

An elephant never forgets

The Wayback Machine, which enables attorneys to find prior art web pages that are no longer accessible on the internet, is a useful tool in post-grant challenges, as **Deborah Sterling** and **Christopher Gallo** of Sterne, Kessler, Goldstein & Fox report.

The internet is a massive information repository that never sleeps. As quickly as the information is generated, it is also changing or disappearing as websites are modified or deleted. However, the Internet Archive's Wayback Machine can counteract the impermanence of the internet, turning it into the proverbial elephant that never forgets.

The Wayback Machine is an online service maintained by the Internet Archive, a non-profit organisation that allows users to visit archived versions of websites. While not originally intended for legal use, the Wayback Machine has become a strong tool in a patent litigation toolbox. This is because prior art is particularly important for challenging patent claims and the Wayback Machine enables attorneys to find prior art web pages that are no longer accessible on the internet.

Over time, these archived websites have become readily accepted as evidence in federal district court proceedings. In the area of patent litigation in particular, accused infringers have proffered web pages provided through the machine as prior art publications to challenge asserted patent claims. Courts have accepted this evidence, and the Patent Trial and Appeal Board (PTAB) seems to be following suit, making the machine an attractive tool in post-grant challenges at the US Patent and Trademark Office (USPTO).

What is the Wayback Machine?

The Wayback Machine scours the internet on a daily basis and archives web content that would otherwise be lost whenever a website is changed or closed down, with the goal being to archive every website at least every two months. Once archived, these websites are forever accessible simply by visiting the Wayback Machine website. It has archived more than 452 billion web pages since 1996 and, as of December 2014, contained almost nine petabytes of data—a veritable wealth of prior art possibilities.

It is important to realise that the machine cannot be relied on to establish the date on which a web page was created; it can only show what a web page disclosed on the date that the web page was archived. Other limitations to the machine include archived pages that contain broken links, are missing graphics, or are otherwise incomplete.

The Wayback Machine is unable to process certain JavaScript elements. Also, it archives a web page only when web crawlers visit the page and not every time it is updated. Of course, the more popular a web page, the more frequently it will be archived—for example The New York Times website is archived multiple times on a daily basis.

It can take between six and 14 months for a website that was crawled to become accessible in the database. It was established in 1996, so websites that disappeared before then are, obviously, not included. Last, passcode-protected sites cannot be archived and website owners may opt out of the archive process altogether.

Post-grant challenges

With the passing in 2011 of the America Invents Act (AIA), parties can use various post-grant proceedings to challenge US patents before the PTAB. In the first year of the AIA's enactment, the USPTO expected about 300 to 400 post-grant challenge petitions to be filed.

In 2013 alone approximately 800 petitions were filed, and the total number of petitions filed since the AIA's inception currently hovers around 2,700. Consequently, post-grant proceedings have become particularly attractive to parties looking to challenge competing patents.

Various types of post-grant challenges are available—*inter partes* review, covered business method review, and post-grant review—and the availability of each type depends on the patent challenged. One thing they all have in common, however, is that they provide the ability to challenge patent claims using prior art patents and printed publications.

A reference qualifies as a printed publication if it “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”.

Under the 1952 Patent Act, an invention may not be patented if it was described in a printed publication before the invention date. Under the AIA, a patent application with an effective filing date on or after March 16, 2013 may not be patented if it was described in a printed publication before the effective filing date of the patent application.

A web page may constitute a printed publication and qualifies as prior art as of the date it was posted and made publicly available. However, the rapidly changing nature of internet postings—the average web page has a life of 100 days—can make it virtually impossible to know exactly what was disclosed to the public, and when.

The beauty of the Wayback Machine is that it forever freezes in time a web page that it captures. If that captured web page was once publicly available before a prior art critical date, then it does not matter that the web page may no longer exist, as the attorney can still access the prior art web page to add it to the patent challenge.



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The Wayback Machine broadens the universe of prior art, making it an attractive tool for a patent challenger and a bigger concern for a patentee. It is therefore of interest how the PTAB treats prior art generated from the machine once it is submitted as evidence in post-grant proceedings.

The USPTO has previously accepted web pages archived using the machine as prior art in *ex parte* prosecutions. The PTAB seems to be following suit, typically accepting web pages archived using the machine as prior art in post-grant proceedings.

One key difference between using the Wayback Machine in prosecution and in post-grant proceedings, however, is that post-grant proceedings are governed by the Federal Rules of Evidence, whereas prosecution is not. Consequently, patent owners can challenge the authentication of the machine's web pages. This is because, as printouts of electronic information, exhibits of archived web pages are generally not self-authenticating under the Federal Rules of Evidence.

Declarations from witnesses or attorneys are generally insufficient to authenticate the machine's web captures if the witnesses do not have personal knowledge of the archive's contents. But one simple way to authenticate the archived website is by using an affidavit from the Internet Archive, which maintains the Wayback Machine website and therefore has personal knowledge of the captured web pages.

The Internet Archive has readily cooperated with requests for such affidavits. These affidavits verify that the web page captured is a true and correct copy of the web page as originally published. They also describe the process by which the Wayback Machine archives websites, how the archives can provide a snapshot of a website from various dates, and how the URL provided by the Wayback Machine indicates the archival date of the relevant capture. Indeed, the PTAB has found affidavits from the Internet Archive sufficient to authenticate machine-based exhibits.

That being said, even without an affidavit from the Internet Archive, the PTAB has been reluctant to exclude web captures in the machine as evidence, due to authentication issues. For instance, the PTAB found that a petitioner's failure to obtain an affidavit authenticating captured web pages was not sufficient to exclude the archives. The PTAB has also accepted declarations from a party's expert witness and counsel attesting to exhibits being true and correct copies of the information published on the machine's website as sufficient for authentication.

Patent owners have also challenged whether archived web pages truly represent the



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information that was publicly available at the time of archiving. The PTAB has generally rejected such challenges when evidence suggests that at the time the web pages were archived, they were disseminated, or otherwise

would have been made available, to a person of ordinary skill in the art exercising reasonable diligence.

In response, patent owners have argued that the petitioner must provide evidence that proves a person of ordinary skill in the art actually accessed the web page in question at the critical time point to qualify it as prior art. But this has been roundly rejected by the PTAB; a party needs only to provide sufficient evidence to demonstrate that the reference was disseminated publicly or was otherwise made available.

Patent owners have also raised hearsay objections to machine-based evidence. But, typically, a web page capture is used to show that the description of a product or concept, which anticipates or renders obvious the challenged claims, was available as prior art; it is not used to show the truth of the information it conveys. Therefore, the PTAB has not found machine-archived web pages to be hearsay.

In sum, machine web page captures can be a powerful tool in a challenger's arsenal. They provide a universe of prior art to petitioners in post-grant patent challenges, but come with some technological limitations—such as incomplete web pages or broken links.

The PTAB has so far readily accepted Wayback Machine web pages as prior art. And while patent owners have yet to successfully exclude them as evidence, they should not be considered immune to all challenges under the Federal Rules just yet. ■



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