



## **PTAB: Merely Showing That a Reference Was Available on the Internet Does Not Establish ‘Public Accessibility’**

January 29, 2024

Reading Time : **2 min**

By: Megan R. Mahoney, Matthew George Hartman, Rubén H. Muñoz

The Patent Trial and Appeal Board denied institution of a petition for IPR after determining that the petitioner failed to show a reasonable likelihood that its primary asserted reference, which was available through the Internet Archive, qualified as a prior art printed publication that was publicly accessible before the critical date. In particular, the board found that the petitioner failed to present sufficient evidence that an interested party exercising reasonable diligence would have located the archived reference.

The challenged patent relates to a free-standing solar tracker that rotates a solar panel assembly to track the movement of the sun during the day. The petitioner challenged two claims as anticipated and obvious over an installation guide for a solar tracker. In addressing the prior art status of the asserted installation guide, the petitioner stated that the reference was publicly accessible because it was available on a webpage prior to the critical date of the patent, as verified by the Internet Archive’s Wayback Machine. As further support that the reference constituted prior art, the petitioner also submitted an affidavit from a record processor at the Internet Archive who explained that the Wayback Machine allows users to browse more than 450 billion archived webpages by searching their URLs. The affidavit attached screenshots of the webpage that contained the asserted installation guide.

The patent owner in its response argued that the petitioner failed to meet its burden in establishing that the reference is prior art. According to the patent owner, the petitioner did not show that the website containing the reference was indexed in a manner that would allow a person of ordinary skill in the art to locate it. Thus, in the patent owner’s view, the

petitioner failed to demonstrate that the reference was publicly accessible such that it could have been located with reasonable diligence by those interested or ordinarily skilled in the subject matter.

The board ultimately agreed with the patent owner and found that the petitioner failed to present sufficient evidence or argument to demonstrate that the asserted reference was publicly accessible. In doing so, the board first distinguished the petitioner's reference from an online publication that would have been well known to the community interested in the subject matter. Here, the petitioner provided no evidence that a person interested in solar panel assemblies would have been independently aware of the web address or even the company name for the asserted installation guide. Next, the board noted there was an absence of evidence demonstrating that the website at which the reference was located was indexed and thereby locatable by an Internet search engine. Because the petitioner's affidavit only indicated that the Wayback Machine is searchable by URL, without explaining how a query of a search engine using a combination of words would have produced the web address containing the asserted reference, the petitioner failed to establish that the asserted reference would have been located by an interested party exercising reasonable diligence. Ultimately, the board held that the petitioner's showing that the asserted installation guide was "technically accessible" on the Internet was insufficient to establish public accessibility.

**Practice Tip:** While relying on archived webpages is a common practice for establishing the prior art status of a reference, parties should take care not to conflate mere accessibility with the legal requirements for showing "public accessibility." Even where a party can demonstrate that an asserted reference was available on the internet prior to the critical date of a patent, the party must also demonstrate that the reference was either actually disseminated or locatable with reasonable diligence by an interested party to qualify as prior art.

*First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 (PTAB Nov. 16, 2023).

## Categories

Patent Trial & Appeal Board

Patent Litigation

Prior Art

© 2024 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.