

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner.

Case No. IPR2025-00489
Patent No. 7,784,058

**PETITIONER GOOGLE LLC'S NOTICE RANKING PETITIONS AND
EXPLAINING MATERIAL DIFFERENCES**

Petitioner is filing two parallel petitions for *inter partes* review challenging U.S. Patent No. 7,784,058 (“the ’058 patent”). Pursuant to the Board’s Consolidated Trial Practice Guide (November 2019) (“TPG”)¹ at 59-60, Petitioner submits this notice identifying a ranking of the petitions and a succinct explanation of differences between the petitions, why the issues addressed by the differences are material, and why the Board should institute both petitions.

I. RANKING OF PETITIONS

| Rank | Petition | Grounds |
|------|---------------|--|
| 1 | IPR2025-00489 | Callender renders obvious claims 1-18 |
| 2 | IPR2025-00490 | 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 September 21, 2004, and claims priority to a provisional application filed September 22, 2003. Because both filing dates predate the enactment of the Leahy-Smith America Invents Act (“AIA”), the ’058 patent is subject to pre-AIA law under which the patentee can remove a reference as §102(e) prior art by establishing earlier invention antedating the reference.

¹ <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>

In the concurrent district-court proceeding between Patent Owner (“VirtaMove”) and Petitioner (“Google”), VirtaMove claims “[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 “VirtaMove reserves the right to supplement this response.” *See* VirtaMove’s Supplemental Preliminary Disclosure of Asserted Claims and Infringement Contentions, *VirtaMove Corp. v. Google LLC*, No. 2:24-cv-00033 (W.D. Tex. Sep. 6, 2024) (EX1107), 5 (emphasis added). VirtaMove further identified documents “as related to evidencing conception and reduction to practice,” while again “reserv[ing] the right to supplement.” *Id.* That proceeding was stayed just after fact discovery began, with further responses not yet due.

By alleging “a priority date *at least* as early as” the earliest claimed date on the ’058 patent’s face, while leaving the possible date range open-ended and “reserv[ing] the right to supplement” (*id.*, emphasis added), VirtaMove has expressly implicated the possibility that VirtaMove may attempt to defeat IPR2025-00489 (“Petition 1”) by antedating the prior art on which it relies.

Petition 1 challenges the ’058 patent’s claims over U.S. Patent No. 7,024,672 (“Callender”), which issued from an application filed June 26, 2002 (before the ’058 patent’s provisional application date) and published January 1, 2004 (less than a year before the ’058 patent’s nonprovisional filing date).

Therefore, Callender is prior art under pre-AIA 35 U.S.C. §102(e), but not under §102(b). VirtaMove could therefore attempt to defeat Petition 1 by establishing an invention date earlier than Callender's filing date of June 26, 2002. To date, VirtaMove has left open the possibility of establishing such an earlier priority date, and VirtaMove has not stipulated that Callender is prior art. *See* TPG at 61.

IPR2025-00490 ("Petition 2") challenges the '058 patent's claims over U.S. Patent Application Publication No. 2003/0041118 ("Elnozahy") in view of U.S. Patent No. 6,349,355 ("Draves"). Draves issued as a published patent on February 19, 2002 (more than a year before the September 22, 2003 filing date of the '058 patent's provisional application), and therefore is indisputable prior art under §102(b). Elnozahy was published on February 27, 2003 (more than a year before the '058 patent's September 21, 2004 nonprovisional filing date), and therefore is indisputable prior art under §102(b) unless VirtaMove can establish the challenged claims' entitlement to the September 22, 2003 provisional filing date. Even if VirtaMove did so, Elnozahy would still be prior art under §102(e) as of its August 23, 2001 filing date, which is ten months earlier than Callender's filing date.

Defeating Petition 2 by antedating Elnozahy would thus require VirtaMove 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 August

23, 2001. This presents a significantly higher burden than that required to antedate Callender's June 26, 2002 filing date. Thus, should VirtaMove establish a priority date earlier than June 26, 2002, Petition 2 will remain viable against the '058 patent unless VirtaMove is able to carry that significantly higher burden.

B. Material Difference 2: Different Evidence and Grounds

Petition 1 relies on single-reference obviousness over Callender to meet all claim limitations, whereas Petition 2 relies on a combination of Elnozahy and Draves, with Draves supplying teachings not expressly present in Elnozahy. Thus, apart from the material difference of the potential priority dispute, the unpatentability and obviousness issues between the two petitions are also materially distinct and non-cumulative.

III. INSTITUTION OF BOTH PETITIONS IS WARRANTED

The potential priority dispute between the parties justifies institution of two petitions. The 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); *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8, 46-47 (April 27, 2020) (instituting two petitions where patent owner “might try to defeat Petition 1 by alleging an earlier date of invention, but would be unable to do so with respect to [indisputable prior art] in Petition 2,” noting that “[t]o avoid institution of two parallel petitions, Patent Owner could have agreed not to dispute Petitioner’s contention that [Petition 1’s] references are prior art,” but “did not do so”) (internal quotation marks and citations omitted); *SolarEdge Techs. Ltd. v. SMA Solar Tech., AG.*, IPR2020-00965, Paper 8, 33-34 (Jan. 11, 2021).

Although Petitioner ranks Petition 1 higher than Petition 2, instituting both petitions is the fairest outcome in view of the potential dispute between the parties about priority date of the ’058 patent, absent a stipulation by VirtaMove. TPG at 61. Institution of two trials will not unduly burden the Board given the limited number of grounds (each Petition presents only one ground against each claim).

Dated: January 31, 2025

Respectfully submitted,
Google LLC

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

I certify that on January 31, 2025, I will cause a copy of the foregoing document, including any exhibits or appendices filed therewith, to be served via USPS Priority Mail Express at the following correspondence address of record for the patent:

Allen, Dyer, Doppelt + Gilchrist, PA
1135 East State Road 434
Suite 3001
Winter Springs, FL 32708

Date: January 31, 2025

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