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# PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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## At the PTAB, If It's Ancient, Meaning 1997, It's Prior Art

By Charles W. Shifley

June 28, 2017 — Some of us in the practice remember the “cited prior art” of *Sakraida v. Ag Pro*. The U.S. Supreme Court invalidated a patent on a system to flush out barns for cows, U.S. Patent 3,223,070 of 1965. Notoriously, the first-referenced prior art in the Court’s obviousness analysis was “among the labors of Hercules.” 423 U.S. 273 at 275 n. 1 (1976). “[Hercules] went to [a] stream, ... [and] conducted [the stream] to the [cattle pen] ... so that the water streamed in at one end ... carrying all the dirt [out] with it. ... C. Witt, *Classic Mythology* 119-120 (1883).” Greek mythology having been what it was, said the Court, the modern day patent was invalid. Never mind that the patent was on, in part, abrupt release of water from a tank causing a rolling action of the water on a barn floor, accomplishing cleaning without hand labor, and including a “striking result,” “great convenience,” “a cheaper and faster way” to clean, and “commercial success.” *Id.* at 281-2. Never mind that the real prior art included only “spot delivery of water,” by way of “high pressure hoses or pipes,” and required “supplemental hand labor” that “took several hours.” *Id.* Never mind that the Supreme Court report did not include any indication that the barn-cleaning people of ordinary skill in 1965 knew any Greek mythology. The invention nevertheless lacked invention because its combination of elements lacked a “synergistic result.”

So critical prior art at that time in the history of the U.S. Supreme Court and its tests of invalidity for obviousness, 40 years ago, included the mythic accomplishments of Greek and Roman gods known to the justices.

Fast forward, to now, and go to the Patent Trial and Appeal Board (PTAB). In 2017, at the PTAB, obviousness analysis also includes a study of the “ancients,” and the prior art may also include publications about them, as in *Sakraida*, although it might surprise you to learn that “ancient” in this case means 1997.

The proof is from an *inter partes* review (IPR), *Arista Networks, Inc. v. Cisco Systems, Inc.*, IPR2016-00303 (PTAB May 25, 2017). In *Arista*'s final decision, Paper 53, the PTAB confronted the question of whether a technical reference manual, an "ATM UNI specification," on "asynchronous transfer mode" (ATM) switches, *id.* at 13, 15, was proven to be a printed publication, and printed at a prior art time. The evidence of publication included the alleged publication's own copyright notice, an Arizona State University card catalog number, and an uncorroborated declaration of an employee of the parent company of the alleged publisher, Prentice Hall. *Id.* at 17-21. The critical date of the patent in IPR was 1998, and the alleged date of publication was 1993.

As the *Arista* decision indicates, many PTAB, Federal Circuit, and district court patent cases have concluded that alleged printed publications were not proven to be what they were claimed to be. *Id.* One, *Hilgraeve, Inc. v. Symantec corp.*, 271 F. Supp. 2d 964, 976 (E.D. Mich. 2003), stated that a copyright notice is "insufficient to establish that a product was known or used by others on that date." The PTAB distinguished all relevant such cases in *Arista*, however, crediting the copyright notice and the witness declaration. *Id.* Concerning *Hilgraeve*, the PTAB noted that PTAB panels had relied on copyright notices as probative evidence of publication, citing two panels. *Arista* at 18.

To our main interest, however, the PTAB most notably credited the copyright notice as not being subject to a hearsay objection. The objection was not made, it said, but also, said the PTAB, crediting the copyright notice was appropriate because the notice was on a document allegedly from 1993. That age, stated the PTAB in a footnote, *id.* at 18 n. 3, was more than 20 years in the past, qualifying the notice—and indeed, the whole document—for the hearsay exception of Federal Rule of Evidence (FRE) 803(16): "The following are not excluded by the rule against hearsay, regardless of whether the declarant is available as a witness: (16) Statements in Ancient Documents. A statement in a document that it is at least 20 years old and whose authenticity is established." The ATM UNI specification, stated the PTAB footnote, qualified as such an ancient document. The ATM UNI specification copyright notice, then, was not hearsay and, because the specification had been authenticated, the notice could be credited, to an end: patent claims invalid.

The *Arista* reliance on FRE 803(16) is certainly tutorial, or for many of us, at least a reminder. The PTAB applies the FRE. Thus, before the PTAB, the "ancient" will sometimes be at issue, and the "ancient" may be as recent as 20 years ago, meaning 1997. So whether your patent invalidity case is in the Supreme Court or the PTAB, mind the ancients. Their prior art may be the heroic acts of the gods from antiquity, or their prior art may be the alleged mundane publications from 20 years more recent than even *Sakraida* itself. Either way, the ancients may affect your case and its outcome.

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