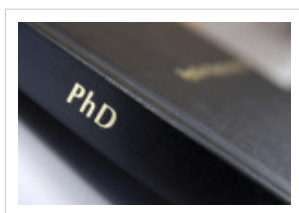




## APJs Dispute Requirements for a Reference to Qualify as a Printed Publication

By Michael R. Weiner on October 15, 2015

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Final written decisions, IPR2014-00781, IPR2014-01086, IPR2014-00821, IPR2004-00580, IPR2014-00802, for IPRs of several patents owned by Zond, LLC, which include rare dissenting opinions, illustrate different views of APJs concerning the requirements for establishing that a reference is a printed publication under 35 U.S.C. § 102(b). These decisions provide helpful guidance on

how to address references whose status as a printed publication may be in dispute.

Zond, LLC patents have been frequently targeted in IPR petitions, with 125 petitions filed, including challenges to patents directed to “sputtering” methods and apparatus used to deposit films on semiconductor substrates. The alleged prior art references relied on in many of these petitions include a Russian-language Ph.D. thesis allegedly published in 1994, several years before the critical date for the challenged patents. In five final written decisions, addressing 16 of the IPRs assigned to the same five-APJ panel, APJ Debra K. Stephens wrote a dissenting opinion, which disagreed with the panel’s conclusion that the petitioners had properly established that the Russian thesis was prior art under § 102(b), specifically questioning whether the petitioners had established the thesis was publicly accessible before the critical date.

The disputed Russian thesis was a doctoral thesis from the Moscow Engineering Physics Institute. To establish that the thesis was a printed publication, the petitioners proffered a copy of a catalog entry for the thesis from the Russian State Library, bearing a statement reading “Imprint Moscow 1994,” as well as a certified translation of the document. The majority concluded that the petitioners established that the document was published (i.e., was publicly accessible) prior to the critical date, although a specific publication date was not established. The majority further noted that the patent owner failed to object to the admissibility of the thesis, or challenge the authenticity of the thesis or catalog entry. Accordingly, the majority concluded that the thesis was prior art under § 102(b).

In the dissent’s view, the evidence was insufficient to establish that the thesis was prior art, because the

of the critical date, as required by authority including *In re Hall*, 781 F.2d 897, 989-99 (Fed. Cir. 1986). According to the dissent, the designated imprint date alone, without evidence of when the thesis was received by the library, when a publicly-accessible catalog was made available, or concerning general practices of the library, did not establish that the thesis was prior art under § 102(b). Further, in the dissent's view the patent owner had no obligation to object to the admissibility of the thesis, because the issue was the sufficiency or weight of the evidence, not its admissibility.

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“ a patent owner disputing whether alleged prior art satisfies the requirements of § 102(b) should argue about the sufficiency of the evidence, object to its admissibility, and move to exclude the alleged prior art

These cases illustrate the specific types of evidence that may be required to establish that a disputed printed publication is prior art, and suggest that a patent owner disputing whether alleged prior art satisfies the requirements of § 102(b) should argue about the sufficiency of the evidence, object to its admissibility, and move to exclude the alleged prior art. Until the PTAB issues a precedential opinion concerning these issues, the approach of a particular panel of APJs may be difficult to predict.

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