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Spotlight On Public Availability In Inter Partes Review

Law360, New York (February 27, 2015, 10:50 AM ET) -- In one limitation of inter partes review, as opposed to other forms of post-grant challenges to patent validity, the challenge must rely only on patents or printed publications, and not on other forms of prior art such as prior sales or use. 35 U.S.C. § 311(b). Several factors combine to determine whether prior art qualifies as a "printed publication," and one such factor is the notion of reasonable accessibility to interested members of the relevant public. See *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981).



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Two back-to-back decisions by the Patent Trial and Appeal Board help to bookend its views on when information in an IPR proceeding is or is not a printed publication. One decision, *Sipnet EU S.R.O. v. Straight Path IP Group Inc.*, IPR2013-00246 (paper 62, Oct. 9, 2014), determined that the information constituted a printed publication, whereas the other, *A.R.M. Inc. v. Cottingham Agencies Ltd.*, IPR2014-00671 (paper 10, Oct. 3, 2014), determined that it did not.

Sipnet's patent involved a point-to-point Internet protocol which uses a server to determine whether a second process is connected to a computer network. The challenger relied on a printed version of Windows TCP/IP User Guide which described the Windows Internet Name Service server. The printed version of WINS included a copyright date, but warned that it was distributed only with new PCs.

Because of distribution only with new PCs, the patent owner asserted that the printed version of WINS was not publicly available and thus did not constitute a printed publication.

The PTAB ultimately sided with the challenger, relying on supplemental evidence provided by the challenger on public availability. This supplemental evidence included a CD version of the printed WINS version, together with declaration testimony of a worker in the field of computer installation, who testified that he personally saw the printed version and the CD version in the pertinent time frame. The PTAB ruled that the supplemental evidence established that the printed version of WINS was publicly available, and invalidated the challenged claims.

The challenger in *A.R.M.* did not fare as well. *A.R.M.* involved a patent on an aerial ride for

amusement parks, and the challenger relied on a brochure showing the construction of an aerial ride called the "Barnstormer." Barnstormer itself was an actual, operational ride, undisputedly in public use and readily available to the public during the pertinent times. But the patent owner objected to use of the brochure, asserting that unlike the ride, the brochure was not similarly available to the public. The challenger did not respond with any supplemental evidence.

The PTAB sided with the patent owner and concluded that there was insufficient evidence to establish that the brochure was made available to interested persons skilled in the art. It therefore refused even to institute IPR proceedings.

One takeaway from these decisions is a reminder that the evidentiary burden of establishing public availability remains always with the challenger. Moreover, this evidentiary burden exists at both the institution stage and the final decision stage. See *Palo Alto Networks Inc. v. Juniper Networks Inc.*, IPR2013-00369 (Paper 39, Feb. 14, 2014).

But at what level of proof? Here again, the PTAB has stated its view. The burden of persuasion is a preponderance of the evidence standard, i.e., the challenger must show by a preponderance of the evidence that the reference in question was published and available publicly prior to the critical date. See, for example, *Toyota Motor Corporation v. American Vehicular Sciences LLC*, IPR2013-00417 (Paper 78, Jan. 7, 2015).

Toyota was arguably a close question, demonstrating that even a scant evidentiary advantage will satisfy the "more likely than not" nature of the preponderance standard. Each side presented conflicting evidence over whether an invalidating article by Fry was publicly available at the beginning of 1995 or at the end. The patent owner pointed to date-stamped copies of the article, submitted by Toyota as part of its challenge, for which even the earliest of the stamped dates was later than the critical date. Toyota freely admitted that it could not find a copy of the Fry article with an earlier date, but relied instead on supplemental evidence including a pair of declarations. The first declaration, from the author Fry, attempted to prove an early publication date by inference, using an award won by Fry for his article. According to Fry's declaration, the award had been won early in 1995, thus proving the earlier date. The PTAB gave only minimal weight to Fry's declaration, saying that any such inference was weak at best, and not based on the personal knowledge of Fry.

The second declaration, from a librarian at the publisher for the Fry article, was given more weight, but apparently only because the patent owner failed to cross-examine the declarant. The PTAB viewed this declaration as if it were testimony of the publisher itself, providing personal knowledge of the publisher's publishing records and practices. The declaration included direct testimony that the Fry article was published early in 1995, before the critical date. The PTAB criticized the patent owner for failing to cross-examine the declarant, which is always permitted as part of routine discovery, observing that had it done so, the patent owner might have developed deficiencies in the testimony.

Acknowledging the conflict in the evidence presented by the parties, and implicitly recognizing the close nature of the outcome, the PTAB nevertheless concluded that Toyota had shown by a preponderance of the evidence that the Fry article was available publicly prior to the critical date, resulting in invalidation of the sole remaining claim in the patent.

Practitioners confronted with this issue should remember that the evidentiary burden is a mere preponderance, and remains with the challenger throughout all stages of inter partes review.

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