

# *INTER PARTES* REVIEW PRACTICE: CHALLENGES IN PROVING UP PUBLICATIONS AS PRIOR ART



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When proving up prior art in *inter partes* review (IPR) patent challenges, patents and patent applications are easy in comparison to publications. The issues are far more complicated and unpredictable when working with books, journal articles, product manuals and other printed publications.

This article analyzes varying opinions from Patent Trial and Appeal Board panels, along with the concerns at play in *Hulu, LLC v. Sound View Innovations, LLC*, to help practitioners improve their strategies.



# INTER PARTES REVIEW PRACTICE: CHALLENGES IN PROVING UP PUBLICATIONS AS PRIOR ART

## 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 (PTAB or 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, the issue is far more complicated and unpredictable. PTAB panels take this issue on a case-by-case basis, and their opinions have varied widely.

**The difficulty in proving up prior art depends on whether the reference is a patent or a publication.**

## Panel Disparity in Dealing with Publications as Prior Art

The amount of evidence required to prove up a reference—such as a 2010 product manual—as prior art is panel-specific. Some panels may find that the product manual, with its 2010 copyright date alone, meets the threshold for institution. Other panels may require additional evidence showing its dissemination.

Numerous panels accept a reference, and its publication, at its 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.

Some panels maintain this lower threshold even if the patent owner provides 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 that the article was indexed and searchable. *Shenzhen Zhiyi Tech. Co. v. iRobot Corp.*, IPR2017-02137, Paper 9, at 19–20 (P.T.A.B. Apr. 2, 2018).

## PTAB OPINIONS

### COPYRIGHT NOTICE

*Arista Networks, Inc.  
v. Cisco Systems, Inc.*

### NEWSPAPER ARTICLE

*Shenzhen Zhiyi Technology Co.  
v. iRobot Corp.*

### COPYRIGHTED ARTICLE AND ISBN

*Ericsson Inc. v. Intellectual  
Ventures I LLC*

Further still, some panels apply a low evidentiary threshold at final written decision, where the preponderance of the evidence standard applies. In *Ericsson Inc. v. Intellectual Ventures I LLC*, one panel held that an 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).

It is probable that any of these panels, or panels following their decisions, would find that the 2010 product manual was prior art on its face for the purposes of institution.

Other panels demand 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). The Board found that a copyright date is insufficient to demonstrate public accessibility—it merely describes a claim of ownership. *Id.* at 11–12.

**Some panels apply a low evidentiary threshold at final written decision, where the preponderance of the evidence standard applies.**

A Library of Congress Catalog Card Number was also deemed insufficient because it does 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. *Alarm.com* is not an isolated case—numerous panels have held that a copyright notice alone is insufficient to establish that a reference is prior art. See, e.g., *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 12, at 12 (P.T.A.B. Dec. 3, 2018). Any of these panels would likely find that the 2010 product manual, without additional evidence, does not meet the evidentiary threshold for institution.

Compounding this confusion, some panels have reached the exact opposite conclusion on the same type of evidence. In its final written decision, a panel held that an IEEE article's copyright and ISBN is not probative of publication and is 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 holding of *Ericsson Inc. v. Intellectual Ventures I LLC* on the same type of evidence—an IEEE article with a copyright date and ISSN.

**There are numerous PTAB panel inconsistencies. Several panels have held that a copyright notice alone is insufficient to establish that a reference is prior art.**

The above is an example of diametrically opposed rulings. There is significant inconsistency across panels, and there is unpredictability with how references at the institution stage are handled.

## POP Review in *Hulu v. Sound View Innovations*

The panel-specific decisions create challenges for petitioners, but clarity may be on the way. In April 2019, the PTAB Precedential Opinion Panel (POP)[1] issued an order in response to a rehearing request of a denial of institution on the basis that a book bearing a copyright did not qualify as prior art. See *Hulu*, IPR2018-01039, Paper 12, at 9–10 (P.T.A.B. Dec. 3, 2018). The petitioner's rehearing request identified panel inconsistencies on the issue of what is required for a petitioner to demonstrate that a reference is a printed publication, and the POP asked the parties to brief the following issue:

What is required for a petitioner to establish that an asserted reference qualifies as [a] “printed publication” at the institution stage?

See *Hulu*, IPR2018-01039, Paper 15, at 2. The Board ordered an oral hearing—which was held on June 18, 2019—after receiving party and amicus curiae briefing. See *Hulu*, IPR2018-01039, Paper 26, at 1.

The Board has yet to issue a ruling in the proceeding, but the briefing gives some indication of the potential outcome. The briefing roughly falls into two categories. The first argues that all evidence must be presented in the petition because the petition presents the petitioner’s case-in-chief. See *Hulu*, IPR2018-01039, Paper 18, at 9. The second argues that presenting some indicia of publication, e.g., a copyright, should be sufficient to meet the institution threshold. See *Hulu*, IPR2018-01039, Paper 17, at 1, 8–14; *Hulu*, IPR2018-01039, Paper 21, at 1; *Hulu*, IPR2018-01039, Paper 23, at 2; *Hulu*, IPR2018-01039, Paper 19, at 3–4; *Hulu*, IPR2018-01039, Paper 20, at 3–4. The POP may well provide clarifying guidance as to what a petitioner needs to show to demonstrate that a reference is a printed publication.

**The *Hulu* POP may well clarify what a petitioner needs to show to demonstrate that a reference is a printed publication.**

## Filing a Petition Today

At this time, there is no clear guidance. Panels are divided, and no panel has provided substantive comment on the *Hulu* institution denial. In this atmosphere, petitioners should err on the side of caution and offer as much evidence as possible to demonstrate that the reference qualifies as prior art. Petitioners should follow the cautionary guidance provided by the *Hulu* denial of institution and should take these steps:

1. Provide a declaration demonstrating public dissemination of the reference from someone with personal knowledge. See *Hulu*, IPR2018-01039, Paper 12, at 9.
2. Provide evidence of dissemination of the publication and to whom the reference was disseminated. See *id.* at 10.
3. Demonstrate how the publication could have been obtained by the public or those interested in the art. See *id.* at 10–11.

Consider *Stryker Corp. v. Karl Storz Endoscopy-America, Inc.*, which provides some guidance for proving up the 2010 product manual as prior art. IPR2015-00677, Paper 15 (P.T.A.B. Sept. 2, 2015).

The *Stryker* panel instituted the petition but rejected the notion that a copyright notice by itself demonstrates that a reference is prior art because a copyright does not establish public accessibility. *Id.* at 18–19. The petitioner, however, presented far more than a copyright notice—three declarations were submitted from those with knowledge that the product manual was publicly disseminated. *Id.* at 19–22. One individual testified that the manual was shipped with the product and provided sales information to demonstrate that the product and its manual were disseminated. *Id.* at 21. Another testified that the manual was given to engineers at training sessions and to any customer who wanted it. *Id.* Providing declarations from those with knowledge is ideal to demonstrate that a reference such as the 2010 product manual qualifies as prior art, but it may not always be possible for individuals with knowledge of dissemination to be located.

**Key  
Tip**

**> In the current atmosphere of divided panels, petitioners should err on the side of caution and offer as much evidence as possible to demonstrate that the reference qualifies as prior art.**

A petitioner should present whatever evidence is possible. As an example, a petitioner submitted dated Amazon.com reviews to support a reference that had a copyright and an ISBN. *CIM Maint. Inc. v. P&RO Sols. Grp., Inc.*, IPR2017-00516, Paper 8, at 18–20 (P.T.A.B. June 22, 2017). This panel deemed that this evidence was sufficient to meet the institution threshold. If declarations cannot be obtained, other evidence indicating public availability should be submitted.

**A petitioner submitted dated Amazon.com reviews to support a reference that had a copyright and an ISBN. A panel deemed the evidence sufficient to meet the institution threshold.**

## Remedying a Challenged Reference

Evidence relating to a reference qualifying as prior art must be presented in the petition—there is little recourse to fix evidentiary deficiencies before institution. Supplemental evidence generally 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). A reply to a preliminary response, or evidence in a rehearing request, is allowed 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). Addressing sufficiency of the evidence, however, may not always 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).

A panel may not find good cause 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)). However, petitioners faced with a challenge to the prior art status of relied-upon printed publications may still wish to seek relief from the Board to present additional evidence or argument.

Post-institution allows some wiggle room to submit additional evidence. Supplemental evidence can be served in response to a patent owner’s objection. See 37 C.F.R. § 42.64(b)(2). And a patent owner can object to the reference within ten business days of institution in order to preserve the ability to file a motion to exclude that reference. See 37 C.F.R. §§ 42.64(b)(1), (c). After objection, a petitioner can serve supplemental evidence and later file it with the Board 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](https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf).

Nonetheless, it is advisable to avoid pre-trial and post-trial evidentiary problems and to present as much evidence as possible with the petition. For a 2010 product manual, for example, a petitioner should submit a declaration from the author of the manual and/or a person who publicly disseminated it.

**Key  
Tip**

**> Petitioners faced with a challenge to the prior art status of relied-upon printed publications may still wish to seek relief from the Board to present additional evidence or argument.**

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## ENDNOTE

[1] The POP is a panel of at least three judges, selected by the director, that establishes binding agency authority concerning major policy or procedural issues. More information on the POP can be obtained at <https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>.

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