

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENS LABS LTD.,
Petitioner,

v.

UNSTOPPABLE DOMAINS INC.,
Patent Owner.

IPR2024-00872
Patent 11,558,344 B1

Before MICHAEL J. STRAUSS, CHARLES J. BOUDREAU, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

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

I. INTRODUCTION

ENS Labs Ltd. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 11,558,344 B1 (Ex. 1001, “the ’344 patent”). Petitioner filed a declaration of James McDonald (Ex. 1002) in support of the Petition. Unstoppable Domains Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). Patent Owner filed a declaration of Dr. Richard Newman (Ex. 1003) in support of the Preliminary Response.

We have jurisdiction under 35 U.S.C. § 6 (2018). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and any response thereto shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Considering the Petition, Preliminary Response, and all supporting evidence, we determine that Petitioner does not demonstrate a reasonable likelihood of prevailing for any of the challenged claims. Accordingly, we do not institute *inter partes* review.

A. *Real Parties in Interest*

ENS Labs Ltd. identifies itself as the only real party in interest for Petitioner in this proceeding. Pet. 62. Unstoppable Domains Inc. identifies itself as the only real party in interest for Patent Owner. Paper 5, 2 (Patent Owner’s Mandatory Notices).

B. *Related Matters*

The parties state they are unaware of any related litigation, reexamination certificates, or reissue applications for the ’344 patent. Pet. 62, Paper 5, 2. The parties identify U.S. Patent No. 11,876,774, issued

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Patent 11,558,344 B1

January 16, 2024, and U.S. Patent Application No. 18/513,214, filed

November 17, 2023,¹ as related to the '344 patent. *Id.*

C. The '344 Patent

The '344 patent issued January 17, 2023, from an application filed September 27, 2021, and claims priority from a provisional application filed September 28, 2020. Ex. 1001, codes (22), (45), (60). Petitioner does not contest the claim to priority. Pet. 10. The '344 patent is directed to using blockchain smart contracts to resolve a domain name or uniform resource locator (URL), such as used to reference a website, into an Internet Protocol (IP) address. Ex. 1001, 1:20–22, 1:35. The '344 patent explains the domain name system (DNS) allows a user to reference an Internet resource (e.g., website) by an associated human-friendly name (e.g., URL) rather than by the resource's IP address. *Id.* at 1:13–22. The DNS relies on centralized domain name registrars to manage URL registration and hosting. *Id.* at 1:23–25. DNS URLs are resolved (i.e., translated into IP addresses) at DNS servers. *Id.* at 17:3–4. The '344 patent seeks to decentralize management and operation of the DNS by providing a name service based on blockchain technology. *Id.* at 2:59–60. Domain name decentralizing is provided using smart contracts on a crypto blockchain that governs how domains are created and used. *Id.* at 2:59–63. “The blockchain is a decentralized and distributed computer ledger that records transactions that are publicly viewable and

¹ Patent Application No. 18/513,214 is a continuation of Patent Application No. 17/991,498, filed November 21, 2022, now U.S. Patent 11,876,774, which, in turn, is a continuation application of Patent Application No. 17/486,512, filed September 27, 2021, which issued on January 17, 2023, as the subject '344 patent. We note that the Petition and Patent Owner's Mandatory Notices both misidentified related U.S. Patent No. 11,876,774 as U.S. Patent No. 11,875,774. Pet. 62, Paper 5, 2.

verifiable.” *Id.* at 3:3–5. “A smart contract includes self-executing code that functions to implement an agreement deployed to store state and execute code on the blockchain” and “govern[s] how domains are created, managed, and utilized.” *Id.* at 3:13–15, 3:18–19.

According to the ’344 patent, resolution of a URL using a decentralized blockchain-based name service may be supported by an intermediary gateway/server or by a web browser directly or through a browser plugin/extension. Ex. 1001, 3:26–30. In response to a request to resolve a URL, based on the top-level domain² of the URL, a determination is made if the name is to be resolved using a blockchain. *Id.* at 3:33–40. “For example, extensions/top-level domains ‘crypto’ and ‘zil’ [may be] included in [a predetermined] list [of identifiers to be resolved using a blockchain] and if the domain of the name identifier includes any of these top-level domains, it is automatically determined to resolve it using a blockchain.” *Id.* at 17:10–21. If the URL is to be resolved using a blockchain, a request is made to a smart contract of the blockchain for resolution records for the domain. *Id.* at 17:25–27. Once received, “the smart contract can be invoked to obtain one or more records that can be used to resolve the domain of the name identifier to obtain the corresponding web resource.” *Id.* at 17:38–41.

² A top-level domain is identified by the “letters at [the] end of [the] domain name after [the right-most period or] dot.” Ex. 1001, 17:9–10.

D. Illustrative Claim

Of the challenged claims, claims 1, 19, and 20 are independent. Claim 1 is reproduced below with paragraph designations used in the Petition.

[1-pre] A method, comprising:

[1a] receiving a request to resolve a name of a domain of an identifier of web content;

[1b] automatically determining that the name of the domain is to be resolved using a blockchain;

[1c] determining an identifier of a non-fungible token corresponding to the domain of the identifier of the web content;

[1d] using the identifier of the non-fungible token to send a request to a smart contract of the blockchain to obtain one or more resolution records for the domain, wherein the blockchain stores the non-fungible token associating the domain to an account address of an owner of the domain;

[1e] receiving the one or more resolution records of the domain; and

[1f] utilizing the received one or more resolution records to resolve the name of the domain.

Ex. 1001, 21:25–42; Pet. 24–35. Independent claim 19 recites a system (i.e., a “machine” statutory class under § 101) and independent claim 20 recites a program product (i.e., a “manufacture” statutory class), each claim having limitations generally corresponding to those of claim 1. Ex. 1001, 22:40–23:13.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2–4, 6, 7, 10, 15, 19, 20	103 ³	Johnson, ⁴ Millegan ⁵
5	103	Johnson, Millegan, Schneider ⁶
9	103	Johnson, Millegan, Moore ⁷
8, 11	103	Johnson, Millegan, EIP137 ⁸
12–14	103	Johnson, Millegan, EIP137, Haynes ⁹
16–18	103	Johnson, Millegan, Saini ¹⁰

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, and was effective on March 16, 2013. Because the ’344 patent claims priority after the effective date of the applicable AIA amendments (*see* Ex. 1001, code (60)), we refer to the AIA version of 35 U.S.C. § 103.

⁴ Johnson, Nick, *ENS Documentation, Release 0.1* (ENS Labs, March 30, 2019) available at <https://buildmedia.readthedocs.org/media/pdf/ens/latest/ens.pdf> (last visited November 13, 2024) (Ex. 1003).

⁵ Millegan, Brantly, “ENS Now Supports Tor .Onion Address Resolution” (The ENS Name Service, August 15, 2019), <https://medium.com/the-ethereum-nameservice/ens-now-supports-tor-onion-address-resolution-9bb3bdff6217> (Ex. 1004).

⁶ Schneider et al., U.S. Patent Publication No. 2005/0235031 A1, published October 20, 2005 (Ex. 1011).

⁷ Moore, Richard, “EIP-634: Storage of text records in ENS,” May 17, 2017 (captured on the Internet Archive March 13, 2019) <https://eips.ethereum.org/EIPS/eip-634> (Ex. 1008).

⁸ Johnson, Nick, “EIP-137: Ethereum Domain Name Service—Specification,” Ethereum Improvement Proposals, No. 137, April 4, 2016 (captured on the Internet Archive Mar. 29, 2018) <https://eips.ethereum.org/EIPS/eip-137> (Ex. 1005).

⁹ Haynes, U.S. Patent Publication No. 2013/0114432 A1, Published May 9, 2013 (Ex. 1010).

¹⁰ Saini, Vaibhav, “StoragePedia: An Encyclopedia of 5 Blockchain Storage Platforms,” August 13, 2018 (captured on the Internet

Pet. 14. In addition to the references listed above, Petitioner relies on the Declaration of James McDonald (Ex. 1002).

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that a person of ordinary skill in the art “would have a Bachelor’s degree (or international equivalent) in computer science, mathematics, or related fields, and at least 2 years of experience with software programming projects including at least six months experience with blockchain technologies.”¹¹ Pet. 13 (citing Ex. 1002 ¶ 56). Alternatively, Petitioner contends,

a [person having ordinary skill in the art (“PHOSITA”)] would not need a Bachelor’s degree (or equivalent) so long as that person had sufficient relevant industry experience, such as an additional two years more of experience with software

Archive August 21, 2018) <https://hackernoon.com/storagepedia-an-encyclopedia-of-5-blockchain-storage-platform-8aa13c630ace> (Ex. 1012).

¹¹ Petitioner and its declarant, Mr. McDonald, aver in the present tense concerning the skill level of one of ordinary skill in the art when the relevant issue is the level of skill at the time of the invention.

programming projects (making the minimum for this person four years of such experience).

Id. (citing Ex. 1002 ¶ 57). However, “[t]his alternative PHOSITA would still need to have at least six months experience with blockchain technologies.”

Id.

Patent Owner does not contest Petitioner’s description with regard to the level of skill at this stage of the proceedings. Prelim. Resp. 12.

As Petitioner’s unchallenged description of the level of ordinary skill appears appropriate to the subject matter of the ’344 patent and the cited prior art, we apply it for purposes of this Decision, albeit without the two instances of the phrase “at least,” which introduce ambiguity. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (acknowledging that the prior art may reflect an appropriate level of skill in the art).

B. Claim Construction

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b) (2023). In this context, claim terms “are generally given their ordinary and customary meaning” as 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, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc).

Neither party proposes express construction of any claim terms for our consideration. *See* Pet. 14 (“Petitioner submits that all claim terms in the ’344 Patent may be interpreted according to their plain and ordinary meaning.”); Prelim. Resp. 12 (“For purposes of this Preliminary Response only, Patent Owner agrees that claim construction is unnecessary.”).

We construe only those claim terms that require analysis to determine whether to institute *inter partes* review. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). At this stage, we do not see the need to construe any claim terms to resolve the issues in dispute.

C. *Principles of Law*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

Under 35 U.S.C. § 311(b), a petitioner in an *inter partes* review may only challenge the claims of a patent based on “prior art consisting of patents or printed publications.” Petitioner has the initial burden of production to establish that there is prior art that renders the challenged claims unpatentable. *See Dynamic Drinkware*, 800 F.3d at 1379 (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008)).

For institution purposes, Petitioner has the burden to establish a reasonable likelihood that it will prevail on the merits, which includes, *inter alia*, making a threshold showing in the Petition that non-patent documents

are “printed publications” within the meaning of 35 U.S.C. §§ 102 and 311(b). 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108(c).

Whether a reference qualifies as a “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). The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the effective filing date. *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (quoting *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989)). A reference is considered “publicly accessible” upon a satisfactory showing that the 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.” *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (citation and internal quotation marks omitted).

We analyze the asserted grounds of unpatentability in accordance with these principles to determine whether Petitioner has met its burden to establish a reasonable likelihood of success at trial.

D. Asserted Obviousness of Claims over Johnson and Millegan

Petitioner contends that claims 1, 2–4, 6, 7, 10, 15, 19, and 20 are unpatentable over the combined teachings of Johnson and Millegan. Pet. 21–44. Petitioner further contends the remaining claims are unpatentable over the combined teachings of Johnson and Millegan in view of Schneider (claim 5 (Pet. 45–46)), Moore (claim 9 (Pet. 46–48)), EIP137 (claims 8 and 11 (Pet. 48–51)), Haynes (claims 12–14 (Pet. 51–55)), and Saini (claims 16–18 (Pet. 55–60)). Petitioner asserts Johnson and Millegan, in addition to EIP-137, Moore, and Saini, qualify as prior art under 35 U.S.C. §102(a)(1)

as printed publications. Pet. 15, 17–20. Patent Owner disputes Petitioner’s contentions, arguing neither Johnson nor Millegan qualifies as a prior art printed publication. Prelim. Resp. 14–37.

1. Johnson (Ex. 1003)

a. Summary of Johnson

Johnson, titled “ENS Documentation, Release 0.1,” provides an introduction and guide to using, implementing, and deploying the Ethereum Name Service (ENS) described as “a distributed, open, and extensible naming system based on the Ethereum blockchain.” Ex. 1003, i (index), 1 (Introduction). Johnson’s Introduction explains:

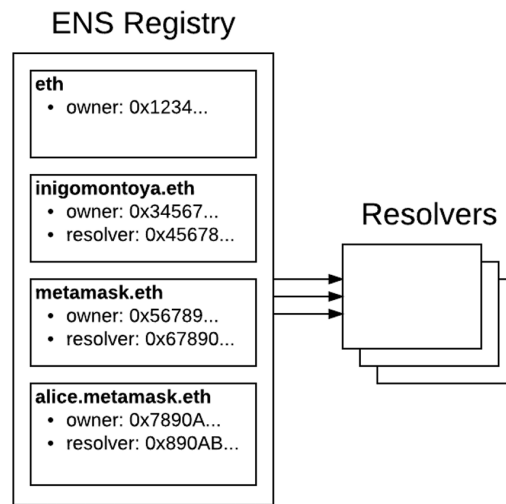
ENS’s job is to map human-readable names like ‘alice.eth’ to machine-readable identifiers such as Ethereum addresses, content hashes, and metadata. ENS also supports ‘reverse resolution’, making it possible to associate metadata such as canonical names or interface descriptions with Ethereum addresses.

ENS has similar goals to DNS, the Internet’s Domain Name Service, but has significantly different architecture, due to the capabilities and constraints provided by the Ethereum blockchain. Like DNS, ENS operates on a system of dot-separated hierarchial [sic] names called domains, with the owner of a domain having full control over the allocation of subdomains.

Top-level domains, like ‘.eth’ and ‘.test’ are owned by smart contracts called registrars, which specify rules governing the allocation of their subdomains. Anyone may, by following the rules imposed by these registrar contracts, obtain ownership of a second-level domain for their own use.

Ex. 1003, 1.

Johnson discloses that the two principal components of ENS are its Registry and Resolvers as depicted in the figure below. Ex. 1003, 1.



The figure above is reproduced from Johnson depicting a block diagram of an ENS Registry hosting the .eth top level domain smart contract and three subdomains pointing to associated domain name resolvers. Ex. 1003, 2.

The ENS registry stores information about each subdomain including owners, resolvers, and time-to-live for all records. Ex. 1003, 2. The resolvers translate ENS names into addresses using the Ethereum blockchain. *Id.*

b. Johnson’s Prior Art Status

i. Petitioner’s Evidence and Arguments

The Petition’s only substantive discussion of the prior art status of Johnson is:

Johnson, entitled “ENS Documentation, Release 0.1,” was published on March 30, 2019. EX1003. Johnson was captured and archived by the Internet Archive on December 13, 2019.³ EX1003; EX1018. Johnson was publicly accessible to a PHOSITA as of that date, if not earlier. EX1002 at 58-60.

Johnson is a printed publication and is prior art under 35 U.S.C. § 102(a)(1).

Pet. 15. Footnote 3 of the citation above reads: “An affidavit from the Internet Archive, popularly known as ‘the WayBack Machine,’ is attached as EX1018 and certifies the public availability date.” *Id.* at 15 n.3.

Exhibit 1018 is an affidavit from Nathaniel E. Frank-White (“Frank-White Affidavit”), a Record Request Processor at the Internet Archive. Ex. 1018 ¶ 1. The Frank-White Affidavit explains that the Internet Archive is “a website that provides access to a digital library of Internet sites and other cultural artifacts in digital form.” *Id.* ¶ 2. The Frank-White Affidavit states that “the Internet Archive has created a service known as the Wayback Machine,” which “makes it possible to browse more than 450 billion pages stored in the Internet Archive’s web archive.” *Id.* ¶ 3. The Frank-White Affidavit describes that the Wayback Machine allows users to “search the archives by URL (i.e., a website address),” and that “[i]f archived records for a URL are available, the visitor will be presented with a display of available dates,” which the user may select to browse an archived version of the file for that date. *Id.* The Frank-White Affidavit also explains the format of URLs the Internet Archive assigns to the archived files and how those relate to the date that the file was archived. *Id.* ¶ 5.

Exhibit A of the Frank-White Affidavit includes screenshots of the Internet Archive’s records for the archived files for the URLs and dates specified. *Id.* ¶ 6. These screenshots appear to be copies of Petitioner’s Exhibit 1005, i.e., the “EIP-137: Ethereum Domain Name Service – Specification,” from the Ethereum.org website (Ex. 1018, 4–11) and Petitioner’s Exhibit 1004, i.e., Millegan (Ex. 1018, 12–17). Exhibit B of the Affidavit are copies of the Internet Archive’s records for the archived files

for the URLs and dates specified. *Id.* ¶ 7. Exhibit B appears to be a copy of Johnson, titled “ENS Documentation, Release 0.1,” and Petitioner’s Exhibit 1003. Ex. 1018, Ex B.

Mr. McDonald’s declaration cites the Frank-White Affidavit (Ex. 1018) in asserting that Johnson (Ex. 1003) was captured and archived by the Internet Archive on December 13, 2019. Ex. 1002 ¶ 59.

Mr. McDonald further avers as follows:

In my opinion, Johnson would have been publicly accessible to a PHOSITA as of at least December 13, 2019, if not by March 30, 2019, because Johnson is what is known as a developer’s guide, which is intended to guide developers in the use and implementation of the features and protocols described therein. Moreover, Johnson was published by Ethereum Name Service on Read the Docs’ website that was widely known to software developers to store and publish their user documentation. Johnson and the URL address where it was located were also cited in IEEE academic publications. See, e.g., EX1053 at 19, 32, fn192; EX1054 at 271, 278, fn.6. Thus, a PHOSITA would have accessed Johnson in the course of keeping up with latest developments in Ethereum.

Ex. 1002 ¶ 59.

ii. Patent Owner’s Arguments

Patent Owner raises a number of arguments contending that Petitioner has failed to meet its burden to show that Johnson is prior art. Prelim. Resp. 28–38. First, Patent Owner argues that the Petition itself is insufficient. *Id.* at 28–29. Second, Patent Owner asserts the Frank-White Affidavit attesting to capture of the Johnson document by the Wayback Machine fails to evidence public accessibility of the document. *Id.* at 29–30. Third, Patent Owner argues the McDonald Declaration is deficient. *Id.* at 30–37. In particular, Patent Owner argues (a) the McDonald Declaration is conclusory and at odds with Dr. Newman’s testimony (*id.* at 31–32),

(b) the McDonald Declaration lacks “evidence that a person of ordinary skill could have found Johnson” (*id.* at 32–34), and (c) publications asserted as citing to Johnson (Exs. 1053, 1054) “do not provide evidence that Johnson was published before the critical date”¹² (*id.* at 34–37).

iii. Analysis

Patent Owner’s arguments in connection with its challenge to Johnson as prior art raise significant questions as to Johnson’s status as a printed publication before the filing date of the application for the challenged patent. As discussed below, we agree with Patent Owner’s contention (*see* Prelim. Resp. 20–21) that Petitioner has failed to present sufficient evidence or argument that an interested party exercising reasonable diligence would have located Johnson. *See Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (“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.’” (quoting *Kyocera*, 545 F.3d at 1350)).

(a) Adequacy of the Petition

Patent Owner argues “[t]he Petition[’s] showing is facially insufficient to establish that Johnson qualifies as a prior art printed publication.” Prelim. Resp. 28. Patent Owner asserts “the Petition only presents the following short conclusory assertion, devoid of any substantive explanation or

¹² Patent Owner asserts that the priority date of the ’344 patent is the provisional application filing date, although Patent Owner has not offered evidence and argument to support that the patent claims are entitled to the filing date of the provisional application. Nonetheless, all of the references asserted, and particularly the Johnson reference discussed here, are alleged by Petitioner to have prior art status prior to the September 28, 2020 provisional application filing date. *See* Pet. 14–21.

analysis, that Johnson qualifies as a prior art publication,” referring to and quoting page 15, lines 2–6 of the Petition. *Id.* Patent Owner additionally argues, “to the extent that the Petition purports to make its arguments by incorporating the cited testimony from the Frank-White Affidavit and the McDonald Declaration, the Board should reject this improper attempt [at incorporation].” *Id.* (citations omitted).

The determination of whether a document is a “printed publication” under 35 U.S.C. § 102 is a legal conclusion and “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Klopfenstein*, 380 F.3d at 1350; *Kyocera*, 545 F.3d at 1350. It has long been recognized that the touchstone as to whether an asserted reference qualifies as prior art is public accessibility. *See In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). “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.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (emphasis added) (citing *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). “[A] variety of factors may be useful in determining whether a reference was publicly accessible.” *Lister*, 583 F.3d at 1312.

“[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); *see also id.*

at 16 (same). “This standard is far more than is required in typical notice pleading, which only requires that a party make plausible claims.” *Id.* at 13. Moreover, “there is no presumption . . . in favor of finding a reference to be a printed publication under [37 C.F.R.] § 42.108(c) or any other authority.” *Id.* at 16.

Hulu also recognizes that determining whether a document is a printed publication involves “a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public,” and this determination is satisfied in different ways depending on the particularities of the document. *Id.* at 9 (quoting *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018)). For example, for manuscripts and dissertations, we might inquire whether a reference was sufficiently indexed, catalogued, and shelved, while for other documents such as information displayed at meetings, we might look to other facts, such as their purpose and whether members of the public were permitted to copy the information,¹³ to determine whether the reference has been disseminated or otherwise been made available to the extent that persons interested and ordinarily skilled can locate it exercising reasonable diligence. *Id.* at 9–11.

Furthermore, according to the November 2019 Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”),¹⁴ “§ 42.6(a)(3) prohibits incorporating arguments by reference from one document into another. Thus, parties that incorporate expert testimony by reference in their

¹³ See, e.g., *In re Klopfenstein*, 380 F.3d 1345, 1347–50 (Fed. Cir. 2004) (finding that posters displayed at two professional conferences were printed publications because their entire purpose was public communication of the relevant information)

¹⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board.” CTPG 35–36 (citing *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative)). Also, under our rules, the petition must contain a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2); *see also, e.g., Fidelity Nat'l Info. Servs., Inc., v. DataTreasury Corp.*, IPR2014-00489, slip op. at 9 (PTAB Aug. 13, 2014) (Paper 9) (“We, therefore, decline to consider information presented in a supporting declaration, but not discussed sufficiently in a petition.”).

We distinguish, however, between improper incorporation of argument by reference and proper citation to a document for evidentiary support of arguments made in the petition. *Compare Conopco, Inc. v. Proctor & Gamble Co.*, IPR2013-00510, slip op. at 8 (PTAB Feb. 12, 2014) (Paper 9) (declining to consider information in an expert declaration but not discussed in the petition), *with Kamada, Ltd. v. Grifols Therapeutics Inc.*, IPR2014-00899, slip op. at 23 (PTAB Dec. 18, 2014) (Paper 8) (considering an expert declaration where the petition contained a detailed explanation identifying where each reference disclosed each claim limitation). There is a balance between making sure the petition is complete, as a stand-alone document, in stating everything necessary to meet the elements of establishing a reasonable likelihood of unpatentability, and the need for citation to, and reliance on, evidence to support each argument. Here, the balance tips, slightly, in favor of Petitioner.

We determine the Petition itself includes appropriate argument by asserting “Johnson is a printed publication and is prior art under 35 U.S.C. § 102(a)(1)” because “Johnson was publicly accessible to a PHOSITA as of

that date.” Pet. 15. Rather than argument, the Petition relies on evidence in the McDonald Declaration (Ex. 1002) and the Frank-White Affidavit (Ex. 1018). *Id.* In particular, the Petition cites Mr. McDonald’s declaration for testimonial evidence that a PHOSITA would have considered Johnson to be a developer’s guide for using and implementing ENS features and protocols, for evidence that Johnson was accessible on a “website that was widely known to software developers,” and for documentary evidence of accessibility based on citations to Johnson appearing in IEEE academic publications. Ex. 1002 ¶ 59 (citing Exs. 1053, 1054). Similarly, the Petition relies on the Frank-White Affidavit for evidence that Johnson was available to the public before the effective filing date of the ’344 Patent. Pet. 15 (citing Ex. 1018). Thus, the Petition properly references and cites to evidence rather than attempting to improperly incorporate argument from the McDonald Declaration and the Frank-White Affidavit.

(b) *Frank-White Affidavit*

Patent Owner contends “the Frank-White Affidavit fails to support public accessibility of Johnson.” Prelim. Resp. 29. Patent Owner argues the “Affidavit only states that the Wayback Machine is searchable ‘by URL (i.e., a website address),’ rather than using any combination of search words.” *Id.* (citing Ex. 1018, 1). Patent Owner asserts the Affidavit provides “no evidence that an interested person (who did not already know of the URL, i.e., ‘<https://buildmedia.readthedocs.org/media/pdf/ens/latest/ens.pdf>’ (see EX1018, 19)) would have located Johnson either using the Wayback Machine or by querying an external internet search engine before the critical date of the ’344 patent.” *Id.* at 30.

We agree with Patent Owner’s argument. Petitioner presents evidence that Johnson could be downloaded from a website on the Internet in 2019, as

evidenced by the Frank-White Affidavit, which states that Johnson is a copy of a document on a website archived by the Internet Archive. *See* Ex. 1018. That a person might have been able to download Johnson through public means is not evidence that Johnson was “made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer*, 445 F.3d at 1378. The Frank-White Affidavit’s evidence of public accessibility amounts to little more than Johnson was available on the Internet by December 13, 2019. Pet. 15; Ex. 1018 ¶¶ 1–5, 7, Ex. B. However, because the Wayback Machine is only searchable by URL, as attested to in the Frank-White Affidavit, this does not suffice to support that one of ordinary skill in the art would have sought out the Read the Docs website and, once there, located Johnson without prior knowledge of Johnson and the URL at which Johnson was available.

Accordingly, the Frank-White Affidavit alone is insufficient to prove public accessibility of Johnson.

(c) *McDonald Declaration*

(i) *Well-Known Characterization of the Read the Docs Website*

Mr. McDonald asserts “Johnson was published by Ethereum Name Service on Read the Docs’ website that was widely known to software developers to store and publish their user documentation.” Ex. 1002 ¶ 59. Patent Owner argues “the record, however, is devoid of any corroborating evidence establishing that this website was widely known to those in the art and, consequently, the McDonald Declaration’s unsupported assertion should be given no weight.” Prelim. Resp. 31 (citing *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1367 (Fed. Cir. 2019); *Upjohn Co. v.*

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Mova Pharm. Corp., 225 F.3d 1306, 1311 (Fed. Cir. 2000); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022); 37 CFR § 42.65). Moreover, Patent Owner provides evidence to contradict Mr. McDonald’s “well-known” characterization of the Read the Docs website. *Id.* at 31–32. In particular, Patent Owner’s declarant, Dr. Newman, testifies that he was personally unaware that ENS published a developers’ guide on the Read the Docs website or that the guide was accessed by others. *Id.* at 32 (quoting Ex. 2001 ¶ 30).

We agree with Patent Owner’s argument. In particular, in the absence of sufficient corroborating evidence, we give little weight to Mr. McDonald’s characterization of the Read the Docs website as being well known for storing and publishing user documentation. Thus, there is insufficient showing that the Read the Docs website was sufficiently well known in the community of interest to persuasively demonstrate public accessibility of Johnson at the website.

(ii) *Whether a person of ordinary skill could have found Johnson*

Patent Owner contends, “[e]ven if Read the Docs’ website was widely known (which Petitioner has not shown), the McDonald Declaration provides neither evidence nor explanation of how an interested person would have located Johnson on the Read the Docs website before the critical date.” Prelim. Resp. 32 (citing *Hulu*, Paper 29 at 16). Patent Owner argues:

The McDonald Declaration fails to provide any evidence, or even argument, sufficient to establish that a skilled artisan would have been able to locate Johnson on the Read the Docs website using that website’s search function or that Johnson was “indexed . . .

(through search engines or otherwise)” and thus locatable by an internet search engine.

Prelim. Resp. 33 (citing *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1381 (Fed. Cir. 2012); *Blue Calypso*, 815 F.3d at 1350).

Moreover, Patent Owner contends evidence of present-day unsuccessful searches to locate Johnson on the Read the Docs website suggests Johnson was not reliably indexed, if at all, during the relevant time period. Prelim Resp. 34. In particular, Patent Owner argues, “Dr. Newman accessed the currently available Read the Docs website and ‘[u]sing currently available search functions . . . performed a search for ‘Nick Johnson,’ which yielded 108 results but none of which led to the Johnson reference filed by Petitioner.’” *Id.* at 33 (quoting Ex. 2001 ¶ 31; citing Ex. 2006 (screen capture of results of search for “Nick Johnson” on Read the Docs)). Patent Owner further argues the failure of additional searches to find Johnson also suggests it was not properly indexed so that it could be located by a skilled artisan. *Id.* at 33–34 (citing Ex. 2001 ¶ 31; Ex. 2007; Ex. 2008).

We have reviewed the argument and supporting evidence, which support a finding that a search of Read the Docs for Johnson would not have been successful in locating Johnson. Thus, Petitioner has made an insufficient showing of a reliable search functionality sufficient to demonstrate public accessibility of Johnson.

*(iii) Whether Citations by Others of Johnson
Evidence Public Availability*

Although the Petition does not specifically argue or provide authority for a finding that citations by academic publications to a document are evidence of public accessibility, Mr. McDonald states “Johnson and the URL address where it was located were also cited in IEEE academic

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publications.” Ex. 1002 ¶ 59 (citing Ex. 1053, 19, 32 n.192; Ex. 1054, 271, 278 n.6).

Patent Owner contends the citing documents fail to evidence Johnson was published before the critical date. Prelim. Resp. 34.

Ex. 1053 (“Shi”)

Petitioner identifies Exhibit 1053 as follows:

Shi, Z. et al., “Integration of Blockchain and Auction Models: A Survey, Some Applications, and Challenges,” IEEE Communications Surveys & Tutorials, Vol. 25, No. 1, First Quarter 2023, pp. 497–537, <https://doi.org/10.1109/COMST.2022.3222403>. Available: <https://ieeexplore.ieee.org/stamp/stamp.jsp?arnumber=9953944>.

Pet. viii (List of Exhibits).

Shi includes citations to numbered references, including reference [217] cited as follows:

[217] N. Johnson. “ENS Documentation.” 2019. Accessed: Oct. 3, 2021. [Online]. Available: <https://buildmedia.readthedocs.org/media/pdf/ens/latest/ens.pdf>

Ex. 1053, 39.

Patent Owner contends, because Shi’s citation to Johnson indicates Johnson was accessed on October 3, 2021, i.e., not only after the September 28, 2020 provisional application date, but also after the September 27, 2021 application for the ’344 patent, it “cannot provide evidence that persons in the art [were] aware of Johnson and were able to access the document before the critical date.” Prelim. Resp. 35.

We agree that Shi’s citation to Johnson is based on accessing Johnson after the filing date of the application for the ’344 patent, which eliminates any evidentiary value of Shi’s citation as evidence of public accessibility as of the filing date.

Ex. 1054 (“Seike”)

Petitioner identifies Exhibit 1054 as follows:

Seike, H., et al., “Blockchain-Based Ubiquitous Code Ownership Management System without Hierarchical Structure,” 2018 IEEE SmartWorld, Ubiquitous Intelligence & Computing, Advanced & Trusted Computing, Scalable Computing & Communications, Cloud & Big Data Computing, Internet of People and Smart City Innovation (SmartWorld/SCALCOM/UIC/ATC/CBDCOM/IOP/SCI), Guangzhou, China, 2018, pp. 271-276, doi: 10.1109/SmartWorld.2018.00081. Available: <https://ieeexplore.ieee.org/document/8560059>.

Pet. viii–ix (List of Exhibits).

Seike also includes citations to numbered references, including reference [6] cited as follows:

[6] N. Johnson, ENS Documentation Release 0.1, <https://media.readthedocs.org/pdf/ens/latest/ens.pdf>.

Ex. 1054, 6.

Patent Owner contends, because Seike indicates it was published in 2018, its citation [6] cannot be to the asserted Johnson document that is asserted to be published in 2019, i.e., the following year. Prelim. Resp. 36. Patent Owner further argues that the citation by Seike lists a different URL than used by the Internet Archive to retrieve the 2019 Johnson document and that Petitioner fails to explain the discrepancy. *Id.* at 36–37.

Petitioner’s failure to explain the discrepancies in Seike’s citation to Johnson greatly diminishes or eliminates any value of the citation as evidence of public accessibility to establish publication of Johnson before the ’344 patent’s filing date.

iv. Conclusion

For the reasons discussed above, we agree with Patent Owner that Petitioner has failed to adequately show that Johnson was publicly

accessible before the '344's filing date and, therefore, has failed to adequately show that Johnson is a prior art printed publication under 35 U.S.C. § 102(a)(1).

2. Millegan (Ex. 1004)

Petitioner provides a brief discussion of Millegan's status as prior art (Pet. 17), and Patent Owner raises a number of arguments that Petitioner has failed to meet its burden to show that Millegan is prior art (Prelim. Resp. 14–28). Because our determination that Petitioner has failed to adequately show that Johnson is a prior art printed publication under 35 U.S.C. § 102(a)(1) is dispositive of our Decision, we find it unnecessary to decide the availability of Millegan as a prior art printed publication under 35 U.S.C. § 102(a)(1).

c. Conclusion Regarding Printed Publication Status of the References

For the above reasons, we are not persuaded by the record before us that Johnson qualifies as a prior art printed publication. All asserted grounds for unpatentability rely, at least in part, on the disclosure of Johnson. Accordingly, because the record does not persuasively support Johnson as a publicly accessible printed publication, we find that Petitioner has not established a reasonable likelihood of prevailing on any of its grounds of unpatentability.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner does not demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims, and thus, we do not institute an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

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