Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner.

_____

Case No. IPR2025-00487
Patent No. 7,519,814

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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1001	U.S. Patent No. 7,519,814 ("'814 patent")
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1003	Declaration of Samrat Bhattacharjee, Ph.D. ("Bhattacharjee")
1004	Curriculum Vitae of Samrat Bhattacharjee, Ph.D.
1005	U.S. Patent No. 7,117,495 ("Blaser")
1006	U.S. Patent Application Publication No. 20020066022 ("Calder")
1007	U.S. Patent No. 6,931,449 ("Schmidt-449")
1008	U.S. Patent Application Publication No. 20020095479 ("Schmidt-479")
1009	U.S. Patent Application Publication No. 20020133529 ("Schmidt-529")
1010	U.S. Patent Application Publication No. 20020124072 ("Tormasov")
1011	U.S. Patent Application Publication No. 20010009425
1012	U.S. Patent Application Publication No. 20010018708
1013	U.S. Patent Application Publication No. 20010047472
1014	U.S. Patent Application Publication No. 20010056572
1015	U.S. Patent Application Publication No. 20010029605
1016	U.S. Patent Application Publication No. 20020023158
1017	U.S. Patent Application Publication No. 20020052727
1018	U.S. Patent Application Publication No. 20020143795
1019	U.S. Patent Application Publication No. 20020156612
1020	U.S. Patent Application Publication No. 20020156877
1021	U.S. Patent Application Publication No. 20020174215
1022	U.S. Patent Application Publication No. 20020188718
1023	U.S. Patent Application Publication No. 20020194394
1024	U.S. Patent Application Publication No. 20020194488
1025	U.S. Patent Application Publication No. 20030009408
1026	U.S. Patent Application Publication No. 20030014381

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1027	U.S. Patent Application Publication No. 20030014466
1028	U.S. Patent Application Publication No. 20030018717
1029	U.S. Patent Application Publication No. 20030023839
1030	U.S. Patent Application Publication No. 20030041173
1031	U.S. Patent Application Publication No. 20030093688
1032	U.S. Patent Application Publication No. 20030097464
1033	U.S. Patent No. 6,467,052
1034	U.S. Patent Application Publication No. 20030140179
1035	U.S. Patent Application Publication No. 20030154221
1036	U.S. Patent No. 7,159,184
1037	U.S. Patent No. 7,103,745
1038	U.S. Patent No. 6,263,440
1039	U.S. Patent Application Publication No. 20040190534
1040	U.S. Patent No. 7,356,771
1041	U.S. Patent No. 5,903,753
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1044	U.S. Patent No. 5,421,009
1045	U.S. Patent No. 5,568,630
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1047	U.S. Patent No. 5,657,221
1048	U.S. Patent No. 5,675,831
1049	U.S. Patent No. 5,742,829
1050	U.S. Patent No. 4,742,450
1051	U.S. Patent No. 5,761,669
1052	U.S. Patent No. 5,784,555
1053	U.S. Patent No. 5,835,765

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1054	U.S. Patent No. 6,044,465
1055	U.S. Patent No. 6,122,744
1056	U.S. Patent No. 6,195,650
1057	U.S. Patent No. 6,321,323
1058	U.S. Patent No. 6,363,409
1059	U.S. Patent No. 6,453,470
1060	U.S. Patent No. 6,567,767
1061	U.S. Patent No. 6,732,359
1062	U.S. Patent No. 6,874,148
1063	U.S. Patent No. 6,985,937
1064	U.S. Patent No. 7,140,015
1065	U.S. Patent No. 7,185,192
1066	U.S. Patent No. 7,454,440
1067	U.S. Patent No. 8,209,680
1068	U.S. Patent No. 5,926,636
1069	U.S. Patent No. 5,218,530
1070	U.S. Patent No. 6,134,593
1071	U.S. Patent No. 6,918,038
1072	U.S. Patent Application Publication No. 20040034623
1073	U.S. Patent No. 7,461,148
1074	U.S. Patent No. 7,136,800
1075	PCT Application Publication No. WO2002056156
1076	Kamp et al., "Jails: Confining the omnipotent root," Proceedings of the 2nd International SANE Conference (Vol. 43, p. 116) (2000)
1077	Prevelakis et al., "Sandboxing Applications," USENIX Annual Technical Conference, FREENIX Track (pp. 119-126) (2001)
1078	Plaintiff VirtaMove Corp.'s Supplemental Preliminary Disclosure of Asserted Claims and Infringement Contentions, in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Sept. 06, 2024)

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1079	Chart re: '814 Patent accompanying Plaintiff VirtaMove Corp.'s Supplemental Preliminary Disclosure of Asserted Claims and Infringement Contentions, in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Sept. 6, 2024)
1080	First Amended Complaint for Patent Infringement Against Google LLC in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (May 21, 2024)
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1082	Federal Court Management Statistics–Profiles, U.S. District Courts–Combined Civil and Criminal (September 2024)
1083	U.S. Patent Application Publication No. 20020095500 ("Schmidt-500")
1084	U.S. Patent Application Publication No. 20050169073
1085	U.S. Provisional Application No. 60/533,388
1086	U.S. Patent No. 5,412,808
1087	Order Granting Defendant Google LLC's Motion to Transfer Venue to the Northern District of California in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Jan. 22, 2025)
1088	Microsoft's Computer Dictionary (5th ed. 2002) (excerpt)
1089	U.S. Patent No. 6,381,742
1090	U.S. Patent Application Publication No. 20030035430
1091	U.S. Patent No. 6,477,624
1092	U.S. Patent No. 5,931,947
1093	U.S. Patent No. 6,148,335
1094	U.S. Patent No. 6,944,790
1095	U.S. Patent No. 6,014,135
1096	U.S. Patent No. 6,282,660
1097	U.S. Patent Application Publication No. 20040153709
1098	U.S. Patent Application Publication No. 20050050389
1099	U.S. Patent Application Publication No. 20040225952

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1101	Plaintiff's Disclosure of Proposed Claim Constructions in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Oct. 1, 2024)
1102	Google LLC's Opening Claim Construction Brief in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Oct. 24, 2024)
1103	Plaintiff's Responsive Claim Construction Brief in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Nov. 12, 2024)
1104	Google LLC's Reply Claim Construction Brief in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Nov. 26, 2024)
1105	Plaintiff's Sur-Reply Claim Construction Brief in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Dec. 13, 2024)
1106	Joint Claim Construction Statement in *VirtaMove, Corp. v. Google LLC*, 7:24-cv-00033-DC-DTG (W.D. Tex.) (Dec. 18, 2024)
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1108	U.S. Patent Application Publication No. 20050188268
1109	U.S. Patent Application Publication No. 20020140743
1110	U.S. Patent Application Publication No. 20020143906 ("Tormasov-906")
1111	U.S. Patent No. 7,076,633 ("Tormasov-633")
1112	U.S. Patent Application Publication No. 20060089950 ("Tormasov-950")
1113	U.S. Patent No. 7,222,132 ("Tormasov-132")
1114	U.S. Patent Application Publication No. 20020147815 ("Tormasov-815")
1115	U.S. Patent No. 7,209,973 ("Tormasov-973")
1116	U.S. Patent Application Publication No. 20020138629 ("Schmidt-629")
1117	U.S. Patent No. 6,944,860 ("Schmidt-860")
1118	U.S. Patent Application Publication No. 20020174265 ("Schmidt-265")

Exhibit	Description
1119	U.S. Patent Application Publication No. 20020116659 ("Tormasov-659")
1120	Bach, Maurice. 1987. Design of the Unix Operating System by Marice J Bach, 1 edition (Feb. 27, 1987) Prentice Hall; ISBN: 0132017997.
1121	Crowley, Charles. 1997. Operating Systems: a design-oriented approach. Irwin. 1997. ISBN 0-256-15151-2.
1122	Eckel, George and Chris Hare. 1995. Building a Linux Internet Server, Chris Hare", G. Eckel, New Riders Publishing; ISBN: 1562055259.
1123	RESERVED
1124	RESERVED
1125	RESERVED
1126	RESERVED
1127	U.S. Patent No. 6,854,009
1128	U.S. Patent No. 7,080,356
1129	U.S. Patent No. 5,870,539
1130	U.S. Patent No. 6,883,028
1131	U.S. Patent No. 7,209,959
1132	U.S. Patent Application Publication No. 20020065835
1133	The Wayback Machine archive of USENIX Association – Home Page (2001-11-14)
1134	The Wayback Machine archive of USENIX – Publications – Proceedings (2001-11-15)
1135	The Wayback Machine archive of USENIX – 2001 USENIX Annual Technical Conference (2001-11-11)
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1144	The Wayback Machine archive of Second International SANE Conference (2001-06-20)
1145	The Wayback Machine archive of "Jails: Confining the omnipotent root." (2000-09-02)
1146	The Wayback Machine archive of Linux Journal (1999-05-08)
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1148	RESERVED
1149	RESERVED
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1157	Civil Docket in *IP, LLC v. Lyft, Inc.*, 3:24-cv-03348-RFL (N.D. Cal.) (includes civil docket for 7:24-cv-00051 (W.D. Tex.))
1158	Civil Docket in *Safecast Ltd. v. Google, LLC*, 5:23-cv-03128-PCP (N.D. Cal.) (includes civil docket for 6:22-cv-00678 (W.D. Tex.))
1159	Civil Docket in *eCardless Bancorp, Ltd. v. PayPal Holdings Inc.*, 5:24-cv-01054-BLF (N.D. Cal.) (includes civil docket for 7:22-cv-00245 (W.D. Tex.))
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1166	Scheduling Order in *eCardless Bancorp, Ltd. v. PayPal Holdings Inc.*, 5:24-cv-01054-BLF (N.D. Cal. May 27, 2024)
1167	Scott R. Boalick (Chief APJ), *Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*" (Mar. 24, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf (last checked June 2, 2025)
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I. INTRODUCTION

VirtaMove's lawsuit against Google was recently transferred from the Western District of Texas (WDTX) to the Northern District of California (NDCA), where no trial date has been set and an initial case management conference has yet to be scheduled. The *Fintiv* factors weigh strongly against denial because it is highly likely that a final written decision ("FWD") will issue in this IPR well before any trial will take place in NDCA.

As the Director found in the *Twitch Interactive* cases discussed *infra* §II.A, NDCA has stayed parallel litigation 76% of the time after institution of an *inter partes* review. And if the NDCA litigation is not stayed, there is no reason to believe that any trial date (there currently is none) would precede an FWD in this IPR. EX2003, at 66; *infra* §§II.B.1-3. VirtaMove says that because of progress allegedly made in WDTX before the litigation was transferred, a trial is likely to take place in NDCA within the next 12 months. That baseless assertion is refuted by objective evidence. Fact discovery in WDTX had only just commenced before the case was stayed and then transferred to NDCA. *See infra* §II.C. In two examples of similarly-situated cases that were also recently transferred to NDCA from WDTX after claim construction briefing was concluded, trials were scheduled for 20 months or more after the initial case management conference (EX1164, EX1166), which is currently unscheduled in this case. *See infra* §II.B.3.

Thus, any trial date to be scheduled in NDCA will likely be well after the FWD issues. *Infra* §II.B.2-3. The *Fintiv* factors therefore weigh heavily against discretionary denial.

VirtaMove's separate assertion that discretionary denial is warranted because the Petition allegedly "over"-relies on expert testimony is baseless. VirtaMove exalts form over substance by criticizing the declaration's length. The Director and the Board have consistently rejected that argument based on declarations of comparable length. *See infra* §§IV.A.1-2. VirtaMove's other complaint is that the expert declaration cites prior-art references (which VirtaMove pejoratively calls "shadow references") to corroborate the expert's explanations of background knowledge of those of skill in the art. These citations show exactly the opposite of "over"-reliance on expert testimony, by demonstrating that the Petition makes its case based on patents and printed publications rather than an expert's say-so. Indeed, in a recent decision rejecting the same argument VirtaMove advances, the Board applauded an expert declaration for extensively citing corroborating references. *See infra* §IV.A.2. There is nothing about the Petition's citation to the expert declaration that warrants discretionary denial.

VirtaMove's additional assertion that Amazon having filed its own petitions warrants discretionary denial is premised on the assertion that Google "coordinated" with Amazon on the IPRs. That unsubstantiated assertion is false.

VirtaMove sued Amazon, Google, IBM, and Hewlett Packard Enterprise ("HPE") over a two-week period, and then Microsoft and Oracle several months later, on the same patents. That VirtaMove faces IPRs from multiple petitioners is the unsurprising direct result of VirtaMove's own choices. VirtaMove's assertion that discretionary denial is warranted because an unrelated company (Amazon) filed its own IPR petition is contrary to the Board's established precedent.

Finally, VirtaMove ignores the Petition's merits. Petitioner identified prior art that was not of record during original prosecution and that discloses the claim feature that the examiner found missing from the prior art of record during prosecution in allowing the '814 patent. *See infra* §II.F. The strength of the Petition is reinforced by the fact that two sophisticated companies—Microsoft and Oracle—have moved to join this IPR. The Petition's strong merits weigh against discretionary denial.

VirtaMove fails to identify any legitimate basis for discretionary denial because there is none. The Director should decline to discretionarily deny this Petition and should pass this case to a Board panel to be evaluated on its merits.

II. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER *FINTIV*

There is no basis to deny this IPR under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (precedential) (Mar. 20, 2020) ("*Fintiv*"). The parties' litigation was recently transferred from WDTX to NDCA and no trial date has been

scheduled. Indeed, NDCA has yet to schedule an initial case management conference ("CMC") to discuss a schedule and set a trial date.

There is every reason to believe that no trial will take place in NDCA until after an FWD issues in this IPR. Examples of other recent cases in procedural postures like Google's NDCA case (i.e., transferred from WDTX to NDCA after claim construction briefing was completed), as well as NDCA's median time-to-trial statistics, demonstrate that the trial is highly likely to be scheduled for a date ***after*** the date by which an FWD will issue here. *See infra* §§II.B.2-3. And as the Director recently found in deciding not to exercise her discretion to deny an IPR based on a parallel litigation in NDCA, stays are granted at a high rate (76%) in that jurisdiction after an IPR is instituted, which further weighs against discretionary denial. *See infra* §II.A.

"The framers of the AIA intended for IPR to serve as a faster, less costly alternative to district court litigation" and to "improve patent quality by providing a more efficient means to adjudicate patent validity issues." EX1150, i, 13. Those objectives would be served here by having a merits panel evaluate Google's IPR on the merits. The efficiencies gained if the Board were to institute an IPR trial would be further magnified given that Oracle and Microsoft have sought to join Google's IPRs in understudy roles.

The *Fintiv* factors weigh heavily in favor of instituting this IPR.

A. Factor 1 (Stay Potential) Weighs Against Denial Because NDCA Commonly Stays Litigation Once IPR Is Instituted

Fintiv Factor 1, which considers the likelihood of a stay, weighs against discretionary denial. As ***the Director recently recognized***, the stay rate in NDCA is 76% in cases like this where an FWD will precede the trial date (which is as-yet unscheduled here). *See Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 2-3 (May 16, 2025) (finding potential for stay in NDCA weighed against discretionary denial where a yet-to-be-scheduled trial would likely occur after FWD, because "[o]ver the past twelve years" NDCA judges "have granted or partially granted 76% of all post-institution motions to stay pending" IPRs) (citing evidence from Docket Navigator);[1] *see also Regents of Univ. of Michigan v. Novartis Pharms. Corp.*, No. 22-CV-04913-AMO, 2023 WL 6795971, at *1 (N.D. Cal. Oct. 12, 2023) ("Courts in this district have often recognized a 'liberal policy in favor of granting motions to stay' pending IPR." (quoting *Zomm, LLC v. Apple Inc.*, 391 F. Supp. 3d 946, 956 (N.D. Cal. 2019)).

Nevertheless, VirtaMove argues "there is no reason to suggest" that NDCA will stay the litigation. *See* VirtaMove's Request for Discretionary Denial (Paper 8, hereafter "DD-Brief"), 7. This is not credible. VirtaMove itself represented to the Federal Circuit in a mandamus petition filed just last week seeking to undo the

[1] The most up-to-date stay percentage for NDCA is the same. EX1151 (76%).

transfer to NDCA that the NDCA "is known to stay cases pending USPTO proceedings." EX1172, 34.

Thus, Factor 1 weighs against discretionary denial.

B. Factor 2 (Timing of Trial and FWD) Weighs Heavily Against Denial Because No Trial Date Has Been Set and Any Trial Date Will Be After FWD

Factor 2 considers the relative timing of the court's trial date and the IPR's FWD. Because no trial date has been set in NDCA, and because any trial is likely to take place after the FWD here, Factor 2 weighs heavily against denial. VirtaMove's arguments, which are inconsistent with representations it has made in other forums, do not show otherwise.

1. No trial date has been scheduled

On May 7, 2025, WDTX ordered VirtaMove's case against Google transferred to NDCA. EX1173, at 9 (DKT#102). Google's motion for transfer had been granted by the WDTX magistrate judge in January but was stayed at VirtaMove's request to allow VirtaMove time to object. *See id.*, 8 (DKT#86), 9 (DKT#94-95). In May, the WDTX District Court Judge overruled VirtaMove's objections to the magistrate's transfer order, and ordered the case transferred to NDCA. *See id.*, 9 (DKT#102).

The court normally will not set a schedule with a trial date until at or after the initial case management conference, which itself currently does not have a

scheduled date.[2] Given that NDCA has not set a trial date, Factor 2 weighs against discretionary denial. *Twitch*, IPR2025-00307, Paper 18 at 2-3 (Director declining to discretionarily deny institution where, like here, an NDCA trial had not yet been scheduled but some discovery had already occurred); *id.*, Paper 11 at 12-13 (discussing some discovery having occurred); *see also BMW of N. Am., LLC v. Michigan Motor Techs., LLC*, IPR2023-01224, Paper 15 at 11 (Feb. 15, 2024) ("Factor 2 favors institution as it is undisputed that no trial date was set in district court.").

2. NDCA's median time-to-trial statistics for civil actions

In a memorandum dated March 24, 2025, Chief APJ Boalick stated that the Board will consider "median time-to-trial statistics for civil actions" under *Finitiv* Factor 2. EX1167, at 3. The Director's March 26, 2025 Memorandum addressing "Interim Processes for PTAB Workload Management" (hereafter "Interim Memo") issued two days later on March 26, 2025. Since the issuance of the Director's Interim Memo, several Board decisions have relied on the most recent median-time-to-trial statistics for all civil actions. *See Charter Commncs., Inc. v. Adaptive*

[2] There have been some false-starts in setting a case management conference in NDCA but, at present, no initial case management conference is on the schedule. *See* EX1154.

Spectrum & Signal Alignment, Inc., IPR2025-00087, Paper 14 at 9-11 (May 5, 2025) (citing the most recent median time-to-trial statistics for all civil cases); *Liberty Energy, Inc. v. U.S. Well Servs., LLC*, IPR2025-00031, Paper 9 at 11-12 (Apr. 29, 2025) (citing the Interim Memo as support for finding consistency between "median time-to-trial statistics" and a scheduled trial date); *HP Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01429, Paper 11 at 8-9 (Apr. 16, 2025) (citing the most recent median "time-to-trial statistics" for civil actions).

VirtaMove concedes that NDCA's current median time-to-trial for all civil actions is 34.5 months. DD-Brief, 8 n.2 (citing EX2003, at 66). Thus, even if VirtaMove were right that its litigation against Google in NDCA is about "halfway" to trial (DD-Brief, 7),[3] applying NDCA's median time-to-trial for all civil actions indicates that even if a case management conference were held tomorrow, a trial would likely be scheduled for a date more than 17 months (half of 34 months) from now, which would be two months ***after*** the FWD will issue here.[4]

[3] The litigation is not halfway to trial. *See infra* §§II.B.3-4, §II.C.

[4] Also, as discussed *infra* §II.B.4, even if representative statistics for only patent cases were used, they still would put trial later than FWD.

3. Schedules in cases transferred into NDCA at a similar stage reinforce that a trial is unlikely to take place before FWD

Petitioner has been able to identify two other cases that were transferred from WDTX to NDCA in the past two years at a similar procedural stage to VirtaMove's case against Google—where claim construction briefing had occurred in WDTX but a *Markman* hearing had not—and thereafter had scheduling orders entered in NDCA. Those scheduling orders provide further evidence that trial likely will be scheduled for a date after the FWD in this case.

eCardless Bancorp, Ltd. v. PayPal Holdings Inc., 5-24-cv-01054 (NDCA) involved a case transferred to NDCA from WDTX after claim construction briefing was completed but before a *Markman* hearing. EX1159, at 6 (DKT#61, 11/01/2023 reply claim construction brief filed in WDTX), 8 (DKT#86, 02/22/2024 transfer of case to NDCA). Trial in that case was scheduled for ***20 months*** after the case management conference—i.e., 23 months after WDTX's transfer order. *See* EX1159, at 10-11 (DKT#116, order setting case management conference for 05/02/2024; DKT#123, scheduling order setting trial for 01/12/2026).

Safecast Ltd. v. Google LLC was also transferred to NDCA from WDTX after claim construction briefing was completed but before a *Markman* hearing. EX1158, at 5 (DKT#53, WDTX *Markman* hearing scheduled for 06/29/2023; DKT#54, joint claim construction brief filed; DKT#56, 06/23/2023 order granting

motion to transfer to NDCA). Trial in that case was scheduled for ***24 months*** after the case management conference—i.e., 28.5 months after WDTX's transfer order. *See* EX1158, at 9-10 (DKT#87, order setting case management conference for 11/09/2023; DKT#98, scheduling order setting trial for 11/10/2025).

Thus, the above two cases having similar procedural postures as Google's had their NDCA trial dates scheduled for a date 20-24 months after the date of the case management conference. An FWD will be due in this IPR within 15 months from now; thus, similar timing in NDCA would place trial months after FWD, even if a case management conference in Google's case were held tomorrow.

4. VirtaMove's statistics here are not a reliable indicator of what trial date will be scheduled in VirtaMove's litigation against Google

Initially, despite telling the Director that trial in NDCA is likely to happen within 9-12 months (DD-Brief, 8), in its just-filed petition seeking mandamus to overturn or vacate the order transferring the case to NDCA, VirtaMove told the Federal Circuit that "VirtaMove's case is likely to languish in the NDCA for 6-7 years without trial." EX1172, at 1. Regardless, VirtaMove bases an estimated trial date on EX2002, which VirtaMove characterizes as including Docket Navigator's "median time-to-trial statistics" for NDCA for patent cases "from May [01,] 2020 to" May 11, 2025. But as VirtaMove notes, this "exclud[es] cases with stays." DD-Brief, 7-8. As such, VirtaMove lists just ***five*** patent cases. When cases with

stays are ***not*** excluded over the same five-year period covered by EX2002, there are 12 patent cases that went to trial, and Docket Navigator's median time-to-trial for those cases in NDCA is ***31*** months. *See* EX1152. That is comparable to NDCA's median time-to-trial for all civil cases, which VirtaMove concedes is 34.5 months. DD-Brief, 8 n.2 (citing EX2003, at 66).

Despite the Board's practice to the contrary (*supra* §II.B.2), VirtaMove alleges that stayed cases should be excluded when determining median time-to-trial because if this case were "hypothetically stayed pending IPR, then its time-to-trial is not relevant (because trial would necessarily occur *after* final written decision)." DD-Brief, 8 n.2 (emphasis original). VirtaMove cites no case where the Director or the Board has excluded stayed cases in determining a median time-to-trial. There is good reason why the Director and the Board should consider all cases (including stayed cases) in determining the median time-to-trial. Considering ***all*** patent cases in NDCA is a more accurate indicator of when this case will go to trial than VirtaMove's sample because nothing suggests that this case will be among the minority of cases that would not be stayed if this IPR is instituted.

VirtaMove also argues that "[b]ecause claim construction briefing was already completed" in WDTX, "the case is approximately halfway to trial" so that "the time to trial will be reduced significantly" and "be set for 9-12 months from

the May 7 transfer date." DD-Brief, 7-8. This is unsupported by any ***evidence***. As discussed further below (§II.C addressing Factor 3), there is much work to be done before the trial would occur. While claim construction briefing occurred in WDTX, no *Markman* hearing has yet been held, and no decision has been issued. Fact discovery had only just opened on January 10 before the WDTX case was stayed on January 22 and then transferred. And as explained above (§§II.B.2-3), median time-to-trial statistics for all civil cases and actual schedules for similarly-situated patent cases transferred into NDCA illustrate that a trial is not likely to be scheduled to occur until after the FWD.

By any reasonable metric (*see supra* §§II.B.1-3), a trial in NDCA is highly unlikely to take place until after an FWD has issued in this IPR.

5. NDCA is the correct venue to consider under *Fintiv*

Although VirtaMove filed a petition for writ of mandamus with the Federal Circuit on June 4, 2025 seeking reversal or vacatur of the transfer to NDCA (EX1172, at 3), VirtaMove does not dispute that the NDCA proceeding is the one to consider for *Fintiv* analysis. VirtaMove's request to the Director for

discretionary denial only argues for denial under *Fintiv* in view of the case proceeding in NDCA, not back in WDTX.[5] DD-Brief, 5-14.

The Federal Circuit typically takes about two and a half months to issue orders responsive to mandamus petitions. *See* EX1155-EX1157. Docket Navigator lists few, if any, cases since 2017 where the Federal Circuit granted a ***plaintiff's*** mandamus petition to overturn or vacate a district court's venue-transfer order. *See* EX1161. Even in the highly unlikely event that the case was transferred back, WDTX would have to issue a new scheduling order. Trial in WDTX was still 12.5 months away when the court granted Google's transfer motion. EX1154, at 4 (DKT#34, setting WDTX trial for 02/02/2026), 8 (DKT#86, 01/22/2025 order granting motion to transfer). It is highly unlikely that there will be a trial in WDTX at all, let alone one that would occur before the FWD issues.

6. Factor 2 conclusion

For the reasons discussed above (§§II.B.1-5), there is every reason to believe that no district-court trial will take place until after an FWD issues. Thus, Factor 2 weighs heavily against denial.

[5] If the Director were to authorize VirtaMove to belatedly seek discretionary denial under *Fintiv* in view of an anticipated trial in WDTX rather than NDCA, Google would seek authorization to respond to any such belated argument.

C. Factor 3 (Litigation Investment) Weighs Against Discretionary Denial

There has been limited investment in the district-court litigation. "[A] significant portion of work remains to be done," including scheduling and conducting a *Markman* hearing and conducting most "fact" discovery and all "expert discovery and dispositive motions." *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 14-15 (Mar. 4, 2022). Indeed, in NDCA, "the court has not set any deadlines for those activities" yet. *Bio-Rad Labs., Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11 at 10 (Mar. 27, 2025). Thus, Factor 3 weighs strongly against discretionary denial.

VirtaMove alleges that "the parties have already served extensive infringement and invalidity contentions, and fully briefed and already had a hearing on claim construction." DD-Brief, 9. Much of that is false. A claim construction hearing was scheduled for January 21, 2025, but was never held because WDTX cancelled the hearing before transferring the case to NDCA. EX1154, at 7 (DKT#84, cancelling *Markman* hearing). And only ***preliminary*** infringement and invalidity contentions were served, not final contentions. Fact discovery had opened January 10, 2025 (EX1081, at 3) and the parties served discovery requests, but neither party responded to them given the transfer order and stay that occurred 12 days later.

VirtaMove further argues (without evidence) that, under an alleged "typical schedule," by the time of the institution decision (three months from now), "a claim construction order will have issued, the parties will have nearly completed fact discovery, and the parties will be preparing opening expert reports." DD-Brief, 9. But actual schedules in NDCA for similarly-situated cases (transferred from WDTX after claim construction briefing) support that a *Markman* hearing, an order, and nearly-complete fact discovery would not happen until after the institution decision. *See* EX1166 (*eCardless* scheduling order setting *Markman* hearing over 5 months after the case management conference, fact discovery closing 8.5 months after the case management conference); EX1165 (*SafeCast* scheduling order leaving *Markman* hearing unscheduled and setting fact discovery to close 12 months after the case management conference).

Factor 3 weighs heavily against denial.

D. Factor 4 (Issue Overlap) Weighs Against Discretionary Denial

This Petition challenges all 34 claims of the '814 patent, while only 8 are asserted in district court. EX1079; DD-Brief, 10. VirtaMove's "stipulat[ion] that it will not assert against Google any claims of the '814 patent other than those already asserted against Google" ("if institution is denied") (DD-Brief, 10) does not change the fact that Google's IPR addresses 26 claims that NDCA will not address. That "fact alone minimizes the potential overlap between the issues raised

here vis-à-vis those raised in the parallel proceeding," and weighs against denial. *Markforged Inc. v. Continuous Composites Inc.*, IPR2022-00679, Paper 7 at 32-33 (Oct. 25, 2022).

VirtaMove's stipulation to not assert additional claims against Google (DD-Brief, 10) also does not tilt Factor 4 in VirtaMove's favor because VirtaMove has not made the same assurances for any of Google's customers, despite the fact that VirtaMove's Complaint alleges induced infringement. EX1080, 7.

Moreover, if Google's IPR is not considered on its merits, at least 26 demonstrably unpatentable claims will remain at large for VirtaMove to assert against others. Denying Google its opportunity to demonstrate to the Board why these claims should be cancelled to prevent further litigation would be a public disservice and contrary to the purposes and charge of the Board. That more than three quarters of the '814 patent's 34 claims will be addressed by the Board but not NDCA further illustrates that an IPR trial will be a "true alternative" to the NDCA litigation in addressing issues the court will not address. *Palo Alto Networks, Inc. v. Centripetal Networks*, IPR2021-01149, Paper 10 at 10-11 (Feb. 22, 2022).

Furthermore, as noted above, the Director recently found that NDCA often issues a stay if an IPR trial is instituted. *Supra* §II.A (citing *Twitch*, IPR2025-00307, Paper 18 at 2-3). That reduces "concerns of inefficiency and the possibility of conflicting decisions" (*Fintiv*, IPR2020-00019, Paper 11 at 12) because the

parties will not expend further resources on any invalidity issue in parallel with this IPR.

And again, even if the litigation is not stayed, an FWD is highly likely to issue before any NDCA trial date. *Supra* §II.B. Once the FWD issues, Google will be estopped from asserting in litigation "any ground that the petitioner raised or reasonably could have raised during" the IPR. 35 U.S.C. §315(e)(2).[6] The statutory estoppel provision ensures that the efficiency of Google's IPR accrues regardless of which party prevails on claims challenged in the IPR and asserted in NDCA, and moots VirtaMove's concern about potential overlap between invalidity arguments in NDCA. That is because if Google prevails the claims will have been found unpatentable, whereas if VirtaMove prevails Google would be estopped from "pursu[ing] the ***same*** invalidity theories" (DD-Brief, 12 (emphasis original)) in NDCA. Given that an FWD will so clearly precede a trial in the district court, it was unnecessary for Google to offer a *Sotera* stipulation because any such stipulation would be moot in view of statutory estoppel. But to remove any doubt,

[6] Google would also be estopped from pursuing a reexamination "with respect to [any challenged] claim on any ground that the petitioner raised or reasonably could have raised during" this IPR. 35 U.S.C. §315(e)(1). That alleviates VirtaMove's protestations about a possible duplicative reexamination. DD-Brief, 12.

Google hereby stipulates that if the Office institutes this IPR, then Google will not pursue in the district-court litigation any grounds that were raised or reasonably could have been raised in this IPR. *See* 35 U.S.C. §315(e)(2); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13 (precedential) (Dec. 1, 2020); *see also Solus Advanced Materials Co., Ltd. v. SK Nexilis Co., Ltd.*, IPR2024-01463, Paper 14 at 16-17 (Apr. 25, 2025) (finding *Sotera* stipulation causes Factor 4 to weigh against denial even where petitioner maintained right to pursue in district court "invalidity assertions based on combinations of art with 'unpublished systems prior art'").

Factor 4 weighs strongly against discretionary denial. VirtaMove's below-addressed arguments to the contrary (DD-Brief, 12) are baseless.

VirtaMove argues "there is substantial overlap between the prior art arguments" in the Petition and those "advanced by Petitioner in the District Court litigation." DD-Brief, 10. This ignores the lack of overlap in the challenged claims. With respect to the prior art, Google was obligated under the district court's standing order to identify ***all possible*** prior art to preserve its defenses months before this Petition was filed. The purpose of disclosing invalidity contentions early in the litigation is to provide notice and preserve a right to make an argument later, not to identify the arguments that will ultimately be presented at

trial, which happens much later.[7] Regardless, VirtaMove's assertion that this causes Factor 4 to favor denial is premised on the assumption that "the District Court will likely decide the validity of the '814 patent claims months prior to" the FWD (DD-Brief, 11), which again is plainly wrong. *See supra* §§II.A-B.

Finally, VirtaMove argues that this IPR should be discretionarily denied because "if the Board were to institute, Petitioner would be able to serially challenge the validity of the '814 Patent in this proceeding, in the District Court Proceeding, and in an *ex parte* reexamination proceeding," which is the "opposite of the efficiency contemplated" by the AIA. DD-Brief, 12. VirtaMove has it exactly wrong—instituting this IPR would ***increase*** efficiency.

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[7] *See, e.g.*, *Pisony v. Commando Constructions, Inc.*, No. 6:17-CV-00055-ADA, 2020 WL 4934463, at *1 (W.D. Tex. Aug. 24, 2020) ("[T]he purpose of invalidity contentions is to provide notice while discovery is intended to develop details so that legal theories become more concrete as the litigation progresses.") (internal quotation marks and citation omitted); *see also GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00070-JRG-RSP, 2020 WL 6731050, at *3 (E.D. Tex. Aug. 14, 2020) ("Indeed, one of the desired outcomes of discovery and a result of expert reports is the crystallization of invalidity and infringement theories preserved in a party's contentions.").

As the Federal Circuit has explained, "the purpose of the AIA" is "to create a ***more efficient*** alternative to district court litigation." *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 86 F.4th 1338, 1344 (Fed. Cir. 2023).[8] Google is availing itself of the IPR process that Congress created to cost-effectively and efficiently demonstrate that the '814 patent's claims are unpatentable. If IPR is instituted, Google will seek a stay of the litigation, which will further help avoid "conflicting decisions." DD-Brief, 12. If the Board finds merit in Google's Petition and finds the challenged claims unpatentable, substantial cost savings and efficiencies will have been achieved for the parties and the NDCA court in not litigating over a patent that never should have issued in the first place. And if any asserted claim were to survive this IPR, Google will be subject to the AIA's estoppel provisions.

The efficiencies that would be gained by instituting IPR here are further enhanced because two defendants in separate litigations (Microsoft and Oracle) have filed motions for joinder. *See Microsoft Corp. v. VirtaMove, Corp.*, IPR2025-00849, Paper 3 (Apr. 18, 2025); *Oracle Corp. v. VirtaMove, Corp.*, IPR2025-00964, Paper 4 (May 16, 2025); *see also infra* §III.B. The Board can efficiently address Google's patentability challenges that Microsoft and Oracle seek to join in a single proceeding.

[8] All emphases herein are added unless otherwise indicated.

Thus, for the reasons discussed above, Factor 4 weighs strongly against discretionary denial.

E. Factor 5 (Litigation Defendant) Weighs Against Discretionary Denial

VirtaMove argues "this factor weighs in favor of discretionary denial." DD-Brief, 12 (citing *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 [sic: 13-14] (May 13, 2020) (informative)).

VirtaMove ignores that the Board's "precedent takes varying approaches on how to weigh the fifth *Fintiv* factor when the parties in the two proceedings are the same." *Shenzen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 20 (Feb. 25, 2025) (granting institution and collecting cases). Some panels have found that the petitioner being the litigation defendant is simply ***neutral*** and does not weigh in favor of denial. *See, e.g.*, *Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30 at 13 (Dec. 3, 2024) (Decision Granting Director Review) ("agree[ing] with the parties that *Fintiv* factor 5 is neutral" where petitioner was a litigation defendant, *see* Paper 1 at 75); *Markforged Inc. v. Continuous Composites Inc.*, IPR2022-00679, Paper 7 at 33 (Oct. 25, 2022)

In fact, in cases such as this where the Board is "likely to address the challenged patent first" before the district court (*see supra* §II.B), panels have found that "this factor weigh[s] ***against*** exercising discretion to deny institution" because it is more efficient to have the Board address patentability so that the

district court does not have to. *Markforged*, IPR2022-00679, Paper 7 at 33; *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11 at 13 (June 15, 2023) ("This factor ***weighs against exercising discretion to deny*** institution because, although the parties are the same as in the related litigation…, that trial is scheduled to occur after the deadline for a final written decision in this proceeding.").

Factor 5 weighs against denial here (or is, at worst, neutral) because the Board is likely to issue an FWD before a district-court trial, which will maximize efficiencies for the parties and the court.

F. Factor 6 (Other Circumstances: Strong Merits)

The merits of Google's Petition are particularly strong because the cited prior art plainly teaches the allegedly "key difference" between the '814 patent and the prior art. EX1001, 1:56-61.

The '814 patent alleges that the "key difference between" the invention and the prior art's "existing solutions" are so-called "application containers." EX1001, 1:56-61. Google's Petition demonstrates that the Blaser reference (EX1005), which is used in every ground, expressly teaches application containers. Petition (Paper 2), 7 (quoting Blaser, 6:62-7:23 ("[a] layer [] provides a convenient ***container*** to limit access to an ***application***")). The Petition also demonstrated that Blaser expressly teaches that applications in layers are not shareable between

different layers and that layers have unique root file systems, which are the features the Examiner found missing in the prior art of record during prosecution of the '814 patent. *See* Petition, 4 (summarizing prosecution history), 41-45 (explaining how Blaser meets elements [1F]-[1G]).

The Petition presents strong merits of unpatentability because the allegedly novel disclosure of the '814 patent, and the limitations the Examiner found missing in the prior art, were explicitly taught by the Petition's prior-art Blaser reference.

The Petition's strong merits are further demonstrated by the fact that Microsoft and Oracle have each agreed to join the Petition. *See* EX1168-EX1169.

VirtaMove says its "merit-based briefing" will "highlight" "claim limitations [that] are not disclosed by ***any*** of the alleged combination references." DD-Brief, 13-14 (original emphasis). Google cannot respond to arguments that VirtaMove has not yet made. But in §IV.A below, which relates to VirtaMove's baseless accusations that the Petition overly relies on expert testimony, Google responds to VirtaMove's allegation that the Petition mischaracterizes teachings in the prior art.

VirtaMove asserts that the Petition's merits are not strong because the Petition "relies solely on obvious combinations under §103," which allegedly "serves to highlight the novelty of the challenged claims." DD-Brief, 13. But the Board has repeatedly found strong merits demonstrated by obviousness grounds. *See, e.g.*, *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 12-13 (Apr.

7, 2025); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00985, Paper 11 at 19-25 (Dec. 12, 2024); *BioNTech SE v. ModernaTX, Inc.*, IPR2023-01359, Paper 20 at 77 (Mar. 19, 2024). Google's obviousness grounds present strong merits because the Petition shows that the allegedly novel feature of the '814 patent is taught by Blaser, which also discloses (or requires only a minor obvious modification to meet) every other limitation of the challenged claims. *See SAP*, IPR2024-01433, Paper 13 at 12-13 (finding the petition "present[ed] particularly strong merits" because its "showing depends on a single reference for nearly every limitation, with a modification to only one aspect of that reference").

Lastly, VirtaMove argues that Factor 6 favors denial because "it [is] extremely likely" that the district court will decide validity before an FWD. DD-Brief, 13. That argument fails for the reasons discussed *supra* §II.B.

Given the Petition's strong merits, Factor 6 weighs against denial.

III. GOOGLE'S PARALLEL PETITION AND AMAZON'S INDEPENDENT PETITIONS DO NOT SUPPORT DISCRETIONARY DENIAL

VirtaMove argues that if any of Google's or Amazon's IPR petitions on the '814 patent "are instituted, they should be limited to, at most, one institution." DD-Brief, 19. For the reasons discussed below, neither Google's second-ranked '814 Petition (IPR2025-00488) nor Amazon's '814 petitions (IPR2025-00563, IPR2023-00566) support discretionarily denying this Petition.

A. Google's Second-Ranked '814 Petition Provides No Basis to Discretionarily Deny This Petition, Which Google Ranked First

The Consolidated Trial Practice Guide (at 59) recognizes that "more than one petition may be necessary" "when there is a dispute about priority date requiring arguments under multiple prior art references." VirtaMove acknowledges that there is a potential dispute about the '814 patent's priority date. *See* IPR2025-00488, Paper 8 at 17-18. Because this Petition (IPR2025-00487) is ranked first (*see* Paper 3, 1) and VirtaMove does not object to the order of Google's ranking of its petitions, Google's second-ranked petition provides no basis to discretionarily deny this first-ranked Petition. *See Samsung Elecs. Co. v. Hardin*, IPR2022-01333, Paper 13 at 50-51 (Feb. 7, 2023) ("declin[ing] to exercise" discretion "to deny institution" of the first-ranked of several parallel petitions because "[p]atent [o]wner does not object to the order in which [the p]etitioner ranks the petitions for consideration on the merits"); *Hanwha Solutions Corp. v. Rec Solar Pte. Ltd.*, IPR2021-00988, Paper 12 at 10-11 (Dec. 13, 2021) (finding that "even if [p]atent [o]wner's argument" objecting to "multiple petitions were persuasive, [p]atent [o]wner's position would not provide a basis for denying institution of the single [p]etition, ranked first in priority").

B. Amazon's Independently-Filed Petitions Do Not Weigh Against Institution of Google's Petitions

Under the Board's precedential *General Plastic* decision, the principal factor in deciding whether to deny institution of an IPR based on another IPR having challenged the same patent is "whether the ***same petitioner*** previously filed a petition directed to the same claims of the patent." *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-16 (Sept. 6, 2017) (precedential). The "same petitioner" was extended to include a petitioner having "a significant relationship" with an earlier petitioner in *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9-10 (Apr. 2, 2019) (precedential); *Videndum Prod. v. Rotolight*, IPR2023-01218, Paper 12 at 6 (Apr. 19, 2024) (Decision Granting Director Review) ("Under USPTO policy and precedent, *General Plastic* has not been extended to any cases in which the first and second petitioners do not have a significant relationship.").

Google and Amazon are different entities and do not have a significant relationship under *Valve*. VirtaMove presents no evidence of such a relationship because no such relationship exists. Google had no involvement in preparing

Amazon's IPRs, and vice versa.[9] *See Ford Motor Co. v. Neo Wireless, LLC*, IPR2023-00763, Paper 28 at 9 (Mar. 22, 2024) (holding that petitioners with "different allegedly infringing products and in different district court proceedings" who did not coordinate, as here, did not have a "significant relationship" under *Valve*).

In cases like this, where separate petitioners have challenged the same patent but "are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* ***factor one necessarily outweighs the other General Plastics factors***" and weighs strongly against discretionary denial. *Videndum*, IPR2023-01218, Paper 12 at 5-6.

VirtaMove alleges that discretionary denial of at least three of the four '814 Petitions brought by Google and Amazon is warranted because "there appears to be a coordinated attempt by [these] technology giants" to challenge VirtaMove's '814 patent. DD-Brief, 18-19. VirtaMove does not even attempt to substantiate this baseless and irresponsible allegation of coordination. That Google and

[9] Google's and Amazon's '814 Petitions raise different grounds. *See Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00563, -00566, Paper 1 at 9 (Jan. 31, 2025) (both challenging claims based on Osman, Tucker, Bandhole, and Gélinas, none of which are named in any ground of Google's '814 Petitions).

Amazon filed separate petitions against the '814 patent around the same time is an unremarkable and highly predictable consequence of ***VirtaMove's strategic decision*** to sue Google and Amazon within one week of each other. Amazon and Google did not coordinate their IPRs in any way. VirtaMove's speculation to the contrary is baseless and simply wrong.

VirtaMove's protestation that it is a "relatively small" company being "overwhelm[ed]" by litigation expenses (DD-Brief, 18-19) is belied by VirtaMove's own strategic decision to assert its patents against six corporations in parallel across two districts. Within the span of two weeks last year, VirtaMove elected to sue four companies—Amazon, Google, IBM, and Hewlett Packard Enterprise—in two different jurisdictions (EDTX and WDTX), on two patents in different patent families. Several months later, VirtaMove elected to bring lawsuits in WDTX against two additional defendants—Microsoft and Oracle. Thus, in less than a year, VirtaMove chose to file ***six*** lawsuits in ***two*** separate districts against different companies, with the full knowledge that multiple IPR petitions by those separate defendants were not just possible but also easily foreseeable.[10]

[10] At the time of filing its suits against Microsoft and Oracle, the '814 patent was also involved in a declaratory-judgment suit brought by Red Hat in NDCA, which

But even if the expenses of the party that chose to initiate litigation could be a relevant consideration for discretionary denial, IPRs were specifically designed to be ***more efficient and streamlined*** than district-court actions, as VirtaMove itself concedes. DD-Brief, 5. Two additional defendants (Microsoft and Oracle) have sought to join Google's IPRs. *See supra* §II.D. Thus, if the Board grants either (or both) of those joinder motions, the overall efficiencies to be gained by (and potential litigation expenses to be saved because of) Google's IPRs will be more even pronounced here as compared to a typical one-defendant IPR. *See* EX1168, at 6-7 (joinder motion) (Oracle's joinder motion "accepting an 'understudy' role") (citing IPR2015-01353, Paper 11 at 6-7 (finding "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" because the petitioners agreed to an "understudy" role)); EX1169, at 5 (Microsoft's joinder motion agreeing to "tak[ing] an 'understudy' role").

Thus, to the extent VirtaMove's alleged concern for reducing its litigation expenses are at all relevant to the Director's consideration, the cost-saving benefit

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was recently dismissed for lack of subject matter jurisdiction and is on appeal. *See Red Hat Inc. v. VirtaMove, Corp.*, 5-24-cv-04740 (N.D. Cal.).

over district-court actions is ***multiplied*** here where two additional defendants can be joined with Google's IPRs.

VirtaMove's suggestion that it was entitled to sue six companies across multiple jurisdictions but that "at most" only one IPR should be instituted (DD-Brief, 19) is plainly unreasonable. Google would be prejudiced if the Director were to discretionarily deny Google's Petition simply because Amazon filed its own. Google did not choose the prior art in Amazon's '814 petitions and has no control over how (or even whether) that IPR will proceed. Amazon's IPR petition is no substitute for Google being able to present its own challenge to the '814 patent.[11] Moreover, Google's and Amazon's petitions were filed at essentially the same time. There is no basis to favor Amazon's petition over Google's.

Under the Board's existing precedent (*General Plastic*, *Valve*, and *Videndum*) discussed above, Amazon's '814 petitions provide no basis for discretionarily denying this Petition. *See also* Interim Memo, 2 (interim

[11] At this point, it is unclear whether either of Amazon's '814 petitions will be instituted on its merits. VirtaMove's "one institution" argument provides no basis for denying Google's '814 Petition because it might be the only petition filed against the '814 patent that the Board finds meritorious enough to warrant institution.

procedures are designed to be "consistent with the discretionary considerations enumerated in existing Board precedent").

IV. NONE OF THE OTHER CONSIDERATIONS LISTED IN THE DIRECTOR'S INTERIM MEMORANDUM SUPPORT DISCRETIONARY DENIAL

The Director's Interim Memorandum has a list of other considerations that may be relevant for discretionary denial.[12] Interim Memo, 2-3. None of these considerations warrants discretionary denial here.

A. The Petition Does Not Over-Rely on Expert Testimony

Recognizing the weakness of its *Fintiv*-based arguments, VirtaMove leads its brief by arguing that discretionary denial is warranted "irrespective of any other factors" because of "Google's extraordinary over-reliance on expert testimony." DD-Brief, 3-5. Neither the Director nor the Board has ever discretionarily denied a petition on this basis. VirtaMove hopes that this case will be the first. It should not be for numerous reasons discussed below.

[12] Petitioner reserves the right to challenge the Interim Process for PTAB Workload Management announced in the Director's March 26, 2025 memorandum at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

This Petition was filed before the Director's Interim Memo issued and is supported by an expert declaration that is similar to, and relied upon in the same way, as numerous prior expert declarations that have been credited by the Board in instituting IPR trials and finding claims unpatentable at FWD. *See infra* §§IV.A.1-2. There is nothing "extraordinary" about the Petition's reliance on Dr. Bhattacharjee's testimony. DD-brief, 3. The Petition demonstrates unpatentability based on patents and printed publications. The Petition does not in any sense ***over***-rely on expert testimony, let alone do so in a manner that would warrant discretionary denial of this Petition despite its strong merits and the fact that the *Fintiv* factors (*supra* §II) weigh strongly against denial.

1. The Petition does not inappropriately rely on Dr. Bhattacharjee's testimony

The prior art's teachings themselves clearly meet the claims. Most of the Petition's citations to Dr. Bhattacharjee's declaration simply confirm that Dr. Bhattacharjee agrees with the Petition's analysis of the prior-art teachings. That is different from the Petition ***over-relying*** on expert testimony to make its unpatentability showing. If there are any issues on which the Board might find it helpful to review expert testimony to "provide helpful context or to explain terms of art," Dr. Bhattacharjee's testimony corroborates everything he says with citation to a prior-art patent or printed publication. *See* USPTO's "FAQs for Interim Processes for PTAB Workload Management" ("Interim-Processes FAQs"), FAQ

#21.[13] While VirtaMove ***criticizes*** the corroborating references (pejoratively labelling them as "shadow references," DD-Brief, 2), Board decisions have "***applauded***" similar expert testimony that is corroborated by extensive citation to published references. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (May 19, 2025); *see infra* §§IV.A.2-3.

2. VirtaMove does not substantiate any alleged inappropriate reliance on Dr. Bhattacharjee's testimony

In its allegations of extensive reliance on expert testimony, VirtaMove mainly criticizes the ***length*** of Dr. Bhattacharjee's declaration and the ***number*** of corroborating references. DD-Brief, 3-5, 15-17. As discussed below, both criticisms fail.

As to the declaration's length, VirtaMove alleges that the Petition's submission of a "***271-page*** declaration spanning ***more than 55,000 words***" is "exactly the type of over-reliance on expert testimony that the Director has indicated is ill-suited for resolution at the PTAB, because the Board should base its decision on patents and printed publications, not the written opinions of an expert who will not even testify at the hearing." DD-Brief, 3 (emphasis original). VirtaMove cites no authority to support this assertion.

[13] https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (last checked June 9, 2025).

VirtaMove acknowledges that a concern about overreliance on expert testimony is implicated if a petition relies on expert testimony ***in place of*** patents or printed publications. *Id*. ("***because the Board should base its decision on patents and printed publications***, not the written opinions of an expert");[14] *see also* Interim Processes FAQs (FAQ #21: "The statute and our reviewing court require that petitions be based on prior art patents and printed publications."). But the length of the expert declaration has no bearing on whether the Petition relies on expert testimony instead of patents or printed publications. VirtaMove's focus on length exalts form over substance. VirtaMove does not identify a single issue on which the Petition's arguments would require the Board to "base its decision on" on "the written opinions of an expert" instead of the teachings of the prior art that both the Petition and the expert discuss. DD-Brief, 3. That is because there is no such issue. *See infra* §IV.A.3.

The length of Dr. Bhattacharjee's declaration results primarily from the fact that most substantive paragraphs of the Petition cite Dr. Bhattacharjee's testimony.

[14] VirtaMove's assertion that Dr. Bhattacharjee "will not even testify at the hearing" is plainly wrong. DD-Brief, 3 His sworn declaration is "testimony" and VirtaMove will have the opportunity to cross-examine him and submit that testimony as well. 37 C.F.R. §42.53.

That is because, at least before the recent guidance in the Director's Interim Memo dated after this Petition was filed, it had been common practice for petitioners to cite expert testimony to support every argument—even those that the petitioner did not expect the patent owner to reasonably dispute. It has been common for petitioners to do so because they could not anticipate what issue(s) a patent owner might dispute with expert testimony, and it was not uncommon for the Board to favor a party who submitted expert testimony on a disputed issue over one that relied simply on attorney argument. *See, e.g.*, *Wasica Finance GmbH v. Continental Auto Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017) (finding it "reasonable for the Board to accept" one party's "expert testimony over" the other party's "bare attorney argument"). There is nothing "extraordinary" about the Petition being accompanied by a lengthy expert declaration. DD-Brief, 3. It is consistent with common practice since the AIA created IPRs.

The Director's Interim Memo refers to the extent to which the Petition ***relies on*** expert testimony, not the declaration's length. The length of Dr. Bhattacharjee's declaration does not matter because the declaration does nothing but provide "appropriate supporting technical details and/or testimony as to the understanding of a" person of ordinary skill in the art without "offer[ing] wholly new arguments not found in the Petition." *Nat'l Beef Packing Co., LLC v. Inst. For Envtl. Health, Inc.*, IPR2024-00186, Paper 8 at 50-51 (Jan. 13, 2025) (rejecting

patent owner's complaints about a 317-page expert declaration); *see also B/E Aerospace, Inc. v. Mag Aerospace Indus., LLC*, IPR2014-01510, Paper 24 at 13-14 (Mar. 26, 2015) ("[T]he length of the Declaration relative to the Petition is not the critical inquiry. The critical inquiry is whether an argument that is made in the Declaration is explained sufficiently in the Petition.").

VirtaMove's assertion that it cannot "practically respond" to every word in the expert declaration in a 14,000 word patent owner response is a red herring. DD-Brief, 4. VirtaMove need only respond to the arguments in the Petition, because the Petition cannot (and did not) incorporate by reference any argument from the expert declaration. 37 C.F.R. §42.6(a)(3); *see also B/E Aerospace*, IPR2014-01510, Paper 24 at 14 ("In our analysis of the grounds of unpatentability that follows, we address the declaration evidence commensurate in scope with the presentation and discussion of that evidence in the Petition.").

Just last month, the Director declined to discretionarily deny two related IPRs despite the patent owner arguing that the petition extensively relied on expert testimony because the petition "cite[d] its expert's ***269-page declaration at least 260 times***." *Twitch*, IPR2025-00307, Paper 11 at 18-19 (patent owner's request for discretionary denial); *id.*, Paper 18 at 3 (May 16, 2025) (decision denying request). That declaration's 269 pages was a comparable length to Dr. Bhattacharjee's declaration here, and the Director did not discuss the declaration's length as

relevant to her discretionary-denial consideration. That decision is consistent with prior decisions instituting an IPR despite a patent owner's complaint about a declaration's length. *See also Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00419, Paper 9 at 24 (Sept. 4, 2024) (instituting despite "[p]atent [o]wner complain[t]s about" "a 349-page declaration"); *Canon USA, Inc. v. Slingshot Printing LLC*, IPR2022-01541, Paper 7 at 21 (May. 22, 2023) (instituting where petitioner submitted a "232 pages long" declaration); *SNF SA v. Chevron USA Inc.*, IPR2022-01534, Paper 12 at 21 n.15 (Apr. 19, 2023) (instituting where petitioner submitted a "290 page[]" declaration).

There is no reason to treat this Petition differently.

VirtaMove's other primary complaint is that the Petition and Dr. Bhattacharjee cite a substantial number of corroborating references. DD-Brief, 15-16 (referring to them derisively as "dozens upon dozens of additional 'shadow' references"). But once again, VirtaMove does not identify a single instance where the Petition relies only on Dr. Bhattacharjee's testimony to fill an alleged gap in the prior art's teachings, because no such examples exist. *See supra* §II.F (discussing the Petition's strong merits); *infra* §IV.A.3 (discussing VirtaMove's single example of the Petition allegedly mischaracterizing the prior art).

Citation to corroborating references does not demonstrate overreliance on Dr. Bhattacharjee's testimony—it demonstrates precisely the opposite. The

substantial number of corroborating references reveals that the Petition relies on "prior art patents and printed publications" to make its case, rather than on Dr. Bhattacharjee's testimony. *See* Interim Processes FAQs (FAQ #21). The Board thus can decide any disputed issues of material fact from the corroborating references themselves, without relying on Dr. Bhattacharjee's testimony.

The Board's rules are clear that an expert must "disclose the underlying facts or data upon which the opinion is based" or the testimony may be given "little or no weight." 37 C.F.R. §42.65(a). That is all Dr. Bhattacharjee did here. Dr. Bhattacharjee's opinions are supported by multiple pieces of corroborating evidence. That does not render his testimony unfocused. It strengthens his testimony because he provides the underlying facts and data on which he based his opinions.

The Board recently instituted a petition and rejected discretionary-denial arguments by a patent owner that were nearly identical to VirtaMove's arguments here that criticize the length of the expert declaration and the number of corroborating references cited. *Tesla*, IPR2025-00032, Paper 11 at 39. In *Tesla*, the patent owner (much like VirtaMove here) complained about an expert declaration that was "twice as long as the Petition at 278 pages with a substantive portion containing 42,329 words." *Id.* at 39 (internal quotation marks omitted). Like VirtaMove here, the patent owner in *Tesla* also complained that it was unfair

to have "to wade through the 42,329 words" in the expert declaration to understand the petition's argument and complained that the expert "cit[ed] forty-three references that are not expressly identified as a basis for that challenge" (what VirtaMove calls "shadow" references, DD-Brief, 15). The Board rejected those complaints because it did not find any improper incorporation by reference of arguments from the declaration into the petition, which is equally true here. Indeed, ***the Board "applaud[ed]" the expert*** for "support[ing] his extensive explanations of his opinions with citations to dozens of pieces of objective evidence," which "is a feature, not a bug of his testimony" ***because the expert "le[ft] virtually none of the substance of his testimony unsupported by objective evidence***." *Tesla*, IPR2025-00032, Paper 11 at 39. There is no reason to treat this Petition differently than the Board treated the *Tesla* petition.

3. VirtaMove's single example fails to show extensive reliance on expert testimony rather than on the prior art

As explained below, despite using far fewer than the 14,000 words allowed, VirtaMove's Request for discretionary denial identified no claim limitation that the Petition meets via expert testimony alone, rather than via the teachings of a patent or printed publication. VirtaMove also failed to identify any issue on which there could be a reasonable dispute between experts, let alone one that the Board could not resolve as well as an Article III court.

VirtaMove provides "one specific example" that purports to establish that the Petition is "weak and overly reliant on unreliable expert testimony to gap-fill holes in the prior art." DD-Brief, 15-16. VirtaMove's argument is based on the assertion that "the Petition mischaracterizes the prior art" Blaser reference. *Id*. The Petition does no such thing. Indeed, it is VirtaMove that mischaracterizes both the prior art and the Petition's reliance on expert testimony.

The '814 patent's claim 1 requires "a system having a plurality of servers with operating systems that differ" and containers of applications that "include an object executable by at least some of [the system's] different operating systems." *See* Petition, Claim Listing ([1PREA]-[1PREB]). To meet those limitations, the Petition demonstrates that Blaser explicitly discloses layers of object-including application software that map to the claimed containers and discloses implementing application layers in systems having a plurality of servers with differing operating systems. Petition, 9-15. The Petition also argued in the alternative, with support from multiple pieces of corroborating evidence, that it would have been obvious to implement Blaser's layers to execute on different operating systems for use in a system having servers running different operating systems. Petition, 10-13.

VirtaMove disputes the arguments based on Blaser's teachings and alleges that Blaser "makes clear that the layers are 'provided of an application layering

system under ***a*** [single] 32-bit Microsoft Windows architecture," which, according to VirtaMove, "does not teach that a system would involve ***numerous different*** architectures." DD-Brief, 16 (emphasis & bracketing original). VirtaMove similarly argues that Blaser does not "teach that Blaser's *layers are compatible with* operating systems other than Windows." DD-Brief, 16 (italics original; quotation marks omitted).

Based on these assertions, VirtaMove argues that the Petition extensively relies on Dr. Bhattacharjee's testimony because VirtaMove alleges that Blaser does not expressly disclose that its layers of applications are compatible with various operating systems. DD-Brief, 16-17. VirtaMove is wrong on both counts. Blaser's disclosure is as the Petition explains, and the Petition relies on those disclosures, not merely Dr. Bhattacharjee's testimony.

The Petition explains that Blaser expressly discloses that its layer technique applies to "computing systems" that include "servers" (Blaser (EX1005), 3:16-27; cited in Petition, 14) to provide for "transfer of applications between similar computing systems" (Blaser, 7:12-15; cited in Petition, 14). That is, Blaser discloses using layers to transfer applications between different computers (e.g., servers) in a computer network having multiple servers that are "similar" (not identical) "computing systems" to each other. Blaser, 7:12-15, 6:62-7:23, 8:48-9:4 (cited in Petition, 14). The Petition also demonstrated that Blaser expressly

discloses that its "[e]xample systems" include different versions of "a 32-bit Microsoft Windows architecture, such as Windows 95, 98, NT, 2000, and XP," which are different operating systems based on the patentee's own remarks during prosecution. Blaser, 13:43-57 (cited in Petition, 14); EX1002, 300-301 (cited in Petition, 11-12). Blaser also discloses that its "inventions may be applied to…computing systems" with "Windows™ operating systems" and with "operating systems other than Windows." Blaser, 3:15-36 (cited in Petition, 9-10). Thus, the Petition relies on Blaser's explicit disclosure as teaching those of skill in the art that its layers are compatible with multiple, different operating systems.

As demonstrated above, for both arguments that VirtaMove identifies as allegedly demonstrating extensive reliance on expert testimony, the Petition relies on explicit disclosures in Blaser. The Petition cites Dr. Bhattacharjee "to provide helpful context" for how a person of ordinary skill in the art would understand Blaser's disclosures, consistent with the Office's guidance. *See* Interim Processes FAQs (FAQ #21). For example, Dr. Bhattacharjee explains that Blaser's disclosure of different versions of Windows-based operating systems, like "Windows 95 and Windows 98 would be different OSs" by the "same reasoning" argued during prosecution of the '814 patent where the applicants argued that "Unix-based OSs" like "'Solaris 8' and Solaris 10'" "are OSs that differ." EX1003, ¶[0077] (cited in Petition, 10). Dr. Bhattacharjee further explained that

skilled persons knew (as part of their background knowledge in the art) that applications native to one Windows OS (e.g., Blaser's Windows 95) were often compatible with other Windows OSs (e.g., Blaser's Windows 98), and Dr. Bhattacharjee corroborated this explanation by citing three references demonstrating that knowledge in the art. EX1003, ¶¶[0077]-[0082] (citing EX1017, EX1128, EX1050) (cited in Petition, 12).

VirtaMove also ignores the Petition's alternative obviousness argument that a skilled person would have been "motivate[d to] us[e] Blaser's layers in a system having multiple servers running different OSs" and to make each layer "executable on more than one different OS." Petition, 9-13. VirtaMove does not allege that those arguments are over-reliant on Dr. Bhattacharjee's testimony. With good reason, because the Petition established this motivation to combine by citation to explicit disclosures in Blaser and multiple pieces of independent, corroborating evidence. Petition, 9-11 (citing, quoting, and explaining, *e.g.*, Blaser, 13:1-15, 13:29-41; EX1058, 1:14-21; EX1049, 1:41-58; EX1020, [0004]-[0005]; EX1051, 2:35-37). The Petition explained that the Calder reference—used in combination with Blaser—explicitly discloses techniques for making applications compatible with "non-native platforms" (i.e., making an application compatible with operating systems that are different from the operating system the application was originally intended for). Calder (EX1006), [0101] (cited in Petition, 12). The Petition's

obviousness arguments rely on the plain teachings of Calder (and other corroborating references), not just Dr. Bhattacharjee's testimony, to demonstrate unpatentability.

To the extent VirtaMove's characterization of the corroborating references (e.g., EX1017, EX1128, EX1050) as "shadow references" is intended to criticize them for not being "enumerated" in the Petition's "combination[s]" (DD-Brief, 15, 17), that argument fails because "[t]here is nothing improper with using additional references as corroboration." *PLR Worldwide Sales Ltd., v. Flip Phone Games, Inc.*, IPR2024-00209, Paper 28 at 24 (Apr. 24, 2025) (finding a petition properly relied on evidence providing "corroboration of" the expert's "testimony as to how a person having ordinary skill in the art would have understood the teachings of" a reference in the prior-art combination) (citing *IXI IP, LLC v. Samsung Elec. Co.*, 903 F.3d 1257, 1262-63 (Fed. Cir. 2018)); *PLR*, IPR2024-00209, Paper 28 at 31 (explaining that "corroboration evidence" does not have to be "part of the ground[s]" and "there is no reason to identify it as such"); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) ("Art can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.").

As discussed above (§§IV.A.1-2), the Petition's extensive citation to corroborating evidence demonstrates the exact opposite of over-reliance on expert testimony.

B. No Other Forum Has Already Adjudicated the Validity or Patentability of the Challenged Patent Claims, Which Weighs Against Discretionary Denial

Neither the PTAB nor any other forum has adjudicated the validity or patentability of the challenged patent claims. *See* Interim Memo, 2. Thus, this consideration weighs against discretionary denial.

C. No Settled Expectation of the Parties Supports Discretionary Denial

The Director's Interim Memorandum says that an additional consideration is the "[s]ettled expectations of the ***parties***" (i.e., the settled expectations of the patent owner ***and*** petitioner). Interim Memo, 2. There were no settled expectations of the parties about the '814 patent that would warrant discretionary denial.

The '814 patent issued in 2009. VirtaMove did not sue Google until 15 years later. VirtaMove's complaint does not allege that VirtaMove ever called the '814 patent to Google's attention prior to suing Google.[15] After being sued, Google filed this Petition because the '814 patent's claims are demonstrably unpatentable. The very "purpose and design" of IPRs—to "weed out bad patent

[15] Around the same time VirtaMove also sued Amazon, IBM, and HPE.

claims"—would be fulfilled by the Board addressing the (strong) merits of the Petition, which demonstrates that VirtaMove's '814 patent should never have issued in the first place. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) ("By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently").

VirtaMove alleges that it had a "settled expectation[]" that it could "adjudicate its patent claims [only] before an Article III court" because the patent issued nearly fifteen years ago at a time before IPRs were available. DD-Brief, 17-18. VirtaMove has known for thirteen of those fifteen years (since 2012) that its patent was subject to IPR, and certainly knew that before it filed suit against Google and others. Any "expectation" VirtaMove allegedly had that the '814 patent was immune from IPR was baseless, unreasonable, and cannot warrant discretionary denial.

That the '814 patent has gone unchallenged for fifteen years also does not demonstrate that VirtaMove had a reasonable, settled expectation of patentability of the challenged claims. It is unsurprising that the '814 patent went unchallenged because it was never asserted before 2024. Once VirtaMove asserted its patent, multiple independent parties challenged its patentability on a multitude of independent grounds. *Google LLC v. VirtaMove, Corp.*, IPR2025-00488 (Jan. 31,

2025); *Amazon.com, Inc. v. VirtaMove, Corp*., IPR2025-00563, -00566 (Jan. 31, 2025); *IBM Corp. v. VirtaMove, Corp.*, IPR2025-00599 (Feb. 7, 2025). There was never any settled expectation of patentability of the '814 patent's claims that would warrant discretionary denial.

Instead, the public interest is best served by the Director not rewarding VirtaMove for having waited until nearly the end of its patent's life to file suit against Google (and others) by insulating VirtaMove from having to defend the patentability of its claims in this IPR on the merits. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 263 (2016) ("The purpose of inter partes review" includes "protect[ing] the public's paramount interest in seeing that patent monopolies are kept within their legitimate scope.") (internal quotation marks and citation omitted).

D. Compelling Economic Interests Weigh Against Discretionary Denial

There are compelling economic interests in instituting this IPR, which weigh against discretionary denial. Interim Memo, 2. VirtaMove is asserting the '814 patent against several companies: Google, Amazon, HPE, IBM, Microsoft, and Oracle. EX1080, 2; Paper 2, xvii. Thus, there are compelling reasons to have the Board efficiently assess the patentability of the asserted claims. Conversely, there stand to be substantial negative economic consequences if VirtaMove's unpatentable claims remain in force and continue to be asserted in more expensive

and time-consuming litigations. These considerations weigh against discretionary denial.

V. CONCLUSION: A HOLISTIC ASSESSMENT OF ALL DISCRETIONARY FACTORS WEIGHS STRONGLY AGAINST DENIAL

It is highly likely that an FWD will issue well before a district-court trial, which weighs heavily against discretionary denial under *Fintiv*. *See supra* §II.B.

VirtaMove's other primary assertion is that the length of the Petition's expert declaration "justifies denial of institution, irrespective of any other factors." DD-Brief, 3-5. That assertion is unsupported by any authority and has been repeatedly rejected by the Director and the Board. *See supra* §IV.A; *see, e.g.*, *Twitch*, IPR2025-00307, Paper 18 at 3.

The Interim Memo's other additional considerations are considered under a "holistic assessment of all of the evidence and arguments presented" in determining whether to "exercise discretion to deny institution." *Twitch*, IPR2025-00307, Paper 18 at 3; *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (May 16, 2025). No other consideration warrants discretionary denial, as discussed above (§§IV.B-D).

Discretionary denial under §314 is not warranted.[16]

Respectfully submitted,

Date: June 10, 2025

/Elisabeth Hunt/
Elisabeth Hunt, Reg. No. 67,336
WOLF, GREENFIELD & SACKS, P.C.

[16] As the Petition established and VirtaMove does not dispute, the prior-art references combined in the Petition's Grounds were not previously presented to the Office. Petition, 78. Thus, there is also no basis to deny the Petition under §325(d), and VirtaMove does not allege otherwise.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24, the undersigned certifies that the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** contains 10,456 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: June 10, 2025

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6(E)(4)

I certify that on June 10, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Reza Mirzaie	rmirzaie@raklaw.com
	rak_almondnet@raklaw.com
Marc A. Fenster	mfenster@raklaw.com
Neil Rubin	nrubin@raklaw.com
James A. Milkey	jmilkey@raklaw.com
Qi (Peter) Tong	ptong@raklaw.com
	rak_virtamove@raklaw.com

Date: June 10, 2025

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.