



## PTAB: Digital Repository's Listed Publication Date Insufficient to Show Reference's Public Availability

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The Patent Trial and Appeal Board denied institution of an *inter partes* review after determining that petitioner failed to establish public availability of a prior art reference based on an alleged publication date listed in several digital repositories. The board also held that evidence in the form of a linked webpage is entitled to no weight.

The challenged patent related to systems and methods of detecting, controlling and removing pestware, which is any computer program that collects information about a person or an organization. Petitioner asserted several grounds of unpatentability, all of which relied on a reference authored by Li. In response, patent owner argued that petitioner had failed to show that the Li reference was publicly available as of the asserted priority date. To establish public availability, petitioner relied on a declaration from a university professor who did not claim to have personal knowledge of when the Li reference was published. Instead, the professor testified that the Li reference was presented at a conference and was also published in three digital repositories, all of which indicated a publication date of January 2004. As further evidence of public accessibility, the professor stated that more than 30 publications in Google Scholar had cited the Li reference.

Ultimately, the board sided with patent owner. As a threshold matter, the board noted that the professor's declaration cited several webpage links, instead of exhibits as required by the rules. Despite being given an opportunity to correct this error by filing late copies of the webpage links as exhibits, petitioner did not do so. The board refused to consider the hyperlinked webpages as evidence and in doing so emphasized that exhibits must be filed

because, unlike a webpage link, exhibits are not subject to change or removal and provide public access to the record of the case. As such, the board determined that the professor's declaration was unsupported because it relied on links instead of exhibits. In addition, the board accorded the declaration little or no weight and held that petitioner failed to establish public availability of the Li reference.

The board found that even if it were to consider the substance of the webpage links, petitioner still failed to show that the Li reference was publicly available before the priority date of the challenged patent. In this regard, the board noted that the Li reference is undated and has no indication within its four corners evidencing a timeframe in which it might have been published. Petitioner also submitted no evidence that the Li reference was disseminated at a conference or otherwise made available such that persons interested and ordinarily skilled in the subject matter could locate it with reasonable diligence. Petitioner's assertion that the Li reference "is" available from digital repositories does not show that it *was* publicly accessible in the relevant timeframe—i.e., 17 years earlier. The board found the reliance on the purported publication dates in the digital repositories unpersuasive. For one thing, one of the repositories, ResearchGate, was not established until after the patent's priority date. Google Scholar, another digital repository, listed the Li reference only through a link to ResearchGate. Moreover, the Li reference's citation to papers dated *after* January 2004 called into question the January 2004 purported publication date in the ResearchGate and Google Scholar repositories. Given the lack of evidentiary support, the board agreed with patent owner that petitioner merely relied on speculation that the Li reference was publicly accessible in the relevant timeframe and accordingly declined to institute the IPR.

**Practice Tip:** Parties in IPR proceedings should heed the rules for submitting evidence to the board and should avoid citations to webpages in lieu of exhibits. Parties are also well advised to avoid relying on merely the publication date listed in a digital repository, without more, when attempting to establish a reference's date of public availability.

*Sophos Ltd. v. Open Text Inc.*, IPR2023-00732, Paper 23 (P.T.A.B. Nov. 2, 2023)

## Categories

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