

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner.

Case No. IPR2025-01002

Patent No. 7,519,814

Issue Date: April 14, 2009

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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35 U.S.C. § 315	9
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PATENT OWNER'S EXHIBIT LIST

No.	Description
2001	April 25, 2025 Joint Motion for Entry of Scheduling Order in <i>VirtaMove, Corp. v. Oracle Corp.</i> , 7:24-cv-00339-ADA (W.D. Tex.), and attached Proposed Order
2002	DocketNavigator Time-to-Trial Statistics for Judge Alan Albright

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 memorandum regarding Interim Processes for PTAB Workload Management (“March 26, 2025 Memo”), Patent Owner requests that the Director exercise discretion to deny institution of the instant Petition, which is substantively identical to a petition that was already denied on discretionary grounds. *See* Paper 4 at 1 (describing the instant Petition as a “substantively identical” petition); *Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00566, Paper No. 11 (PTAB July 11, 2025) (denying institution of original petition to which the instant Petition is “substantively identical” for discretionary reasons).

U.S. Patent No. 7,519,814 (the “’814 patent”) challenged by the Petition issued on April 14, 2009, and as such it has been in force for over *sixteen years* (since before the introduction of the *inter partes* review procedure). Accordingly, Patent Owner VirtaMove had strong settled expectations that the ’814 patent would not be invalidated through agency action.

Accordingly, because the ’814 patent has been enforceable for over sixteen years, the settled expectations weighs heavily in favor of denying institution.

Given the heavily weight of settled expectations, the *Fintiv* factors taken as a whole favor denial of institution. Trial is scheduled before a Final Written Decision will be due in this case. And all of the other *Fintiv* factors also either weigh strongly against institution or are neutral.

Finally, there are *four* parallel petitions filed against the challenged patent filed by Petitioner, presenting nine distinct grounds involving ten different explicitly identified references (including over a hundred different “shadow” references relied on to support the presented invalidity theories). To the extent the Board finds *any* of these Petitions should be instituted, Patent Owner requests that institution be limited to one Petition.

Under similar facts, the Director has already exercised discretion to deny the Petition filed by Amazon. *Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00566, Paper No. 11 (PTAB July 11, 2025). The same result is appropriate here, and Patent Owner respectfully requests that the likewise Director exercise discretion to deny institution in this proceeding.

II. DISCRETIONARY DENIAL OF INSTITUTION UNDER §314(a) IS WARRANTED.

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party;
6. other circumstances that impact the Board's exercise of discretion.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”). In evaluating these factors, the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”).

A. *Fintiv* Factor 1: There is no evidence that a stay will be granted.

Fintiv Factor 1 looks to “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv I* at 5-6.

Here, the District Court Proceeding is pending before Judge Albright in the Western District of Texas. Because the Board ordinarily “will not attempt to predict” how a district court will proceed if a stay has not been granted (*see Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)), there is no reason to suggest that Judge Albright will issue a stay, particularly because the *Markman* hearing (scheduled for October 6, 2025—*see* Ex. 2001) will have been concluded by the time any decision

granting institution would issue. *Fintiv* Factor 1 is thus neutral.

B. *Fintiv* Factor 2: The District Court trial will likely at or before the time for a final written decision.

Fintiv Factor 2 looks to “proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.” *Fintiv I* at 5-6. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Id.* at 9.

Here, the Court’s trial date is November 16, 2026. *See* Ex. 2001. This is before the December 12, 2026 projected deadline for final written decision (if a decision granting institution were issued on December 12, 2025). And the median time-to-trial from original filing for patent cases before Judge Albright is 25 months. *See* Ex. 2002 (Docket Navigator median time-to-trial statistics for Judge Albright). Accordingly, *Fintiv* factor 2 weighs against institution.

C. *Fintiv* Factor 3: The parties will have invested substantially in the District Court case before any institution decision

Fintiv Factor 3 looks to “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision*.” *Fintiv I* at 9 (emphasis added). For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10. “Likewise, district court claim

construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

Here, an institution decision would be due by December 12, 2025. *See* 35 U.S.C. § 314(b). Prior to the deadline for an institution decision, the parties will have invested significant resources in the parallel District Court Proceeding. For example, the parties have already served extensive infringement and invalidity contentions, and Petitioner’s opening claim construction brief has already been filed. *See* Ex. 2001. And by the time any institution would occur, the parties would have completed claim construction briefing and the corresponding hearing, and began the process of fact discovery.

Accordingly, *Fintiv* Factor 3 weighs in favor of discretionary denial.

D. *Fintiv* Factor 4: There is substantial overlap between this IPR and the District Court proceeding.

Fintiv Factor 4 looks to “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. In short, this factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the IPR proceeding. *Id.* at 12. Here, the challenged claims cover all asserted claims, and Petitioner’s stipulation does little to alleviate concerns with redundancy of invalidity theories presented

between this proceeding and the District Court Litigation.

First, the Petition challenges claims 3, 5, 7, 11-12, 15-16, and 31-34, which need not be litigated because these are not asserted against Petitioner, and to the extent they are asserted by Petitioner, the district court would evaluate their validity. *See* Ex. 1029 (VirtaMove’s March 28, 2025 Preliminary Infringement Contentions) at 1 (showing claims 1, 2, 6, 9, 10, and 13 are asserted).

Furthermore, while Petitioner filed a *Sotera*-type stipulation (Paper No. 8 at 1), the scope of Petitioner’s stipulation is not sufficient to ensure that IPR proceedings would be a “true alternative” to the District Court litigation. *See Sotera*, Paper 12 at 19; *see also Motorola v. Stellar*, IPR2024-01205, -01206, -01297, -01208, Paper 19 at 3–4 (March 28, 2025) (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [inter partes review] proceedings would be a ‘true alternative’ to the district court proceeding”).

For example, as discussed in the director review decision in *Motorola v. Stellar*, a standard *Sotera* stipulation is no longer sufficient to determine that *Fintiv* Factor 4 weighs in favor of institution where the district court invalidity contentions “are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *Motorola v. Stellar*, Paper 19 at 4 (March 28, 2025) (“although Petitioner’s *Sotera* stipulation may mitigate some concern of duplication between

the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding or Fintiv factors 1, 2, and 5....”). As the Board has explained in similar situations:

[A] majority of the parties’ work that would be done here will also be required in the litigation regardless of whether we institute review. Accordingly, we do not consider the presence of the *Sotera* stipulation in our case to ensure that *inter partes* review would be a “true alternative” to the Litigation. On balance, we find that Fintiv Factor 4 weighs in favor of discretionarily denying institution.

SAP America, Inc. v. Cyandia, Inc., IPR2024-01496, Paper No. 13 at 9 (PTAB Apr. 7, 2025).¹

Here, Petitioner’s stipulation only warrants that it will not pursue the same grounds as those raised in the IPR proceedings (or that could have been reasonably raised in the IPR proceedings). Paper No. 8 at 1. Thus, the stipulation does not cover any combinations of system prior art, even if such combinations involve art that could have been raised in this proceeding (or even if those combinations involve the *exact same* art raised in this proceeding), rendering Petitioner’s stipulation insufficient to ensure the IPR proceedings are a “true alternative” to the District Court proceedings.

¹ See also FAQs for Interim Processes for PTAB Workload Management, <https://www.uspto.gov/patents/ptab/faqs> (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).

Additionally, Petitioner's stipulation still permits subsequent *ex parte* reexamination petitions on grounds that could have been raised in the Petition (at least before final written decision is entered in this proceeding). Thus, Petitioner's stipulation still allows for repeated challenges to the same patent by the same defendant in multiple venues, obviating the very purpose of the IPR process to streamline the patent system and reduce litigation costs. *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."). While the Director's concerns in *Motorola v. Stellar* focused on concerns over the duplication between the PTAB and District Court proceedings, expecting the Patent Office (through the PTAB and the Central Reexamination Unit) to hear two serial challenges to the same patent is little better.²

² While 35 U.S.C. § 315(e) does preclude a petitioner from filing an *ex parte* re-examination based on any invalidity grounds "which petitioner raised or reasonably could have raised," this language does not fully protect patent owners from serial validity attacks using substantially the same prior art. As the Federal Circuit has explained, if a petitioner seeks to serially challenge a patent (i.e., by filing an *ex parte* re-examination right after conclusion of an IPR proceeding against the same patent), "[t]he burden of proving, by a preponderance of the evidence, that a skilled searcher exercising reasonable diligence would have identified an invalidity ground rests on the **patent holder**." *See Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1298-99 (Fed. Cir. 2023). Thus, petitioners may still abuse the system by withholding certain prior art during the initial IPR challenge, then filing an *ex parte* proceeding if the IPR challenge fails, forcing the patent owner to then carry the burden of proving that the petitioner could have found the additional references with reasonable diligence.

In short, if the Board were to grant institution in this proceeding, it would be considering the same claims of the '814 patent whose validity would also be previously tried before the District Court, and the same claims of the '814 patent whose validity may subsequently be challenged again during any potential *ex parte* reexamination process. This is the opposite of efficiency and contravenes the very purpose of the IPR process.

Thus, *Fintiv* Factor 4 weighs in favor of discretionary denial.

E. *Fintiv* Factor 5: Petitioner is a defendant in in the District Court litigation.

Fintiv Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv I* at 5-6. Specifically, when “the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15. Here, the Petitioner is a defendant in the parallel litigation.

Thus, *Fintiv* Factor 5 weighs in favor of discretionary denial.

F. *Fintiv* Factor 6: Other considerations weigh against institution.

Fintiv Factor 6 looks to “other circumstances that impact the Board's exercise of discretion, including the merits.” *Fintiv I* at 5-6. This factor also weighs heavily against institution, including for the reasons discussed below with regard to

additional considerations (and in particular, the fact that the '814 patent was issued more than sixteen years ago).

G. Additional considerations weigh in favor of discretionary denial.

In addition to the above factors, as explained in the March 26, 2025 Interim Processes for PTAB Workload Management, additional relevant considerations may weigh in favor of discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Here, as discussed further below: 1) the claims have been in effect for over 16 years; 2) no changes in the law support reconsideration of validity of the '814 patent claims, and 3) the Petition is weak and is overly reliant on conclusory expert testimony.

1. Settled expectations weigh heavily against institution.

The '814 Patent issued on April 14, 2009 (before the America Invents Act was even signed into law), and has been in effect for over *sixteen years*. When the patent issued, VirtaMove was not even aware of the possibility of an IPR challenge. Accordingly, the settled expectations of VirtaMove of being able to adjudicate its patent claims before an Article III Court weigh strongly against institution.

2. No changes in the law support reconsideration of patentability.

Second, no changes in the law support reconsideration of the validity of the '814 patent claims, such that there is nothing that would justify upending the settled expectations of both parties as discussed above.

H. The balance of the *Fintiv* factors favor denial.

In sum, five *Fintiv* Factors weigh in favor of discretionary denial, and one is neutral. Furthermore, additional relevant considerations (particularly, settled expectations of the parties) further weigh strongly in favor of discretionary denial. Thus, considered as a whole, the relevant facts all weigh in favor of exercising discretionary denial.

III. PARALLEL PETITIONS WEIGH AGAINST INSTITUTION.

Petitioner Oracle has filed *four* separate petitions against the '814 patent. *See* Paper No. 3 at 1–2. To the extent *any* of these petitions are instituted, Patent Owner requests that institution be limited to a single petition, as Petitioner has not explained

why it should be entitled to five separate attacks on the validity of the '814 patent (its four IPRs plus the district court invalidity arguments).

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution.

Date: August 12, 2025

Respectfully submitted,

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 2,891 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above document was served on August 12, 2025 by filing this document through the Patent Trial and Appeal Case Tracking System (PTACTS) as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioner:

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