

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 Martin¹ 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”).

noted above, the '115 patent was also addressed in *Microsoft*, IPR2019-00814, Paper 52 at 47–48 (PTAB Dec. 2, 2022) (Final Written Decision on Remand) and *Microsoft*, No. 2021-1412, 2022 WL 989403 (Fed. Cir. Apr. 1, 2022).

D. The '115 Patent and Illustrative Claims

The '115 patent describes “software-based architectures for communication and cooperation among distributed electronic agents.” Ex. 1001, 1:27–29. Figure 4 of the '115 patent is reproduced below.

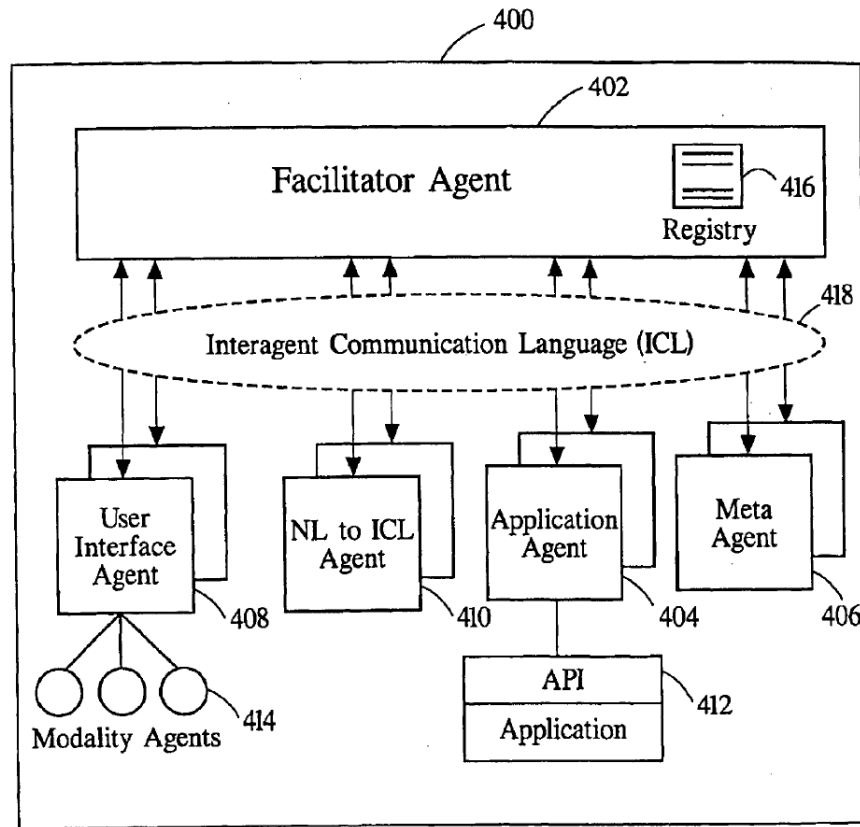


Fig. 4

Figure 4 depicts the structure of an exemplary distributed agent system of the '115 patent. *Id.* at 6:25–32. As shown in Figure 4, system 400 includes facilitator agent 402, user interface agents 408, application agents 404, and meta-agents 406. *Id.* at 6:25–28. The '115 patent describes that system 400

is organized “as a community of peers by their common relationship” to facilitator agent 402 (*id.* at 6:28–30), which is “a specialized server agent that is responsible for coordinating agent communications and cooperative problem-solving” (*id.* at 6:32–35).

According to the ’115 patent, cooperation among agents is structured around a three-part approach as follows: (1) providers of services register their capabilities specifications with a facilitator; (2) requesters of services construct goals and relay them to the facilitator; and (3) the facilitator coordinates the efforts of the appropriate service providers in satisfying these goals. *Id.* at 10:42–47. The ’115 patent describes that cooperation among agents is achieved via messages expressed in a common language, called the Interagent Communication Language (“ICL”). *Id.* at 10:40–48.

Referencing Figure 3 (not reproduced herein) and Figure 4, the ’115 patent describes the operation of a distributed agent system in a preferred embodiment. *Id.* at 7:13–39. The ’115 patent describes that, when invoked, a client agent makes a connection to a facilitator, e.g., facilitator agent 402, and registers with the facilitator a specification of the capabilities and services it can provide. *Id.* at 7:15–21. For example, a natural language agent may register the characteristics of its available natural language vocabulary. *Id.* at 7:21–23. When facilitator agent 402 receives a service request and determines that registered services 416 of one of its client agents will help satisfy a goal of the request, the facilitator sends that client a request expressed in ICL 418. *Id.* at 7:25–29. The client agent parses this request, processes it, and returns answers or status reports to the facilitator. *Id.* at 7:30–32.

Referencing Figures 5 and 6 (not reproduced herein), the '115 patent describes an exemplary embodiment where user interface (UI) agent 408 runs on a user's laptop, accepting user input, sending requests to facilitator agent 402 for delegation to appropriate agents, and displaying the results of the distributed computation. *Id.* at 7:53–63. As illustration, the '115 patent describes that, when the question “What is my schedule?” is entered on UI agent 408, UI agent 408 sends the request to facilitator agent 402, which in turn asks natural language agent 426 to translate the query into ICL. *Id.* at 8:4–8. The translated ICL expression is then routed by facilitator agent 402 to appropriate agents, e.g., calendar agent 434, to execute the request. *Id.* at 8:13–15. Finally, results are sent back to UI agent 408 for display. *Id.* at 8:15–16.

Claim 63 depends from independent claim 61. Claims 61 and 63 are reproduced below.

61. A facilitator agent arranged to coordinate cooperative task completion within a distributed computing environment having a plurality of autonomous service-providing electronic agents, the facilitator agent comprising:
 - an agent registry that declares capabilities of service-providing electronic agents currently active within the distributed computing environment; and
 - a facilitating engine operable to parse a service requesting order to interpret a compound goal set forth therein, the compound goal including both local and global constraints and control parameters, the service request formed according to an Interagent Communication Language (ICL), wherein the ICL includes:
 - a layer of conversational protocol defined by event types and parameter lists associated with one or more of the events, wherein the parameter lists further refine the one or more events; and

a content layer comprising one or more of goals, triggers and data elements associated with the events; and

the facilitating engine further operable to construct a goal satisfaction plan by using reasoning that includes one or more of domain-independent coordination strategies, domain-specific reasoning, and application-specific reasoning comprising rules and learning algorithms.

63. A facilitator agent as recited in claim 61 wherein the agent registry includes a symbolic name, a unique address, data declarations, trigger declarations, task declarations, and process characteristics for each active agent.

Ex. 1001, 35:4–29, 35:35–38.

E. Testimonial Evidence

In support of its unpatentability contentions, Petitioner relies on the Declaration of Dr. Dan R. Olsen Jr. (Ex. 1002, “Olsen Declaration” or “Olsen Decl.”) and the Declaration of Dr. Douglas B. Moran (Ex. 1007). Petitioner submits Patent Owner’s cross-examination deposition testimony of Dr. Moran (Ex. 1153), who is named as an author of the Martin reference. Patent Owner deposed and Petitioner cross-examined Mr. Adam J. Cheyer (Ex. 2037) and Mr. David L. Martin (Ex. 2038), who are both listed as inventors on the ’115 patent and named as co-authors of the Martin reference. In addition, both parties cite the 37 C.F.R. § 1.132 declarations of Messrs. Cheyer and Martin submitted in the prosecution history of the ’115 patent. Ex. 1004, 221–24 (37 C.F.R. § 1.132 declarations); Ex. 2039 (37 C.F.R. § 1.132 declarations).

II. ANALYSIS

A. Relevant Principles of Law

To prevail in challenging Patent Owner's claim, Petitioner must demonstrate by a preponderance of the evidence that the claim is unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). "In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).⁵

⁵ With respect to the fourth *Graham* factor, the parties do not present arguments or evidence regarding objective indicia of non-obviousness.

An obviousness determination requires finding “both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’”

Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359, 1367–68 (Fed. Cir. 2016) (citation omitted); *see KSR*, 550 U.S. at 418 (holding that in an obviousness analysis, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”). Further, “[t]o satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

In our Final Written Decision, we found Petitioner’s proposal consistent with the level of ordinary skill in the art reflected by the prior art of record. Final Dec. 7 (citing *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995)). On appeal the parties did not challenge this finding and we see no reason to depart from this determination on remand. Thus, we continue to find that a person of ordinary skill in the art at the time of the invention of the ’115 patent would have had at least a Bachelor’s degree in computer science, electrical engineering, or a similar discipline, and one to two years of work experience in networked computer systems or a related area. Ex. 1002 ¶ 14.

C. Claim Construction

In an *inter partes* review, we apply the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), following the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2019); 83 Fed. Reg. 51,340, 51,340–41, 51,343 (Oct. 11, 2018). In applying this standard, claim terms are generally given their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art, at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13. The parties do not propose a construction for any claim term. Petitioner avers that no express constructions are required (Pet. 17), and Patent Owner concurs and provides no express constructions (Prelim. Resp. 5; PO Resp.).

Based on the final record, we determine no claim terms require express construction. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that only terms that are in controversy need to be construed, and “only to the extent necessary to resolve the controversy”); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying *Vivid Techs.* in the context of an *inter partes* review).

D. Asserted Prior Art Overview

1. Overview of Martin (Ex. 1011)

Martin relates to the Open Agent Architecture (OAA), which “makes it possible for software services to be provided through the cooperative

efforts of distributed collections of autonomous agents.” Ex. 1011, 10⁶ (Abstract). According to Martin, “[c]ommunication and cooperation between agents are brokered by one or more facilitators, which are responsible for matching requests, from users and agents, with descriptions of the capabilities of other agents.” *Id.*

Figure 1 of Martin is reproduced below.

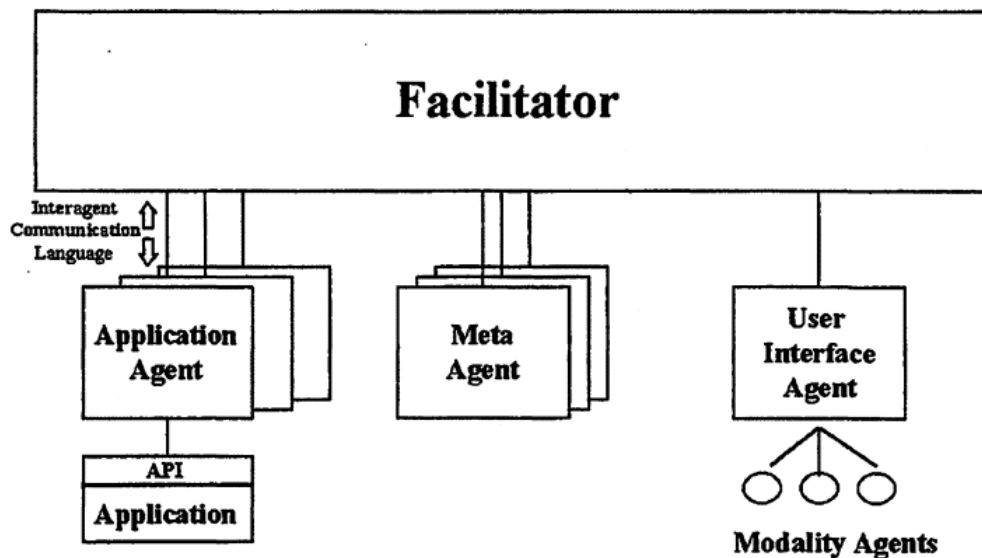


Figure 1: OAA System Structure.

Figure 1 depicts the structure typical of a small OAA system, showing a user interface agent, several application agents, and meta-agents, organized as a community of peers by their common relationship to a facilitator agent. *Id.* at 14. Figure 1 also shows an Interagent Communication Language (“ICL”). *Id.* at 16, Fig. 1.

According to Martin, cooperation among the agents of an OAA system is achieved via messages expressed in a common language,

⁶ The page numbers for the Martin reference refer to Petitioner’s inserted page numbers in the bottom, left-hand corner of each page.

Interagent Communication Language (ICL). *Id.* at 17. Martin describes “Mechanisms of Cooperation” as follows.

Cooperation among the agents of an OAA system is achieved via messages expressed in a common language, ICL, and is normally structured around a 3-part approach: providers of services register capabilities specifications with a facilitator; requesters of services construct goals and relay them to a facilitator, and facilitators coordinate the efforts of the appropriate service providers in satisfying these goals.

Id.

According to Martin, all agents that are not facilitators are called client agents. *Id.* at 16. Martin describes that when invoked, a client agent makes a connection to a facilitator. *Id.* at 16–17. Upon connection, an agent informs the facilitator of the services it can provide. *Id.* at 17. When the agent is needed, the facilitator sends it a request expressed in ICL. *Id.* The agent parses this request, processes it, and returns answers or status reports to the facilitator. *Id.*

2. *Overview of Kohn (Ex. 1012)*

Kohn describes a Multiple-Agent Hybrid Control Architecture (MAHCA) which uses agents to analyze, design, and implement intelligent control of distributed processes. Ex. 1012, [57]. According to Kohn, a single agent can be configured to control a local process, or a network of agents can be configured to control more complex, distributed processes. *Id.* Kohn describes that the network of multiple agents interact through messages to create a global behavior. *Id.* For example, each individual agent may take local actions in accordance with local and global constraints. *Id.* at 16:20–22. Also, a network of cooperating control agents may

implement local control actions to synchronize attainment of global goals.
Id. at 16:23–25.

E. Martin as Prior Art Under 35 U.S.C. § 102(a)

1. Martin Reference Background

The Martin reference discussed above is a conference paper titled “Building Distributed Software Systems with the Open Agent Architecture,” and was published in 1998. Ex. 1011, 1, 10. Martin was “authored by three SRI employees—the two inventors of the ’115 patent (Cheyer and Martin) and their [SRI] co-worker (Moran).” PO Resp. 1; Ex. 1011. “Both the ’115 patent and *Martin* relate to work done on the Open Agent Architecture project at SRI, and large portions of the ’115 application and the *Martin* reference are identical or almost identical.” PO Resp. 1; *compare* Ex. 1001, *with* Ex. 1011, 10–29.

Martin was considered during prosecution of the ’115 patent. The Examiner initially rejected claims of the application that issued as the ’115 patent under § 102(a) based on Martin. Ex. 1004, 453, 454–68. Patent Owner overcame the rejection by submitting Rule 1.132 declarations from the named inventors, Messrs. Cheyer and Martin, attesting that they alone invented the subject matter disclosed and claimed in the ’115 patent application. Pet. 12; Ex. 1004, 221–24 (§ 1.132 declarations), 212–13. Cheyer and Martin also attested that Dr. Moran was not an inventor of the subject matter disclosed and claimed in the ’115 patent. Ex. 1004, 221–24. The Examiner withdrew the rejections based on Martin in the next Office Action. *Id.* at 187–202.

In support of Petitioner’s contention that Martin is the work of another and lacks a common inventive entity with the ’115 patent, Petitioner relies

on a Declaration from Dr. Moran (Ex. 1007) describing his contributions to the Martin reference. Pet. 11–15. Dr. Moran’s declaration states that he worked on the Open Agent Architecture project at SRI in 1994, becoming the project leader in August 1994. Ex. 1007 ¶¶ 23, 27. Dr. Moran testified that he co-authored the Martin reference with his colleagues David Martin and Adam Cheyer. *Id.* ¶ 35. Regarding authorship, Dr. Moran testified that “[m]uch of the writing in the OAA paper [the Martin reference] is mine, either directly borrowed from or derived from papers, presentations and proposals that I wrote.” *Id.* ¶ 37. Dr. Moran also states that based on his experiences he “contributed to the conception of distributed technologies that are at the core of the OAA paper [the Martin reference],” including “various networking-related concepts described in the [Martin reference],” the “distributed technologies that are at the core of the [Martin reference] . . . , as described at Sections 2.5 and 3,” and “the distributed agent-based approach, and in particular using a facilitator, as described in the [Martin reference] at Section[s] 4 and 4.1–4.5.” *Id.* ¶ 39.

Following institution, Patent Owner cross-examined Dr. Moran (Ex. 1153). Patent Owner deposed and Petitioner cross-examined Mr. Cheyer (Ex. 2037) and Mr. Martin (Ex. 2038).

2. Our Final Written Decision and The Federal Circuit’s Decision

In our Final Written Decision, we determined that Petitioner provided insufficient evidence to establish that the Martin reference was the work of another. Final Dec. 23–25. Specifically, we found the evidence insufficient to credit Dr. Moran’s declaration and testimony regarding his contribution to the Martin reference over Patent Owner’s competing evidence and testimony from Messrs. Cheyer and Martin that asserted that Dr. Moran did not make a

technical contribution to the Martin reference. *Id.* In so doing, we found that Petitioner did not carry its burden to establish Dr. Moran’s sufficient contribution to the Martin reference to qualify as a joint inventor. *Id.*

The Federal Circuit found “no error with the Board’s requiring that Petitioner 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.” *Google*, 34 F.4th at 1086. However, the Federal Circuit found that in finding the testimony of Dr. Moran, Mr. Martin, and Mr. Cheyer credible (Final Dec. 15 n.6), we failed to resolve the various conflicts in testimony and make certain findings of fact under the *Duncan* analysis to credit Messrs. Cheyer and Martin or Dr. Moran with respect to the joint inventor inquiry for the Martin reference. *Google*, 34 F.4th at 1086.

With respect to the joint inventor inquiry into the Martin reference, the Federal Circuit states that:

Joint inventors need “not physically work together or at the same time, . . . make the same type or amount of contribution, or . . . make a contribution to the subject matter of every claim of the patent.” 35 U.S.C. § 116(a). A joint inventor must simply:

- (1) contribute in some significant manner to the conception or reduction to practice of the invention,
- (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art.

In re VerHoef, 888 F.3d 1362, 1366 (Fed. Cir. 2018) (quoting *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998)).

Accordingly, “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 him a joint inventor of the applied portions of the reference patent.

Duncan Parking, 914 F.3d at 1358 (quoting pre-AIA 35 U.S.C. § 102(e)).

Google, 34 F.4th at 1085. Having reviewed the record and the Final Written Decision, the Federal Circuit focused on Dr. Moran’s claim of contributions to the facilitator concept recited in Section 4.5 (Facilitation) of the Martin reference, which found their way into the specification of the challenged patents. *Id.* at 1087 (comparing the Martin reference and the challenged patent’s specification) (citing Ex. 1011, 23–24 (Section 4.5); U.S. Patent No. 7,069,560 B1 (“the ’560 patent”), 19:14–62); *see* Ex. 1001, 18:56–19:36. In further addressing the testimony and evidence, the Federal Circuit characterized the joint inventorship inquiry as requiring Google to “show[] that Dr. Moran made a significant enough contribution to the portions [of the Martin reference] relied on to invalidate the challenged patents to qualify as a joint inventor of those portions.” *Google*, 34 F.4th at 1086.

Thus, the Federal Circuit instructs us that the issue on remand is “whether [Dr. Moran’s] testimony should ultimately be credited over Cheyer and Martin’s conflicting testimony during the IPR proceedings” (*id.* at 1088) as “[t]he § 1.132 declarations by Martin and Cheyer [in the prosecution

history], standing alone, were insufficiently focused on the *Duncan* question to raise a fact issue” (*id.* at 1088 n.5).

3. *Parties’ Contentions on Remand*

With respect to the *Duncan* analysis, the parties do not dispute the portions of Martin that Petitioner cites and relies upon in the Petition. *See* Pet. Remand 3–4; PO Remand 2. Accordingly, we focus our inquiry on the second and third prongs of *Duncan*: “(2) . . . 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 him a joint inventor of the applied portions of the reference patent.” *Duncan Parking*, 914 F.3d at 1358.

Petitioner argues that under *Duncan Parking*, a preponderance of the evidence supports that Dr. Moran contributed to the facilitator in Martin. Pet. Remand 1. Petitioner asserts that Dr. Moran identified that he contributed to and helped conceive of Sections 2.5, 3, 4, 4.1, 4.2, 4.3, 4.4, and 4.5 of the Martin reference and that these sections were extensively relied on in the Petition. *Id.* at 3–4 (citing, *inter alia*, Ex. 1007 ¶ 39; Pet. 18–23 (relying on Sections 2.5, 3, 4.1, and 4.5)). With respect to the second requirement of the *Duncan Parking* inquiry, Petitioner argues that the evidence, properly credited as discussed by the Federal Circuit, supports the degree to which Dr. Moran conceived of the portions of the Martin reference. Pet. Remand 5–8 (citing Ex. 1011 (listing Dr. Moran as coauthor of Martin); Ex. 1007 ¶¶ 5–22, 23–34, 35–39 (background on the OAA project and the Martin reference); Ex. 1174, 1–2 (article describing the OAA system, including the facilitator, and listing Dr. Moran as the lead author, Mr. Cheyer as second author, but not including Mr. Martin)). In addition,

Petitioner argues that the last prong of *Duncan Parking* (the significance of the contribution measured against the full disclosure) is met, as Dr. Moran's contribution was substantial and instrumental in development of the facilitator. Pet. Remand 12 (citing Ex. 1011, 14).

Patent Owner responds that Petitioner fails to show any substantive analysis concerning the second and third *Duncan* steps, i.e., steps that demonstrate Dr. Moran's specific contributions to the facilitator in the Martin reference or in the aspects relied on in the Petition. Pet. Remand 1. Patent Owner argues that Petitioner has failed to cure the deficiency in the Petition by ignoring the central inquiry, by failing to "identify[] to what degree (if any) Dr. Moran conceived of **specific aspects** of the facilitator described in Martin that are also relied upon in the petition." *Id.* at 3.

Unlike the analysis in *Duncan*, where there was detailed testimony of the inventive contribution at issue (*Duncan Parking*, 914 F.3d at 1359), Patent Owner argues that Petitioner's evidence and testimony offers no substantive details regarding Dr. Moran's contributions beyond the general statement that Dr. Moran "played a significant role regarding the distributed agent-based approach, and in particular using a facilitator" (Ex. 1007 ¶ 39). PO Remand 3–4. Indeed, Patent Owner asserts that without evidence of *specific* contributions, Petitioner errs in relying on the credibility determination based on the evidence of record and fails to comport with law or the Federal Circuit's instructions. *Id.* at 5–6. Finally, in contrast to the specific evidence cited as the detailed contribution in *Duncan Parking*, 914 F.3d at 1359, Patent Owner argues that Petitioner makes no attempt to measure the contribution of Dr. Moran to the facilitator described in Martin against the full anticipating disclosure in Martin. PO Remand 6–7.

4. *Analysis of the Joint Inventorship of the Martin Reference*

At issue in this Remand is whether the testimony and evidence Petitioner relies upon is sufficient to establish the degree to which the relied-on portions of the Martin reference were conceived by Dr. Moran, and the significance of those contributions to the overall anticipating disclosure of the Martin reference. *See Google*, 34 F.4th at 1086–88; *Duncan Parking*, 914 F.3d at 1358. Contrary to Patent Owner’s contentions, Petitioner is not merely relying on Dr. Moran’s authorship to establish inventorship. PO Remand 8 (citing *In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982)). Instead, Dr. Moran’s testimony establishes how his background led to his contributions to the multiple facilitator architectures disclosed in Martin and in the ’115 patent specification. *Google*, 34 F.4th at 1087; Ex. 1007 ¶¶ 23–34 (OAA project), 35–39 (OAA paper). In view of Dr. Moran’s testimony, we do not agree with Patent Owner that evidence analogous to that in *Duncan Parking* is required in this case or for Petitioner to meet its burden by stating which specific aspects of the Facilitator were conceived by Dr. Moran. PO Remand 3–4. As the Federal Circuit stated, the facilitator described in Section 4.5 of the Martin reference plays a central role in the OAA disclosed in the specification of the ’115 patent. *Google*, 34 F.4th at 1087; *see* Ex. 1011, 23–24 (Section 4.5); Ex. 1001, 18:56–19:36. In addition, Patent Owner admits that “large portions of the ’115 application and the *Martin* reference are identical or almost identical.” PO Resp. 1. We find that Petitioner and Dr. Moran have sufficiently identified the facilitator in the Martin reference as his work, and persuasively asserted that Dr. Moran’s background and experience with OAA and distributed software systems support his contribution to the conception of the facilitator in the

distributed agent approach of Sections 4.1–4.5. Ex. 1007 ¶¶ 23–39.

Dr. Moran’s testimony provides sufficient and persuasive detail to support his contribution claim to the facilitator of Section 4.5. *Id.*

Based on the record, the Federal Circuit’s remand squarely asks whether Dr. Moran’s stated contributions to the conception of the facilitator should be credited over Cheyer and Martin’s conflicting testimony regarding his lack of technical contribution. *Google*, 34 F.4th at 1088 (stating that “[t]he testimony of Dr. Moran, if credited, might well establish that he was a co-inventor of the particular portions of the Martin reference relied on by Google in, and relevant to, the challenge to particular claims”). When Dr. Moran’s testimony is viewed in combination with the supporting evidence,⁷ we find that incorporation of the facilitator in general, which is also found in the specification and claims, persuasively supports Dr. Moran’s testimony regarding his inventive contribution to the Martin reference. Specifically, we find Dr. Moran’s testimony persuasively supported and credible over the conflicting testimony and evidence offered by Mr. Cheyer and Mr. Martin. *See* Pet. Reply 12–13; Ex. 2038, 116:2–8, 117:7–119:10 (Cheyer admission that Dr. Moran made technical contributions to OAA); Ex. 2037, 34:1–20, 64:16–20, 102:2–4.

Dr. Moran’s testimony states that he “contributed to the conception of distributed technologies that are at the core of the OAA paper [the Martin reference],” including “various networking-related concepts described in the

⁷ Ex. 1170, 1; Ex. 1174, 1 (identifying Dr. Moran as an author); U.S. Patent No. 6,859,931 (“the ’931 patent”) (Ex. 2002), code (75) (listing Dr. Moran as joint inventor); and the testimony of Messrs. Cheyer and Martin. (Ex. 1153, 78:22–79:10, 79:16–81:13 (Martin deposition testimony); Pet. Reply 12–13 (citing Cheyer and Martin testimony).

[Martin reference],” the “distributed technologies that are at the core of the [Martin reference] . . . , as described at Sections 2.5 and 3,” and “the distributed agent-based approach, and in particular using a facilitator, as described in the [Martin reference] at Section[s] 4 and 4.1–4.5.” Ex. 1007 ¶ 39 (stating that Dr. Moran “played a significant role regarding the distributed agent-based approach, and in particular using a facilitator, as described in the [Martin reference] at Section[s] 4 and 4.1–4.5.”).⁸

Patent Owner relies on the testimony of Cheyer and Martin in attempting to establish that Dr. Moran’s role was merely administrative and his inclusion as an author on the Martin reference was a sign of respect, but not evidence of an inventive contribution to the Martin reference. PO Remand 11 (citing PO Resp. 48–51; PO Sur-reply 15–19; Ex. 2037, 35:24–37:20; Ex. 2038, 44:5–24). Patent Owner also states that Cheyer and Martin both “independently testified that Dr. Martin did not make technical contributions to ‘the core infrastructure [of OAA],’ which would have included the facilitator.” *Id.* (citing PO Resp. 49–50; Ex. 2037, 33:9–35:22, 37:12–38:7, 64:16–65:4, 92:20–95:3; Ex. 2038, 36:2–21, 42:16–46:2, 67:12–15, 73:24–74:10, 123:11–19).

With respect to Dr. Moran’s contribution to the Martin reference, we find Dr. Moran’s testimony credible over that of Mr. Cheyer and Mr. Martin, because the latter testimony conflicts with other evidence of record. *Google*,

⁸ The Federal Circuit also directly determined that “Dr. Moran’s testimony as to his technical contributions was sufficiently corroborated by his being named as a co-author on the Martin reference, his role within the OAA project, Cheyer’s acknowledgement of Dr. Moran’s technical contributions to the OAA project, and Dr. Moran’s being named on the related [’931 patent]” (*id.* at 1088), “which is a continuation-in-part of the application that resulted in the ’115 patent” (*id.* at 1086).

34 F.4th at 1088. Cheyer’s and Martin’s testimony that Dr. Moran’s role was administrative and non-technical with respect to the core infrastructure of OAA is belied by a separate article describing OAA that includes the facilitator and lists Dr. Moran as the lead author. Ex. 1174, 1–2, 4. Indeed, the OAA article lists Dr. Moran and Mr. Cheyer as authors, but excludes Mr. Martin. *Id.* Although Mr. Cheyer disagrees with the article’s description of the origins of OAA and the facilitator (Ex. 2037, 78:23–79:12 (Mr. Cheyer asserting that he “would not agree in the characterization of Open Agent Architecture grew out of [earlier] works” as described in the article)), Mr. Cheyer admits in his deposition that Dr. Moran was extremely technical, and probably made technical contributions to OAA (*id.* at 34:1–20, 64:16–20, 102:2–4). Similarly, Mr. Martin’s testimony also supports that Dr. Moran “may have made contributions to the technological development of either interfaces for use with OAA, agents used with OAA, or systems based on OAA.” Ex. 2038, 116:2–8, 117:7–119:10. When viewed in light of Dr. Moran’s status as a joint inventor on the closely related U.S. Patent No. 6,859,931 (“the ’931 patent”) (Ex. 2002, code (75)) and as a lead author of the substantive paper that discusses OAA’s early development, we find Mr. Martin’s and Mr. Cheyer’s admissions—that Dr. Moran made technical contributions to OAA—undermine their testimony that Dr. Moran’s inclusion as an author on the Martin reference was a matter of administrative respect and not a result of a technical contribution. *See* PO Remand 11; PO Resp. 49–50. Indeed, we find Cheyer’s and Martin’s general description of Dr. Moran—as an administrator without technical contributions to the Martin reference—not supported by the full record, which instead supports Dr. Moran’s

contributions to technical work that involves the Martin reference, such as contemporary papers and the '931 patent. *See, e.g.*, Ex. 1174, 2002. In sum, the conflicting testimony and contemporary evidence supports Dr. Moran's testimony that his conception and contribution to the Martin reference, the facilitator, was technical and not merely administrative. Ex. 1007 ¶ 39.

Patent Owner's reliance on the source code listing Cheyer and Martin as its authors to support that Dr. Moran did not contribute to the facilitator in the Martin reference is also unavailing. PO Resp. 19–20; PO Sur-reply 13; PO Remand 11; Ex. 1001, 23:3–23. We do not agree that the source code shows that Cheyer and Martin “were responsible for the conception of the facilitator, including as described in [the Martin reference].” PO Remand 11. The authorship of the source code does not resolve the conflicts in the testimony of Cheyer and Martin regarding Dr. Moran's technical contribution to OAA, nor does it undermine Dr. Moran's testimony that he helped conceive but not code the ideas implemented in the source code. *See* Pet. Remand 10; Ex. 1007 ¶ 33; Ex. 2038, 71:1–6. Indeed, as the Federal Circuit noted, every contributor need not make the same type or amount of contribution to the subject matter of a reference, and may instead contribute to the conception of the reference. *Google*, 34 F.4th at 1085 (citing, *inter alia*, *In re VerHoef*, 888 F.3d at 1366; *Duncan Parking*, 914 F.3d at 1358). On the record before us, we credit the evidence that Dr. Moran made a significant contribution to the facilitator. Ex. 1007 ¶¶ 23–39.

We also are not persuaded by the parties' arguments of bias in the testimony of Mr. Martin, Mr. Cheyer, or Dr. Moran. *See, e.g.*, PO Resp. 48 (noting Dr. Moran's compensation in contrast to Cheyer and Martin who were not paid or affiliated with Patent Owner); Pet. Remand 11–12 (citing

Ex. 2038, 81:13–82:19 (noting that Mr. Martin was instructed not to answer a question regarding his obligation to cooperate with Patent Owner));
Ex. 2037, 52:3–13 (discussing Mr. Cheyer’s erroneous understanding that Dr. Moran claimed to be an inventor of the ’115 patent); PO Resp. 31–34, 48 (asserting that Dr. Moran has memory gaps, lacks details, and was paid for his participation). We find such evidence does not alter our determination that Dr. Moran’s testimony is credible and consistent with the evidence of his contribution to the Martin reference. We also do not find allegations of Mr. Martin’s and Mr. Cheyer’s bias informative in assessing their conflicting descriptions of Dr. Moran’s contributions to the Martin reference and related OAA papers and patents.

Upon weighing the parties’ testimony and evidence, we agree with Petitioner that sufficient evidence supports the technical contributions of Dr. Moran to OAA, including admissions by Mr. Martin that Dr. Moran made such contributions (*see* Ex. 2038, 116:2–116:8, 117:7–119:10; *see also id.* at 73:3–73:15); contemporaneous papers showing Dr. Moran’s contribution to the OAA including a facilitator (*see* Ex. 1170; Ex. 1174, 1–2), and the ’931 patent (Ex. 2002). *See* Pet. Reply 5–7, 8, 12–13; Pet. Remand 11. In particular, Dr. Moran’s testimony establishes that he contributed to Section 4.5, the facilitator that plays an essential role in the OAA, that differs from prior art agents, and that is found in the ’115 specification. We find Dr. Moran’s contributions to be significant when measured against the full anticipating Martin reference, and to render him a joint inventor of the Martin reference. *Google*, 34 F.4th at 1085 (quoting *Duncan Parking*, 914 F.3d at 1358).

5. Conclusion

Based on the full record, we find that Petitioner has provided persuasive evidence by a preponderance of the evidence that Dr. Moran is an inventive entity to the Martin reference. Accordingly, we find that Petitioner has established that Martin is “by another” and is prior art under § 102(a) to the ’115 patent. We next turn to the sole remaining ground based on the Martin reference to determine the patentability of the remaining challenged claim.

F. Dependent Claim 63: Obviousness

Petitioner argues that Martin in combination with Kohn discloses or suggests claim 63. Pet. 46; Ex. 1002 ¶¶ 105–123. Claim 63 depends from claim 61. For claim 61, Petitioner asserts that the agent-based systems and processes for servicing requests disclosed in Martin and the ’115 patent are virtually identical, using the same nomenclature relating to the Open Agent Architecture and its components. Pet. 11 (comparing Figure 4 of the ’115 patent with Figure 1 of Martin, and comparing the Abstract of the ’115 patent with the Abstract of Martin). Petitioner contends that Martin teaches all limitations of claim 61 except for the “local and global constraints” limitation for which Petitioner relies on Kohn. Pet. 18–45; Ex. 1002 ¶¶ 61–103; *see* Pet. 18–35 (discussing combination with Kohn). To support its arguments, Petitioner identifies specific passages in the cited references and explains in detail the significance of each passage in reference to the corresponding claim limitation. Pet. 18–45. Petitioner also cites the Declaration of Dr. Olsen and asserts that a person of ordinary skill in the art would have been motivated to combine Martin with Kohn to provide

flexibility in handling various requests, including accommodating requests with local and global constraints. *Id.* at 34–35 (citing Ex. 1002 ¶ 87).

With respect to dependent claim 63, Petitioner provides detailed explanations and specific citations to Martin indicating where each of the additionally recited limitations of claim 63 are disclosed in the reference. *Id.* at 46–52; Ex. 1002 ¶¶ 105–123. Petitioner also relies on the testimony of Dr. Olsen to support its position and explains how Martin’s disclosed agents are configured to teach the “symbolic name, a unique address, data declarations, trigger declarations, task declarations, and process characteristics for each active agent” as recited in claim 63. Pet. 46–52.

Patent Owner argues that the Petition does not sufficiently explain how the two references, Martin and Kohn, are combined. Specifically, Patent Owner asserts that:

[t]he Petition admits “Martin does not explicitly disclose that the compound goal includes local and global constraints.” (Pet., 32.) Acknowledging this deficiency, Petitioner argues that it would have been obvious, in view of Kohn, to modify Martin’s facilitator agent to interpret a compound goal that includes both local and global parameters. (*Id.*) However, there is no explanation in the Petition on how to combine Martin and Kohn, as required by long-standing Federal Circuit precedent.

PO Resp. 53 (citing *ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312 (Fed. Cir. 2012)). Patent Owner argues that Petitioner’s expert admits that his declaration provides no details on how to combine Martin and Kohn. PO Resp. 54–55; Ex. 2024, 158:20–160:16. In addition, Patent Owner argues that Petitioner and its expert used the claims of the ’115 patent as a roadmap to combine Martin and Kohn, engaging in impermissible hindsight. PO Resp. 56; Ex. 2024, 160:8–16.

We disagree with Patent Owner’s contention regarding the combination of Martin and Kohn. Petitioner’s expert, Dr. Olsen, provides persuasive testimony and evidence that Martin teaches compound goals and a skilled artisan would have been motivated in view of Kohn to modify Martin’s facilitator agent to interpret a compound goal that includes both local and global constraints. Pet. 32–34; Ex. 1002 ¶¶ 49, 77–88.

Dr. Olsen’s testimony does not evince hindsight, but instead supports the finding that an ordinarily skilled artisan could use compound goals required in Martin and apply the type of constraints (global and local) disclosed in Kohn. Ex. 2024, 159:4–160:16. In addition, Dr. Olsen testified, the proposed implementation “would have been a mere combination of known components and technologies . . . , according to known methods, to produce predictable results.” Ex. 1002 ¶ 87. We do not agree that this case presents the same technical issues raised in *G.B.T. Inc. v. Wallex Microelectronics Ltd.*, IPR2018-00326, Paper 60 at 16–17 (PTAB June 25, 2019), where the petitioner’s declarant failed to show how the combination would have achieved desired results and features from the combination of the circuits. Here, Dr. Olsen identified known compound goals in Martin to which Kohn’s local and global constraints are applicable. Pet. 32–34; Ex. 1002 ¶¶ 49, 77–88. In view of the level of skill in the art and the testimony of Dr. Olsen (Ex. 1002 ¶¶ 49, 77–88; Ex. 2024, 159:4–160:16), we find that Petitioner establishes persuasive motivation to combine the software teachings of Kohn’s constraints into the goals of Martin and how the references would have been combined by a preponderance of the evidence.

Patent Owner does not present separate arguments that the combination of Martin and Kohn fail to teach or suggest the limitations of dependent claim 63. *See generally* PO Resp. 53–59.

Based on the full record, we find that Petitioner has established by a preponderance of evidence that Martin and Kohn teach the limitations of dependent claim 63 and claim 61 from which it depends, and that a person of ordinary skill in the art would have been motivated to combine the references' teachings.

III. MOTION TO EXCLUDE

In our prior Final Written Decision, we denied Patent Owner's Motion to Exclude (1) portions of Exhibit 1153; (2) Exhibits 1170, 1171, and 1172; (3) Exhibit 1174; and (4) portions of Exhibits 2037 and 2038; and we dismissed as moot Patent Owner's Motion to Exclude (1) Exhibits 1158 and 1159 and (2) Exhibits 1175, 1176, and 1181. Final Dec. 25–28. We maintain these determinations on remand.

IV. PATENT OWNER'S CONSTITUTIONAL CHALLENGE

Patent Owner raises two constitutional challenges, which we need not consider. First, Patent Owner argues that subjecting a pre-AIA patent, such as the '115 patent, retroactively to *inter partes* review violates the Takings and Due Process Clauses of the Fifth Amendment. PO Resp. 60. Second, Patent Owner asserts that *inter partes* reviews violate the Appointments Clause of the U.S. Constitution when conducted by administrative patent judges not nominated by the President and confirmed by the Senate. *Id.*

Patent Owner's Appointments Clause challenge is unavailing as we are bound by the Supreme Court's decision in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021), which addressed this issue.

With regard to the Takings and Due Process Clause challenges, we note that challenges to retroactive application of IPRs to pre-AIA patents have been addressed by the Federal Circuit in *Celgene Corp. v. Peter*, 931 F.3d 1342, 1357–63 (Fed. Cir. 2019), *cert. denied*, 2020 WL 3405867 (June 22, 2020) (Takings Clause), and *Sound View Innovations, LLC v. Hulu, LLC*, Nos. 2019-1865, 2019-1867, 2020 WL 3583556, at *3 (Fed. Cir. July 2, 2020) (non-precedential) (Due Process Clause).

V. CONCLUSION⁹

For the reasons discussed above, we conclude that Petitioner has demonstrated by a preponderance of the evidence that the remaining challenged claim 63 of the '115 patent is unpatentable.

⁹ Should Patent Owner wish to pursue amendment of the challenged claim in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

The table below summarizes our conclusions:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
63 ¹⁰	103(a)	Martin, Kohn	63	

VI. ORDER

In consideration of the foregoing, it is:

ORDERED that claim 63 of the '115 patent has been shown to be unpatentable;

FURTHER ORDERED that, Patent Owner's Motion to Exclude is denied in part and dismissed in part; and

FURTHERED ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

¹⁰ As stated above, the Petition challenged claims 61–70 of the '115 patent. Pet. 4–5. However, claims 61, 62, and 64–70 were found unpatentable, leaving claim 63 as the remaining challenged claim. *See Microsoft*, IPR2019-00814, Paper 52 at 47–48 (PTAB Dec. 2, 2022) (Final Written Decision on Remand) and *Microsoft*, No. 2021-1412, 2022 WL 989403 (Fed. Cir. Apr. 1, 2022) (finding, *inter alia*, claims 61, 62, and 64–70 of the '115 patent unpatentable).

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