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Can an obscure online post constitute prior art?

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Abstract: Years ago, the go-to online hangouts were Usenet newsgroups. These discussion forums have now been largely usurped by social networking sites. Nonetheless, this article looks at a case in which an appeals court considered whether a post on an obscure Usenet newsgroup could constitute prior art and, therefore, invalidate a patent.

Suffolk Technologies, LLC v. AOL, Inc., No. 2013-1392, May 27, 2014 (Fed. Cir.)

Years ago, the go-to online hangouts were Usenet newsgroups. These discussion forums have now been largely usurped by social networking sites. Nonetheless, in *Suffolk Technologies, LLC v. AOL, Inc.*, the U.S. Court of Appeals for the Federal Circuit considered whether a post on an obscure Usenet newsgroup could constitute prior art and, therefore, invalidate a patent.

Decoding the arguments

Suffolk Technologies owns a patent on methods and systems for controlling a server that supplies files to computers. In June 2012, Suffolk sued Google for infringement. (It also sued AOL, but the parties settled.)

In response, Google argued that the patent's claims were anticipated based on a June 1995 nonindexed, nonsearchable post in a newsgroup — nine months before the priority date claimed for Suffolk's patent. The district court found the patent invalid, prompting Suffolk to appeal.

Accessing a document

An invention isn't patentable if it was disclosed in "prior art," such as a printed publication, before the filing date of the patent application. As the Federal Circuit explained here, "public accessibility" is the touchstone in determining whether a reference constitutes a "printed publication."

A document is publicly accessible if it has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject can locate it exercising reasonable diligence. Suffolk argued that the newsgroup post's audience didn't comprise individuals of ordinary skill in the subject, but mostly beginners. The company also argued that locating the post would be difficult.

The Federal Circuit found that Suffolk misunderstood the level of ordinary skill in the subject at the time when it contended that the newsgroup was populated mostly by beginners, not those of ordinary skill. The court pointed out that only those with access to a university or corporate computer, a subset of those more likely to be skilled, could use newsgroups.

As to locating the post, the Federal Circuit found that newsgroups were organized in a hierarchical manner, making it easy for an interested party to locate a list of posts on the topic. Moreover, a printed publication needn't be easily searchable if it was sufficiently disseminated at the time of publication. The court determined that this was the case here because the post elicited at least six responses in the week after its publication, and many more people may have viewed the posts without commenting.

Searching deep

For patent holders in today's age of big data, the costs of an inadequate prior art search can be high. In this case, Suffolk lost not only its infringement case, but also its patent.