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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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Use Wayback Machine with Caution: PTAB Excludes Website Printouts from Wayback Machine

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March 26, 2015 — In a decision on the patent owner’s motion to exclude evidence, the PTAB excluded certain website printouts from the Wayback Machine as lacking authentication.

[IPR2013-00578 – *Neste Oil Oyj v. REG Synthetic Fuels, LLC* \(Paper 53, March 12, 2015\)](#)

The petitioner filed a petition requesting *inter partes* review of a patent based in part on a reference that the petitioner alleged was a prior art printed publication. The patent owner served objections on the petitioner contending that the reference had not been qualified as prior art because the publication date had not been established. In response to the objection, the petitioner submitted a declaration, with the petitioner’s counsel as the declarant, accompanied by printouts of websites obtained from the Internet Archive, commonly referred to as the “Wayback Machine.” The Wayback Machine caches webpages obtained by a web crawler that crawls the Internet. Upon providing the Wayback Machine with a web address (e.g., a URL), the Wayback Machine may return an image of a webpage corresponding to the web address that was captured by the web crawler on a particular date.

In the instant case, the declarant used the Wayback Machine to obtain printouts of websites evidencing that the relied upon reference qualifies as prior art. The patent owner subsequently filed a Motion to Exclude the Wayback Machine printouts on the basis that they were not authenticated. The patent owner argued that the declarant, who submitted the Wayback Machine printouts, did not have personal knowledge of their contents. Meanwhile, the petitioner argued that the declarant relied on her personal knowledge of the retrieval of the Wayback Machine printouts.

The Board noted that authentication of an item of evidence requires that “the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Federal Rules of Evidence 901(a). The Board stated that “[w]hen offering a printout of a webpage into evidence to prove the website’s contents, the proponent of the evidence must authenticate the information from the website itself, not merely the printout.” As an example, the Board explained that a statement from a person with knowledge of the website, such as a web master, would be sufficient to authenticate the Wayback Machine printouts. In the instant case, however, the Board found that the declarant did not have the personal knowledge of the websites depicted in the Wayback Machine printouts. Thus, the Board concluded that the Wayback Machine printouts lacked authentication and granted the patent owner’s motion to exclude them.

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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