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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Hulu, LLC
Petitioner

v.

Sound View Innovations, LLC
Patent Owner

IPR2018-01039
Patent 5,806,062

PETITIONER'S REQUEST FOR REHEARING

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Petitioner respectfully requests rehearing of the Board’s decision (Paper 12) deciding not to institute review on Petitioner’s Petition for *Inter Partes* Review of U.S. Patent No. 5,806,062 (“the ’062 patent”), based on the view that Petitioner’s submission of a textbook with a “copyright year of 1990” indicating that it was “first published” in that year was insufficient at the institution stage to consider the textbook to have been “publicly available” prior art, even though Patent Owner offered no contrary evidence. (Paper 12 at 11.) The Board’s decision in Paper 12 conflicts with numerous other Board decisions and should be reversed, and review on the Petition should be instituted.

The Board misapprehended or overlooked prior decisions of the Board that, for purposes of the preliminary determination for instituting an *inter partes* review petition, find that (1) a copyright notice is *prima facie* evidence that a publication is prior art;¹ (2) a copyright notice, alone or combined with other minimal corroborating evidence, is sufficient evidence of public accessibility to meet the

¹ *FLIR Systems, Inc. v. Leak Surveys, Inc.*, IPR2014-00411, -00434, -00608, and -00609, Paper 9 at 18-19 (PTAB Sept. 5, 2014); *Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00127, Paper 13 at 13 (PTAB Jul. 16, 2013).

“reasonable likelihood” threshold for institution;² (3) a copyright notice by a well-known publisher in the United States is sufficient evidence of public accessibility;³ (4) a copyright notice should be evidence viewed in the light most favorable to a petitioner when resolving disputes regarding public accessibility at the institution stage;⁴ and/or (5) where a patent owner merely points out possible inconsistencies in petitioner’s evidence—without submitting its own evidence of a different public

² *Provepharm Inc. v. Wista Laboratories Ltd.*, IPR2018-00182, Paper 16 at 17-18 (PTAB Jul. 5, 2018); *Rayvio Corp. v. Nitride Semiconductors Co., Ltd.*, IPR2018-01141, Paper 14 at 25-27 (PTAB Dec. 4, 2018); *Fujifilm Corp. v. Hologic, Inc.*, IPR2018-00595, Paper 10 at 18 (PTAB Aug. 27, 2018); *Arista Networks, Inc. v. Cisco Systems, Inc.*, IPR2016-00244, Paper 10 at 19 (PTAB May 25, 2016).

³ *CIM Maintenance Inc. v. P&RO Solutions Group, Inc.*, IPR2017-00516, Paper 8 at 19 (PTAB Jun. 22, 2017); *Shenzhen Zhiyi Technology Co. Ltd. v. iRobot Corp.*, IPR2017-02137, Paper 9 at 21 (PTAB Apr. 2, 2018); *Global Tel*Link Corporation v. Securus Technologies, Inc.*, IPR2017-01437, Paper 7 at 15 (PTAB Dec. 4, 2017); *Syncro Soft Srl v. Altova GMBH*, IPR2018-00660, Paper 6 at 9-10 (PTAB Sept. 5, 2018).

⁴ *CIM Maintenance Inc.*, IPR2017-00516, Paper 8 at 17.

availability date—the petition should be instituted, and any determination as to public availability occur during the trial.⁵ Petitioner respectfully submits that the Board’s determination in this matter therefore constitutes an abuse of discretion as (1) clearly unreasonable, arbitrary, or fanciful, and/or (2) based on an erroneous conclusion of law.

As explained in further detail below, the contradiction between the Board’s decision in this matter and the Board’s decisions in other matters supports rehearing. In addition, it presents an issue of broad applicability to the Board, presents a conflict between Board decisions, and undermines the Board’s desire to promote certainty and consistency.

Request For Precedential Opinion Panel

The Board’s decision regarding the effect of a copyright year in considering a reference’s public availability contradicts prior decisions by other panels in several respects. In particular, several panel decisions have accepted a copyright year as sufficient evidence of public availability for purposes of satisfying the threshold required for institution. Such panels have articulated standards consistent with the fact that a petitioner need merely show a “reasonable

⁵ *Provepharm Inc.*, IPR2018-00182, Paper 16 at 18.

likelihood” of prevailing for the Board to institute a petition and that the evaluation of the issue on the merits should be reserved for the *inter partes* review trial.

Under any of the approaches adopted by those panels and summarized below, the reference at issue here (Dougherty, Ex. 1004) would have been treated as prior art, as it should have been.

First, several panel decisions have treated a copyright notice as *prima facie* evidence that a petitioner’s identified reference is prior art (and therefore implicitly publicly available) for purposes of institution. For example, in *FLIR Systems, Inc. v. Leak Surveys, Inc.*, IPR2014-00411, -00434, -00608, and -00609, Paper 9 at 18–19 (PTAB Sept. 5, 2014), the Board held that a copyright notice was *prima facie* evidence that the reference was prior art to the patent at issue effective as of the date the notice. The panel in *Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2013-00127, Paper 13 at 13 (PTAB Jul. 16, 2013), likewise held that a copyright notice with an appropriately early date is *prima facie* evidence that the asserted reference is prior art to the patent.

Second, other panel decisions note that a petitioner need merely provide sufficient evidence to satisfy the “reasonable likelihood” threshold for institution. For example, in *Provepharm Inc. v. Wista Laboratories Ltd.*, IPR2018-00182, Paper 16 at 17-18 (PTAB Jul. 5, 2018), the Board found that “conventional”

indicia in the asserted references supported a finding that the copyright notice satisfied the petitioner's burden to show a reasonable likelihood of prevailing in showing public availability. Such indicia included edition identifiers (e.g. "Third Edition" and "Fifth Edition") and identifiers regarding dated changes to the document (e.g. "Supplement 2001" and "Supplement 5.4"). (*Id.* at 16.) Other indicia included statements on the face of the reference that it was submitted "for review on June 25, 1999," that a final version had been "submitted" "on August 17 1999," and that the document was "published on the Web on October 23, 1999." (*Id.* at 17-18.) Such "conventional markers" "[without] evidence to the contrary" indicated that the reference was published as of the year those markers state. (*Id.* at 18.) In *Rayvio Corp. v. Nitride Semiconductors Co. Ltd.*, IPR2018-01141, Paper 14 at 26 (PTAB Dec. 4, 2018), the Board treated additional copyright "indicia" as probative of public availability, including the statement "Published in the United States by Oxford University Press Inc., New York" and "a 1993 copyright date." In *Fujifilm Corp. v. Hologic, Inc.*, IPR2018-00595, Paper 10 at 18 (PTAB Aug. 27, 2018), the Board explained that "[a]t [the institution] stage of the proceeding, the question is not whether a preponderance of the evidence supports [the asserted reference] being prior art, but rather whether Petitioner has provided sufficient

evidence, based on the current record, to show a reasonable likelihood of prevailing on its asserted grounds.”

At least one decision goes further, finding that a copyright notice standing alone is sufficient evidence to meet that “reasonable likelihood” threshold. *See Arista Networks, Inc. v. Cisco Systems, Inc.*, IPR2016-00244, Paper 10 at 19 (PTAB May 25, 2016) (“Thus, on this record and for purposes of this decision, we are persuaded that the presence of a copyright notice, given the circumstances of this case, is sufficient evidence of public accessibility as of the critical date to meet the ‘reasonable likelihood’ threshold for institution.”).

Third, several panel decisions find that, when a publisher is well-known and commonly publishes in the United States, a copyright notice from that publisher is sufficient to treat the reference as prior art at the institution stage. For example, in *CIM Maintenance Inc. v. P&RO Solutions Group, Inc.*, IPR2017-00516, Paper 8 at 19 (PTAB Jun. 22, 2017), the Board found that a reference published by “McGraw-Hill” with a copyright notice stating that fact, bearing a copyright date, and the notation “[p]rinted in the United States of America” was sufficient to support the public availability of the reference. The Board noted that “McGraw-Hill was, and is, a commercial publisher in the business of printing and selling books” and that fact “lends credence to Petitioner’s assertion that [the reference]

was *publicly accessible* as of its copyright date.” (*Id.* (emphasis added)). Likewise in *Shenzhen Zhiyi Technology Co. Ltd. v. iRobot Corp.*, IPR2017-02137, Paper 9 at 21 (PTAB Apr. 2, 2018), the Board found that a “publication date on the face of” a New York Times article, along with a “New York Times logo in the upper right corner, as well as the New York Times’s familiar header/section format” is sufficient to make a threshold showing of public accessibility. Such an approach was also taken in *Global Tel*Link Corp. v. Securus Technologies, Inc.*, IPR2017-01437, Paper 7 at 15 (PTAB Dec. 4, 2017), where the reference in question was likewise published by a “well-known” publisher. Similarly, at least one other decision treated the notoriety of the reference’s publisher, O’Reilly Media,⁶ as a fact favoring public availability, since O’Reilly Media is “in the business of publishing educational and technical literature, and its publications are popular and

⁶ O’Reilly Media is the current name for O’Reilly & Associates, which published the textbook at issue in this matter. See Max Chafkin, *The Oracle of Silicon Valley*, INC. (May 1, 2010), available at <https://www.inc.com/magazine/20100501/the-oracle-of-silicon-valley.html> (noting that O’Reilly Media used to be called O’Reilly & Associates).

widely available.” *Syncro Soft Srl v. Altova GMBH*, IPR2018-00660, Paper 6 at 9-10 (PTAB Sept. 5, 2018).

Fourth, at least one panel noted that contradictions in evidence regarding public availability should be viewed in the light most favorable to the Petitioner at the institution phase. In *CIM Maintenance Inc.*, IPR2017-00516, Paper 8 at 17, in evaluating testimony used to support a date of public availability based on a copyright notice, the Board cited 37 C.F.R. § 42.108(c) and noted that it would view that testimony “in the light most favorable to Petitioner.”

Fifth, at least one panel notes that, when a patent owner merely points out contradictions among evidence submitted by a petitioner (*i.e.* merely asserting that a petitioner failed to meet its burden), without submitting evidence that shows a different public availability date, such argument is insufficient to defeat institution, but rather deserves consideration at the trial stage. *See Provepharm Inc.*, IPR2018-00182, Paper 16 at 18 (noting that, without evidence tending to show that reference was not publicly available, there is no reason to doubt publication as of the copyright date).

Petitioner recognizes that some panel decisions appear to have required more than the “reasonable likelihood” standard. *See, e.g., Microsoft Corp. v. Corel Software, LLC*, IPR2016-01300, Paper 13 (PTAB Jan. 4, 2017); *Power*

Integrations, Inc. v. Semiconductor Components Industries, LLC, IPR2017-01975, Paper 9 (PTAB Mar. 12, 2018). But these decisions did not mention—and indeed are inconsistent with—the “reasonable likelihood” standard that governs the public accessibility inquiry at the institution stage. Likewise, in *Apotex Inc. v. Celgene Corp.*, IPR2018-00685, Paper 8 (PTAB Sept. 27, 2018), the panel denied institution without reference to whether it was reasonably likely that the petitioner would show the public availability of the reference in question.

There have been other contradictions in approach. For example, in both *Microsoft Corp.* and *Power Integrations*, the panels found that restrictions on dissemination accompanying the copyright notices were significant evidence suggesting that the references were not actually publicly available. *Microsoft Corp.*, IPR2016-01300, Paper 13 at 11; *Power Integrations, Inc.*, IPR2017-01975, Paper 9 at 14. On the other hand, several other cases, including those described above (that reflect the “reasonable likelihood” standard for public availability) found that such copyright restrictions were boilerplate and had no impact on the public availability analysis. For example, in *Xactware Solutions, Inc. v. Pictomertry International Corp.*, IPR2016-00593, Paper 13 at 8 (PTAB Aug. 31, 2016) the Board found that limitations on the “reproduction, storage, or transmittal of the publication ‘without the prior written permission of [the publisher]’” was not

“inconsistent with [the] distribution of the document to existing or potential customers interested in documentation relating to a commercially-available software system.” *See also Xactware Solutions, Inc. v. Pictomertry International Corp.*, IPR2016-00594, Paper 13 at 11 (PTAB Aug. 31, 2016).

The inconsistency in panel decisions has been recognized by the panels themselves. *Provepharm Inc.*, IPR2018-00182, Paper 16 at 15 (“We acknowledge that panels have differed on whether a copyright notice is inadmissible hearsay or probative evidence of a printed publication.”) (*comparing e.g., Int’l Bus. Machs. Corp. v. Intellectual Ventures II LLC*, IPR2014-00681, Paper 11 at 13–14 (PTAB Oct. 30, 2014) (finding copyright date sufficient for threshold showing that document is a printed publication) *with Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, Paper 41 at 13-16 (PTAB Apr. 23, 2015) (finding copyright notice to be inadmissible hearsay)); *Provepharm Inc.*, IPR2018-00323, Paper 15 at 16 (same); *Power Integrations, Inc.*, IPR2017-01975, Paper 9 at 13 (“Some panels have found that such dates, such as the date appearing in a copyright notice, are hearsay, and, thus, cannot be relied upon as evidence in *inter partes* reviews. . . . Other panels have given the copyright notice more persuasive weight.”).

The reference at issue here, Dougherty (Exhibit 1004), which was published by O’Reilly & Associates (O’Reilly Media’s original name) bears a copyright date

of 1990—a date several years prior to October 17, 1995, the earliest priority date of the '062 patent—and includes notations on the copyright notice indicating only minor corrections made in November 1992 at the latest, still years before the earliest priority date of October 17, 1995. (Exhibit 1004 at 4.) At best, the Patent Owner's response attempts to suggest (without any evidence) that Dougherty (Exhibit 1004), with its November 1992 correction date, *might be* materially different from Dougherty (Exhibit 1005), which was publicly accessible as of September 1992 via the Cornell library. However, nowhere does the Patent Owner argue—much less demonstrate—that Dougherty (Exhibit 1004) was unavailable or inaccessible between November 1992 (the date on the copyright notice) and the earliest asserted priority date of October 17, 1995. At most, the Patent Owner merely points out some minor inconsistencies in the evidence, but puts forth no evidence of any public availability date, other than what is plainly evident by the reference's copyright notice.

Accordingly, under approaches taken by at least *FLIR, Universal Remote, Provepharm, Rayvio, Fujifilm, Arista, CIM Maintenance, Shenzehn Zhiyi Technology Co., Global Tel*Link, and Syncro Soft*, Dougherty (Exhibit 1004) sufficiently supports the preliminary determination required for instituting *inter partes* review because of any of the following: (1) it has a copyright notice that is

prima facie evidence of public availability as of the date on the notice, and that evidence is unrebutted, (2) Petitioner proffered a copyright notice that—standing alone, or combined with corroborating evidence from the Cornell Library—establishes that versions of the reference were publicly available under the “reasonable likelihood” standard, (3) the reference’s publisher (O’Reilly & Associates) is well-known,⁷ and therefore a copyright notice with a copyright date by that well-known publisher should be considered sufficient for purposes of a preliminary determination to institute an *inter partes* review, (4) any contradictions identified by the Patent Owner should be viewed in the light most favorable to Petitioner for the initial determination to institute an *inter partes* review, and/or (5) the fact that the Patent Owner merely identified purported contradictions in

⁷ O’Reilly & Associates is the same company as O’Reilly Media, which a previous panel found to be a well-known publisher. *The Oracle of Silicon Valley* (<https://www.inc.com/magazine/20100501/the-oracle-of-silicon-valley.html>); *Syncro Soft Srl v. Altova GMBH*, IPR2018-00660, Paper 6 at 9-10 (PTAB Sept. 5, 2018) (“[T]he publisher, O’Reilly Media, is in the business of publishing educational and technical literature, and its publications are popular and widely available.”).

Petitioner's evidence, without submitting any controverting evidence of a different publication date from that shown by the copyright notice, should not defeat public availability as of that date (at least for purposes of institution).

The multiple, irreconcilable approaches to this issue, which frequently recurs in *inter partes* review, and its direct effect on the outcome in this matter support the need for review by a precedential panel. A precedential opinion on this issue would encourage predictability by resolving conflicts between panel approaches regarding how to use a copyright notice to establish the public availability of asserted prior art. Moreover, by clarifying that under the appropriate reasonable likelihood standard, a petitioner need merely submit a sufficient copyright notice from a well-known publisher to establish public availability for purposes of instituting *inter partes* review, a precedential opinion would improve efficiency by rejecting an overly formalistic approach that would encourage gamesmanship during a panel's preliminary determination.

Petitioner respectfully requests rehearing of the decision on institution by a precedential opinion panel.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 2, 2019, I caused a true and correct copy of the foregoing materials:

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