

Keywords: prior art; printed publication; public accessibility; 35 U.S.C. §102(b); dissemination

General: Whether a publication posted to a non-indexed FTP site is 102(b) prior art raises a genuine issue of material fact.

SRI Int'l v. Internet Security Systems
85 U.S.P.Q.2d 1489 (Fed. Cir. 2008)
Decided January 8, 2008

I. Facts

SRI owns U.S. Patent Nos. 6,484,203 (the '203 patent), 6,708,212 ("the '212 patent"), 6,321,338 ("the '338 patent") and 6,711,615 ("the '615 patent") related to intrusion detection and cyber security. The four patents originated from an application filed on November 9, 1998. SRI filed suit against Internet Security Systems (ISS) and Symantec Corp. for infringement of all four patents. ISS filed a motion for summary judgment of invalidity based on two of SRI's references: 1) A paper entitled "EMERALD: Event Monitoring Enabling Responses to Anomalous Live Disturbances" ("EMERALD 1997"); and 2) A publication entitled "Live Traffic Analysis of TCP/IP Gateways" ("Live Traffic").

SRI posted the EMERALD 1997 paper on its File Transfer Protocol (FTP) server in June 1997. In October 1997, SRI presented the EMERALD 1997 paper at a conference, which then published the paper after peer-review. The EMERALD 1997 paper describes a variety of techniques, including early research into Intrusion Detection Import System (IDES) technology, and describes a wide range of statistical measures to profile user behavior and detect network anomalies. The EMERALD 1997 paper and the '212 patent specification contain overlapping material, including two identical figures. Both the EMERALD 1997 paper and the '212 patent describe the NIDES algorithm and also share additional descriptions. SRI did not argue that the EMERALD 1997 fails to disclose each limitation of the claims of the '212 patent; instead, SRI argues that the EMERALD 1997 paper is not an enabling disclosure.

The Live Traffic paper is also based on EMERALD, and is incorporated by reference in all four patents. SRI displayed the Live Traffic paper on its website on November 10, 1997, and listed the paper in a disclosure to the government agency funding the research. The Live Traffic paper was published on December 12, 1997, in the 1998 Symposium on Network and Distributed Systems Security (SNDSS), and the Live Traffic paper was cited in the IDS of all four patents and the original application filed on November 9, 1998.

The Live Traffic paper was submitted to the Internet Society (ISOC) for inclusion in the 1998 SNDSS on August 1, 1997. On this date, one of the authors, Mr. Porrás, send an email to the program chair of SNDSS with the paper attached. Mr. Porrás also indicated that the paper would be available on the SRI FTP server, and included the specific FTP address: <ftp://ftp.csl.sri.com/pub/emerald/ndss98.ps>. Additionally, there were seven instances in which Mr. Porrás gave the EMERALD subdirectory of the FTP server as an address to find other papers for the EMERALD project.

ISS moved for summary judgment that the four patents were invalid under §102(b) based on the Live Traffic paper. IS also moved for partial summary judgment that the EMERALD 1997 paper was enabling and was prior art. SRI moved for partial summary judgment that the Live Traffic was not a printed publication under §102(b) and that the EMERALD paper was not enabling and could not anticipate.

The district court granted ISS' summary judgment motions, determining that the Live Traffic paper was a printed publication and anticipated all claims of the four patents. The district court also found the

EMERALD 1997 paper enabling and anticipated the '212 patent. SRI appealed the district court's grant of summary judgment.

II. Issues

1) Is there a genuine issue of material fact that the EMERALD 1997 paper disclosed sufficient information to be enabling and invalidate the '212 patent?

2) Is there a genuine issue of material fact that the Live Traffic paper was accessible to the public before the critical date?

III. Discussion

1) No. The court affirmed the district court's ruling of invalidity of the '212 patent. The court determined that "[b]ased on the 212 patent specification, the EMERALD 1997 paper, and the record before the district court, no reasonable jury could conclude that the EMERALD 1997 paper did not enable statistical profiling of network traffic." The court noted that "[t]he standard for enablement of a prior art reference for purposes of anticipation under section 102 differs from the enablement standard under 35 U.S.C. §112." Anticipation in such a case requires that "suggestions be enabled to one of skill in the art." The court pointed to the identical figures and similar descriptions in the '212 patent and the EMERALD 1997 paper, including the NIDES algorithm. The court also noted that "these disclosures helped the inventors obtain issuance of the '212 patent...[t]he issuance itself shows that the specification satisfied the enablement requirements..." The court gave very little weight to SRI's expert's testimony, stating that he just restated their position and didn't analyze differences between the '212 patent and the EMERALD 1997 paper.

2) Yes. The court began by stating that "'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication...'" Reviewing the arguments of each party, the court noted that SRI argued that the availability of the Live Traffic paper was communicated in a private pre-publication communication. Further, SRI argued that the district court erred in determining the ability of one having ordinary skill in the art to navigate the FTP server's directories to find the Live Traffic paper. Additionally, SRI noted that the name of the paper, ndss98.ps, was not indexed or catalogued in any meaningful way. ISS argued that posting to a publicly accessible FTP server made the paper publicly available to an interested person of ordinary skill in the art. Additionally, posting to a public server could not be a private transmission as argued by SRI.

The court reviewed several previous decisions on public accessibility that covered a broad spectrum of facts. The court determined that the present case falls between *Application of Bayer* (uncatalogued thesis on library shelves known only to three faculty members found to not be printed publication when a customary search could not have made the work reasonably accessible) and *In re Klopfenstein* (publicly displayed posters were printed publications because their purpose was public communication of the information therein). The court analogized the Live Traffic paper to an uncatalogued thesis, with no index or other tools on the FTP server for finding the paper. The court stated that none of the directory names and structures or README files identified the paper. Further, similar to *Bayer*, only one person knew of the paper. Because Mr. Porras had to provide the entire FTP address for the paper to the conference chair, the court took this as evidence that one of ordinary skill in the art would have been unable to find the paper. The court also noted that the Live Traffic paper was not ready for publication, but posted to "facilitate peer review in preparation for later publication."

However, the court also reviewed the similarities to *Klopfenstein*, stating that the paper was available to anyone with knowledge of the FTP server and the directories. The court stated that the Live Traffic paper was "most closely analogous to placing posters at an unpublicized conference with no attendees." Further,

“while actual retrieval is not a requirement for public accessibility,” the court found that the record does not show anyone accessed the paper during the seven days it was available, which suggested absences of actual public accessibility. In reviewing the other instances in which Mr. Porras gave out the location of other papers, the court found that in each case Mr. Porras provided the “full path and filename of the paper, presumably to provide an adequate research aid for a user to locate the paper.” Thus, the court concluded that “the record offers no suggestion that because people had been told that they could find other papers in the past in the /pub/emerald subdirectory, they would—unprompted—look there for an unpublished paper with a relatively obscure filename.” Finding the Live Traffic paper closer to *Bayer* than *Klopfenstein*, the court vacated the summary judgment ruling and remanded for “a more thorough determination of the publicity accessibility of the Live Traffic paper based on additional evidence and in concert with this opinion.”

IV. Dissent

Judge Moore dissented-in-part from the majority opinion. Judge Moore affirmed the finding with regard to the EMERALD 1997 paper, but disagreed with the majority’s conclusion that the Live Traffic paper needed further determination of public accessibility. Judge Moore’s main point of contention was that SRI did not introduce “any evidence showing a genuine issue of material fact as to the public accessibility of the Live Traffic paper, and attorney argument, no matter how good, simply cannot fill this void.” Under Rule 56 of the FRCP, where the defendants support their summary judgment motion with evidence, “a party may not overcome a grant of summary judgment by merely offering conclusory statements.”

In a thorough dissent, Judge Moore attacked each of the majority’s reasons for finding a genuine issue of material fact with regard to public accessibility of the Live Traffic paper. The highlights of her dissent:

- The FTP server was easily navigable to a “computer savvy” person of ordinary skill in the art
- Mr. Porras directions to various papers included directory names that indicate the recipient would know how to navigate the directory and find the paper
- The FTP server was used by the cyber security community at the relevant time, including citations and references on newsgroups (which often just cited the FTP server leaving navigation up to the reader)
- Unlike the library cases, the filename ndss98.ps was not obscure as it is an acronym for the conference, and the community also was familiar with the EMERALD name. Judge Moore analogized the navigable directory to a “research aid” or “customary research tool” in the case law, stating “[i]f a librarian directed a researcher to a particular shelf of books on intrusion detection, even if a book on that shelf had an obscure title, the fact that the librarian referred to the shelf as containing books on intrusion detection would provide enough direction for the researcher to know that the book was related to intrusion detection.”
- Further, the FTP server was used for cyber security work in a subdirectory named for a well-known project (EMERALD): “[I]t is ironic that SRI, which is in the intrusion detection business, argues that those skilled in the art of intrusion detection could not detect information purposefully posted on the internet by a member of the cyber security community.”
- Under the *Klopfenstein* factors, the paper was disseminated to the public: 1) The paper was available for double the amount of time as in *Klopfenstein*; 2) The target audience knew how to use FTP servers and used this particular server to share information; 3) there was no expectation that the paper would not be copied, as there were no protective measures taken by SRI; and 4) Copying the paper from the FTP site is relatively simple.