



USPTO Precedential Opinion Panel (POP) Addresses What Evidence Is Required to Establish That a Reference Qualifies as a “Printed Publication” at the Institution Stage

Jan 2, 2020

Reading Time : **3 min**

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Petitioner Hulu challenged claims as obvious over a textbook, Dougherty. Hulu relied on a fourth printing of the book, which identified a 1990 copyright date and an “8/94” ISBN date. The book also listed four printing dates—November 1990, March 1991, July 1992 and November 1992—with “Minor Corrections” appearing next to the three latter dates. Although not relied on before the POP, Hulu also submitted with its petition a date-stamped excerpt of the second printing of Dougherty from the Cornell University Library and a librarian affidavit averring that this printing was publicly available by September 1992. In its preliminary response, Patent Owner Sound View Innovations (“Sound View”) challenged Petitioner’s showing that Dougherty was publicly available before the critical date in 1995. The Board agreed and denied institution. Hulu requested rehearing and POP review, which the POP granted, setting a briefing schedule and inviting briefing from *amicus curiae*.

On rehearing, the parties agreed that “reasonable likelihood” was the appropriate standard at institution and could be met by presenting a *prima facie* case. The parties, however, disagreed on the timing of the evidence. Hulu argued that the full evidentiary record is developed during the trial phase, and that evidence of “conventional markers” of publication is sufficient for institution. Sound View argued that the petitioner is required to present its case in chief in the petition, including all evidence that will be used after institution, with limited exceptions. Several *amici* argued that 37 C.F.R. § 42.108 provides a presumption in favor of institution generally and therefore a presumption in favor of finding a reference to be a printed publication.

The POP agreed that the institution standard is “reasonable likelihood.” Under 35 U.S.C. § 312(a), the petition must identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date. The POP described the “reasonable likelihood” standard as higher than the “plausible” standard for notice pleading but lower than the “preponderance” standard for a final written decision. The POP noted that, while a petitioner cannot change theories, a petitioner has limited opportunities to present new evidence after the petition, including: (1) a reply to the patent owner preliminary response; (2) a reply to the patent owner response; and (3) a motion to file supplemental information. The POP also rejected any presumption in favor of finding public accessibility, reasoning that § 42.108 provides no such presumption and it is the petitioner’s burden to identify sufficient evidence.

The POP rejected that any particular indicia per se, such as a copyright date, is sufficient for institution. Instead, the POP explained that public accessibility is a case-by-case inquiry and that indicia are considered as part of the totality of the evidence. Here, the POP considered all the evidence, including: (1) the face of the book bears copyright, printing and ISBN dates, all before the critical date; (2) the book was from an established publisher, O’Reilly & Associates, Inc.; and (3) it is part of a well-known book series. The POP also considered evidence cited by an amicus of a trade magazine touting that “The Internet Was Built With O’Reilly Books.” Based on this evidence, the POP concluded that there was sufficient evidence to establish a reasonable likelihood that Dougherty is a printed publication that a publisher made publicly available before the critical date. Sound View disputed Hulu’s use of an affidavit addressing a different version of Dougherty. But the POP noted that Hulu was no longer relying on the affidavit and found that the affidavit was not necessary to their decision that Hulu presented sufficient evidence for purposes of institution.

Practice Tip: When drafting an IPR petition, a petitioner should include all available evidence, including declarations, to demonstrate that an asserted reference was publicly accessible before the critical date. The petitioner, however, may have limited opportunities after the petition to present further evidence of public accessibility, either in a reply before or after institution or in a motion to file supplemental information. To challenge public accessibility at institution, the patent owner must show that the totality of the evidence fails to establish a reasonable likelihood that the reference was publicly accessible before the critical date.

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