

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

Case No. IPR2018-01039
U.S. Patent No. 5,608,062 B2

**BRIEF OF AMICUS CURIAE AMERICAN INTELLECTUAL PROPERTY
LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY**

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I. Interest of Amicus Curiae¹

The American Intellectual Property Law Association (“AIPLA”) is a national bar association of approximately 13,500 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention, while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

II. Introduction

AIPLA appreciates the opportunity to present its views to the Patent Trial and Appeal Board in response to the Board’s Order dated April 3, 2019, for Precedential

¹ This brief was not authored, in whole or in part, or paid for by counsel to a party. AIPLA believes that (1) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to the proceeding in this matter; and (2) no representative of any party to this proceeding participated in the authorship of this brief.

Opinion Panel (“POP”) Review in this proceeding. This Amicus Brief addresses the question of what is required for a petitioner to establish that an asserted non-patent reference qualifies as a “printed publication” at the institution stage.

As noted in Petitioner’s request for rehearing, the standard required for a petitioner to establish printed-publication status of an asserted non-patent reference has not been consistently articulated or applied by Board panels.

It is well-settled law that public accessibility is critical to the question of whether a reference constitutes a printed publication on which an anticipation or obviousness challenge in an inter partes review (IPR) proceeding, a post-grant review (PGR) proceeding, or a proceeding under the transitional program for covered business method patents (CBM) can be based. *See* 35 U.S.C. § 311(b); 35 U.S.C. § 322(a)(3)(A). “To qualify as a printed publication, a reference must have been sufficiently accessible to the public interested in the art.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (internal quotation marks omitted). Indeed, “‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’” *In re Hall*, 781 F.2d 897, 899 (Fed Cir. 1986). Public accessibility refers to a reference being disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence could have located it before the critical date. *Blue Calypso*, 815 F.3d at 1348.

An unsettled question has arisen at the institution stage of IPR, PGR, and CBM proceedings, however. Some IPR institution decisions expressly invoke the public-accessibility standard when assessing the issue of printed-publication status. *See Great W. Cas. Co. v. Intellectual Ventures II LLC*, IPR2015-01706, Paper 10 at 12 (P.T.A.B. Feb. 9, 2016). Many panels have specifically articulated a “threshold showing” of “public accessibility” required for institution. *See Dr. Reddy’s Labs., Inc. v. Celgene Corp.*, IPR2018-01507, Paper 7 at 6–7 (P.T.A.B. Feb. 11, 2019); *HTC Corp. v. Cellular Commc’ns Equip. LLC*, IPR2016-01503, Paper 7 at 16–17 (P.T.A.B. Feb. 13, 2017); *GoPro Inc. v. Contour, LLC*, IPR2015-01078, Paper 8 at 14 (P.T.A.B. Oct. 28, 2015). Others have applied different standards. For instance, some panels have required a “sufficient showing” of printed publication status, without specifically acknowledging the public accessibility requirement. *See Seabery N. Am. Inc. v. Lincoln Global, Inc.*, IPR2016-00840, Paper 11 at 7 (P.T.A.B. Oct. 6, 2016). Even among those panels requiring a threshold showing of public accessibility, some have applied the standard more rigorously than others.

AIPLA believes that, when the evidence filed with an IPR petition establishes a reasonable likelihood that an asserted non-patent reference was publicly accessible before the critical date, the petitioner has established that the reference qualifies as a printed publication for purposes of institution. Similarly, a petitioner establishes that an asserted non-patent reference qualifies as a printed publication for institution

of a PGR or CBM proceeding when the evidence filed with the petition shows it was more likely than not that the reference was publicly accessible before the critical date.

III. The statutory threshold for institution and the public accessibility requirement for establishing printed publication should be consistent

Congress established the thresholds that must be met for the Director to institute IPR, PGR, and CBM proceedings. These statutory thresholds should guide the Board's standard for assessing printed-publication status at the institution stage.

Section 314(a) provides the statutory threshold for instituting an IPR proceeding:

(a) Threshold.— The Director may not authorize an inter partes review to be instituted unless the Director determines that the *information presented in the petition* filed under section 311 and any response filed under section 313 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) (emphasis added); *accord* 37 C.F.R. § 42.108(c).

Section 324(a) provides the statutory threshold for instituting a PGR or CBM proceeding:

(a) Threshold.— The Director may not authorize a post grant review to be instituted unless the Director determines that the *information presented in the petition* filed under section 321, if such information is not rebutted, would demonstrate that it is *more likely than not* that at least 1 of the claims challenged in the petition is *unpatentable*.

35 U.S.C. § 324(a) (emphasis added); *accord* 37 C.F.R. § 42.208(c).

The subsidiary issue of whether a non-patent reference asserted in the challenge qualifies as a printed publication under 35 U.S.C. § 102 falls within the larger issue of unpatentability. Accordingly, the same institution threshold standard should apply to the issue of printed-publication status, including whether a non-patent reference was publicly accessible before the critical date. *See Hall*, 781 F.2d at 899 (public accessibility is the touchstone for “printed publication” determination).

Consistent with the statutory threshold, a petitioner establishes that an asserted non-patent reference qualifies as a printed publication for purposes of institution of an IPR proceeding when the evidence filed with the petition establishes a reasonable likelihood that the reference was publicly accessible before the critical date. *See* 35 U.S.C. § 314(a). Similarly, a petitioner establishes that an asserted non-patent reference qualifies as a printed publication for institution of PGR or CBM proceeding when the evidence filed with the petition shows it was more likely than not that the reference was publicly accessible before the critical date. 35 U.S.C. § 324(a). In its POP review of this case, the Board should expressly set forth this standard to clarify the “threshold showing” on printed-publication status required for institution.

IV. At the institution stage, the Board’s consideration of evidentiary issues should be limited and any factual dispute should be viewed in the light most favorable to the petitioner

Some of the confusion around the “threshold showing” for establishing a non-patent reference as a printed publication rests with associated evidentiary issues. Board rules require a petition to identify the “exhibit number of supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. §§ 42.104(b)(5), 42.204(b)(5), 42.304(b)(5). To satisfy these evidentiary requirements with respect to the issue of publication, a petition must identify the evidence that supports a finding that a non-patent reference qualifies as a printed publication, where specifically that evidence is in the exhibits filed with the petition, and why that evidence is relevant.

The Board should not exclude supporting evidence as inadmissible under the Federal Rules of Evidence at the institution stage. Objections to evidence filed with the petition are due within ten business days of institution of a trial. 37 C.F.R. § 42.64(b)(1). The scheduling order accompanying an institution decision typically sets the deadline for a motion to exclude evidence under 37 C.F.R. § 42.64(c) for an even later date after the patent owner response, reply, and sur-reply. *See, e.g., Unified Patents Inc. v. MOAEC Techs., LLC*, IPR2018-01759, Paper 13 at 7–8 (P.T.A.B. Apr. 17, 2019). Because Board rules do not contemplate receiving

objections to evidence until after institution and because a Board panel does not receive briefing on evidentiary issues until late in a proceeding, it is premature to exclude supporting evidence as inadmissible under the Federal Rules of Evidence at the institution stage.

Consistent with existing Board practice, any factual dispute concerning the issue of whether the reference qualifies as a printed publication should be resolved in favor of the petitioner for purposes of the Board's determination whether to institute a trial. 37 C.F.R. §§ 42.108(c), 42.208(c).

V. The “reasonableness” aspect of the institution threshold allows the Board to reduce opportunities for gamesmanship

AIPLA is sensitive to the opportunity for gamesmanship at the institution stage. As a matter of fairness, petitioners ordinarily should not be allowed to provide supporting evidence that manifestly violates the Federal Rules of Evidence to obtain an institution decision and present the patent owner with arguably compliant supporting evidence for the first time on reply. Because patent owners are only entitled to a short sur-reply as a matter of right in response to the reply, this tactic would prejudice the patent owner's ability to address the additional supporting evidence.

AIPLA recognizes that Board rules permissively allow panels to “exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge,” which includes

the subsidiary issue of whether any non-patent reference in the challenge qualifies as a printed publication. 37 C.F.R. §§ 42.104(b)(5), 42.204(b)(5), 42.304(b)(5). AIPLA believes that complete exclusion of evidence at the institution stage should be applied only in extraordinary cases. For example, if circumstances reveal a clear intent to fill the record with evidence through the filing of petition, with no indication how the evidence relates to the issues in the proceeding, it may be appropriate to give no weight to that evidence.

In general, however, AIPLA believes that the reasonableness aspect of the institution threshold standard gives the Board discretion to assign appropriate weight to supporting evidence, allowing the Board to guard against gamesmanship. The Board may consider a petitioner's good-faith effort (or lack thereof) to address authenticity and admissibility issues for documentary supporting evidence and personal knowledge issues for testimonial supporting evidence. Again, while the Board generally should not exclude supporting evidence as inadmissible under the Federal Rules of Evidence or for other reasons at the institution stage, it may be appropriate to apply the reasonableness standard to avoid opportunities for gamesmanship when assessing the weight given to supporting evidence.

VI. No further guidance is required on classes of documents

AIPLA does not believe this POP review needs to reiterate the established body of law on public accessibility. As has been established through § 102

jurisprudence over the years, many classes of documents can potentially qualify as printed publications, running the gamut from treatises to poster presentations. Indeed, the Manual of Patent Examining Procedure summarizes many cases on establishing public accessibility and guides examiners on how to address these document classes. M.P.E.P. §§ 2128, 2128.01. In the context of IPR, PGR and CBM proceedings, a patent owner preliminary response can appropriately alert the Board if the evidence filed with the petition does not satisfy the public accessibility standard for the relevant class of document. Therefore, no further guidance on the substantive issue of public accessibility is required in this POP review.

VII. Conclusion

For the foregoing reasons, in connection with an IPR petition, an asserted non-patent reference should qualify as a printed publication for purposes of the institution decision when the evidence filed with the petition has established a reasonable likelihood that the reference was publicly accessible before the critical date. Similarly, in connection with a PGR or CBM petition, an asserted non-patent reference should qualify as a printed publication for purposes of the institution decision when the evidence filed with the petition shows it was more likely than not that the reference was publicly accessible before the critical date. While the Board generally should not exclude any supporting evidence as inadmissible under the Federal Rules of Evidence or for other reasons at the institution stage, the Board

should apply the reasonableness standard when assessing the weight given to supporting evidence to discourage gamesmanship.

Dated: May 1, 2019

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CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing brief complies with the page limit set forth in the Board's Order dated April 3, 2019, authorizing amicus curiae to file a brief of no more than 15 pages.

I also certify that this brief has been prepared in a proportionally spaced type (Times New Roman, 14-point) using a Microsoft Word word-processing system.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 1st day of May, 2019, I caused to be served a true and correct copy of the foregoing by electronic mail on the following counsel:

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