UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner.

Case No. IPR2025-00854
Patent No. 7,784,058

PETITIONER MICROSOFT CORPORATION'S NOTICE RANKING PETITIONS REGARDING U. S. PATENT NO. 7,784,058 AND EXPLAINING MATERIAL DIFFERENCES

Petitioner is filing three "copycat" IPR petitions against U.S. Pat. No. 7,784,058 ("'058 patent") and this submits this ranking of those petitions.

I. RANKING OF PETITIONS

Rank	Petition	Grounds
1	IPR2025-00853 ("Petition 1")	1) Callender renders obvious claims 1-18
2	IPR2025-00854 ("Petition 2")	1) Ely and Levine render obvious claims 1-6, 9-14, 16, and 18 2) Ely, Levine, and Thekkath render obvious claims 5-8 and 15 3) Eggert and Levine render obvious claims 1-4, 9-12, 16, and 18
3	IPR2025-00855 ("Petition 3")	1) Elnozahy in view of Draves renders obvious claims 1-18

II. MATERIAL DIFFERENCES BETWEEN PETITIONS

A. Material Difference 1: Potential Priority Dispute

The '058 patent issued from an application filed 9/21/2004, claiming priority to a provisional application filed 9/22/2003. Based on these dates, the '058 patent is subject to pre-AIA §102. In the concurrent district-court proceeding between Patent Owner VirtaMove ("PO") and Petitioner ("Microsoft"), PO asserts "[t]he Asserted Claims of the '058 patent are entitled to a priority date ***at least as early as*** September 22, 2003, the filing date of provisional application No. 60/504,213," and that PO "reserves the right to supplement this response." EX-1033, 4 (emphasis added). PO further identified documents "as related to evidencing conception and reduction to practice," while again "reserv[ing] the right to supplement." *Id.* By alleging "a priority date ***at least*** as early as" the earliest

claimed priority date and "reserv[ing] the right to supplement," PO has expressly raised the possibility that PO may attempt to antedate the prior art relied on by these Petitions.

Petition 1 challenges the '058 patent's claims over U.S. Pat. No. 7,024,672 ("Callender"), which issued from an application filed 6/26/2002 (before the '058 patent's earliest provisional filing date) and published 1/1/2004. Therefore, Callender is prior art under pre-AIA 35 U.S.C. §102(e), but not §102(b), and thus might be antedated by PO. PO has not stipulated that Callender is prior art.

Petition 2 challenges the '058 patent's claims over printed publications, including: (1) Linkers and Loaders, a textbook by John R. Levin, published in 2000 ("Levine"); (2) "Alpine: A User-Level Infrastructure for Network Protocol Development," a 2001 presentation by David Ely and other researchers ("Ely"); (3) "Implementing Network Protocols at User Level," a 1993 conference paper by Chandramohan Thekkath ("Thekkath"); and (4) "File Systems in User Space," a 1993 conference paper by Paul Eggert ("Eggert"). Therefore, these are all prior art under pre-AIA §102(b). PO cannot defeat Petition 2 by antedating these references. However, PO may challenge the date or public availability of these references and has not stipulated that these references are prior art.

"Petition 3" challenges the '058 patent's claims over U.S. Pat. App. Pub. No. 2003/0041118 ("Elnozahy") in view of U.S. Pat. No. 6,349,355 ("Draves").

Draves issued on 2/19/2002 (over a year before the ’058’s provisional filing date of 9/2/2003), and therefore is indisputable prior art under §102(b). Elnozahy was published on 2/27/2003 (more than a year before the ’058 patent’s 9/21/2004 nonprovisional filing date, but less than a year before the ’058 patent’s 9/22/2003 provisional filing date), and therefore is prior art under §102(b) unless PO can establish the challenged claims’ entitlement to the earlier provisional filing date. Even if PO does so, Elnozahy would still be prior art under §102(e) as of its 8/23/2001 filing date, which is ten months earlier than Callender’s filing date. Furthermore, Elnozahy was cited in the ’058 patent’s file history.

Defeating Petition 3 by antedating Elnozahy would thus require PO to establish both that the ’058 patent’s claims are supported by and entitled to the filing date of the provisional application, ***and*** that the claimed subject matter was invented and entitled to a priority date earlier than Elnozahy’s filing date of 8/23/2001. This presents a significantly higher burden than that required to antedate Callender’s 6/26/2002 filing date. Thus, should PO establish a priority date earlier than 6/26/2002, Petition 3 will remain viable against the ’058 patent unless PO is able to carry that significantly higher burden.

B. Material Difference 2: Different Evidence and Grounds

Each petition presents arguments directed to different prior art references or different challenged claims, or both. Petition 1 relies on a single reference,

Callender, for the ’058 patent’s 18 claims. Petition 2 relies on combinations of non-patent reference Levine with three other non-patent references (Ely, Thekkath, and Eggert) to challenge ’058 claims 1-6, 9-14, 16, and 18. Petition 3 relies on a combination Elnozahy and Draves to invalidate all 18 claims of the ’058 patent.

Callender’s teachings from Petition 1 are different than those of the Levine and Ely, Thekkath, or Eggert combinations in Petition 2, or those of the Elnozahy and Draves combination in Petition 3. The references in each petition are mapped to different claim limitations in different ways. Thus, apart from the material difference of the potential priority date dispute, the challenges between the petitions are also materially distinct and non-cumulative.

III. INSTITUTION OF ALL PETITIONS IS WARRANTED

The potential priority dispute between the parties justifies institution of the petitions. The Consolidated Trial Practice Guide (“TPG”) recognizes that “more than one petition may be necessary” in circumstances where “there is a dispute about priority date requiring arguments under multiple prior art references.” TPG at 59. The Board has instituted parallel petitions in similar circumstances as here. *See, e.g.*, *Apple Inc. v. Sonrai Memory Ltd.*, IPR2023-00975, Paper 9, 14 (Dec. 14, 2023) (instituting two petitions relying on references having different prior-art dates, “in view of a potential priority dispute regarding the effective filing date of the challenged claims,” because “Patent owner has not conceded that it cannot

establish a priority date earlier than the filing date" of the challenged patent and "makes no [] stipulation" that the asserted "references qualify as prior art") (internal quotation marks and citations omitted); *see also 10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8, 46-47 (April 27, 2020); *SolarEdge Techs. Ltd. v. SMA Solar Tech., AG.*, IPR2020-00965, Paper 8, 33-34 (Jan. 11, 2021).

Although Petitioner has ranked the petitions, instituting all petitions is the fairest outcome due to the potential dispute between the parties about the priority date of the '058 patent, lack of stipulation by PO, and the materially distinct and non-cumulative nature of each petition. TPG at 61. Further, by filing copycat petitions together with Motions for Joinder in which it agrees to an understudy role, Petitioner has surrendered its opportunity to pursue challenges and claims of its own choosing in order to avoid taxing the Board's finite resources during this interim period of diminished resources. For each underlying petition resulting in institution, there will have been a determination that unpatentability is reasonably likely. This determination implicates the public's strong interest in eliminating bad patents, which harm the economy by stifling competition and hindering economic growth. Granting Petitioner's copycat petition for each granted underlying petition serves that public interest by allowing the underlying IPRs to continue in the event of settlement without impacting the Board's finite resources.

Dated: April 18, 2025

Respectfully submitted,

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

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on April 18, 2025, a true and correct copy of the foregoing document was served by emailing a copy of same to the following attorneys, who have agreed to accept service on behalf of Patent Owner:

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