

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOS ANGELES COUNTY METROPOLITAN
TRANSPORTATION AUTHORITY
Petitioner,

v.

TRANSPORT TECHNOLOGIES, LLC
Patent Owner.

Case IPR2016-01633
Patent 6,980,101

Before DAVID C. McKONE, GEORGIANNA W. BRADEN, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Los Angeles County Metropolitan Transportation Authority, Clark Construction Group LLC, and Atkinson Contractors LP (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) for *inter partes* review of claims 1, 3, 5, 6, 8, and 10 (the “challenged claims”) of U.S. Patent No. 6,980,101 B2 (Ex. 1001, “the ’101 patent”). Transport Technologies, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted trial on all of the challenged claims of the ’101 patent on all grounds of unpatentability alleged in the Petition. Paper 8 (“Institution Decision” or “Inst. Dec.”).

After institution of trial, Patent Owner responded to Petitioner’s challenges including filing a Patent Owner Response, along with a declaration by Mr. Christopher Butler (Ex. 2016). Paper 14 (“PO Resp.”). Petitioner timely filed a Reply. Paper 16 (“Reply”).

A hearing for IPR2016-01633 was held on October 27, 2017. The transcript of the hearing has been entered into the record. Paper 21 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a).

Based on the complete record now before us, we conclude that Petitioner fails to show, by a preponderance of the evidence, that any of the challenged claims of the ’101 patent are unpatentable.

B. Related Proceedings

The parties inform us that the ’101 patent is at issue in the following proceeding: *Transport Techs., LLC v. L.A. County Metro. Transp. Auth.*, Case No. 2:15-cv-6423-RSWL (C.D. Cal.), filed August 21, 2015. Pet. 1; Paper 5, 1.

Additionally, Petitioner filed a separate petition on May 20, 2016, for *inter partes* review, Case No. IPR2016-01077 (“the ’1077 IPR”), that challenges the same claims of the ’101 patent challenged in this proceeding. In the ’1077 IPR, we instituted *inter partes* review of all claims challenged in the proceeding, namely claims 1, 3, 5, 6, 8, and 10 of the ’101 patent. ’1077 IPR, Paper No. 10 (“1077 Inst. Dec.”) 41.

C. The ’101 Patent

The ’101 patent is entitled “Motor Vehicle Occupancy Signaling System” and discloses transmitting “a claim by a registrant as to the number of occupants traveling in a vehicle over a section of highway” that is associated with a high occupancy vehicle (HOV) incentive program. Ex. 1001, [54], [57]. The registrant’s claim is made when “traversing . . . one or more sections of highway at particular times of day and days of the year,” which are “deemed . . . qualifying ride-sharing event[s]” (QREs) by an agency that administers a ridesharing program. *Id.* at 1:51–56 (internal quotation marks omitted). In addition to a claim of occupancy, the ’101 patent also discloses that the agency collects identifying information for the registrant to the ridesharing program. *Id.* at 1:66–2:1.

The ’101 patent further discloses that the claim of occupancy is transmitted by a sending device, alternatively referred to as a transponder, “that is carried or attached to a motor vehicle” and that includes “circuitry [that] will uniquely identify the transponder and the position of the switch claiming an occupancy level.” *Id.* at 2:59–66. Figure 2, reproduced below, is a diagram of the transponder or sending device. *Id.* at 2:32–33.

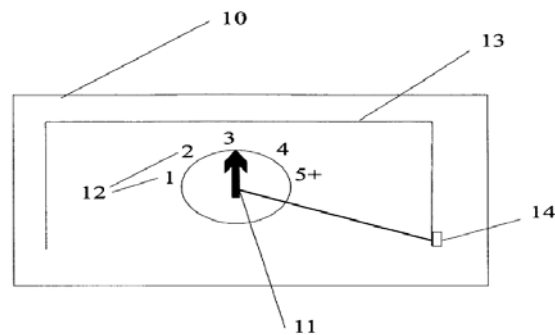


Figure 2 of the '101 patent depicts the transponder or sending device.

Figure 2 depicts sending device 10 “with a multiple position switch 11 that can point to a claimed occupancy level 12.” *Id.* at 2:60–62. Multiple position switch 11 permits claiming an occupancy level from 1 to 5 or more. *See id.* at Fig. 2. Sending device 10 “transmit[s] an identification code when passing by reading device 3.” *Id.* at 2:42–44. Figure 4, reproduced below, depicts processing performed by reading device 3.

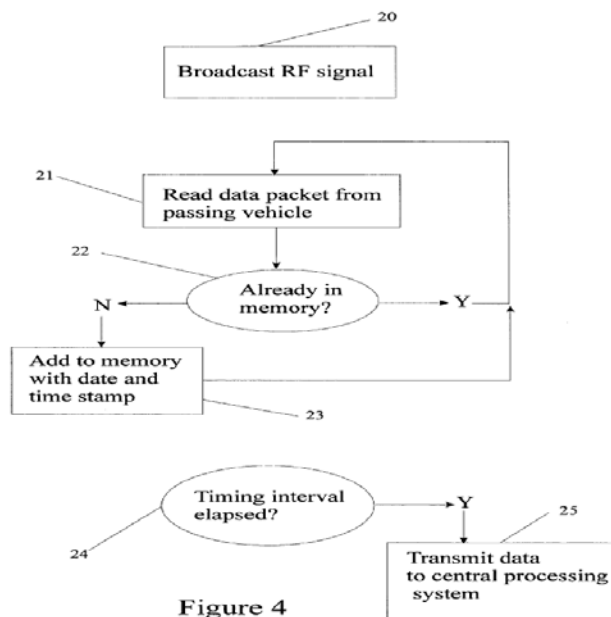


Figure 4

Figure 4 of the '101 patent depicts a process flow diagram for the reading device.

Reading device 3, using its receiver, listens for transmissions from sending device 10 of a passing vehicle that is within its radio frequency signal range. *Id.* at

3:15–18. The '101 patent further discloses that reading device 3 reads data transmitted from sending device 10, stores the data in memory, and transmits the data to a central processing system for the agency. *See id.* at 3:18–24, Fig. 4.

D. Illustrative Claims

As noted above, Petitioner challenges claims 1, 3, 5, 6, 8, and 10 of the '101 patent, of which claims 1 and 6 are independent. Both independent claims are reproduced below.

1. A vehicle occupancy monitoring system wherein a claim is made by a registrant about the number of occupants in a vehicle as it traverses a designated section of highway:
 - a transmitter that transmits a claim as to the number of occupants in the vehicle;
 - a sending transponder in the vehicle that transmits a code that uniquely identifies the registrant with the program administrator;
 - a reading data collector that can interrogate a vehicle within its range, and receive, store and transfer to a central processing facility said transmitted code identifying the registrant along with a time/date stamp.

Ex. 1001, 3:26–37.

6. A method of receiving claimed vehicle occupancy data about a vehicle by a registrant, and also identifying the registrant as the vehicle traverses a designated section of highway, said method comprising the steps of:
 - transmitting the number of occupants in a vehicle claimed by a registrant;
 - transmitting a signal from the vehicle that identifies the registrant;
 - and then receiving the claim by a registrant as to number of occupants in a vehicle and reading the signal from the vehicle that identifies the registrant as the vehicle transits the designated section of highway.

Id. at 4:13–25.

E. The Evidence of Record

Petitioner relies upon the following references, as well as the Declarations of Henry Wong (Ex. 1006), Anthony Wing (Ex. 1007), Scott Andrews (Ex. 1008), and Bill Legg (Ex. 1015):

Reference	Date	Exhibit
“Automated Vehicle Occupancy Monitoring Systems for HOV/HOT Facilities” (“The Draft Ontario Report”)	Aug. 22, 2004	1005
U.S. Patent No. 5,289,183 (“Hassett ’183”)	Feb. 22, 1994	1004

Patent Owner supports its Patent Owner Response with the Declaration of Christopher Butler (Ex. 2016).

F. The Asserted Grounds of Unpatentability

Petitioner asserts unpatentability of the challenged claims of the ’101 patent based on the following grounds:

Reference(s)	Basis	Claims Challenged
The Draft Ontario Report	§ 102	1, 3, 5, 6, 8, and 10
The Draft Ontario Report	§ 103	1, 3, 5, 6, 8, and 10
Hassett ’183 and The Draft Ontario Report	§ 103	1, 3, 5, 6, 8, and 10

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of

the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable construction standard). Under that standard, and absent any special definitions, we generally give claim terms their ordinary and customary meaning, as would have been understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Claim terms need only be interpreted to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

As discussed below, we determine that the Draft Ontario Report does not qualify as prior art. Therefore, it is not necessary for us to construe any claim term.

B. Principles of Law

The determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986). To qualify as a prior art printed publication, the reference must have been disseminated or otherwise made accessible to persons interested and ordinarily skilled in the subject matter to which the document relates prior to the critical date. *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008). Public accessibility is a legal conclusion based on

underlying factual determinations. *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1321 (Fed. Cir. 2002).

C. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner’s Declarant, Mr. Andrews, testifies that a person of ordinary skill in the art relevant to the ’101 patent “would have a Bachelor’s of Science degree in Electrical or Computer Engineering, or the equivalent,” as well as “two years of experience working with automated toll roads, intelligent transportation systems, RFID tracking systems, or a similar field of experience.” Ex. 1008 ¶ 47. Patent Owner does not offer any contrary explanation regarding who would qualify as a person of ordinary skill in the art relevant to the ’101 patent. *See generally* PO Resp.

Based on our review of the ’101 patent, the types of problems and solutions described in the ’101 patent and cited prior art, and the testimony of Petitioner’s Declarant, we adopt and apply Petitioner’s definition of a person of ordinary skill in the art at the time of the claimed invention.

D. Status of The Draft Ontario Report as Prior Art

Petitioner contends that claims 1, 3, 5, 6, 8, and 10 of the ’101 patent are unpatentable under 35 U.S.C. § 103 as obvious over the Draft Ontario Report alone. Pet. 7–23. Petitioner further contends that the challenged claims of the ’101

patent are anticipated under 35 U.S.C. § 102 by the Draft Ontario Report. *Id.* at 23. Lastly, Petitioner contends that the challenged claims of the '101 patent are unpatentable under 35 U.S.C. § 103 as obvious over the combination of the Draft Ontario Report and Hassett '183. *Id.* at 24–43. Patent Owner challenges that the Draft Ontario Report is a prior art printed publication. *See* PO Resp. 21–35.

For the reasons that follow, we conclude that Petitioner does not demonstrate, by a preponderance of the evidence, that the challenged claims of the '101 patent are anticipated by or would have been obvious in view of the Draft Ontario Report because, having considered the arguments and evidence adduced at trial, Petitioner fails to establish that the Draft Ontario Report qualifies as prior art to the '101 patent.

Initially, we note the Draft Ontario Report (Ex. 1005) that was submitted in connection with the present proceeding is dated August 2004 (*see id.* at cover page) and is an earlier-dated version of the Ontario Report ('1077 IPR Ex. 1005, dated December 2004) submitted in connection with '1077 IPR. In the '1077 IPR, we determined that the Ontario Report dated December 2004 was not prior art because the facts supporting Petitioner's assertion of routine business practices did not support sufficiently a determination that the Ontario Report was publicly accessible as of the critical date of the '101 patent, March 14, 2005. '1077 Inst. Dec. 37–40; *cf. Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988) (citing *Hall*, 781 F.2d at 899) (“Evidence of routine business practice can be sufficient to prove that a reference was made accessible before a critical date.”).

Like the Ontario Report submitted in the '1077 IPR, the Draft Ontario Report is also entitled “Automated Vehicle Occupancy Monitoring Systems for HOV/HOT Facilities” and was prepared by the McCormick Rankin Corporation on

behalf of the ENTERPRISE ITS research program. Ex. 1005, Preface. The front cover of the Draft Ontario Report is designated “Final Report” and dated August 2004. *Id.* at cover page.

1. Petitioner’s Evidence

Petitioner’s Declarant, Mr. Wong, an employee of the Ministry of Transportation of Ontario, Canada, testifies that he oversaw and performed “project management work related to a project known as the Automated Carpool Occupancy Detection Systems for High Occupancy Vehicle (HOV) Lane Operations . . . undertaken by Mr. Steve Schijns of the McCormick Rankin Corporation . . . on behalf of the pooled-fund Enterprise ITS (‘Enterprise’) research program.” Ex. 1006 ¶¶ 2, 3. Mr. Wong further testifies that he “distributed to the Enterprise members at that meeting, a draft final report of the study titled ‘Automated Vehicle Occupancy Monitoring Systems for HOV/HOT Facilities’, dated August 2004.” *Id.* ¶ 6; *see id.* ¶ 7. Petitioner’s Declarant, Mr. Legg, testifies that he has been employed by the Washington State Department of Transportation since 1982 (Ex. 1015 ¶ 2), attended the August 2004 Enterprise Board Meeting (“Board Meeting”) in Minnesota (*id.* ¶ 6), and that he “recall[s] Mr. Wong distributing a CD with the draft final report, of which [he] recall[s] receiving the CD and later reviewing the draft final report” (*id.* ¶ 7).

The meeting minutes from the Board Meeting indicate that representatives from various departments of transportation, as well as from the commercial entity, Castle Rock, were in attendance. Ex. 1018, 1. The meeting minutes further indicate that Mr. Wong “handed out a CD with the draft final report on [it].” *Id.* at 11. The meeting minutes also indicate that “[i]t was hoped that members could read the report and give comments back to Ontario within a month” and that “[t]he report will be made available on the Enterprise website.” *Id.*

2. *Institution Decision*

For purposes of institution, we preliminarily determined Petitioner had shown sufficiently that the Draft Ontario Report qualifies as a prior art printed publication based on the meeting minutes (Ex. 1018), the testimony of Mr. Wong (Ex. 1006), and the testimony of Mr. Legg (Ex. 1015). Inst. Dec. 17. We preliminarily determined the meeting minutes established that “the Draft Ontario Report was disseminated to the 12 board members present at the meeting, *without restriction*” and that “[t]he contents of the meeting minutes are further supported by the testimony of Mr. Wong and Mr. Legg.” *Id.* at 19.

More particularly, we preliminarily determined that, based on the 38 stakeholder entities in Appendix B of the Draft Ontario Report, “a person of ordinary skill interested in HOV/HOT lanes would have been aware independently of the ENTERPRISE ITS research group and its publications, and looked to these publications, including the Draft Ontario Report, for relevant information.” *Id.* We found persuasive evidence that “a CD containing the Draft Ontario Report [was] made available to members present at the ENTERPRISE Board Meeting that were representatives of Castle Rock, a non-governmental, commercial entity, absent any indication of protective measures.” *Id.* at 20 (citing Ex. 1018, 1, 11).

3. *Petitioner’s Arguments*

As discussed above in Section II.D.1, Petitioner contends that CDs containing the Draft Ontario Report were distributed to members present at the Board Meeting. *See* Pet. 7, 9, 10; *see* Reply 12–25. Petitioner argues that the Draft Ontario Report was distributed absent “indicia of distribution restrictions . . . such as CONFIDENTIAL or INTERNAL USE ONLY labeling.” Reply 24. Petitioner supports its argument regarding the absence of distribution restrictions

with the deposition testimony of its Declarants, Mr. Legg and Mr. Wong, who testify respectively that there were no restrictions on distributing the CDs outside the Enterprise group and no restrictions preventing attendees, such as “Messrs. Wendtland or Pearson, who were *not* members of the Enterprise board, from obtaining a copy of the CD.” *Id.* at 23 (citing Ex. 2015, 105:9–12, Ex. 2014, 141:15–142:2); *see id.* at 19. Petitioner further argues that, because the Draft Ontario Report “was distributed on a CD-ROM, there were no practical limitations on duplication and dissemination of the Draft Ontario Report.” *Id.* at 20.

Second, Petitioner contends that “the prior art was distributed to interested parties, including outside contractors” because “the Enterprise board meeting was attended by representatives of two non-governmental commercial enterprises – Castle Rock and ITS [Intelligent Transportation Systems] Engineers.” *Id.* at 22, 24. Petitioner argues that the attendees from the commercial entity, ITS Engineers, “were not members of Enterprise but were also persons of ordinary skill and members of the interested public.” *Id.* at 24; *see id.* at 18–19. With respect to the attendees from Castle Rock, Petitioner disputes Patent Owner’s contention that “Castle Rock’s status as management consultants coordinating complex technical studies and activities diminishes the relevance of their attendance,” arguing that the attendees “are still members of the interested public and certainly would be deemed relevant under Federal Circuit precedent.” *Id.* at 22.

4. Patent Owner’s Arguments

First, Patent Owner contends that “neither Mr. Wing, Mr. Wong, nor Mr. Legg has personal knowledge that the purported ‘Draft Ontario Report’ submitted as Exhibit 1005 is the draft report that Mr. Wong allegedly distributed in August 2004 at the Duluth meeting.” PO Resp. 21; *see id.* at 20 (“MTA has submitted no evidence sufficient to support a conclusion that the document Mr. Wing retrieved

from McCormick’s files is what was allegedly distributed.”). Petitioner has not introduced into evidence or produced a CD actually distributed Mr. Wong. *See* PO Resp. 5; *see* Tr. 9:18–24, 47:7–15. Rather, Petitioner relies on a copy of the Draft Ontario Report allegedly kept by Mr. Wing in MMM Group’s¹ files along with Mr. Wong’s testimony that this copy is the same as the copy distributed on the CDs. *See* Tr. 8:14–23, 9:11–17; *see* Ex. 2014, 96:11–106:21.

Second, Patent Owner contends that “[n]owhere in the meeting minutes does it ‘establish sufficiently’ that there was dissemination of the Draft Ontario Report ‘without restriction,’ as the Board found.” PO Resp. 33. Patent Owner cites *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319 (Fed. Cir. 2009) and argues that “the absence of a confidentiality designation does not mean that a document was therefore distributed or made available to the public interested and ordinarily skilled in the art.” PO Resp. 25. Patent Owner further argues that the Draft Ontario Report was, instead, “an internal document for Enterprise Board members, and not intended to be made available to the public.” *Id.* Patent Owner asserts that Petitioner’s Declarants, Mr. Wong and Mr. Legg, “make no mention of the absence of confidentiality restrictions on the Draft Ontario Report.” *Id.* at 33–34.

Third, Patent Owner contends that “Enterprise practice . . . demonstrates that there was a reasonable expectation that the draft would remain within the group, while the final would be made available to the public.” *Id.* at 34; *see id.* at 28–30. Citing *Activision Blizzard, Inc., et al. v. Acceleration Bay, LLC*, IPR2015-01964 (PTAB Mar. 29, 2017), Patent Owner argues that there is “no evidence that a person of ordinary skill in the art would have even been ‘aware independently of

¹ Petitioner indicates that the reason the Draft Ontario Report was obtained from “MMM instead of McCormick Rankin is because McCormick Rankin no longer exists as an independent entity” and has merged with MMM. Tr. 8:15–23.

the ENTERPRISE ITS research group and its publications’ in 2004.” PO Resp. 31. With regard to the non-member attendees noted in the meeting minutes of the Board Meeting, Patent Owner argues that the fact that “Castle Rock is a non-governmental, commercial entity, has no relevance to the issue of public accessibility of the Draft Ontario Report.” *Id.* at 33. Patent Owner argues that “[t]he two members of Castle Rock that were present at the August 2004 Enterprise Board meeting were there [instead,] to serve their purpose as hired consultants for Enterprise.” *Id.*

Fourth, Patent Owner contends that, to enjoy the benefits of Enterprise membership, including meetings to discuss projects, receiving draft reports of the projects, and the ability to provide comments on the draft reports, one had contribute at least \$25,000 to the pooled fund. *Id.* at 28–29.

5. Analysis

To determine whether a document is a prior art printed publication, we consider whether the document was distributed, displayed without indicia of confidentiality, able to be found, or available on request to persons interested and ordinarily skilled in the subject matter to which the document relates. *See Blue Calypso, LLC v. Groupon, Inc.*, 815 F. 3d 1331, 1348 (Fed. Cir. 2016) (“To qualify as a printed publication, a reference ‘must have been sufficiently accessible to the public interested in the art.’” quoting *In re Cronyn*, 890 F.2d 1158, 1160 (Fed.Cir.1989)). We consider the question of whether the Draft Ontario Report is a printed publication anew, based on the complete record, in light of the evidence and arguments adduced at trial.

Petitioner does not dispute that anyone visiting the Enterprise website during the relevant timeframe would be unable to find a copy of the Draft Ontario. *See* Reply 5; *see* Ex. 2015, 94:2–12. Although the “Automated Carpool Occupancy

Detection Systems for High Occupancy Vehicle Lane Operations” research *project* was publicized on the Enterprise website (*see* Ex. 1025, 14–16), Petitioner does not contend, nor does the record indicate, that the *draft report* was publicized on the website so as to convey its availability at the Board Meeting (*see id.*). With respect to the only non-member attendees of the Board Meeting, the evidence of record does not indicate that either the ITS Engineers or the Castle Rock engineers were prompted to attend the meeting based on viewing a description of the research project on the Enterprise website. Rather, the evidence indicates that they were paid consultants of members. *See* Ex. 2014, 60:7–18, 87:6–13, 143:8–20, 148:15–149:7; *see* Ex. 1016, 9; *see* Ex. 1018, 10–12.

With respect to the Draft Ontario Report being available upon request, Petitioner points to Mr. Wong and Mr. Legg’s testimony that

[T]here were no restrictions preventing either Mr. Pearson or Mr. Wendtland (*Id.* at 141:21-142:2) or anyone at the Ontario Ministry of Transportation (*Id.* at 142:3-7) from receiving the Draft Ontario Report. Mr. Legg, who became Chairman of the Enterprise board, testified unambiguously that there were no restrictions against the distribution of the CD with the Draft Ontario Report outside of the Enterprise group.

Reply 19 (citing Ex. 2014, 141:21–142:7; Ex. 2015, 105:9–12). Petitioner presents insufficient evidence, however, to support the finding that distributing draft reports outside of the Enterprise group was a commonly understood and accepted or routine practice, or that it had ever occurred. *See id.*; *see* Tr. 16:23–17:2. Indeed, Petitioner fails to demonstrate that anyone beyond Mr. Wong and Mr. Legg actually obtained and viewed the report. *See* Tr. 14:23–15:14, 15:25–16:11; *see* Reply 23–24 (asserting that “anyone at the Ministry of Transportation *could have seen* the Draft Ontario Report” (emphasis added)). The evidence of record tends to

support a contrary position—that draft reports were not publicized or made available until finalized (*see, e.g.*, Ex. 2015, 94:2–12), and that the Enterprise group’s policies and procedures support a reasonable expectation of confidentiality with respect to draft reports.

Petitioner does not contend that the Draft Ontario Report was displayed. *See generally* Pet.; *see generally* Reply. Petitioner admitted at the oral argument that it was not. Tr. 14:15–22. Petitioner’s declarants indicate that the Draft Ontario Report was not displayed in any manner, nor were any visual presentation materials prepared for the Board Meeting. *See* Ex. 2014, 74:13–75:6, 89:21–90:9; *see* Ex. 2015, 67:2–68:5. Rather, Mr. Wong gave a brief oral presentation indicating the status of the “Automated Carpool Occupancy Detection Systems for HOV Lane Operations” research project. *Id.*; *see* Ex. 1018, 11.

For the foregoing reasons, Petitioner does not present sufficient evidence to support the finding that the Draft Ontario Report was able to be found, available on request, or displayed. Setting aside the question of whether the Draft Ontario Report submitted as Exhibit 1005 was the document actually stored on the CDs that were distributed at the Board Meeting, we consider the issue of whether making the CD available to the attendees listed on the meeting minutes (*see* Ex. 1018, 1) at the Board Meeting constitutes sufficient actual distribution or public dissemination to persons interested and ordinarily skilled in the subject matter to which the document relates.

In *Garrett Corp. v. United States*, 422 F.2d 874, 878 (Ct. Cl. 1970), the Court determined that a report was a printed publication based on the findings that the report was “made available for dissemination in the United States through the Defense Department to government contractors who were advised of its availability and could obtain copies upon request at no cost” and that 80 copies of

the report were distributed in Great Britain to “various British Government agencies, American Government personnel in Great Britain, and 6 commercial companies.” The Court reasoned that these actions “show[ed] intent to make the contents [sic] of the report freely accessible.” *Id.*

The facts of the present proceeding are distinguishable from those in *Garrett* because the evidentiary record does not indicate that anyone other than the attendees of the Board Meeting were advised of the availability of the Draft Ontario Report or the cost at which a copy could be obtained. More particularly, the evidence submitted by Petitioner does not demonstrate that the attendees from ITS Engineers and Castle Rock would have known about the existence and availability of the Draft Ontario Report *but for* their association with Mr. Manny Agah (*see* Ex. 2014, 146:4–10, 150:7–151:6) and the Enterprise research program itself (*see id.* at 60:4–71:4). The evidence suggests that the ITS and Castle Rock engineers attended the meeting as agents of members, not as members of the public. We also agree with Patent Owner that the record developed at trial does not support the finding that a person of ordinary skill in the art would have been independently aware of the Enterprise program and its publications because the record only refers to Enterprise members or their contractors. *See* PO Resp. 31. The evidence presented by Petitioner (*see* Section II.D.1) does not tend to show that the contents of the Draft Ontario Report were made “freely accessible.” *See Garrett*, 422 F.2d at 878.

We also distinguish the facts of this case from those in *Garrett* because Petitioner does not point to evidence that a copy of the Draft Ontario Report was or could have been obtained without the recommended minimum \$25,000 membership fee or contribution to the Enterprise pooled fund. *See* Ex. 2014, 82:9–83:8, 126:7–12, 128:8–20, 134:16–25. In fact, the evidence of record supports the

contrary proposition. Ex. 2007, 1 (“The Board consists of a representative of each of the active member entities of the ENTERPRISE Program. Active membership is defined [as] a public or private entity contributing \$25,000 or more per year to the Program.”); Ex. 2008 (“Your agency can be a full, voting member of ENTERPRISE by making at least the minimum annual contribution. Currently this minimum contribution level is set at \$25,000 per year. . . local agencies can be affiliated with ENTERPRISE by making smaller contributions and working through a fully-active member agency.”).

In *Mass. Instit. of Tech. v. AB Fortia*, 774 F.2d 1104, 1108–09 (Fed. Cir. 1985), the Court affirmed the tribunal’s conclusion that a research paper was prior art based on evidence that the paper “was orally presented by Dr. Levine of the MIT group to the First International Cell Culture Congress in Birmingham, Alabama, September 21–25, 1975,” which “was attended by 50 to 500 cell culturists,” and that “copies were distributed on request, without any restrictions, to as many as six persons, more than one year before the filing date of the ‘534 and ‘654 patents.”

In this case, significantly fewer attendees were present and fewer copies of the CD containing the Draft Ontario Report were actually obtained than in the *MIT* case. See Ex. 1018, 1 (indicating attendees at the Board Meeting); see Tr. 15:4–24. As explained above, the Draft Ontario Report was not presented at the meeting—it was simply made available on a CD. Petitioner also indicated that it was not aware of whether any attendees, other than Mr. Wong and Mr. Legg, took a CD. See Tr. 12:3–16:11. Petitioner further indicated that it did not know whether any attendee made the CD containing the Draft Ontario Report available to members of their organization. *Id.* In this regard, both Mr. Wong and Mr. Legg testified that they could not recall receiving comments on the Draft Ontario Report in response to the

request made at the Board Meeting. *See* Ex. 2014, 92:1–93:8; Ex. 2015, 58:16–59:11.

In *Cooper Cameron*, the court determined reports to be printed publications based on evidence of “employee affidavits stating that those papers were not considered confidential and *were distributed to interested parties, including outside contractors*” and “evidence that the reports were available to participants who were allowed to share confidential data with others.” *Cooper Cameron*, 291 F.3d at 1323–24 (emphasis added). Moreover, in *Cooper Cameron*, evidence was presented “that any other interested persons exercising reasonable diligence could have sought information concerning horizontal tree subsea well designs from [joint venture] SISL, much if not all of which information was available without restriction.” *Id.* at 1324. On remand, the court directed the lower court to “take into consideration that reports need only be accessible to the interested public, . . . which in this case may be the very entities who had access to the documents: SISL joint venture members, participants, and their contractors and licensees,” noting that “those with access to the documents *were asserted to be a significant portion of the interested public.*” *Id.* (internal citations omitted) (emphasis added).

The evidence presented by Petitioner tends to show that the less than twenty attendees at the Board Meeting (*see* Ex. 1018, 1) would not have been a significant portion of the interested public, particularly in light of the 38 stakeholder entities (and associated employees) identified in Appendix B of the Draft Ontario Report. Moreover, Petitioner does not present sufficient evidence that demonstrates an interested person ordinarily skilled in the art could have exercised reasonable diligence and obtained the Draft Ontario Report. *See Northern Telecom, Inc. v. Datapoint, Corp.*, 908 F.2d 931, 943 (Fed. Cir. 1990).

Based on the discussions above regarding making report contents freely accessible, a significant portion of the interested public, and an exercise of reasonable diligence, if there is any reasonable expectation to be inferred from the evidence of record, it is that the Draft Ontario Report was subject to a reasonable expectation of confidentiality. In *Cordis*, the Court noted that “[w]here professional and behavioral norms entitle a party to a reasonable expectation that information will not be copied or further distributed, we are more reluctant to find something a printed publication.” *Cordis Corp.*, 561 F.3d at 1133–34 (quoting *Klopfenstein*, 380 F.3d at 1350–51) (internal quotation marks omitted).

At issue in *Cordis* was the confidentiality expected with respect to a monograph; the Court noted that there was no evidence showing that confidentiality was not honored, irrespective of whether any of the attendees were legally obligated to maintain confidentiality. *Id.* at 1334. The Court further pointed to the lack of evidence that the commercial entities “would have distributed, or in fact did distribute, the 1980 Monograph outside of the company.” *Id.* at 1334–35 (internal quotation marks omitted). The Court also reasoned that

There was no showing that similar documents in the past became available to the public as a result of disclosure by these or similar commercial entities, that these or similar commercial entities typically would make the existence of such documents known and would honor requests for public access, or that these or similar commercial entities had an incentive to make the document available, etc. The mere fact that there was no legal obligation of confidentiality—all that was shown here—is not in and of itself sufficient to show that . . . [an] expectation of confidentiality was not reasonable.

Id. at 1335. In the present proceeding, the evidence indicates that Enterprise draft reports are not shared with the public, and only final reports that have been through the commenting process have undergone the finalizing process. See Ex. 2015, 94:2–12. Although the evidence does not show that the Draft Ontario Report

included indicia or notice of confidentiality, these circumstances suggest that the document was nonetheless treated that way. This evidence weighs against a finding of public accessibility.

In sum, after consideration of the complete record, we find that Petitioner has not shown that the Draft Ontario Report was publicly accessible and, therefore, has not shown that it is prior art to the '101 patent.

E. Discretion Under 35 U.S.C. § 325(d)

Patent Owner contends that we should have denied the Petition because Petitioner presented “the same or substantially the same prior art or arguments” in this proceeding as in the earlier '1077 IPR. PO Resp. 2 (citing 35 U.S.C. § 325(d)). Patent Owner further contends that we abused our discretion by instituting trial in the present proceeding because we did not “explain[] how the invalidity grounds presented in this proceeding are not ‘the same or substantially the same prior art or arguments,’” and as such, our decision was arbitrary and capricious, and violates Patent Owner’s due process rights. *Id.* at 13–15. Lastly, Patent Owner contends that the Petition is barred by the doctrine of *res judicata*. *Id.* at 15.

We decline to address these issues insofar as they are moot in light of our conclusion that the Draft Ontario Report is not demonstrated to qualify as prior art and our ultimate conclusion that the challenged claims are not shown to be unpatentable in view of challenges based on the Draft Ontario Report.

III.CONCLUSION

For the foregoing reasons, we conclude that Petitioner does not demonstrate, by a preponderance of the evidence, that claims 1, 3, 5, 6, 8, and 10 are anticipated

by or would have been obvious in view of the Draft Ontario Report because Petitioner fails to establish that the Draft Ontario Report qualifies as prior art.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 1, 3, 5, 6, 8, and 10 of the '101 patent are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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