

## Google LLC v. IPA Technologies Inc., 34 F.4th 1081 (Fed. Cir. 2022) (Dyk, Schall, Taranto)

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Google petitioned for IPR of two patents owned by IPA. Each of the asserted grounds relied on the Martin reference. Martin lists as authors the two inventors of the challenged patents and a third person, Dr. Moran. During prosecution of the applications leading to the challenged patents, IPA successfully contested the prior art status of Martin, submitting declarations to show that Dr. Moran was not a co-inventor of the reference.

In the IPRs, Google argued that Martin was “by others” and therefore available as prior art. In order to decide whether a reference is “by another,” the Board must complete an analysis under *Duncan Parking Techs., Inc. v. IPS Grp., Inc.*, 914 F.3d 1347, 1358 (Fed. Cir. 2019). The *Duncan* analysis is a three-step analysis: (1) determine which portions of the reference were relied on as prior art; (2) evaluate the degree to which those portions were “by another”; and (3) decide whether the other person’s contribution is significant enough to render him a joint inventor. The Board concluded in the final written decisions that Google “ha[d] not provided sufficient support to explain how Dr. Moran’s contribution [wa]s sufficient to establish he [wa]s an inventive entity with respect to the Martin reference by a preponderance of the evidence.” Thus, the Board found that Martin was not prior art to the challenged patents and, therefore, Google had not shown the challenged claims were unpatentable. Google appealed.

On appeal, Google argued that the Board improperly imposed a burden on it to prove that Martin had a different inventive entity than the challenged patents. The Federal Circuit disagreed. Noting the differences between the burdens of production and persuasion, the court determined that, as to the burden of production, both parties had submitted evidence and arguments to support their respective positions. As to the burden of persuasion, the court “s[aw] no error with the Board’s requiring that Google establish 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.”

Turning to the question of whether Google had met this burden, the court faulted the Board for “not complet[ing] the full *Duncan* analysis.” The Board had before it testimonial evidence from Dr. Moran and from the other named inventors of the challenged patents. The Board concluded that Dr. Moran’s testimony was not sufficiently corroborated. But the Federal Circuit found sufficient evidence on the record to corroborate the testimony, including the fact of his being named as a co-author on Martin, his role within the overall project, another inventor’s acknowledgement of Dr. Moran’s technical contributions to the project, and Dr. Moran’s being a named inventor on a related patent.

The court noted that Dr. Moran’s testimony, “if credited, might well establish that he was a coinventor of the particular portions of the Martin reference relied on by Google.” The Federal Circuit determined that “[t]he issue in this case was not lack of corroboration for Dr. Moran’s testimony, but rather whether his testimony should ultimately be credited over [the named inventors’] conflicting testimony during the IPR proceedings.” The court held that the “Board was required to resolve this highly relevant evidentiary conflict and make appropriate findings of fact.” The Federal Circuit vacated and remanded the Board’s decision, due to this “fail[ure] to resolve fundamental testimonial conflicts in concluding that the relied-upon reference was not prior art.”

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### RELATED CASE

- *Provisur Technologies, Inc. v. Weber, Inc.*, 50 F.4th 117 (Fed. Cir. 2022) (holding that the Board’s mischaracterization of and failure to address Patent Owner’s argument precludes meaningful appellate review, and therefore it violates the APA).