Trials@uspto.gov
571-272-7822

Paper 82
Date: June 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IPA TECHNOLOGIES INC.,
Patent Owner.

IPR2019-00731
Patent 7,069,560 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 73 ("Final Dec."). The Federal Circuit remanded to address whether a cited reference was prior art under § 102(a) to the challenged claims of U.S. Patent No. 7,069,560 B1 ("the '560 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 28 of the '560 patent is unpatentable by a preponderance of evidence.

A. Background

Petitioner, Google LLC ("Google"), filed a Petition challenging claims 26–35, 47, and 48 ("the original challenged claims") of the '560 Patent (Paper 1 ("Petition" or "Pet."), 4–5), and IPA Technologies Inc. ("Patent Owner") filed a Preliminary Response (Paper 6). We instituted trial on all grounds of unpatentability. Paper 11 ("Dec. on Inst."), 34–35. Patent Owner filed a Request for Rehearing of our decision granting institution (Paper 13) that was denied by our Decision Denying Patent Owner's Request (Paper 40). Patent Owner's request for Precedential Opinion Panel (POP) review was also denied (Paper 26).

After institution, Patent Owner filed a Response (Paper 41, "PO Resp."), Petitioner filed a Reply (Paper 58, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 65, "PO Sur-reply"). Patent Owner filed a Motion

to Exclude (Paper 66) and Petitioner filed an opposition (Paper 69) to which Patent Owner replied (Paper 71). A combined oral hearing for this *inter partes* review and related cases (IPR2019-00728, IPR2019-00730, IPR2019-00733, and IPR2019-00734) was held on June 4, 2020, a transcript of which appears in the record in each case. Paper 72 ("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. 26. 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 26, 30.

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

[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").

> against the full anticipating disclosure, to render 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 Remand Brief (Paper 82, "PO Remand").

B. Remaining Challenged Claim

On May 16, 2023, following the completion of related *inter partes* review proceedings, a Certificate issued cancelling claims 1–27, 29–49, and 52 of the '560 patent. *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00835, Paper 53 (PTAB May 16, 2023) (835 Trial Certificate).[2] The cancellation of claims 1–27, 29–49, and 52 of the '560 patent removes claims 26, 27, 29–35, 47, and 48 from the present case. *See id.* Therefore, claim 28 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 the remaining ground at issue in this Remand Final Written Decision below, which is summarized in the following table:

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[2] *See Microsoft Corp. v. IPA Techs. Inc.*, No. 2021-1412, 2022 WL 989403 at *1 (Fed. Cir. Apr. 1, 2022) (nonprecedential); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00835, Paper 42 (PTAB Oct. 15, 2020) (Final Written Decision); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00836, Paper 50 (PTAB Dec. 22, 2022) (Final Written Decision on Remand); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00837, Paper 42 (PTAB Oct. 22, 2020) (Final Written Decision).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
28	103(a)	Martin,[3] Farley[4]

See id.; Dec. on Inst. 7–9, 35; *see* Pet. 4–5.

C. Related Proceedings

The parties inform us that the '560 patent is presently 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. 1–2; Paper 4, 2. The Petition was filed concurrently with petitions filed in IPR2019-00731 and IPR2019-00732, and various petitions filed against U.S. Patent No. 6,851,115 ("the '115 patent"), from which the '560 patent is a continuation. Pet. 2–3; Paper 4, 2–3; *see* Ex. 1001, [63]. Institution of an *inter partes* review was denied in IPR2019-00732. As noted above, the '560 patent was also addressed in *Microsoft Corp. v. IPA Techs. Inc.*, No. 2021-1412, 2022 WL 989403, at *1 (Fed. Cir. Apr. 1, 2022) (nonprecedential); *Microsoft Corp*, IPR2019-00835, Paper 42 (PTAB Oct. 15, 2020) (Final Written Decision); *Microsoft Corp.*, IPR2019-00836, Paper 50 (PTAB Dec. 22, 2020) (Final Written Decision on

[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").
[4] Jim Farley, JAVA DISTRIBUTED COMPUTING, 1st ed., 1998 (Ex. 1020, "Farley").

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