

UNITED STATES
PATENT AND TRADEMARK OFFICE





Best Practices For Proving A Document Is A Printed Publication

Presenters: Judges Lora Green & Brian McNamara

December 7, 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE



Overview

- Burdens
- Underlying Legal Principles
- Frequent Printed Publication Issues
- Summary of Best Practices

12/7/2017

uspto

3

Burdens in Post Grant Proceeding

- Petitioner bears the burden of demonstrating that the reference is a printed publication
- At institution, Petitioner must demonstrate a reasonable likelihood (IPR) or that it is more likely than not (CBM, PGR) that the reference qualifies as a printed publication
- The burden of production shifts to Patent Owner to present evidence demonstrating that the reference is not a printed publication. *Cf., Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015)



12/7/2017

4

Burdens in Post Grant Proceedings

- **The burden of persuasion always remains with Petitioner.** *In re Magnum Oil Tools Int'l, Ltd*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (“In an *inter partes* review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.”).
- Thus, at final written decision, **it is Petitioner’s burden to demonstrate that the reference is a printed publication by a preponderance of the evidence.** 35 U.S.C. § 316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”)



12/7/2017

5

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.