

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOPHOS LTD. AND SOPHOS INC.,
Petitioner,

v.

OPEN TEXT INC.,
Patent Owner.

IPR2023-00731
Patent 8,201,243 B2

Before JUSTIN T. ARBES, BARBARA A. PARVIS, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Sophos Ltd. and Sophos Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 8,201,243 B2 (Ex. 1001, “the ’243 patent”). Pet. 1. Open Text Inc. (“Patent Owner”) filed a Preliminary Response (Paper 13, “Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. After considering the parties’ arguments and evidence, and for the reasons set forth below, Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the ’243 patent. Accordingly, we decline to institute an *inter partes* review.

II. BACKGROUND

A. Related Matters

The parties identify several infringement lawsuits involving the ’243 patent that have now been consolidated as *Webroot, Inc. et al. v. AO Kaspersky Lab*, No. 6:22-cv-243-ADA-DTG (W.D. Tex.) (“the District Court litigation”). Pet. 2; Paper 4, 1.

The following *inter partes* review has also been filed against a related patent, U.S. Patent No. 8,719,932 B2: *Sophos Ltd. v. Open Text Inc.*, IPR2023-00732 (PTAB Apr. 4, 2023).

B. Real Parties-in-Interest

Sophos Ltd. and Sophos Inc. identify themselves as the real parties-in-interest (RPI) for Petitioner. Pet. 2. Patent Owner identifies Open Text Inc.,

Webroot LLC, Carbonite, LLC; Open Text Corporation; and Open Text Holdings, Inc. as real parties-in-interest. Paper 4, 1.

C. The '243 patent

The '243 patent relates to systems and methods of detecting, controlling, and removing pestware. Ex. 1001, 1:35–38. Pestware refers to any program, such as trojans, spyware, and adware, that collects information about a person or an organization. *Id.* at 1:43–54. Figure 4 is reproduced below.

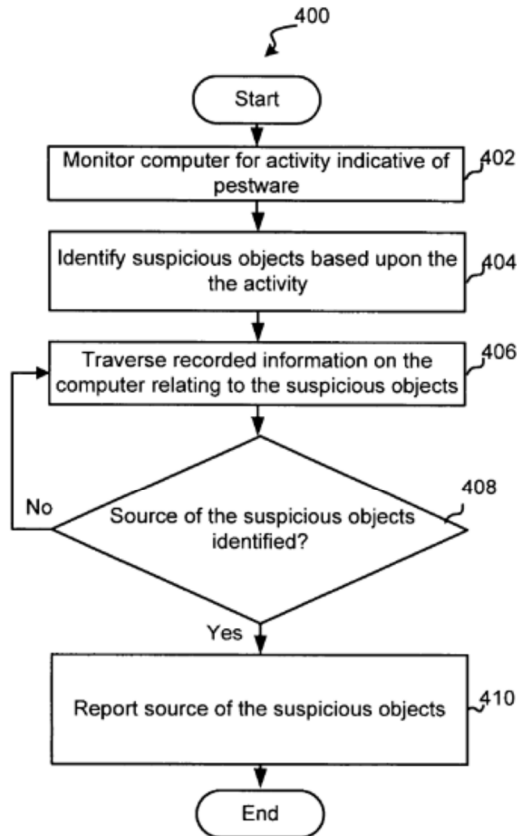


FIGURE 4

The method shown in Figure 4 monitors a computer for activity indicative of pestware 402 and identifies suspicious objects 404 based on that activity. *Id.* at 8:5–22. The method then checks recorded information

on computer 406 to determine the source of suspicious objects 408. *Id.* at 8:23–31. If the source is identified, the computer will report that source “e.g., to a pestware research entity.” *Id.* at 8:32–35. In this way, the suspicious objects and the web sites originating the suspicious objects may be further researched to establish the extent to which they may be a threat. *Id.* at 8:35–38.

D. Challenged Claims

Claim 1, below, is illustrative of the challenged claims.

1. A method for identifying an origin of activity on a computer that is indicative of pestware comprising:

monitoring, using a kernel-mode driver, the computer for activity that is indicative of pestware, wherein the monitoring includes monitoring API calls and storing a history of at least a portion of the API calls in an activity log;

analyzing, heuristically, computer activity to determine whether one or more weighted factors associated with an activity exceeds a threshold so as to arrive at a determination that the activity is indicative of pestware;

identifying, based upon the activity, an object residing on the computer that is a suspected pestware object;

accessing, in response to the identifying an object, at least a portion of a recorded history of externally networked sources that the computer received files from so as to identify a reference to an identity of a particular externally networked source that the suspected pestware object originated from; and

reporting the identity of the particular externally networked source to an externally networked pestware research entity so as to enable the externally networked pestware research entity to research whether the particular externally networked source is a source of pestware.

Ex. 1001, 10:8–30.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 7):

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–14	103	Li, ² Hartrell ³
1–14	103	Li, Hartrell, Mandujano ⁴
1–14	103	Li, Yadav ⁵
1–14	103	Li, Yadav, Mandujano

Petitioner relies on the declaration of Dr. Henry Houh (Ex. 1003).

Patent Owner relies on the declaration of Ron Schnell (Ex. 2001).

III. ANALYSIS

A. Principles of Law

Petitioner bears the burden to demonstrate unpatentability, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is unpatentable as obvious if “the differences between the subject matter sought to be patented and the prior art are such that the

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The ’932 patent was filed before March 16, 2013, so we apply the pre-AIA versions of §§ 102, 103. Ex. 1001, code (22).

² Z. Li, et al., *UCLog: A Unified, Correlated Logging Architecture for Intrusion Detection* (publication date alleged to be 2004) (Ex. 1005).

³ U.S. Patent No. 8,117,659 B2 to Hartrell, issued Feb. 14, 2012 (Ex. 1006).

⁴ Salvador Mandujano Vergara, *A multiagent approach to outbound intrusion detection* (2004) (Ph.D. Thesis, Instituto Tecnológico y de Estudios Superiores de Monterrey) (Ex. 1007).

⁵ U.S. Patent No. 7,174,566 B2 to Yadav, issued Feb. 6, 2007 (Ex. 1008).

subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petition’s challenges.

B. Level of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 13, 17. Petitioner asserts that

A person of ordinary skill in the art (“POSITA”) in April 2006 would have had at least a Bachelor’s degree in Computer Science, Computer Engineering, Electrical Engineering, or an equivalent discipline, and at least two years’ worth of experience developing computer networking or network architecture, or a Master’s degree in a related field. . . . Alternately, more education could substitute for less work experience and vice versa. . . . A POSITA would either have six months’ experience as a network or system administrator, or have taken two advanced computer-security courses.

Pet. 10 (citing Ex. 1003 ¶ 36).

Patent Owner provides a slightly different definition of the level of skill. Prelim. Resp. 22–23 (citing Ex. 2001 ¶¶ 41–43). We are persuaded, on the present record, that Petitioner’s proposal is consistent with the problems and solutions in the ’243 patent and prior art of record. We adopt

Petitioner’s definition of the level of skill for the purposes of this decision. Our decision would not have changed had we adopted Patent Owner’s definition.

C. Claim Construction

In *inter partes* review, we construe a claim using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2022).

The parties do not propose any claim constructions. *See* Pet. 7–8; *see generally* Prelim. Resp. We determine that no terms require construction. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Asserted Obviousness over Li in view of Other References (Grounds 1–4)

Petitioner contends that claims 1–14 would have been obvious over Li and various combinations of other references, as summarized above. Pet. 14–68.

1. *Public Accessibility of Li*

Patent Owner challenges the public accessibility of Li, arguing that Petitioner fails to meet its burden to show that Li was publicly available no later than April 20, 2006 (the asserted priority date of the ’243 patent). Prelim. Resp. 29–35. This issue is dispositive of all grounds.

a. Legal Standards for Public Accessibility

“[T]he burden is on the petitioner to 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.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (PTAB Dec. 20, 2019) (precedential).

The determination of whether a document was publicly accessible “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018). In certain situations, such as for manuscripts or dissertations stored in libraries, courts may inquire whether a reference was sufficiently indexed, catalogued, and shelved. *See, e.g., In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986); *In re Lister*, 583 F.3d 1307, 1315 (Fed. Cir. 2009) (manuscript became publicly accessible once it was placed in a searchable database). Analogously, electronic documents may be publicly accessible if they were indexed or catalogued, or if there were other tools for customary and meaningful research. *See SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1196 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)). In other situations, such as for information displayed at meetings and trade shows, courts have explained that indexing is not required if the information was sufficiently disseminated. *See Medtronic*, 891 F.3d at 1381 (citing *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014)).

What constitutes a printed publication “must be determined in light of the technology employed.” *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. *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)). In sum, “[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*, 511 F.3d at 1194 (quoting *Bruckelmyer*, 445 F.3d at 1378).

b. Petitioner’s Arguments and Evidence

Petitioner argues that “Li was published at least by January 31, 2005, and thus is prior art at least under §102(b).” Pet. 6 (citing Ex. 1009 ¶¶ 43–44). In support of this publication date, Petitioner relies on a declaration of Sylvia D. Hall-Ellis, Ph.D. (Ex. 1009). Dr. Hall-Ellis is an Adjunct Professor in the School of Information at San José State University in San José, California. *Id.* ¶ 6.

Dr. Hall-Ellis testifies that “Exhibit 1002 [Li] is a copy of a conference paper published in the *Proceedings of the 12th International*

Conference on Telecommunication Systems: Modeling and Analysis found in the digital repository Operating Systems Research on Energy, Reliability and Autonomy (OPERA) hosted by the Department of Computer Science and Engineering at the University of California – San Diego.” *Id.* ¶ 40.⁶ According to Dr. Hall-Ellis, the 12th International Conference on Telecommunication Systems: Modeling and Analysis was held on July 22–25, 2004 in Monterey, California. *Id.*

Dr. Hall-Ellis also testifies that Li is available in the following digital repositories: ResearchGate, Google Scholar, and CiteSeer. *Id.* ¶ 41. Each of these repositories indicates a publication date of January 2004, Dr. Hall-Ellis testifies. *Id.*

Dr. Hall-Ellis cites further evidence of public accessibility, including 31 citations in Google Scholar and listing of the paper among the works of Li co-authors Jeff Rosendale and William Yurcik. *Id.* ¶ 42. Dr. Hall-Ellis notes that a paper by William Yurcik citing Li is available from the digital repositories ResearchGate and Semantic Scholar. *Id.*

Dr. Hall-Ellis concludes,

In view of above, the Li conference paper was publicly available on or shortly before July 25, 2004, because by that date it had been written and presented at the 12th International Conference on Telecommunication Systems: Modeling and Analysis. For these reasons, it is my opinion that Exhibit 1002 was published and accessible to the public (and could have been located by a skilled researcher) by January 31, 2005.

Id. ¶ 43.

⁶ Exhibit 1009 cites several webpage links instead of exhibits, contrary to our rules. *See* 37 C.F.R. §§ 42.63(a), 42.6(c). We address this issue in detail below.

c. Patent Owner's Arguments

Patent Owner offers several reasons why Petitioner makes a deficient showing of public accessibility. Prelim. Resp. 29–35. First, Patent Owner asserts that Dr. Hall-Ellis does not claim to be a record custodian for any website or other publication that purportedly resulted in Li becoming publicly available, nor does Dr. Hall-Ellis claim any personal knowledge of when Li was first published. *Id.* at 31. Rather, Patent Owner contends, Dr. Hall-Ellis bases her opinions on reviewing online databases at an unspecified time (and presumably around the time of her declaration in this case), rather than before the April 20, 2006 priority date of the '243 patent. *Id.* (citing Ex. 1009 ¶ 40 (“I obtained this copy of the conference paper from the OPERA digital repository.”)).

Similarly, Patent Owner contends, Dr. Hall-Ellis's testimony that “[t]he Li conference paper *is* also available” in various repositories does not establish that Li *was* available in those repositories before the '243 patent's filing date. *Id.* at 32. Patent Owner relatedly contends that a listing of a January 2004 date in those repositories does not demonstrate that Li was publicly *available* in those repositories as of that date. *Id.* Further, many of these repositories did not exist in January 2004, Patent Owner asserts, including ResearchGate, which launched in 2008. *Id.* at 32–33 (citing Ex. 2014). Google Scholar launched in November 2004 but links to the version of Li on ResearchGate, according to Patent Owner. *Id.* at 33 (citing Ex. 2015). Moreover, Patent Owner argues, Li could not have published in January 2004 because it cites to other publications with later dates. *Id.* (citing Ex. 1005, 14–15 (citations 8, 10, 14, 34, 35, 37)).

As for Li's purported citations by others, Patent Owner contends that nearly all of the 31 citations Dr. Hall-Ellis references "do not list even a purported publication date before the filing date of the '243 patent." *Id.* at 33. The two works Dr. Hall-Ellis singles out are not germane, Patent Owner argues, because they are works by co-authors of the Li paper, and "citations by authors who had 'personal knowledge regarding the cited' reference does not demonstrate public availability." *Id.* at 33–34 (quoting *Argentum Pharms. LLC v. Research Corp. Techs., Inc.*, IPR2016-00204, Paper 19 at 11–12 (PTAB May 23, 2016); *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1372 (Fed. Cir. 2019) (a work is not publicly accessible if the only people who know how to find it are the ones who created it)).

Finally, Patent Owner notes that Dr. Hall-Ellis does not identify any factual support for the statement that "the Li conference paper was publicly available on or shortly before July 25, 2004, because by that date it had been written and presented at the 12th International Conference on Telecommunication Systems: Modeling and Analysis." *Id.* at 34 (citing Ex. 1009 ¶ 43). In sum, Patent Owner charges Petitioner and Dr. Hall-Ellis with relying on nothing more than speculation that Li was publicly accessible in the relevant time frame. *Id.* at 35. Thus, Patent Owner asserts that Petitioner has failed to meet its burden to show that Li is prior art, and because Petitioner relies on Li for every ground in the Petition, the Board should deny institution on this basis alone. *Id.*

d. Dr. Hall-Ellis's Testimony is Unsupported

Before analyzing the substance of Dr. Hall-Ellis's testimony, we first address a threshold issue. Dr. Hall-Ellis's declaration cites several webpage

links instead of exhibits and is therefore unsupported by evidence. *See* 37 C.F.R. § 42.65(a).

Our rules require that “[a]ll evidence must be filed in the form of an exhibit,” and that “[e]ach exhibit must be filed with the first document in which it is cited except as the Board may otherwise order.” *Id.* §§ 42.63(a), 42.6(c). Despite Petitioner not filing the webpage links as exhibits with Exhibit 1009, we gave Petitioner the opportunity to correct this error and ordered Petitioner to file late copies of these webpage links as exhibits by September 22, 2023. *See* Ex. 3001 (email order); 37 C.F.R. § 42.6(c) (“except as the Board may otherwise order”). Petitioner declined to do so, instead choosing to request authorization to file a Motion to Dismiss, which we authorized in an order mailed October 2, 2023 (Paper 17).⁷ In our email order, we informed Petitioner that failure to file the webpage links as exhibits would result in the Board not considering the webpage links as evidence in these proceedings. Ex. 3001. Our order authorizing filing of the Motion to Dismiss did not obviate Petitioner’s responsibility to file copies of the webpage links as exhibits. *See id.*; Paper 17.

The importance of following the Board’s rules with regard to filing exhibits cannot be overstated. Filing documents as exhibits serves at least two important functions. First, exhibits present evidence that—unlike a webpage link—is not subject to change or removal because it is stored in the Office’s electronic filing system. In contrast, a webpage may change in content at any time, or a webpage may be deleted or moved to a different location, rendering it impossible to find the evidence originally presented. A

⁷ For reasons explained in Paper 22, we denied Petitioner’s Motion.

change in one of Dr. Hall-Ellis's cited webpages has, in fact, occurred in this case. As will be discussed in greater detail below, Dr. Hall-Ellis asserts that "[t]he digital repository *Google Scholar* indicates that the Li conference paper has been cited 31 times." Ex. 1009 ¶ 42. Dr. Hall-Ellis cites a link in support, https://scholar.google.com/scholar?hl=en&as_sdt=0%2C6&q=Uclog%3A+A+unified%2C+correlated+logging+architecture+for+intrusion+detection&btnG=. *Id.* n.25. When a member of the panel first accessed this link, it stated "Cited by 31." However, at a later date, when the same panel member accessed this link, the webpage instead stated, "Cited by 30." Changes in the evidence like this call into question the reliability of that evidence.

A second reason for filing web documents as exhibits flows from the first, which is to provide public access to the record of the case. The public has an interest in reviewing Board decisions and accessing evidence cited by those decisions. It is less burdensome for the public to download exhibits from the Office's electronic filing system (or from a third party system hosting these documents) than to follow links. For example, some of the links in Exhibit 1009 are so long that, due to line breaks, clicking on them does not access the correct webpage, and one must instead copy and paste the URL into a browser to find the correct webpage. A reader who does not realize this may accidentally access the wrong document. For expediency, this Decision must necessarily cite to these links (or to the footnotes containing them), which will make access more difficult for members of the public trying to review this Decision. Not only that, but should the links change or become broken, the public will not be able to access the documents referenced by these links.

Petitioner chose not to file the webpage links as exhibits, and therefore, “the Board [will] not consider[] these hyperlinked webpages as evidence in [this] proceeding[.]” Ex. 3001. As a result, Dr. Hall-Ellis’s declaration does not cite any supporting evidence of record in this proceeding (other than Li itself, Ex. 1005). Ex. 1009 ¶¶ 40–43. The declaration thus “does not disclose the underlying facts or data on which the opinion is based” and is therefore “entitled to little or no weight.” See 37 C.F.R. § 42.65(a). For this reason alone, we find that Petitioner has failed to establish the public accessibility of Li.

Yet even if we were to consider the links in Dr. Hall-Ellis’s declaration, the declaration would still be deficient and fail to support Petitioner’s contention that Li was publicly accessible in the relevant timeframe. For clarity of the record, we address in the next section the substance of Dr. Hall-Ellis’s declaration as if those links had been filed as exhibits.

e. Substantive Analysis of Dr. Hall-Ellis’s Testimony

We agree with Patent Owner that Petitioner has not shown a reasonable likelihood that Li was accessible before the priority date of the ’243 patent. In particular, we determine that Petitioner has not shown a reasonable likelihood that Li “has been disseminated” or that Li was “otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” See *SRI*, 511 F.3d at 1194.

As an initial matter, Li is undated. We can find no indication anywhere in Li itself evidencing a timeframe in which it might have been published, not even a copyright date. There is also no indication in Li of any

journal or website where Li may have been published. Dr. Hall-Ellis testifies that Li “appears beginning on page 12” of, purportedly, a record of the 12th International Conference on Telecommunication Systems: Modeling and Analysis, but the copy of Li submitted by Petitioner starts on page “1” and includes no further pages describing any conference. *See* Ex. 1009 ¶ 40; Ex. 1005, 1. Ultimately, there is nothing in the text of Li itself to distinguish Li from a draft paper that was never published.

Petitioner submits no evidence that Li was disseminated at or around the time of the 12th International Conference on Telecommunication Systems: Modeling and Analysis. *See Medtronic*, 891 F.3d at 1381. Dr. Hall-Ellis testifies that Li was “presented” at the conference but submits no evidence in support of this assertion. Ex. 1009 ¶ 43. For example, Dr. Hall-Ellis does not address “whether the copies were freely distributed to interested members of the public” or whether there was a “legal obligation of confidentiality” when distributing any copies, among other factors. *See Medtronic*, 891 F.3d at 1381. Absent any such evidence, we conclude that Petitioner has not shown dissemination of Li at or around the time of the conference, or at any other time before the ’243 patent’s asserted priority date.

Petitioner also does not sufficiently establish that Li was “otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *See SRI Int’l*, 511 F.3d at 1194. Dr. Hall-Ellis’s testimony is deficient because her testimony does not establish that Li was likely made available to the public *before the critical date* of the challenged patent. *See Hulu*, Paper 29 at 16. For example, Dr. Hall-Ellis does not claim personal knowledge of

when Li was first published, was unclear as to when she obtained Li from the OPERA digital repository, and unpersuasively asserts that Li “is” available from other digital repositories. *See* Prelim. Resp. 31–32; Ex. 1009 ¶¶ 40–41. Whether Li “is” available online now does not establish that Li was publicly accessible in the relevant timeframe, i.e., 17 years earlier, prior to the April 20, 2006 priority date of the ’243 patent.

Further, Dr. Hall-Ellis presents no persuasive evidence that the identified digital repositories hosted Li in the relevant timeframe. Patent Owner persuasively asserts that ResearchGate was established in 2008, after the priority date, and that Google Scholar’s page referencing Li links to ResearchGate. Prelim. Resp. 32–33 (citing Ex. 2014 (“We started ResearchGate in 2008”); Ex. 1009 ¶ 41; *see also id.* n.23 (Google Scholar link, showing “[PDF] from researchgate.net”). Accordingly, these repositories do not support Dr. Hall-Ellis’s testimony that Li was publicly available in the relevant timeframe, before April 20, 2006. Dr. Hall-Ellis’s reliance on the CiteSeer repository is also unavailing because Dr. Hall-Ellis’s link to CiteSeer directly opens a PDF file of Li and does not provide any evidence showing that CiteSeer hosted Li in the relevant timeframe. *See* Ex. 1009 ¶ 41 n.24.

We also agree with Patent Owner that a listing of a January 2004 date in those repositories does not demonstrate that Li was actually available in those repositories as of that date. Prelim. Resp. 32 (citing *In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 17 at 5, 12 (PTAB Mar. 30, 2020) (“Simply pointing to a date, alleged to be a ‘publication date,’ even where that date cascaded through various patent references, without interpretation or explanation, does not meet the threshold

standard to show that it is reasonably likely that a reference was [publicly] accessible on that date.”)). This is plainly true in view of ResearchGate being established in 2008, yet claiming a 2004 publication date for Li. *See* Ex. 2014. Moreover, the January 2004 purported publication date in the ResearchGate and Google Scholar repositories is also called into question by Li’s citation to papers dated after January 2004. *E.g.*, Ex. 1005, 15 (citation 35 (Feb. 2004 date); citation 37 (Jun. 2004 date)).

Dr. Hall-Ellis’s reference to other papers citing Li is also unavailing at least because the Google Scholar page about these citations merely says “Cited by 30.”⁸ *See* Ex. 1009 ¶ 42 n.25. Merely being cited 30 (or 31) times does not establish a specific publication date. Dr. Hall-Ellis provides no further analysis about these 30 citations, apart from referring specifically to two of these works. *Id.* ¶ 42. But the two works Dr. Hall-Ellis singles out as citing Li are unpersuasive publication evidence because they are works by co-authors of the Li paper, and citations by authors who had “personal knowledge regarding the cited” reference does not demonstrate public availability. *See* Ex. 1009 ¶ 42; Prelim. Resp. 33–34 (quoting *Argentum*, Paper 19 at 11–12); *see also Samsung*, 929 F.3d at 1372 (“[A] work is not publicly accessible if the only people who know how to find it are the ones who created it.”).

Finally, we agree with Patent Owner that Petitioner and Dr. Hall-Ellis rely on nothing more than speculation that Li was publicly accessible in the relevant time frame. Prelim. Resp. 35. Dr. Hall-Ellis asserts, without any evidentiary support whatsoever, that Li was “published and accessible to the

⁸ As we note above, as of this writing, this Google Scholar page instead says “Cited by 30,” not “Cited by 31,” as Dr. Hall-Ellis testifies.

public” by January 31, 2005. Ex. 1009 ¶ 43. Dr. Hall-Ellis’s explanation for this particular date is that “the Li conference paper was publicly available on or shortly before July 25, 2004, because by that date it had been written and presented at the [conference]. For these reasons, it is my opinion that Exhibit 100[5] was published . . . by January 31, 2005.” *Id.* No evidence supports this statement.

Accordingly, in addition to Dr. Hall-Ellis’s declaration being unsupported due to relying on links instead of exhibits, the substance of Dr. Hall-Ellis’s declaration does not support Petitioner’s assertion that Li is prior art to the ’243 patent. Petitioner has therefore failed to show a reasonable likelihood that Li is, in fact, prior art. As Petitioner has failed to meet this burden, and as Petitioner relies on Li for every ground in the Petition (Pet. 7), we deny institution of *inter partes* review.

IV. CONCLUSION

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its challenges as to at least one challenged claim. Accordingly, we do not institute *inter partes* review.

V. ORDER

It is, therefore,

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is *denied*.

IPR2023-00731
Patent 8,201,243 B2

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