

## PTAB Approaches To Accessibility Of Printed Publication

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The America Invents Act introduced into the U.S. patent system the inter partes review, which is a trial proceeding conducted before the Patent Trial and Appeal Board that provides a less expensive, expedited alternative to challenging the validity of patent claims in district court litigation. An IPR challenge is limited to “prior art consisting of patents or printed publications” and may only be instituted where “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”[1]

While many IPRs are based on prior art patents, those that are based on printed publications face an additional hurdle — proving the date of public accessibility of the printed publication. This determination is “a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public,”[2] requiring “a satisfactory showing that [the reference] has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.”[3]

At the institution phase, the PTAB has characterized this burden as requiring a “threshold showing that the reference is a prior art ‘printed publication[.]’”[4] The question becomes what level of proof meets this “threshold showing,” as well as the degree to which the PTAB will defer evidentiary issues to the final written decision phase. A review of several PTAB decisions concerning various categories of publications demonstrates that the answer to these questions is not always clear.

### Web Publications

In *Coalition for Affordable Drugs IV LLC v. Pharmacyclics Inc.*, the petitioner relied in part on a copy of a webpage from [www.clinicaltrials.gov](http://www.clinicaltrials.gov) disclosing the results of a clinical study.[5] The face of the webpage stated that it was “Updated: 2009\_02\_23.”[6] In denying institution, the board acknowledged the date on the webpage but noted that the petitioner did not provide an “explanation or evidence of what that date means” or “explain how the website disseminates information to the public or even when the website became available to the public.”[7] The board concluded that the petitioner had “not satisfied its initial burden of coming forward with sufficient evidence to make a threshold showing that [the webpage] is a prior art printed publication.”[8]



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In *Crestron Electronics Inc. v. Intuitive Building Controls Inc.*, the petitioner challenged certain patent claims by relying in part on a collection of printouts of archived web pages.[9] The webpages were attached to the affidavit of Christopher Butler, who attested to his role at the Internet Archive (also referred to as the “Wayback Machine”).[10] The Butler affidavit explained the “processes used to archive web pages from the Internet and how the archived copies of web pages can be associated with a date of archiving” and that “the date of an archived web page can be determined from the URL printed on each archived web page.”[11] The patent owner contested the public accessibility of the webpages.[12] The board disagreed, finding that “it [was] reasonably likely that web pages locatable by crawlers of the Wayback Machine would be locatable to interested persons using typical search engines available at least one year before the critical date.”[13]

Finally, in *ServiceNow Inc. v. Hewlett-Packard Co.*, the board considered the public accessibility of three manuals (referred to as the “Collaborate References”) obtained from a website.[14] The petitioner submitted an affidavit by Butler from the Internet Archive that included an archived webpage with download links for the manuals, and also pointed out that each of the manuals included a copyright date and an indication that the manual was available for download from the company’s website.[15] On this basis, the petitioner argued that the manuals were publicly accessible.[16] The board disagreed and denied institution, finding that the petitioner had “fail[ed] to make the critical link between the alleged identification of the Collaborate References on the ‘download page’ and the exhibits relied upon in support of its asserted grounds.”[17]

With respect to the copyright notice and the indications of availability in the manuals themselves, the board held that these statements were inadmissible hearsay.[18] The board acknowledged other PTAB decisions in which the copyright notice was accepted as prima facie evidence of publication, but stated that it was “not bound by th[ose] determinations.”[19] One judge dissented from the decision denying institution, explaining that the “2001 dates on the cover pages of the Collaborate References,” “their 2001 copyright notices,” “and the ... Wayback Machine archive date ... are sufficient to make a ‘threshold showing’ of public availability, similar to showings that we have found sufficient to institute trial in the past.”[20]

## **Professional Articles**

In *Ericsson Inc. v. Intellectual Ventures I LLC*, the petitioner challenged claims based on an article (referred to as “Stadler”) published by the Institute of Electrical and Electronics Engineers.[21] The board instituted the IPR, but without addressing the issue of public accessibility.[22] The patent owner subsequently objected to the authenticity of the article and moved to exclude the article, arguing that the date printed on the reference failed to prove public accessibility.[23] The board rejected this argument, finding that an IEEE copyright line on the first page of Stadler sufficiently evidenced its publication date and public accessibility.[24] The board explained that “IEEE is a well-known, reputable compiler and publisher of scientific and technical publications, and we take Official Notice that members in the scientific and technical communities who both publish and engage in research rely on the information published on the copyright line of IEEE publications.”[25] The board acknowledged that “[a]llowing IPR petitioners to rely on the IEEE publication date in an IPR proceeding, which is an administrative proceeding designed and intended to afford expedited and efficient relief, serves the interests of justice.”[26] The copyright line was also found to be admissible under the residual hearsay exception,[27] and the patent owner’s authenticity objection was rejected.[28] On appeal, the Federal Circuit affirmed the PTAB’s decision without opinion under Fed. Cir. R. 36.[29]

Quite differently, in *TRW Automotive U.S. LLC v. Magna Electronics Inc.*, the board issued a final written decision refusing to accept the copyright date of an IEEE article as proof of publication, despite an accompanying International Standard Book Number (“ISBN”).<sup>[30]</sup> On its face, the IEEE article at issue (referred to as “Goldbeck”), did not include a statement that it had been published.<sup>[31]</sup> Goldbeck did, however, include a 1999 copyright date, an IEEE inscription, and an ISBN number.<sup>[32]</sup> After institution, the patent owner moved to exclude for lack of authentication, hearsay, and relevance.<sup>[33]</sup> In the final written decision, the board found that the petitioner had failed to demonstrate that Goldbeck qualified as a printed publication.<sup>[34]</sup> In reaching that conclusion, the board held that “although the copyright notice is probative that IEEE owns a copyright to the article, it is not probative that the article was ever published by IEEE or anyone else.”<sup>[35]</sup> The board also found that the petitioner failed to prove that the number on the copyright line “is an ISBN, what an ISBN is, what an ISBN signifies, how an ISBN is assigned, who assigns it, or when and under what circumstances an ISBN is stamped onto something.”<sup>[36]</sup> The board granted the patent owner’s motion to exclude Goldbeck, and because all grounds of invalidity in the petition relied on Goldbeck, the board concluded that the challenged claims were not unpatentable.<sup>[37]</sup> One judge dissented, finding that “Goldbeck [was] authentic, admissible, and relevant.”<sup>[38]</sup>

### **Theses and Dissertations**

In *Alternative Legal Solutions Inc. v. Employment Law Compliance Inc.*, the petitioner challenged certain claims of a patent based, in part, on a dissertation written by a student at MIT.<sup>[39]</sup> To establish public accessibility, the petitioner relied solely on the date printed on the dissertation.<sup>[40]</sup> The board instituted IPR on grounds that relied on the dissertation as prior art, without any inquiry into evidence of public accessibility.<sup>[41]</sup> Following institution, the patent owner objected to the prior art status of the dissertation and sought third-party discovery regarding authenticity and public accessibility of the dissertation.<sup>[42]</sup> The board denied the patent owner’s motion for discovery,<sup>[43]</sup> but did not issue a final written decision evaluating the dissertation’s public accessibility because the challenged claims were canceled pursuant to the patent owner’s request for adverse judgment.<sup>[44]</sup>

In the more recent *Argentum Pharmaceuticals LLC v. Research Corp. Technologies Inc.*, the petitioner challenged the validity of a patent based on a master’s thesis from the University of Houston dated December 1987.<sup>[45]</sup> The petitioner argued that the thesis qualified as a printed publication because (1) the patent owner had stipulated in a district court case that the thesis was publicly accessible, (2) the University of Houston denied the petitioner’s request for information regarding public accessibility on the grounds that producing the information was contrary to the university’s competitive interests, and (3) there was evidence of other authors citing other University of Houston theses, that, according to the petitioner, indicated the University of Houston’s theses were accessible to the public in the relevant time frame.<sup>[46]</sup>

The board declined to institute the grounds based on the thesis, holding that the petitioner had not made a threshold showing that the thesis was sufficiently publicly accessible to qualify as a printed publication under § 102(b).<sup>[47]</sup> In reaching this decision, the board was not persuaded by the district court stipulation, noting that the patent owner may have “had other reasons to stipulate on the issue in a case involving different parties in a different forum, regardless of whether the thesis was, in fact, publicly accessible or not.”<sup>[48]</sup> The board also deemed the University of Houston’s refusal to cooperate insufficient to give rise to a rebuttable presumption that the information existed and would establish a reasonable likelihood of public accessibility.<sup>[49]</sup> Last, the examples of University of Houston theses being cited by others did not establish public accessibility because the later articles citing the theses were authored either by the same thesis author or a thesis adviser.<sup>[50]</sup> The board reasoned that these

individuals would have had personal knowledge of the thesis, and therefore, the citations did not establish public access.[51]

## **Product Guides and Operation Manuals**

In *Int'l Business Machines Corp. v. Intellectual Ventures I LLC*, the petitioner relied in part on an Oracle Developer Guide to challenge the patent in question.[52] In the preliminary response, the patent owner contended that the petitioner's citation to the Developer Guide itself did not establish that it was sufficiently disseminated.[53] The board disagreed with the patent owner and instituted the petition, noting that the document "include[d] a date of 'September 2000' on the first page and a copyright on the second page" and also "include[d] a part number and the Oracle trademark." [54] The board found this evidence sufficient for institution.[55] The patent owner maintained its position that there was insufficient evidence that the Developer Guide was sufficiently disseminated, and filed a motion to exclude multiple exhibits the petitioner proffered as to this issue, including a declaration by the primary author of the Developer Guide.[56] The board ultimately rendered a final written decision without reaching the issue of whether the Developer Guide qualified as a printed publication.[57]

In *LG Electronics Inc. v. Advanced Micro Devices Inc.*, the board considered the public accessibility of two publications: (1) a preliminary technical specification prepared by National Semiconductor Corporation ("NSC") for a USB function controller; and (2) a user's manual for the USB function controller developed by Seiko Epson Corporation.[58] The NSC specification included a copyright date prior to the patent's priority date and there was evidence that the specification had been listed on an information disclosure statement (IDS) submitted in an unrelated patent application before the patent's priority date.[59]

In its decision denying institution, the board noted that "[w]hen determining the threshold issue of whether a document is a printed publication for purposes of a decision on institution, a copyright notice has been accepted a[s] prima facie evidence of publication." [60] The board was "persuaded that the presence of a copyright notice, together with the listing of the reference in an IDS, may be taken as some evidence of public accessibility as of a particular date." [61] For these reasons, the board concluded there was sufficient evidence to demonstrate a "reasonable likelihood" that the NSC specification was a printed publication.[62] Conversely, for the Seiko manual, the board determined that the petitioner had not demonstrated a reasonable likelihood that it was a printed publication.[63] Regarding the user manual, the petitioner relied "on the date printed on the face of [the manual] as evidence of its publication" before the patent's priority date.[64] The board explained that "[t]he date itself only contains the notation 'Revision: 2.0,' which may suggest that the document was 'revised' on March 24, 1998, but is not evidence that it was published on that date." [65] Additionally, the board found a conclusory expert declaration stating that the Seiko manual "was more than likely published on or about March 24, 1998," to be insufficient to demonstrate public accessibility.[66]

## **Conclusion**

A petitioner relying on nonpatent prior art should not take the issue of public accessibility lightly in the petition. For proving public accessibility, identifying a copyright date alone or pointing to a date on a document without providing additional evidence as to the nature of the date can be fraught with risk. In addition, the petition should present evidence to authenticate the publication. When information concerning public accessibility and authentication is in the hands of third parties, as a first course of action, a petitioner can seek cooperation from the third party to obtain a declaration authenticating the publication and providing evidence of its public accessibility. If a third party located in the United States

will not cooperate and a district court litigation is pending, a petitioner may also subpoena the third party to obtain a declaration and/or deposition testimony to be included in the petition. If neither third party cooperation nor a subpoena is an option, some tools available to a petitioner include (1) submitting a declaration from a librarian expert; or (2) if the publication was available on a website, submitting an Internet Archive affidavit. With respect to the latter, the Internet Archive publishes its requirements for obtaining an affidavit at <https://archive.org/legal/>.

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[1] 35 U.S.C. §§ 311, 314.

[2] *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

[3] *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A. 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743 (S.D.N.Y. 1966)).

[4] See, e.g., *Coalition for Affordable Drugs IV LLC v. Pharmacyclics, Inc.*, IPR2015-01076, Paper No. 33, Decision Denying Institution at 6 (PTAB Oct. 19, 2015).

[5] *Id.* at 4.

[6] *Id.* at 7.

[7] *Id.* at 7-8.

[8] *Id.* at 8.

[9] *Crestron Electronics, Inc. v. Intuitive Building Controls, Inc.*, IPR2015-01379, Paper No. 16, Institution Decision at 4-5 (PTAB Dec. 15, 2015).

[10] *Id.* at 12.

[11] *Id.*

[12] *Id.* at 13-14.

[13] *Id.* at 14.

[14] *ServiceNow, Inc. v. Hewlett-Packard Co.*, IPR2015-00707, Paper No. 12, Decision Denying Institution at 9-20 (PTAB Aug. 26, 2015).

[15] *Id.*, Paper No. 1, Petition at 21-24 (PTAB Feb. 5, 2015).

[16] Id.

[17] Id., Paper No. 12, Decision Denying Institution at 14.

[18] Id. at 16.

[19] Id. at 17.

[20] Id., Dissent at 2-3 (Crumbley, J., dissenting).

[21] *Ericsson, Inc. v. Intellectual Ventures I LLC*, IPR2014-00527, Paper No. 1, Petition at 7 (PTAB March 21, 2014).

[22] Id., Paper No. 11, Institution Decision (PTAB Aug. 6, 2014).

[23] Id., Paper No. 41, Final Written Decision at 10 (PTAB May 18, 2015).

[24] Id. at 10-11.

[25] Id. at 11.

[26] Id. at 12.

[27] Id. at 11.

[28] Id. at 12-13.

[29] *Intellectual Ventures I LLC, v. Ericsson Inc.*, No. 2015-1947, 2016 WL 4363178, at \*1 (Fed. Cir. Aug. 16, 2016).

[30] *TRW Automotive U.S. LLC, v. Magna Electronics Inc.*, IPR2014-01347, Paper No. 25, Final Written Decision at 5-12 (PTAB Jan. 6, 2016).

[31] Id. at 9.

[32] Id. at 9-10.

[33] Id. at 4 n.6.

[34] Id. at 8-11.

[35] Id. at 8.

[36] Id. at 10.

[37] Id. at 12-13.

[38] Id., Dissent at 20 (Calve, J., dissenting).

[39] Alternative Legal Solutions, Inc. v. Employment Law Compliance, Inc., IPR2014-00562, Paper No. 1, Petition at 3 (PTAB April 1, 2014).

[40] Id.

[41] Id., Paper No. 9, Institution Decision at 21 (PTAB Oct. 7, 2014).

[42] Id., Paper No. 18, Motion for Authorization to Compel Testimony at 1-4 (PTAB Dec. 18, 2014).

[43] Id., Paper No. 22, Order Denying Motion (PTAB Dec. 23, 2014).

[44] Id., Paper No. 25, Judgment (PTAB Feb. 2, 2015).

[45] Argentum Pharmaceuticals LLC v. Research Corp. Technologies, Inc., IPR2016-00204, Paper No. 19, Institution Decision at 3 n.1 (PTAB May 23, 2016).

[46] Id. at 10.

[47] Id. at 12.

[48] Id. at 11.

[49] Id.

[50] Id. at 11-12.

[51] Id.

[52] Int'l Business Machines Corp. v. Intellectual Ventures I LLC, IPR2014-01385, Paper No. 7, Institution Decision at 5 (PTAB Feb. 11, 2015).

[53] Id. at 18.

[54] Id. at 19.

[55] Id.

[56] Id. Paper No. 50, Motion to Exclude (PTAB Oct. 6, 2015).

[57] Id., Paper No. 64, Final Written Decision at 26 (PTAB Jan. 15, 2016).

[58] LG Electronics, Inc. v. Advanced Micro Devices, Inc., IPR2015-00329, Paper No. 13, Decision Denying Institution at 9-13 (PTAB July 10, 2015).

[59] Id. at 10-11.

[60] Id. at 12.

[61] Id.

[62] Id. at 12-13.

[63] Id. at 13.

[64] Id.

[65] Id.

[66] Id.

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