

Reproduced with permission from BNA's Patent, Trademark & Copyright Journal, 85 PTCJ 365, 01/11/2013. Copyright © 2013 by The Bureau of National Affairs, Inc. (800-372-1033) <http://www.bna.com>

### PATENTS

In the wake of a recent Federal Circuit case, the author offers a test for determining whether electronically posted documents qualify as invalidating prior art under Section 102(b) of the Patent Act.

## Electronically Posted Documents as Prior Art



BY KENNETH E. HORTON

The U.S. Court of Appeals for the Federal Circuit recently provided additional insight on establishing when a document posted online qualifies as a printed publication and, therefore, as prior art that can be cited against a patent or patent application under 35 U.S.C. § 102(b). *Voter Verified Inc. v. Premier Election Solutions Inc.*, 698 F.3d 1374, 104 U.S.P.Q.2d 1553 (Fed. Cir. 2012) (85 PTCJ 37, 11/9/12). In this decision, the

*Kenneth Horton is a shareholder with Kirton McConkie, Salt Lake City, and a former patent examiner with the Patent and Trademark Office. His practice includes domestic and foreign patent and trademark prosecution and intellectual property litigation. He may be reached at [khorton@kmclaw.com](mailto:khorton@kmclaw.com) or (801) 321-4897. Horton also is an associate professor of IP strategy in the M.B.A. Technology Management Program at the Gore School of Business at Westminster College Salt Lake City.*

Federal Circuit held that when considering whether an online document qualifies as a printed publication, a key inquiry is whether the reference was made sufficiently accessible to the public interested in that technology, but that indexing of the website is not required.

### District Court Decision.

In *Voter Verified*, the asserted patent claimed automated systems and methods for voting in an election, including a procedure where both machine error and human error were detected before the ballot was submitted by the voter. The question raised was whether a potentially invalidating “Benson” article was available online before the critical date and, therefore, qualified as a printed publication. The patentee argued that the Benson article was not a printed publication for two reasons: first, that a web-based document must be searchable on the internet by relevant search terms; and second, there was no indexing on any database that would have allowed the interested public to locate the website containing the Benson article.

On summary judgment, the district court ruled that Claim 49 of the asserted patent was invalid under 35 U.S.C. § 103 based on the following facts.

1. The Benson article was posted to a website journal, *Risks Digest* on March 4, 1986. At that time, *Risks Digest* was distributed online via a subscription mailing list and was made available for download through a file transfer protocol site.

2. Starting in January 1995, all of the content published by *Risks Digest* (including the Benson article) became available worldwide on the internet through the website associated with the URL <http://catless.ncl.ac.uk/Risks>.

3. *Risks Digest* was well known to the community interested in this technology. By 1999, it contained more than 100 articles relating to electronic voting. All sub-

missions for publication in *Risks Digest* were treated as public disclosures and users could freely and easily copy the content.

4. Since September 1995, the *Risks Digest* website included a search tool that could have retrieved the Benson article in response to relevant search terms.

### Federal Circuit Decision.

On appeal, the patentee argued that (1) the Benson article must be searchable by relevant search terms over the internet to qualify as a printed publication, and (2) no evidence was provided of any indexing on any database that would have allowed the interested public to locate the *Risks Digest* website, much less the Benson article contained therein. The patentee emphasized that indexing was a determinant of public accessibility.

The Federal Circuit disagreed with the patentee, holding that when considering whether an online document qualifies as printed publication, a key inquiry is whether the reference was made sufficiently accessible to the public interested in that technology before the critical date. In response to the argument that indexing is necessary for public accessibility, the Federal Circuit noted that it is merely a relevant factor to be considered. The Federal Circuit instead found that the ultimate question is whether the online document was available to the extent that persons interested in the subject matter could have located it by exercising reasonable diligence.

The Federal Circuit ruled that whether a reference is publicly accessible is determined on a case-by-case basis in light of the facts and circumstances surrounding its disclosure to the public. In finding that the Benson article constituted publicly available prior art, the Federal Circuit relied on the facts highlighted by the district court and concluded that the website:

- was well known to the community interested in the relevant technology;
- treated all submissions as public disclosures;
- allowed users to freely copy content; and
- contained a search tool that would have retrieved the Benson article in response to relevant search terms.

The Federal Circuit commented that even though the website containing the Benson article was not indexed (through search engines or otherwise):

- a person of ordinary skill interested in electronic voting would have been aware of it as a forum for discussing electronic voting technologies; and
- the website's own search functions and an interested researcher's diligence were enough to ensure that the article would have been found.

### Other Relevant Precedent.

*Voter Verified* builds on two earlier decisions by the Federal Circuit. In *SRI International Inc. v. Internet Security Systems Inc.*, 511 F.3d 1186, 1194, 85 U.S.P.Q.2d 1489 (Fed. Cir. 2008) (75 PTCJ 273, 1/18/08), the Federal Circuit ruled that a document posted on a public FTP site did not qualify as a printed publication. The Federal Circuit held that while there are many ways in which a document may be deemed to be publicly accessible to the interested community, a document is certainly accessible when it has been disseminated or oth-

erwise made available so that persons interested and ordinarily skilled in the subject matter can locate it using reasonable diligence. The Federal Circuit found that although the inventor provided the location of the FTP site to others skilled in the art, because the document was not indexed or cataloged it would have been difficult for the public to find and therefore could not be categorized as a printed publication.

A year later, the Federal Circuit held that a manuscript filed with the Copyright Office could qualify as a printed publication. *In re Lister*, 583 F. 3d 1307, 92 U.S.P.Q.2d 1225 (Fed. Cir. 2009) (78 PTCJ 670, 10/2/09). In this dispute, the patentee argued that the manuscript in question was not a printed publication since it was not included in a catalog or index that would have permitted an interested researcher to discover it.

The Federal Circuit, however, noted that the manuscript was included in three relevant databases: the Copyright Office's automated catalog, and two commercial databases, Westlaw and Dialog. Since the Copyright Office's automated catalog was not sorted by subject matter and could only be searched by the author's last name or the title's first word, the Federal Circuit found that it could not support a finding of public accessibility.

In the Westlaw and Dialog databases, however, a user could also perform keyword searches on the full title (but not the full text of the work). The Federal Circuit reasoned that since the title of the manuscript included relevant terms for a researcher to discover the manuscript, it found that the manuscript was publicly accessible as of the date that it was included in either the Westlaw or Dialog databases.

### Three-Part Test for Determining Whether an Online Document Qualifies as Printed Publication.

Synthesizing these decisions leads to three requirements that should be considered to help determine whether an electronically posted document can qualify as a printed publication. The Federal Circuit has only hinted about the third requirement, but it must be considered by the practitioner since our world is becoming increasingly digital.

#### (1) Public Awareness.

The first requirement is whether the relevant public is aware of the website (or other location) where the document is posted. There are several methods to meet this requirement. The definitive method is to actively disseminate knowledge of the website to the relevant public, as was done for the Benson article in *Voter Verified*.

The less definitive method is to publish enough information about the website so that the skilled artisan could have become aware of the website. The Federal Circuit hinted as this option in *Voter Verified*, even though it did not rely on it, when it commented that a person of ordinary skill interested in electronic voting would have been independently aware of the *Risks Digest* website—separate from the being on the subscription list—as a prominent forum for discussing such technologies. This latter option can be risky since if you can't readily find the electronically posted document by doing a reasonable search (with appropriate search terms) via the Internet, then can you prove that the document is publicly accessible?

### (2) Found With Reasonable Diligence.

The second requirement is that having found the website, could the skilled artisan have found the document with reasonable diligence?

Again, there are several methods to meet this requirement. The more definite method involves using the search functionality of the website. This was the exact reason stated by the Federal Circuit in *Voter Verified*.

But this requirement could also potentially be met in circumstances where the search tools, while not hosted on the website, are “specific” to the website since they are designed to pull information from that website. This was the reasoning in *Lister* since Westlaw and Lexis (which are specifically designed to search legal databases) were able to show that the document was present on the Copyright Office website.

There are two unknown factors in this requirement. First, how do you meet the reasonable diligence standard? Would this standard be met where the posted document showed up on page 99 (of 100) of a relevant search? In other words, it is difficult to determine that point at which the search results became sufficiently manageable and not completely overwhelming.

And second, how do you prove the nature of the search results (which should be performed at the time of the invention or even filing) in a litigation or reexamination years later given that websites are so dynamic in nature? In other words, you have to be able to assess the search capabilities as of the time the document was allegedly posted, not those capabilities at the time the case was decided years later. This factor was considered in *Voter Verified*, but little guidance was given since the Federal Circuit noted that although commercial internet search engines were available in 1999, little evidence was submitted indicating whether or not the *Risks Digest* website could have been searched by any such services as of the critical date.

### (3) Lengthy Posting.

The third requirement is to consider whether the document been posted for a sufficiently long period of time. In other words, is the posting only transitory in nature? In *SRI International*, the document remained on the FTP site for several days. But what length of time is too short for the document to qualify as a printed publication? From an evidentiary point of view, documenting how long a particular electronic document was posted online can be very challenging.

### Ramifications.

In light of the issues raised in *Voter Verified*, there are several considerations for our various practices.

First, the printed publication bar is alive and well—it remains part of the America Invents Act when the first-

to-file regime is implemented on March 16, 2103. So the question of when an electronically posted document qualifies as prior art must be continue to be addressed. Indeed, as our world becomes exponentially more digital, this question will likely be raised in every application we handle in the future.

Second, databases of publications are increasingly moving onto the internet. Thus, as practitioners we need to expand our horizons when attacking a patent to include documents that we would typically not otherwise search for or even consider. Indeed, we should implement systems that allow us to periodically identify such prior art given that some of the evidence we need to submit as proof can be difficult to find retroactively.

Third, as more and more online documents qualify as printed publications, online postings are a source we should monitor to identify prior art that can be used in third-party prior art submissions against our competitors.

Fourth, all of this “additional” online prior art can be used against our own applications and patents. So we need to encourage our inventors and engineers to be more aware of online postings, including the websites where they are often located. They need to search these websites when submitting their invention disclosures and submit their search strategies in the invention disclosures.

Fifth, although likely feasible for a few, some organizations should consider creating their own prior art database of printed publications.

As a patent examiner in the early 1990s in the semiconductor art, my colleagues and I sometimes searched and cited International Business Machine Corp.’s Technical Disclosure Bulletins. IBM periodically published these bulletins (in hard copy, no less) and they were a great source of prior art for us examiners. They were not widely used or cited because while they contained a table of contents, they contained no index. IBM kept that information close to the vest since they did not publish the index, only the bulletins themselves. IBM abandoned this effort in 1998.

If IBM were to move this database online, it would most likely pass the three-prong test outlined above and be an extremely useful source of prior art. Any interested organization could likewise utilize a similar scheme to create an online prior art database, especially if they automated the process of collecting, organization, and disseminating the online documents, while keeping the index confidential.

Finally, keep watch on future decisions that clarify when online postings qualify as a printed publication. This topic is an emerging field because we have only just started to see online postings being cited as prior art.