



# THINK FORWARD

## Is It Accessible? Internet Publications As CBM Prior Art

By Joshua James, David Lindner

December 08, 2015

On December 7, 2015, the Federal Circuit heard arguments in *Blue Calypso, LLC v. Groupon, Inc.* (Appeal Nos. 15-1391, -1393, and -1394) as to whether a document posted on a university's engineering department website qualifies as prior art under the printed publication provision of 35 U.S.C. § 102(b). The case law instructs that this determination "involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public," and that a reference is publicly accessible "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it . . . ."

### PTAB Ruling

On December 17, 2014, the Patent Trial and Appeal Board ("PTAB") entered a final written decision in two covered business method ("CBM") patent reviews (CBM2013-00033 and CBM2013-00034) between Petitioner Groupon, Inc. ("Groupon") and Patent Owner Blue Calypso, LLC ("Blue Calypso"). The CBM reviews challenged U.S. Patent No. 8,155,679, which relates to a system and method for peer-to-peer advertising between mobile communications devices.

In its final written decision, the PTAB found that one of the prior art references (the "Ratsimor paper") was not a printed publication under 35 U.S.C. § 102(b). The Ratsimor paper is a technical report from a university's engineering department that Groupon alleged was published more than one year prior to the '679 patent's earliest priority date, relying upon an author's publications list including the Ratsimor paper as well as testimony from a co-author regarding when the reference was available for download. The Board found that Groupon's evidence was insufficient, comparing the paper to an uncatalogued doctoral thesis or a paper placed on an open FTP server and finding that Groupon did not establish "how persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could locate the Ratsimor paper on the Departmental website or otherwise locate [it] in November 2003."

### Groupon's Federal Circuit Brief Arguments

Groupon argued that the Ratsimor paper was publicly available for viewing and downloading on the Internet from a university website. The supporting evidence for this argument included testimony regarding when the reference was available for download, the publication website of one of the paper's authors providing a link to the Ratsimor paper, metadata for the PDF of the Ratsimor paper showing that the file was created in June 2003, and metadata associated with the webserver currently hosting the Ratsimor paper showing that the file was present on the server prior to the '679 patent's filing date.

Groupon distinguished its situation from a paper placed on an open FTP server by pointing out that a search engine could easily find the Ratsimor paper. Additionally, Groupon argued that a previous

Ratsimor article would provide a roadmap to persons of ordinary skill in the art to find the Ratsimor paper. The previous Ratsimor article discussed the same topic, and interested parties would know to search Ratsimor's publications (available on the university's website) for other papers on the topic (which would include the Ratsimor paper). Lastly, Groupon argued that the PTAB's requirements for Internet evidence would violate public policy:

The Board's standard would impose a requirement on Petitioners seeking to institute review of patents to, without subpoena power, proffer a declaration from a search engine to attest to fact that a document published on the Internet in 2003 and made available without restriction to the entire world, was actually crawled, indexed, and searchable by that search engines' algorithm as of a date perhaps a decade prior to the petition.

### **Blue Calypso's Federal Circuit Brief Arguments**

Blue Calypso argued that the Ratsimor paper was made available for download through a space on a webserver controlled by a student, and not through a publicized location like the university's main website (where other papers were listed). Blue Calypso also argued that Groupon's supporting testimony did not identify any member of the public that received the Ratsimor paper, how any member of the public could locate it and download it, how it was ever "issued," how it was indexed in an online search engine, or even if it was indexed at all. Blue Calypso argued that numerous spelling and grammatical errors in the Ratsimor paper and the fact that another author of the paper did not list it as a publication suggest that the Ratsimor paper was not published.

Blue Calypso argued that the Ratsimor paper being made available for download through a space on a webserver controlled by a student was just like a paper located on an unindexed FTP server – a person of ordinary skill in the art would need to know the URL of the website to find the paper. Blue Calypso also argued that there is no evidence showing that the Ratsimor paper was not only available on the dark web. Lastly, Blue Calypso criticized Groupon's lack of evidence showing that the Ratsimor paper was part of the visible web, linked, and locatable to interested researchers, as could be shown via the Internet Archive's Wayback Machine.

### **Oral Argument**

Oral argument took place on December 7, 2015, in front of Judges Reyna, Schall, and Chen. The Panel focused their questions on evidence of public accessibility. The Panel asked several questions about evidence that the webpage containing the Ratsimor paper was indexed or findable by persons of ordinary skill in the art more than one year prior to the '679 patent's earliest priority date. These questions suggested that there may be at least three ways to show public accessibility for documents on the Internet: (1) direct evidence that others accessed the prior art at the relevant timeframe, (2) evidence that the prior art was indexed at the relevant timeframe, and (3) evidence (potentially from an expert) of how persons of ordinary skill in the art would have known how to access the prior art at the relevant timeframe, such as the links they could have clicked to navigate to the webpage hosting the reference. The case should be monitored to see whether and how the Federal Circuit addresses the questions raised during the oral argument.

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