The Application of “Authentication by Comparison” at the PTAB

直接针对美国联邦巡回上诉法院在专利审查与上诉委员会（PTAB）的程序中应用和操作联邦规则证据的直接应用，美国联邦巡回上诉法院部分维持、部分撤销了两起专利复审（IPR）决定，批评PTAB拒绝考虑专利挑战者所依赖的一个特定论据的本因在于未能认证。


PTAB发现，IPR申请人Valve Corporation未能证明几个被指控的专利基于一份未认证的文献《Burns文章》不具有专利性。《Burns文章》是一份2010年在线Xbox 360控制器的评论文章。Simon Burgess，该专利的共发明人之一，通过提供测试控制器给Dave Burns（他为一家在线游戏杂志工作）来协助文章的出版。

PTAB决定，IPR申请人Valve Corporation未能证明几个被指控的专利基于一份未认证的文献《Burns文章》不具有专利性。《Burns文章》是一份2010年在线Xbox 360控制器的评论文章。Simon Burgess，该专利的共发明人之一，通过提供测试控制器给Dave Burns（他为一家在线游戏杂志工作）来协助文章的出版。
promotional purposes. Valve appealed the Board’s decision.

Valve argued that the Burns article copy submitted in connection with the IPR (the Exhibit) was merely a printout of the same online article cited and enclosed in the prosecution histories of the challenged patents, as well as another of Ironburg’s patents directed toward similar subject matter. The Board concluded that Valve failed to show that the Exhibit was the same version of the Burns article that appeared in the prosecution history and that it was not obligated to compare the documents in the absence of testimony from Valve that the two were identical. Valve appealed.

In reviewing the Board’s decision, the Federal Circuit first referred to the principles of authentication by comparison under Fed. R. Evid. 901(b)(3), which permits authentication of a document by a comparison with an authenticated specimen “by an expert witness or the trier of fact.” While the Court did note a discrepancy in the dates shown in the Exhibit and in the Burns article in one of the prosecution histories, the Court found that the difference in dates did not bear on the subject matter being disclosed, which was “virtually identical” between the two, as well as identical to the version of the same article in the other two relevant file histories. The Court held that the Board was obligated to perform this comparison and erred by failing to do so.

After determining that the Exhibit was “substantively the same” as the versions of the Burns article from the relevant prosecution file histories, the Court addressed the question of whether the Exhibit was a printed publication under 35 U.S.C. § 102(a)(1). The Board found “overwhelming evidence” that the Burns article was accessible prior to the critical date of the patents at issue, based in significant part on the fact that Mr. Burgess had provided a controller to Mr. Burns with the purpose of a “dialogue with the intended audience,” an indicia of public accessibility. The Board also noted its agreement with district courts that have taken judicial notice of the contents of webpages available through the internet archive known as the Wayback Machine (the internet archive from which the Burns article was retrieved).

The Federal Circuit thus reversed the Board’s determination that the Burns article was not authenticated (and hence not prior art) and remanded to the Board for consideration of Valve’s arguments based on the Burns article.

© 2021 McDermott Will & Emery

National Law Review, Volume XI, Number 238

Source URL: https://www.natlawreview.com/article/application-authentication-comparison-ptab