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Unrebutted Declaration Supports Public Availability of Prior Art

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Addressing the evidentiary showing necessary to prove whether a foreign publication is publicly available, the US Court of Appeals for the Federal Circuit found that the Patent Trial and Appeal Board (PTAB) did not abuse its discretion when it accepted a declaration submitted on behalf of the petitioner more than one month after institution of *inter partes* review (IPR), and that the declaration included sufficient information indicating that the reference was publicly available. *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, Case Nos. 17-2381, -2385 (Fed. Cir. Nov. 7, 2019) (Newman, J).

Ericsson owns a patent directed to a direct conversion receiver for wireless communication systems that may receive signals from systems that operate at different frequency bands. The alleged benefit to such a receiver is that it can receive multiple frequency bands without requiring significant hardware duplication. TCL filed two petitions for IPR relying on an article entitled “Multimodale Funktelefone,” written by Professor Hans-Joachim Jentschel *et al.* (Jentschel article). Ericsson’s primary argument at the PTAB was that the Jentschel article was not available as prior art as of the priority date of the challenged patent.

The Jentschel article was published in a German periodical, whose cover indicates the date “Mai/Juni” 1996:

May/June 1996 is more than one year prior to the effective filing date of the challenged patent. However, as the publication was not available in the United States until October 1996, TCL was required to prove publication in Germany during the May/June 1996 timeframe.

Six months after the PTAB's decision to institute, TCL moved to submit the sworn declaration of Doris Michel, a librarian at the Technische Universität Darmstadt in Germany, in support of the Jentschel article's public availability. Ericsson objected under 37 CFR § 42.123(b), which requires any party seeking to submit supplemental information more than one month after institution to show why the information reasonably could not have been obtained earlier. The PTAB allowed TCL to submit the declaration, relying on TCL's statement that Michel was the only individual TCL was able to find with personal knowledge of the record-keeping procedures used in 1996, willing to sign a sworn declaration and willing to travel to the United States to be deposed.

Ericsson also argued that the Michel declaration was not sufficient to show public availability. The declaration indicated that Michel worked at the library in 1996, and based on library records, the journal issue dated May/June 1996 "was inventoried by the Library on June 18, 1996 [and] was openly accessible for use to the public after a processing time of 1–2 days." Ericsson argued that precedent requires something more than simply shelving the document in a library, but submitted no evidence in rebuttal of the Michel declaration. The PTAB ruled that the Jentschel article was publicly available and ultimately ruled that the challenged claims of Ericsson's patent were obvious. Ericsson appealed.

The Federal Circuit found that the PTAB did not abuse its discretion when it allowed TCL to supplement the record with the Michel declaration. The Court explained that "when the challenged evidence is reasonably viewed as material, and the opponent has adequate opportunity to respond and to produce contrary evidence, the interest of justice weighs on the side of admitting the evidence." As to the content of the Michel declaration, the Court agreed with Ericsson that it did not bear the ultimate burden of proof with respect to the Jentschel article's public availability. However, as Ericsson provided no evidence to counter the Michel declaration, the declaration combined with the library records and the journal itself were enough to show that the Jentschel article was publicly available in May/June 1996. Accordingly, the Court affirmed the PTAB's rulings regarding public availability, and ultimately went on to affirm the PTAB's finding that the Jentschel article, in combination with other references, rendered the challenged claim invalid as obvious.

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