# It's No Surprise: Your Own Copyright Registration Can Be Prior Art

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The differences between copyrights, trademarks, and patents can be confusing to a person who lacks experience with intellectual property, as illustrated in *In Re Lister*, in which an inventor may have been confused by the differences between copyrights and patents when he first obtained a copyright registration for a manuscript disclosing his invention. While the U.S. Court of Appeals for the Federal Circuit (CAFC) reversed the rejection of his patent application by the United States Patent and Trademark Office (USPTO), the filing of the copyright application may have undermined the inventor's ability to obtain a patent for his invention.

In *In Re Lister*[1], Mr. Lister devised an improvement to the game of golf in which players could adopt a "T handicap." The T handicap would allow the unrestricted use of a golf tee or peg on any golf shot to make the game easier for recreational golfers. Lister drafted a manuscript entitled "Advanced Handicap Alternatives for Golf," and obtained a copyright registration for his publication.

Lister eventually learned that the copyright registration would not protect his invention, so he filed a patent application claiming the T handicap more than two years after receiving his copyright registration. After a very long prosecution, the USPTO rejected Lister's patent application for lack of novelty, citing Lister's own copyright registration. Lister appealed the decision, arguing that the copyright registration was not prior art to his patent application.

For an invention to be patentable, it must be novel. One of the statutory measures of novelty is whether the invention was disclosed in a publication more than one year before the filing of a patent application. In most situations, this is a simple comparison of the date a prior document was published with the date the patent application was filed; however, there are certain situations in which it is not clear whether a document has been published, at least within the meaning of this rule. Prior court cases have resolved many such questions, including whether a student's dissertation stored within a college library is a publication for prior art.

In the case of a student's dissertation, the courts have determined that a dissertation or other such reference is only prior art for purposes of novelty if the reference was indexed in the library's catalog and housed in such a way that an interested researcher could locate and examine the reference. But is a manuscript registered in the Copyright Office analogous to a dissertation indexed in a library?

When a copyright is registered, a sample of the publication is maintained by the Copyright Office. The copyright registration information is available to the public through the Copyright Office's automated catalog, accessible either at the Library of Congress or over the Internet. The ability to search for documents in the catalog is limited, however; keyword searches and subject matter searches are not available. Only an author's last name and the first word in the title of the work are used for searching in the Copyright Office's automated catalog. After registration, however, commercial databases Dialog® and Westlaw® obtain the automated catalog data from the Copyright Office and enter it into their own databases, where keyword searching is available.

The CAFC concluded in *In Re Lister* that an interested researcher would have trouble locating Lister's manuscript in the Copyright Office without keyword searching. The court held that Lister's manuscript was publicly accessible as of the date that it was included in the Westlaw and Dialog databases that permitted keyword searching; however, as the USPTO

[1] *In Re Lister, 583 F.3d 1307 (Fed. Cir. 2009)*

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did not provide any evidence as to when, exactly, the manuscript was available in Westlaw or Dialog, the USPTO's rejection was reversed and the case remanded for further proceedings.

*In Re Lister* offers two lessons. The first is that publications in the Copyright Office are prior art as of the time they are made available in Westlaw, Dialog, or other databases with keyword searching capabilities. It is reasonable to expect that the USPTO will provide the requisite dates of availability in Westlaw or Dialog when making rejections based on copyright registrations in the future. But more importantly, *In Re Lister* is a good reminder to consult with intellectual property counsel before disclosing an inventive idea in a publication. The publication disclosing the invention, whether registered in the Copyright Office or not, may be cited as prior art that could bar the invention from being patented.



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