

**Keywords:** patents; joint-inventors; prior publication; corroboration

**General:** For pre-AIA patents, the courts will use the *Duncan* analysis to decide whether a reference is “by another” when determining whether publications are available as prior art references.

Google LLC. v. IPA Technologies Inc.  
United States Court of Appeals for the Federal Circuit  
Nos. 2021-1179, 2021-1180, 2021-1185  
Decided: May 19, 2022

## **I. Background & Facts**

IPA Technologies Inc. (“IPA”) owns Patent Nos. 6,851,115 (the ‘115 patent, filed January 5, 1999) and 7,069,560 (the ‘560 patent, filed March 17, 1999), relating to software based architecture. Each patent lists David L. Martin and Adam J. Cheyer as inventors. Prior to both filings, in conjunction with a conference that took place March 23-25, 1998, Martin, Cheyer and a third author, Dr. Douglas B. Moran, published an academic paper entitled “Building Distributed Software Systems with the Open Agent Architecture” (“Martin reference”). The paper described the patent’s underlying technology, Open Agent Architecture (“OAA”) and at least some of the technology embodied by the claims of the ‘115 and ‘560 patents was also described. During prosecution of the challenged patents, the Examiner rejected various claims based on the Martin reference. In response, inventor declarations from Cheyer and Martin were admitted under C.F.R. § 1.132, asserting Dr. Moran was not a co-inventor. The declarations resulted in withdrawal of the rejections.

Thereafter, relying on the Martin reference, Google LLC (“Google”) petitioned the Patent Trial and Appeal Board (“Board”) for *inter partes* review (“IPR”) of both the ‘115 and ‘560 patents in February 2019. Google contended the Martin reference was prior art “by others,” since it described the work of an inventive entity (Martin, Cheyer, and Dr. Moran) different from the inventive entity of the challenged patents (Martin and Cheyer). However, the Board found that Google failed to show Dr. Moran was an “inventive entity with respect to the Martin reference” due to insufficient corroborating evidence of Dr. Moran’s testimony, and therefore concluded the Martin reference was not prior art. Google appealed.

## **II. Issues**

- 1) Did the Board correctly decide that the Martin reference was not “by another” and, accordingly, was not available as prior art?

### **III. Discussion**

No. The court noted that in deciding whether a reference patent is by another (for patents filed pre-AIA), the *Duncan* analysis should be applied to:

- (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)).

Pursuant to this analysis, the court made it clear that Google had the ultimate burden to show unpatentability. Therefore, Google was required to show the Martin reference was prior art “by another” through showing Dr. Moran made a significant enough contribution to the portions relied on to invalidate the challenged patents.

To show Dr. Moran made significant contributions to the invalidating portions of the Martin reference, Google relied on testimony by Dr. Moran in which he claimed to play a significant role in the use of a facilitator in OAA, as described in the Martin reference. Google argued that the facilitator played a central role in OAA underlying technology and that its description in the Martin reference rendered claims of the ‘115 patent and the ‘560 patent obvious.

In contrast, Cheyer, in his testimony, characterized Dr. Moran’s contribution as technical assistance at the application level. Similarly, Martin testified that he and Cheyer were responsible for the technical details in the Martin reference, and characterized Dr. Moran’s contribution as “administrative.” The court noted that Dr. Moran’s testimony, if credited, might establish that he was a co-inventor of the particular portions of the Martin reference relied on by Google to challenge particular claims. However, the court found that the Board failed to complete the full *Duncan* analysis and instead merely appeared to have concluded that Dr. Moran’s testimony was insufficiently corroborated by additional evidence. The court disagreed with this conclusion by the Board, finding that the record revealed more than adequate corroboration of Dr. Moran’s testimony.

The court noted that while “corroborating an inventor’s testimony is a well-established principle in our case law” for purposes of determining inventorship, it is not the case that “an inventor must produce contemporaneous documentary evidence...to support his or her declaration” or that a “high degree of corroboration...is required across the board.” *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 1346–47 (Fed. Cir. 2017). Moreover, the court recognized that although co-authorship does not presumptively make a co-author a co-inventor, *e.g.*, *In re Katz*, 687 F.2d 450, 455 (CCPA 1982); *Allergan*, 754 F.3d at 969, it is significant corroborating evidence that a co-author contributed to the invention. As applied to the present facts, the court found 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 a related continuation-in-part patent with priority to the '115 patent.

The court reasoned that the issue in this case was not lack of corroboration for Dr. Moran's testimony, but rather whether his testimony should ultimately be credited over Cheyer and Martin's conflicting testimony during the IPR proceedings. Instead of resolving the conflicts, the Board stated that it found all the witnesses, including Dr. Moran, credible. The court found that this was not a tenable position for the Board to take and remanded the case to the Board to complete the *Duncan* analysis.

#### **IV. Conclusion and Takeaways**

- 1) The *Duncan* analysis is applied in determining whether a reference is applicable as prior art against pre-AIA patents and applications.
- 2) Co-authorship of a reference provides significant corroborating evidence to a person's testimony regarding their technical contributions to that reference.