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Patent Trial and Appeal Board
PRECEDENTIAL
Standard Operating Procedure 2
Designated: 12/20/19

Paper 29
Entered: December 20, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

IPR2018-01039
Patent 5,806,062

Before ANDREI IANCU, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*, ANDREW HIRSHFELD, *Commissioner for Patents*, and SCOTT R. BOALICK, *Chief Administrative Patent Judge*.

BOALICK, *Chief Administrative Patent Judge*.

DECISION
Granting Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Hulu, LLC ("Petitioner") filed a Petition (Paper 3, "Pet.") requesting an *inter partes* review of claims 1–3, 7, 10, 11, 14, and 15 of U.S. Patent No. 5,806,062 (Ex. 1001, "the '062 patent"). Petitioner asserted that the claims were obvious over Dale Dougherty, SED & AWK (Tim O'Reilly, ed., O'Reilly & Associates, Inc.) (Nov. 1990) (Ex. 1004, "Dougherty"). *See* Pet. 3–4.

Sound View Innovations, LLC ("Patent Owner") filed a Preliminary Response (Paper 10, "Prelim. Resp.") to the Petition. Patent Owner challenged Petitioner's showing that Dougherty was publicly available as a printed publication before the filing of the '062 patent in 1995. *Id.* at 3–23.

The Board issued a decision denying institution of an *inter partes* review. Paper 12 ("Decision"). The Board found that there was insufficient evidence to show that Dougherty was publicly accessible and concluded that Petitioner failed to show sufficiently that Dougherty qualifies as prior art under 35 U.S.C. §§ 102(a) and (b). *Id.* at 11–12.

Petitioner requested rehearing of the Board's decision, and requested Precedential Opinion Panel ("POP") review. Paper 13. Because prior Board decisions conflicted on requirements for institution involving issues of public accessibility of an asserted "printed publication," the POP ordered a review on rehearing to address the following issue:

> What is required for a petitioner to establish that an asserted reference qualifies as "printed publication" at the institution stage?

Paper 15 (Order), 2 (citing Standard Operating Procedure 2 ("SOP 2"),[1] 3–7). The POP set a briefing schedule for the parties and also invited briefing from amicus curiae. *Id.* at 2–3.

Petitioner and Patent Owner each filed a brief addressing the POP review issue (Paper 17, "Pet. Br."; Paper 18, "PO Br."), and each party then filed a response to the other party's first brief (Paper 24, "Pet. Resp."; Paper 25, "PO Resp."). Several *amici curiae*—American Intellectual Property Law Association; Canon, Inc.; Google LLC, Microsoft Corp., Arista Networks, and Uber Technologies Inc.; Unified Patents, Inc.; and Sandoz Inc.—filed briefs addressing the POP review issue. Paper 19 ("AIPLA Br."); Paper 20 ("Canon Br."); Paper 21 ("Google Br."); Paper 22 ("Unified Br."); Paper 23 ("Sandoz Br."). An oral hearing was held on June 18, 2019, and a transcript of the hearing is included in the record. Paper 28 ("Tr.").

We grant Petitioner's request for rehearing. We conclude that, based on the totality of the evidence currently in the record, Petitioner has submitted evidence sufficient to establish a reasonable likelihood that the Dougherty reference was publicly accessible before the critical date of the challenged patent, and, thus Petitioner has established a reasonable likelihood that the reference qualifies as a printed publication.

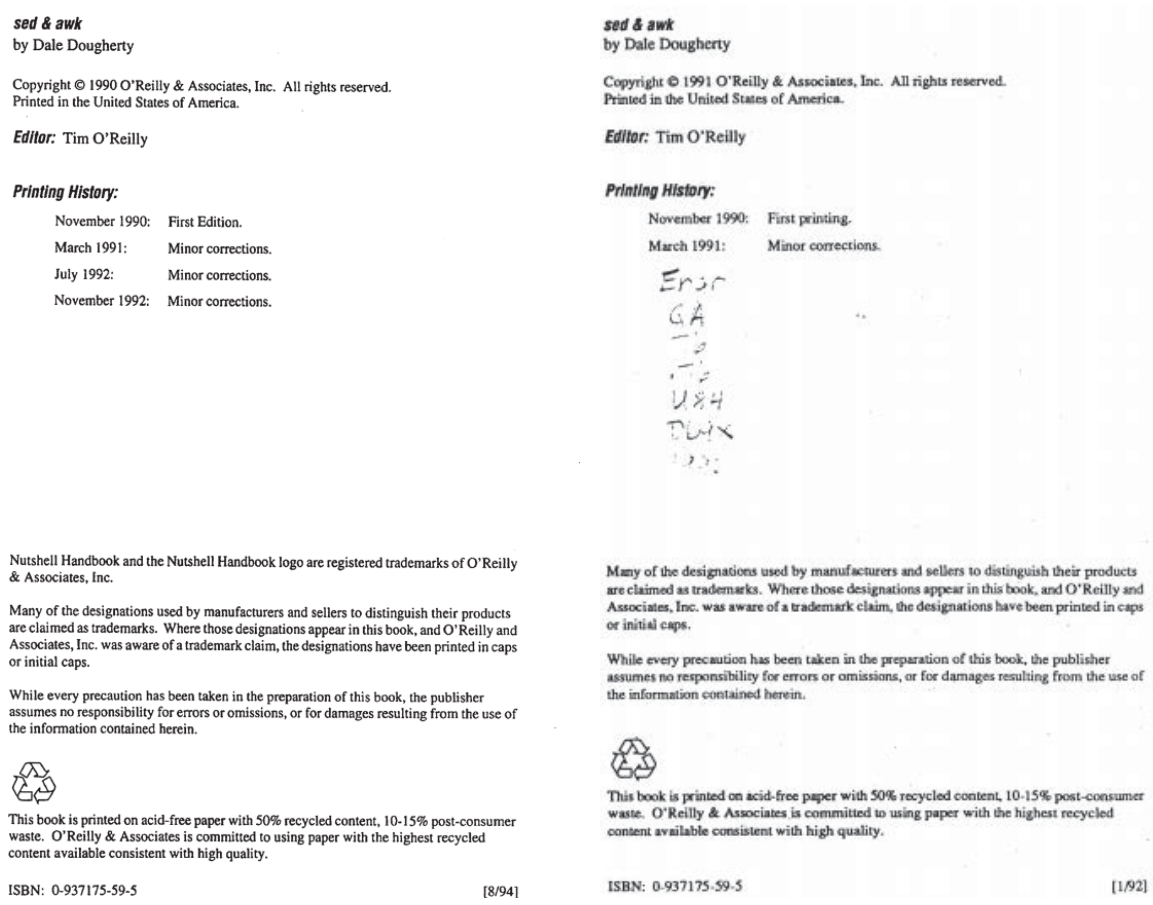
In view of this holding, we remand to the merits panel to determine whether Petitioner has demonstrated a reasonable likelihood that it will prevail with respect to at least 1 of the claims challenged in the Petition. *See* 35 U.S.C. § 314(a).

[1] Available at https://go.usa.gov/xPMqx.

II. BACKGROUND

The following facts are undisputed on this record. *See* Decision 9; Prelim. Resp. 7–9; Pet. Br. 2–3. Petitioner relies on Dougherty as prior art in its asserted ground of unpatentability. Pet. 3–4; Decision 9. Petitioner additionally submits Exhibit 1005 ("Cornell Dougherty"), which contains the first fifteen pages from a different version of Dougherty, and shows a date stamp from the Cornell University Library. Pet. 3, 20; Decision 9. Petitioner also submits an affidavit (Ex. 1006) of Pamela Stansbury, the Administrative Supervisor in the Original Cataloging Unit at Cornell University Library, who avers that Cornell Dougherty was indexed and publicly available on September 16, 1992. Pet. 20; Ex. 1006 ¶¶ 1–2, 4.

The copyright pages from Dougherty and Cornell Dougherty are reproduced below:



sed & awk
by Dale Dougherty

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The copyright pages of Dougherty and Cornell Dougherty, respectively. Ex. 1004, 4; Ex. 1005, 4.

Dougherty, i.e., the version of the book Petitioner relies on as a copy of the prior art reference, indicates that it is the fourth printing of the book and lists four printing dates under the heading "Printing History": November 1990; March 1991; July 1992; and November 1992. Ex. 1004, 4. The words "Minor Corrections" appear next to the three latter dates. *Id.* Dougherty has an ISBN date of "8/94" and lists a 1990 copyright date. *Id.*

Cornell Dougherty, i.e., the version relied on in the librarian's affidavit, indicates that it is the second printing of the book and lists two printing dates under the heading "Printing History": November 1990 and March 1991. Ex. 1005, 4. Cornell Dougherty has an ISBN date of "1/92"

and lists a 1991 copyright date. *Id.* Cornell Dougherty bears a Cornell University Library stamp "ENGR. LIBR. SEP 16 1992." Ex. 1005, 2.

In its first brief before the POP, Petitioner states that it does not rely on evidence that Dougherty was available in the Cornell University Library as of September 1992 because "additional evidence is unnecessary to resolve the question presented." Pet. Br. 3 n.1.

The '062 patent's filing date is October 17, 1995. Decision 10; Pet. 14; Prelim. Resp. 13.

III. ANALYSIS

A. *POP Review Issue*

The issue for POP review is: what is required for a petitioner to establish that an asserted reference qualifies as a "printed publication" at the institution stage? Paper 15, 2.

B. *Principles of Law*

1. Inter Partes Review

Section 311 provides for an *inter partes* review of a patent, upon petition to the Director. The petition must be based on "a ground that could be raised under section 102 [anticipation] or 103 [obviousness] and only on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b) (boldface omitted).

Section 312(a) identifies the required contents of a petition. Among other requirements, it provides that the petition must identify *with particularity* (1) the claims challenged, (2) the grounds on which that challenge is based, (3) the evidence supporting those grounds, including the prior art patents and printed publications and affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions,

and (4) any other information as the Director may require by regulation (*see* 37 C.F.R. § 42.104 (setting forth the required content of the petition)).

In response to a petition, a patent owner may, but is not required to, "file a preliminary response to the petition . . . that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter." 35 U.S.C. § 313.

If the patent owner files a preliminary response, for good cause, the petitioner may seek leave to file a reply with further evidence. 37 C.F.R. § 42.108(c).

The Director then determines whether the information in the petition and in any response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). If the Director makes that determination, the Director may, but is not required to, institute review. *Id.*

If the Director institutes review, the patent owner may file a response. 37 C.F.R. § 42.120. Additionally, the petitioner may file a reply, and a patent owner may file a sur-reply. 37 C.F.R. § 42.23; *see* Consolidated Trial Practice Guide[2] ("CTPG") at 95–97 (App. A-1, Sample Scheduling Order). However, after institution, the petitioner "may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability." CTPG at 73. And the parties cannot raise new issues in reply. *Id.* at 74. The exception to this general rule precluding the submission of new evidence is that the parties can respond to arguments raised in a prior brief and "[a] party also may submit rebuttal

[2] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

evidence in support of its reply." *Id.* at 73–74 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015)).

After institution, there is also an opportunity for the petitioner to move to submit supplemental information under 37 C.F.R. § 42.123. Unless this motion is filed within one month of institution, the petitioner must show "why the supplemental information reasonably could not have been obtained earlier." 37 C.F.R. § 42.123(b) and (c).

In order to prevail in any instituted review, a petitioner has the burden of proving unpatentability by a "preponderance of the evidence." 35 U.S.C. § 316(e) (boldface omitted).

2. Printed Publications

Here, the petitioner challenged the claims based on the existence of a prior art printed publication.[3] Whether a reference qualifies as a "printed

[3] Section 311, discussed above, refers to § 102, which also uses the term "printed publication." Much of the existing case law interprets the term "printed publication" as it arises in § 102(b), and we understand the meaning of the phrase in § 102(b) in the case law to apply to the term "printed publication" in § 311 as well. *See, e.g.*, *United States v. Stewart*, 311 U.S. 60, 64 (1940) (statute *in pari materia* "aids in ascertaining the meaning of the words as used in their contemporary setting").

In pertinent part, pre-America Invents Act (pre-AIA) § 102 provides that:

> A person shall be entitled to a patent unless —
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale

publication" is a legal conclusion based on underlying factual findings. *Nobel Biocare Servs. AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1375 (Fed. Cir. 2018) (citing *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356 (Fed. Cir. 2018)). The underlying factual findings include whether the reference was publicly accessible. *Id.* (citing *In re NTP, Inc.*, 654 F.3d 1279, 1296 (Fed. Cir. 2011)). "The 'printed publication' provision of § 102(b) 'was designed to prevent withdrawal by an inventor . . . of that which was already in the possession of the public.'" *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (alteration in original) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981))).

The determination of whether a document is a "printed publication" under 35 U.S.C. § 102 "involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public." *Medtronic*, 891 F.3d at 1380 (citing *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004)). In certain situations, particularly for manuscripts or dissertations stored in libraries, courts may inquire whether a reference was sufficiently indexed, catalogued, and shelved. *See, e.g.*, *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986); *In re Lister*, 583 F.3d 1307, 1315 (Fed. Cir. 2009) (manuscript became publicly accessible once it was placed in a searchable database). In other situations, such as for information

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> in this country, more than one year prior to the date of the application for patent in the United States, ...

35 U.S.C. § 102(a)–(b) (1994). As it relates to this proceeding, pre-AIA § 103 provides for obviousness based on the types of prior art set forth in pre-AIA § 102.

displayed at meetings and trade shows, courts have explained that indexing is not required if it was sufficiently disseminated. *See Medtronic*, 891 F.3d at 1381 (citing *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014)). The Federal Circuit has summarized that "[w]hile cataloging and indexing have played a significant role in our cases involving library references, we have explained that neither cataloging nor indexing is a necessary condition for a reference to be publicly accessible." *Lister*, 583 F.3d at 1312 (citing *Klopfenstein*, 380 F.3d at 1348).

What constitutes a "printed publication" must be determined in light of the technology employed. *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019) (citing *Wyer*, 655 F.2d at 226). Public accessibility requires more than technical accessibility. *Id.* (citing *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)). "[A] work is not publicly accessible if the only people who know how to find it are the ones who created it." *Id.* at 1372. On the other hand, "a petitioner need not establish that specific persons actually accessed or received a work to show that the work was publicly accessible." *Id.* at 1374. "In fact, a limited distribution can make a work publicly accessible under certain circumstances." *Id.* (quoting *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 694 (Fed. Cir. 2018)).

"Because there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication' bar under 35 U.S.C. § 102(b)." *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Hall*, 781 F.2d at 898–99). "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) (quoting *Bruckelmyer*, 445 F.3d at 1378).

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. *Nobel Biocare Servs.*, 903 F.3d at 1375 (citing *Medtronic*, 891 F.3d at 1380); *see also In re Wyer*, 655 F.2d at 227 (a party asserting a reference as a prior art printed publication should provide sufficient proof of accessibility).

C. *Parties' Arguments*

Petitioner argues that the relevant standard for institution is whether there is a reasonable likelihood that a reference is a printed publication. *See* Pet. Br. 5. Petitioner argues that this standard is satisfied by presenting a "prima facie" case of unpatentability, with the full evidentiary record being developed during the trial phase. *Id.* at 4–7. Petitioner argues that "conventional markers" of publication satisfy this standard. *Id.* at 8–15.

Patent Owner agrees that the relevant standard for institution is whether there is a reasonable likelihood that a reference is a printed publication. PO Br. 2. And Patent Owner agrees that this standard is met through presenting a "prima facie" case. *Id.* at 4. However, Patent Owner argues that this standard is satisfied only when a petitioner presents its "case in chief" in the petition, including all evidence that will be used in any instituted review, with a few limited exceptions. *Id.* at 2–8. Patent Owner describes the threshold determination at institution as a "high" or "elevated"

threshold. *Id.* at 9–10. Thus, Patent Owner argues that conventional markers of publication are not sufficient to meet the standard for institution. *See id.* at 14–15.

The parties' and amici's briefing further raises another related issue, whether there is a presumption in favor of finding that a reference is a "printed publication." *See* PO Resp. 3–4; AIPLA Br. 7; Canon Br. 2, 12; Google Br. 15. In the discussion that follows, we address this additional issue as it pertains to the question submitted for POP review.[4]

D. *Discussion*

1. The standard at institution

35 U.S.C. § 314(a) provides that "[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." Both parties agree that because this is a decision on institution, the statutory "reasonable likelihood" standard for institution applies to the issue of whether a reference is a printed publication. 35 U.S.C. § 314(a); *see also Optium Corp. v. Emcore Corp.*, 603 F.3d 1313, 1319–20 (Fed. Cir. 2010) (applying the applicable standard of proof to an essential element). However, the parties disagree as to what

[4] Patent Owner also argues that the Federal Rules of Evidence apply before institution and that a petitioner must satisfy the Federal Rules of Evidence. PO Br. 8. We do not reach the question of excluding evidence at this time, as it is beyond the scope of the POP question. Similarly, the facts of this case do not implicate the procedure for pre-institution reply briefing to which Patent Owner and one amicus refer; that is also beyond the scope of the POP question. *See* PO Br. 6; Google Br. 14.

the institution standard means in terms of presenting its evidence. The statute answers that question – it provides that a petitioner is required to present evidence and arguments sufficient to show that it is reasonably likely that it will prevail in showing the unpatentability of the challenged claims. *See* 35 U.S.C. §§ 312(a)(3), 314(a). Additionally, the statute requires that the petition identify *with particularity* the grounds for institution and evidence supporting such grounds. 35 U.S.C. § 312(a). This includes the prior art relied upon and evidence that it qualifies as such. This standard is far more than is required in typical notice pleading, which only requires that a party make plausible claims. *See* F.R.Civ.P. 8(a)(2) (general rules of pleading in federal courts); *ABB Turbo Sys. AG v. Turbousa, Inc.*, 774 F.3d 979, 984 (Fed. Cir. 2014). Thus, at 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.

As to Patent Owner's argument that this is a high or elevated threshold for institution, that depends on the frame of reference. We have explained that it is a higher standard than mere notice pleading, but, as both parties agree, it is lower than the "preponderance" standard to prevail in a final written decision.[5] The Federal Circuit has described these standards as

[5] For a post-grant review, the standard for institution is whether it is "more likely than not" that the petitioner would prevail at trial (*see* 35 U.S.C. § 324(a)), and the standard of proof at trial is a preponderance of the evidence (35 U.S.C. § 326(e)). Accordingly, to institute a post-grant review, a petitioner would have to establish that it is more likely than not that it will prevail at trial.

"qualitatively different." *See, e.g.*, *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (comparing § 314(a) with § 316(e)) ("TriVascular's argument also fails to appreciate that there is a significant difference between a petitioner's burden to establish a 'reasonable likelihood of success' at institution, and actually proving invalidity by a preponderance of the evidence at trial. The Board's findings in its Final Written Decision were thus not inconsistent with those in its Institution Decision; they were made under a qualitatively different standard.") (citations omitted).

2. After filing a petition, a petitioner has limited opportunities to submit additional evidence

While the petitioner must submit evidence sufficient to meet the reasonable likelihood standard, some limited opportunities exist for the petitioner to present new evidence later, including: (1) in a reply to a patent owner preliminary response; (2) in a reply to the patent owner response; and (3) in a motion to file supplemental information. 37 C.F.R. §§ 42.108(c), 42.23, 42.123. As to the first two opportunities, the evidence must be responsive to the prior briefing. 37 C.F.R. § 42.23 ("A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response."). As to the third, the supplemental information must be relevant to a claim for which trial was instituted and, if the submission occurs after one month from institution, the petitioner must show good cause as to "why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R. § 42.123.

For example, if the patent owner challenges a reference's status as a printed publication, a petitioner may submit a supporting declaration with its reply to further support its argument that a reference qualifies as a printed publication. *See* 37 C.F.R. §§ 42.2 (affidavit), 42.23. Or, if 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. 37 C.F.R. § 42.123; *see, e.g.*, *Nikon Corp. v. ASML Netherlands B.V.*, IPR2018-00688, Paper 16 at 5–6 (PTAB Oct. 29, 2018) (granting motion to submit librarian declaration as supplemental information); *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2014-01149, Paper 19 at 6–7 (PTAB March 30, 2015) (granting motion to submit supplemental information as to librarian declarations attesting to the public accessibility of documents on which trial was instituted); *see also Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1345–46 (Fed. Cir. 2019) (concluding that the Board did not abuse its discretion in admitting librarian declaration as supplemental information).

The opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016) (affirming Board discretion to deny entry of petitioner's reply brief that contained an improper new unpatentability theory and evidence, citing, among other things, § 312(a)(3)); *see also* CTPG at 74 ("'Respond,' in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing."). Whether any

additional evidence changes the theories presented in a petition will be determined under the facts and circumstances of that particular case.

3. *There is no presumption in favor of finding that a reference is a "printed publication"*

Based largely on 37 C.F.R. § 42.108, some *amici* argue that there is a presumption in favor of institution generally and, therefore, a presumption in favor of finding a reference to be a printed publication at the institution stage. *See* AIPLA Br. 7; Canon Br. 2, 12; Google Br. 15. Patent Owner argues that, contrary to *amici*, 37 C.F.R. § 42.108(c) does not apply to whether a petitioner failed to present adequate evidence that a reference is a printed publication. PO Resp. 3–4. We agree with Patent Owner that there is no presumption in favor of institution or in favor of finding a reference to be a printed publication under § 42.108(c) or any other authority. As discussed herein, the burden is on the petitioner to 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.

Section 42.108(c) merely provides that a patent owner may file a declaration with its preliminary response and addresses how the Board will resolve "a genuine issue of material fact created by such testimonial evidence."[6] The rule does not articulate any general presumptions. In any

[6] Section 42.108 reads, in pertinent part, as follows:

> The Board's decision will take into account a patent owner preliminary response where such a response is filed, including any testimonial evidence, but a genuine issue of material fact

event, Patent Owner did not file a declaration in this preliminary proceeding, so the rule is not implicated.

4. The role of indicia on the face of a reference

Petitioner argues that a reference meets the reasonable likelihood standard for institution where the reference bears conventional markers of publication, such as a copyright date, edition identifiers, publication by a commercial publisher, and the assignment of an ISBN number. Pet. Br. 2–3, 9–14; *see also* Canon Br. 15 (arguing that panels should accept as true facially reliable evidence presented by a petitioner showing publication and may consider copyrights among other evidence); Google Br. 1, 6–7 (arguing that a petitioner should be permitted to rely on a publication date or copyright date appearing on the face of a reference in the first instance); Sandoz Br. 3 (arguing that a petitioner could rely on the facial date of a reference among other evidence). Petitioner states that other evidence, such as a supporting declaration, could be used if a reference lacks indicia sufficient to establish public availability. Pet. Br. 9; *see* Canon Br. 15. Patent Owner argues that printed dates or stamps are not sufficient evidence of public accessibility. PO Br. 14–15 (citing, e.g., *Nobel Biocare*, 903 F.3d at 1379).

We do not hold that any particular indicia per se is sufficient at the institution stage. Rather, the indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the

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> created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review.

37 C.F.R. § 42.108(c).

evidence. *See Nobel Biocare*, 903 F.3d at 1377 ("Although the ABT Catalog's date is not dispositive of the date of public accessibility, its date is relevant evidence that supports the Board's finding of public accessibility at the March 2003 IDS Conference.").

The Board has often found a reasonable likelihood that a reference is a printed publication for institution of an *inter partes* review when the evidence relied on in a petition provides strong indicia that an asserted reference was publicly accessible. For example, the Board determined that a package insert for a drug, supported with a screenshot of an FDA webpage from the Wayback Machine, a declaration from the office manager of the Internet Archive including the site's archival records, and expert testimony asserting its public accessibility was sufficient evidence for instituting an *inter partes* review. *Sandoz Inc. v. Abbvie Biotechnology Ltd.*, IPR2018-00156, Paper 11 at 8–13 (PTAB June 5, 2018). Similarly, the Board determined that a thesis, supported with a declaration from the author's thesis advisor discussing the university's thesis publication practices and with evidence of indexing on a national library system website, was sufficient evidence of public accessibility to institute an *inter partes* review. *Seabery N. Am. Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 11 at 7–8 (PTAB Oct. 6, 2016). Additionally, the Board determined that a user manual, supported with a copyright notice, metadata information from the reference on the company's website, the release date of the printed version, a declaration from the office manager of the Internet Archive, and a declaration from an expert stating that she located and obtained a copy of the reference before the patent's filing date, was sufficient evidence of public accessibility to institute an *inter partes* review. *Syncro Soft SRL v. Altova*

Gmbh, IPR2018-00660, Paper 6 at 8–10 (PTAB Sept. 5, 2018).

Conversely, the Board has found evidence insufficient on this issue for institution of an *inter partes* review when a petitioner's evidence of indicia was weak. For example, the Board determined that a dissertation, supported with a Joint Statement of Uncontested Facts from a related district court litigation identifying the dissertation as prior art for the purposes of that litigation, and evidence that a student's dissertation advisor cited similar dissertations was insufficient to show public accessibility for purposes of institution. *Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204, Paper 19 at 8–12 (PTAB May 23, 2016). Further, the Board previously concluded that a conference paper, bearing a copyright date of 2012 and including a date of September 2012 on its cover, was insufficient to show that the paper had been disseminated prior to the conference (November 2012). *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 14 at 4–13 (PTAB Sept. 6, 2019).

5. Application of the law to the facts present on this record

We determine that, at this point in the case and for purposes of institution, and based on the totality of the evidence to date, Petitioner has established a reasonable likelihood that Dougherty is a printed publication. The face of Dougherty bears a copyright date of 1990, a printing date of November 1992, and an ISBN date of 8/94. Ex. 1004, 4. In addition, the book is a textbook from an established publisher, O'Reilly, and a well-known book series. *See* Canon Br. 11–12 (quoting https://www.oreilly.com/about/history.html). As Canon asserts, the cover of *Publisher's Weekly* stated (with respect to this series) that "The Internet Was Built With O'Reilly Books." *Id.* Altogether, this is sufficient evidence to

establish a reasonable likelihood that Dougherty is a printed publication that a publisher made available to the pertinent public prior to the October 1995 critical date.

Patent Owner disputes Petitioner's use of an affidavit, pointing out that the affidavit addresses a different version of Dougherty, i.e., Cornell Dougherty. *See* PO Br. 13–14. Petitioner no longer relies on the affidavit accompanying Cornell Dougherty (*see* Pet. Br. 3 n.1.), and we do not find the affidavit necessary to our decision that Petitioner has presented sufficient evidence for purposes of institution.

Patent Owner also contends that we should not allow Petitioner to disavow the affidavit accompanying Cornell Dougherty on rehearing because that would amount to changing arguments on rehearing. *See* PO Resp. 9–10 (citing 37 C.F.R. § 42.71(d)). However, Petitioner is not changing its position on rehearing because the affidavit is not required. Nevertheless, even considering the affidavit, we arrive at the same conclusion, i.e., that Petitioner has presented a reasonable likelihood that the Dougherty reference is a printed publication. We observe that the affidavit accompanies an earlier printing of Dougherty. We further note that the affidavit is probative that Dougherty is the type of book that a university library would have collected and catalogued. *See* Ex. 1005, 2 (library stamp); Ex. 1006 ¶¶ 3, 5 (affidavit discussing Cornell University library). Taken together with all of the evidence of record, including the evidence regarding Dougherty discussed above, we determine that Petitioner has established a reasonable likelihood that Dougherty is a printed publication, which suffices at the institution stage.

We do not opine at this stage of the proceeding as to the ultimate determination of whether Petitioner will establish by a preponderance of the evidence—the standard to prevail at trial (35 U.S.C. § 316(e))—that Dougherty is a printed publication. Should trial be instituted, Patent Owner may challenge Petitioner's evidence, and Petitioner may respond if appropriate, as indicated herein.

IV. CONCLUSION

For institution of an *inter partes* review, a petitioner must establish a reasonable likelihood that a reference is a printed publication. If trial is instituted, the petitioner will ultimately have the burden to prove that the reference is a printed publication by a preponderance of the evidence. We conclude that, based on the totality of the evidence currently in the record, Petitioner has established a reasonable likelihood that the Dougherty reference is a printed publication that was publicly accessible before the critical date of the challenged patent.

V. ORDER

It is hereby

ORDERED that Request for Rehearing is *granted* to address the POP review issue; and

FURTHER ORDERED that the matter is remanded to the original merits panel for further proceedings consistent with this opinion, including consideration of whether to institute a trial on the merits of the obviousness ground presented in the Petition.

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