

PTAB 'Printed Publication' Scrutiny Can Trip Up Challengers

By Ryan Davis

Law360, New York (January 17, 2018, 8:01 PM EST) -- The Patent Trial and Appeal Board has stringent requirements for when printed publications like thesis papers can be used to challenge patents, and zeroing in on them is an effective way for patent owners to defeat challenges. Here's a primer on the board's handling of this key America Invents Act review issue.

In inter partes reviews, petitioners can ask the PTAB to review patents that they believe are rendered anticipated or obvious by previous inventions described in either earlier patents or printed publications. The printed publication issue can often turn into a key battlefield in AIA reviews and usually plays out at the institution stage, where the board decides whether to review a patent at all.

Challenges based on patents are straightforward, but the PTAB has issued numerous decisions about what exactly does and does not qualify as a printed publication.

The board has held that the printed publication must have been available to the public before the patent being challenged was filed, and in a way that skilled artisans could locate it using reasonable diligence. The burden is on the petitioner to show that, and in many cases the board has said the burden was not met and refused to review the patent as a result.

"If you don't meet the burden, the board has been more than willing to deny institution, which can be extraordinarily detrimental," said John Strand of [Wolf Greenfield & Sacks PC](#).

For patent owners, persuading the board that the petitioner's prior art does not qualify as a printed publication is a resounding victory, fending off review by a tribunal that has struck fear into the hearts of many patentees by issuing hundreds of decisions invalidating claims.

"Patent owners have been much more aggressive when [this issue] hasn't been fully proved up, because attacking that can be, for lack of a better term, an easy out," said Justin Oliver of [Fitzpatrick Cella Harper & Scinto](#). "It's the low-hanging fruit of the arguments available to you."

Compared to district court, where judges are often unwilling to delve into minutiae like the date a document became publicly available, litigants have found the PTAB ready and willing to grapple with the issue.

"There's a big difference between the PTAB and district court," Strand said. "The board is much more

skeptical towards documents that would be more readily accepted in litigation."

For some types of printed publications, like articles in reputable scientific journals, proving that they were publicly accessible is generally not an issue, as the PTAB accepts that the publication date on the journal is when it was available.

Things get more murky when petitioners rely on documents like a graduate school thesis found only in a specific university's library, a presentation that appeared only online, a paper distributed at a conference, or a catalog at a trade show. It can often be a challenge to show that such publications were available to skilled artisans and, if so, when.

"It may be easy to prove it was out there, but it may be difficult to prove the exact date," said Jason Eisenberg of Sterne Kessler Goldstein & Fox PLLC.

In cases involving libraries, petitioners often produce declarations from librarians or others with firsthand knowledge of when the document could be accessed by the public, such as when the document was indexed and could be located through a search.

"Anything you can show was publicly available at a library is your best bet," Oliver said.

A librarian's word will often suffice, but not always. The board has found fault with some brief, cursory declarations by librarians, saying they do not provide enough information to show that the declarant knew the date the document was actually available. In addition, the growing number of AIA reviews has caused some librarians to shy away from the proceedings.

"Some librarians are willing to give declarations, but it's less and less common," Strand said. "Many librarians don't want to get involved."

Petitioners face myriad pitfalls when relying on printed publications beyond documents found in libraries, as the PTAB has cast a skeptical eye on many types of documents.

Online documents present a special case. Petitioners have successfully used the internet archive known as the Wayback Machine to show when a document was online, and the archive's operators have often submitted PTAB declarations. But if the document itself is not in the archive, only a link or reference to it elsewhere, the PTAB has said that's not enough.

Similarly, in one case last year, the board held that a patient consent form that was disseminated to patients and posted on an oncology group's website was not a printed publication because there was not sufficient evidence that skilled artisans would be able to find it.

The board also recently rejected a petitioner's argument that an article was publicly available because it was cited on a website announcing a symposium, ruling that there was no indication of what was presented at the symposium or who attended.

In that case, the board also rejected the claim that the same document was accessible because it was mentioned in other academic papers, saying that only showed that the authors, not the public, knew about the document.

While unsuccessful petitioners may see such decisions as nitpicking, attorneys say that because

petitioners have the burden to show that a document is a printed publication, it is up to them to affirmatively prove that they can use it to challenge the patent by showing both that it was publicly accessible and exactly when.

"The more evidence you can put in to show that it was publicly accessible, the more likely it is that you'll be able to avoid some of the negative outcomes people have run into," said David Cochran of Jones Day.

It's therefore imperative for petitioners to thoroughly think about how the printed publication they're relying on was disseminated and provide support. That's especially true because if the PTAB denies institution, the AIA's time limit on petitions likely means the challenger won't get another shot.

On the opposing side, patent owners have realized that "this is a very hot attack you can make to get institution denied," Eisenberg said. So it's important for patentees aiming to avoid a PTAB review to hammer the printed publications presented by petitioners and force them to prove their case.

"The patent owner should be relentless and make sure the petitioner has dotted the i's and crossed the t's to show that it's a printed publication," Strand said.

One lesson some petitioners have taken from the PTAB's aggressive scrutiny of printed publications is that it may be better to use them only when absolutely necessary.

"Unless your nonpatent prior art is significantly better than your patent prior art, the better strategy is to go with the patent prior art. Then you don't have to deal with this issue," Cochran said.

--Editing by Mark Lebetkin and Katherine Rautenberg.