Trials@uspto.gov
571-272-7822

Paper 81
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.

IPR2019-00730
Patent 7,069,560 B1

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

JEFFERSON, *Administrative Patent Judge*.

TERMINATION
Dismissal After Institution of Trial on Remand
37 C.F.R. § 42.72

The United States Court of Appeals for the Federal Circuit 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 72 ("Final Dec."). The Federal Circuit remanded to address whether a cited reference was prior art under 35 U.S.C. § 102(a) to the challenged claims of U.S. Patent No. 7,069,560 B1 ("the '560 patent," Ex. 1001). *Id.*

Our vacated Final Written Decision addressed the challenges of Petitioner, Google LLC, to claims 1–4 and 14–24 ("the challenged claims") of the '560 Patent. Paper 1 ("Pet.") 4–5; Paper 11 ("Dec. on Inst."), 36–37; Final Dec. 26, 30. On June 28, 2022, the Federal Circuit issued its mandate. *See* Paper 75.

Following Remand, the parties, Petitioner and Patent Owner (IPA Technologies Inc.), filed additional briefing limited to addressing the remanded prior art issue. *See* Petitioner's Brief on Remand (Paper 79); Patent Owner's Responsive Remand Brief (Paper 80).

On May 16, 2023, following the conclusion of related *inter partes* review proceedings addressing the patentability of claims in the '560 patent, an *inter partes* review certificate issued cancelling claims 1–27, 29–49, and 52 of the '560 patent. *See, e.g.*, *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00835, Paper 53 (PTAB May 16, 2023) (835 Trial Certificate Checklist); Ex. 3002 (Inter Partes Review Certificate). The cancellation of claims 1–27, 29–49, and 52 of the '560 patent removes challenged claims 1–4 and 14–24 in the present case.

Following the 835 Trial Certificate, no challenged claims of the '560 patent remain in this proceeding. *Id.* Under 37 C.F.R. § 42.73(b)(2), Patent Owner is precluded from taking action inconsistent with the prior

judgments,[1] including obtaining in any patent a claim that is not patentably distinct from a finally refused or canceled claim. *See Facebook, Inc. v. Uniloc USA, Inc.*, IPR2016-01756, Paper 43 (PTAB June 6, 2022) (terminating remanded case following an *inter partes* review certificate cancelling all claims).

Because the challenged claims have been canceled, good cause exists to terminate this proceeding.

Accordingly, it is

ORDERED that this proceeding is terminated.

[1] Here, the challenged claims have been cancelled pursuant to judgments in IPR2019-00835, IPR2019-00836, and IPR2019-00837 against Patent Owner. *See* 835 Trial Certificate Checklist; *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).

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PETITIONER:

Naveen Modi
Joseph Palys
Daniel Zeilberger
Arvind Jairam
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
joesphpalys@paulhastings.com
danielzeilberger@paulhastings.com
arvindjairam@paulhastings.com

PATENT OWNER:

Steven Hartsell
Alexander Gasser
Sarah Spires
SKIERMONT DERBY LLP
shartsell@skiermontderby.com
agasser@skiermontderby.com
sspires@skiermontderby.com