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The Challenge of Proving Publication at the PTAB

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In December of last year, in the precedential *Hulu* case, the PTAB found that for purposes of institution under 35 U.S.C. § 311(b), a petitioner must show a reasonable likelihood that an asserted reference qualifies as a printed publication.[1] Last week, the PTAB made clear that the publication issue is a major point of emphasis, designating an additional five decisions as either precedential or informative.[2] While the issue of public-accessibility is highly fact-dependent, there are some lesson to be drawn from these cases.

The first case deals with the rules that apply in examination versus those applied in post-grant proceedings, finding that they are different. In *Ex parte Grillo-López*, the PTAB found that the same FDA transcript was available as a reference in examination but **not** publicly available in IPR proceedings. In so finding, the PTAB noted that the examination context involves a burden-shifting framework in which the applicant is required to come forward with rebuttal evidence once the Examiner sets out a *prima facie* case. In contrast, the petitioner bears the burden of proving the public availability of references in the IPR context.

All of the remaining informational cases were decided pre-*Hulu* and discuss evidence the PTAB used to determine whether a reference qualifies as a printed publication. Generally, these cases stand for the proposition that specific evidence is required to prove public-accessibility of the reference.

Two of the cases dealt with the public accessibility of a thesis, finding public-accessibility in one case but not in the other. In *Sandoz*, the Petitioner provided specific testimony regarding availability of the thesis in the relevant time frame, and the PTAB found the testimony sufficient to show public accessibility. In *Argentum*, the PTAB found that Petitioner failed to show that the particular thesis on which the petition relied was publicly accessible in the relevant time frame and how one might have obtained a copy. Even a stipulation in a related litigation was not found to be dispositive since it was provided in a different context and Petitioner was not a party.

As PTAB practitioners are well aware, a copy of the document available on the Internet Archive (the “Wayback Machine”) on a particular date and accompanied by an affidavit can help prove public accessibility of a reference.[3] Finally, the PTAB noted that while evidence of indexing is probative of public accessibility, it is not necessary in all cases.[4]

What is clear from these cases is that the PTAB will closely evaluate the issue of publication when determining whether to institute a proceeding. Petitioners must submit evidence proving public accessibility during the

relevant time frame. And Patent Owners should closely evaluate such evidence in determining whether to file a Preliminary Response challenging such references.

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[1]*Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039 (PTAB Dec. 20, 2019) (Designated: Dec. 20, 2019) (Paper 29).

[2]*Ex parte Grillo-López*, 2018-006082 (Jan. 31, 2020); *Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.*, Case IPR2016-00204, Paper 19 (May 23, 2016); *Seabery North America Inc. v. Lincoln Global, Inc.*, Case IPR2016-00840, Paper 11 (Oct. 6, 2016); *Sandoz Inc. v. AbbVie Biotechnology Ltd.*, Case IPR2018-00156, Paper 11 (June 5, 2018); and *In-Depth Geophysical, Inc. v. ConocoPhillips Company*, Case IPR2019-00849, Paper 14 (Sept. 6, 2019).

[3]See, *Seabery North American*.

[4]See, *Sandoz*.