

# Managing Intellectual Property

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## SPONSORED POST: COPYRIGHT NOTICES AS PRIMA FACIE EVIDENCE OF PUBLIC ACCESSIBILITY

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**Validity challenges under the AIA increasingly rely on non-traditional publications such as web-based publications and product brochures. Michael O'Neill of Fitzpatrick Cella Harper & Scinto discusses the extent to which the publication's copyright notice, which often is the only evidence submitted to prove the date of publication, is adequate for the task**

Missing an opportunity to clarify an increasingly common corner case, the Patent Trial and Appeal Board (PTAB) again skirted the issue of whether a copyright notice, standing alone, is sufficient evidence of public accessibility, at least for purposes of deciding whether to institute proceedings in an *inter partes* review (IPR). See *Intex*



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*Recreation Corp et al v Bestway Inflatables & Material Corp*, IPR2016-00180 (Paper 13, June 6 2016), in which the PTAB instituted review, despite unresolved issues of whether an owner's manual was publicly accessible on the date indicated by its copyright notice.

By way of background, challenges under IPRs are characterised by the requirement that they be based only on patents and printed publications. See 35 USC § 311(b). A publication is a "printed publication" if it was disseminated and/or otherwise made available and accessible to the interested public. Where the challenge is based on a publication from well-known scientific and technical journals, such as IEEE publications, the copyright notice usually suffices, despite recognition that the copyright notice is hearsay evidence on the date of publication. See, for example, *TRW Automotive US LLC v Magna Electronics Inc*, IPR2014-01347 (Paper No. 25, January 6 2016).

In an increasing number of corner cases, however, the publication alleged to be a printed publication may be rooted in a non-traditional source. As examples taken from a variety of cases, the challengers have relied on: a product brochure describing features of an infrared camera (*FLIR Sys Inc v Leak Surveys Inc*, IPR2014-00411); a technical specification on a USB controller designated as "preliminary" by its manufacturer (*LG Elecs Inc v Advanced Micro Devices Inc*, IPR2015-00329); a European report on an R&D project on cruise control for automobiles where the R&D project spanned nearly a decade (*Ford Motor Co v Cruise Control Techs LLC*, IPR2014-00291); and an on-line knitting guide said to disclose broad

features of a patented loom (*IdeaVillage Prods Corp v Choon's Design LLC*, IPR2015-01143).

Like these cases, the publication in the *Intex* case was non-traditional: an owner's manual said to disclose broad aspects of the challenged patent on a filter pump for a pool. Relying only on the manual's copyright notice, the challenger asserted that it was a printed publication that pre-dated the critical date of the patent.

Under the rules for IPRs, the patent owner is entitled to file a preliminary response, before the PTAB even decides on whether to institute proceedings. The patent owner did so here, and challenged the sufficiency of a copyright notice as the sole piece of evidence on whether the owner's manual constituted a printed publication.

Before issuing its decision on whether to institute proceedings, the PTAB issued an order in which it recognised that there had been inconsistent outcomes on the issue of whether a copyright notice, standing alone, amounts to sufficient evidence of public accessibility for purposes of deciding whether to institute proceedings. *Intex*, IPR2016-00180 (Paper 9, March 25 2016). It invited the parties to submit briefings, which they did.

But rather than deciding the issue, the PTAB simply instituted proceedings. It reasoned that there were multiple grounds for instituting proceedings, including grounds that did not rely on the owner's manual. Given the existence of other grounds for institution, the PTAB concluded that efficient resolution of the challenge favoured institution on all proposed grounds, including grounds based on the owner's manual:

“Here, there is considerable dispute over the material facts surrounding public dissemination of the [owner's manual]. This issue, however, is not a factor with respect [other proposed grounds for institution]. Thus, at this stage, we need not reach the dispute regarding whether [these] manuals have been established properly to be “printed publications” under 35 U.S.C. § 102.” See *id.*, paper 13 at page 13.

The issue thus remains open. Best practices suggest that in filing a challenge based on non-traditional publications, the challenger might be advised to offer direct declaration evidence that the publication was publicly accessible as of its copyright date, which is something that the challenger in *Intex* failed to do.

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