

Friendfinder Networks v. WAG Acquisition: Thesis Does Not Qualify As Prior Art IPR2015-01033

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: The Board may determine a thesis was not “publicly accessible,” and thus not prior art, when the record shows that a microfiche copy in a library was indexed only by the author’s last name and the first word of the work’s title.

In its [Decision](#), the board declined to institute inter partes review of claims 1-4 of U.S. Patent No. 8,327,011. The '011 patent relates to a streaming media buffering system.

Each of Petitioner’s challenges to claims 1-4 of the '011 patent are based on a combination of a thesis by Su with other references. In its Preliminary Response, Patent Owner contended that Petitioner had “not demonstrated that Su was publicly accessible, so as to constitute printed publication prior art.” In a previous decision, the Board denied Petitioner’s request for authorization to submit a reply to the Preliminary Response regarding this issue. The Board stated that Petitioner previously “acknowledged that it did not seek to introduce new evidence or rebut facts presented in the Patent Owner Preliminary Response and that the question before [the Board] is a legal one.” Accordingly, the Board first analyzed whether Su was a “printed publication” before the September 2000 filing date of the earliest related application identified on the face of the '011 patent.

According to the Petition, “Su is a thesis submitted to the Department of Computing and Information Science at Queens University, Ontario, Canada in September 1998.” Petitioner submitted as an exhibit a copy of Su bearing “a copyright notice with the year 1998.” Petitioner also stated that “Su was published by and available at the National Library of Canada in 1999.” In support of this assertion, Petitioner cited “bibliographic information provided in a print-out from Theses Canada” [referred to as “TH-Su”] that “includes an active PDF link to Su, identifies Su as resident on two microfiches, indicates the publisher is the Ottawa: National Library of Canada [1999], and includes an abstract . . . an AMICUS No. (20672380), an international standard book number (ISBN 0612312569), a Canadian Number (992099080), and the following information “Copies: NL Stacks – Mic. TJ-31256.” However, the Theses Canada print-out indicates that “it is a document created and modified on July 18, 2008.”

Patent Owner argued in its Response that “the bibliographic information in TH-Su does not identify when the PDF link and abstract rendered in the document were added to the database from which that web page was generated” and that “TH-Su does not establish any date, short of the present, as

to when Su was accessible in a searchable or indexed manner, such that it could be located by persons interested and ordinarily skilled in the subject matter or art using reasonable diligence.” The Board noted that “[i]t is not clear if July 18, 2008 is the date Su became available through the Theses Canada service.”

The Board explained that its “inquiry focuses on whether Su, as it was catalogued, indexed, and shelved, was reasonably accessible to the public before the critical date.” In its analysis, the Board will “consider all the facts and circumstances surrounding the disclosure and determine whether an interested researcher would have been able to find the reference and examine its contents exercising reasonable diligence, prior to the critical date.” The Board stated that “Petitioner’s only evidence of public accessibility is TH-Su and Su itself” and that it therefore looks “to other information provided on Su and TH-Su to assess whether Su was accessible to an interested researcher exercising reasonable diligence.”

The Board began by considering Su’s copyright notice. Although “a copyright notice has been accepted a prima facie evidence of publication,” when determining the threshold issue of whether a document is a printed publication for purposes of a decision on institution, “a copyright notice may not be determinative” in the absence of further evidence. According to the Board, “Petitioner acknowledges that Su was not published until at least 1999” and “it is undisputed that Su was not publicly accessible during the year stated in its copyright notice, i.e., 1998.” Accordingly, the Board did not give the copyright notice any weight “on the issue of public accessibility.”

The Board then determined that Petitioner did not offer evidence of public accessibility from the ISBN, AMICUS No., or Canadian No. printed on TH-Su.

Next, the Board acknowledged that TH-Su “identifies a microfiche and the shelf on which it could be found,” but concluded that “Petitioner provides no evidence concerning when or how Su was publicly accessible before July 18, 2008.”

Patent Owner submitted evidence including “photograph of the microfiche copy of Su,” a “photograph of an envelope in which the microfiche is stored,” and a copy of an “index microfiche” listing titles and authors but not including abstracts. The envelope photograph showed the following information: “Jan–Jul/Aug 1999 ISSN 0225-3216 Index A Authors Titles Series.” Patent Owner argued that its exhibits “demonstrate that in 1999 the activities of the National Library of Canada were limited to

copying the thesis to microfiche, creating a bibliographic entry with the author’s name and title and other identifying information (but importantly not an abstract), putting those bibliographic entries into a publicly accessible physical index, organized and accessible by looking up the author’s last name and the first word of the title in an alphabetical list, and shelving the two theses microfiches at the library stack location specified in the index.

The Board then reviewed the law concerning public accessibility, with a particular focus on the indexing and cataloging of theses. In short, “where a reference is not catalogued in a meaningful way, its availability may not be sufficient to make the reference reasonably accessible to the public.”

In this case, the Board was “persuaded by Patent Owner that the rudimentary indexing of the Su

thesis by author name ('Su') and/or the first word of the title ('Continuous,' which is the only indexing that the evidence suggests may have occurred before the priority date and does not suggest its relevance to the streaming media network transport problem addressed by the '011 Patent) would not be sufficient to meet the applicable standard for public accessibility." The Board explained that "such indexing would not provide a meaningful pathway to a researcher who was not previously aware of the existence of the thesis and was searching by subject matter." Accordingly, the Board concluded that Petitioner did not meet "its initial burden of production of evidence establishing that Su is applicable as prior art." Because Su was cited as prior art in each of Petitioner's challenges, the Board declined to institute IPR.

Friendfinder Networks Inc. v. WAG Acquisition, LLC, IPR2015-01033

Paper 8: Decision – Denying Institution of Inter Partes Review

Dated: October 19, 2015

Patent: 8,327,011

Before: Michael P. Tierney, Donna M. Praiss, and Jo-Anne M. Kokoski

Written by: Kokoski

Related Proceedings: WAG Acquisition, LLC v. Sobonito Investments, Ltd., No. 2:14-cv-1661 (D.N.J.); WAG Acquisition, LLC v. Multi Media, LLC, No. 2:14-cv-2340 (D.N.J.); WAG Acquisition, LLC v. Data Conversions, Inc., No. 2:14-cv-2345 (D.N.J.) ; WAG Acquisition, LLC v. Flying Crocodile, Inc., 2:14-cv-2674 (D.N.J.); WAG Acquisition, LLC v. Gattyàn Group S.à r.l., No. 2:14-cv-2832 (D.N.J.); WAG Acquisition, LLC v. MFCXY, Inc., No. 2:14-cv-03196 (D. N.J.); WAG Acquisition, LLC v. FriendFinder Networks Inc., No. 2:14-cv-3456 (D.N.J.); and WAG Acquisition, LLC v. Vubeology, Inc., No. 2:14-cv-4531 (D.N.J.); IPR2015–0137; IPR2015–0137; IPR2015–0136

© 2025 Faegre Drinker Biddle & Reath LLP. All Rights Reserved.

National Law Review, Volume V, Number 296

Source URL: <https://natlawreview.com/article/friendfinder-networks-v-wag-acquisition-thesis-does-not-qualify-prior-art-ipr2015>