

INTELLECTUAL PROPERTY LITIGATION

Expert Analysis

## Standard for Showing When A Reference Is a ‘Printed Publication’

**T**he Patent Office may institute inter partes review (IPR) only based on prior-art patents or printed publications. In

*Hulu v. Sound View Innovations*, IPR2018-01039, the Patent Office’s Precedential Opinion Panel (POP)—which decides issues of exceptional importance involving Patent Trial and Appeal Board (PTAB) policy or procedure—is set to decide what showing an IPR petitioner must make to establish, at the institution stage, that an asserted reference was publicly available prior to the critical date of the challenged patent and thus qualifies as a printed publication. We report here on *Hulu* and on other cases to have considered this issue.

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### Scope of Inter Partes Review

An IPR may be instituted only if “there is a reasonable likelihood that the petitioner would prevail

The Precedential Opinion Panel granted Hulu’s petition for rehearing, to address “What is required for a petitioner to establish that an asserted reference qualifies as [a] ‘printed publication’ at the institution stage?”

with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. §314(a). Those challenges are limited to anticipation or obvi-

ousness based on prior-art patents or printed publications:

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

35 U.S.C. §311(b). To show that a reference is a prior art printed publication, a petitioner must demonstrate that the reference was publicly accessible before the critical date of the challenged patent. *Nobel Biocare Servs. AG v. Intradent USA*, 903 F.3d 1365, 1375 (Fed. Cir. 2018). “A reference is considered publicly accessible if it was ‘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.’” *Acceleration Bay v. Activision Blizzard*, 908 F.3d 765, 772 (Fed. Cir. 2018).

## Prior PTAB Decisions Addressing the Issue

At least two prior Patent Trial and Appeal Board decisions have addressed the standards for proving that a publication qualifies as printed prior art.

In one, *Samsung Elecs. Co. v. Ibex PT Holdings Co.*, IPR2018-00012 (P.T.A.B. April 10, 2019), Samsung petitioned for inter partes review of an Ibex patent covering video-coding technologies. At the institution stage, evaluating whether two pieces of prior art were “printed publications” within the meaning of Section 311(b), the PTAB found—based on declarations provided by Samsung stating that the asserted references were made available on a public website and sent to an email listserv—that Samsung “made a sufficient threshold showing” that the references in question were “sufficiently disseminated or made available so that persons interested and ordinarily skilled in the art of video coding, exercising reasonable diligence, could locate them.” *Samsung*, Paper 6 at 24. The board explained that while Samsung had made a sufficient showing, Ibex would “have the opportunity to further develop the evidence on this issue during the proceeding, including through cross-examination of petitioner’s declarants.” *Id.*

The IPR then proceeded to trial, after which the board concluded that Samsung had failed to prove “by a preponderance of the evidence” that one of the asserted references was publicly available. Specifically, the board found that Samsung had not shown a skilled artisan, “exercising reasonable diligence, could have located” the asserted prior-art reference “from among the over 900 documents” available on the website, by either scrolling or using search terms. *Samsung*, Paper 30 at 16-17. Because the board concluded that the first reference in Samsung’s asserted obviousness ground was not publicly available, it did not need to consider the public availability of the second reference.

In the other, *Hamamatsu Photonics K.K. v. SEMICAPS Pte Ltd.*, IPR2017-02112 (P.T.A.B. March 18, 2019), at the institution stage the PTAB determined that petitioner Hamamatsu had made a “threshold showing” that the asserted reference was publicly available, based on the declarations of an employee of the organization that published the reference and an attendee of the conference at which the reference was allegedly presented. *Hamamatsu*, Paper 8 at 27, 29. The board cautioned, however, that its finding of public accessibility was “for purposes of [the institution] decision only.” *Id.* at 29.

At the trial stage, the board required Hamamatsu to show by a preponderance of the evidence that the asserted reference qualifies as a printed publication. The board explained the difference between the institution and trial stages: “We note that that ‘threshold showing’ was petitioner bringing forth enough evidence to demonstrate a likelihood of prevailing on the publication date issue during the ensuing trial, and did not involve a determination, during that preliminary stage, that petitioner had satisfied the ultimate burden of proving the matter by a preponderance of the evidence.” *Hamamatsu*, Paper 33 at 36.

### ‘Hulu v. Sound View’

Hulu petitioned for inter partes review of Sound View’s patent covering a data-analysis system. Hulu based its petition on a textbook (Dougherty), that had a copyright date stamp of 1990, five years before the 1995 priority date of Sound View’s patent. In support of its argument that Dougherty was publicly available as of 1990, Hulu submitted pages from a later, date-stamped version of Dougherty from the Cornell library and the testimony of a Cornell librarian that the later version of Dougherty was publicly available at the library as of 1992.

The board declined to institute review, finding that Hulu “has not presented sufficient evidence to show a reasonable likelihood that Dougherty is prior art” to Sound View’s patent. Hulu, Paper No. 12 at 10. The board held that the 1990 copyright date “does not indicate anything more” than that “this is the date the work was fixed in a tangible medium of expression,” which is insufficient to show “the extent of public accessibility of Dougherty” or to allow the board to conclude that “the book was sufficiently publicly accessible such that” persons skilled in the art “could have located it.” Id. at 11-12. The board further explained that it “has no information on which to determine what the routine practices of” the textbook’s publisher were, “such as how long it typically takes from [the publisher’s] printing of a manuscript to making the document available to the public, and whether [the publisher] always made every book that it printed available to the public.” Id. at 12.

The board also found that the copy of Dougherty at Cornell was different than the copy relied on by Hulu because “the printing history of the later copyrighted version indicates that corrections were made in the March 1991 printing. Id. at 10. The board concluded that Hulu had failed to

“demonstrate[] a reasonable likelihood of prevailing in showing that any of” the challenged claims “is unpatentable on any asserted ground.” Id. at 13.

The Precedential Opinion Panel granted Hulu’s petition for rehearing, to address “What is required for a petitioner to establish that an asserted reference qualifies as [a] ‘printed publication’ at the institution stage?” Paper No. 15 at 2. Before the POP, Hulu argued that at the institution stage, “consistent with the ‘reasonable likelihood’ institution standard,” “the petitioner must present a *prima facie* case that the reference qualifies as a ‘printed publication’” and that one method of doing so is “by relying on conventional markers on the document—i.e., objective, contemporaneous evidence of public distribution that is generally expected to be found on documents of the same kind.” Hulu Br. at 1, 3.

According to Hulu, for a published book those indicia of availability include: (1) a copyright notice; (2) edition identifiers; (3) a statement that the document was published by a commercial publisher; or (4) the assignment of an International Standard Book Number. Id. at 1. Hulu also argued that the *prima facie* standard is consistent with how the board treated the issue at the institution

stage in *Samsung* and *Hamamatsu*. Id. at 5-6.

In response, Sound View argued that “the ‘likelihood that the petitioner would prevail’ requires a high threshold at the institution stage” and that the “petition represents the petitioner’s case-in-chief.” Sound View Br. at 1-2. Thus, according to Sound View, “[t]he institution threshold [] is not a lower standard of proof,” but is instead a “substantial threshold” that “asks whether the standard of proof is reasonably likely to be met once ‘all the evidence’ is in.” Id. at 4, 9 (emphasis in original).

Sound View also argued that “printed dates or stamps are not *prima facie* public availability” because prior board and federal circuit decisions “have treated copyright and similar dates as potentially ‘relevant evidence’ if taken together with other evidence of alleged printed publication, but ‘not dispositive of the date of public accessibility.’” Id. at 14, 15 (emphasis in original).

The POP heard oral argument on June 18. The transcript of the argument was not yet available as of the writing of this article.