Filed: September 30, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

PETITIONER,

v.

IPA TECHNOLOGIES INC.,

PATENT OWNER.

Case No. IPR2019-00728
U.S. Patent No. 6,851,115

PATENT OWNER'S RESPONSIVE REMAND BRIEF

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I. INTRODUCTION

Patent Owner IPA Technologies LLC submits this responsive remand brief pursuant to the Board's September 2, 2022, Order. (Paper 79 ("Order").)

Despite the Board's instruction to submit briefing "apply[ing] the *Duncan* analysis to the disputed prior art reference" (Order, 3), Google failed to undertake any substantive analysis concerning the second and third *Duncan* steps. Google's failure to show specific contributions by Dr. Moran to the facilitator described in the Martin reference (Ex. 1011 ("*Martin*")), or any aspect of *Martin* relied on in the petition, confirms that Google has not sustained its burden. With no evidence in the record concerning Dr. Moran's alleged contribution to the *Martin* facilitator, Google retreats to arguing that a finding that Dr. Moran is generally credible should be sufficient and then recycles its failed arguments that Dr. Moran was in a position to make contributions to *Martin* (regardless of whether he actually did). The Board has already rejected these arguments and should do so again.

II. GOOGLE FAILS TO ESTABLISH THAT *MARTIN* QUALIFIES AS PRIOR ART UNDER THE *DUNCAN* FRAMEWORK

The Federal Circuit instructed the Board to comprehensively analyze whether *Martin* is prior art under *Duncan's* three-step framework, which requires: (1) determin[ing] what portions of the reference patent were relied on as prior art to anticipate the claim limitations at issue, (2) evaluat[ing] the degree to which those portions were conceived "by another," and (3) decid[ing] whether that other

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person's contribution is significant enough, when measured against the full anticipating disclosure, to render him a joint inventor of the applied portions of the reference patent. *Google LLC v. IPA Techs. Inc.*, 34 F.4th 1081, 1085 (Fed. Cir. 2022) ("*Remand Op*.") (citing *Duncan Parking Technologies, Inc. v. IPS Group, Inc.*, 914 F.3d 1347 (Fed. Cir. 2019) ("*Duncan*")).

The Federal Circuit affirmed the Board's determination that Google bears the burden of "establish[ing that] the Martin reference was prior art 'by another' by showing that Dr. Moran made a significant enough contribution to the portions relied on to invalidate the challenged patents to qualify as a joint inventor of those portions." *Remand Op*. at 1086. In other words, this is something Google needed to establish in its petition. But Google did not make this required showing in its petition and has never cured that deficiency. Nothing in Google's remand brief alters the fundamental fact that "[t]he evidence introduced at trial has not sufficiently or persuasively addressed Dr. Moran's testimony regarding his contribution to the Martin reference"—a fatal defect. Paper 74 ("FWD"), 15.

A. ***Duncan*** Step 1: Identify The Portions Of ***Martin*** Relied Upon.

IPA does not contest that Google identified the portions of *Martin* relied upon in its petition.

B. ***Duncan*** Step 2: What Degree, If Any, Of The Relied Upon Portions Of ***Martin*** Were Conceived Of By Moran?

Google states that the Board "may focus specifically on Dr. Moran's

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