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Paper 27
Date: July 27, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUARDIAN ALLIANCE TECHNOLOGIES, INC.,
Petitioner,

v.

TYLER MILLER,
Patent Owner.

IPR2020-00031
Patent 10,043,188 B2

Before SALLY C. MEDLEY, DAVID C. MCKONE,
and JOHN R. KENNY, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing of Decision on Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Guardian Alliance Technologies, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1, 5, 9, and 15 of U.S. Patent No. 10,043,188 B2 (Ex. 1001, "the '188 patent"). Pet. 1. Tyler Miller ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp."). The Petition raised two grounds, the first based in part on the Background Solutions[1] video and the second based in part on the POBITS[2] reference (Ex. 1004). Pet. 4. Upon consideration of the Petition and the Preliminary Response, as to the first ground, we determined that Petitioner had not shown sufficiently that Background Solutions was publicly accessible, and, thus, prior art to the '188 patent. Paper 23 ("Dec."), 9–17. As to the second ground, we determined that Petitioner had not shown sufficiently that POBITS was publicly accessible, and, thus, prior art to the '188 patent. Dec. 17–20.

Petitioner asks us to reconsider our determinations that Background Solutions and POBITS were not publicly accessible and, thus, were not prior art to the '188 patent. Paper 24 ("Req."). For the reasons given below, we decline to modify our Decision.

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[1] Petitioner submitted Exhibit 1002 as the Background Solutions video and subsequently moved to correct it through submission of a substitute video (Exhibit 1027), a motion that Patent Owner opposed. Papers 11 (Motion to Correct), 16 (Opposition). Concurrently, Patent Owner moved to terminate based on the incorrectly submitted Exhibit 1002. Papers 10 (Motion to Terminate), 12 (Opposition). We granted Petitioner's Motion to Correct for the limited purpose of determining that Petitioner had not shown sufficiently that Exhibit 1027 was a printed publication and dismissed the Motion to Terminate as moot. Paper 23, 20.

[2] Peace Officer Background Investigation Tracking System ("POBITS").

Petitioner requested review by the Precedential Opinion Panel ("POP"). Req. 1; Ex. 3001. POP review was denied on June 16, 2020. Paper 26.

II. ANALYSIS

A. Legal Background

When rehearing a decision on institution, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (2019). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The burden of showing that the Institution Decision should be modified is on Petitioner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d) (2019). In addition, "[t]he request must specifically identify all matters the party believes [we] misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." *Id.*

Whether a reference qualifies as a "printed publication" is a legal conclusion based on underlying factual findings. *See Nobel Biocare Servs. AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1375 (Fed. Cir. 2018) (citing *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356 (Fed. Cir. 2018)). The underlying factual findings include whether the reference was publicly accessible. *See id.* (citing *In re NTP, Inc.*, 654 F.3d 1279, 1296 (Fed. Cir. 2011)).

"The determination of whether a reference is a 'printed publication' under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public." *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). "Because there are many ways in which a reference may be disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication' bar under 35 U.S.C. § 102(b)." *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). "A given 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." *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc*., 445 F.3d 1374, 1378 (Fed. Cir. 2006)).

What constitutes a "printed publication" must be determined in light of the technology employed. *See* S*amsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019) (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). Public accessibility requires more than technical accessibility. *See id.* (citing *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)). "[A] work is not publicly accessible if the only people who know how to find it are the ones who created it." *Id.* at 1372. On the other hand, "a petitioner need not establish that specific persons actually accessed or received a work to show that the work was publicly accessible." *Id.* at 1374. "In fact, a limited distribution can make a work publicly accessible under certain circumstances."

Id. (quoting *GoPro, Inc. v. Contour IP Holding LLC*, 908 F.3d 690, 694 (Fed. Cir. 2018)).

"To prevail in a final written decision in an *inter partes* review, the petitioner bears the burden of establishing by a preponderance of the evidence that a particular document is a printed publication." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 11 (PTAB Dec. 20, 2019) (precedential). "[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication." *Id.* at 13.

B. Printed Publication Status of Background Solutions and POBITS

For Background Solutions, Petitioner relied primarily on the third-party testimony of Tom Ward, the founder and co-owner of Background Solutions, LLC, to argue that Mr. Ward presented the Background Solutions video at national background investigation seminars and made the video available on a website, all prior to the critical date of the '188 patent. Pet. 18–24; Ex. 1009 (Ward Declaration). We found that Mr. Ward provided "vague and conclusory" testimony that lacked basic details such as "how many such seminars he presented at, when or where those seminars were, who attended the seminars, or who watched the 2009 Video at the seminars." Dec. 11–13. As to availability of Background Solutions on a website, we found that Petitioner's evidence, including Mr. Ward's testimony, did not show when Background Solutions was posted to the website, did not explain whether and how the website was indexed, and did

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