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Paper 18
Entered: June 29, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIOT GAMES, INC.,
Petitioner,

v.

PALTALK HOLDINGS, INC.,
Patent Owner.

Case IPR2018-00130
Patent 5,822,523 & 5,822,523 C1

Before THU A. DANG, KARL D. EASTHOM, and
NEIL T. POWELL, *Administrative Patent Judges.*

DANG, *Administrative Patent Judge*.

DECISION
Patent Owner's Request for Rehearing
37 .F.R. § 42.71

I. INTRODUCTION

Patent Owner filed a Request for Rehearing (Paper 14, "Req. Reh'g") of our Decision (Paper 11, "Dec.") to institute *inter partes* review of claims 1, 11–15, and 19–30 of (the "challenged claims") of U.S. Patent No. 5,822,523 and 5,822,523 C1 (Ex. 1001, the "'523 patent"). In the Decision, we instituted a trial on the following grounds asserted by Petitioner: 1) claims 1, 15, and 19–27 of the '523 patent for obviousness over Aldred and RFC 1692; and 2) claims 11–15, 23, and 27–30 of the '523 patent for obviousness over Aldred, RFC 1692, and Ulrich. Dec. 49. For the reasons stated below, Patent Owner's Request for Rehearing is *denied*.

II. ANALYSIS

When rehearing a decision on petition, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing an abuse of discretion, and "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked." 37 C.F.R. § 42.71(d).

Patent Owner argues "the Board abused its discretion in accepting Petitioner's evidence that RFC 1692 is a prior art publication to the '523 Patent." Req. Reh'g 2. Patent Owner contends the Crocker Declaration does not provide sufficient evidence that, on or before the filing date of February 1, 1996 (the "critical date") of the '523 patent, "RFC 791, RFC 1001, RFC 1459, and/or RFC 1692 were actually available to the public online, that these RFCs were actually accessed or downloaded by any member of the public, or whether and how any alleged sources such as the anonymous FTP hosts or the RFC Editor's Website were indexed or cataloged." *Id.* at 7. Thus, according to Patent Owner, "Petitioner has not

sufficiently shown that RFC 791, RFC 1001, RFC 1459, and/or RFC 1692 were 'publicly accessible' on or before the critical date," rendering the references unavailable as prior art references under 35 U.S.C. § 102.[1] *Id.* Patent Owner fails to show an overlooked or a misapprehended matter.

In our Decision, we addressed the arguments that Patent Owner made in its Preliminary Response concerning the RFCs. We determined, based on the current record and for purposes of institution, RFC 1692 and RFC 791 were "publicly accessible" to persons of ordinary skill interested in computer networking and security, respectively as of August 1994 and September 1981, i.e., before the critical date. *See* Dec. 28–33.

As we noted in the Decision,

> [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.

Dec. 32–33 (citing *SRI Int'l, Inc. v. Internet Security Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. 21 Cir. 2008)).

As pointed out in the Decision, the '523 patent itself, in several places, relies on and cites RFC documents, including RFC 791, indicating that, generally, persons of ordinary skill interested in computer networking and security (the public) would have been able to find and subsequently access RFC documents on or before the filing date of the '523 patent. *See* Dec. 32 (citing, *e.g.*, Ex. 1001, 3:48). We cited *PGMedia, Inc.*, which states "[m]uch of the development and technical management of the Internet has

[1] RFC 1001 and RFC 1459 do not appear to be at issue in this proceeding, although the parties should clarify respective positions on this point.

been by the consensus of Internet users. This is evidenced . . . by IETF and the more than 2000 RFC's which have been written and circulated.")). *Id.* (citing *PGMedia, Inc. v. Network Sols., Inc.*, 51 F. Supp. 2d 389, 406 (S.D.N.Y. 1999).[2] *PGMedia, Inc.* corroborates that RFCs were generally available to the public prior to the critical date, to help address a central concern of building a consensus for developing the Internet and associated standards, *i.e.*, not merely "today" or "*currently*" as Patent Owner contends. Req. Reh'g. 6.[3]

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[2] We also cited *VirnetX Inc.*, where the Board found RFCs were publically available notwithstanding patent owner's arguments otherwise. Dec. 30 (citing *VirnetX Inc. v. Apple Inc.*, 2018 WL 1371144 (Fed. Cir. Mar. 16, 2018) (IPR2015-00870 & IPR 2015-00871) (Rule 36)). Dec. 32. The showing in *VirnetX Inc*. involved a later critical date than at issue here. Nevertheless, the case demonstrates that RFC dates of publication generally were reliable indicators to corroborate public accessibility in light of similar evidence regarding RFC publication practices.

[3] In *PG Media*, the court states "[i]n 1987, the Internet community agreed on a new protocol, announced in Request for Comments ('RFC') 1034, dated November 1987 and written by one P. Mockapetris." *Id.* at 391. The court also notes the following:

> RFC's are formal memos produced by members of the Internet Engineering Task Force ("IETF"). The IETF is a "loosely self-organized group of people who make technical and other contributions to the engineering and evolution of the Internet and its technologies. It is the principal body engaged in the development of new Internet standard specifications." (Strawn Decl. Ex. A.) *As there is no centralized authority that controls the Internet, the Internet's smooth functioning depends on the cooperation and consensus of its users, and IETF represents an effort to meet that goal*. The situation is well summarized in NSI's 1997 S-1 filing with the SEC.

Id. at 391 n.5 (emphasis added). In context to the 1987 RFC 1034 document cited, and given that the court cites over 2000 RFC published documents

Patent Owner's contention that these "other cases . . . should not weigh against Patent Owner's position" correctly posits that the Board must solve a "case-by-case inquiry into the facts and circumstances surrounding [the RFCs] disclosure to members of the public." *Id.* (latter quote quoting *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004) (emphasis by Patent Owner)). Nevertheless, the cited cases generally corroborate the testimony of Mr. Crocker concerning practices of the IETF and the public accessibility of RFCs in general prior to and after the critical date. *See supra* notes 2, 3.

As we pointed out in the Decision, the RFC documents are as indicated in their title, "Request for Comments," "typically announcing a request for suggestions and improvements for Internet standards," and therefore, "constitute the type of documents with a main . . . purpose being for public disclosure and consideration." Dec. 32; *see also* note 3 (noting RFCs used to build consensus about the Internet). That is, the title, "Request for Comments," and statements therein further corroborate specific availability of the RFC to the public from which it seeks comments at the time of its announcement.

In the Decision, for purposes of institution, we found credible Mr. Crocker's testimony that the RFCs were available generally prior to the critical date, wherein a skilled artisan could have determined how to access particular RFCs based on mailing lists and newsletters discussing the RFCs. *See* Dec. 30–32. In particular, Mr. Crocker's testimony included the

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(numbered accordingly), the "situation" regarding RFCs and the IETF, as summarized by the court employing, in part, evidence including a 1997 SEC (Securities Exchange Commission") filing, would not have changed materially prior to the critical date (February, 1996) involved here.

following: 1) "an official summary of published RFCs appeared in each issue of the Internet Society's newsletter" which "was well-known to members of the Internet technical community as a source for an official summary of published RFCs" (*id.* at 31 (citing Ex. 1026 ¶ 24)); 2) a well-known mailing list announced RFCs to which anyone could subscribe since the late 1980s (*id.* (citing Ex. 1026 ¶ 21)); and 3) an RFC Editor publication "summarize[d] the status of all Internet protocol and service specifications" wherein "[t]hese RFCs are made publicly available pursuant to the standard RFC publication process" (*id.* (citing Ex. 1026 ¶ 23)). Mr. Crocker further testifies as follows: "Since the early 1990s, the RFC Editor repository has been freely accessible to the general public with no login, password, or membership requirement, and was similarly available to the Internet technical community since the 1970s." *Id.* (citing Ex. 1026 ¶ 26).

Patent Owner's argument that Petitioner fails to show actual publication, and fails to show indexing or cataloging, does not show an overlooked or misapprehended point. *See* Req. Reh'g. 7. Even Patent Owner concedes, "Petitioner provides evidence of general RFC practice." *Id.* As Mr. Crocker testifies, "[t]he Internet Society's newsletter was well-known to members of the Internet technical community as a source for an official summary of published RFCs," and "[a]nyone with an interest in Internet and Internet-connected technologies would have been able to locate this mailing list, subscribe, and then receive announcements of new RFCs." Ex. 1026 ¶¶ 21, 24. In other words, an RFC is a "Request for Comments" from artisans interested in the subject matter, including recipients on the mailing list and the newsletter.

In a recent case, our reviewing court clarified that documents (videos and slides) disseminated to members of even a somewhat closed group without restriction as to further dissemination may tend to indicate public accessibility of the documents, in light of other factors, even in the absence of indexing for search purposes. *See Medtronic, Inc. v. Barry*, No. 2017-1169, 2018 WL 2769092, at **8–9 (Fed. Cir. June 11, 2018) ("Further, even if the Board were correct in its assumption that Medtronic only gave the Video and Slides to the SDSG members, it did not address whether the disclosures would remain confidential.")[4] On this preliminary record, Petitioner's evidence shows sufficiently that mailing list members would have been apprised of a new RFC's contents, at least via the Internet Society's newsletter's summary, if not via the mailing list (coupled with prior knowledge of the documents via group circulation thereof), with unrestricted access to the newly published RFC documents, and without any further restriction as to dissemination. *See* Ex. 1026 ¶¶ 18–24. In other words, prior to official publication of RFC documents, "[t]he Area Director . . . *circulates* the document to the wider IETF community, *for comment*, and then decides whether to publish the document as an RFC." *Id.* ¶ 18 (emphases added). The latter testimony indicates each RFC document

[4] The *Medtronic* court noted the following: "We have stated that a printed publication 'need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication.'" *Id.* at *8 (quoting *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1365, 1364 (Fed. Cir. 2014) (characterizing *Suffolk*, *id.* at 1364, as "concluding that an electronic newsgroup post was sufficiently disseminated where the newsgroup was populated by those of ordinary skill in the art and 'dialogue with the intended audience was the entire purpose of the newsgroup postings,' even though the post was non-indexed and non-searchable")).

actually was disseminated prior to publication in order to provide further comments, and in any event, even if altered via the comment/circulation process into a final version, would have apprised group members of its contents to allow members and other interested artisans to find each document in the future.

Therefore, for purposes of institution, Mr. Crocker's testimony sufficiently shows that RFC 1692, RFC 1459, and RFC 791 were publically accessible to persons of ordinary skill interested in computer networking and security prior to the critical date.

Based on the foregoing discussion, Patent Owner fails to show an overlooked or misapprehended material matter amounting to an abuse of discretion in determining Petitioner shows sufficiently that RFC 1692, RFC 1459, and RFC 791 qualify as prior art printed publications.

III. CONCLUSION

Patent Owner has not carried its burden of demonstrating that we misapprehended or overlooked any material matters in the Decision, and has not shown an abuse of discretion in the Decision to institute an *inter partes* review of the challenged claims of the '523 patent.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Request for Rehearing is *denied*.

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