

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOPCON MEDICAL SYSTEMS, INC. AND
TOPCON HEALTHCARE SOLUTIONS, INC.,
Petitioner

v.

CARL ZEISS MEDITEC, INC.,
Patent Owner

IPR2021-00452
Patent 9,968,251 B2

Before BRYAN F. MOORE, ELIZABETH M. ROESEL, and
AMBER L. HAGY, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

A. Background

Topcon Medical Systems, Inc. and Topcon Healthcare Solutions, Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–7, 10–15, 18–23, and 26–30 (“the challenged claims”) of U.S. Patent No. 9,968,251 B2 (Ex. 1001, “the ’251 patent”) pursuant to 35 U.S.C. §§ 311–319, along with the supporting Declaration of Dr. Milan Sonka. Paper 1 (“Pet.”); Ex. 1006. Carl Zeiss Meditec, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). With authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 11 (“Pet. Reply”)), with Patent Owner filing a Sur-Reply which incorporates a Motion to Strike (Paper 12 (“PO Sur-reply”)), and Petitioner filing a Sur-Reply directed to Patent Owner’s Motion to Strike (Paper 13 (“Pet. Sur-reply”)).

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons that follow, we determine that Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. For the reasons set forth below, and pursuant to 35 U.S.C. § 314, we do not institute

¹ Petitioner identifies Topcon Corporation as the parent of both entities. Pet. 2.

an *inter partes* review of claims 1–7, 10–15, 18–23, and 26–30 of the '251 patent.

B. Related Proceedings

At the time of the Petition filing, Petitioner indicated *Carl Zeiss Meditec, Inc. v. Topcon Medical System, Inc., et al.*, Case No. 4:19-cv-04162-SBA (N.D. Cal.) involved the '251 patent. Pet. 2; Paper 4, 1 (“Notices”). On August 21, 2020, the court dismissed Patent Owner’s patent infringement claims in view of the regulatory safe harbor of 35 U.S.C. § 271(e)(1). Pet. 2 (citing Ex. 1029).

C. The '251 Patent

The '251 patent is titled “Combined Structure-Function Guided Progression Analysis” and issued on May 15, 2018, from an application filed on September 30, 2016. Ex. 1001, codes (22), (45), (54).

The '251 patent is directed to “displaying combined [ophthalmologic] structural and functional progression information to a user.” Ex. 1001, 1:6–8. “In particular, the invention discloses various methods of displaying optical coherence tomography (OCT) and visual field exam information together on the same screen or viewport, so that their respective progression can easily be compared to each other and assessed.” Ex. 1001 at 1:8–12. Figure 4, reproduced below, exemplifies a side-by-side display of structural and functional data described in the claims.

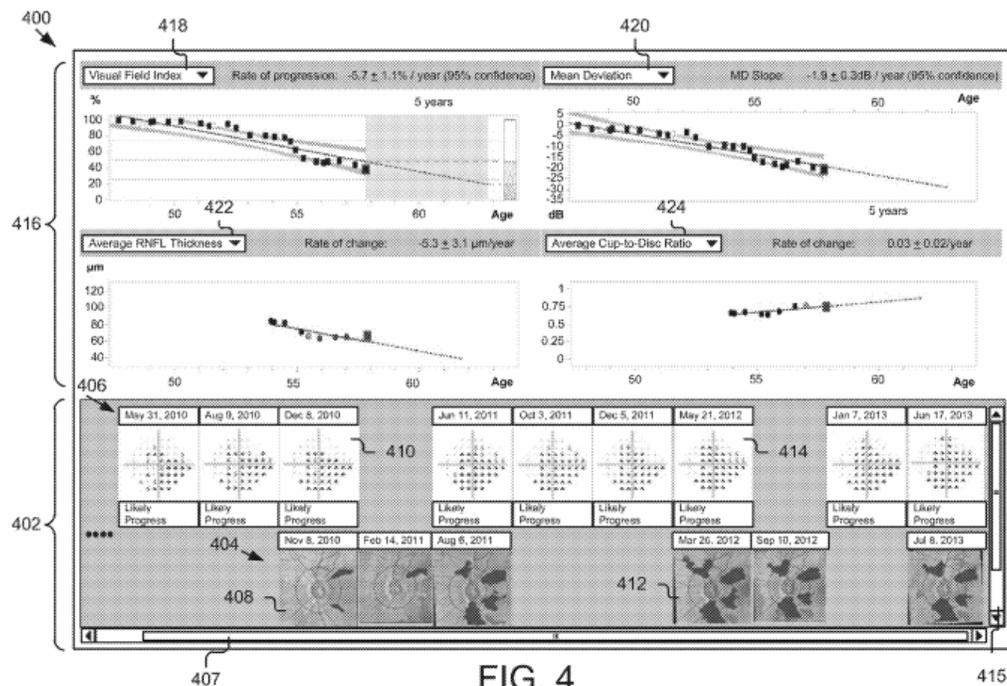


FIG. 4

Figure 4, reproduced above, reflects an exemplary graphical user interface of an integrated structural and functional disease progression information of an eye in which there are structural measurements (measured by OCT), i.e. item number 422 and functional measurements (visual field, measured by HFA), i.e. item number 418. Ex. 1001, 3:21–23, 5:36–39, 5:65–6:1, 7:37–41. In addition to presenting functional and structural measurements over time, Figure 4 also discloses the presentation of functional and structural metrics presented in a similar side-by-side format. Ex. 1001, Fig. 4, 7:34–41. For example, in the upper left of Figure 4 there is a trend line of OCT-derived metrics over time side-by-side with a trend line of visual field (HFA-derived) metrics over time.

Challenged claims 1, 12, and 21 of the '251 patent are independent. Claim 1, an illustrative independent claim of the '251 patent, is reproduced below, with sub-paragraphing added to the limitations for reference purposes.



1. [pre] A method of displaying combined structural and functional disease progression information of a patient's eye, said method comprising:

[a] receiving a set of structural measurements of the patient's eye, said set of structural measurements taken at a plurality of testing dates;

[b] receiving a set of functional measurements of the patient's eye, said set of functional measurements taken at a plurality of testing dates;

[c] generating a single viewport comprising a side by side display of structural and functional measurements over a common time scale, wherein each of the structural and functional measurements in the generated viewport has a testing date falling within the common time scale; and

[d] displaying the generated single viewport or storing results of the generated single viewport.

Ex. 1001, 11:7–25.

D. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–7, 10–15, 18–23, and 26–30 of the '251 patent on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)
1–7, 10, 12–14, 18–23, 26–28, 30	102	Abe ²
1–7, 10–15, 18–23, 26–30	103	Abe, Coelho ³
1–7, 10–15, 18–23, 26–30	103	Abe, Ono ⁴

Pet. 4.

² Ricardo Y. Abe, “The Relative Odds of Progressing by Structural and Functional Tests in Glaucoma,” *Investigative Ophthalmology & Visual Science (IOVS)* (Vol. 57, No. 9) (July 2016). Ex. 1003.

³ US Pub. No. 2014/0293222 A1, published October 2, 2014. Ex. 1004.

⁴ Japanese Pub. No. 2016-101297, published June 2, 2016. Ex. 1005.

III. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art would have “at least a bachelor’s degree in engineering or computer science or a related discipline, and at least two years of experience working on an interdisciplinary team of software developers and ophthalmologists.” Pet. 8.

Patent Owner asserts one of ordinary skill would have “a bachelor’s degree in computer science, computer engineering, electrical engineering, or biomedical engineering, and at least 2 years of experience in the development of software/systems which provide graphical/multimedia displays to users. Alternatively, such a person could have a Master’s degree in computer science, computer engineering, electrical engineering, or biomedical engineering and at least 1 year of such experience.” Prelim. Resp. 16.

Patent Owner argues that “not all engineering disciplines are relevant . . . [and] working on an interdisciplinary team of software developers and ophthalmologists is not necessary to understand the benefits of creating a software for presenting medical data in an enhanced manner that allows doctors to track the progression of a disease.” Prelim. Resp. 16. Petitioner’s declarant asserts “the ’251 patent is expressed at a highly general level, and the claimed inventions are stated at a level that is easily grasped by a person at the skill level proposed by” Patent Owner. Ex. 1006 ¶ 13. Accordingly, for purposes of this decision, we adopt Patent Owner’s characterization of the level of ordinary skill, which we determine is consistent with the ’251 patent written description and the asserted prior art.

B. Claim Construction

The Board interprets claim terms in accordance with the standard used in federal district court in a civil action involving the validity or infringement of a patent. *See* 37 C.F.R. § 42.100(b) (2020). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Because, as explained below, we determine that Petitioner has not shown sufficiently that Abe’s figures and tables are prior art, we determine that it is not necessary to provide an express interpretation of any terms of the claims. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

C. Legal Background

A claim is anticipated if a single prior art reference either expressly or inherently discloses every limitation of the claim.

Motor Am., 605 F.3d 967, 975 (Fed. Cir. 2010). Although the elements must be arranged or combined in the same way as in the claim, “the reference need not satisfy an ipsissimis verbis test,” i.e., identity of terminology is not required. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990)) (emphasis omitted).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when presented, objective evidence of nonobviousness.⁵ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

*D. Alleged Anticipation of Claims 1–7, 10, 12–14, 18–23, 26–28, and 30
by Abe*

Petitioner contends that claims 1–7, 10, 12–14, 18–23, 26–28, and 30 are anticipated by Abe. Pet. 14–65. Patent Owner opposes. *See generally* Prelim. Resp.

We address the evidence and arguments presented.

⁵ Patent Owner presents no objective indicia in the Preliminary Response. *See generally* Prelim. Resp.

1. Prior Art status of Abe (Ex. 1003)

Patent Owner argues that Petitioner does not demonstrate that Abe is prior art. Prelim. Resp. 16–37. Patent Owner, thus, contests whether Abe is a prior art “printed publication” in accordance with 35 U.S.C. §§ 102 and 311(b). *Id.*

a. Motion to Strike

Patent Owner moves to strike evidence presented by Petitioner relevant to determining whether Abe is a prior art “printed publication.” PO Sur-reply 8–10. This evidence includes a Declaration (Ex. 1031) of Debra Chin and related portions of Petitioner’s Reply. *Id.* Because, as explained below, we find Petitioner has not shown Abe is a prior art “printed publication” even if we consider the Chin Declaration and the related parts of Petitioner’s Reply, we dismiss Patent Owner’s Motion to Strike as moot.

b. Principles of Law

“[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). “The determination of whether a document is a ‘printed publication’ under 35 U.S.C. § 102 ‘involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.’” *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir.

2018) (citing *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004)). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been 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.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)).

“If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.” *Jazz Pharms., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356 (Fed. Cir. 2018) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988)).

Although Patent Owner challenges whether Abe is a printed publication, the burden remains on Petitioner to demonstrate unpatentability. *Hulu*, IPR2018-01039, Paper 29 at 16. (“[T]he burden is on the petitioner to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent.”) (emphasis added); see also *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in an *inter partes* review). At the institution stage, Petitioner must present evidence sufficient to establish a reasonable likelihood that the challenged claims are unpatentable, and one aspect of such a showing is that the references relied upon are patents or printed publications. See 35 U.S.C. §§ 311(b), 314(a).

c. Background

Patent Owner contends that Abe is not prior art under 35 U.S.C. § 102(b) because Petitioner failed to demonstrate that Abe was publicly accessible. Prelim. Resp. 16–37. In particular, Patent Owner argues that Petitioner relies on Figure 3 of Abe for each of the grounds in its Petition but Petitioner has not shown “the figures and tables of Abe Ex. 1003, including Fig. 3, were publicly available prior to the effective date, and Petitioner’s declarant from the Internet Archive unequivocally confirms this.” *Id.* at 13. Additionally, Patent Owner argues “the face of the Abe reference in Ex. 1003 does not provide any publication date” and the year of publication “fail[s] to establish that Abe Ex. 1003 qualifies as prior art, because the ’251 [p]atent was filed on September 30, 2016, and Abe Ex. 1003 would not qualify as prior art if it were published in October, November, or December of 2016.” *Id.* at 22–23.

Abe is a research article titled “The Relative Odds of Progressing by Structural and Functional Tests in Glaucoma.” Ex. 1003, Cover Page. The document contains the notation, “Submitted: December 14, 2015 Accepted: March 30, 2016” and “IOVS | Special Issue | Vol. 57 | No. 9 | OCT422.” *Id.* at 1, 2. Investigative Ophthalmology & Visual Science (IOVS) is an online official journal of the Association for Research in Vision and Ophthalmology (ARVO). Ex. 1027. Petitioner provides an Internet Archive record and affidavit purporting to show that the article was publicly available as a printed publication by at least July 18, 2016. Pet. 14 (citing Ex. 1026 at 1, 4–5) (showing the article was archived by the Internet Archive on July 18, 2016, at 6:51:25 pm at the URL: <<http://iovs.arvojournals.org/Article.aspx?articleid=2536014>>). The

Internet Archive version of Abe appears to be dated about two months prior to the effective filing date of the '251 patent (i.e. September 30, 2016 (Ex. 1001, code (22))).

d. Petitioner Relies on Figure 3

Petitioner relies heavily on Figure 3 of Abe for each of its grounds. Claim 1 recites “generating a single viewport comprising a side by side display of structural and functional measurements . . . ; and displaying the generated single viewport.” Ex. 1001, 11:18–20, 11:24. The other independent claims 12 and 21 also recite substantially the same elements of a single view port comprising a side-by-side display of structural and functional measurements and displaying the generated viewport. For these elements, the Petition relies *exclusively* on Figure 3 of Abe (Ex. 1003) and does not mention any other portion of Abe for that element, in any of the independent claims. Pet. 19–21, 29–32, 34–35.

Accordingly, for at least the “generating a single viewport comprising a side by side display” step of each independent claim, Petitioner’s position depends entirely on whether it has established a reasonable likelihood that Figure 3 of Abe (Ex. 1003) qualifies as prior art. Similarly, for the “displaying the generated single viewport” step of claims 1, 12, and 21, Petitioner again relies exclusively on Figure 3 of Abe (Ex. 1003) for the “viewport” limitation, and does not mention any other portion of Abe (Ex. 1003) as disclosing or teaching a “viewport.” *See id.* at 22, 30, 35.

e. Internet Archive Evidence

Petitioner asserts, “The [Abe] article (including its Figure 3), . . . was stored on the Internet by July 2016, as confirmed by the Internet Archive.” Pet. 22 (citing Ex. 1026). Patent Owner asserts that “Petitioner relies on the

declaration of Ms. Elizabeth Rosenberg (Ex. 1026), who cites a *text* version *without any of the figures or tables* as shown in the August 2020 version of Abe Ex. 1003.” Prelim. Resp. 20. Specifically, Patent Owner asserts “as indicated with the screenshot [reproduced below] taken from p. 9 of Ms. Rosenberg’s declaration, Fig. 3 was ‘*Not Available*’ to the public on July 18, 2016.” Reproduced below is an excerpt from Ex. 1026 showing the indication that Figure 3 is not available.



Reproduced above is an excerpt from Ex. 1026 showing the title “Figure 3” but below showing a broken link icon and the words “Image Not Available” and below that links to “View Original” and “Download Slide. Ex. 1026, 9.” Because Figure 3 is not available in Ex. 1026, Patent Owner asserts Petitioner has not shown that Abe qualifies as a prior art printed publication under AIA 35 U.S.C. § 102(a). Prelim. Resp. 14. Patent Owner relies on *Guardian Alliance* for the proposition that, when the Internet Archive provides a non-working link to content, that content cannot be found to be publically available. *Guardian Alliance Techs., Inc. v. Tyler Miller*, IPR2020-00031, Paper 23 at 16–17 (PTAB Mar. 26, 2020).

Petitioner accepts that the image of Figure 3 was not captured by the Internet Archive but argues that “Patent Owner ignores that in order for the image of Figure 3 to be unavailable *it must first exist*.” Pet. Reply 7. In our view, the relevant question is not whether Abe’s figures and tables *existed* in July 2016. Instead, Petitioner has the burden to show that they were publicly

accessible before the critical date, i.e., that before September 30, 2016, a person of ordinary skill in the art would have been able to view the figures and tables, for example, by clicking on operable links that led to the figures and tables.

Lacking direct evidence that the tables and figures were publicly accessible, Petitioner presents circumstantial arguments. In particular, Petitioner asserts “Abe was accepted by IOVS on March 30, 2016, halting further edits to the article [and thus,] Abe’s figures existed as of March 30, 2016.” *Id.* (citing Exs. 1003, 1026). Petitioner provides no evidence to support this attorney argument. Petitioner also points out that both the current and Internet Archive versions of Abe contain “*identical* descriptions of Figure 3 . . . describing an ‘example of an eye of a glaucoma patient’ with a specific disease progression.” Pet. Reply 5 (quoting Ex. 1003 6; Ex. 1026, 9). Thus, according to Petitioner, “Figure 3’s description does not suggest that it was updated after July 18, 2016 to provide additional data about that specific patient, nor does it suggest ongoing revisions.” *Id.*

Petitioner misses the point. The issue before us is whether there were operable links not just to Abe’s text but also to Abe’s figures and tables before the critical date. Petitioner’s evidence (e.g., the version captured by the Wayback Machine in the Internet Archive) does not show that Figure 3 was available before the critical date. This may be because bringing up the figures requires clicking another link, but there is no evidence in the record demonstrating, for example, whether the links were functioning at any time prior to the critical date.

The only alleged source for Abe before the critical date is the Internet; Petitioner has not asserted that a hard copy of the article was publicly

disseminated. Pet. 14–15. Thus, Petitioner bears the burden to prove that the *entire* article was available on the Internet prior to the critical date, not just the text. As explained above, Petitioner’s evidence from the Internet Archive depicts a version of Abe that is different than Exhibit 1003 in the record at least as to the fact that figures and tables are not included in the Internet Archive version. Compare Ex. 1003, with Ex. 1026.⁶

This difference goes to the heart of Petitioner’s invalidity argument because, as explained above, Petitioner relies almost exclusively on Figure 3 of Abe to support its invalidity challenges as to at least the limitations of “generating a single viewport” and “displaying the generated single viewport.” Pet. 19–22, 29–32, 34–35. Thus, on the present record, we do not credit the Internet Archive materials as sufficient evidence of publication of the entirety of the Abe reference, including at least Figure 3, more than one year before the September 2016 filing date of the ’251 patent.

Petitioner also cites to *Coriant (USA)* for the proposition that “[f]or established publishers, demonstrating a date of publication is alone sufficient for showing [public] accessibility.” *Coriant (USA) Inc. v. Oyster Optics, LLC*, IPR2018-00258, Paper 13 at 11 (PTAB June 6, 2018). *Coriant* involved an article published by IEEE, which the Board has recognized as a well-established publisher. See *id.* (citing *Ericsson Inc. v. Intellectual Ventures I LLC*, Case IPR2014-00527, slip op. at 10–11 (PTAB May 18, 2015) (Paper 41)). Regardless of whether the Association for Research in Vision and Ophthalmology & Vision Science (the publisher of IOVS) is a

⁶ We note that Exhibit 1003 appears to be a pdf version of Abe that is also different from Exhibit 1026 because it has the heading “Special Issue” in blue that does not appear on the Internet Archive version (Ex. 1026).

well-established publisher among those in the interested public, Petitioner has not shown that Figure 3 was available prior to the critical date. *See* Ex. 1031 ¶ 1.^{7, 8}

f. Indicia of Publication do not Cure the Deficiency in the Internet Archive Evidence

Petitioner relies on multiple conventional indicia of publication and public accessibility on the face of Abe, as volume and page numbers, year of publication, a link to the journal’s website, the ISSN, article submission and approval dates, and author contact information, all of which are relevant evidence supporting a finding of public accessibility. Ex. 1003, 1, 2; *see also Hulu*, Paper 29 at 17–18 (“We do not hold that any particular indicia per se is sufficient at the institution stage. Rather, the indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the evidence.”); *Nobel Biocare Services AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1376 (Fed. Cir. 2018) (“Although the ABT Catalog’s date is not dispositive of the date of public accessibility, its date is

⁷ Petitioner cites Exhibit 1027 for the proposition that “IOVS is a journal that could be located by those interested in ophthalmology or the visual sciences” and is ‘#1 of 60’ in total citations in the Ophthalmology field.” Pet. Reply 6. Exhibit 1027 does not, however, show that Figure 3 of Abe could have been located by persons of ordinary skill in the art before the critical date.

⁸ Patent Owner also argues “Petitioner does not even allege that the relevant community of the POSITA, under its own definition, would be interested in IOVS articles, and instead points to an entirely different community (‘ophthalmology or the visual sciences’).” PO Sur-reply 6. We do not rely on this argument because, for other reasons, we determine that Petitioner has not met its burden of showing that the entirety of Abe, including Figure 3, is prior art.

relevant evidence.”); *see also VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065 (Fed. Cir. 2020) (“When there is an established publisher there is a presumption of public accessibility as of the publication date.”).⁹

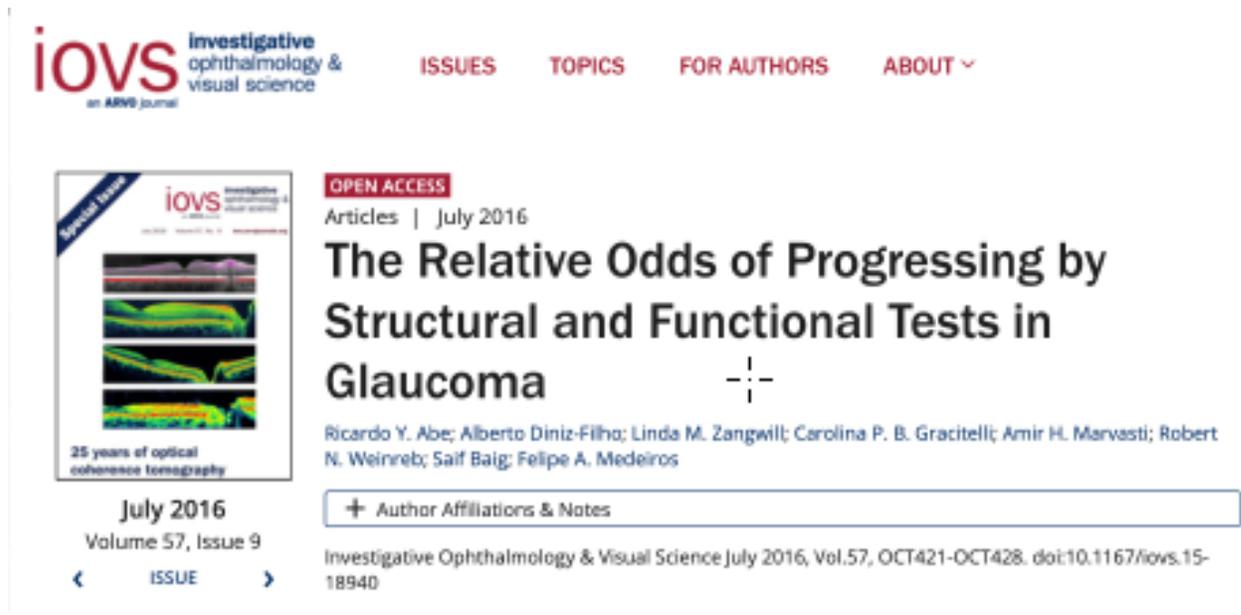
Petitioner also asserts that “IOVS published this specific volume and issue in July 2016 [thus,] *it was* available.” Pet. Reply 5 (footnote omitted). In support of this statement, Petitioner cites to an Internet link that provides past publications of IOVS journals. *Id.* at 5, n.2. Petitioner does not explain this link or provide any evidence such as screen shots of this website. We do not discern that this unexplained current link to a website that purports to contain a copy of a journal dated years earlier is sufficient to show it “*was available*” on a particular date. *See* PO Sur-reply 5¹⁰

There is no “publication date” on Exhibit 1003. The only dates shown on the face of the Exhibit 1003 version of Abe are a submission date (2016) and the date it was downloaded from the Internet by Petitioner (in 2020). The download date is well after the priority date of the challenged patent and the mere submission to an academic journal and acceptance by that journal is insufficient to establish public accessibility to render the article a printed publication for prior art purposes. *Cf. In re Lister*, 583 F.3d 1307, 1316–17 (Fed. Cir. 2009) (holding that a manuscript was not a “printed publication” even though it was registered with the Copyright Office and available for inspection by visitors to that office).

⁹ Patent Owner also asserts the indicia on the face of Exhibit 1003 are hearsay but because we do not find this evidence persuasive to show public accessibility of Abe we do not address this argument. PO Sur-reply 5.

¹⁰ Patent Owner also asserts the link is hearsay but we do not rely on that argument. PO Sur-reply 5.

An excerpt of Exhibit 1026, reproduced below, shows that the Abe article stored in the Internet Archive contained an indication that it was in the “July 2016” issue of IOVS. Ex. 1026.



The excerpt of Exhibit 1026 reproduced above indicates that this version of Abe was in a “July 2016” issue of IOVS.¹¹ Nevertheless, the copy of Abe included in Exhibit 1026 is not a complete copy because it is missing, among other things, the critical Figure 3.

g. Petitioner’s Reply Evidence of Public Accessibility does not Cure the Deficiency in the Internet Archive Evidence

Petitioner offers a declaration with its Reply to support its contention that Abe was publicly accessible. Pet. Reply 3–7, 9. Specifically, Petitioner provides a declaration of Debra L. Chin, Manager for the entity that publishes IOVS. Pet. Reply 7; Exhibit 1031. Ms. Chin, the Journals Manager at the Association for Research in Vision and Ophthalmology &

¹¹ This is consistent with a current version of the IVOS website cited in Petitioner’s Reply, but was not entered into the record in the Petition or Petitioner’s Reply. See Reply 5, n.2.

Vision Science (“ARVO”), states she is aware of the Abe article in question. Ex. 1031 ¶¶ 1, 2. Ms. Chin states in conclusory fashion that “the full article . . . including both text and figures—was published in IOVS on July 13, 2016.” *Id.* ¶ 3. Ms. Chin bases this assertion on the “the records [she] kept in 2016” and the fact that “we had stopped doing ‘publish ahead of print’ more than a year earlier, July 13, 2016, is the only publication date for this article.” *Id.*

The probative value of routine business practice to show the performance of a specific act has long been recognized. *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986) (citations omitted). “Evidence of routine business practice can be sufficient to prove that a reference was made accessible before a critical date.” *Constant v. Advanced Micro–Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988). However, in this case, Petitioner does not provide the records Ms. Chin references nor does Petitioner provide an explanation to show whether Ms. Chin is stating that she remembers it being published on that date by personal knowledge (refreshed by “records”) or by the standard practice of publishing by a certain date.

Ms. Chin does not explain, for example, why Figure 3 of the Abe article would have been available on the publisher’s website on that date nor does she tie her knowledge to the website records produced in Exhibit 1026 from the Internet Archive. Additionally, Ms. Chin does not explain how she knows that the copy that was allegedly published in July 2016 is the same copy cited at Exhibit 1003; in fact, she appears to merely assume that is the case by citing the Abe article by its title rather than referring to any particular copy of Abe. *See* Ex. 1031 ¶ 2. Petitioner fails to file the records that Ms. Chin used to refresh her recollection regarding the publication date,

and does not offer any evidence to support Ms. Chin's assertion that the figures and tables were published in July 2016 besides a conclusory reference to documents that are not part of the record before us. As discussed above, Ms. Chin's testimony is not supported by Petitioner's Internet Archive evidence, which fails to show that the figures and tables were publicly accessible in July 2016.

h. Conclusion

Petitioner does not make a sufficient showing of dissemination or public accessibility of the entirety of the Abe reference. In particular, Petitioner does not show sufficiently for institution that the entirety of the Abe reference, including Figure 3, was publicly accessible before the critical date of the '251 patent.

2. Independent Claims 1, 12 and 21

Petitioner's challenges to independent claims 1, 12 and 21 each rely on Figure 3 of Abe to show the "generating a single viewport comprising a side by side display . . ." and "displaying the generated single viewport" step of each independent claim and we determine Petitioner has not shown the entirety of Abe, including Figure 3, to be prior art. Pet. 4. Thus, on this record, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 1, 12, and 21 are anticipated by Abe.

3. Dependent Claims 2–18, 20–34

Petitioner's challenges to claims 2–7, 10, 13, 14, 18–20, 22, 23, 26–28, and 30 both rely on Figure 3 of Abe to show the "generating a single viewport comprising a side by side display . . ." and "displaying the generated single viewport" step of each independent claim and we determine

Petitioner has not shown the entirety of Abe, including Figure 3, to be prior art. Pet. 4. Thus, on this record, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 2–7, 10, 13, 14, 18–20, 22, 23, 26–28, and 30 are anticipated by Abe.

E. Alleged Obviousness of Claims 1–7, 10–15, 18–23, and 26–30 Over Abe and Coelho

Petitioner contends that claims 1–7, 10–15, 18–23, and 26–30 would have been obvious over the combination of Abe and Coelho. Pet. 38–52. To support its contentions, Petitioner provides explanations as to how Abe and Coelho teach each claim limitation. *Id.*

Petitioner does not argue that Coelho alone meets all the limitations of the challenged claims and thus, because Figure 3 of Abe, which is relied on to show the “generating a single viewport comprising a side by side display . . .” and “displaying the generated single viewport” step of each independent claim, has been not shown to be prior art, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 1–7, 10–15, 18–23, and 26–30 would have been obvious over the combination of Abe and Coelho.

F. Alleged Obviousness of Claims 1–7, 10–15, 18–23, and 26–30 Over Abe and Ono

Petitioner contends that claims 1–7, 10–15, 18–23, and 26–30 would have been obvious over the combination of Abe and Ono. Pet. 52–65. To support its contentions, Petitioner provides explanations as to how Abe and Ono teach each claim limitation. *Id.*

Petitioner does not argue that Ono alone meets all the limitations of the challenged claims and thus, because Figure 3 of Abe, which is relied on

to show the “generating a single viewport comprising a side by side display . . .” and “displaying the generated single viewport” step of each independent claim, has not shown to be prior art, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 1–7, 10–15, 18–23, and 26–30 would have been obvious over the combination of Abe and Ono.

IV. CONCLUSION

Taking account of the information presented in the Petition, the Preliminary Response, the Reply, Patent Owner’s Sur-reply, and Petitioner’s Sur-reply, for reasons stated above, we determine that Petitioner has not shown a reasonable likelihood of prevailing at trial with respect to any challenged claim of the ’251 patent.

V. ORDER

Accordingly, it is:

ORDERED that the Petition is denied and no trial is instituted.

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