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## WHITE PAPER

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### Are Online Videos “Publicly Accessible”?

The decision in *HVLP02 LLC v. Oxygen Frog* turned on whether or not a YouTube video could qualify as a “printed publication,” and therefore constitute prior art for patent purposes. As courts tend to assign the term “printed publication” a broad definition that usually includes videos, the YouTube video in question was considered prior art. Still, much of the analysis in these matters involves the “public accessibility” of a particular video.

This Jones Day *White Paper* reviews the law surrounding printed publications, explains practical ways to demonstrate that a YouTube video is or is not publicly accessible, and summarizes best practices.

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No one challenging an online video's status as prior art wants to hear the court chide "[i]t appears that Plaintiff is unfamiliar with how YouTube works." But that was the judge's retort in *HVLP02 LLC v. Oxygen Frog, LLC* ("*Oxygen Frog*").<sup>1</sup> Video channels like YouTube or Vimeo are among the most visited websites on the web.<sup>2</sup> As these sites grow in popularity, they are more and more likely to host videos that may disclose inventions. Practitioners are increasingly looking to this medium for prior art.

Certain prior art is defined by 35 U.S.C. § 102(b) ("Section 102") as "described in a printed publication." But can an online video, something that is not printed, be a printed publication? The short answer is: yes. Some challenge that videos posted on the web are not a printed medium, and thus not prior art. This argument usually fails because courts give the term "printed publication" a broad meaning that tends to include videos. The crux of the online video prior art analysis is "public accessibility" and whether a video "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."<sup>3</sup> This *White Paper* discusses the law surrounding printed publications, practical ways to show a YouTube video is or is not publicly accessible, and summarizes best practices.

## LAW AND PTO INTERPRETATION

Prior to the Leahy-Smith America Invents Act ("AIA"), under Section 102, a person was entitled to a patent unless "the invention was patented or *described in a printed publication* in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."<sup>4</sup> The current Section 102 still includes the "printed publication" phrase, but was modified under the AIA to also include a catch-all provision that captures anything else that was "otherwise available to the public."<sup>5</sup>

The Federal Circuit broadly interprets the term *printed publication* "to give effect to ongoing advances in the technologies of data storage, retrieval, and dissemination."<sup>6</sup> Rather than limiting the prior art based on whether a reference was "printed," courts use "public accessibility" as the "touchstone in determining whether a reference constitutes a 'printed publication' bar under 35 U.S.C. § 102(b)."<sup>7</sup> "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."<sup>8</sup> Practitioners should thus focus on the public accessibility of the video as opposed to whether the video was "printed."

The Supreme Court of the United States recently granted certiorari to discuss if "otherwise available to the public" affects other provisions of Section 102, but the United States Patent and Trademark Office ("PTO") considers this phrase a catch-all that specifically includes internet videos.<sup>9</sup> For example, the PTO guidance also states that a YouTube video may qualify as a printed publication under both pre-AIA and post-AIA law.<sup>10</sup> The Manual of Patent Examining Procedure ("MPEP") also considers electronic publications, including digital videos, "printed publications" under pre-AIA and post-AIA law provided that "the publication was accessible to persons concerned with the art to which the document relates."<sup>11</sup> As a practical matter, when applying AIA law, practitioners should argue that online videos are prior art as both a "printed publication" and "otherwise available to the public."

## NONPRIVATE VIDEOS

Videos posted online may have different accessibility standards. For example, YouTube offers different privacy settings where videos may be public, private, or unlisted. As discussed below, these settings may impact whether a particular online video is or is not prior art.

Courts grappling with "public accessibility" of a nonprivate web-posted video analogize to a library reference because they are both cataloged, indexed, and locatable when searched. In the context of a library reference, courts consider "whether the reference was sufficiently indexed or cataloged."<sup>12</sup> In giving a broad definition to "printed publications," the Federal Circuit considers the same public accessibility analysis for online references as for traditional media.<sup>13</sup> A nonprivate online video can be a printed publication and courts typically look at whether the video was sufficiently indexed or cataloged so that a person interested and ordinarily skilled in the subject matter exercising reasonable diligence would locate the video.

The classic example of a “printed publication” is a single copy of a dissertation that was likely shelved in the library of a German university.<sup>14</sup> “Printed publications” also include microfilm copies of an Australian patent application available at the Australian Patent Office and its five “sub-offices” and a drawing found only in the file history of a Canadian patent.<sup>15</sup> Consistent with the policy of prohibiting patentees from reclaiming subject matter from the public domain, published information, even if it is behind significant access barriers, is nevertheless “publicly accessible” through the exercise of “reasonable diligence.”<sup>16</sup>

Several district court cases and IPRs address the issue of whether videos, in general, constitute prior art. In 2006, the district court in *Diomed, Inc. v. AngioDynamics, Inc.* found that a video disseminated to a large number of people over the years was *not* a printed publication under Section 102 because it was more similar to an oral presentation, than a “print out” presentation and, therefore, the print element of the publication was not satisfied.<sup>17</sup> This case appears to be an outlier because most recent decisions hold that videos are “printed publications” under Section 102.<sup>18</sup>

The Patent Trial and Appeal Board (“PTAB”) also held that videos are “printed publications” in several IPRs.<sup>19</sup> In *Medtronic, Inc. v. Barry* (“*Medtronic*”), the PTAB found that a narrated video recorded on CD satisfies the printed requirement because a CD includes data that defines the displayed content, but this CD was not a “publication” because it was not adequately disseminated to the relevant audience.<sup>20</sup> The Federal Circuit agreed that the video could be prior art, but disagreed about public accessibility.<sup>21</sup> The court remanded the case for the PTAB to reconsider the public accessibility of the video distributed at a conference.<sup>22</sup>

The Federal Circuit emphasizes public accessibility as the touchstone for the printed publication analysis.<sup>23</sup> In *Blue Calypso, LLC v. Groupon, Inc.* (“*Blue Calypso*”), the court found that the petitioner “failed to carry its burden of establishing that an interested party exercising reasonable diligence would have located [the prior art].”<sup>24</sup> The court found that an expert’s testimony stating that the report was publicly available on a website alone was insufficient to carry that burden.<sup>25</sup> The court also looked at the lack of “evidence indicating that [the prior art] was viewed or downloaded,” and the lack of evidence “that a person interested in [the art] would be independently aware

of the web address.”<sup>26</sup> Additionally, the defendant provided no evidence that the webpage reference could have been found by a search engine.<sup>27</sup> The report was posted to a webpage that was not linked, no one knew about, was not indexed, and was not downloaded or viewed.<sup>28</sup> Public online videos, however, are fundamentally different than the webpage in *Blue Calypso* because they are typically searchable, indexed, and display the number of views and the upload date.

The Federal Circuit addressed “public accessibility” in the internet era in *Suffolk Techs. LLC v. AOL Inc.* (“*Suffolk*”) and *Voter Verified, Inc. v. Premier Election Solutions, Inc.* (“*Voter Verified*”). *Suffolk* held that a Usenet newsgroup post was a “printed publication” where: (i) its audience included skilled artisans; (ii) the newsgroups were organized in a hierarchical manner and were easily navigated; and (iii) it was sufficiently disseminated because it got responses and others may have viewed it without posting responses.<sup>29</sup> And in *Voter Verified*, an article posted online was a “printed publication” where: (i) the site was known to the interested public; (ii) submissions were considered public and could be copied; and (iii) the site had an internal search tool that could be used to locate the article.<sup>30</sup> Applying these considerations to an online video, a fact finder could easily find that such a video is a prior art printed publication.

In *Oxygen Frog*, the court did exactly this. The court addressed whether a YouTube video is considered a printed publication for purposes of pre-AIA 35 U.S.C. 102(a).<sup>31</sup> The plaintiff contested YouTube’s public accessibility because the video was uploaded on a channel “not associated with a trade group or website well-known to the relevant community.”<sup>32</sup> The court disagreed:

It appears that Plaintiff is unfamiliar with how YouTube works. A familiar user would know that you don’t need to search for a particular channel to watch the videos uploaded on it. For example, if you want to watch a video of a cat skateboarding, you can search “cat skateboarding”; you don’t need to know that it might have been “CatLady83” who uploaded the video you end up watching.<sup>33</sup>

The court reasoned that “[s]urely, the effort involved in composing a basic search query and scrolling down the page a few times does not exceed the ‘reasonable diligence’ that the law expects of a hypothetical prior-art subject.”<sup>34</sup> The court

held that “a reasonable jury could find that someone interested and ordinarily skilled in the pertinent art, exercising reasonable diligence, would have been able to locate” the video on the priority date, and denied the plaintiff’s motion to exclude the video.<sup>35</sup> As familiarity with online video sites increases, practitioners can expect an uphill battle arguing that online videos are not “publicly accessible.”

## PRIVATE VIDEOS

The video in *Oxygen Frog* was publicly listed, but video sites like YouTube have alternative privacy settings for videos, such as privately listed or unlisted.<sup>36</sup> A public video is searchable and is available to anyone. A private video does not appear in search results and does not appear on a channel; instead, the owner must invite viewers to see the video. An unlisted video appears neither in search results nor on the channel. But anyone with the specific link may view the video, and anyone with the link may share the video with anyone else.<sup>37</sup>

The private and unlisted videos are similar to materials distributed at a conference, because the references are only distributed to a limited number of individuals and are not later searchable. But that does not end the “printed publication” inquiry, because a printed publication “need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication.”<sup>38</sup> In limited distribution cases, courts apply factors to gauge “public accessibility” set forth in *In re Klopfenstein*.<sup>39</sup> The *Klopfenstein* factors are: (i) “the length of time the display was exhibited”; (ii) “the expertise of the target audience”; (iii) “the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied”; and (iv) “the simplicity or ease with which the material displayed could have been copied.”<sup>40</sup> For a private or unlisted video, like materials distributed at a conference, practitioners must consider these factors to establish public accessibility of the video. Depending on these factors, a private or unlisted online video may be prior art, even if it was not listed as public.

## PROVING A VIDEO IS A PRINTED PUBLICATION

Anyone challenging a patent’s validity “bears the burden of establishing that a particular document is a printed publication.”<sup>41</sup> The PTO suggests that to rely on a video as a

printed publication, the party introducing the reference should “provide evidentiary support for its public accessibility.”<sup>42</sup>

Some best practices are emerging in this area. First, contact the video owner to obtain the video and obtain a declaration from the owner regarding the video’s public accessibility. Second, record the presence of the video on the public forum.<sup>43</sup> Video hosting pages sometimes report video statistics and accessibility dates. As a practical guide, others have suggested to:

- Take a screenshot of each frame of the video playing inside the browser that includes the URL to the video and the video date of publication (or upload) in each screenshot.
- Collate the screenshots in a single document in sequential order.
- Reference the time stamp in each screenshot to follow the video progress. This will help in citing to a particular time where the most important images appear.
- Provide captions of the entire video.<sup>44</sup>

Additionally, practitioners should log the steps necessary to search for and find the reference—ideally by recording a video of the process.

Third, the video may also be archived by the Internet Archive: WayBack Machine, a nonprofit dedicated to preserving content published on the web.<sup>45</sup> This archive tool displays snapshots of the webpage on previous dates. Practitioners should use this with caution because the snapshots may show certain information such as the date of publication and number of views, but may not actually include video playback, and may not include all videos. The PTO suggests authenticating archived webpages with an affidavit of a “Wayback Machine employee with personal knowledge of contents who can verify copy is true and accurate copy of WBM records.”<sup>46</sup> This process has become somewhat routine and staff at the Internet Archive are familiar with this process.<sup>47</sup> Ultimately, a practitioner should do everything he or she can to collect as much information about the reference to prove its public accessibility.

## CONCLUSION

To qualify as prior art, content must be “sufficiently accessible to the public interested in the art,” at the relevant time. This

does not strictly require “printed”; rather “public accessibility” is the key and every record of public accessibility counts.

The PTO and district courts are increasingly recognizing that web-posted videos can qualify as “printed publications” due to internet video channels’ burgeoning status as a mainstream medium. But the party introducing any online video still bears the burden of showing that it was publicly accessible. Relevant accessibility evidence includes snapshots of (i) the video with the URL, (ii) the title, (iii) captions, and (iv) the playback time. If the video was shared only with a select number of individuals, the practitioner should analyze how the *Klopfenstein* factors show that the reference was sufficiently disseminated to constitute prior art. A video’s author may be a good source of information in that regard.

## LAWYER CONTACTS

For further information, please contact your principal Firm representative or the lawyers listed below. General email messages may be sent using our “Contact Us” form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

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## ENDNOTES

- 1 *HVLP02 LLC v. Oxygen Frog, LLC*, No. 4:16-cv-00336, Dkt. 133 (N.D. Fla. May 28, 2018).
- 2 The Top 500 Sites on the Web, Alexa, <https://www.alexa.com/top-sites> (last visited June 28, 2018).
- 3 *Medtronic Inc., v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (internal citation and quotations omitted).
- 4 Pre-AIA 35 U.S.C. § 102 (emphasis added).
- 5 35 U.S.C. § 102.
- 6 *In re Hall*, 781 F.2d 897, 898 (Fed. Cir. 1986) (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)).
- 7 *In re Hall*, 781 F.2d at 899.
- 8 *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) (internal citation and quotations omitted).
- 9 *Helsinn Healthcare v. Teva Pharm.*, — S. Ct. —, 2018 WL 1142984 (Mem); *First Inventor to File Comprehensive Training Prior Art Under AIA*, USPTO, [https://www.uspto.gov/sites/default/files/aia\\_implementation/fitf\\_comprehensive\\_training\\_prior\\_art\\_under\\_aia.pdf](https://www.uspto.gov/sites/default/files/aia_implementation/fitf_comprehensive_training_prior_art_under_aia.pdf) (2013), at 15; MPEP § 2152.02(e).
- 10 *First Inventor to File* at 15.
- 11 MPEP § 2128 II. A. (citing *Wyer*, 665 F.2d at 227).
- 12 *Medtronic*, 891 F.3d at 1380.
- 13 *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012) (“[I]ndexing is no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media.”).
- 14 *Hall*, 781 F.2d at 899-900.
- 15 *Wyer*, 655 F.2d at 226-27; *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1379 (Fed. Cir. 2006).
- 16 *Hall*, 781 F.2d at 900.
- 17 *Diomed, Inc. v. AngioDynamics, Inc.*, 450 F. Supp. 2d 130, 141-42 (D. Mass. 2006).
- 18 See *Apple, Inc. v. Samsung Elecs. Co.*, 877 F. Supp. 2d 838, 885 (N.D. Cal. 2012) (finding that a paper and a video shown at two conferences was sufficiently publicly accessible to constitute prior art), *rev’d on other grounds*, 695 F.3d 1370 (Fed. Cir. 2012); *Kimberly-Clark Worldwide, Inc. v. First Quality Baby Prods., LLC*, No 09-C-0916, 2012 WL 5930609, at \*6-7 (E.D. Wis. No. 27, 2012) (finding a video shown at a conference constituted prior art).
- 19 See *Acco Brands Corp. v. Think Products, Inc.*, IPR2015-01167, Paper 40 (Oct. 11, 2016) (finding that a product video continuously available on the internet for about a year was a printed publication); *Intex Recreation Corp. v. Bestway Inflatables & Material Corp.*, IPR2016-00180, Paper 33 (May 26, 2017) (finding that an instructional video constituted a printed publication, but the patent owner did not dispute the authenticity or printed publication status of the video).
- 20 IPR2015-00780 (Paper No. 51) (Sept. 7, 2016), *affirmed in part, vacated in part by Medtronic, Inc. v. Barry*, 891 F.3d 1368 (Fed. Cir. 2018).
- 21 *Medtronic*, 891 F.3d at 1381.
- 22 *Id.*
- 23 *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016).

- 24 *Id.* at 1348.
- 25 *Id.* at 1349.
- 26 *Id.*
- 27 *Id.* at 1350.
- 28 *Id.* at 1348–50.
- 29 *Suffolk Techs. LLC v. AOL Inc.*, 752 F.3d 1358, 1365 (Fed. Cir. 2014).
- 30 *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380-81 (Fed. Cir. 2012).
- 31 *HVLPO2, LLC v. Oxygen Frog, LLC*, No. 4:16-cv-00336, Dkt. 133 (N.D. Fla. May 28, 2018).
- 32 *Id.* at \*3.
- 33 *Id.* at \*3–4.
- 34 *Id.* at \*4.
- 35 *Id.* at \*5.
- 36 *Change Video Privacy Settings*, YouTube, <https://support.google.com/youtube/answer/157177> (last visited June 26, 2018).
- 37 *Id.*
- 38 *Medtronic*, 891 F.3d at 1380 (citing *Suffolk Techs.*, 752 F.3d at 1365).
- 39 *Medtronic*, 891 F.3d at 1381–82 (citing *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004)).
- 40 *Id.*
- 41 *Medtronic*, 891 F.3d at \*7 (citing *Blue Calypso*, 815 F.3d at 1350–51).
- 42 Judges Lora Green & Brian McNamara, *Best Practices For Proving A Document Is a Printed Publication*, USPTO, (Dec. 7, 2017) at 18, [https://www.uspto.gov/sites/default/files/documents/boardside\\_chat\\_on\\_prior\\_art\\_12\\_7\\_17.pdf](https://www.uspto.gov/sites/default/files/documents/boardside_chat_on_prior_art_12_7_17.pdf).
- 43 Obtaining a copy of the video from YouTube, however, may create tension YouTube's terms of service. *Terms of Service*, YouTube, <https://www.youtube.com/static?template=terms> (last visited June 25, 2018).
- 44 See *Can YouTube Videos be Used as Prior-arts?*, Citius Minds, (July 4, 2016) <https://www.citiusminds.com/blog/can-youtube-videos-be-used-as-prior-arts/>.
- 45 *About the Internet Archive*, The Internet Archive WayBack Machine, <https://archive.org/about/> (last visited June 29, 2018).
- 46 *Best Practices*, USPTO at 15.
- 47 *The Internet Archive's Policy for Responding to Information Requests*, The Internet Archive WayBack Machine, <https://archive.org/legal/> (last visited June 29, 2018).

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