

Retweeting Sanity: Federal Circuit Holds that PTAB Properly Considered Reply Evidence of Prior Art Status

VidStream LLC v. Twitter, Inc., No. 2019-1734, (Fed. Cir. Nov. 25, 2020)

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The Court of Appeals for the Federal Circuit (the “CAFC”) [held](#) that the Patent Trial and Appeal Board (the “PTAB”) properly considered evidence submitted with the Petitioner’s reply supporting the prior art status of references relied upon in its petition for *inter partes* review. Thus, the CAFC upheld the PTAB’s determinations in favor of the petitioner, Twitter, Inc., that the claims of U.S. Patent No. 9,083,997, owned by VidStream LLC, were invalid as obvious.

The challenged patent was filed on May 9, 2012. The asserted prior art, several pages of a book (the “Bradford reference”) was submitted by Twitter with a copyright notice page indicating that copyright was registered in 2011. Following institution of *inter partes* review, Vidstream argued that the copy of the Bradford reference submitted with Twitter’s petition bore a publication date of December 13, 2015. On reply, Twitter advanced substantial evidence showing that copies of the reference were publicly accessible in 2011. These included a copy of the Bradford reference from the Library of Congress, the testimony of an expert in library cataloguing that it would have been publicly available and indexed no later than December 4, 2011, attorney testimony that the Library of Congress copy was identical in relevant part to that submitted with the petition, and two webpages archived by the Internet Archive’s Wayback Machine in 2011 showing the Bradford reference as available for purchase.

One might have expected this mountain of evidence to resolve the publication date dispute, but VidStream remained unsatisfied. Relying on the PTAB Trial Practice Guide’s statements that “petitioner’s case-in-chief” must be made in the petition, and that the “[p]etitioner may not submit new evidence or argument in reply that it could have presented earlier[.]” VidStream moved to exclude Twitter’s evidence as neither timely submitted nor probative because it did not pertain to the version of the Bradford reference submitted with the Petition. The PTAB and CAFC both rejected VidStream’s arguments, finding that Twitter was allowed to respond to VidStream’s challenge of its prior art with supporting evidence and that this evidence did properly corroborate the prior art status and public accessibility of the Bradford reference (which Twitter explained was a reprint).

Following in the wake of the PTAB’s precedential decision in [Hulu, LLC v. SoundView Innovations, LLC, IPR2018-01039, Paper 29 \(PTAB Dec. 20, 2019\)](#), which clarified the evidentiary standard for instituting post-grant proceedings on printed publication prior art, the CAFC’s decision in *Twitter* addresses the next step, confirming that reply evidence of public accessibility should be considered. It further confirmed that a reference’s prior art date in instituted post-grant proceedings does not depend upon when the specific copy submitted with the petition was published. This alleviates the expense and waste involved in submitting every possible piece of evidence of publication with the petition (before any real dispute materializes). The decision engenders confidence that post-grant proceedings turn upon the apparent correct answer in view of the totality of the evidence rather than on pedantic over-application of rules, guidelines, and evidentiary defects.