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Federal Circuit Clarifies Standard for Public Accessibility of Printed Publications; Offers Claim Drafting Tips

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Activision Blizzard, Inc.; Electronic Arts Inc.; Take-Two Interactive Software, Inc.; 2k Sports, Inc.; and Rockstar Games, Inc. (collectively, "Blizzard") filed six IPR petitions against patents owned by Acceleration Bay, LLC ("Acceleration"). The patents-at-issue are directed to a broadcast technique in which a broadcast channel overlays a point-to-point communications network. The Board instituted IPR on each petition and rendered six final written decisions. In three of those decisions, the Board determined that a number of asserted claims were unpatentable. In the other three, the Board concluded that the Lin reference was not a printed publication under 35 U.S.C. § 102(a). Both parties appealed portions of the Board's final written decisions.

Blizzard appealed the Board's determination that Lin was not a printed publication under § 102(a) despite having been uploaded into an electronic technical reports library at the University of California, San Diego. The Board found that, despite some indexing and search functionality on the host website, Lin was not publicly accessible. The Board determined that an artisan might, at best, have located Lin "by skimming through potentially hundreds of titles in the same year, with most containing unrelated subject matter, or by viewing all titles in the database listed by author, when the authors were not particularly known." The Board also determined that the website's advanced search function failed to allow a user to search keywords for the author, title and abstract fields reliably. Based on these facts, the Board held that Blizzard had not shown that a skilled artisan would have located Lin; thus, Lin was not a printed publication.

The Federal Circuit agreed and held that the Board did not err in determining that Lin was not a printed publication. In affirming the Board, the Federal Circuit clarified that the test for public accessibility is not whether a reference has been indexed. Instead, the ultimate question is whether the reference was available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising diligence, can locate it. Here, Lin was not meaningfully indexed such that an interested artisan exercising reasonable diligence would have found it. Additionally, the Federal Circuit noted that the website's advanced search function was deficient. Thus, Lin was not sufficiently accessible to qualify as a printed publication.

For its part, Acceleration appealed the Board's decision as to whether "game environment" and "information delivery service" were claim limitations despite appearing in the preambles of the claims. Acceleration argued that these terms were limiting because they provide structure for the remainder of the claims. The Board and the Federal Circuit disagreed, finding that the claim terms were non-limiting because they merely described intended uses for a structurally complete invention. Acceleration raised an alternative argument that the terms were part of the body of the claim because the claims lacked a transition phrase denoting a preamble. On this point, the Federal Circuit explained, "Acceleration's poor claim drafting will not be an excuse for it to infuse confusion into its claim scope" "by failing to include a transition word in the claim to clearly delineate the claim's preamble from the body." The Federal Circuit cautioned patentees against omitting a transition word between the preamble and the body of the claim.

Practice Tip #1 – Although a reference may be placed on a website and indexed in some manner, the reference may not be publicly accessible such that it can qualify as prior art under 35 U.S.C. § 102(a). For a patent owner, it may be worth challenging the public accessibility of a reference in light of difficulties that an interested artisan may have in locating the reference. On the other hand, for a patent challenger, it is important to establish that a reference is publicly accessible. This requires a patent challenger to show that a reference has been meaningfully indexed such that an interested artisan, using reasonable diligence, can locate the reference.

Practice Tip #2 – When drafting claims, it is prudent to include a transition phrase between the preamble and the body of the claim to avoid confusion regarding claim scope. However, the lack of a transition phrase will not preclude a finding that the words in a preamble are non-limiting.

Acceleration Bay, LLC, v. Activision Blizzard Inc., Electronic Arts Inc., Take-Two Interactive Software, Inc., 2K Sports, Inc., Rockstar Games, Inc., Bungie, Inc., 2017-2084, 2017-2085, 2017-2095, 2017-2096, 2017-2097, 2017-2098, 2017-2099, 2017-2117, 2017-2118 (Fed. Cir. Nov. 6, 2018).

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