

The PTAB's Evolving Evidentiary Standards: Printed Publications at the Institution Phase

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Summary

The PTAB's evolving evidentiary standards often perplex petitioners and patent owners. Historically, significant party effort has gone into attempting to establish that non-patent literature, such as articles, textbooks, conference proceedings, and the like qualified as a printed publication. Often times this was a frustrating exercise in futility given the lack of reasonable certainty as to what a particular panel would require. In 2019, the Patent Trial and Appeal Board (PTAB) addressed this issue head-on through the newly formed Precedential Opinion Panel (POP). Namely in *Hulu, LLC, v. Sound View Innovations, LLC*,¹ the POP determined that at the institution phase of trial "a petitioner must establish a reasonable likelihood that a reference is a printed publication."² And if trial is instituted, the petitioner has the burden to prove that "the reference is a printed publication by a preponderance of the evidence."³ The POP also endorsed several other cases addressing printed publication issues and provided helpful guidance.

Laying the Hulu Groundwork

In September 2018, the PTAB created the POP to decide issues of exceptional importance and thereby establish binding authority before the PTAB.⁴ It was thus no surprise that 2019 saw the first POP decisions, including the POP's decision in *Hulu, LLC, v. Sound View Innovations, LLC*.⁵

Before arriving at the POP, the initial panel in *Hulu v. Sound View Innovations* was asked to determine whether a specific textbook qualified as a "printed publication" that was "publicly available" and then, based on those inquiries, whether the textbook qualified as prior art against the challenged patent.⁶ The initial panel denied institution because it found that the Petitioner's attempt to show that the textbook ("Dougherty") was "publicly accessible" was "legally insufficient for multiple reasons" and therefore did not qualify as prior art. Specifically, the panel found that the Petitioner proffered public-availability evidence for a version of Dougherty that was different from the version relied upon in the petition and that it was unclear which version of the textbook was printed later.⁷ In denying institution, the panel explained that "the Board cannot speculate as to when and even whether, based only on a copyright year and the identity of the owner of copyright, the book was sufficiently publicly accessible."⁸ Because previous PTAB panel decisions offered conflicting opinions on this issue, POP review was granted.

The POP specifically ordered a review on rehearing to address the question: "What is required for a petitioner

to establish that an asserted reference qualifies as 'printed publication' at the institution stage?"⁹ The POP's Answer: At the institution-phase of trial, "a petitioner must establish a reasonable likelihood that a reference is a printed publication."¹⁰ And if trial is instituted, the petitioner has the burden to prove that "the reference is a printed publication by a preponderance of the evidence."¹¹

The POP further concluded that each decision must be made based on the totality of evidence on the record for each proceeding but declined to hold that any particular evidence is *per se* sufficient to show public availability.¹² While the POP did not provide explicit direction on how or when the standards are met, the POP did provide guidance regarding the evidentiary standard at the institution phase of an IPR proceeding.¹³

In the *Hulu* proceeding, specifically, the POP determined that the following evidence presented by the Petitioner regarding Dougherty was sufficient for instituting an *inter partes* review: (i) a copyright date of 1990, a printing date of November 1992, (ii) an ISBN date of 8/94, (iii) evidence that the book was a textbook from an established publisher and a well-known book series, and (iv) that a cover of an issue of Publisher's Weekly magazine stating that "The Internet Was Built With O'Reilly Books."¹⁴

Hulu's Guidance with Respect to Existing Printed Publication Decisions

The POP also tacitly endorsed three PTAB decisions where the Petitioner satisfied its initial burden at institution to show that a non-patent reference was a printed publication that was publicly accessible, including:

1. *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2018-00156 – The Board determined that a package insert for a drug, supported with a screenshot of an FDA webpage from the Wayback Machine, a declaration from the office manager of the Internet Archive including the site's archival records, and expert testimony asserting its public accessibility was sufficient evidence for instituting an *inter partes* review.¹⁵
2. *Seabery N. Am. Inc. v. Lincoln Global, Inc.*, IPR2016-00840 – The Board determined that a thesis, supported with a declaration from the author's thesis advisor discussing the university's thesis publication practices and with evidence of indexing on a national library system website, was sufficient evidence of public accessibility to institute an *inter partes* review.¹⁶
3. *Syncro Soft SRL v. Altova GmbH*, IPR2018-00660 – the Board determined that a user manual, supported

with a copyright notice, metadata information from the reference on the company's website, the release date of the printed version, a declaration from the office manager of the Internet Archive, and a declaration from an expert stating that she located and obtained a copy of the reference before the patent's filing date, was sufficient evidence of public accessibility to institute an *inter partes* review.¹⁷

Moreover, the POP tacitly endorsed two decisions that found Petitioner's evidence that a reference was a printed publication that was public availability insufficient for purposes of institution:

1. *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204 – the Board determined that a dissertation, supported with a Joint Statement of Uncontested Facts from a related district court litigation identifying the dissertation as prior art for the purposes of that litigation, and evidence that a student's dissertation advisor cited similar dissertations was insufficient to show public accessibility for purposes of institution.¹⁸
2. *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849 – the Board concluded that a conference paper, bearing a copyright date of 2012 and including a date of September 2012 on its cover, was insufficient to show that the paper had been disseminated prior to a November 2012 conference.¹⁹

Hulu Provides Helpful Guidance to Petitioners and Patent Owners

In view of the POP's decision in *Hulu, LLC, v. Sound View Innovation*, petitioners and patent owners should consider the following evidence when evaluating whether a reference qualifies as a printed publication that was public availability:

- Textbooks: (i) the textbook's copyright date and printing date; (ii) the textbook's ISBN date; (iii) evidence that the textbook was from an established publisher and/or a well-known book series; and (iv) any other evidence showing public

availability, including a magazine article or a supporting declaration.²⁰

- Webpages or Electronic Documents: (i) a screenshot of the webpage from the Wayback Machine²¹; (ii) a declaration from the office manager of the Internet Archive including the site's archival records; and (iii) expert testimony asserting its public accessibility.²²
- Theses and Dissertations: (i) a declaration discussing the university's publication practices and (ii) evidence of indexing on a national library system website.²³

Note: a dissertation, supported with (i) a Joint Statement of Uncontested Facts from a related district court litigation identifying the dissertation as prior art for the purposes of that litigation and (ii) evidence that a student's dissertation advisor cited similar dissertations has been found to be insufficient to make a threshold showing of public availability.²⁴

- User Manuals: (i) a user manual's copyright notice, metadata information from the user manual on the company's website, and the release date of the printed version; (ii) a declaration from the office manager of the Internet Archive; and (iii) a declaration from an expert stating that she located and obtained a copy of the reference before the patent's filing date.²⁵
- Conference Papers: (i) a conference paper's copyright date; and (ii) additional explanation or persuasive corroborating evidence explaining how, or why, the date qualifies the conference paper as a publicly accessible printed publication is required.²⁶

Note: absent additional explanation or corroborating evidence, a copyright date appearing on a conference paper has been found to be insufficient to show that a paper was disseminated prior to a conference.²⁷

¹ *Hulu, LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, (PTAB December 3, 2018).

² *Id.* at 21, *emphasis added*.

³ *Id.*, *emphasis added*.

⁴ PTAB Standard Operating Procedure (SOP) 2 (Revision 10), 3.

⁵ *Hulu, LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 12, (PTAB December 3, 2018).

⁶ *Id.* at 9.

⁷ *Id.* at 9-10.

⁸ *Id.* at 12.

⁹ *Hulu, LLC, v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 2 (PTAB December 20, 2019).

¹⁰ *Id.* at 21, *emphasis added*.

¹¹ *Id.*, *emphasis added*.

¹² See *id.* at 19, 21.

¹³ See *id.* at 17-18.

¹⁴ See *id.* at 19-20.

¹⁵ See *Hulu, Paper 29 at 18 (citing Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2018-00156, Paper 11 at 8-13 (PTAB June 5, 2018).)

¹⁶ See *id.* at 18 (citing *Seabery N. Am. Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 11 at 7-8 (PTAB Oct. 6, 2016).)

¹⁷ See *id.* at 18-19 (citing *Syncro Soft SRL v. Altova GmbH*, IPR2018-00660, Paper 6 at 8-10 (PTAB Sept. 5, 2018).)

¹⁸ See *id.* at 19 (citing *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204, Paper 19 at 8-12 (PTAB May 23, 2016).)

¹⁹ See *id.* at 19 (citing *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 14 at 4-13 (PTAB Sept. 6, 2019).)

²⁰ See *id.* at 19-20.

²¹ Internet Archive – Wayback Machine (<https://archive.org/web/>).

²² See *Hulu, Paper 29 at 18 (citing Sandoz at 8-13)*.

²³ See *id.* at 18 (citing *Seabery N. Am. at 7-8*).

²⁴ See *id.* at 19 (citing *Argentum Pharm. at 8-12*).

²⁵ See *id.* at 18-19 (citing *Syncro Soft at 8-10*).

²⁶ See *id.* at 19 (citing *In-Depth Geophysical at 4-13*).

²⁷ See *In-Depth Geophysical at 9-13*.