

Evidence at the PTAB: Evolving Standards, New Precedential and Informative Decisions

Best Practices for Submitting and Challenging Evidence in PTAB Proceedings

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Today's faculty features:

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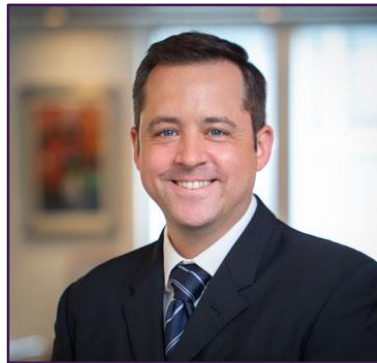
Evidence at the PTAB: New Precedent, Guidance for What Qualifies, and Impacts on Proceedings

July 23, 2020



Technical Minds. Legal Muscle.

Speakers



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Agenda

- Evidence at the PTAB
- *Hulu, LLC, v. Sound View Innovations, LLC*
- *Ex parte Grillo-Lopez*
- Recent Informative Cases
 - *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*
 - *Seabery N. Am. Inc. v. Lincoln Global, Inc.*
 - *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*
 - *Sandoz Inc. v. AbbVie Biotechnology Ltd.*
- Practice Tips

Burden of Proof

- To prevail in a final written decision in an *inter partes* review, the petitioner bears the burden of establishing by a preponderance of the evidence that a particular document is a printed publication
- But what about the burden of proof at institution?



Evidence at the PTAB: Patents and Printed Publications

35 U.S.C. § 311 Inter partes review

- (b) 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. § 312 Petitions

- (a) Requirements of Petition
 - (3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—
 - (A) copies of patents and printed publications that the petitioner relies upon in support of the petition;

35 U.S.C. § 102

- 35 U.S.C. § 102(a)(1):
 - **the claimed invention was patented, described in a printed publication**, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention
- Pre-AIA 35 U.S.C. § 102(b):
 - **the invention was patented or described in a printed publication** in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

Patents and Printed Publications

- Patents v. Non-Patent Literature (NPL)
- Non-Patent Literature:
 - Articles
 - Webpages
 - Textbooks
 - Theses and Dissertations
 - User Manuals
 - Conference Proceedings

Requirements of a Printed Publication

- Printed
 - Written in some form
 - Not solely an oral presentation
 - Oral presentations can potentially be used as prior art outside of *inter partes* review as “otherwise available to the public before”

Requirements of a Printed Publication

- Published, *i.e.*, Accessible to the Public
 - If “persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018)
 - “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been 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.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)



Hulu, LLC, v. Sound View Innovations, LLC

Background

- *Hulu* filed an IPR petition relying upon a textbook
 - Submitted evidence of public availability related to different version
- Initial panel found publicly accessibility evidence insufficient and denied institution
- *Hulu* requested rehearing and Precedential Opinion Panel (POP) review, asking:
 - “What is required for a petitioner to establish that an asserted reference qualifies as ‘printed publication’ at the institution stage?”

POP Decision

- “[A] petitioner must establish a **reasonable likelihood** that a reference is a printed publication”
- If trial is instituted, the petitioner has the burden to prove that “the reference is a printed publication by a **preponderance of the evidence**”
- Must consider totality of evidence

POP Decision

- Reversed initial panel in *Hulu*
- Found sufficient evidence to establish a reasonable likelihood that textbook was a printed publication
 - Copyright date of 1990
 - Printing date of 1992
 - ISBN date of 1994
 - Established publisher
 - Well-known book series
 - Evidence related to different version not necessary

POP Guidance

- No per se sufficient evidence to show public availability
- POP identified several PTAB decisions where the Petitioner satisfied, or did not satisfy, its initial burden at institution to show that a non-patent reference was a printed publication that was publicly accessible



Ex parte Grillo-Lopez

Ex parte Grillo-Lopez

Appeal 2018-006082

- In a request for rehearing, a patent applicant (Grillo-Lopez) argued that an appeal decision inappropriately held that a cited piece of art qualified as a printed publication
- Art in question: transcript of a public FDA meeting
 - Grillo-Lopez noted that previous board decisions in the IPR context held that the same FDA Transcript was not a printed publication
- The rehearing decision was made precedential

Standards for Establishing a Printed Publication

- Acknowledged the *Hulu* standard for IPR’s under which **a petitioner is required to present evidence and arguments** sufficient to show that it is reasonably likely that it will prevail
- “[T]he framework set forth in **the Hulu decision for IPR proceedings does not apply to examination.**”
 - Instead, **“the examination context involves a burden-shifting framework** under which the USPTO can shift the burden to the applicant to come forward with rebuttal evidence or argument to overcome a prima facie case” that a document qualifies as a printed publication.

Ex parte Grillo-Lopez

Appeal 2018-006082

- **Holding:** the transcript qualifies as a printed publication
- Because of the different standards, it is not necessary to follow the IPR holding's rationale
- Moreover, the record contained evidence in addition to what was presented in the IPR proceeding:
 - Publication of the Notice of Hearing in the Federal Register
 - Attendance of the hearing by an interested member of the public pursuant to the notice
 - The requirements of FACA [Federal Advisory Committee Act] in support of the public accessibility of the FDA Transcript.

Ex parte Grillo-Lopez Takeaways

- An Examiner need only establish a prima facie case of availability to establish a document as a printed publication
- Overcoming the Examiner's assertion will likely require rebuttal evidence or argument that undermines the Examiner's assertion
- Bottom line: its much easier for an Examiner to establish public availability than it is for an IPR petitioner



Informative Decisions on Printed Publications

Printed Publication Analysis: A Fact-Dependent Inquiry

- As explained by the Federal Circuit, a determination of whether a reference is a printed publication "involves ***a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public.***" *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).
- The PTAB has identified ***four "informative" cases*** to aid in understanding the inquiry
 - While designated as "informative," they are not precedential
 - These cases illustrate the type and quantity of evidence that may be necessary for a proponent to produce

Argentum Pharm. LLC v. Research Corp. Tech., Inc.

IPR2016-00204 , Paper 19

- **Evidence in question:** a dissertation from the University of Houston library
- **Supporting evidence of record:**
 - A concession of public accessibility from a related district court litigation
 - Journal publications in which similar dissertations from the University of Houston were cited in journal publications

Argentum Pharm. LLC v. Research Corp. Tech., Inc.

IPR2016-00204, Paper 19

- **Holding:** Evidence was insufficient to show that the dissertation was a printed publication
- **Board's Rationale:**
 - The concession was a stipulation that could have been made for a variety of reasons, and was expressly limited to the district court litigation
 - None of the citations in petition were to the thesis in question
 - Publications citing to other theses were not persuasive because, in each case, the publication's authors included the student that wrote the thesis—personal knowledge by the author, not evidence of public access per se

Argentum Pharm. LLC v. Research Corp. Tech., Inc.

IPR2016-00204, Paper 19

- **Lessons learned:**

- Evidence should be targeted specifically to the publication in question
- Party admissions made in other forums are not binding
- University's refusal to participate/provide information does not relieve the proponent's burden

Seabery N. Am. Inc. v. Lincoln Global, Inc.

IPR2016-01840 , Paper 11

- **Evidence in question:** a dissertation from the University of Bremen library
- **Supporting evidence of record:**
 - A declaration from the author's thesis advisor discussing the university's thesis practices, and stating that he personally confirmed the thesis' availability at the time of deposit
 - Evidence of indexing on a library website
 - Copyright and publication dates within the thesis

Seabery N. Am. Inc. v. Lincoln Global, Inc.

IPR2016-01840, Paper 11

- **Holding:** Evidence was sufficient to show that the dissertation was a printed publication for institution
- **Board's Rationale:** the petitioner "demonstrated sufficiently" that the thesis qualifies as a printed publication

Seabery N. Am. Inc. v. Lincoln Global, Inc.

IPR2016-01840, Paper 11

- **Lessons learned:**

- Declarations can provide evidence of public accessibility
 - Downside: potential deposition, and increased cost
- Library shelving and indexing practices can be factors in printed publication analysis
- Publication and copyright dates in the document itself can provide evidence of public accessibility

In-Depth Geophysical, Inc. v. ConocoPhillips Co.

IPR2019-00849, Paper 14

- **Evidence in question:** Conference paper from the inventors
- **Supporting evidence of record:**
 - Copyright date of 2012 
 - Entry in “Researchgate” website listing September 2012 in reference to the paper
 - Acceptance of publication as prior art in European prosecution

In-Depth Geophysical, Inc. v. ConocoPhillips Co.

IPR2019-00849, Paper 14

- **Holding:** Evidence was insufficient to show that the conference paper was prior art under 102(b)

- **Board's Rationale:**
 - Petitioner's evidence amounts to little more than a bare allegation that Li was published in September 2012
 - The presented evidence was not sufficient to show that the conference publication was available more than one year before the November 1, 2013 priority date
 - Patent Owner presented declaration as evidence the paper was only available during and after the November 4, 2012 conference (within one year of priority date)
 - The EP acceptance of the paper as prior art is not informative because the EP law does not allow for a one-year grace period

In-Depth Geophysical, Inc. v. ConocoPhillips Co.

IPR2019-00849, Paper 14

• Lessons learned:

- Dates need to be linked to public accessibility
 - A listing of a date alone is not sufficient because it could refer to dates of submission, acceptance, etc.
- Presentation of an alternative date of public availability by a patent owner can be “compelling”

Sandoz Inc. v. AbbVie Biotechnology Ltd.

IPR2018-00156, Paper 11

- **Evidence in question:** 2003 Humira Package Insert
- **Supporting evidence of record:**
 - Wayback Machine showing availability of the package insert (and accompanying affidavit)
 - Testimony regarding general availability of package inserts on the FDA website

Sandoz Inc. v. AbbVie Biotechnology Ltd.

IPR2018-00156, Paper 11

- **Holding:** Petitioner provided adequate evidence to establish the Humira Package Insert as a “printed publication”
- **Rationale:**
 - While “evidence of indexing is probative of public accessibility, such evidence is not necessarily required in all cases.”
 - “[T]estimony indicating that the particular online publication or website on which the reference was published was well-known to the community interested in the subject matter” was sufficient here, when combined with evidence of search functions on the website.

Sandoz Inc. v. AbbVie Biotechnology Ltd.

IPR2018-00156 , Paper 11

- **Lessons learned:**

- Evidence of how a document is indexed or found by searches is not necessary (but is useful)
- Availability on web pages can be shown with resources such as the Wayback Machine



Recent PTAB Cases

Cooler Master Co., Ltd. V. Aavid Thermalloy LLC

IPR2019-00334

- **Evidence in question:** unexamined Japanese patent application that lacked INID codes present on most published international applications
- **Supporting evidence of record:**
 - Declaration from a Japanese patent attorney
 - Presence of a “condensed” version of the application in the JPO’s gazette

Grünenthal GMBH v. Antecip Bioventures II LLC

PGR2018-00026

- **Evidence in question:** scientific articles in well-known journals, and a printout from clinicaltrials.gov
- **Supporting evidence of record:**
 - Self-contained indicia such as source, date, and publisher
 - Journal website captures
 - Declaration from publisher

Grünenthal GMBH v. Antecip Bioventures II LLC

PGR2018-00026

• **Holdings:**

- Petitioner made a sufficient showing that each of the references qualify as a prior art printed publication
- The information pertaining to the publication on the face of the journal articles is sufficient to establish each document qualifies as a printed publication .
- A printout from clinicaltrials.gov also qualified in view of similar indicia of publication and in view of it being from a “reliable and trustworthy source”

Varian Med. Sys. V. Best Med. Int'l., Inc.

IPR2020-00071

- **Evidence in question:** book chapters
- **Supporting evidence from petitioner:**
 - Self-contained indicia such as source, date, and publisher
 - Printout/declaration from the Wayback Machine
 - Declaration from librarian
- **Evidence from patent owner:**
 - Publisher listed a later publication date
 - Cover of book in the record did not match the cover in the Wayback Machine capture

Varian Med. Sys. V. Best Med. Int'l., Inc.

IPR2020-00071

- **Findings:**

- Wayback Machine not sufficient to establish 102(b) date
- Copyright date does not establish chapters as 102(b) art because it mentions only a year
- Librarian declaration and copyright date sufficient to qualify chapters as 102(a) art

- **Institution Decision:**

- Instituted to determine whether the chapters are the inventor's own work



Practice Tips and Best Practices

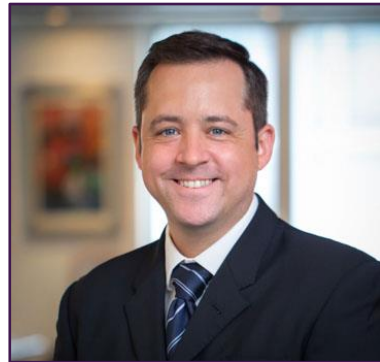
Tips for Submitting Evidence

- Provide evidence that directly indicates the availability of the publication in question
 - Declarations, internet archive, objective evidence of availability in libraries
- Pay particular attention to key references
- Don't depend solely on admissions
- Don't depend solely on evidence that other similar documents were publicly available

Tips for Challenging Evidence

- Remember: the proponent of the evidence has the burden
- Is the supporting evidence hearsay?
- Challenge the personal knowledge of declarants
- Is there evidence (more than speculation) that the publication was not publicly available?
 - Can you tell a different “story”?
- Analogize to prior cases in which evidence was held not to be a printed publication

Thank you! Stay Well!



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