

Federal Circuit Affirms PTAB Allowance of New Evidence on Reply

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VidStream LLC v. Twitter, Inc., 981 F.3d 1060, 1064 (Fed. Cir. 2020).

Appeals from IPR2017-00829, IPR2017-00830.

Before: Newman, O'Malley, and Taranto

The Federal Circuit affirmed the PTAB's evidentiary ruling allowing an IPR petitioner to present new evidence of a reference's publication date on reply.

Twitter filed IPR petitions using a book by Bradford as the primary prior art reference against a patent with a 2012 priority date. The Bradford book contained both a copyright 2011 date and a "made" in 2015 date. In the patent owner's response, VidStream argued that the Bradford book did not qualify as prior art under 102(a) because of publication in 2015. On reply, Twitter submitted additional evidence of publication in 2011, including 1) the Bradford book's copyright registration certificate documenting publication in 2011, 2) a librarian declaration on public availability of the Bradford book in 2011 based on library MARC records, and 3) an Internet Archive website showing the book for sale in 2011. Twitter argued that the 2015 date indicates the date of reprint. The PTAB allowed the patent owner to file a sur-reply challenging the timeliness of the evidence. The Board found the Bradford book first published in 2011 and qualified as prior art. The Board also found the challenged patent invalid over the Bradford book and other secondary references.

On appeal, VidStream argued that the PTAB's rules required Twitter to include all of its evidence in its original petition because the 2018 PTO Trial Guide states that "Petitioner may not submit new evidence or argument in reply that it could have presented earlier." Trial Practice Guide Update, United States Patent and Trademark Office 14–15 (Aug. 2018), https://www.uspto.gov/sites/de-fault/files/documents/2018_Revised_Trial_Practice_Guide.pdf. Twitter responded that PTAB precedent allows a petitioner to introduce new evidence as a legitimate reply to evidence introduced by the patent owner. The Federal Circuit held that the PTAB's allowance of new evidence did not amount to an abuse of discretion. The Federal Circuit found the Board's actions appropriately permitted both sides to provide evidence in pursuit of the correct answer.

VidStream also argued that, even if the new evidence were admissible, the Board erred by failing to establish the publication date or public accessibility of the specific version of the Bradford book relied on by the petitioner. Based

on the collective evidence, the Federal Circuit affirmed the Board's finding that the Bradford book was publicly accessible in 2011.

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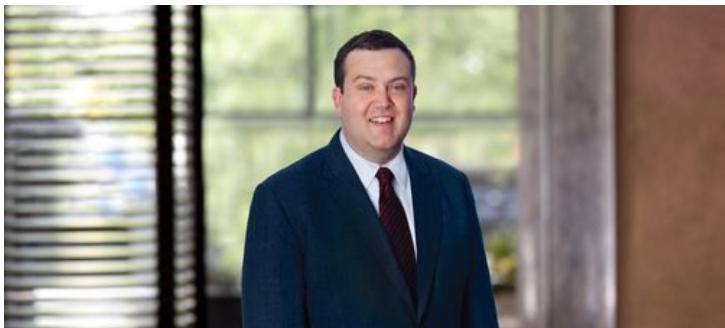
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