

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner

v.

VIRTAMOVE, CORP.,
Patent Owner

Case No.: IPR2025-00981
U.S. Patent No. 7,784,058
Issue Date: August 24, 2010

Title: COMPUTING SYSTEM HAVING USER MODE CRITICAL SYSTEM
ELEMENTS AS SHARED LIBRARIES

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ARGUMENT.....	2
A. The <i>Fintiv</i> Factors Weigh In Favor Of Institution	2
1. Factor 1 (Stay Potential) Favors Institution.....	2
2. Factor 2 (Timing Of Trial and FWD) Favors Institution Because Patent Owner Voluntarily Dismissed the '058 Patent From the District Court Action.....	3
3. Factor 3 (Litigation Investment) Favors Institution Because the Parties' Investment Is Minimal.....	4
4. Factor 4 (Issue Overlap) Favors Institution Because Patent Owner Voluntarily Dismissed the '058 Patent From the District Court Action.....	5
5. Factor 5 (Identity Of the Parties) Favors Institution.....	7
6. Factor 6 (Other Circumstances) Favors Institution	8
B. Other Considerations, Including Discretionary Considerations Of The March 26, 2025 Interim Processes For PTAB Workload Management, Weigh In Favor Of Institution.....	9
1. Settled Expectations Favor Institution.....	9
2. The Strength Of Oracle's Petition Favors Institution	12
3. Patent Owner Should Not Be Allowed to Escape IPR and Strategically Reassert the '058 Patent Later	13
C. Oracle's Filing Of Parallel Petitions Does Not Support Discretionary Denial.....	13
III. CONCLUSION	15

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , No. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	<i>passim</i>
<i>BOE Tech. Grp. Co., Ltd. v. Optronix Sci. LLC</i> , No. IPR2024-01130, Paper 16 (PTAB Jan. 27, 2025)	8
<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. 2019)	11
<i>NHK Spring Co. Ltd. v. Intri-Plex Techs., Inc.</i> , No. IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	11
<i>Nintendo Co., Ltd. et al. v. Resonant Sys., Inc. d/b/a RevelHMI</i> , No. IPR2025-00680, Paper 18 (PTAB Aug. 14, 2025)	3
<i>Nokia of Am. Corp. v. Soto</i> , No. IPR2023-00680, Paper 30 (PTAB Dec. 3, 2024)	7
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , No. IPR2020-01019, Paper 12 (PTAB December 1, 2020)	5, 6

Statutes

35 U.S.C. § 315(e)	6, 7
American Inventors Protection Act of 1999	11

Other Authorities

MPEP § 2601 (Rev. 1, Nov. 2024)	11
Rule 12(b)(6)	1, 3

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 7,784,058
1002	Prosecution History of U.S. Patent No. 7,784,058
1003	Declaration of Samrat Bhattacharjee, Ph.D. (“Bhattacharjee”)
1004	Curriculum Vitae of Dr. Samrat Bhattacharjee
1005	U.S. Patent No. 7,024,672 (“Callender”)
1006	RESERVED
1007	U.S. Patent No. 6,263,376 (“Hatch”)
1008	U.S. Patent No. 6,260,075 (“Cabrero”)
1009	U.S. Patent No. 6,212,574 (“O’Rourke”)
1010	U.S. Patent No. 5,481,706 (“Peek”)
1011	U.S. Patent No. 7,499,966 (“Elnozahy”)
1012	U.S. Patent App. Pub. No. 2004/0216145 (“Wong”)
1013	U.S. Patent App. Pub. No. 2003/0065856 (“Kagan”)
1014	U.S. Patent No. 7,583,681 (“Green”)
1015	Excerpts from Charles Petzold, <i>Programming Windows 95</i> (Microsoft Press 1996) (“Petzold”)
1016	U.S. Patent App. Pub. No. 2002/0066086 (“Linden”)
1017	U.S. Patent No. 6,349,355 (“Draves”)
1018	Excerpts from Silberschatz et. al, <i>Operating System Concepts</i> (Wiley 6th ed. 2002) (“Silberschatz”)
1019	U.S. Patent No. 7,451,456 (“Andjelic”)
1020	Chart re: ’058 Patent accompanying Plaintiff VirtaMove Corp.’s Supplemental Preliminary Disclosure of Asserted Claims and Infringement Contentions, in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Sep. 26, 2024)
1021	U.S. Patent App. Pub. No. 2002/0095224 (“Braun”)
1022	U.S. Patent No. 6,173,336 (“Stoeckl”)

Exhibit	Description
1023	U.S. Patent No. 6,016,515 (“Shaw”)
1024	U.S. Patent No. 7,080,172 (“Schmalz”)
1025	Excerpts from <i>Webster’s New World Computer Dictionary</i> (10th ed. 2003)
1026	Excerpts from <i>Barron’s Dictionary of Computer and Internet Terms</i> (8th ed. 2003)
1027	U.S. Patent No. 7,324,450 (“Oliver”)
1028	U.S. Patent App. Pub. No. 2003/0103455 (“Pinto”)
1029	U.S. Patent No. 6,526,567 (“Cobbett”)
1030	U.S. Patent App. Pub. No. 2004/0142563 (“Fontarensky”)
1031	U.S. Patent No. 7,284,246 (“Kemp”)
1032	U.S. Patent No. 5,375,241 (“Walsh”)
1033	U.S. Patent No. 6,698,015 (“Moberg”)
1034	Excerpts from Collin, <i>Dictionary of Computing</i> (Collin 4th Ed. 2002) (“Collin”)
1035	Microsoft Computer Dictionary (Microsoft 5th ed. 2002) (“Microsoft”)
1036	U.S. Patent No. 6,526,159 (“Nickerson”)
1037	U.S. Patent App. Pub. No. 2003/0154320 (“Calusinski”)
1038	U.S. Patent No. 7,437,483 (“Goossen”)
1039	U.S. Patent No. 7,100,162 (“Green-162”)
1040	U.S. Patent No. 7,453,852 (“Buddhikot”)
1041	U.S. Patent No. 5,584,023 (“Hsu”)
1042	U.S. Patent No. 7,144,031 (“Lin”)
1043	U.S. Patent No. 6,792,492 (“Griffin”)
1044	U.S. Patent App. Pub. No. 2002/0116563 (“Lever”)
1045	U.S. Patent No. 6,594,698 (“Chow”)
1046	U.S. Patent No. 7,216,164 (“Whitmore”)
1047	U.S. Patent No. 6,988,271 (“Hunt”)

Exhibit	Description
1048	Liss et. al, <i>Efficient Exploitation of Kernel Access to Infiniband: a Software DSM Example</i> , 11th Symposium on High Performance Interconnects, 2003 (“Liss”)
1049	Patel et. al., <i>A Model of Completion Queue Mechanisms Using the Virtual Interface API</i> , Proc. IEEE Int’l Conf. on Cluster Computing, 281-282 (IEEE 2002) (“Patel”)
1050	Scheduling Order in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex. June 17, 2024) (ECF 34)
1051	Federal Court Management Statistics–Profiles, U.S. District Courts–Combined Civil and Criminal (September 2024)
1052	Google LLC’s Proposed Claim Terms for Construction, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Oct. 1, 2024)
1053	Plaintiff’s Disclosure of Proposed Claim Constructions, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Oct. 1, 2024)
1054	U.S. Patent No. 7,124,260 (“LaBerge”)
1055	U.S. Patent No. 7,406,677 (“Colling”)
1056	U.S. Patent No. 5,278,969 (“Pashan”)
1057	Excerpts of <i>Webster’s New World Dictionary</i> (4th Ed. 2003)
1058	Joint Claim Construction Statement, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Dec. 18, 2024)
1059	Google’s Opening Claim Construction Brief, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Oct. 22, 2024)
1060	Request for <i>Ex Parte</i> Reexamination of U.S. Patent No. 7,784,058 (“Unified Reexam”)
1061	U.S. Patent No. 7,210,124 (“Chan”)
1062	U.S. Patent No. 7,055,152 (“Ganapathy”)
1063	U.S. Patent No. 6,419,502 (“Trammel”)
1064	U.S. Patent App. Pub. No. 2003/0140051 (“Fujiwara”)
1065	U.S. Patent No. 6,442,752 (“Jennings”)

Exhibit	Description
1066	U.S. Patent App. Pub. No. 2003/0225864 (“Gardiner”)
1067	VirtaMove’s Responsive Claim Construction Brief, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Nov. 12, 2024)
1068	VirtaMove’s Surreply Claim Construction Brief, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Dec. 13, 2024)
1069	U.S. Patent No. 7,213,247 (“Wilner”)
1070	U.S. Patent App. Pub. No. 2004/0078600 (“Nilsen”)
1071	U.S. Patent App. Pub. No. 2002/0138675 (“Mann”)
1072-1088	RESERVED
1089	Order Granting Defendant Google LLC’s Motion to Transfer Venue, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Jan. 22, 2025)
1090	Order Cancelling Markman Hearing, <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Jan. 17, 2025)
1091-1096	RESERVED
1097	U.S. Patent No. 7,424,710 (“Nelson”)
1098-1106	RESERVED
1107	Plaintiff VirtaMove Corp.’s Supplemental Preliminary Disclosure of Asserted Claims and Infringement Contentions, in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (Sept. 06, 2024)
1108	Order Overruling Objections and Transferring Case to Northern District of California, in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (May 7, 2025)
1109	Plaintiff VirtaMove Corp.’s Preliminary Disclosure of Asserted Claims and Infringement Contentions, in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339 (W.D. Tex.) (Mar. 28, 2025)

Exhibit	Description
1110	Plaintiff’s Voluntary Partial Dismissal Affecting the ’058 Patent, Dkt. No. 48, in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339 (W.D. Tex.) (Aug. 25, 2025)
1111	Scheduling Order, Dkt. No. 54, in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339 (W.D. Tex.) (Sept. 9, 2025)
1112	Excerpt from Defendant Oracle Corp.’s Second Amended Preliminary Invalidity Contentions, in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339 (W.D. Tex.) (July 17, 2025)
1113	First Amended Complaint for Patent Infringement Against Oracle Corporation, Dkt. No. 21, in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339 (W.D. Tex.) (Apr. 11, 2025)
1114	The Future of Linux Containers, YouTube landing page and associated video, https://www.youtube.com/watch?v=wW9CAH9nSLs (Mar. 21, 2013)
1115	A. Avram, Docker: Automated and Consistent Software Deployments, https://www.infoq.com/news/2013/03/Docker/ (Mar. 27, 2013)
1116	Kubernetes Blog: B. Killen, et al., 10 Years of Kubernetes, https://kubernetes.io/blog/2024/06/06/10-years-of-kubernetes/ (June 6, 2024)
1117	GitHub, First Commit – Kubernetes, https://github.com/kubernetes/kubernetes/commit/2c4b3a562ce34cddc3f8218a2c4d11c7310e6d56 (June 6, 2014)
1118	Docket Report, <i>VirtaMove Corp. v. Amazon.com, Inc., et al.</i> , 7:24-cv-00030 (W.D. Tex.) (as of Sept. 9, 2025)
1119	Docket Navigator District Court Litigation Report for VirtaMove Corp. (as of Sept. 9, 2025)

I. INTRODUCTION

Patent Owner's request for discretionary denial is based on the mischaracterization of critical facts and the omission of others. When all the facts are accurately described and considered, the *Fintiv* factors and other relevant considerations favor denial of Patent Owner's request.

To begin, Patent Owner mischaracterizes important facts. For example, Patent Owner mischaracterizes the status of the parallel district court action. The case is in its very early stages. The Court has yet to decide Oracle's motion to dismiss under Rule 12(b)(6) and a motion to transfer venue from the Western District of Texas. Oracle has yet to answer the complaint. General discovery has yet to open. Patent Owner also mischaracterizes the effect of Oracle's broad stipulation that eliminates overlap between this IPR and the district court action, and relies on speculation that Oracle *may* find other prior art and *may* use it in an *ex parte* reexamination.

Patent Owner also ignores critical facts. Most notably, Patent Owner's request does not address the fact that it voluntarily dismissed the '058 patent from the parallel district court action. It also ignores facts that give rise to Oracle's settled expectations that the '058 patent should be reviewed by the Board. The public and Oracle have developed settled expectations since the late 1990s that weak patents can be challenged via congressionally enacted processes in parallel with district

court litigation: first with *inter partes* reexaminations and later strengthened with *inter partes* review proceedings. Furthermore, Patent Owner fails to disclose that the technology it is accusing of infringement in the district court action—third-party open-source technology—has been on the market since 2014, yet Patent Owner waited until 2024 to assert its patent against *anyone* (including Oracle). Because of Patent Owner’s inaction despite wide industry adoption of the accused technology, Oracle formed a settled expectation that the technology it uses is noninfringing.

For these reasons, and the additional reasons explained in this paper and the petition, Oracle respectfully requests that the Director deny Patent Owner’s Request for Discretionary Denial of Institution (Paper 9, the “Request”) and refer this *inter partes* review (IPR) to the merits panel for an institution decision.

II. ARGUMENT

A. The *Fintiv* Factors Weigh In Favor Of Institution

Patent Owner primarily relies on the *Fintiv* factors in arguing that the Director should discretionarily deny Oracle’s Petition. *See* Request at 2-10. But Patent Owner omits facts which show that the *Fintiv* factors collectively favor institution.

1. Factor 1 (Stay Potential) Favors Institution

Factor 1 is “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020). Patent Owner’s request does not mention that it voluntarily dismissed its claims related to the ’058 patent in the

parallel district court action. Ex. 1110. Thus, just as if a stay had been granted, no further investment related to the '058 patent will be made in the district court action and there is no risk of inconsistent outcomes. This factor weighs in favor of institution. *See Nintendo Co., Ltd. et al. v. Resonant Sys., Inc. d/b/a RevelHMI*, No. IPR2025-00680, Paper 18 at 2 (PTAB Aug. 14, 2025) (stay resulting in reduction of “concern of inconsistent outcomes or significant duplication of efforts” weighs in favor of institution). Even if Patent Owner reasserts the '058 patent at some point in the future, this factor would be neutral because whether a stay will (or will not) issue in the parallel district court action is speculative.

2. Factor 2 (Timing Of Trial and FWD) Favors Institution Because Patent Owner Voluntarily Dismissed the '058 Patent From the District Court Action

Factor 2 is the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. Because Patent Owner voluntarily dismissed its claims related to the '058 patent in the parallel district court action (Ex. 1110), there will be no trial for the '058 patent. This factor heavily favors institution. Even if Patent Owner reasserts the '058 patent at some point in the future, this factor would be neutral for the reasons explained below.

Patent Owner’s assertion that the “trial date is November 16, 2026” is speculative. Request at 4. The Court has not ruled on Oracle’s motion to dismiss under Rule 12(b)(6) or on its motion to transfer venue to the Northern District of

California. Should the Court dismiss the case, the trial is moot. And should the Court transfer the case against Oracle, the transferee court will need to ingest the case and set its own pretrial and trial schedule. This factor would be neutral.

3. Factor 3 (Litigation Investment) Favors Institution Because the Parties' Investment Is Minimal

Factor 3 is “investment in the parallel proceeding by the court and the parties.” *Fintiv*, Paper 11 at 6. Because Patent Owner voluntarily dismissed its claims related to the '058 patent in the parallel district court action (Ex. 1110), neither the parties nor the Court will be investing further time or work into this patent, which heavily favors institution. Even if Patent Owner reasserts the '058 patent at some point in the future, this factor would favor institution for the reasons explained below.

This factor weighs in favor of institution because the case is still in its early stages. The pleadings are not closed because the Court has yet to rule on Oracle's motion to dismiss, so Oracle has not yet answered the complaint. Moreover, the Court has not ruled on Oracle's motion to transfer venue to the Northern District of California. The Court has not yet held a *Markman* hearing. The general discovery period has not commenced, and expert reports and summary judgment are many months away. Ex. 1111 at 3. If the Court transfers the case against Oracle (just as the Court did with respect to similar cases filed by patent owner on the same patents against Google and Amazon), the transferee court will need to ingest the case and set its own pretrial and trial schedule. This factor weighs in favor of institution.

4. Factor 4 (Issue Overlap) Favors Institution Because Patent Owner Voluntarily Dismissed the '058 Patent From the District Court Action

Factor 4 is “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 6. Because Patent Owner voluntarily dismissed its claims related to the '058 patent in the parallel district court action (Ex. 1110), there is no issue overlap between this IPR and the parallel district court action, and this factor heavily favors institution. Even if Patent Owner reasserts the '058 patent at some point in the future, this factor would favor institution for the reasons explained below.

Oracle filed a stipulation to prevent issue overlap should this IPR be instituted. *See* Paper 8. Oracle’s stipulation will prevent Oracle from litigating in district court over the same prior art raised in this proceeding should the Board institute this IPR. *See id.* The Board has found such stipulations, which eliminate the overlap between the co-pending proceedings, to weigh in favor institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 18-19 (PTAB December 1, 2020) (precedential).

Oracle’s stipulation is a *Sotera* stipulation, which is broader than a *Sand Revolution* stipulation. Oracle stipulated that it would not pursue in the district court proceeding “(i) the specific grounds raised in IPR2025-00981, (ii) any other ground that could have reasonably been raised before the Board in that instituted proceeding

(i.e., any other ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications).” Paper 8.

While Patent Owner discounts the value of Oracle’s *Sotera* stipulation, it does not dispute that Oracle’s *Sotera* stipulation will prevent Oracle from bringing any ground it raised or could have raised in this IPR in the district court proceeding, eliminating overlap between that proceeding and this IPR. Request at 5-9. Oracle’s stipulation applies the full scope of 35 U.S.C. § 315(e) to the district court proceeding.

Instead, Patent Owner argues that Oracle’s stipulation is insufficient for two reasons: (1) the stipulation does not cover system prior art described by the prior art used in this IPR (Request at 5-7); and (2) *ex parte* reexamination remains an available procedure to challenge the patentability of the patent (Request at 7-9).

Patent Owner’s first reason ignores the efficiency gains from removing printed prior art grounds. It is also incorrect. This IPR raises the following prior art in its obviousness ground: Callender (Ex. 1005). Oracle does not use this prior art reference to describe any system prior art that it asserts in its invalidity contentions in the parallel district court proceeding. *See* Ex. 1112.

Patent Owner’s second reason misapprehends the application of estoppel under 35 U.S.C. § 315(e) and relies entirely on speculation. The preclusive effect of 35 U.S.C. § 315(e) is broader than Patent Owner lets on because it prohibits

Oracle from maintaining at the Patent Office any invalidity grounds that it “raised or **reasonably could have raised**” after a final written decision is entered. Oracle has already served invalidity contentions in the parallel proceeding and filed petitions for IPR of the patent. Patent Owner’s argument is pure speculation about art that Oracle may find in the future that is different from what it reasonably could have raised in its invalidity contentions and IPR petitions. *See* 35 U.S.C. § 315(e).

Because Oracle’s broad *Sotera*-type stipulation will eliminate overlap between this IPR and the parallel district court proceeding, this factor weighs in favor of institution.

5. Factor 5 (Identity Of the Parties) Favors Institution

Factor 5 is “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Because Patent Owner voluntarily dismissed its claims related to the ’058 patent in the parallel district court action (Ex. 1110), there is no litigation involving the ’058 patent to which Oracle is a party. This factor therefore favors institution. Even if Patent Owner reasserts the ’058 patent at some point in the future, this factor would be neutral for the reasons explained below.

Both Oracle and Patent Owner are parties in the parallel proceeding. This, however, is of little moment because parallel proceedings often result in party overlap. *See Nokia of Am. Corp. v. Soto*, No. IPR2023-00680, Paper 30 at 13 (PTAB

Dec. 3, 2024) (“*Fintiv* factor 5 is neutral” where the Petitioner and a defendant in a parallel district court proceeding are the same). Furthermore, this factor is “neutral or weighs slightly in favor of not exercising discretionary denial” when the trial in the parallel district court proceeding “may not occur before the entry of a final written decision.” *BOE Tech. Grp. Co., Ltd. v. Optronic Sci. LLC*, No. IPR2024-01130, Paper 16 at 13-14 (PTAB Jan. 27, 2025). As explained in §§ II.A.2-II.A.3, should the Court grant Oracle’s motion to dismiss, the trial date will be moot. Should the Court grant Oracle’s motion to transfer to the Northern District of California, the transferee court will need to ingest the case and set its own pretrial and trial schedule. This factor would be neutral.

6. Factor 6 (Other Circumstances) Favors Institution

Factor 6 is “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6.

As explained below (§ II.B), other circumstances weigh in favor of institution: (1) Oracle has a settled expectation that the decade-old technology that Patent Owner is only now accusing of infringement is noninfringing; (2) the public, Oracle, and Patent Owner have a settled expectation that patents are subject to challenge at the PTO; (3) Oracle’s petition is strong and has substantive merit; and (4) the Director should not reward Patent Owner’s gamesmanship in attempting to leave the door open to reassert the ’058 patent at some future date.

B. Other Considerations, Including Discretionary Considerations Of The March 26, 2025 Interim Processes For PTAB Workload Management, Weigh In Favor Of Institution

The factors listed in the Director’s March 26, 2025 memorandum¹ weigh in favor of institution. The factors for consideration listed in the Interim Process include: (1) “Settled expectations of the parties”; (2) “The strength of the unpatentability challenge;” and (3) “Any other considerations bearing on the Director’s discretion.”

1. Settled Expectations Favor Institution

The Interim Process calls for consideration of the “[s]ettled expectations of the parties.” Interim Process at 2. This factor favors institution because (1) Patent Owner sat on its patents for a decade after the accused third-party open-source technology was released before asserting claims of infringement, and (2) the public, Oracle, and patent owners have expectations that the validity of patents may be reviewed, and their claims may be cancelled, during the life of issued patents.

First, Oracle developed a settled expectation that the accused technology is noninfringing. Oracle adopted technology that was brought to market over a decade

¹ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (“Interim Process”).

ago by third parties, yet VM did not claim that the technology infringes its patent until 2024.

Specifically, Patent Owner asserts that the use of technology called Docker and Kubernetes infringes its patent. *See* Ex. 1113. Docker debuted and was made open source in 2013. *See* Exs. 1114-1115. Kubernetes was publicly available when it was first pushed to GitHub on June 6, 2014. *See* Exs. 1116-1117.

Despite this, Patent Owner sat on its patents for a decade. Patent Owner did not start its current litigation campaign against various cloud computing companies that use Docker and Kubernetes technology (including Oracle) until 2024. *See* Ex. 1118. Indeed, Docket Navigator indicates that the patent was never asserted—whether by VirtaMove or anyone else—in *any* litigation prior to the current litigation campaign. *See* Ex. 1119. Because Patent Owner did not assert this patent against *anyone* over *any* technology—let alone against Oracle and its use of decade-old technology—Oracle developed settled expectations that the technology is not infringing.

Second, over several decades, patent owners, Oracle, and the public developed a settled expectation that issued patents are subject to review and possible cancellation at the Patent Office during their lifetime, even when they are the subject of parallel district court litigation. Before Congress created the *inter partes* review framework, the Patent Office offered the *inter partes* reexamination procedure,

which was added to the then-existing *ex parte* reexamination procedure on November 29, 1999, as a part of the American Inventors Protection Act of 1999. *See* MPEP § 2601 (Rev. 1, Nov. 2024).

Congress enacted an even more robust mechanism in 2011 for challenges to patents regardless of their age: the *inter partes* review. The point of the IPR procedure is to strengthen the patent system by ensuring patents of spurious quality can be challenged efficiently outside of costly litigation. *See, e.g.*, H.R. Rep. No. 112-98, at 39–40 (2011) (“The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”).

The expectation that “patent owners have had for nearly four decades” is “that patents are open to PTO reconsideration and possible cancelation.” *Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019); *See also NHK Spring Co. Ltd. v. Intri-Plex Techs., Inc.*, No. IPR2018-00752, Paper 8 at 19 (PTAB Sept. 12, 2018) (precedential) (rejecting patentee’s contention that ten-year delay in challenging patent warranted discretionary denial). The fact that the patent is old does not remove this expectation, especially considering that Patent Owner waited until only last year to levy allegations of infringement against decade-old technology.

Patent Owner cannot now suggest that any patent that reaches an arbitrary age is insulated from the review mechanism Congress enacted to *allow for* review of

issued patents regardless of age. Patent Owner provides *no* authority suggesting that the age of the patent insulates it from challenge or is the only consideration that can support that a party had “settled expectations.” Request at 10-11. Overall, this consideration favors institution.

2. The Strength Of Oracle’s Petition Favors Institution

The Interim Process calls for a consideration of “[t]he strength of the unpatentability challenge.” Interim Process at 2. This factor favors institution because the grounds in Oracle’s Petition are strong.

Specifically, according to the examiner, the application was allowed because the prior art of record did not disclose “a shared library having shared library critical system elements (SLCSEs) stored therein for use by the plurality of software applications in user mode” and the final three “wherein” clauses of what issued as claim 1 of the patent which further characterize the SLCSEs. Ex. 1002 (5/3/2010 Notice of Allowance) at pp. 352-353.

The Petition presents grounds that include prior art disclosing the missing features that formed the sole reason for the patent’s allowance. Specifically, the Callender reference, which underpins the sole ground in the petition, discloses a “user mode library” that applications may use for sending and receiving data instead of using preexisting functionality in the system. *See* Pet. at 8-15, 27-49; Ex. 1005.

Had the examiner considered Callender during prosecution, the patent would not have issued in the first place.

3. Patent Owner Should Not Be Allowed to Escape IPR and Strategically Reassert the '058 Patent Later

On August 21, 2025, Patent Owner approached Oracle to discuss dismissal of its claims related to the '058 patent. To avoid gamesmanship and a strategic reassertion of the patent, Oracle requested that if Patent Owner dismisses its claims related to the '058 patent, it should do so with prejudice. Despite this, Patent Owner voluntarily dismissed its claims without prejudice. Ex. 1110.

Given this conduct, Patent Owner may attempt to reassert the '058 patent at some point in the future. Should Patent Owner do so, this will likely require the parties to make additional and inefficient investments of work either in a new district court action or in the existing parallel action to accommodate for the renewed assertion of the '058 patent. Oracle should be given the opportunity now to challenge the patentability of the '058 patent at the PTAB to ensure predictability and promote judicial economy.

C. Oracle's Filing Of Parallel Petitions Does Not Support Discretionary Denial

Patent Owner argues that institution should be denied because Oracle filed “five separate attacks on the validity of the '058 patent.” Request at 11. This is incorrect. Patent Owner admits that Oracle filed “*three* separate petitions against

the '058 patent.” *Id.* And because Patent Owner voluntarily dismissed its claims related to the '058 patent in the parallel district court action (Ex. 1110), and assuming the '058 patent remains unasserted, Oracle will not be presenting any “attack on the validity of the '058 patent” in the current district court proceeding.

This is not a late-filed “serial” petition nor is it an attempt to leverage Patent Owner’s papers in other IPRs to “roadmap” a later petition. Rather, Oracle filed three parallel “copycat” IPR petitions on the same day (May 16, 2025). Paper No. 3 at 1. Along with each petition, Oracle filed a Ranking of its petitions, including an explanation of the material differences between the petitions and why multiple petitions were filed. *Id.* at 1-4. Those differences include: (1) potential priority disputes arising from Patent Owner’s vague assertion in the parallel district court action that the patent is entitled to a priority date “at least as early as September 22, 2003” (*id.*); and (2) each petition presents arguments directed to different prior art references, different challenged claims, or both. *Id.* This petition presents unpatentability and obviousness issues materially distinct from, and non-cumulative of, any of Oracle’s other petitions. *See id.*

Furthermore, each of Oracle’s petitions for IPR present strong merits with compelling grounds. *See* § II.B.2. This weighs in favor of institution.

III. CONCLUSION

Institution is appropriate for the reasons outlined above and in the Petition. Oracle respectfully requests that the Director deny Patent Owner's request to discretionarily deny institution of Oracle's petition for IPR.

Respectfully submitted,
ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: September 11, 2025

/Bas de Blank/

Bas de Blank
Orrick, Herrington & Sutcliffe LLP
Lead Counsel for Petitioner
Registration No. 74,930
1000 Marsh Road
Menlo Park, CA 94025
Tel: 650-614-7400
Fax: 650-614-7401
Email: m2bptabdocket@orrick.com

Attorney for Petitioner Oracle Corporation

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on September 11, 2025 via electronic mail, upon the following attorneys of record for the Patent Owner:

Reza Mirzaie (rmirzaie@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

/Karen Johnson/

Karen Johnson