

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



Overview

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

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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)



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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.”)



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5

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