VIDSTREAM LLC v. TWITTER, INC., Appeal Nos. 2019-1734 and 2019-1735 (Fed. Cir. November 25, 2020). Before Newman, O'Malley, and Taranto. Appealed from the Patent Trial and Appeal Board.

Background:

Twitter filed two inter partes review petitions asserting that two of Vidstream's patents were invalid as obvious over a combination of a book (Bradford) and various patent references. Vidstream argued that the Bradford reference was not prior art because it was published on December 13, 2015 as stated on a cover page of the copy of Bradford submitted with the petitions, which is after the effective date for Vidstream's patents. Twitter responded by submitting additional evidence to establish that the Bradford reference was first published in November 2011, and thus constitutes prior art under §102.

Vidstream filed a motion to exclude all of the additional evidence submitted by Twitter after the filing of the petitions because the additional evidence was not timely filed. The Board disagreed and held that the additional evidence was submitted as a direct response to arguments raised by Vidstream. The Board subsequently held that the Bradford reference constituted prior art and all claims of Vidstream's patents were unpatentable as obvious. Vidstream appealed.

Issues/Holdings:

Did the Board err in entering and considering the additional evidence submitted by Twitter after the filing date of the petitions? - No, affirmed.

Did the Board err in finding that the Bradford reference constituted prior art under §102 in light of the additional evidence submitted by Twitter? - No, affirmed.

Discussion:

First, the Federal Circuit agreed that the Board properly allowed Twitter to submit additional evidence after the filing of the petitions. The Federal Circuit referred to the Trial Practice Guide, which states that a petitioner may submit new evidence "if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness." Twitter argued, and the Federal Circuit agreed, that the additional evidence submitted by Twitter was a legitimate reply to Vidstream's challenge of the publication date of the Bradford reference. The Federal Circuit then noted that Vidstream was given an opportunity to file a sur-reply to respond to all of the additional evidence submitted by Twitter.

Second, the Federal Circuit affirmed the Board's finding that the Bradford reference constituted prior art under 35 U.S.C. §102 in light of the totality of the evidence submitted by Twitter. The Federal Circuit reviewed the evidence, which included a copy of the U.S. Copyright Office Certificate of Registration showing the date of first publication as November 8, 2011, a Library of Congress copy of Bradford, a Declaration stating the copies are identical, and an Amazon webpage from the Internet Archive. The Federal Circuit agreed with the Board that all of this evidence supports a first publication date in November or December of 2011, which supports that the Bradford reference constitutes prior art under §102.