Webpages Must Meet Accessibility Standard To Be Prior Art

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An anticipation or obviousness challenge that relies on a prior art document requires a threshold showing that the reference qualifies as a "printed publication." Patent challengers, including petitioners at the Patent Trial and Appeal Board, might reasonably assume that if a reference was uploaded to a website before the critical date, the printed publication standard is met. It is not.

Proving that a reference was available on the internet, as certified by the Internet Archive digital library, is only half the battle. The law requires more. The touchstone for establishing a reference as a printed publication is "public accessibility."

For any reference, public accessibility requires a showing that persons interested and ordinarily skilled in the art, exercising reasonable diligence, can locate it. Public accessibility can thus be established, for example, by showing that a reference was sufficiently disseminated.

For references available on the internet, a Nov. 16 decision from the board, First Solar Inc. v. Rovshan Sade, serves as a reminder of the unforgiving requirements that must be satisfied to establish that a reference is a printed publication.[1]

In First Solar, the board denied institution of a petition for inter partes review after determining that the petitioner failed to show a reasonable likelihood that its primary asserted reference — which the Internet Archive showed was unquestionably available on the internet before the critical date — qualified as a prior art printed publication that was publicly accessible.

In particular, the board found that the petitioner failed to present sufficient argument or evidence that an interested party exercising reasonable diligence would have located the archived reference.

The challenged patent relates to solar panels with a tracker for detecting sun movement. The petitioner challenged two claims as anticipated and obvious based on an installation guide for a solar tracker.

In addressing the prior art status of the asserted installation guide, the petitioner stated that the reference was publicly accessible because it was available on a webpage prior to the critical date.

In support, the petitioner submitted an affidavit from a record processor at the Internet Archive who explained that the Wayback Machine digital archive allows users to browse more than 450 billion archived webpages by searching their URLs. The affidavit attached screenshots of the webpage that contained the asserted installation guide.

In response, the patent owner argued that the petitioner failed to meet its burden in establishing that the reference was prior art. According to the patent owner, the petitioner did not show that the website containing the reference was indexed in a manner that would allow a person of ordinary skill in the art to locate it.

Thus, in the patent owner's view, the petitioner failed to demonstrate that the reference was publicly accessible such that it could have been located with reasonable diligence by those interested or ordinarily skilled in the subject matter.

The board agreed with the patent owner and found that the petitioner failed to present sufficient evidence or argument to demonstrate that the asserted reference was publicly accessible. In doing so, the board first distinguished the petitioner's reference from the type of online publication that would have been well known to the community interested in the subject matter.

Here, the petitioner provided no evidence that a person interested in solar panel assemblies would have been independently aware of the web address or the company name for the asserted installation guide. The board also stated that there was an absence of evidence demonstrating that the website in question was indexed and thereby locatable by an internet search engine.

According to the board, the petitioner's affidavit only indicated that the Wayback Machine is searchable by URL, without explaining how a query of a search engine using a combination of words would have produced the web address containing the asserted reference.

As such, the board found that the petitioner had failed to establish that the asserted reference would have been located by an interested party exercising reasonable diligence. Ultimately, the board held that the petitioner's showing that the asserted installation guide was "technically accessible" on the internet was insufficient to establish public accessibility.[2]

The outcome in First Solar is consistent with recent precedent from the U.S. Court of Appeals for the Federal Circuit, which further clarifies that not every type of indexing on a website will make a reference publicly accessible. Rather, what is required is for the reference to be meaningfully indexed.

For example, in the Federal Circuit's 2018 Acceleration Bay v. Activation Blizzard decision, a reference asserted by the patent challenger had indisputably been uploaded to a university's technical reports library website before the critical date.[3]

Although reports were indexed by author and year, the reference was not publicly accessible because, in order to find it, an interested person would have had to skim through potentially hundreds of titles by year, or view all titles by author, where the authors were not well known.

Evidence also showed that a purported search form on the website was unreliable, such that a search for keywords in the title and abstract of the asserted reference failed to produce any results.

The Federal Circuit similarly held in the 2019 Samsung Electronics Co. v. Infobridge Pte. Ltd. decision that a reference uploaded to a website was not publicly accessible because someone trying to navigate the website would have had to first select a particular folder from among a list of available meeting locations, and then scroll through hundreds of

documents organized by identifying number, rather than subject matter, to find the right reference.[4]

Here again, the Federal Circuit found that the reference had not been meaningfully indexed such that an interested artisan exercising reasonable diligence would have located it.

These cases provide several lessons to practitioners. For references that are published or otherwise available on the internet, patent challengers frequently turn to the Wayback Machine as a tool to access archived webpages.

In essence, the Wayback Machine allows users to view webpages as they existed at given points in time where archival "snapshots" have been recorded. This functionality is critical when trying to demonstrate the date on which a particular reference became available on the internet.

But patent challengers should avoid conflating mere accessibility with the legal requirements for showing public accessibility. Even where a challenger can demonstrate that an asserted reference was available on the internet prior to the critical date of a patent, the challenger must also demonstrate that the reference was locatable with reasonable diligence by an interested party.

To meet this requirement, a patent challenger should submit, for example, any available evidence of indexing along with an explanation of how that indexing was meaningful such that a skilled artisan could have freely navigated the website to locate the reference.

A patent challenger should also describe in detail any search functionality that would have allowed an interested person to find the relevant reference through keyword searches, which is a factor the Federal Circuit has found weighs heavily in favor of public accessibility.[5]

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[1] First Solar Inc. v. Rovshan Sade, IPR2023-00827, Paper 13 (PTAB Nov. 16, 2023).

[2] Id. at 18 ("Thus, while Petitioner has attempted to make a showing that [the reference] was technically accessible, 'public accessibility requires more than technical accessibility.'").

[3] Acceleration Bay LLC v. Activision Blizzard Inc., 908 F.3d 765 (Fed. Cir. 2018).

[4] Samsung Elecs. Co. v. Infobridge Pte. Ltd., 929 F.3d 1363 (Fed. Cir. 2019).

[5] In re Lister, 583 F.3d 1307 (Fed. Cir. 2009).