

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Best Practices For Proving A Document Is A Printed Publication

Presenters: Judges Lora Green & Brian McNamara

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Overview

- Burdens
- Underlying Legal Principles
- Frequent Printed Publication Issues
- Summary of Best Practices

Burdens in Post Grant Proceeding

- Petitioner bears the burden of demonstrating that the reference is a printed publication
- At institution, Petitioner must demonstrate a reasonable likelihood (IPR) or that it is more likely than not (CBM, PGR) that the reference qualifies as a printed publication
- The burden of production shifts to Patent Owner to present evidence demonstrating that the reference is not a printed publication. *Cf., Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015)

Burdens in Post Grant Proceedings

- **The burden of persuasion always remains with Petitioner.** *In re Magnum Oil Tools Int'l, Ltd*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (“In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.”).
- Thus, at final written decision, **it is Petitioner’s burden to demonstrate that the reference is a printed publication by a preponderance of the evidence.** 35 U.S.C. § 316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”)

Burdens in Ex Parte Proceedings

- The **burden of making a prima facie case that a reference is a printed publication is on the Examiner**. MPEP § 2128(II)(B) (“Absent evidence of the date of publication that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date) it cannot be relied upon” as prior art); *but see* MPEP § 2128(II)(A) (“The Office policy requiring recordation of the field of search and search results ... weighs in favor of finding that Internet and on-line database references are accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents”).
- Once the Examiner makes a prima facie case, **the burden shifts to Applicant to demonstrate that a reference is not a printed publication**. *In re Nature Remedies, Ltd.*, 315 Fed. Appx. 300, 2009 WL 615841 (Fed. Cir. 2009). *Cf. In re Epstein*, 32 F.3d 1559, 1570-71, 31 USPQ2d 1817, 1824-25 (Fed. Cir. 1994) (Plager, J., concurring) (discussing the concept of the prima facie case in connection with a public use or on sale bar).

Burdens in Ex Parte Proceedings

- On appeal to the PTAB, **the Board determines if the rejection is supported by a preponderance of the evidence.** See *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (“[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections ...”), *Ex parte SPX Corp.*, App. 2006-1875 (BPAI March 14, 2007) (same).

Underlying Legal Principles

- Touchstone is “**public accessibility.**” *In re Hall*, 781 F.2d 897-899 (Fed. Cir. 1986)
- **Case by case inquiry into facts and circumstances** surrounding reference’s **disclosure to members of the public.** *In re Klopfenstein*, 380 F. 3d 1345, 1350 (Fed. Cir. 2004) – Who is the public? What is “accessible?”
- Key Inquiry – whether reference was made “**sufficiently accessible** to the **public interested in the art**” before critical date. *In re Lister*, 583 F. 3d 1307, 1311 (Fed. Cir 2009)
- Reference is publically accessible upon satisfactory showing that 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.**” *Kyocera Wireless Corp. v. ITC*, 545 F. 3d 1340, 1350 (Fed. Cir. 2008)
- If accessibility proved, no requirement to show particular members of the public received the information. *Constant v. Advanced Micro Devices, Inc.*, 848 F. 2d 1560, 1568 (Fed. Cir. 1988)

Underlying Legal Principles

- If **no facts in dispute**, whether reference is printed publication is **question of law**. *In re Cronyn*, 890 F.2d 1158-1159 (Fed. Cir. 1989)
- **Burden of proof on party seeking to introduce reference** – sufficient proof of dissemination to persons concerned with art to which document relates and most likely to avail themselves of its content. *In re Wyer*, 655 F. 2d 221, 227 (CCPA 1981)
- POSITA can **locate it and recognize** therefrom the **essentials of the claimed invention without** the need for **further research** or experimentation. *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)
- Form of publication not determinative – may be in print, by data retrieval system, etc. *In re Wyer*, 655 F.3d at 226
- Additional Guidance: § MPEP 2128

Frequent Printed Publication Issues

- Documents stored in public/private libraries
- Conference proceedings
- Oral presentations
- Slide presentations
- Advertisements
- On-line versions of texts/documents
- Websites
- Wayback Machine
- Data sheets/Application notes
- Clinical trials
- Patent file histories
- Copyright notice
- Video recordings/Web Video Clips

Documents Stored In Public/Private Libraries

- Doctoral thesis indexed and shelved in library, even if library access restricted, is printed publication. *In re Hall*, 781 F. 2d 897 (Fed. Cir. 1988)
 - Proved by testimony about cataloguing and shelving practices at the time
- Even if library access restricted, still printed publication if presumption is raised that portion of public concerned with art would know of invention.
 - No such presumption when only 3 members of graduate committee have access. *In re Bayer*, 568 F. 2d 1357 (CCPA 1978)
- Doctoral theses shelved and indexed on index cards in shoe box kept in chemistry department and filed alphabetically by student name & title not catalogued in meaningful way – not printed publication. *In re Cronyn*, 890 F.2d 1159 (Fed. Cir 1989)
 - Thesis could only be found if student's name known
 - Researcher's name bears no relation to subject of thesis
- Petitioner showed document submitted to CERN Library, but not when it became publically accessible, or that POSITA would have been able to locate it - not printed publication. *EMC Corp. v. Acqis*, IPR2014-01469 (PTAB Mar 8, 2016) (Final Dec)
- **Best Practice:** prove by testimony that demonstrates dissemination, public accessibility
 - When document received, when & how catalogued (show how the relevant public could locate it)
 - If possible provide testimony by person responsible for cataloguing & shelving at time of receipt
 - Next best thing – testimony by person with knowledge of procedures in place at time of receipt, e.g. successor to person who catalogued document
 - Other options: written or formal cataloging/shelving procedures; person who can testify as to informal procedures regularly followed

Conference Proceedings

- **Prove date of availability NOT date of conference**
 - May be same if document made available at conference
 - **Best practice:** Prove with evidence, e.g., testimony by attendee
 - **Next best thing:** Evidence from those knowledgeable about the preparations and actual dissemination of the subject proceedings;
 - **Next, next best thing:** Evidence by those knowledgeable of how such proceedings are generally prepared and distributed (may be insufficient)
- **Alternative evidence**
 - Conference Publication database; IEEE, etc.
 - **Caution:** some databases only provide year of publication (evidence of publication only on the last day of the year) – relying on the actual date of the conference as publication date of document may require additional testimonial evidence from attendee or someone with actual knowledge *See Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2016-01169 (PTAB Dec. 14, 2016) (Dec. to Institute)

Oral and Slide Presentations

- **Oral Presentation w/o slides or other documentation**
 - NOT printed publication
- **Reference displayed but not distributed or indexed**
 - **Best practice:** Prove printed pub status with evidence – Testimony of attendee or one with actual knowledge; Photographs of presentation
 - 4 Factors
 - Length of time display exhibited
 - Expertise of target audience
 - Existence (or lack thereof) of reasonable expectations that material would not be copied
 - Ease with which material could be copied
 - reference shown to members of public having ordinary skill who could take notes and photographs of the reference, for lengthy amount of time and absence of restrictions on use of reference was sufficiently accessible to be a printed publication *In re Klopfenstein* at 1350.
 - Testimony that 14 page slide presentation was submitted to IEEE 801.11 high throughput study group found not present sufficient facts and circumstances to demonstrate disclosure to public. *Huawei Device USA, Inc. v. SPH America, LLC*, IPR2015-00221 (PTAB May 28, 2015)
- **Slide presentation distributed but not indexed**
 - **Best practice:** Prove with evidence/testimony of attendee or one with actual knowledge, e.g. conference organizer, that document was available and disseminated at conference



Data Sheets, Application Notes, Advertisements

- **Date on face of document generally not sufficient to show public accessibility – must show dissemination**
 - Advertisement in magazine & mailer not prior art in absence of evidence of receipt by any of the addressees before filing date. *Carella v. Starlight Archery*, 804 F. 3d 135 (Fed. Cir. 1986)
- **Date on data sheet not sufficient proof of public availability. *Toshiba Corp. v. Optical Devices LLC*, IPR2014-01447 (Final Dec. Mar 9, 2016)**
 - Press announcement of new product (obtained on Wayback Machine) is evidence of product availability, not evidence datasheet was available
 - Testimony that “it stands to reason” datasheet was also available “as chip companies typically disseminate a datasheet” not persuasive as not based on specific knowledge or underlying facts
- **Declaration of corporate director of marketing that company’s practice has been to make publicly available datasheets and articles for devices it offers for sale supports conclusion that data sheet is printed publication as of the date on data sheet. *Kinetic Tech. Inc. v. Skyworks Solutions, Inc.*, IPR2014-00690 (PTAB Oct. 19, 2015)(Final Dec.)**
- **Best practice** – obtain testimony from chip company personnel with actual knowledge or at least knowledge of normal practices concerning such documents
 - Declaration of CEO sufficient to support public availability of dated manual . See *In re Enhanced Security Research*, 739 F. 3d 1347, 1354-55 (Fed. Cir. 2014)



Websites/WayBack Machine

- **Current Webpages**
 - Typically provided as a printed exhibit
 - Not generally self-authenticating – evidentiary issue
 - Authenticity: Testimony of person who printed it out as to when it was printed and what it looked like, e.g., Attachment 1 is printed version that accurately represents the screen I observed on (date certain) and which I printed out
 - Similar to testimony to establish photograph is fair and accurate representation of what a witness saw
 - Does not establish what the page looked like on an earlier date
- **Archived Webpages: Authentication v. Hearsay with respect to Printed Publication**
 - Use webpages that no longer exist as prior art
 - Authenticate with affidavit Wayback Machine employee with personal knowledge of contents who can verify copy is true and accurate copy of WBM records. Note: some courts have required testimony from original poster
 - Hearsay (AIA proceedings apply FRE; ex parte proceedings, e.g., ex parte reexams do not):
 - (i) not hearsay if website describes product/concept sufficiently to anticipate or render obvious, because it is admissible without regard to its truth to show statements were made;
 - (ii) is hearsay for purpose of showing disclosure was available to the public as of critical date – proponent must prove truth of matter asserted, i.e., that archive accurately represents the website on specific date – possible approaches: (1) testimony from original poster; (2) testimony from employee of Internet Archive having personal knowledge of archiving practices.

On-Line Versions of Documents/Texts

- Temporary availability – *Electronic Frontier Foundations v. Personal Audio, LLC*, IPR2014-00070 (Apr. 18, 2014)
 - Insufficient factual evidence that temporarily available document obtained through Wayback Machine and no longer existing at URL was publically accessible
 - Face of document says it was posted to a group, but Petitioner provides no evidence about the group, its members, or its size
- Publicly available as of date publicly posted
 - Establish earlier date by copy of original document
- Other Circumstances – e.g., on-line version of textbook
 - Is it worth objecting? Was document generally available off-line?
 - Residual hearsay exception FRE 807 – equivalent circumstantial guarantees of trustworthiness
- **Best Practice:** provide sufficient evidence of public dissemination; Choose battles wisely

Patent File Histories, Copyright Notices

- **Patent File Histories**

- Citation in IDS alone is NOT sufficient to demonstrate document is printed publication. *Microsoft Corp. v. Bascotti Inc.*, Case IPR2014-01457, slip op. at 25–28 (PTAB Mar. 19, 2015) (Paper 9)
- File history of patent reference is accessible to anyone who sought it - its contents is available as prior art. *Duodecad IT Svcs. Luxembourg S.A.R.L. v. WEG Acquisition LLC*, IPR2015-01036 (PTAB Oct. 20, 2016) (Final Decision)

- **Copyright Notices**

- Copyright Notice sheds virtually no light on public accessibility as of that date – additional evidence required. *Microsoft Corp. v. Corel Software, LLC*, IPR2016-01300 (PTAB Jan. 4, 2017)(Denial of Institution)
- Copyright Notice as hearsay v. probative evidence of publication discussed. *Xactware Solutions, Inc. v. Pictometry Int'l. Corp.*, IPR2016-00593 (PTAB Aug. 31, 2016)(Dec. to Institute); *Ford Motor Co. v. Versata Development Grp., Inc.*, IPR2016-01014 (PTAB Sept. 27, 2016)(Denial of Institution)

Video Recordings, Web Video Clips

- Narrated video recorded on CD satisfies “printed” requirement because CD includes indicia stored on it that defines content to be displayed
 - BUT was not a “publication” because evidence showed dissemination limited to surgeons who qualified through application and approval process were far more qualified than those of ordinary skill). *Medtronic, Inc. v. Mark A. Barry*, IPR2015-00780 (PTAB Sep. 7, 2016)(Final Dec.)
- Product video continuously available to public on Internet for about a year found to be a printed publication. *Acco Brands Corp. v. Think Products, Inc.*, IPR2015-1167 (PTAB Oct. 11, 2016)(Final Decision)
 - Petitioner provided declaration of ACCO Brands employee concerning development and availability of website to promote its ClickSafe product
 - Frames of video disclosed the claimed features
- **Best Practice:** To rely on a video, provide evidentiary support for its public accessibility

AIA Procedural Issues

- **Status as prior art printed publication is substantive, not evidentiary issue**
 - Not subject matter for motion to exclude
 - Address in substantive papers, e.g. petition, preliminary response; *See Kinetic Tech., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00690 (PTAB Oct. 19, 2015)(Final Dec.)
- **Best Practice for Petitioner – Address in AIA Petition**
 - Patent Owner may dispute status of document as printed publication in Preliminary Response
 - No guarantee panel will allow Petitioner to respond if raised in Preliminary Response
- **Best Practice for Patent Owner – Dispute in Preliminary Response**
 - May defeat institution; can raise again after institution with more insight into panel's view
 - Delaying allows Petitioner to refute in Petitioner Reply – could require Patent Owner to depose witness and rely on Observations on Cross Examination – less opportunity to argue
 - *Motorola Mobility v. Intellectual Ventures*, IPR2014-00501: evidence in Petitioner's Reply OK because Petitioner provided sufficient evidence to make initial determination, evidence was submitted in reply to Patent Owner's arguments, Patent Owner had opportunity to cross-examine Petitioner's witness
- **Motion to File Supplemental Information – w/in 30 days of institution**
- **Typical Evidentiary Objections to Documents**
 - Lack of Authentication
 - Hearsay
- **Typical Evidentiary Objections to Petitioner's Supporting Evidence**
 - Hearsay, Testimony not based on actual knowledge
 - Relevance



Best Practices Summary

- Remember that printed publication status is a question of law based on underlying facts
- Recognize that each case is unique and has its own set of facts – plan your case accordingly
- Recognize that most printed publication issues concern public accessibility
- In AIA cases address such issues in Petition and Preliminary Response
- Consider issues that require proof, especially for on-line documents
- Support positions with declarations from persons with actual knowledge of events, if possible; rely on evidence of formal or regular procedures as backup
- Address ultimate question of printed publication status as a substantive issue, not an evidentiary matter – NOT subject matter for a motion to exclude
- Consider possible evidentiary issues in *inter partes* proceedings
- Successful motions to exclude certain evidence may result in there being insufficient factual evidence to establish printed publication status as a matter of law

Example Bio/Pharma AIA proceedings Involving Printed Publication Issues

- **Protocols for Clinical Trials**

- *Boehringer Ingelheim Int'l GMBH v. Biogen, Inc.*, IPR2015-00418 (PTAB Jul. 13, 2015) (Dec. Inst.) (published protocols for cancer treatments not sufficiently shown to be printed publications as they were not shown to be disseminated by a cooperative group that perform multicenter cancer clinical trials).
- *Coalition for Affordable Drugs IV LLC V. Pharmacyclics, Inc.*, IPR2015-01076 (PTAB Oct. 19, 2015) (Dec. Inst.) (published clinical trial apparently retrieved from www.clinicaltrials.gov not shown to be a printed publication as Petitioner did not submit a threshold amount of evidence demonstrating it was available before the critical date).

- **Drug Labels**

- *Frontier Therapeutics, LLC. V. medac Gesellschaft fur klinische Spezialpraparate mbh*, IPR2016-00649 (PTAB Sep. 1, 2016) (Dec. Inst.) (package insert for a pharmaceutical product not sufficiently shown to be printed publication; Board found conclusory statements of Petitioner's expert without supporting evidence to be insufficient to establish public availability).
- *Mylan Pharm., Inc. v. Boehringer Ingelheim GMBH*, IPR2016-01565 (PTAB Aug. 1, 2017) (Req. Reh'g Dec. Inst.) (finding that Petitioner did not provide evidence demonstrating that drug label was publicly available, noting that "a copyright date is associated with the creation of a document, but not necessarily its publication.").
- *Pfizer Inc. v. Biogen Inc.*, IPR2017-01166 (PTAB Nov. 13, 2017) (Dec. Inst.) (drug label not shown by Petitioner to be a printed publication as the record was 'devoid of evidence' demonstrating the public availability of the label before the critical date).
- *Teva Prarm. USA, Inc. v. Indivor UK Ltd.*, IPR2016-00280 (PTAB Jun. 10, 2016) (Dec. Inst.) (drug label not shown to be printed publication even though patent owner had appeared to stipulate to that in a co-pending litigation).

- **Reports filed with the U.S. Securities and Exchange Commission ("SEC")**

- *Celltrion, Inc. V. Biogen, Inc.*, IPR2017-01095 (PTAB Oct. 6, 2017) (Dec. Inst.) (Annual Report filed with SEC was not sufficiently established to be a printed publication based on Petitioner's reliance on the EDGAR Filing Manual and EDGAR Filing Details showing filing date and acceptance of the report).

Example Bio/Pharma AIA proceedings Involving Printed Publication Issues

- **Public Presentations**

- *Coalition for Affordable Drugs VIII, LLC v. The Trustees of the U. of Penn.*, IPR2015-01835 (PTAB Mar. 6, 2017) (Final Dec.) (concluding that a slide presented at an Investor Day not shown to be a printed publication as press release announcing the Investor Day did not mention subject matter of slides, and no evidence the slide set was presented to those of ordinary skill in the art; in addition slides themselves were not shown to be printed publication as “Wayback Machine” screenshots only showed a hyperlink and not the content of the slides and hyperlink now defunct).

- **Posters**

- *Mylan Pharm., Inc. v. Boehringer Ingelheim GMBH*, IPR2016-01565 (PTAB Aug. 1, 2017) (Req. Reh’g Dec. Inst.) (finding that Petitioner’s expert only offered a conclusory statement as to the date of publication, noting that it did not appear that declarant had personal knowledge as to when and how the reference was made available to the public).
- *Oxford Nanopore Tech. Ltd. v. U. of Wash.*, IPR2014-00513 (PTAB Feb. 26, 2016) (Final Dec.) (finding that a poster presented at a session wherein the attendees of the session were primarily connected to the presenters (e.g. mentors, friends, family members) was not presented to interested persons of ordinary skill in the art, and was, thus, not a printed publication).
- *Coalition for Affordable Drugs LLV v. Acorda Ther., Inc.*, IPR2015-00817 (PTAB Aug. 24, 2015) (Dec. Inst.) (after analyzing consideration in *Klopfenstein*, concluding that Petitioner had not established a threshold showing that two poster presentations constituted prior art).

- **Master’s Thesis**

- *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204 (PTAB May 23, 2016) (Dec. Inst.) (concluding that Petitioner had not made a threshold showing that thesis was publicly available before the critical date. Stipulation in co-pending litigation not sufficient as Patent Owner may have had a reason to stipulate, such as streamlining trial. University’s refusal to provide information to Petitioner did not give rise to rebuttable presumption that establishes a reasonable likelihood thesis is prior art).

QUESTIONS?

Boardside Chats

Date	Time	Topic
Tuesday, February 1, 2018	Noon to 1 pm Eastern Time	Design Patent Appeals
Tuesday, April 5, 2018		AIA Motion Practice
Tuesday, June 7, 2018		Motions to Exclude and Strike in AIA Trials
Tuesday, October 4, 2018		Motions to Seal, Protective Orders, and Confidential Information in AIA Trials
Tuesday, December 6, 2018		Hearsay and Authentication

THANK YOU

