IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

INTELLECTUAL VENTURES II LLC,	§	
	§	
Plaintiff,	§	Case No. 2:17-cv-00662-JRG-RSP
	§	
v.	§	
	§	
SPRINT SPECTRUM, L.P. ET AL,	§	
	§	
Defendants.	§	

REPORT AND RECOMMENDATION

Before the Court is Defendants' Motion for Partial Summary Judgment that Certain Disputed References are Prior Art. (Dkt. No. 305.) Three groups of references are discussed in the Motion: 1) the Yang reference; 2) the Hwang and Liebetreu references; and 3) the CATT and LG references. After consideration, the Court concludes that the Motion should be GRANTED IN PART. The Motion should be GRANTED with respect to the Yang reference, but the Motion should be DENIED for the other references as factual questions remain as to the public accessibility of the references.

I. Applicable Law

"Whether a reference qualifies as a printed publication under § 102 is a legal conclusion based on underlying fact findings," and one important fact question that should be considered is public accessibility. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018) (citing *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356 (Fed. Cir. 2018)). "A reference is 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 *Jazz Pharm., Inc*., 895 F.3d at 1356).

Several factors are used such as how widely circulated the reference was, whether the reference was indexed in a manner that would have made it accessible to interested persons with a reasonable degree of effort, and whether the reference was distributed with a pledge or understanding that the contents would remain confidential. *Erfindergemeinschaft UroPep GbR v. Eli Lilly & Co*., Case No. 2:15-cv-1202-WCB, 240 F.Supp.3d 605, 620 (E.D. Tex. 2017). Other courts have noted factors such as the expertise of the target audience. *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1382 (Fed. Cir. 2018).

In *Acceleration Bay*, the Federal Circuit concluded that the Patent Trial and Appeal Board ("PTAB") did not err in concluding that certain publications were not publicly accessible even when those publications were placed on a library's website because the publications were "not indexed in a meaningful way" and that "the website's advanced search form was deficient." *Acceleration Bay*, 908 F.3d at 773. In making its decision, the PTAB stated that the evidence presented "suggests that an artisan might have located [the relevant publication] by skimming through potentially hundreds of titles in the same year . . . ." *Id*.

Summary judgment is only proper when "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). Any evidence must be viewed in the light most favorable to the nonmovant. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (citing *Adickes*

v. S.H. Kress & Co., 398 U.S. 144, 158–59 (1970)). "As a general rule, summary judgment is inappropriate where an expert's testimony supports the non-moving party's case." *Vasudevan Software, Inc. v. MicroStrategy, Inc*., 782 F.3d 671, 683 (Fed. Cir. 2015).

II. Yang Reference

Plaintiff stated that it will not contest the public accessibility of the Yang Reference. (Dkt. No. 343 at 2.) Because of this, the Court concludes that Yang was publicly accessible before the priority date, so Defendants' Motion should be GRANTED with respect to the Yang reference.

III. Hwang and Liebetreu References

Defendants, with the exception of Nokia ("applicable Defendants"), move for summary judgment arguing that the Hwang and Liebetreu references qualify as prior art to U.S. Patent No. 8,953,641 ("'641 Patent"). The applicable Defendants argue that the Hwang and Liebetreu references are submissions to the March 2004 IEEE 802.16 Working Group Session #30 meeting. (Dkt. No. 305 at 1.) The applicable Defendants assert that Hwang and Liebetreu references were publicly accessible by March 15, 2004 at the latest and that the references are therefore prior art to the '641 Patent, which has a priority date of May 1, 2004. (*Id*.)

The Court concludes that summary judgment should be DENIED for these two references because fact questions remain as to whether the Hwang and Liebetreu references were publicly accessible before the relevant priority date. Both references were filed on a website with somewhere between 4,000 to 10,000 references (by the estimate of the

applicable Defendants' own witness) with the references listed primarily in chronological order. (Dkt. No. 343-3 at 68:19–69:10; *cf. Acceleration Bay*, 908 F.3d at 773 (affirming PTAB decision that a reference was not publicly accessible when the PTAB decision stated that evidence presented "suggests that an artisan might have located [the relevant publication] by skimming through potentially hundreds of titles in the same year . . . .").) While the applicable Defendants provided a declaration from Randall Schwartz contending that the references were typically "labeled fairly clearly" as to what the issue was that was being addressed in the reference, (Dkt. No. 343-3 at 67:6–10), Schwartz does not indicate how either of the specific Hwang or Liebetreu references were labelled. Further, the Hwang reference was withdrawn, so it likely was not discussed at the meetings, making it even more difficult for this reference to be found. (*see* Dkt. No. 343 at 1; Dkt. No. 343-3 at 33:25–34:2, 79:3–22.)

For these reasons, the Court concludes that a question of fact exists as to whether these references were publicly available as it is unclear whether persons interested and ordinarily skilled in the subject matter would be able to locate these references using reasonable diligence. Consequently, the applicable Defendants' Motion for Partial Summary Judgment should be DENIED with respect to the Hwang and Liebetreu references.

IV. CATT and LG References

All of the Defendants rely on the CATT and LG references, which are 3GPP submissions. (Dkt. No. 305 at 2.) Defendants assert that the CATT and LG references were

publicly accessible by March 31, 2006 at the latest and that the references are therefore prior art to U.S. Patent No. 8,682,357 ("'357 Patent") and U.S. Patent No. 9,532,330 ("'330 Patent").

After consideration, the Court recommends that Defendants' Motion be DENIED with respect to the CATT and LG references. Questions of fact remain as to the public accessibility of the CATT and LG references. While the references were distributed by email to the working group and then placed on the 3GPP server, it remains unclear whether the references were indexed in a way that would allow persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, to locate the two references. Defendants merely indicate that the references were sent on the emails, but a very large number of references were sent through the emails. Defendants have also not shown that the references could be found through any sort of search through the emails or through the website. While Defendants argue that "indexing is not a prerequisite to finding that a reference qualifies as a printed publication," (Dkt. No. 305 at 4 n.5), a failure to appropriately index may still create a question of fact as to whether a reference qualifies as a printed publication. Additionally, Plaintiff's validity expert Douglass Chrissan asserted that the CATT and LG references were not publicly available (Dkt. No. 305-21 at ¶ 26), and this suggests that summary judgment would be inappropriate. *See Vasudevan*, 782 F.3d at 683. Because it remains unclear whether persons interested and ordinarily skilled in the

subject matter or art, exercising reasonable diligence, could locate the two references, the Court should deny Defendants' Motion for Summary Judgment on these references.[1]

V. Conclusion

Summary Judgment should be DENIED for the Hwang, Liebetreu, CATT, and LG references. Summary Judgment should be GRANTED for the Yang reference. A party's failure to file written objections to the findings, conclusions, and recommendations contained in this report within 14 days bars that party from *de novo* review by the district judge of those findings, conclusions, and recommendations and, except on grounds of plain error, from appellate review of unobjected-to factual findings and legal conclusions accepted and adopted by the district court. Fed. R. Civ. P. 72(b)(2); *see Douglass v. United Servs. Auto. Ass'n*, 79 F.3d 1415, 1430 (5th Cir. 1996) (*en banc*).

SIGNED this 18th day of April, 2019.

ROY S. PAYNE
UNITED STATES MAGISTRATE JUDGE

[1] While the Defendants point to the PTAB decision in their argument (Dkt. No. 305 at 8), the Court gives that opinion little weight as the PTAB was not operating under the current summary judgment standard.