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Is It A Printed Publication? PTAB Panel May Give Answers

By **Matthew Bultman**

Law360 (April 12, 2019, 7:00 PM EDT) -- The panel that sets precedent for the Patent Trial and Appeal Board will tackle a question about what is required for a publication, such as a textbook, to be used to challenge patents, giving it a chance to provide clarity on a thorny issue that has divided PTAB panels in the past.

The Precedential Opinion Panel, or POP, agreed on April 3 to consider a case between Hulu and Sound View Innovations. Hulu asked the panel, which was created just last year, to intervene after the PTAB denied its bid for inter partes review of a Sound View data processing patent.

The board ruled a textbook Hulu claimed made Sound View's invention obvious hadn't been shown to be a "printed publication" that could be used in the challenge. The POP will consider what is required of a challenger in the initial stages of review to establish that a reference qualifies as a printed publication.

"My first thought was, it's about time that the board took this up," said Jon Wright, co-chair of the appellate and PTO litigation practices at Sterne Kessler Goldstein & Fox PLLC. "When you read [Hulu's] request for rehearing, you can see the wide variety of things that panels have done resolving this issue."

The panel of PTAB judges in Hulu's case was focused specifically on the textbook's copyright date and whether that date was, on its face, enough to show the book was available to the public. Public availability is a requirement for a reference to be a printed publication.

The question the POP agreed to consider — "What is required for a petitioner to establish that an asserted reference qualifies as 'printed publication' at the institution stage?" — is more broad, suggesting the panel could come up with a ruling that is applicable to a wider array of evidence.

This could include things like product user manuals or documents found on the internet, where copyright dates aren't an issue.

"I'm hopeful that the board provides some clarification to the broader question it asked," Wright said.

The Sound View patent challenged by Hulu relates to customizable data-processing applications. Hulu, which has been accused of infringing the patent, has argued the software operations it describes were well-known to computer scientists and database designers.

The entertainment company's challenge hinged on a textbook that was published by O'Reilly & Associates, called "Sed & Awk." The textbook had a copyright date of 1990, well before the patent's 1995 filing date.

But the PTAB in a December decision said the copyright date didn't establish the book was actually available to the public during the relevant time. For example, the board said it wasn't clear if O'Reilly always released the books it printed, or how long it took for them to become available.

"The board cannot speculate as to when and even whether, based on only a copyright year and the identity of the owner of copyright, the book was sufficiently publicly accessible such that persons interested ... in the subject matter, exercising reasonable diligence, could have located it," the PTAB wrote.

In an attempt to show public availability, Hulu had also submitted pages from a copy of the textbook kept at the Cornell University library. The pages were date-stamped September 1992. Still not convinced, the board said the textbook at Cornell was a different version than the one Hulu used in its challenge.

John Sganga, a partner at Knobbe Martens Olson & Bear LLP, said the decision is part of a larger trend from the board when considering questions about dates of publication.

"What we're seeing here is the PTAB keeps ratcheting up what you have to do at the institution stage, demanding more and more evidence," he said.

Hulu argued in its rehearing request that the decision conflicted with rulings from other PTAB panels in various respects. For example, several have found that when a publisher is well-known, a copyright notice is enough to treat the document as prior art at the institution stage, it said.

In one of those cases, the panel also held that any contradictions in the evidence regarding public availability should be viewed in the light most favorable to a challenger at institution, according to Hulu, which complained about the "irreconcilable approaches" between panels using copyright notices.

"The inconsistency in panel decisions has been recognized by the panels themselves," it said, highlighting a 2014 decision in which the board wrote that "panels have differed on whether a copyright notice is inadmissible hearsay or probative evidence of a printed publication."

There will always be particular facts that distinguish individual cases, attorneys said. A copyright date slapped onto a flyer or a marketing brochure, for example, is probably going to be viewed with more skepticism than the publication date on a New York Timesarticle.

For that reason, attorneys said it would be difficult for the POP to establish a bright-line rule that is going to resolve every case.

"The [Precedential Opinion Panel] is likely to use some broader language to set guideposts for future board decisions to follow so that there is some more uniformity in how the panels are treating purported printed publications where evidence of their public availability includes the copyright date," Nathan Speed, a shareholder at Wolf Greenfield & Sacks PC, said.

One guidepost Sganga suggested the panel could provide is to make clear when evidence, such as a declaration from a librarian attesting to public availability, needs to be presented.

“Part of why we’re seeing variability here is that practitioners are not sure whether they’re going to have to put in all of this evidence at the petition stage or whether they’re going to have another chance to supplement the record during the trial,” he said.

“That’s something,” he added, “that is more of a procedural issue that the board could really shed some light on and give everyone some guidance.”

Given the nature of IPRs, where patents can only be challenged based on earlier patents or printed publications, questions about whether a reference qualifies as a printed publication do often arise, turning this area into a key battleground.

For patent owners, it can be an opportunity to end a review before it even gets off the ground.

“Any time you’re a patent owner and a petition is relying on a printed publication as opposed to a [patent], one of the first things you’ll do is look to see whether or not there’s an argument to be made that that printed publication is not prior art,” Speed said.

The importance of the issue, and the frequency with which it arises, make this an area worth the attention of the precedent panel, Harness Dickey & Pierce PLC principal Glenn Forbis said. How the POP rules could have big implications.

“At the end of the day, [the panel] is going to set the height of the hurdle that a petitioner has to go through to establish something is a printed publication,” he said.

--Editing by Philip Shea.