Filed on behalf of William Grecia
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE SYSTEMS INCORPORATED
Petitioner

v.

WILLIAM GRECIA
Patent Owner

Case No.: IPR2018-00419
Patent 8,533,860

PATENT OWNER'S PRELIMINARY RESPONSE

I. INTRODUCTION

Petitioner, Adobe Systems Incorporated (hereinafter, "Adobe"), admits that its Petition recycles a petition previously denied by this Board: the only difference between the two petitions is that Petitioner adds one reference here. Petition, 3-4 ("While this petition relies on some prior art references already presented to the Board in MasterCard's petition in IPR2017-00791, all proposed grounds in this petition rely on the *Venkataramu* reference . . . .").

Patent Owner, William Grecia, respectfully requests that the Board deny institution under 35 U.S.C. § 325(d) because Adobe failed to introduce evidence showing that the sole new prior art reference—*Venkataramu*—was publicly accessible as of the critical date.

II. FACTS

The following facts are taken from the Petition:

1. As of October 2, 2008, a student project report by Ramya Venkataramu titled "Analysis and Enhancement of Apple's FairPlay Digital Rights Management," (hereinafter, the "*Venkataramu* Report"), was stored on the San Jose State University web server. Petition, 36 (citing Ex. 1024).

2. A book citing the *Venkataramu* Report titled *Handbook of Research on Secure Multimedia Distribution*, by Shiguo Lian and Yan Zhang,

(hereinafter, the "Shiguo Lian Book"), has a 2009 copyright notice date. Ex. 1015.

3. A Library of Congress Online Catalog states that the Shiguo Lian Book was "Published/Created" in 2009. Ex. 1022.

III. ARGUMENT

A. Legal Framework

Pre-AIA law governs the Petition, and states "[a] person shall be entitled to a patent unless . . . b) the invention was . . . described in a printed publication in this . . . country . . . more than one year prior to the date of the application for patent in the United States . . . ." 35 U.S.C. § 102(b) (1952).

"To qualify as a printed publication, a reference 'must have been sufficiently accessible to the public interested in the art.'" *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989)). "A reference will be considered publicly accessible if it was 'disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.'" *Id.* (quoting *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008)).

Finally, "[p]ublic accessibility is a legal conclusion based on underlying factual determinations." *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012).

B. Adobe Fails to Prove that the *Venkataramu* Report Was Publicly Accessible Before the Critical Date of March 21, 2009.

Adobe asserts the *Venkataramu* Report was publicly accessible because it was saved on a web server on October 2, 2008. Ex. 1024 (Butler Aff.), ¶ 5 ("The Internet Archive assigns a URL on its site to the archived files"); *see also id.*, Ex. A (displaying a copy of a printout showing an archived file dated October 2, 2008).

A student's paper saved on the Internet is *not* a "printed publication" under section 102(b). *Blue Calypso*, 815 F.3d at 1348. In *Blue Calypso*, the Federal Circuit affirmed the PTAB's determination that the petitioner failed to establish "that an interested party exercising reasonable diligence would have located [the reference]." *Id.* at 1349.

Mere presence on a web server was not enough, and the Federal Circuit noted that the petitioner failed to produce evidence showing that the student paper was viewed or downloaded, or that one of ordinary skill "would be independently aware of the web address" where the paper was posted. *Id.*

The *Blue Calypso* petitioner argued that a search engine would have uncovered the paper, but the Federal Circuit confined itself to the record. *Id.*

at 1350. ("The record is devoid of any evidence that a query of a search engine before the critical date, using any combination of search words, would have led to [the reference] appearing in the search results.").

Here, Adobe's only evidence is a single private web server backup. Such evidence lacks the necessary basis to hold that one of ordinary skill, exercising reasonable diligence, would have located the *Venkataramu* Report before the critical date, March 21, 2009. Adobe also does not show that the *Venkataramu* Report was viewed or downloaded before March 21, 2009. Petition, 36. Nor does Adobe show or attempt to show that an interested party would have been independently aware of the San Jose State University website as of March 21, 2009. *Id.* Adobe further fails to produce evidence showing that before March 21, 2009, one of ordinary skill could have—with reasonable diligence—discovered the *Venkataramu* Report through queries in a search engine. *Id.*

The Federal Circuit rejected the argument that a reference must be searchable on the Internet as an "absolute prerequisite." *Voter Verified*, 698 F.3d at 1380. In *Voter Verified*, the Federal Circuit affirmed the district court's holding that the reference was publicly accessible before the critical date and therefore prior art under section 102(b). *Id.* Although the record there failed to establish that the reference was searchable on the Internet, the Federal

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