

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 Solutions¹ video and the second based in part on the POBITS² 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.

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 Samsung 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

not provide any other information on how a skilled artisan would have located the reference. *Id.* at 13–17.

As to POBITS, Petitioner relied primarily on the third party testimony of Kingsley Klosson (Ex. 1014) and an Internet Archive capture (Ex. 1004) to argue that POBITS was available on an Internet website prior to the critical date of the '188 patent. Pet. 24. We found that, even if we credited Mr. Klosson's testimony, it did not allege enough facts to conclude that POBITS was publicly accessible. Dec. 17–19.

Petitioner's Request for Rehearing is based on four alleged mistakes: (1) we overlooked or misapprehended the standard for instituting an *inter partes* review when a petitioner relies on “non-traditional, electronic publications”; (2) we overlooked or misapprehended the difficulties involved in obtaining evidence from third parties at the institution stage; (3) because we did not resolve the parties' dispute as to the level of skill in the art, we misapprehended the significance of the third party witness testimony; and (4) we misapplied or misapprehended the level of proof necessary, at the institution stage, to show the public accessibility of a document on a public website. Req. 1–2.

1. Non-Traditional Electronic Publications and the Difficulties of Obtaining Third-Party Evidence

Petitioner's first two allegations, that we misapprehended the institution standard for non-traditional, electronic publications and the difficulties of obtaining third-party evidence pre-institution, are related. In short, Petitioner argues that we held its primary evidence of the public accessibility of Background Solutions and POBITS, third-party declarations, to an incorrectly high standard.

Petitioner contends that we did not recognize the “inherent difficulties” petitioners face in establishing the printed publication status of “non-traditional, electronic publications.” Req. 3–4. Petitioner argues that *Hulu* addressed the “relative simplicity” of establishing a book housed in a library as publicly accessible but did not address the “added difficulties involved with non-traditional, electronic publications.” *Id.* at 4–5 (citing *Hulu*, at 2–4). According to Petitioner, parties in its position face disadvantages such as the absence of hard copies on library shelves, lack of librarians ready to testify, and difficulties of obtaining the voluntary cooperation of third-party witnesses. *Id.* at 5–6. Petitioner argues that we abused our discretion by effectively holding Petitioner to a preponderance of the evidence standard at the institution stage. *Id.* at 6–7. Petitioner contends that its third-party witness testimony is “strong indicia” of public accessibility that meets the “totality of the evidence” standard set forth in *Hulu*. *Id.* at 7.

We are not persuaded. Although we are sympathetic to the difficulties a party might encounter in obtaining the cooperation of third parties while drafting a petition, the Statute and our Rules require a petitioner to set forth its case with particularity in the petition and to support that case with evidence. *See* 35 U.S.C. § 312(a)(3) (“A petition filed under section 311 may be considered only if— . . . (3) the petition identifies, in writing and *with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and *the evidence that supports the grounds for the challenge to each claim*, including— . . . (B) affidavits or declarations of supporting evidence” (emphasis added)); 37 C.F.R. § 42.104 (b). *Hulu* does not distinguish between “traditional” publications, such as books in a library, and “non-traditional” publications. In the case of

videos and websites, as well as books in a library, “at 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.” *Hulu*, at 13. According to the *Hulu* panel, this “is a higher standard than mere notice pleading, but . . . it is lower than the ‘preponderance’ standard to prevail in a final written decision.” *Id.* This is the standard to which we held Petitioner’s evidence. Dec. 12–20.

It is the “particularity” required by *Hulu* that the Petition lacks. As we explained in the Decision, neither Petitioner nor Mr. Ward provided enough specificity to determine when Background Solutions was presented at seminars, when those seminars occurred, or who attended the seminars. Dec. 17. Thus, there is no persuasive evidence presented now from which we might later conclude that Background Solutions was publicly accessible by virtue of its display at seminars. Similarly, neither third-party witness provides any particularity as to how a skilled artisan would have located Background Solutions or POBITS on public websites. *Id.* at 17–19.

Petitioner contends that we “fail[ed] to recognize the serious differences” between developing a record at trial and making a showing in a Petition prior to institution. Req. 8. Petitioner argues that we should consider not only the evidence presented in the Petition but also evidence that may come out at trial. *Id.* at 8–9. Petitioner notes that the Board regularly grants motions to submit supplemental information under 37 C.F.R. § 42.123. *Id.* at 9. Indeed, *Hulu* recognizes that a petitioner may submit rebuttal evidence in a reply and move to submit supplemental information under Rule 42.123. *Hulu*, at 7–8. Petitioner argues that we erred by failing to consider what evidence Petitioner likely would have developed at trial. Req. 10.

As to the third-party declarations in particular, Petitioner's argument essentially is that it obtained the evidence that it could from Mr. Ward and Mr. Klosson and believes that they would provide more specific testimony if compelled during trial. Req. 10–12. As to Mr. Ward's testimony, Petitioner argues that, although "informed" by Petitioner's counsel, this testimony was produced voluntarily and uncompelled. *Id.* at 10. According to Petitioner, "Mr. Ward did not feel compelled to find, provide, or otherwise refresh his recollection about specific information requested by Guardian's counsel." *Id.* Petitioner argues that the same is true for Mr. Klosson's testimony. *Id.* at 11 ("The same argument applies to the Board's criticisms of Mr. Klosson's Declaration. He is a third party with no duty or obligation to incur the time or expense of voluntarily cooperating with Guardian.").

Petitioner misapprehends the role of rebuttal evidence and supplemental information. As *Hulu* notes, rebuttal evidence must respond to arguments raised by Patent Owner, rather than be evidence necessary to make Petitioner's prima facie case. *Hulu*, at 7 (citing 37 C.F.R. § 42.23). The evidence Petitioner presents in the Petition does not make a prima facie case of public accessibility. For example, Mr. Ward does not testify that he presented Background Solutions to anyone in any context prior to the critical date of the '188 patent. Even if we fully credit all of Mr. Ward's testimony, it is not sufficient to make Petitioner's prima facie case. Petitioner does not cite any authority for the proposition that it can simply allege public accessibility and later support those allegations with supplemental information adduced in a trial. That is akin to the "mere notice pleading" that *Hulu* confirms is insufficient for institution of a trial. *Hulu*, at 13.

Petitioner did not, in the Petition, present persuasive evidence that would lead us to believe that additional favorable evidence likely would be

uncovered through the discovery process. In fact, the Request confirms that the Petition presents no more than bare allegations of the public accessibility of Background Solutions and POBITS along with the hope that discovery in a trial would reveal evidence sufficient to prove those allegations. Pet. 19–24. For example, Petitioner “believes that once Mr. Ward and his company, Background Solutions, are compelled to gather and produce evidence, Mr. Ward will be able to specifically testify as to ‘when or where the seminars occurred or who attended them’ and the specific date by which the 2009 Video was posted on Background Solutions’ website.” Req. 11; *see also id.* (“The same argument applies to the Board’s criticisms of Mr. Klosson’s Declaration. He is a third party with no duty or obligation to incur the time or expense of voluntarily cooperating with [Petitioner].”). Yet, the Petition presents no persuasive evidence indicating what it expects to uncover and why. Petitioner’s mere belief that Mr. Ward and Mr. Klosson will testify favorably in the future is more akin to notice pleading, rather than the “particularity” required by *Hulu*.

Thus, we did not apply an incorrect evidentiary standard at institution or misapprehend *Hulu*’s application to so-called “non-traditional” references.

2. *Level of Skill in the Art*

Petitioner argues that if we had resolved the level of skill correctly in our Decision, we would have concluded that the seminars at which Mr. Ward presented were attended by skilled artisans and, thus, that there is a reasonable likelihood that Background Solutions was publicly accessible. Req. 12–14.

In the Petition, citing to the Declarations of Mr. Ward and Mr. Klosson, Petitioner argued that a skilled artisan “would have had at least a high school degree, or equivalent thereof, and at least one to three years of experience in the relevant field, which includes background investigation methods, systems, and technologies.” Pet. 5–6 (citing Exs. 1009, 1014). Petitioner argued that “Mr. Ward’s presentation and demonstration of the Background Solutions video to a national conference of background investigators, i.e. those interested and skilled in the subject matter, qualifies it as a printed publication.” *Id.* at 20–21. Patent Owner argued that “a police officer isn’t the typical [person of ordinary skill in the art] that produces ‘web based software applications,’” and that we should “adopt[] a level of skill appropriate for the software industry.” Prelim. Resp. 7.³ In the context of Background Solutions, we declined to resolve this dispute because Mr. Ward does not testify as to who attended the unidentified “law enforcement and background investigation seminars” at which he presented Background Solutions to “seminar attendees.” Dec. 13 n.4; Ex. 1009 ¶¶ 7–9.

Petitioner argues that if we had resolved the level of skill in its favor, we would have understood the Declarations of Mr. Ward and Mr. Klosson differently (and more favorably to Petitioner). Req. 12–14. Specifically,

³ Petitioner now states that “skilled artisans for the ’188 patent include law enforcement officers (like Messrs. Ward, Klosson, and Miller).” Req. 14. It is unclear whether Petitioner is now advocating for a lower level of skill (law enforcement officers), or arguing that some law enforcement officers might have higher levels of skill (e.g., a law enforcement officer who also is a background investigator with at least one to three years of experience in background investigation methods, systems, and technologies). Pet. 5–6, 20–21; Req. 14.

Petitioner argues that “Mr. Ward’s Declaration refers to ‘law enforcement and background investigation seminars,’ not general law enforcement seminars,” and that Petitioner “understood Mr. Ward to be testifying that those attending the seminars where he presented the 2009 Video had backgrounds in law enforcement and/or background investigation.” *Id.* at 12–13. According to Petitioner, we were misled by Patent Owner’s arguments and, as a result, misunderstood that these seminars were no more than trade shows attended by police officers. *Id.* at 13 (citing Prelim. Resp. 7). Nevertheless, Petitioner argues, “[e]ven if the conferences were ‘nothing more than trade shows,’ [Petitioner] still believes that the evidence shows that police officers are skilled artisans in the context of the ’188 patent.” *Id.* Petitioner argues that if we “had at least considered [Petitioner’s] position that skilled artisans for the ’188 patent include law enforcement officers (like Messrs. Ward, Klosson, and Miller), then suddenly Mr. Ward’s testimony about presenting the 2009 Video at seminars for law enforcement (as well as background investigators) becomes all the more complete.” *Id.* at 14.

Petitioner misunderstands our determination. We did not implicitly adopt a level of skill requiring software industry experience and determine that only police officers attended the law enforcement and background investigation seminars at which Mr. Ward presented. We determined that the evidence did not support a finding that skilled artisans attended the seminars under any statement of the level of skill because Mr. Ward provided no information about who attended. Dec. 13 & n.4. Petitioner did not argue, in the Petition, that we should infer a level of skill of the attendees based on Mr. Ward’s statement that he had presented at “law enforcement and background investigation seminars.” Ex. 1009 ¶ 9. Thus, we could not

have overlooked such an argument. In any case, it would not have been persuasive, because Mr. Ward's vague statement does not imply any specific backgrounds for seminar attendees.

Moreover, even if Mr. Ward had been specific about the backgrounds of the attendees, he still did not testify that he presented at any seminar prior to the critical date of the '188 patent. Dec. 13. Thus, even if we were to accept Petitioner's new argument, Petitioner still has not presented sufficient evidence of public accessibility of Background Solutions.

3. Public Accessibility of a Document Posted to a Website

Petitioner contends that the 2010 copyright date on the face of POBITS, along with Mr. Klosson's testimony that he authored and uploaded POBITS onto his company's website by the end of 2010, is enough to show a reasonable likelihood that POBITS was publicly accessible prior to the critical date of the '188 patent. Req. 15. In the Decision, we determined that, even if we credit Mr. Klosson's testimony fully, simply showing that a reference was posted to an Internet website is not enough to show public accessibility by skilled artisans. Dec. 18–20 (citing *Blue Calypso*, 815 F.3d at 1349–50); *see also Samsung*, 929 F.3d at 1369 (“[W]hile indexing is not required to show that a work is publicly accessible, some evidence that a person of ordinary skill could have reasonably found the website and then found the reference on that website is critical.”).

Petitioner now argues that MPEP⁴ § 2128(II)(B) sets forth the standard for determining public accessibility of a document posted to a

⁴ Manual of Patent Examining Procedure (“MPEP”).

website. Req. 14–15. Petitioner did not make this argument in the Petition. Thus, we could not have overlooked it. Nevertheless, it is not persuasive.

MPEP § 2128(II)(B) provides: “Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted.”⁵ We discussed in the Decision, both for Background Solutions and POBITS, why, under Federal Circuit law, simply showing that a document was posted on the Internet is not sufficient to show that the document was publicly accessible. Dec. 13–20. We do not read the MPEP as inconsistent with Federal Circuit law. Indeed, MPEP § 2128(II)(B) expressly references § 2128(I), which makes clear that a reference is not shown to be publicly accessible in the absence of a showing that it was made available to the extent that skilled artisans, exercising reasonable diligence, could have located it. *See* MPEP § 2128(I) (citing *In re Wyer*, 655 F.2d 221 (CCPA 1981)); *see also* MPEP § 2128(II)(A) (“An electronic publication, including an online database or Internet publication (e.g., discussion group, forum, digital video, and social media post), is considered to be a ‘printed publication’ within the meaning of 35 U.S.C. 102(a)(1) and pre-AIA 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates.” (citing *Wyer*, 655 F.2d at 227)). Thus, MPEP § 2128(II)(B) provides guidance on the date a reference will be given during examination, provided that it is shown to be publicly accessible. It does not purport to provide the underlying standard for showing whether a reference was accessible to the relevant public.

⁵ Petitioner appears to cite to the current version of the MPEP. However, the 8th edition, Revision 8, of MPEP § 2128, in force on April 6, 2012, provides similar discussion of public accessibility.

Petitioner also cites to several Board decisions that it contends contradict our institution decision. Req. 3–4, 14. Petitioner did not cite these cases in the Petition or argue their relevance. Pet. 18–24. Thus, we could not have misapprehended or overlooked them. In any case, these cases are non-precedential and were decided before *Hulu*. Our Decision considered Petitioner’s evidence in light of the standards set forth in *Hulu* and Federal Circuit precedent. Petitioner does not persuade us that we misunderstood or misapplied the law.

III. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we misapprehended or overlooked its arguments or abused our discretion in denying the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED Petitioner’s Request for Rehearing is *denied*.

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