Intellectual Property & Technology Law Journal

Edited by the Technology and Proprietary Rights Group of Weil, Gotshal & Manges LLP

VOLUME 31 • NUMBER 11 • NOVEMBER 2019

Working Draft Distributed to Members of Well-Known Standard Setting Group Was Not a Publication

By Vinu Raj

In *Samsung Electronics Co., Ltd. v. Infobridge Pte. Ltd.*, the U.S. Court of Appeals for the Federal Circuit (the CAFC) addressed the legal standard for assessing the public accessibility of prior art documents before a patent's critical date.[1] This case arises from an appeal by Samsung to decisions by the Patent Trial and Appeal Board (the Board) in two inter partes review proceedings which upheld all challenged claims of U.S. Patent 8,917,772 (the '772 patent) owned by Infobridge. In each proceeding, the Board found that Samsung failed to show that a certain prior art reference was publicly accessible before the critical date for the '772 patent, and thus could not be considered prior art. The CAFC vacated the Board's decision, holding that that the correct standard for public accessibility is whether a person of ordinary skill in the art *could*, after exercising reasonable diligence, access a reference.[2]

The '772 patent, titled "Method of Constructing Merge List," generally relates to encoding and decoding video data using methods that both parties agreed are essential to the High Efficiency Video Coding standard (the H.265 standard). The question before the court was whether a working draft of the H.265 standard (Working Draft 4 or the WD4 reference), developed by the Joint Collaborative Team on Video Coding (JCT-VC), was publicly accessible prior to the critical date for the '772 patent. In answering this question, the court addressed three facts set forth by Samsung in support of the reference's public accessibility before the critical date: (1) it was discussed at various JCT-VC meetings and distributed to meeting attendees; (2) it was uploaded to the JCT-VC and MPEG websites; and (3) it was emailed to the JCT-VC listserv.

The JCT-VC Meetings

Samsung argued that the WD4 reference became publicly accessible during JCT-VC meetings held in Torino, Italy, on July 2011, and in Geneva, Switzerland, on November 2011, because it was developed at a "prominent international conference" and distributed to meeting participants. The Board did not address whether the distribution of the WD4 reference at these meetings would have made it publicly accessible, and while the CAFC found that Samsung had waived this argument, it noted that the WD4 reference was not created until after the July 2011 meeting and that Samsung conceded the November 2011 meeting occurred only

Vinu Raj is an associate at Haynes and Boone, LLP, counseling clients at all stages of growth in developing new technologies and bringing them to market. He may be reached at *vinu.raj@haynesboone.com*.

after the critical date for the'772 patent (November 7, 2011).

Uploading to the JCT-VC and MPEG Websites

Samsung also argued that the WD4 reference was publicly accessible prior art because it was uploaded to a public website maintained by JCT-VC on October 4, 2011, while also being uploaded to a website maintained by the Moving Picture Expert Group (MPEG), a parent organization of the JCT-VC, on the same date. Unlike the MPEG website, the JCT-VC website required no password for users to access materials. Rather, to access the WD4 reference on the JCT-VC website, users only needed to:

(1) Navigate to the website;

(2) Select a menu option to view information about "All meetings" held by the JCT-VC;

(3) Select the meeting location by city (Torino) from the list of available meeting options; and

(4) Select the WD4 reference from a list of "hundreds" of documents organized by an identifying number but not by subject matter.

Samsung argued that uploading the WD4 reference to the JCT-VC site in October made it publicly accessible prior to the November critical date for the '772 patent. Samsung relied primarily on a declaration by Benjamin Bross, the lead author of the WD4 reference, who testified:

> [B]ased on my knowledge and recollection, given the prominence of the JCT-VC in the video coding industry, persons interested in tracking the developments of the latest video coding standard would regularly visit the JCT-VC site to ensure that products and services they were developing were consistent with the HEVC Standard under development.[3]

However, the CAFC agreed with the Board's finding that Mr. Bross's testimony was speculative and insufficient to show that a person of ordinary skill (particularly, those outside of the JCT-VC), exercising reasonable diligence, would have located the JCT-VC website or even known to look for it.[4] The Board explained that "identifying a meeting location was key to navigating the JCT-VC site," but there was "no evidence" anyone outside of those participating in the JCT-VC meetings would have found "cities . . . helpful in any respect in locating a document on the site."[5] The fact that the JCT-VC site was organized in a hierarchical manner was insufficient to show that the WD4 reference was "*meaningfully* indexed such that an interested artisan exercising reasonable diligence would have found it."[6]

The CAFC was also not persuaded by Samsung's argument that sharing the WD4 reference among members of the JCT-VC was analogous to presenting a paper to academics at a conference, which the court had recognized in prior cases was enough to make a work publicly accessible. According to the court, these cases suggest that a work is not publicly accessible if the only people who know how to find it are the ones who created it.[7]

In the instant case, the court found that the structure of the website, which organized documents by meeting and lacked a way to search by subject matter, meant that a person would only find the WD4 reference if they knew where to look. The court also pointed to a lack of advertising as another example of Samsung's failure to show that those outside of the JCT-VC knew about the JCT-VC website. Ultimately, the court reached the same conclusion as the Board, and found that a person of ordinary skill in the art would not have been able to find the WD4 reference on the MPEG website even after exercising reasonable diligence.[8]

The JCT-VC Listserv

Finally, Samsung relied on an October 4, 2011 email sent by Mr. Bross to a JCT-VC listserv to show the public accessibility of the WD4 reference prior to the critical date for the '772 patent. Samsung's argument was based on Mr. Bross's testimony that the listserv included JCT-VC members as well as other interested members of the public who subscribed to the listserv. Mr. Bross also testified that "any person could subscribe to the JCT-VC [listserv]" and that "anyone with a valid e-mail address requesting subscription was typically approved."[9] The Board found this evidence insufficient to

establish public accessibility because it did not show that the "254 individuals" who subscribed to the listserv represented "a significant portion of those interested and skilled in the art."[10] The Board concluded that Mr. Bross's email "was, at best, a limited distribution of a link to the WD4 document information webpage to a select group" and therefore, did not show the work was generally disseminated to persons of ordinary skill in the art.[11]

The CAFC, however, disagreed and found that the Board erred by confusing access with accessibility to conclude that the listserv email did not make the WD4 reference publicly accessible. The court held that the correct standard for public accessibility is not whether specific persons *actually* accessed a reference, but whether a person of ordinary skill in the art *could*, after exercising reasonable diligence, access the reference. The court also recognized that public accessibility did not require a reference to be "generally" or "widely" disseminated and that a limited distribution may be enough under certain circumstances. As an example, the court cited *Mass. Inst. of Tech. v. AB Fortia*,[12] where the distribution of a work to six conference attendees was enough to make it publicly accessible.

According to the CAFC, the Board should have considered whether Mr. Bross's testimony was sufficient to show that an ordinarily skilled artisan could have accessed the WD4 reference based on the listserv email. The court noted that other considerations relevant to this inquiry might include examining whether a person of ordinary skill would have joined the listserv, why the email was sent, and whether it was covered by an expectation of confidentiality.[13] Because the record was not clear as to the Board's findings on these factual questions and the Board applied an erroneous legal standard in reaching its conclusion with respect to the listserv email, the CAFC vacated the Board's decision and remanded for further proceedings on this issue.

The CAFC's decision in this case is particularly instructive for those practitioners who often rely on working drafts of a standard setting organization as prior art to show the invalidity of a patent in district court cases or inter partes review proceedings. This decision underscores the importance of considering the circumstances in which a prior art reference was disseminated and whether the evidence establishes that an ordinarily skilled artisan, after exercising reasonable diligence, could have accessed the document prior to the critical date of the patent at issue. Practitioners should be aware of the appropriate factual questions emphasized by the CAFC here in assessing whether this legal standard for public accessibility is met. As the court explains in reaching its decision, "public accessibility requires more than technical accessibility."[14]

Notes

1. Appeal No. 18-2007 (Fed. Cir. July 12, 2019).
2. *Id.* at 18.
3. *Id.* at 12.
4. *Id.* at 15.
5. *Id.* at 13.
6. *Id.* at 9.
7. *Id.* at 14 (discussing SRI Int'l, Inc. v. Internet Sec. Sys., Inc., 511 F.3d 1186, 1196 (Fed. Cir. 2008)).
8. *Id.* at 16-17.
9. *Id.* at 17.
10. *Id.* at 18.
11. *Id.* at 6, 18.
12. 774 F.2d 1104 (Fed. Cir. 1985).
13. Appeal No. 18-2007 at 20.
14. *Id.* at 9.