

Proving Up Publications as Prior Art in *Inter Partes* Review Proceedings After *Hulu*



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Imagine The Following Scenario.

A product manual contains disclosures that mirror the claims of a patent that a competitor has been using to threaten your company. The cover of the reference bears a 2010 copyright date, which is a full two years before the competitor filed its patent. If this manual is provided in an *inter partes* review (IPR) against your competitor's patent, it would need to be proven up as prior art. How do you do that?

In *Hulu, LLC v. Sound View Innovations, LLC*, the U.S. Patent and Trademark Office Patent Trial and Appeal Board offered a precedential opinion on the topic. Here we examine that decision and its implications for IPR practitioners.

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Prior Art in *Inter Partes* Reviews

Any third party can petition the Patent Trial and Appeal Board at the United States Patent and Trademark Office (the Board) to review the patentability of a United States patent based on whether the invention was previously described in a patent or a printed publication. *See, e.g.*, 35 U.S.C. § 311(b).

It is conventional wisdom that a petitioner needs to lay all its evidentiary cards on the table in the petition. That includes evidence demonstrating that the relied-upon reference qualifies as prior art. The difficulty in proving up prior art depends on whether the reference is a patent or a publication. Patents and patent applications are easy—they are self-authenticating, and their listed publication date is taken as correct. For books, journal articles, product manuals, and other printed publications, however, the issue is far more complicated and unpredictable. Board panels have taken this issue on a case-by-case basis, and their opinions have varied widely.

Board Guidance in Proving Prior Art

Recently, the Board provided a precedential opinion on the topic. In *Hulu, LLC v. Sound View Innovations, LLC*, the Board addressed the question, “[w]hat is required for a petitioner to establish that an asserted reference qualifies as [a] ‘printed publication’ at the institution stage?” (IPR2018-01039, Paper 29, at 2 (P.T.A.B. Dec. 20, 2019) (precedential)), answering:

“[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.”

See Hulu, IPR2018-01039, Paper 29, at 13. The Board stated that this standard is higher than “mere notice pleading,” *i.e.*, where a theory merely needs to be articulated, but lower than the “preponderance standard,” *i.e.*, more likely than not, and further stated that a petitioner bears the burden to identify its evidence, with particularity, because there is no presumption that a reference qualifies as prior art.

Id. at 13, 16.

Turning to the specific circumstances in *Hulu*, the Board found that the petitioner’s showing was sufficient. The petitioner provided a publication from a well-known book series and publisher (O’Reilly), which bore copyright, printing, and ISBN dates. *Id.* at 19. The Board also found that a declaration showing that an earlier version of the book was collected and cataloged at a library demonstrated that the book in question was collected and cataloged. *Id.* at 20. Altogether, this evidence established a reasonable likelihood that the printed publication was made available to the pertinent public and qualified as prior art. *Id.*

Prior Panel Disparity in Dealing with Publications as Prior Art

The Board provided *Hulu* as a precedential opinion because of prior conflicting panel decisions, which required varying amounts of evidence to prove up a reference as prior art. *Hulu*, however, does not clear up all conflicts with its standard based on “evidence sufficient to establish a reasonable likelihood.” Post-*Hulu*, it is important to be aware of the panel disparities because they may provide guidance to future panels weighing the *Hulu* standard.

Numerous panels have accepted a reference, and its publication, at face value. As an example, in *Arista Networks, Inc. v. Cisco Systems, Inc.*, the Board found that a copyright notice on a Juniper Networks API guide met the institution threshold to demonstrate that it was prior art. IPR2016-00244, Paper 10, at 18–19 (P.T.A.B. May 25, 2016). The Board cited numerous panel decisions holding that “a copyright notice” alone is “prima facie evidence of publication.” *Id.* at 19.

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Some panels have applied this lower threshold even if the patent owner provided evidence challenging dissemination. For example, a panel held that a *New York Times* article qualified as prior art for the purposes of institution even though the patent owner submitted a declaration from a librarian contesting whether the article was indexed and searchable. *Shenzhen Zhiyi Tech. Co. Ltd. v. iRobot Corp.*, IPR2017-02137, Paper 9, at 19–20 (P.T.A.B. Apr. 2, 2018).

Further still, some panels have applied a low evidentiary threshold at final written decision, where the preponderance of evidence standard applies. In *Ericsson Inc. v. Intellectual Ventures I LLC*, one panel held that an Institute of Electrical and Electronics Engineers (IEEE) article bearing a copyright and an ISSN code—with no other evidence—qualified as prior art on its face. IPR2014-00527, Paper 41, at 10–11 (P.T.A.B. May 18, 2015).

Other panels have demanded more than what is described on a reference’s face to meet the institution threshold.

In *Alarm.com Inc. v. Vivint, Inc.*, a Honeywell engineering manual was rejected as prior art, even though it had a copyright date and a Library of Congress Catalog Card Number. IPR2016-00155, Paper 14, at 10–12 (P.T.A.B. Apr. 28, 2016). This panel found that a copyright date was insufficient to demonstrate public accessibility—it merely described a claim of ownership. *Id.* at 11–12. The Board deemed a Library of Congress Catalog Card Number insufficient because it did not explain how the manual “was cataloged or indexed in a meaningful way, such that it could be located by the public interested in the art.” *Id.* at 12. Such a Board panel may still find that the 2010 product manual described above, without additional evidence, does not meet the evidentiary threshold for institution post-*Hulu*.

Compounding the pre-*Hulu* confusion, some panels reached the exact opposite conclusion on the same type of evidence. In one final written decision, a panel held that an IEEE article’s copyright and ISBN are not probative of publication and are insufficient

to establish that the article is prior art. *TRW Auto. U.S. LLC v. Magna Elecs., Inc.*, IPR2014-01347, Paper 25, at 8 (P.T.A.B. Jan. 6, 2016). This is the opposite of the holding in *Ericsson Inc. v. Intellectual Ventures I LLC* on the same type of evidence—an IEEE article with a copyright date and ISSN. The above is just one example of diametrically opposed rulings.

There have been significant inconsistencies across panels, and there is still some unpredictability post-*Hulu* regarding how the Board will handle references at the institution stage.

Filing a Petition Today

Although *Hulu* provides guidance, the Board did not adopt the petitioner's proposed bright-line rule that a conventional marker of publication, such as a copyright date alone, should be sufficient to qualify a reference as prior art at the petition stage. *Hulu*, IPR2018-01039, Paper 29, at 17. Instead, the Board held that "indicia on the face of the reference . . . are [to be] considered as part of the totality of the evidence." *Id.* at 17–18.

But this raises the question, what level of evidence is sufficient to establish a reasonable likelihood that a reference is prior art? The Board answered that question for a book from a well-known series and publisher—copyright, printing, and ISBN dates are likely sufficient. *Hulu*, IPR2018-01039, Paper 29, at 19.

However, with other published materials that parties often seek to use as prior art (for example, a product manual), the answer remains murky, and petitioners should be cognizant of negative decisions such as *Alarm.com* and *TRW Auto* that may still be persuasive to the Board after *Hulu*.

When addressing published materials like a product manual to show that the reference is prior art, a petitioner should consider providing evidence to the Board demonstrating:

- how the reference was publicly disseminated;
- the individuals it was disseminated to; and
- how those individuals could obtain it.

This evidence should ideally take the form of a declaration from someone with personal knowledge of dissemination. Providing this evidence will be helpful to avoid negative decisions like *Alarm.com* when the question of public accessibility of a reference is not so clear.

Although decided before *Hulu*, *Stryker Corp. v. Karl Storz Endoscopy-America, Inc.* provides guidance for proving up a reference like a product manual as prior art. IPR2015-00677, Paper 15 (P.T.A.B. Sept. 2, 2015). The *Stryker* panel instituted trial but rejected the notion that a copyright notice by itself demonstrates public accessibility. *Id.* at 18–19. The petitioner, however, presented three declarations—from those with personal knowledge—demonstrating that the product manual was publicly disseminated and specifying the individuals to whom it was disseminated. *Id.* at 19–22. One declarant testified that the manual was shipped with the product. *Id.* at 21. Another testified that the manual was given to engineers at training sessions and to any customer who requested it. *Id.* In totality, this showing likely qualifies as "evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible."

What level of evidence is sufficient to establish a reasonable likelihood that a reference is prior art? The answer remains murky for several published materials used as prior art.

When declarations are not available to prove public accessibility, a petitioner should present any evidence it can obtain. As the Board noted in *Hulu*, it will look at the “totality of the evidence” in assessing whether a reference is prior art. *Hulu*, IPR2018-01039, Paper 29, at 17–18. As an example, a petitioner submitted dated Amazon.com reviews to support that a reference was publicly disseminated. *CIM Maint. Inc. v. P&RO Sols. Grp., Inc.*, IPR2017-00516, Paper 8, at 18–20 (P.T.A.B. June 22, 2017). This type of evidence would be helpful in demonstrating that the public had access to a publication.

Declaration Submissions in Post-*Hulu* Cases

A handful of post-*Hulu* cases have demonstrated that declarations should be submitted to prove up prior art. Two have found that a reference qualifies as prior art because of supporting declarations. See *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01279, Paper 7, at 9 (P.T.A.B. Jan. 9, 2020) and *Polycom, Inc., v. Directpacket Research, Inc.*, IPR2019-01234, Paper 19, at 37 (P.T.A.B. Jan. 13, 2020).

In *Lenovo*, the author of the prior art in question submitted a declaration, and, in *Polycom*, a declarant from the SANS Institute testified about the routine business practices surrounding publication (*i.e.*, availability, accessibility, and time of publication) of articles at the SANS Institute.

When declarations are not available to prove public accessibility, a petitioner should present any evidence it can obtain. As the Board noted in *Hulu*, it will look at the “totality of the evidence” in assessing whether a reference is prior art.

Another panel rejected a manual—which bore a confidential footer—as prior art when the petitioner failed to provide additional evidence, such as a supporting declaration. See *Garrett M. Salpeter v. ARP Mfg., LLC*, IPR2019-01382, Paper 13 (P.T.A.B. Dec. 27, 2019). Post-*Hulu*, panels are likely to react positively to supporting declarations.

Responding to a Challenged Reference

The *Hulu* panel also provided some guidance regarding how a petitioner might remedy patent owner challenges to the prior art status of a reference. The Board stated that “if the patent owner challenges a reference’s status as a printed publication, a petitioner may submit a supporting declaration with its reply.” *Hulu*, IPR2018-01039, Paper 29, at 15. However, the *Hulu* panel spoke only to the ability of petitioners to submit supporting declarations in reply. *Id.*

Submitting additional evidence is simple when filing a reply after institution, which a petitioner can do as a matter of right. If a patent owner raises issues before institution, however, the situation is more opaque. The Board allows a petitioner to file a reply to a patent owner’s pre-institution preliminary response only for good cause (see 37 C.F.R. § 42.108(c), *Huawei Device Co. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19, at 3–4 (P.T.A.B. Jan. 8, 2019) (precedential)). And the *Hulu* panel did not specifically indicate whether a patent owner challenge to prior art availability constitutes good cause. *Hulu*, IPR2018-01039, Paper 29, at 14–15.

It is uncertain whether the Board will allow petitioners to file pre-institution replies to address challenges to a publication’s prior art status. Prior panels have held that addressing the

sufficiency of the evidence does not constitute good cause (see *Mylan Pharms., Inc. v. Bristol-Myers Squibb Co.*, IPR2018-00892, Paper 22, at 4 (P.T.A.B. Sept. 17, 2018)), and that good cause does not exist when a petitioner seeks to address evidence that could have been raised in the petition (see, e.g., *Facebook, Inc. v. Sound View Innovations*, IPR2017-00985, Paper 13, at 4 (P.T.A.B. July 20, 2017)). Moreover, additional supporting evidence in the form of "supplemental evidence" cannot be submitted before institution. See *Azure Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 9, at 3 (P.T.A.B. Dec. 4, 2014). Nonetheless, petitioners faced with a challenge to the prior art status of printed publications should seek permission from the Board to file a pre-institution reply and declaration supporting the prior art status of their references. Otherwise, the Board may deny institution based on deficiencies in showing that a reference qualifies as prior art.

After institution, beyond a reply, petitioners have additional options for providing more support to show a reference qualifies as prior art. "[I]f a patent owner does not challenge the reference's status as a printed publication, the petitioner may move to submit the declaration through the supplemental information process." *Hulu*, IPR2018-01039, Paper 29, at 15 (citing 37 C.F.R. § 42.123). But submitting additional evidence does not mean a petitioner can change its theories. *Id.* Furthermore, although not specifically addressed by the *Hulu* panel, petitioners can serve supplemental evidence in response to patent owner objections to evidence. See 37 C.F.R. § 42.64(b)(2). A patent owner will often object to evidence in order to preserve its ability to file a motion to exclude that evidence. See 37 C.F.R. § 42.64(c). That opens the door for the petitioner to provide supplemental evidence. The previously served supplemental evidence may later be filed if a patent owner files a motion to exclude. See Trial Practice Guide Update 16 (Aug. 2018), https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf.

Practice Tip

Despite opportunities to cure deficiencies in proving up prior art, petitioners should avoid pre-trial and post-trial evidentiary problems by presenting as much evidence as possible with the petition. That evidence might include a declaration from the author of a printed publication, such as a product manual, or from someone who publicly disseminated the manual, or perhaps both. In collecting and submitting evidence to establish a reference as a printed publication, it is truly better to be safe than sorry.

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