# McCombs, Goryunov and Horsley in The Patent Lawyer: The Way (Back) to Public Accessibility

October 10, 2024 David McCombs

PRACTICES Patents, Patent Prosecution and Counseling, Patent Office Trials

Haynes Boone Partners David McCombs, Eugene Goryunov and Associate Eric Horsley authored an article for the September/October edition of *The Patent Lawyer* reviewing recent cases that have questioned public accessibility to provide best practice advice for indexing and searchability.

Read an excerpt below.

Prior art in the form of patents and printed publications is the foundation of any challenge to patent validity in an *inter partes* review ("IPR"). A petition for IPR must show that a publication qualifies as prior art under 35 U.S.C. § 102. Without that showing, an IPR never gets off the ground. In *First Solar, Inc. v. Rovshan Sade ("First Solar")*, the Patent Trial and Appeal Board ("Board") denied institution of IPR as a result of Petitioner First Solar's failure to establish that a reference was publicly accessible before the critical date. A discussion of First Solar, related cases, and a few lessons follows.

***First Solar, Inc. v. Rovshan Sade***
The patent at issue in First Solar is directed to solar trackers that reorient solar panels to track the sun throughout the day. First Solar ("Petitioner")challenged claims 5-6 based on an installation guide ("Wattsun") and a brochure ("RayTracker") – each related to a solar tracker product. Petitioner alleged that the public accessibility of Wattsun was "evidenced at least by its reference on a webpage verified by the Internet Archive as being publically [sic] available as early as December 2, 2005." For support, the Petitioner cited an affidavit of a Records Request Processor at the Internet Archive that described the Wayback Machine and how it is searched. Similar Wayback Machine-related support was offered for the RayTracker reference. For RayTracker, Petitioner alleged further support for public accessibility from "testimony by persons with personal experience and knowledge of *RayTracker*" and "identification of a later version of *RayTracker* as prior art by the Applicant during the prosecution of US Patent No. 9,917,546, a continuation of the '57546 Patent." However, the RayTracker webpage containing the brochure relied on by Petitioner was not archived in the Wayback Machine before the relevant priority date.

The Board was not convinced of the public accessibility by the relevant priority date. For Wattsun, the Board agreed with Patent Owner that "Petitioner has failed to present sufficient evidence or argument that an interested party exercising reasonable diligence would have located Wattsun." The Board found two deficits. First, a lack of testimonial evidence "that a person interested in solar trackers or solar panel assemblies would be independently aware of the web address for Wattsun or even of the company or its products."Second, the website for Wattsun was not shown to be indexed and thus only "technically accessible." For RayTracker, the Board observed that RayTracker did not match a later version of the webpage cited by Petitioner, and that uncorroborated testimony could not salvage an availability date for RayTracker.

In *First Solar*, the inability to establish public accessibility was sufficient to decide the entire IPR. Irrespective of the reasons for not offering sufficient evidence, the denial of institution tracks with

the existing caselaw. That caselaw provides a guide to successfully establishing public accessibility of a reference and avoiding common pitfalls. We now turn to that caselaw.

To read the full article from *The Patent Lawyer*, click here.