

The 'Wayback Machine' in Patent Prosecution and Litigation
by Kirk Coombs

"The [Wayback Machine](#) (WBM), provided by [archive.org](#), periodically "crawls" selected websites and archives their contents. This post provides an overview of general operation and limitations of the Wayback Machine, how to use it to obtain historical versions of websites, and how it may be useful in connection with Intellectual Property prosecution and litigation.

In the context of patent law, the WBM can be an important source of prior art. A reference qualifies as a printed publication, for prior art purposes, if it "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." *In re Wyer*, 655 F.2d 221, 226 (C.C.P.A 1981) (*quoting I.C.E Corp. v. Armco Corp.*, 250 F. Supp. 738, 743 (S.D.N.Y. 1966)). In other words, a webpage may constitute a "printed publication," and qualify as prior art as of the date that it was posted and made publicly available. Often, however, the dynamic nature of Internet webpages makes it virtually impossible to know when a particular disclosure of the webpage became publicly available. The WBM provides patent examiners, investigators, attorneys, and others with the ability to recover and use as prior art webpages that no longer exist, along with date information providing the date when the webpages were archived.

During patent prosecution, a patent examiner can use the WBM to establish a past version of a webpage, and can use the associated archival date to establish the webpage as prior art to an examined application. Likewise, the WBM can be used by an attorney to obtain a past version of a webpage, and to establish that the past version of the webpage is prior art to a targeted patent in a validity challenge of the patent. In these contexts, one limitation of the WBM is that since a webpage is only archived when the WBM crawls the webpage, the WBM cannot be relied upon to establish when the webpage was created or when it was *first accessible to the public*. It can only be used to show when the webpage was *first archived* by the WBM.

Other important considerations include the issue of how long a webpage must be publicly accessible before qualifying as a printed publication, and under what circumstances must a

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website be accessible to become a printed publication. There is little case law related specifically to these issues. Further, the America Invents Act (AIA), the major provisions of which were implemented on March 16, 2013, defines an item as prior art if it is a printed publication, public use, sale, or is *otherwise available to the public* before the effective filing date of the claimed invention. It is unclear if the "otherwise available to the public" provision of the AIA affects these WBM related issues.

In the context of litigation, courts have generally recognized the WBM as having "sufficient indicia of reliability to support introduction of [its] contents into evidence," subject to objections at trial. See *ForeWord Magazine, Inc. v. OverDrive, Inc.*, No. 1:10-cv-1144, 2011 U.S. Dist. LEXIS 125373, at *10 (W.D. Mich. Oct. 21, 2011). However, some courts have expressed extreme caution in admitting such evidence, primarily because of potential authentication and hearsay concerns.

Websites are generally not self-authenticating, and a party seeking to admit a capture from the WBM must produce extrinsic evidence "sufficient to support a finding that the [printout] is what the proponent claims it is." Fed. R. Evid. 901(a). For WBM webpage captures, authentication generally must be authenticated using the opinion of an expert witness examining the evidence to determine if it has all of the properties that it would be expected to have if it were authentic. Of course, the requesting party can also ask for an admission or stipulation from the opposing party.

Declarations from witnesses or attorneys are insufficient to authenticate printouts from the WBM if the witnesses do not have personal knowledge of the archive's contents. Instead, the majority of courts require that the WBM webpages be authenticated by an affidavit from a WBM representative having personal knowledge of their contents and who can verify that they are true and accurate copies of WBM's records. The WBM provides notarized affidavits starting at \$370, and strives to respond to requests within five business days. See <https://archive.org/legal>, <https://archive.org/legal/faq.php>.

A minority of courts have been more demanding, however. In an opinion affirmed by the

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Second Circuit, the Eastern District of New York rejected an affidavit made by the plaintiff and required instead that the affidavit be submitted by a representative of the employer hosting the *original* website that the WBM's archived webpages purported to represent. See *Novak v. Tucows, Inc.*, 2007 U.S. Dist. LEXIS 21269.

The most common WBM issue related to hearsay is that, when a WBM capture is used to show what a website showed on a particular date, the proponent is attempting to use the WBM capture to prove the truth of the matter asserted by the WBM capture. When used for that purpose, the WBM's representation in an affidavit that the website was captured on a specific date constitutes hearsay, and the proponent of such evidence will need to assert a hearsay exception or exclusion to admit the date into evidence. Of course, if the underlying webpage is posted by a party-opponent, traditional discovery tools such as a request for admission, interrogatory, or deposition can be used to establish the content of the website on a specific date.

Litigation best practices include examining the opposing party's website. Become familiar with its structure and content, and determine whether there is enabling disclosure on the website that could qualify as prior art and whether the relevant documents themselves contain publication dates before resorting to the WBM. In addition, parties can try to get the opposing party to (1) stipulate to the webpage's authenticity under FRCP 16(c)(2)(C) and 36(a)(1)(B), (2) admit to the webpage's authenticity using a request for admission under Rule 36, or (3) seek judicial notice under the Federal Rules of Evidence. Parties should also consider obtaining a WBM affidavit. They have been accepted in support of pretrial motions by courts adhering to the majority view of authentication described earlier. Also of note, the WBM does provide a method for requesting that a webpage/site be archived. This can be useful where one wants to defensively create prior art using their website, and have an additional source of evidence dating the generated prior art.

Parties should also be aware of technological limitations in collecting archived material. Some pages may not be archived, or the archived version may be incomplete. For example, it honors robots.txt files, which enable website owners to instruct automated systems to not

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crawl their websites. It does not capture dynamic elements that need to contact an originating server to work (e.g., Javascript elements and server side image maps). It cannot capture unknown websites. Orphaned webpages are not captured. Files over 10MB are not archived. Further, there is typically a 6 to 14-month lag time between the date a site is crawled and captured and the date it is available on the WBM.

In the context of patent prosecution, inventors and patent practitioners should understand that the USPTO does not apply the Federal Rules of Evidence during patent prosecution. As such, WBM archives may be used more liberally by examiners and/or by third parties submitting prior art. Examiners commonly use the WBM to establish website posting dates in order to qualify the website as prior art, and many patents issue with WBM archives cited as prior art. By contrast, trial-like proceedings before the USPTO (e.g., inter partes reviews, post-grant reviews, and derivations proceedings) are governed by the Federal Rules of Evidence, and therefore many of the issues facing proponents of such evidence in the Federal courts exist in these proceedings.