patent Lawyer* here.](#)