
Hot Topics and Oral Argument at the PTAB

*Presented at the PTAB Bar Association Annual Conference
March 14, 2019*

Panelists

- Judge Kevin Cherry
- Judge Rama Elluru
- Chetan Bansal (Washington, DC: Paul Hastings)
- Joshua James (Chicago: Brinks, Gilson & Lione)
- Jennifer O'Connell (New York City: Davidson, Davidson & Kappel, LLC)
- Fahd Patel (Washington, DC: Morrison & Foerster)
- Jason Stach (Atlanta: Finnegan)

Overview of Proving That Printed Publications Are Prior Art

“Public Accessibility” Is the Key

- Test for public accessibility formulated long ago

“[P]ublic accessibility has been called the touchstone in determining whether a reference constitutes a ‘printed publication.’” *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986).

Public accessibility requires “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.” *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981).

Remains a Hot Topic Today

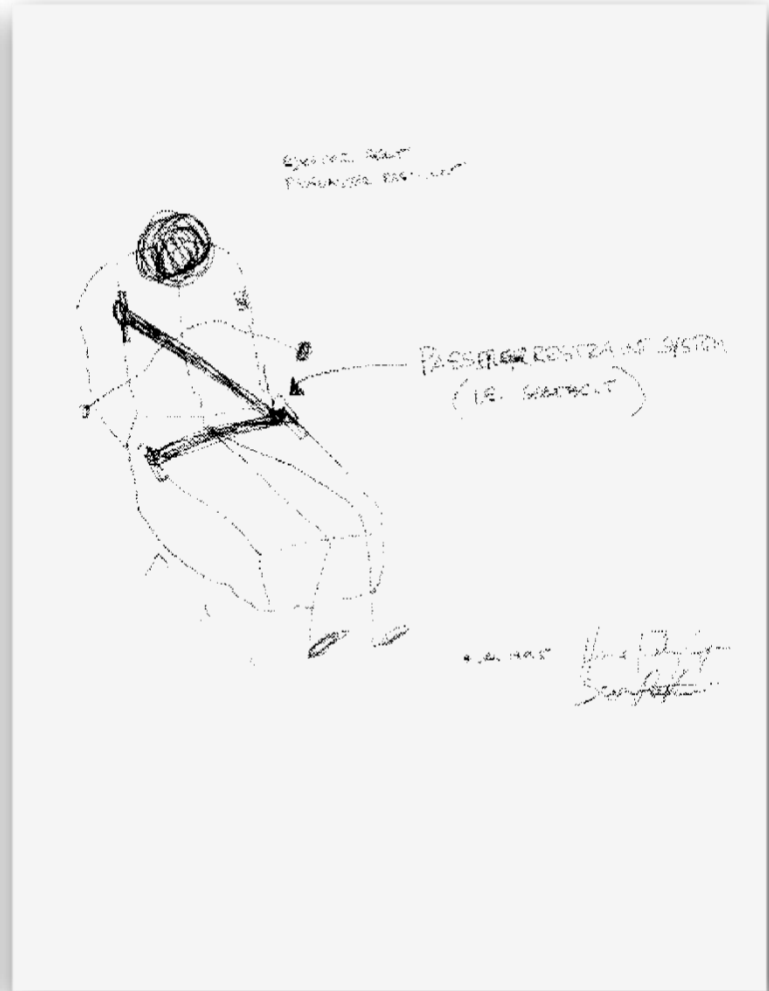
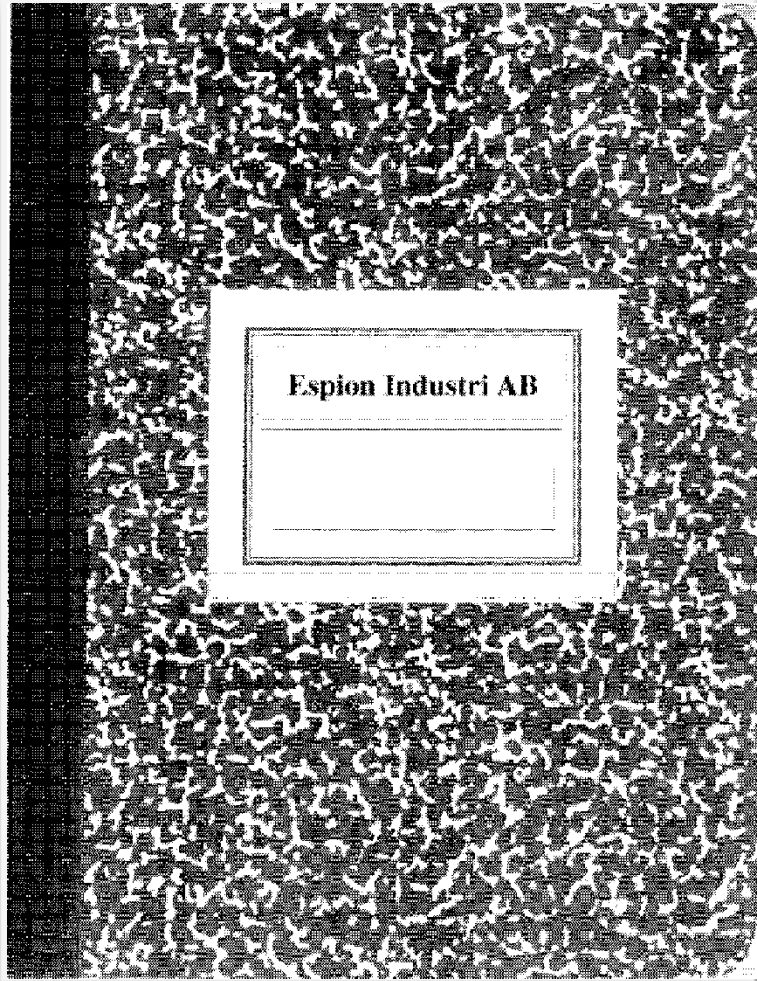
- At least five Federal Circuit decisions addressing public accessibility in appeals from the PTAB since June of 2018
 1. ***Acceleration Bay, LLC v. Activision Blizzard Inc.***, 908 F.3d 765 (Fed. Cir. 2018)
 2. ***GoPro, Inc. v. Contour IP Holding LLC***, 908 F.3d 690 (Fed. Cir. 2018)
 3. ***Nobel Biocare Servs. AG v. Instradent USA, Inc.***, 903 F.3d 1365 (Fed. Cir. 2018)
 4. ***Jazz Pharm., Inc. v. Amneal Pharm., LLC***, 895 F.3d 1347 (Fed. Cir. 2018)
 5. ***Medtronic, Inc. v. Barry***, 891 F.3d 1368 (Fed. Cir. 2018)

Non-Exhaustive Factors for Determining Public Accessibility

- Evidence of actual public distribution or access
- The existence or lack of “meaningful” indexing or cataloging
- Whether a database permits keyword searching
- The length of time the material was exhibited
- The expertise of the target audience
- Expectations of confidentiality
 - The existence or lack of reasonable expectations that the material would not be copied and/or shared
 - Other restrictions on public disclosure of the information
- The simplicity or ease with which the material displayed could have been copied

Mock Argument Facts

Famed Inventor Max Gunnar's Invention - The Easy Ejector Seat



The Key to Safety Is in the Restraint



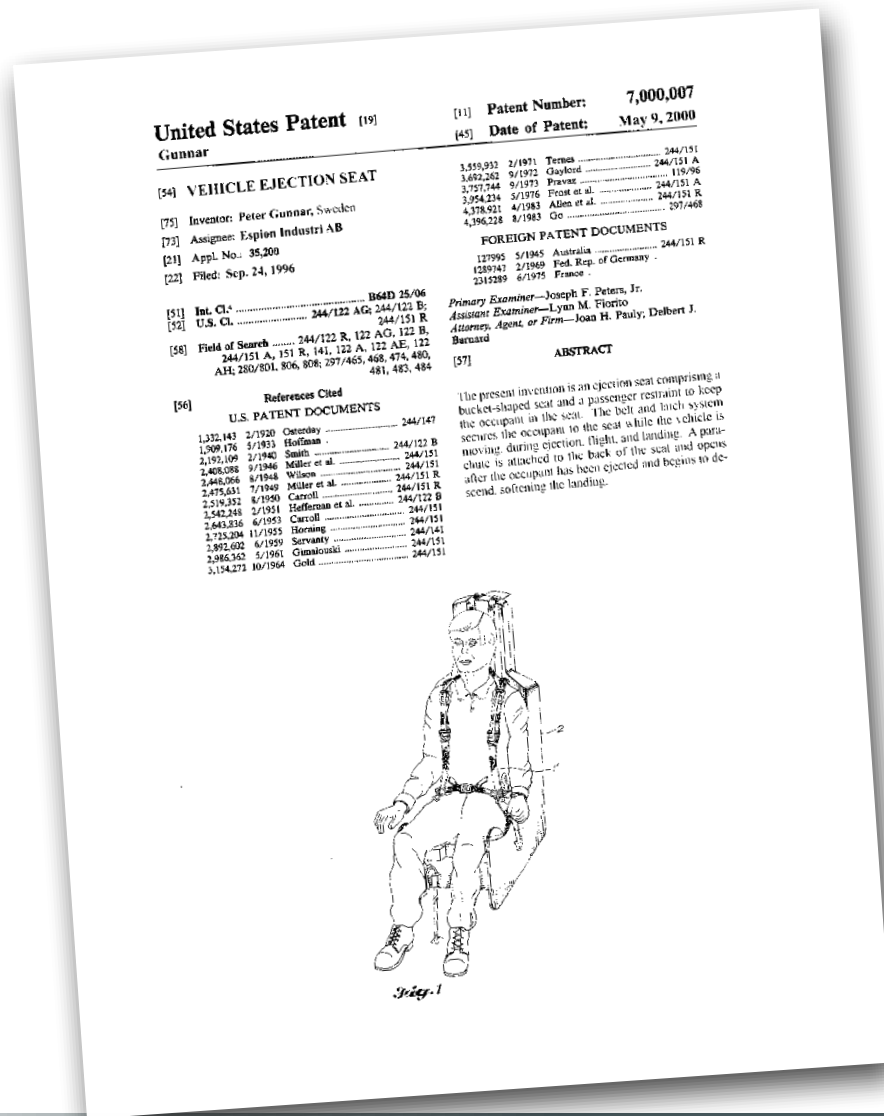
Easy Ejector Used All Over the World



**Protecting
Dignitaries And
Government
Officials Worldwide**

U.S. Secret Service
duty vehicle with Easy
Ejector Seat

Easy Ejector Covered by the '007 Patent



SpyTech's (Allegedly) Infringing Rejector System

The screenshot shows a web browser window with the title "SpyTech - Don't Dodge Bullets, Stop Them in Their Tracks!". The address bar displays "http://www.spytech.com/rejector2005.htm". The main content area features a large advertisement for the "2005 Supercharged H2 With Rejector 2005". The ad includes the SpyTech logo, the slogan "Own the Streets!", and a list of features. On the left, there is an inset image of a red and purple racing seat with a "new!" starburst, and another inset image of a parachute. The background of the ad is a black Hummer H2 truck parked on a city street at night.

SPYTECH
Own the Streets!
2005 Supercharged H2 With Rejector 2005

- **TorsoLock cage secures driver during high-speed maneuvers and during ejection**
- **Top quality parachute system**
- **Level IIIB armoring including all glass**
- **Run-flat and puncture-proof tires**
- **Optional smoke-screen emitter**

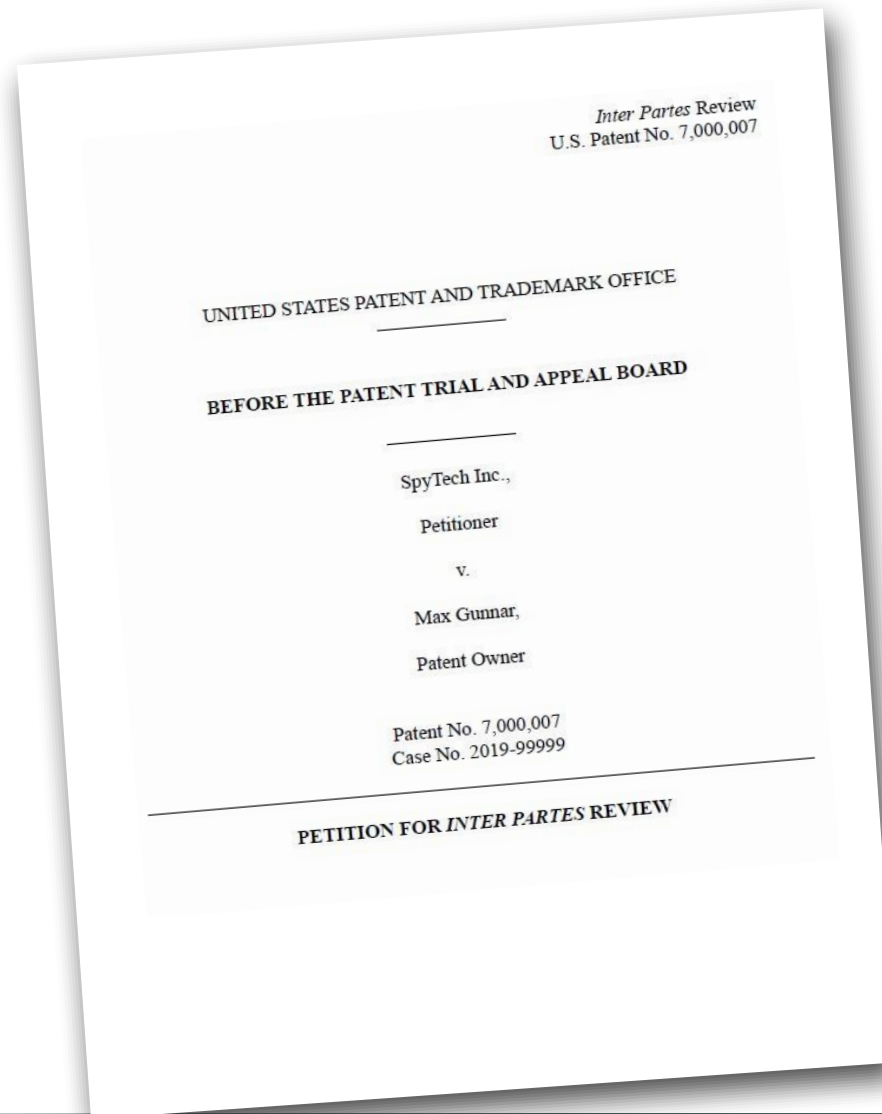
new!

Done Internet

Gunnar Sues SpyTech

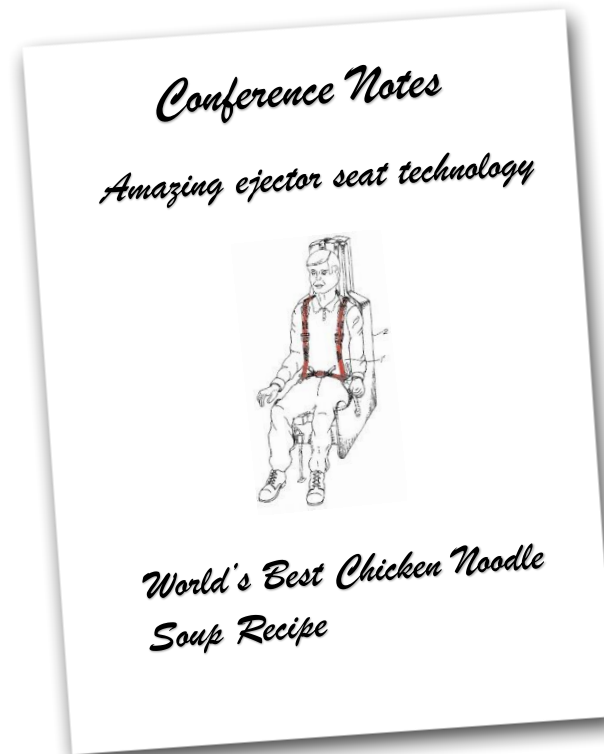


SpyTech Petitions for IPR of the '007 Patent



Two Anticipatory Prior Art References

- Two references each disclose every feature of the challenged claims, and Patent Owner concedes this fact
- The only issue is whether the references have been proven to be prior art printed publications



Reference 1 – Catalog Available During a Conference

- “Spy Innovations Today” catalog available at the International Espionage Conference
- Cover bears a copyright date a decade before Gunnar invented and filed for the '007 patent
- Conference not open to the public, but anyone who is *anyone* in the spy industry was invited to attend
- Problem is that spies do not like to show their faces at events
 - Many invitations were rejected
 - Only the least skilled, most inept spies showed up
- Hefty fee also cut attendance so only 5 people attended

Reference 1 – Catalog Available During a Conference

- Attendees could review the catalog during the conference but could not take it with them
- Attendees signed an agreement that:
 - Prohibited taking notes on the presented material, including the catalog
 - Did not otherwise impose any obligation of confidentiality related to the materials presented at the conference

Reference 2 – Notes about Reference 1

- Somehow a set of handwritten conference notes, including a sketch that looks almost identical to the image in the '007 patent, appeared on the web
- Text of the notes was searchable before the priority date
- But the notes were not located by a declarant in the IPR until years after the '007 patent's priority date, and only after a brand-new search tool indexed them
 - It is like OCR but for pictures, converting images into detailed searchable text descriptions
- The declarant who located the notes checked the access records and discovered:
 - The notes were posted online five years before the '007 priority date
 - The notes had previously been accessed over 10,000 times, but it is unclear who accessed them (could it have been for the chicken soup recipe?)

Declarations on Public Accessibility

- Declaration #1
 - Woman who organized the conference but did not attend it
 - Heard from multiple people that the catalog was made available during the conference
 - Presented records of who signed in at the conference and signed the no-note-taking agreement
 - Provided pre-conference e-mails showing that a Spy Innovations Today catalog was to be made available at the conference
 - But the e-mails only name the catalog's title and do not specify which edition of the catalog would be presented (earlier editions did not have the relevant ejector seat information in them)
- Declaration #2
 - Man who located the notes online
 - Happens to be a major investor in SpyTech Inc. (the accused infringer and IPR petitioner)

Mock Arguments & Practice Pointers

Cases on Proving that Printed Publications Are Prior Art

Acceleration Bay v. Activision (Nov. 6, 2018)

- Petitioner relied on a technical report uploaded to the University of California, San Diego's Technical Reports Library website
- Uploaded early enough to be prior art if publicly accessible
- Petitioner submitted a declaration by a Systems Administrator at UCSD's Computer Science and Engineering Department attesting that:
 - His department regularly maintains electronic technical reports and related records
 - A staff member assigns a unique identifier to each report based on the year it was uploaded and the relative order it was uploaded in comparison to other papers

Acceleration Bay v. Activision (Nov. 6, 2018)

- But “[t]he Board then correctly noted that ‘public accessibility’ **requires more than technical accessibility.**”
- No evidence the report disseminated to the public, so focused on whether “an interested skilled artisan, using reasonable diligence, would have found [the report] on the CSE Technical Reports Library website”
- Indexed report only by author and year
- No evidence of how many reports were on the site
- Potentially needed to skim hundreds of titles uploaded in the same year to find the report

Acceleration Bay v. Activision (Nov. 6, 2018)

- Website's advanced search features shown to be unreliable
- Administrator testified he did not know how the search worked or how keywords were generated
- Admitted it was possible the search function did not work
- Petitioner argued the testimony was unauthenticated hearsay, but the administrator testified the functionality had remained unchanged over time
- Federal Circuit affirmed Board's finding that there was insufficient evidence of record to demonstrate that the report was sufficiently publicly accessible to qualify as prior art

GoPro v. Contour IP Holding (Nov. 1, 2018)

- GoPro petitioned for IPR using its own catalog for a GoPro point-of-view (“POV”) action sports video camera
- To prove it was publicly accessible, GoPro submitted a declaration by an employee attesting to the following:
 - He attended a trade show about six weeks before the critical date
 - There were about 150 vendors and over 1,000 attendees
 - He manned GoPro’s booth, where the catalog was displayed
 - He personally distributed the catalog to attendees
 - Actual and potential dealers, retailers, and customers of POV cameras attended the trade show
- GoPro also provided documents and emails corroborating the declaration
- The trade show was for dealers of sports vehicles, such as motorcycles, motorbikes, ATVs, snowmobiles, and watercraft – it was not a trade show specifically about cameras
- The trade show was not open to the public

GoPro v. Contour IP Holding (Nov. 1, 2018)

- Accessibility by the general public is not necessary.
- “We have interpreted § 102 broadly, finding that even relatively obscure documents qualify as prior art so long as the relevant public has a means of accessing them.”
- But actual access is not required:
 - “If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988).

GoPro v. Contour IP Holding (Nov. 1, 2018)

- “The parties do not dispute any of the facts or evidence presented by GoPro regarding the distribution of its catalog.”
- “The Board found all the evidence presented by GoPro credible”
- Evidence was sufficient to demonstrate public accessibility of the catalog, so it was prior art
- Remanded to evaluate patentability based on the GoPro catalog

GoPro v. Contour IP Holding (Nov. 1, 2018)

- **History of the *GoPro* Decision**

- *GoPro, Inc. v. Contour IP Holding LLC*, 898 F.3d 1170, 1174 (Fed. Cir. 2018), issued on July 27, 2018
- On November 1, 2018, the panel withdrew that opinion and replaced it with a new one. See *GoPro, Inc. v. Contour IP Holding LLC*, Nos. 2017-1894, 2017-1936, 908 F.3d 690 (Fed. Cir. Nov. 1, 2018)
- The en banc Federal Circuit denied rehearing

GoPro v. Contour IP Holding (Nov. 1, 2018)

- **Additions**

- “When direct availability to an ordinarily skilled artisan is no longer viewed as dispositive, the undisputed record evidence compels a conclusion that the GoPro Catalog is a printed publication as a matter of law.”
- An observation that the trade show “was attended by actual and potential dealers, retailers, and customers of POV video cameras.”

- **Deletions**

- Whether those interested in POV action cameras like GoPro’s should have been aware of the trade show and could have attended
- Sophistication of the trade show attendees
- Whether other attendees made similar products as GoPro

Nobel Biocare v. Instradent (Sept. 13, 2018)

- IPR petitioner relied on product catalog as prior art
- Catalog maker looked for distributors at a conference in Germany with possibly a thousand attendees
- In a prior case before the International Trade Commission, witness testified to attending conference at a small booth
- He did not recall whether he brought the catalog to the conference, but it was “unlikely”
- If he brought the catalog, there would have only been a few copies he could fit in his luggage
- Also testified to using catalog in training courses with no non-disclosure agreement

Nobel Biocare v. Instradent (Sept. 13, 2018)

- Date on the catalog cover
- E-mails allegedly corroborated publication date
- International Trade Commission Administrative Law Judge found the catalog was prior art
- Full ITC disagreed (found it was not prior art)
- Federal Circuit affirmed without opinion
- IPR filed before ITC initial determination

Nobel Biocare v. Instradent (Sept. 13, 2018)

- During the IPR, two additional people testified about the catalog
 - One said he was not sure which catalogs he received at the conference, but “gathering brochures ‘is open to everyone’ at the [conference] and not done in secret”
 - The other said he was certain that he received the catalog at issue
- Board found the catalog to be prior art

Nobel Biocare v. Instradent (Sept. 13, 2018)

- Federal Circuit not bound by prior affirmance of ITC decision finding insufficient evidence of public accessibility
 - Different evidence and different evidentiary standard on validity issue in IPR vs. ITC
- Board reasonably credited witness testimony
- Testimony needed corroboration, but passed the “rule of reason” test because two witnesses corroborated each other, date on catalog cover was consistent, and there was testimony about operating a booth at the conference
- Date on cover, while not dispositive, was also relevant evidence of public accessibility – especially in light of testimony about its meaning

Jazz Pharm. v. Amneal Pharm. (July 13, 2018)

- Patents on drug distribution system for tracking sensitive drugs (those that are addictive or can be abused)
- Food & Drug Administration scheduled a public advisory committee meeting to discuss risk management issues for one sensitive drug
- Federal Register notice publicized the meeting and included instructions and a link to access additional materials on an FDA website
- “Advisory Committee Art”: background materials posted to FDA website before meeting and meeting minutes, transcript, and slides posted after meeting
- Advisory Committee Art on FDA website over 2 months before critical date

Jazz Pharm. v. Amneal Pharm. (July 13, 2018)

- Board found Advisory Committee Art to be prior art and found all instituted claims obvious
- Federal Circuit affirmed
- No evidence of searchability or indexing, but this is not essential for finding public accessibility
 - Nonetheless, Federal Register notice was indexed
- Advisory Committee Art found to be disseminated more broadly and for longer than in earlier cases
- Federal Register and public federal website showed no expectation of confidentiality
- No claims of dissemination at the meeting
 - Focused only on availability of materials on website and through Federal Register

Medtronic v. Barry (June 11, 2018)

- Patents directed to spinal alignment systems and methods
- IPR petitioner relied in part on a video and slides distributed to spinal surgeons at three meetings
- Video constituted a narrated surgery performed by the petitioner's expert
- Slides has numerous pictures from surgeries
- Materials distributed on CD, but also distributed binders of relevant portions of slides at two programs
- One of the three meetings was limited to members of a trade group, while other two meetings were open to other surgeons
- Attendance ranged from 20 to 55 surgeons at the meetings

Medtronic v. Barry (June 11, 2018)

- Board found the materials were not printed publications, but Federal Circuit remanded to consider:
 - “the size and nature of the meetings and whether they are open to people interested in the subject matter of the material disclosed”
 - “whether there is an expectation of confidentiality between the distributor and the recipients of the materials”
- “Distributing materials to a group of experts, does not, without further basis, render those materials publicly accessible or inaccessible, simply by virtue of the relative expertise of the recipients. The nature of those meetings, as well as any restrictions on public disclosures, expectations of confidentiality, or, alternatively, expectations of sharing the information gained, can bear important weight in the overall inquiry.”

THANK YOU!