

BRUCKELMYER V. GROUND HEATERS, INC.:
FOREIGN FILE WRAPPER IS A PRINTED PUBLICATION

Patent applications were filed in the United States in 1995 and two patents were issued to Mark Bruckelmyer (“Bruckelmyer”) for methods of thawing frozen ground so that a layer of concrete can be laid on top of the ground. Thirteen years prior to Bruckelmyer’s applications, a Canadian patent issued describing a portable heating system that places flexible hoses in “close proximity to objects of various shapes and configurations which would otherwise be difficult to heat.” Additionally, the patent went on to mention that the “system is suitable for applying heat to other objects and is not necessarily confined to use in relation to concrete placement. Other typical uses are: . . . thawing frozen ground.” During the prosecution of the Canadian patent, two relevant figures illustrating the use of the heating system to thaw ground were canceled. These figures were not shown in the issued patent, but remained in the patent file history.

In 2002, Bruckelmyer filed a complaint against Ground Heaters, Inc. (“Ground Heaters”) and T.H.E. Machine Company (“Machine Company”) claiming infringement *Bruckelmyer v. Ground Heaters, Inc.*, 2006 U.S. Dist. LEXIS 9255 (D. Minn. May 13, 2005). Ground Heaters filed a cross-claim asserting that the Bruckelmyer patents were invalid and filed a motion for summary judgment of invalidity based on the two figures that were canceled from the Canadian patent application. The district court denied the motion for summary judgment based on a genuine issue of material fact as to whether a person having ordinary skill in the art would have been enabled by the two canceled figures to practice the technology. In reaching its decision, the court determined that the Canadian application was a printed publication because it was available for inspection at the Canadian Patent Office more than one year before the priority date of the Bruckelmyer patents. Further, the court determined that “the contents of the file wrapper [were] sufficiently accessible to the relevant and interested public as to constitute a printed publication for purposes of § 102(b).” Bruckelmyer also stipulated that the figures involved in the suit rendered the claims of his patent invalid. The district court then granted Ground Heaters renewed motion for a summary judgment of invalidity.

On appeal, the only issue was whether the two canceled figures from the Canadian patent application constituted “printed publications” for the purposes of § 102(b). *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374 (Fed. Cir. 2006). Bruckelmyer argued that there was no evidence in the record disclosing that the contents of the file wrapper were disseminated because the only copy was in the Canadian Patent Office. *Id.* at 1378. He further argued that a person skilled in the art would not have been able to locate the figures because the Canadian Patent Office did not index or catalogue the application. *Id.* Finally, he argued that the figures would have been overlooked because they were cancelled during prosecution. *Id.*

The court rejected all of Bruckelmyer’s arguments. The court concluded that the published Canadian patent is a roadmap to the application file. *Id.* at 1379. The court indicated that someone having ordinary skill in the art would have been directed to the Canadian patent application after having read the possible uses of the claimed invention

and therefore, the application was “publicly accessible.” *Id.* After accessing the application, a person having ordinary skill in the art would have been enabled to practice the invention using the figures that were canceled. *Id.* Finally, although the figures were canceled, they remained in the file wrapper and thus were considered published for purposes of 35 U.S.C. §102 (b). *Id.*

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