

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOCKER, INC.,

Petitioners,

v.

INTELLECTUAL VENTURES II LLC,

Patent Owner.

Case No. IPR2025-00840

U.S. Patent No. 8,332,844

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PATENT OWNER’S EXHIBIT LIST

Ex. 2001	Petition in IPR2025-00931 filed by American Airlines and Southwest Airlines
Ex. 2002	Reexamination No. 90/019,938 filed by Unified Patents
Ex. 2003	Invalidity Contentions of American Airlines in District Court
Ex. 2004	S. Munoz, “ <i>The History of Docker’s Climb In The Container Management Market</i> ,” published on TechTarget.com, June 25, 2019
Ex. 2005	J. Kronchmaiski, <i>Developing with Docker</i> , published November, 2016 by Packet Publishing.
Ex. 2006	A. Shaw, “Docker, Container Images and Standards,” published on Medium.com, August 1, 2016
Ex. 2007	Posting on Docker.com by Docket CEO Scott Johnston dated February 1, 2022
Ex. 2008	Order Granting Reexamination Request in case no. 90/019,938 filed by Unified Patents
Ex. 2009	Defendant Southwest Airlines Co.’s Preliminary Invalidity Contentions in <i>Intellectual Ventures I LLC et al. v. Southwest Airlines, Co.</i> , 7:24-cv-277 (WDTX)
Ex. 2010	Declaration of Erez Zadok in IPR2025-00931
Ex. 2011	Abstract of Title of ‘844 Patent
Ex. 2012	Evidence of Use of Docker By American Airlines

I. INTRODUCTION

The Director should exercise discretion and deny institution because Petitioner Docker, Inc. (“Docker”), together with American Airlines, Southwest Airlines and Unified Patents, are engaging in a campaign to harass the patent owner with multiple coordinated challenges to U.S. Patent No. 8,332,844 (the ‘844 Patent). On April 30, 2025, American Airlines and Southwest Airlines filed IPR2025-00931 (Ex. 2001) challenging the ‘844 Patent. On the same day, Unified Patents filed a reexamination request (Ex. 2002) challenging the ‘844 Patent based on grounds identical to those set forth in IPR2025-00931. The next day (May 1, 2025), Docker filed the present IPR, advancing grounds that are virtually identical to grounds being advanced by American Airlines in the district court. Ex. 2003, 188-213. All three of these post-grant challenges rely on testimony from the same expert -- Erez Zadok. Entertaining duplicative and coordinated challenges to the same patent is not a good use of the Office’s limited resources and is unfair to the Patent Owner. Permitting the Petition to move forward will not conserve resources, but will waste them. These tactics favor discretionary denial of the Petition.

Separate and apart from the inefficiency and unfairness associated with the coordinated attacks on the ‘844 Patent, the settled expectations of the parties also favor discretionary denial. The ‘844 Patent issued in 2012, and was directed to systems that perform image caching in connection with management of distributed

applications. Ex. 1001, Title. The next year, in 2013, Petitioner Docker released its platform, which used “Docker images” for managing distributed applications. Ex. 2004, 2, Ex. 2005, 3-4, Ex. 2006, 1-3. Starting a few years later, Docker began generating (and has continued to this day generating) significant revenues by licensing versions Docker’s platform. Ex. 2004, 4 and Ex. 2007, 1-2. During all of that time, the ‘844 Patent was publicly available and provided notice to Docker which had a strong commercial interest in the technology claimed in the ‘844 Patent. Nonetheless, despite being on notice for over a decade and having a strong commercial interest in the subject matter of the ‘844 Patent, Docker took no steps to challenge the ‘844 Patent during the 12 years that the patent has been in force. Rather, Docker waited until now to launch its challenge. The significant length of time that the ‘844 Patent has been in force evidences strong well-settled expectations of the parties, which favors discretionary denial. *Samsung v. OS-New Horizon Personal Computing*, IPR2025-00613 (PTAB July 17, 2025), Paper #10 (denying institution where “the challenged patent has been in force for more than 12 years, creating strong settled expectations”) (emphasis added).

Finally, the merits of the Petition are objectively weak. For example, the Petition is deficient on its face with respect to the recitation of “a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes,” as recited in claim 1 of the ‘844 Patent. It would be a waste of the

Office's resources to refer this Petition to a panel of three PTAB judges to evaluate on the merits only for them to reach the same conclusion, namely, that the Petition is deficient on its face.

For all of these reasons, and as explained more fully below, the Director should exercise her discretion to deny institution.

II. PETITIONER ALONG WITH AMERICAN AIRLINES, SOUTHWEST AIRLINES AND UNIFIED PATENTS IS ENGAGING IN A CAMPAIGN TO HARASS THE PATENT OWNER WITH MULTIPLE CHALLENGES TO THE '844 PATENT

Petitioner (Docker) is part of a coordinated campaign involving American Airlines, Southwest Airlines and Unified Patents to harass the Patent Owner with multiple and virtually simultaneous post-grant challenges to the '844 Patent. In each post-grant challenge, the grounds being advanced by the challenger are duplicative of grounds being advanced by another challenger before either the Office or in the district courts -- and all of the post-grant challenges are based on the testimony of the same expert (Erez Zadok). By way of overview, the table below sets forth the filing date, challenger, and IPR or reexamination number of each of these challenges, together with a description of the parallel duplicative challenges being advanced before the Office or the district courts.

<u>Filing Date</u>	<u>Challenger(s)</u>	<u>IPR/Reexam Number</u>	<u>Parallel Duplicative Challenge(s)</u>
4/30/25	American Airlines and Southwest Airlines	2025-00931	• Reexam No. 90/019,938 includes identical grounds. • American Airlines is advancing the same grounds in the district court (case no. 4:24-cv-980). • Southwest Airlines is advancing the same grounds in district court (case no. 7:24-cv-277).
4/30/25	Unified Patents	90/015337	• IPR2025-00931 (filed by American Airlines and Southwest Airlines) includes identical grounds. • American Airlines is advancing the same grounds in the district court (case no. 4:24-cv-980). • Southwest Airlines is advancing the same grounds in district court (case no. 7:24-cv-277).
5/1/25	Docker	2025-00840	• American Airlines is advancing virtually identical grounds in the district court (case no. 4:24-cv-980).

The duplicative nature of the challenges identified in the table above are set forth in more detail below. There is substantial circumstantial evidence that these duplicative challenges are being coordinated for the purpose of harassing Patent Owner. In addition to being unfair to Patent Owner, multiple duplicative challenges to the same patents waste the Office's limited resources.

A. The Grounds In IPR2025-00931 Filed By American And Southwest Airlines Are Identical To Those Set Forth In Reexamination No. 90/019,938 Filed By Unified Patents

The Petition in IPR2025-00931 filed by American Airlines and Southwest Airlines (Ex. 2001) and Reexamination Request No. 90/019,938 filed by Unified Patents (Ex. 2002) challenge the exact same claims of the ‘844 Patent (1-27), based on the exact same prior art references and the testimony of the same expert (Erez Zadok) and present identical grounds. On July 22, 2025, the Office issued an Order granting the reexamination request filed by Unified Patents. Ex. 2008. The Order found in pertinent part as follows:

SNQ grounds #1-4 in the current Request are based on the same prior art as presented in ... IPR2025-00931. ... Accordingly, the statutory threshold under 35 USC 325(d) permitting the Director to exercise discretion to reject this request is met.

However, in view of the following facts, the Examiner as delegated by the Director declines to exercise discretion to reject this Request because: ... the other prior IPR petition (IPR2025-00931) in which identical grounds were presented has yet to have a decision on institution issued by the PTAB. Ex. 2008, 17 (emphasis added).

Thus, as the Office has already found, the Petition in IPR2025-00931 filed by American Airlines and Southwest Airlines and Reexamination Request No. 90/019,938 filed by Unified Patents (which was granted) asserts “identical grounds.” Thus, there can be no dispute that these two challenges to the ‘844 Patent are duplicative of each other.

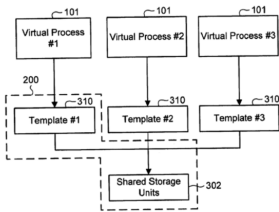
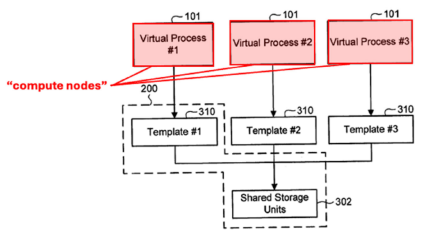
B. In Addition To Being Duplicative Of The Grounds In Reexamination No. 90/019,938, The Grounds In IPR2025-00931 Are Duplicative Of Grounds Set Forth By Both American Airlines And Southwest Airlines In The District Courts

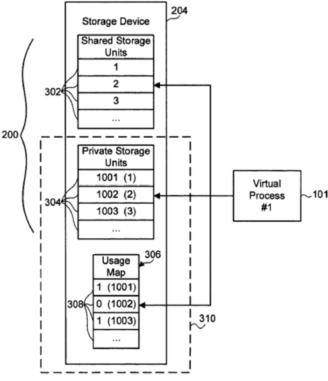
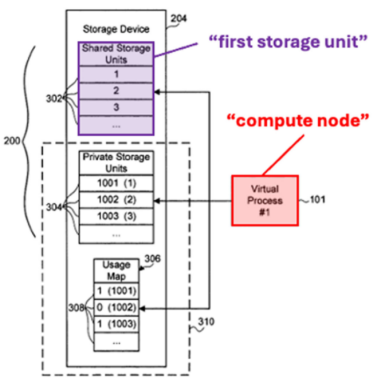
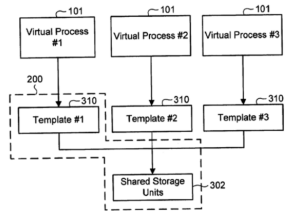
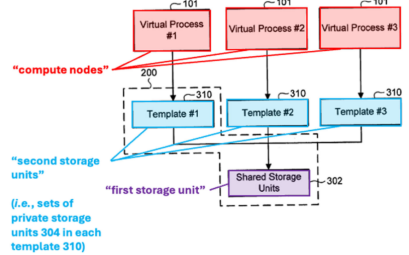
Southwest Airlines and American Airlines are also each advancing grounds challenging the ‘844 Patent that are duplicative of those set forth in IPR2025-00931 and Reexamination No. 90/019,938, in different parallel district court litigations. More specifically, American Airlines has served Invalidity Contentions in parallel district court litigation (case no. 4:24-cv-980) that include all of the grounds set forth in IPR2025-00931 (and Reexamination No. 90/019,938). Ex. 2003, note 10 on page 17 (incorporating “by reference, in full, the Petition and the Exhibits in IPR2025-00931”). Similarly, Southwest Airlines has served Invalidity Contentions in parallel district court litigation (case no. 7:24-cv-277) that include substantially all of the grounds set forth in IPR2025-00931 (and Reexamination No. 90/019,938). Ex. 2009, 80 (identifying Sapuntzakis, Holzmann and Birse as references relied on for invalidity of the ‘844 Patent) and 210-242 (claim charts).

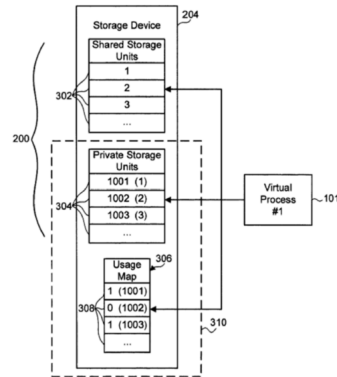
Thus, there can be no dispute that the challenges to the ‘844 Patent set forth in IPR2025-00931 and Reexamination No. 90/019,938 are duplicative of challenges separately advanced by American Airlines and Southwest Airlines in parallel district court actions.

C. The Grounds In The Present Petition Filed By Docker Are Duplicative Of Grounds Advanced By American Airlines In Parallel District Court Litigation

The duplication continues with the present Petition, which is duplicative of grounds advanced by American Airlines in the district court (case no. 7:24-cv-277). Both the Petition and American Airlines in the district court rely on Menage as a primary reference. Set forth below is a table comparing the mappings of Menage to claim 7 of the ‘844 Patent by American Airlines in the district court and the present Petition:

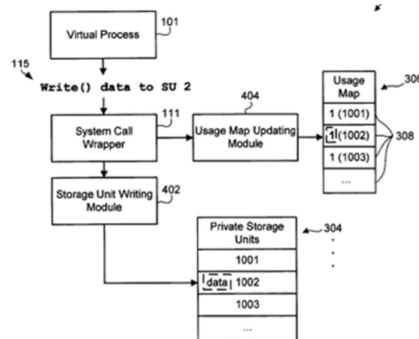
Element of Claim 7	Mapping to Menage by American Airlines (American)	Mapping to Menage in IPR2025-00840
A method for providing data to a plurality of compute nodes, comprising:	American cites to Menage at 3:56-58 and 2:3-6. Ex. 2003, 190. American relies on Figure 7 of Menage:  Ex. 2003, 191.	The Petition cites to Menage at 3:56-58 and 2:3-6. Pet., 17-18 and 33. The Petition relies on Figure 7 of Menage:  Pet., 17-18 and 33.
storing blocks of a root image of said compute nodes on a first storage unit;	American cites to Menage at 8:8-15 and 7:36-40. Ex. 2003, 192. American relies on Figure 3 of Manage:	The Petition cites to Menage at 8:10-15 and 7:33-40. Pet., 20-21 and 34. The Petition relies on Figure 3 of Manage:

	 Ex. 2003, 192.	 Pet., 20 and 34.
storing leaf images for respective compute nodes on respective second storage units, said leaf images including only additional data blocks not previously contained in said root image and changes made by respective compute nodes to the blocks of the root image, wherein said leaf images of respective compute nodes do not include blocks of said root image that are unchanged by respective compute nodes; and	American cites to Menage at 8:15-21, 8:28-24, 8:46-49, 8:58-67, 9:1-9, 9:10-28, 9:29-46, 9:48-53. Ex. 2003, 194-199. American relies on Figure 7 of Menage:  Ex. 2003, 194. American relies on Figure 3 of Menage:	The Petition cites to Menage at 8:15-17, 8:28-34, 8:46-49, 8:58-61, 9:4-7, 9:10-12 and 18-23, 9:30-33 and 35-41, 9:48-52. Pet., 23-27 and 34. The Petition relies on Figure 7 of Menage:  Pet., 22 and 34. The Petition relies on Figure 3 of Menage:



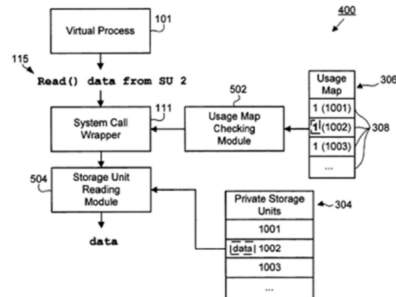
Ex. 2003, 195.

American relies on Figure 4 of Menage:



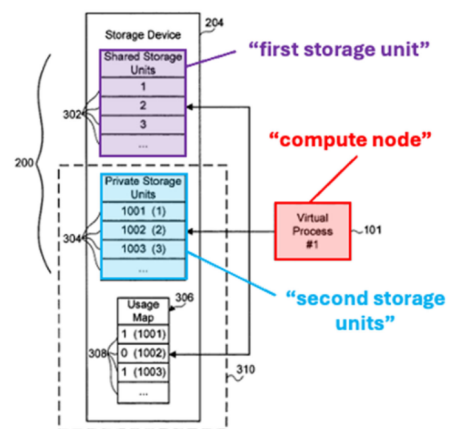
Ex. 2003, 197.

American relies on Figure 5 of Menage:



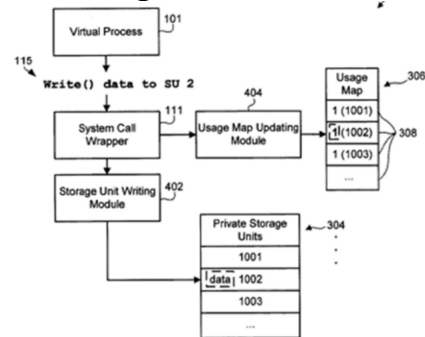
Ex. 2003, 199.

American relies on Figure 6 of Menage:



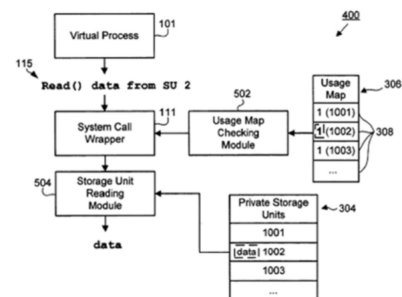
Pet., 22 and 34.

The Petition relies on Figure 4 of Menage:



Pet., 24 and 34.

The Petition relies on Figure 5 of Menage:



Pet., 25 and 34.

The Petition relies on Figure 6 of Menage:

	Ex. 2003, 200.	Pet., 26 and 34.
caching blocks of said root image that have been accessed by at least one of said compute nodes in a cache memory.	American cites to Menage at 9:66-10:6. Ex. 2003, 204.	The Petition cites to Menage at 10:2-6. Pet., 27.

There can be little dispute that the mappings of Menage to the claims of the ‘844 Patent being advanced by American Airlines and the present Petition are duplicative of each other.

D. The Most Reasonable Conclusion Based On The Evidence Is That American Airlines, Southwest Airlines, Unified Patents And Docker Have Coordinated Their Duplicative Post-Grant Challenges

The following evidence indicates that American Airlines, Southwest Airlines, Unified Patents And Docker have coordinated their duplicative post-grant challenges.

First, all three post-grant challenges were filed at virtually the same time. More specifically, IPR2025-00931 and Reexamination No. 90/019,938 were filed the same day (April 30, 2025), and IPR2025-00840 was filed the next day (May 1,

2025). It would be quite a coincidence for all three post-grant challenges to have been filed within a day of each other if the challengers were not working together.

Second, all three challenges rely on testimony from the same expert -- Erez Zadok -- who signed declarations within days of each other. For example, Dr. Zadok executed his declaration in IPR2025-00931 on April 25, 2025 (Ex. 2010, 243) and executed his declaration in this IPR on April 28, 2025. Ex. 1003, 28. Thus, it is clear that the post-grant challenges were prepared in parallel. Using one common expert across all three challenges and preparing the challenges at the same time undoubtedly facilitated more consistent positions across the different challenges.

Third, in each post-grant challenge, the grounds being advanced by the challenger are duplicative of grounds being advanced by another challenger before either the Office or in the district courts. This indicates that the challengers are sharing work product, which is consistent with coordinated efforts.

The most reasonable conclusion based on the totality of the evidence is that American Airlines, Southwest Airlines, Unified Patents and Docker have coordinated their duplicative post-grant challenges to the '844 Patent.

E. The Multiple Challenges Advanced Against The '844 Patent Constitute Harassment Of The Patent Owner And Waste The Resources Of The PTAB

In passing the AIA statute establishing the IPR process, Congress did not intend for IPRs to become vehicles to harass patent owners. One safeguard that

Congress included was the discretionary denial provision of §314(a), which provides the Director with authority to deny Petitions where harassment of the Patent Owner is evident. The present facts represent just such a situation, and therefore warrant discretionary denial. In addition, permitting the Petition to move forward under such circumstances will not conserve resources, but will waste them. On this basis alone, the Director should exercise her discretion and deny the Petition.

F. The Most Reasonable Conclusion From The Evidence Is That American Airlines, Southwest Airlines, Unified Patents And Docker Are Connected By Preexisting Established Relationships Sufficient To Confer Real Party In Interest Status

As the Federal Circuit explained in *Applications In Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1350 (Fed Cir. 2018), one purpose of the “real party in interest” provisions in the AIA was to prevent harassment of patent owners through repeated administrative attacks on the validity of a patent:

Turning to the legislative history, we find nothing that suggests Congress intended for the term “real party in interest” to have a meaning that departs from its common-law origins. Instead, it reveals that Congress intended for it to have an expansive formulation. A 2011 House Report on the AIA explains that, “[i]n utilizing the post-grant review process, petitioners, real parties in interest, and their privies are precluded from improperly mounting multiple challenges to a patent or initiating challenges after filing a civil action challenging the validity a claim in the patent.” H.R. Rep. No. 112-98, at 48 (2011), reprinted in 2011 U.S.C.C.A.N. 67, 78 (emphasis added). In the following paragraph, the report makes clear that Congress “recognizes the importance of quiet title to patent owners to ensure continued investment resources.” *Id.* Thus, “[w]hile this amendment is intended to remove current disincentives to current administrative processes, the

changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent.” *Id.* (emphases added).

The Court also explained that “Congress intended that the term ‘real party in interest’ have its expansive common meaning” and that “determining whether a non-party is a ‘real party in interest’ looks to “whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications In Internet Time*, 897 F.3d 1336, 1351.

The most reasonable conclusion based on the evidence is that one or both of Southwest Airlines and American Airlines: (i) is a member of Unified Patents, (ii) has paid substantial membership fees to Unified Patents which Unified Patents uses to fund post-grant challenges like Reexamination No. 90/019,938 filed by Unified Patents, and (iii) has coordinated with Unified Patents to launch duplicative challenges to the ‘844 Patent. These facts are consistent with there being a preexisting, established relationship between one or both of Southwest Airlines and American Airlines and Unified Patents, where one or both of Southwest Airlines and American Airlines is a clear beneficiary.

The most reasonable conclusion based on the evidence is also that one or both of Southwest Airlines and American Airlines: (i) use Docker’s software and therefore has a vendor relationship with Docker (Ex. 2012, 1-5), and (ii) have coordinated with Docker to launch duplicative challenges to the ‘844 Patent. These

facts are consistent with there being a preexisting, established relationship between one or both of Southwest Airlines and American Airlines and Docker, where Southwest Airlines and American Airlines are clear beneficiaries of Docker's IPR Petition challenging the '844 Patent, and Docker is a clear beneficiary of the IPR Petition filed by Southwest Airlines and American Airlines challenging the '844 Patent.

G. Given The Evidence Of A Commonality Of Real Parties In Interest With Respect To The Multiple Challenges To The '844 Patent, American Airlines, Southwest Airlines, Unified Patents And Docker Should Be Considered As One Collective Entity Under Section II(D)(2) Of The Trial Practice Guide

The Trial Practice Guide sets forth the following procedure with respect to parallel challenges to the same patent:

Parallel Petitions Challenging the Same Patent. Based on the Board's experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. See 35 U.S.C. § 316(b). ...

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it

identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a). Trial Practice Guide, Section II(D)(2).

It is respectfully submitted that the above procedures, which generally limit a petitioner to a single petition ought to apply collectively to the multiple parallel challenges being advanced against the '844 Patent in the Office because of the evidence of a commonality of the real parties in interest amongst the various challenges. Moreover, given that at this point, the Reexamination Request filed by Unified Patents has been granted and is therefore the furthest along, Patent Owner respectfully submits that the multiple parallel challenges being advanced against the '844 Patent should be limited to those reexamination proceedings, and all other challenges to the '844 Patent (including the present petition) should be denied under §314.

III. THE WELL-SETTLED EXPECTATIONS OF THE PARTIES FAVOR DISCRETIONARY DENIAL

Discretionary denial is also warranted because the circumstances surrounding Petitioner's delayed challenge to the '844 Patent, combined with the exceptional length of time that the patent has been in force, strongly support discretionary denial. As detailed below, despite engaging in commercial activity directly related to the subject matter of the '844 Patent for more than a decade, Petitioner waited until now to initiate this IPR. This delay, particularly in light of the widespread and long-standing public availability of the '844 Patent, weighs heavily against institution.

The ‘844 Patent has been in force for over 12 years, a duration that, under the Board’s precedent and the Director’s recent guidance, gives rise to strong settled expectations.

A. Petitioners’ Delay in Challenging the ‘844 Patent Despite Having A Longstanding Commercial Use of Software For Distributed Application Management

The ‘844 Patent issued in 2012, and was directed to systems that perform image caching in connection with the management of distributed applications. Ex. 1001, Title (“Root Image Caching And Indexing For Block-Level Distributed Application Management”). The next year, in 2013, Petitioner Docker released its platform, which used “Docker images” for managing distributed applications. Ex. 2004, 2, Ex. 2005, 3-4, Ex. 2006, 1-3. Later, Docker began generating (and has continued to this day generating) revenues by licensing versions of its platform. Ex. 2004, 4 and Ex. 2007, 1-2.

It is indisputable that Docker has been generating significant revenue by licensing versions of its platform. During all of that time, the ‘844 Patent was publicly available and provided notice to Docker, which had a strong commercial interest in technology described in the ‘844 Patent. Nonetheless, despite being on notice for over a decade and having a strong commercial interest in the subject matter of the ‘844 Patent, Docker took no steps to challenge the ‘844 Patent during the 12 years that the patent has been in force.

In the present case, Docker has had a strong, developed commercial interest in the subject matter of the ‘844 Patent for many years, including generating significant revenues by licensing its software. It would have been prudent for Docker to have taken steps to understand the patent landscape pertinent to its businesses, including patents directed to systems that perform image caching and/or relate to the management of distributed applications. Had Docker conducted even the most basic keyword search for patents pertinent to its business, Docker would most certainly have discovered the ‘844 Patent, which has a title that expressly refers to performing image caching in connection with the management of distributed applications. To the extent that Docker failed to learn of the ‘844 Patent, it could only have been because, for its own business reasons, Docker chose not to investigate the patent landscape relating to its business.

B. The ‘844 Patent Has Been in Force For Over 12 Years, Which Supports a Finding of Strong Settled Expectations

The long period of time that the ‘844 Patent has been in force evidences strong settled expectations. “Although there is no bright-line rule when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Solutions v. AXA Power ApS*, IPR2025-00408 (PTAB June 18, 2025), Paper #21. Moreover, to the extent Docker were to assert that it had no actual notice of the patent, the Board has explained that actual

notice of the patent or of possible infringement is not required to create to settled expectations. For example, in *Dabico*, the Board explained:

... patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. 35 U.S.C. § 122. Interested parties may find published patents and patent applications using the Office’s automated search systems as well as publicly available resources on the Internet. See 35 U.S.C. § 41(i). As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations. (emphasis added).

Consistent with the guidance provided by Director Stewart, the Board has found settled expectations sufficient to deny institution where a patent has been in force for as little as seven years. *Dabico*, IPR2025-00408, Paper #21 (finding that settled expectations favored discretionary denial where the challenged patent had been in force for over seven years); *see also*, *Intel Corp. v. Proxense LLC*, IPR2025-00327 (PTAB June 26, 2025), Paper #12, 2 (denying institution based on settled expectations where the “challenged patents have been in force over nine years”); *Cambridge Industries v. Applied Optoelectronics*, IPR2025-00434 (PTAB June 26, 2025), Paper #11, 3 (denying institution where the challenged patents had been in force for nine and seven years).

Moreover, guidance from Director Stewart goes a step further where the patent has been in force for still longer periods of time, such as 12 years. In such cases, the Director has characterized the extended period of time that the patent has

been in force as “creating strong settled expectations.” *Samsung v. OS-New Horizon Personal Computing*, IPR2025-00613 (PTAB July 17, 2025), Paper #10 (“the challenged patent has been in force for more than 12 years, creating strong settled expectations”); *International Business Machines Corp. v. Virtamove Corp.*, IPR2025-00591 (PTAB July 17, 2025), Paper #8 (“the challenged patents have been in force for over fifteen years, creating strong settled expectations”); *Carvana, LLC v. International Business Machines Corporation*, IPR2025-00564 (PTAB July 10, 2025), Paper #11 (“the challenged patent has been in force for approximately 15 years, creating strong settled expectations”); and *SAP America, Inc. v. Valtrus Innovations, Ltd.*, IPR2025-00414 (PTAB July 10, 2025), Paper #12, 2 (“the challenged patents have been in force for over 17 years, creating strong settled expectations. Under these circumstances, discretionary denial is appropriate”).

These precedents demonstrate that where, as here, the patent has been in force for 12 years, there are strong settled expectations that weigh in favor of denying institution. Simply put, the exceptional length of time during which the ‘844 Patent has been in force strongly favors discretionary denial.¹

¹ For the last 12 years, the ‘844 Patent has been owned by companies owned and controlled by Intellectual Ventures’ Invention Investment Fund II, LLC (IIF II). As set forth in the Abstract of Title, on May 18, 2012, the ‘844 Patent was assigned to Emendable Assets Limited Liability Company, LLC (a company owned/controlled by IIF II). Ex. 2011, Assignment #3. On August 26, 2015, Emendable Assets Limited Liability Company was merged into Xenogenic Development Limited

IV. THE PETITION IS FACIALLY DEFICIENT AND IT WOULD BE A WASTE OF THE OFFICE’S RESOURCES TO HAVE MULTIPLE PTAB JUDGES EVALUATE THE PETITION ON THE MERITS SIMPLY TO REACH THE SAME CONCLUSION

Petitioner bears the burden of demonstrating how each and every limitation of the challenged claims is disclosed or rendered obvious by the cited prior art. That burden is not met here. Two examples where the Petition is deficient are set forth below. Further examples will be set forth in Patent Owner’s Preliminary Response.

A. Ground 1 Is Deficient

Claim 1 of the ‘844 Patent recites “a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes.” The law is clear that the term “configured to” means “programmed to.” See, e.g., *Nevro Corp. v. Boston Scientific Corp.*, 955 F.3d 35, 41 (Fed. Cir. 2020). Thus, the claim language is not met by a generic memory buffer that simply caches any information. Rather, the claim language is that the cache be programmed to store specific information, i.e., “blocks of said root image previously accessed by at least one of said compute nodes.” The ‘844 Patent describes an example of such programming as follows:

... While the first compute node is loading its data, its reads are intercepted and cached on a per-block basis in cache 260. Thereafter,

Liability Company, which was owned/controlled by IIF II. Ex. 2011, Assignment #4. On November 2, 2023, Xenogenic Development Limited Liability Company assigned the patent to Intellectual Ventures II LLC, another company owned/controlled by IIF II. Ex. 2011, Assignment #5.

when a second compute node (e.g., compute node 220b) goes to boot, any data required by 60 the second compute node that was previously accessed by the first compute node can be served out of the cache 260 rather than the first storage unit. Ex. 1001, 6:56-62 (emphasis added).

The Menage reference relied on in Ground 1 of the Petition fails to disclose anything close to such functionality. Absent from Menage is the disclosure of any functionality of a cache that is programmed to store information “previously accessed” by anything. Instead, the Petition maps the claim limitation in question to a generic memory buffer that simply caches any information. More specifically, the Petition purports to map the limitation reciting “a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes” to Menage as follows:

Menage discloses and/or renders this limitation obvious. EX1003, ¶¶320–22.

Menage explains that because “all the virtual processes 101 use the same set of shared storage units 302”—which, as discussed with respect to [1.a], store blocks of a root image of said compute nodes—“the shared storage units 302 may be easily cached for high speed access in the computer memory 102 or in a memory integrated with the storage device 204.” EX1004, 10:2–6. Petition, 27 (emphasis added).

Clearly missing from the relied on disclosure from Menage is any disclosure of a cache that is programmed to store information “previously accessed” by anything. Rather, the Petition relies on Menage’s disclosure of caching all information in shared storage units -- and glosses over the claim requirement that the cached information have been “previously accessed by at least one of said compute nodes.”

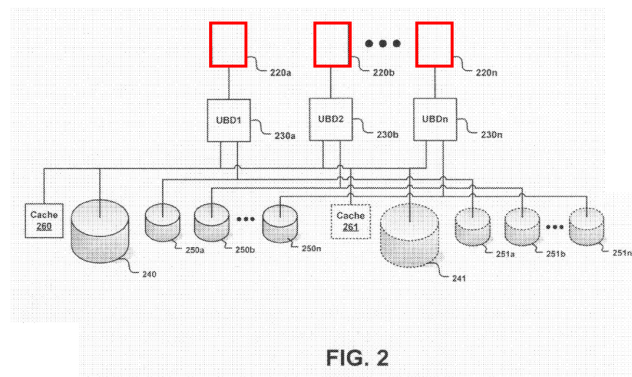
The Petition's analysis essentially treats the claim language as if it read "a cache configured to cache blocks of said root image ~~previously accessed by at least one of said compute nodes~~" -- essentially writing the phrase "previously accessed by at least one of said compute nodes" out of the claim.

After quoting the deficient disclosure from Menage as set forth above, the Petition then makes the conclusory assertion that "it would have been obvious to a POSITA that blocks of the root image stored in the shared storage units 302 would have been cached, as described by Menage, upon read access by one of the virtual processes (i.e., "one of said compute nodes"), in accordance with well-known caching techniques." Petition, 27. Completely missing is any explanation why such caching would occur "upon read access by one of the virtual processes." Thus, the Petition offers nothing more than an unsupported conclusion regarding obviousness, which fails to add up to a reasonable likelihood of prevailing. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (a petitioner cannot satisfy its burden of proving obviousness by employing "mere conclusory statements," but "must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness"). Here, the lack of a "why" is dispositive: a determination of obviousness cannot be reached where the record lacks an explanation why Menage would be modified to perform caching "upon read access by one of the virtual processes." *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066

(Fed. Cir. 2016); *Virtek Vision Int’l ULC, Inc.*, 97 F.4th at 886 (“These disclosures, however, do not provide any reason why a skilled artisan would use 3D coordinates instead of angular directions in a system”).

B. Ground 2 Is Deficient

Claim 14 of the ‘844 Patent recites that “at least one of said compute nodes is configured to index said root image and provide the indexing results to another of said compute nodes.” In purporting to map this claim element to the prior art in Ground 2, the Petition acknowledges that “Menage may not describe ‘indexing’” but argues that the claim element is met by Murphy. Pet., 45-46. As noted above, the term “configured to” means “programmed to.” See, e.g., *Nevro Corp.*, 955 F.3d 35, 41. Thus, claim 14 requires, *inter alia*, that one compute node be programmed to provide indexing results to another compute node. The ‘844 Patent depicts examples of “compute nodes” as nodes 220a-n in Figure 2 (reproduced below with red boxes added by Patent Owner to identify the “compute nodes”):



Ex. 1001, 5:19-21 (identifying “compute nodes” in Figure 2). In the example of Figure 2, “one compute node (e.g., compute node 220a) can index the contents of the root image and then provide the indexing results to the other compute nodes (e.g., compute nodes 220b-n).” *Id.*, 7:28-31.

In Murphy, client computers 202a-202c are coupled to a server 206 which responds to database requests. Ex. 1005, 3:41-51. As best understood, the Petition analogizes Murphy’s client computers 202a-c (red boxes) to the “compute nodes” recited in claim 14. Significantly, the Petition fails to allege (let alone explain) that Murphy’s server 206 (blue box), which Murphy describes as responding to database requests corresponds, to a “compute node.” Figure 2 of Murphy (with colored boxes added by Patent Owner) is reproduced below:

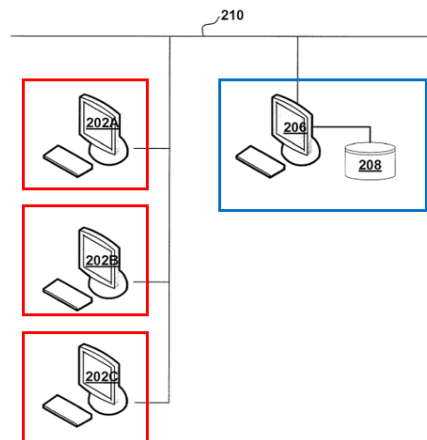


Figure 2

As alleged in the Petition (at 45), in Murphy the alleged indexing results are provided from the server 206 to client computers 202 (analogized to the “compute nodes”). This in contrast to the claim language which that one compute node be

programmed to provide indexing results to another compute node, in Murphy the alleged indexing results are not provided from one compute node (client computer 202) to another compute node (client computer 202) -- but rather from the server 206 to the alleged compute nodes (client computers 202). The Petition fails to explain how Murphy's forwarding of indexing results from server 206 to client computers 202 equates to one compute node being programmed to provide indexing results to another compute node, as recited in claim 14. Thus, Ground 2 is plainly deficient.

C. The Petition Is Deficient On Its Face

Petitioner had the burden of explaining how the challenged claims were to be interpreted, as well as how the prior art mapped to each and every limitation in the challenged claims. Clearly, Petitioners failed to meet this burden, because, e.g., Ground 1 of the Petition is deficient on its face with respect to the recitation of “a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes,” as recited in claim 1 of the ‘844 Patent. In addition, Ground 2 is deficient on its face with respect to the limitation in claim 14 reciting “at least one of said compute nodes is configured to index said root image and provide the indexing results to another of said compute nodes.” Further deficiencies will be set forth in Patent Owner's Preliminary Response. It would be a waste of the Office's resources to refer this Petition to a panel of three PTAB judges to evaluate

on the merits only for them to reach the same conclusion, namely, that the Petition is deficient on its face.

V. CONCLUSION

The Director should exercise her discretion to deny institution because the most reasonable conclusion from the evidence is that the Petitioner (Docker), along with American Airlines, Southwest Airlines, and Unified Patents, have coordinated duplicative challenges to the ‘844 Patent, resulting in harassment of the Patent Owner. Permitting the Petition to move forward under such circumstances will not conserve resources, but will waste them. On this basis alone, the Director should exercise discretion to deny the Petition.

In addition, the settled expectations of the parties strongly favor discretionary denial. Despite having a strong commercial interest in the subject matter of the ‘844 Patent for many years, Petitioner took no steps until now to challenge the ‘844 Patent during the last 12 years that the patent has been in force. The significant length of time that the ‘844 Patent has been in force evidences strong, well-settled expectations of the parties, which favors discretionary denial.

Finally, as explained above, Ground 1 of the Petition is deficient on its face with respect to the recitation of “a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes,” as recited in claim 1 of the ‘844 Patent, and Ground 2 of the Petition is deficient on its face with respect

to the requirement in claim 14 that “at least one of said compute nodes is configured to index said root image and provide the indexing results to another of said compute nodes.” It would be a waste of the Office’s resources to refer this Petition to a panel of three PTAB judges to evaluate on the merits only for them to reach the same conclusion, namely, that the Petition is deficient on its face.

For all of these reasons, the Director should deny institution.

Respectfully submitted,

Dated: July 29, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Intellectual Ventures II LLC*

CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 5,945 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: July 29, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Intellectual Ventures II LLC*

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on July 29, 2025 to lead and backup counsel of record for Petitioner as follows:

Brian M. Buroker (Reg. No. 39,125)
Gibson, Dunn & Crutcher LLP
1700 M St. NW
Washington, DC 20036
Phone: (202) 955-8500
Fax: (202) 467-0539
Email: bburoker@gibsondunn.com

Nathan Curtis (Reg. No. 70,471)
Gibson, Dunn & Crutcher LLP
2001 Ross Avenue, Suite 2100
Dallas, TX 75201
Phone: (214) 698-3423
Fax: (214) 571-2961
Email: ncurtis@gibsondunn.com

GDC-DockerIPR@gibsondunn.com

Dated: July 29, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Intellectual Ventures II LLC*