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PATENTS

Printed Publications at the PTO



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With the implementation of the America Invents Act of 2011, inter partes review proceedings at the Patent Trial and Appeal Board have become a popular way to challenge the validity of a patent. The types of information which may be used to challenge validity are limited to “patents and printed publica-

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tions.”¹ Typically, when practitioners think of “printed publications,” they think of articles in academic or industry journals. However, sometimes useful prior art references are neither patents nor journal articles, but another type of document. In such instances, a party contemplating a validity challenge should consider whether the document is a “printed publication” under the statute.

This article surveys recent PTAB decisions which provide an indication how the PTAB is evaluating the status of a document as a printed publication. The article also provides guidance on what evidence the PTAB has considered persuasive and what has been found wanting.

Types of Alternative Documents That Have Been Used in IPR Proceedings

Using patents or printed publications, such as journal articles, to support unpatentability in an IPR unquestionably carries certain advantages. Patents and journal articles are generally easy to search for via patent search tools or library catalogs. Moreover, these documents (particularly patents and articles from widely circulated journals) clearly meet the definition of a publication, and are seldom challenged on authenticity or hearsay grounds.

However, sometimes important disclosures are made in informal settings or in a less widely circulated medium (e.g., message board) prior to dissemination in a “formal” document like a patent filing or journal article. In such situations, the use of the more informal documents can allow a challenger to establish an earlier date of disclosure, which can be desirable, even necessary, for getting behind a challenged patent's critical date.

When challenging patents that relate to telecommunications, for example, useful prior art can be found in the archives of standards-setting bodies such as the In-

¹ 35 U.S.C. § 311(b).

stitute of Electrical and Electronics Engineers or the Third Generation Partnership Project. These organizations publish industry standards such as the 802.11 standard for Wi-Fi (published by the IEEE) or the LTE standard for cellular communications (published by the 3GPP).

Often, a standard might go through multiple drafts before an “official” release. Moreover, during the process of developing a standard, participants in these organizations (typically university faculty or representatives of major players in the industry) exchange and discuss written technical proposals. Because of the time it takes to consider and debate the different proposals and draft the standard, key disclosures may be made in documents drafted and circulated to members of the organizations months or even years before the publication of the official standard in question.

Thus, challengers often seek to use proposals or draft standards from organizations such as the IEEE or 3GPP as prior art. For example, in *Samsung Electronics Co. v. Rembrandt Wireless Techs., LP*, the petitioner sought to use a draft IEEE standard from 1997 to challenge a patent with a priority date of Dec. 5 of that year.² Similarly, ideas that may later be published in academic journal articles are sometimes first disclosed at conferences via PowerPoint slides, posters, or even drafts of papers. For example, in *Coalition for Affordable Drugs (ADROCA) LLC v. Acorda Therapeutics, Inc.*, the petitioner asserted as prior art two posters that had been presented at medical conferences.³

Other types of documents, such as website printouts, have been used to demonstrate what was available to someone skilled in the art at the time when a challenged patent was filed. In *EMC Corp. v. Personalweb Techs., LLC*, for example, the petitioner relied on a Usenet posting from 1991 to show that certain techniques for looking up binary data were known in the art.⁴

The use of such printouts can be especially useful when challenging patents related to fields that are unlikely to be of sufficient industry or academic interest to warrant publication in a journal. For example, in *LKQ Corp. v. Clearlamp, LLC*, in which the challenged claims related to methods for refurbishing vehicle headlights, the petitioner successfully relied on postings from a car enthusiast website to show that certain steps in the challenged claims were known in the art.⁵

Documents such as press releases can also be used to demonstrate a motivation to combine. For example, in *Biomarin Pharmaceutical Inc. v. Genzyme Therapeutic Products LP*, the petitioner relied on a press release about an upcoming Food and Drug Administration trial to demonstrate that the use of a certain type of treatment was likely to be effective.⁶

Finally, sometimes a good invalidating reference is not a “document” at all, but is rather a pre-existing

product. However, since a product itself cannot be used in an IPR, petitioners may seek to use documents describing the product or its functionality as a prior art. For example, in *FLIR Systems, Inc. v. Leak Surveys, Inc.*, the PTAB instituted the IPR relying in part on a user guide and brochure for a prior art camera.⁷ Similarly, in *IBM Corp. v. Intellectual Ventures II LLC*, the PTAB accepted as a printed publication a dated and copyrighted user guide for a prior art network security system.⁸

Challenges to Use of Documents as Printed Publications

The panel decisions at the PTAB rejecting material as a “printed publication” often focus on two failings.⁹ First, the PTAB has rejected proffered documents where there was insufficient evidence that a member of the public would actually be able to find the document in question. Second, the PTAB has rejected documents pursuant to the Federal Rules of Evidence.

When Is a Document ‘Public’ Enough to Be a ‘Publication’?

The Federal Circuit has held that, for a reference to be a “publication” for prior art purposes, it “must have been sufficiently accessible to the public interested in the art.”¹⁰ This means that in practice, it is not enough to merely show that the public was not *restricted* from accessing it; rather, “[a] given reference is ‘publicly accessible’ upon a satisfactory showing that such document 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.*”¹¹ This requirement will ordinarily be satisfied if the document is distributed to the public or if it is stored in a library and indexed in some way to enable a reasonable searcher to find it, per *In re Klopfenstein*.¹²

But the requirement can be satisfied in other ways as well. For example, when analyzing whether a slide presentation at a conference was a “printed publication,” the *Klopfenstein* court considered factors including: “[1] the length of time the display was exhibited, [2] the expertise of the target audience, [3] the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and [4] the simplicity or ease with which the material displayed could have been copied.”¹³

Panels at the PTAB apply this law in accepting or rejecting documents as “printed publications.” For ex-

⁷ IPR2014-00411, Paper No. 10 (Decision on Institution) at 19-20 (P.T.A.B. Sept. 5, 2014).

⁸ IPR2014-00681, Paper No. 11 (Decision on Institution) at 13-14 (P.T.A.B. Oct. 30, 2014) (denying institution on unrelated grounds).

⁹ The three-judge panel decisions cited in this article are “routine” (not precedential) decisions by the board.

¹⁰ *In re Lister*, 583 F.3d 1307, 1311, 92 U.S.P.Q.2d 1225 (Fed. Cir. 2009) (78 PTCJ 670, 10/2/09).

¹¹ *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194, 85 U.S.P.Q.2d 1489 (Fed. Cir. 2008) (75 PTCJ 273, 1/18/08) (emphasis added).

¹² 380 F.3d 1345, 1348-1349, 72 U.S.P.Q.2d 1117 (Fed. Cir. 2004) (68 PTCJ 505, 9/3/04).

¹³ *Id.* at 1350.

² IPR2014-00514, Paper No. 18, at 5-6 (P.T.A.B. Sept. 9, 2014).

³ IPR2015-00817, Paper No. 12, at 2 & n.1, 2 (P.T.A.B. Aug. 24, 2015).

⁴ IPR2013-00083, Paper No. 80 (Final Written Decision) at 39 (P.T.A.B. Oct. 30, 2014).

⁵ IPR IPR2013-00020, Paper No. 73 (Final Written Decision) at 11-12 (P.T.A.B. Mar. 27, 2014).

⁶ IPR2013-00537, Paper No. 79 (Final Written Decision) at 8-9, 17 (P.T.A.B. Feb. 23, 2015).

ample, in *Samsung*, the PTAB panel excluded the draft IEEE standard presented by Samsung. In that case, Samsung presented a declaration from an editor of the IEEE-802.11-1997 standard stating that drafts of the standard were stored on a password protected server, but that any member of the public could get access to the group's server and email list by contacting the working group's chairman. However, applying SRI, the PTAB panel held that this was not sufficient because only those who were *already aware* of the working group and of the procedure for accessing the e-mail list and server would have been able to find the draft. In so ruling, the PTAB contrasted the case with *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, where the Federal Circuit found that the 3GPP wireless standards were printed publications because they were "visible to any member of the interested public without requesting them from an ETSI [European Telecommunications Standards Institute] member."¹⁴

Similarly, in *Symantec Corp. v. Trustees of Columbia University*, a PTAB panel held that a master's thesis was not a printed publication because, even though it had been marked as being for public distribution, the petitioner presented no evidence that it had actually been distributed or indexed in a library. The PTAB panel noted that the thesis contained a list of search terms that "appear[ed] suited for facilitating an electronic-database search," but faulted the petitioner for failing to present evidence that the document had actually been entered into a searchable database.¹⁵

In *ADROCA*, a PTAB panel excluded the petitioner's proffered conference posters for failure to provide evidence relating to the *Klopfenstein* factors mentioned above. Although it was undisputed that the posters in question had been presented at conferences prior to the critical date, the petitioner presented no evidence regarding the duration of the presentation or how easily it could have been copied.¹⁶

In contrast, in *CaptionCall, LLC v. Ultratech, Inc.*, the PTAB panel rejected the patent owner's challenge to the March 1996 publication date asserted by the petitioner for a paper presented at a conference. In support of the date, the petitioner presented the transcript of a deposition of the paper's author taken during a related district court litigation. The author testified that not only did he present the paper orally at the conference, but the paper was contemporaneously made available for purchase at the conference as part of a book with all of the conference papers, and many conference attendees did in fact purchase it.¹⁷

Finally, the PTAB has noted that under Federal Circuit law, mere disclosure of a document in an Information Disclosure Statement (IDS) to the Patent and Trademark Office does not satisfy the publication requirement.¹⁸

¹⁴ *Samsung*, IPR2014-00514, Paper No. 18, at 7-9 (referencing 545 F.3d 1340, 1351, 89 U.S.P.Q.2d 1057 (Fed. Cir. 2008) (76 PTCJ 896, 10/24/08)).

¹⁵ IPR2015-00371, Paper No. 13 (Decision on Institution) at 8-9 (P.T.A.B. Jun. 27, 2015) (denying institution because all asserted grounds relied on rejected thesis).

¹⁶ IPR2015-00817, Paper No. 12, at 5.

¹⁷ IPR2013-00544, Paper No. 74 (Final Written Decision) at 35-38 (P.T.A.B. Mar. 3, 2015).

¹⁸ See *Synopsys, Inc. v. MentorGraphics Corp.*, IPR2012-00042, Paper 16 (Decision on Institution) at 35-36 (P.T.A.B. Feb. 22, 2013), citing *ResQNet.com, Inc. v. Lansa, Inc.*, 594

Evidentiary Concerns

With certain exceptions, the Federal Rules of Evidence apply to IPRs.¹⁹ Motions to exclude journal articles are rare, but the PTAB's decision in *Ericsson Inc. v. Intellectual Ventures I LLC* indicates that such documents are likely to survive evidentiary challenges.

In *Ericsson*, the PTAB accepted, over the patent owner's objection, an article published in the proceedings of the IEEE Military Communications Conference. The PTAB first rejected the patent owner's authenticity challenge, holding that the article was authentic under Fed. R. Evid. 901(b)(4) because its appearance indicated that it was a genuine IEEE article. The court also rejected a hearsay challenge to the publication date listed on the article, applying both the exception for "compilations that are generally relied on by the public or by persons in particular occupations" under Fed. R. Evid. 803(17) and the residual exception under Rule 807.²⁰ However, the PTAB's decisions indicate that other types of references can succumb to evidentiary challenges.

Evidentiary issues frequently arise when a petitioner seeks to use website printouts. The PTAB has held that "[t]o authenticate printouts from a website, the party proffering the evidence must produce some statement or affidavit from someone with knowledge of the website . . . for example a web master or someone else with personal knowledge would be sufficient."²¹ In *EMC*, for example, the PTAB accepted a document archived on a website, over the patent owner's objections, where the petitioner submitted declarations from persons knowledgeable about the relevant websites.²²

In contrast, in *Standard Innovation Corp. v. Lelo, Inc.*, the PTAB excluded printouts from the Internet Archive's "Wayback Machine" for failure to provide supporting declarations. The PTAB noted that although courts have approved of the use of Wayback Machine printouts as prior art, it had required them to be authenticated by a witness who either knew how Wayback Machine worked or had personal knowledge that the printouts were authentic.²³

Evidentiary challenges can also arise with respect to a document's date. With undated documents, witness testimony or other evidence may be required to establish a date.

For example, in *FLIR*, the PTAB accepted the petitioner's date for an undated user guide over the patent owner's objection where the petitioner also provided testimony that the guide was distributed to the public along with a camera that was sold prior to the critical date.²⁴ And in *Biomarin*, the PTAB relied on a newspaper article as evidence to establish the publication date

F.3d 860, 865-66, 2010 BL 24667, 93 U.S.P.Q.2d 1553 (Fed. Cir. 2010) (79 PTCJ 422, 2/12/10).

¹⁹ See 37 C.F.R. § 42.62.

²⁰ IPR2014-00527, paper 41 (Final Written Decision) at 10-13 (P.T.A.B. May 18, 2015).

²¹ *EMC Corp. v. Personalweb Techs., LLC*, IPR2013-00084, Paper No. 64 (Final Written Decision) at 45-46 (P.T.A.B. May 15, 2014).

²² *Id.* at 46-47.

²³ IPR2014-00148, Paper No. 41 (Final Written Decision) at 10-11 (P.T.A.B. Apr. 29, 2015) (citing *U.S. v. Bansal*, 663 F.3d 634, 667-68, 2011 BL 316225 (3d Cir. 2011)).

²⁴ IPR2014-00411, Paper No. 10 at 19-20.

of the press release at issue and rejected the patent owner's attempt to exclude it.²⁵

The PTAB has generally accepted copyright dates as evidence of their publication date.²⁶ However, even a dated document can be challenged by the patent owner.

For example, in *QSC Audio Products, LLC v. Crest Audio, Inc.*, the petitioner asserted as prior art two "pre-prints" of papers that were subsequently presented at a convention. As in *Ericsson*, the patent owner raised an evidentiary objection to the statements on the face of the preprints regarding when they were presented, arguing that they were hearsay because they were offered for the truth of the matter asserted—i.e. when the papers were distributed. The PTAB agreed that the statements were hearsay, although it ultimately admitted the statements under the residual exception of Fed. R. Evid. 807 because preprints themselves were sufficiently trustworthy. However, the PTAB noted that the petitioner could have avoided the hearsay finding in the first place by obtaining evidence from the conference organizers about how their electronic records were stored.²⁷

Lessons for Practitioners

The PTAB's decisions make clear that it is applying the Federal Rules of Evidence and the Federal Circuit's guidance on the printed publication requirement. Petitioners should therefore make certain that they are familiar with this law and carefully consider whether additional evidence will be needed to demonstrate that a particular reference is a "publication."

For instance, when considering using a standards document, petitioners should carefully study how the relevant standards body maintained that particular type of document. Standards organizations often post proposals, draft standards and e-mail discussions among

participants on the internet, but the degree of public accessibility of such documents can vary among standards bodies and among document types. The IEEE 802.11 working group, for example, allows members of the public to search and download working group proposals and meeting minutes, but permits only members to access draft standards.²⁸ Likewise, when evaluating conference presentations, petitioners should determine what evidence of publication is available beyond the mere fact of the presentation itself.

Petitioners should also ensure that they can obtain declarations from witnesses who are sufficiently knowledgeable to authenticate and establish the date of a document. When using a website, petitioners should ensure that they can present testimony from a witness knowledgeable about the site itself or about archiving tools such as the Wayback Machine. And when relying on a user guide for a product, petitioners should ensure that they can present evidence when the guide itself was distributed to the public.

Additionally, if an IPR is being considered in conjunction with pending litigation, petitioners should consider whether the district court might be a better vehicle in which to assert a given reference. With product prior art in particular, it may be more effective in some instances to have an expert demonstrate the product to a jury than to try to locate a manual to present to the PTAB, particularly if a product's manual may not discuss key features for the invalidity argument.

Patent owners should likewise familiarize themselves with the Federal Rules of Evidence and with the Federal Circuit's printed publication law so that they can recognize opportunities to exclude a prior art reference. The case law surveyed above makes it clear that the PTAB takes the admissibility rules seriously will exclude prior art from an IPR if the petitioner has not provided sufficient support. Owners should thus carefully examine each proffered reference to determine whether it can be attacked on public access or evidentiary grounds.

²⁵ IPR2013-00537, Paper No. 79 at 23-25.

²⁶ *FLIR*, IPR2014-00411, Paper No. 10 at 18-19; *IBM*, IPR2014-00681, Paper No. 11 at 13-14.

²⁷ IPR2014-00127, Paper No. 43 (Final Written Decision) at 11-16 (P.T.A.B. Apr. 29, 2015).

²⁸ See IEEE, *IEEE 802.11*, <http://www.ieee802.org/11/> (last accessed Jan. 20, 2016).