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Paper 83
Date: June 1, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IPA TECHNOLOGIES INC.,
Patent Owner.

IPR2019-00728
Patent 6,851,115 B1

Before KEN B. BARRETT, TREVOR M. JEFFERSON, and BART A. GERSTENBLITH, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining Remaining Challenged Claim Unpatentable
Denying In Part and Dismissing In Part Patent Owner's Motion to Exclude
35 U.S.C. §§ 144, 318

I. INTRODUCTION

This Remand Decision is a final written decision on remand from the United States Court of Appeals for the Federal Circuit, which vacated and remanded our original Final Written Decision in this *inter partes* review. *See Google LLC v. IPA Techs. Inc.*, 34 F.4th 1081, 1089 (Fed. Cir. 2022); Paper 74 ("Final Dec."). The Federal Circuit remanded for the Board to address whether a cited reference was prior art under § 102(a) to the challenged claims of U.S. Patent No. 6,851,115 B1 ("the '115 patent," Ex. 1001). *Id.*

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision on Remand under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that the remaining challenged claim 60 of the '115 patent is unpatentable by a preponderance of evidence.

A. Background

Petitioner, Google LLC ("Google"), filed a Petition seeking *inter partes* review of claims 61–70 of the '115 patent, which is assigned to IPA Technologies Inc. ("Patent Owner" or "IPA"). Paper 1 ("Petition" or "Pet."), 4–5. Patent Owner filed a Preliminary Response (Paper 6). Applying the standard set forth in 35 U.S.C. § 314(a), we instituted an *inter partes* review of the challenged claims. Paper 11 ("Dec. on Inst.").

After institution, Patent Owner filed a Response (Paper 41, "PO Resp."), Petitioner filed a Reply (Paper 59, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 66, "Sur-reply"). Patent Owner filed a Motion to Exclude (Paper 67) and Petitioner filed an opposition (Paper 70) to which Patent Owner replied (Paper 72). A combined oral hearing for this *inter*

partes review and related cases (IPR2019-00730, IPR2019-00731, IPR2019-00733, and IPR2019-00734) was held on June 4, 2020, a transcript of which appears in the record in each case. Paper 73 ("Tr.").

We issued a Final Written Decision finding that Petitioner Google had not established that the Martin[1] reference that was asserted in all challenged grounds was prior art under § 102(a). Final Dec. 25. Accordingly, we found that Google failed to show any of the challenged claims were unpatentable as each of the challenged grounds rely on the Martin reference. *Id.* at 25, 29.

On May 19, 2022, the Federal Circuit issued an opinion vacating and remanding our Final Written Decision finding that "the Board did not complete the full . . . analysis" required by *Duncan Parking Technologies, Inc. v. IPS Group, Inc.*, 914 F.3d 1347, 1357 (Fed. Cir. 2019), with respect to the § 102(a) prior art status of the asserted reference. *Google*, 34 F.4th at 1087. Specifically, with respect to the Martin reference, the Federal Circuit instructs us that,

> "to decide whether a reference patent is 'by another' . . . , the Board must":
>
> > (1) determine what portions of the reference patent were relied on as prior art to anticipate the claim limitations at issue, (2) evaluate the degree to which those portions were conceived 'by another,' and (3) decide whether that other person's contribution is significant enough, when measured against the full anticipating disclosure, to render

[1] David L. Martin, Adam J. Cheyer, Douglas B. Moran, *Building Distributed Software Systems with the Open Agent Architecture*, PROCEEDINGS OF THE THIRD INTERNATIONAL CONFERENCE ON THE PRACTICAL APPLICATION OF INTELLIGENT AGENTS AND MULTI-AGENT TECHNOLOGY 355 (1998) (Ex. 1011, "Martin" or "the Martin reference").

> him a joint inventor of the applied portions of the reference patent.

Id. at 1085 (quoting *Duncan Parking*, 914 F.3d at 1358 (quoting pre-AIA 35 U.S.C. § 102(e)) (alteration in original)). On June 28, 2022, the Federal Circuit issued its mandate. *See* Paper 77. With our authorization (Paper 79), in September 2022, the parties filed additional briefing limited to addressing the remanded prior art issue. *See* Petitioner's Brief on Remand (Paper 81, "Pet. Remand"); Patent Owner's Responsive Brief on Remand (Paper 82, "PO Remand").

B. Remaining Challenged Claim

In a related challenge to the '115 patent, the Federal Circuit affirmed a Board decision finding claims 61, 62, and 64–70 unpatentable. *Microsoft Corp. v. IPA Techs. Inc.*, No. 2021-1412, 2022 WL 989403, at *1 (Fed. Cir. Apr. 1, 2022) (nonprecedential); *see also Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00814, Paper 44 at 171 (PTAB Nov. 5, 2020) (Final Written Decision) (finding, *inter alia*, claims 61, 62, and 64–70 of the '115 patent unpatentable). In a subsequent remand decision, the Board found claim 63 of the '115 patent was not unpatentable. *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00814, Paper 52 at 47–48 (PTAB Dec. 2, 2022) (Final Written Decision on Remand). Claims 61, 62, and 64–70 have been canceled. *Id.* at Paper 55, 2 (814 Trial Certificate) (canceling claims 1–8, 11–28, 48–62, and 64–89 of the '115 patent). Thus, although Petitioner Google challenged claims 61–70 of the '115 patent in this proceeding, claim 63 is the sole remaining claim at issue in this remanded proceeding.

Analyzing the full record in view of the Federal Circuit's remand decision, we address below the remaining ground at issue in this Remand Final Written Decision, which is summarized in the following table.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
63	103(a)[2]	Martin,[3] Kohn[4]

See id.; Dec. on Inst. 7–8, 36; *see* Pet. 4–5.

C. Related Proceedings

According to the parties, the '115 patent is the subject of the following district court litigation: *IPA Techs. Inc. v. Google LLC*, No. 1:18-cv-00318 (D. Del.); *IPA Techs. Inc. v. Microsoft Corp.*, No. 1:18-cv-00001 (D. Del.); and *IPA Techs. Inc. v. Amazon.com, Inc.*, No. 1:16-cv-01266 (D. Del.). Pet. 2; Paper 5, 2. The '115 patent was also the subject of a petition for *inter partes* review filed by Petitioner in IPR2019-00729. Pet. 3; Paper 5, 2. Institution of an *inter partes* review was denied in that case. As

[2] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102 and 103. Because the '115 patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of §§ 102 and 103.
[3] David L. Martin, Adam J. Cheyer, Douglas B. Moran, *Building Distributed Software Systems with the Open Agent Architecture*, PROCEEDINGS OF THE THIRD INTERNATIONAL CONFERENCE ON THE PRACTICAL APPLICATION OF INTELLIGENT AGENTS AND MULTI-AGENT TECHNOLOGY 355 (1998) (Ex. 1011, "Martin" or "the Martin reference").
[4] U.S. Patent No. 6,088,689 to Kohn issued Jul. 11, 2000, filed Nov. 29, 1995 (Ex. 1012, "Kohn").

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